

HEINONLINE

Citation: 2000 U. Ill. L. Rev. 1119 2000

Content downloaded/printed from
HeinOnline (<http://heinonline.org>)
Wed Jul 25 15:15:57 2012

- Your use of this HeinOnline PDF indicates your acceptance of HeinOnline's Terms and Conditions of the license agreement available at <http://heinonline.org/HOL/License>
- The search text of this PDF is generated from uncorrected OCR text.
- To obtain permission to use this article beyond the scope of your HeinOnline license, please use:

[https://www.copyright.com/ccc/basicSearch.do?
&operation=go&searchType=0
&lastSearch=simple&all=on&titleOrStdNo=0276-9948](https://www.copyright.com/ccc/basicSearch.do?&operation=go&searchType=0&lastSearch=simple&all=on&titleOrStdNo=0276-9948)



VANDERBILT
UNIVERSITY

DiscoverArchive

Retrieved from DiscoverArchive,
Vanderbilt University's Institutional Repository

This work was originally published in
2000 U. Ill. L. Rev. 1119 2000

IMPLIED LIMITS ON THE LEGISLATIVE POWER: THE INTELLECTUAL PROPERTY CLAUSE AS AN ABSOLUTE CONSTRAINT ON CONGRESS

Paul J. Heald*
Suzanna Sherry**

Professors Heald and Sherry argue that the language of Article I, Section 8, Clause 8, the Intellectual Property Clause, absolutely constrains Congress's legislative power under certain circumstances. Their analysis begins by looking at other limits on the legislative power that the Court has found in the Bankruptcy Clause, the Eleventh Amendment, the Tenth Amendment, and Article III. Then by examining the history and structure of the Intellectual Property Clause and relevant precedent, they distill four principles of constitutional weight—the Suspect Grant Principle, the Quid Pro Quo Principle, the Authorship Principle, and the Public Domain Principle. These principles inform the Court's jurisprudence in cases involving the Intellectual Property Clause, acting as implied and absolute limits on Congress's exercise of its legislative power. Finally, Professors Heald and Sherry apply these principles to recent pieces of legislation and evaluate the constitutionality of several proposed and recently enacted laws.

I. INTRODUCTION

The Congress shall have the Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.¹

* Allen Post Professor of Law, University of Georgia.

** Cal Turner Professor of Law and Leadership, Vanderbilt University.

We would like to thank Dan Burk, Dan Coenen, Paul Edelman, Dan Farber, Marci Hamilton, Mark Lemley, Larry Lessig, David McGowan, and faculty colloquia at the University of Arizona and the University of Texas for their critiques and suggestions.

1. U.S. CONST. art. I, § 8, cl. 8.

Congress recently has been chafing at the limits imposed by the Intellectual Property Clause. Some of the constraints on Congress's power over intellectual property² are self-evident: grants of rights should "promote the Progress of Science and useful Arts" and be made only for "limited Times" to "Authors and Inventors."³ The Court has suggested that other limits are inherent in the language, including the requirements that "Writings" be original⁴ and that "Discoveries" be interpreted in such a way as to protect the public domain from privatization.⁵ 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.⁶ As the debate heats up over the constitutionality of these laws, two questions become urgent: (1) What is the scope of Congress's power under the Intellectual Property Clause? and (2) To what extent does the limiting language of the Clause constrain Congress's other Article I powers, such as those granted in the Commerce and Treaty Clauses?⁷

Two recent controversies illustrate the difficulty in applying the language of the Clause. The proposed Database Protection Act⁸ seeks to

2. When we talk about Article I, Section 8, Clause 8 of the Constitution, we will use the term "Intellectual Property Clause" rather than refer to disjunct Patent or Copyright Clauses, even though the term "intellectual property" was probably not known to the framers. Elsewhere in the paper, we use the term "intellectual property" as current practitioners do to denote works typically protected under the law of patents, copyrights, trademarks, and trade secrets.

3. U.S. CONST. art. I, § 8, cl. 8.

4. See *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345-56 (1991).

5. See *Graham v. John Deere Co.*, 383 U.S. 1, 5-6 (1966) (dictum).

6. See *infra* notes 8, 12, 15-19 and accompanying text.

7. Articles raising this question include Theodore H. Davis, Jr., *Copying in the Shadow of the Constitution: The Rational Limits of Trade Dress Protection*, 80 MINN. L. REV. 595, 640 (1996) ("Congress cannot override constitutional limitations on its own authority merely by invoking the Commerce Clause."); Rochelle C. Dreyfuss, *A Wiseguy's Approach to Information Products: Muscling Copyright and Patent into a Unitary Theory of Intellectual Property*, 1992 SUP. CT. REV. 195, 230 ("Restrictions on constitutional grants of legislative power, such as the Copyright Clause, would be meaningless if Congress could evade them simply by announcing that it was acting under some broader authority."); Michael F. Finn, "Just the Facts, Ma'am": *The Effect of the Supreme Court's Decision in Feist Publications, Inc. v. Rural Telephone Service Co. on the Colorization of Black and White Films*, 33 SANTA CLARA L. REV. 859, 871 (1993) ("It seems likely that the same rationale present in *Gibbons* would also bar any type of Commerce Clause legislation aimed at removing limitations of the Intellectual Property Clause."); John J. Flynn, *The Orphan Drug Act: An Unconstitutional Exercise of the Patent Power*, 1992 UTAH L. REV. 389, 414 n.81 ("[T]he Commerce Clause and the Patent Clause should be read together as establishing an implicit policy of precluding the federal government from granting private parties unregulated and exclusive monopolies over economic activity other than that authorized by the Patent Clause."); 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."). There are also a few federal cases. See, e.g., *United States v. Moghadam*, 175 F.3d 1269, 1280 (11th Cir. 1999) (holding Congress may enact antibootlegging legislation to protect musical works that are not fixed); *Authors League of Am., Inc. v. Oman*, 790 F.2d 220, 224 (2d Cir. 1986) (upholding now-expired manufacturing clause of the Copyright Act).

8. H.R. 354, 106th Cong. (1999).

evade the Court's decision in *Feist Publications, Inc. v. Rural Telephone Service Co.*⁹ that under the Intellectual Property Clause, only an original selection or arrangement of facts, but not the facts themselves, may receive copyright protection.¹⁰ For example, under the proposed legislation an independent real-estate agent could not make an unauthorized use of information in a publicly distributed list of houses for sale. Similarly, a travel agent could not "extract" an airline's arrival, departure, and fare information from its publicly accessible website without authorization.¹¹ Can Congress justify providing protection for facts under its general legislative power despite *Feist's* holding that the Intellectual Property Clause prohibits copyright protection for facts? Another controversy involves a recently passed amendment to the Patent Act that provides for the issuance of patents for biotech processes even if they are obvious in light of the prior art.¹² Formerly, the Court in *Graham v. John Deere Co.*¹³ suggested that under the Intellectual Property Clause, Congress may only reward an inventor with a patent if the invention embodies an inventive step beyond the prior art.¹⁴ Is the new statute, which requires no such step, properly grounded in the Intellectual Property Clause, and if not, can its proponents justify it by reference to another Article I power instead?

Other recent statutes raise similar questions. For example, has Congress validly extended the term of copyright protection for works that have already been created?¹⁵ Has Congress validly granted sui generis protection for obvious boat-hull designs¹⁶ and long-known orphan drugs?¹⁷ Has Congress validly restored copyright protection to certain foreign works that had fallen into the public domain?¹⁸ Has Congress validly protected music that has not been fixed in a tangible form?¹⁹

Our attempt to answer these questions has led us far beyond the typical reaches of substantive intellectual property law and directly to one of the most difficult conundrums in constitutional law—how to determine when limiting language found in one part of the Constitution affects the scope of powers emanating from different clauses. We could not address the legitimacy of the proposed database legislation, for example, merely by reading the Court's pronouncements in *Feist* about the scope of Congress's copyright power. Although the case contains very strong language favoring broad public access to facts,²⁰ it expresses no opinion on whether Congress's

9. 499 U.S. 340 (1991) (holding telephone white pages not protectable).

10. See *id.* at 363.

11. See H.R. 354, 106th Cong. § 1402(b) (1999).

12. See 35 U.S.C. § 103(b)(1) (Supp. IV 1998).

13. 383 U.S. 1 (1966).

14. See *id.* at 6.

15. See 17 U.S.C. § 304 (1994 & Supp. IV 1998).

16. See *id.* § 1301.

17. See 21 U.S.C. §§ 360aa–360ee (1994 & Supp. IV 1998).

18. See 17 U.S.C. § 104(A) (1994 & Supp. IV 1998).

19. See 18 U.S.C. § 2319A (1994 & Supp. IV 1998).

20. See *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349–50 (1991).

interest in regulating interstate commerce might justify restricting that access. Therefore, in searching for *absolute limits* on the legislative power, we were forced to consider whether the language of the Intellectual Property Clause impliedly constrains Congress's other Article I powers. If implied constraints exist, then what is the scope and nature of these constraints? The lack of a clearly established methodology for finding implied constraints on the legislative power rendered our task a formidable one.

A. *Implied Powers*

We all know how to read implied legislative powers into the Constitution. The lasting legacy of *McCulloch v. Maryland*²¹ is not only Chief Justice Marshall's recognition that Congress has implied powers to legislate,²² but also his comprehensive exposition of the sorts of arguments that the Court will find persuasive in determining whether such implied powers grant Congress authority to enact a specific statute.²³ His opinion is an example of legal pragmatism at its best: he used an eclectic mix of sources to support his ultimate conclusion that Congress had the power to establish a national bank.²⁴ He turned to history, text, usage, structure, congressional action and inaction, logic, common-law reasoning, and practical considerations in his quest to interpret the Necessary and Proper Clause.²⁵ In the final analysis, Congress has the power to establish the Bank of the United States not simply because banking might theoretically be understood to constitute "commerce" under the Commerce Clause, but rather because taking all relevant interpretive guideposts into account, Marshall was convinced that those who enacted the Constitution understood it to grant Congress that power.²⁶

B. *Implied Limits*

Although we are all familiar with the *McCulloch* strategy for determining the existence and contours of implied powers, we are less likely to notice its usefulness for specifying implied limits on congressional power. One dramatic example of such a limit came in *Railway Labor Executives'*

21. 17 U.S. (4 Wheat.) 316 (1819).

22. *See id.* at 419.

23. *See generally id.*

24. For discussions of legal pragmatism, see, for example, RICHARD A. POSNER, *THE PROBLEMS OF JURISPRUDENCE* (1990); *PRAGMATISM IN LAW AND SOCIETY* (Michael Brint & William Weaver eds., 1991); *THE REVIVAL OF PRAGMATISM: NEW ESSAYS ON SOCIAL THOUGHT, LAW, AND CULTURE* (Morris Dickstein ed., 1998); Daniel A. Farber, *Legal Pragmatism and the Constitution*, 72 MINN. L. REV. 1331 (1988); Daniel A. Farber, *Reinventing Brandeis: Legal Pragmatism for the Twenty-First Century*, 1995 U. ILL. L. REV. 163; and Thomas C. Grey, *Holmes and Legal Pragmatism*, 41 STAN. L. REV. 787 (1989).

25. *See generally McCulloch*, 17 U.S. at 401-37 (employing arguments including the authority of the First Congress, the lack of limiting phrases, the location of the Necessary and Proper Clause, and the definition of "necessary").

26. *See id.*

Ass'n v. Gibbons,²⁷ in which the Court held that Congress could not enact legislation under the Commerce Clause that would conflict with the language in Article I granting Congress the power to enact “uniform Laws on the subject of Bankruptcies.”²⁸ Similarly, in recent cases interpreting the Tenth Amendment, the Eleventh Amendment, and Article III, the Court has gone beyond the text to find implied limits on congressional power.²⁹ The Court also takes an analogous approach to state regulation of commerce: the grant of power to Congress is interpreted to impose an implied limit on the power of states.³⁰

We might call the process of implying limits the “flipside” of *McCulloch*. *McCulloch* tells us how to determine whether an enumerated power is broader than it looks. In this article, we ask whether an enumerated power also may be narrower than it looks. In particular, we ask how the Court should limit the reach of a particular clause *given the existence of another constitutional clause, read in light of its history and place in the overall structure of the Constitution*. In other words, we try to distill from one part of the Constitution principles that are so significant that they affect interpretation of other parts as well. Specifically, we examine the underlying history and structure of the Intellectual Property Clause in order to determine which of its limits are so fundamental that they should absolutely constrain Congress’s power. The Court has sometimes labeled such limits “essential postulates”;³¹ we call them “principles of constitutional weight.”

We emphasize that these limitations entail implied positive prohibitions on congressional conduct, not merely lack of authority to legislate. Thus, we do not discuss cases like *United States v. Lopez*,³² in which the Court held that Congress simply lacked authority under the Commerce Clause to enact the Gun Free School Zones Act,³³ or *City of Boerne v. Flores*,³⁴ in which the Court held that Congress lacked the power under Section 5 of the Fourteenth Amendment to enact the Religious Freedom Restora-

27. 455 U.S. 457 (1982).

28. U.S. CONST. art. I, § 8, cl. 4; *see also Gibbons*, 455 U.S. at 473.

29. *See infra* text accompanying notes 42–74.

30. *See* JOHN E. NOWAK & RONALD D. ROTUNDA, CONSTITUTIONAL LAW § 4.1 (4th ed. 1991).

31. *See, e.g., Alden v. Maine*, 527 U.S. 706, 729 (1999) (quoting *Monaco v. Mississippi*, 292 U.S. 312, 322 (1934)); *Printz v. United States*, 521 U.S. 898, 918 (1997) (quoting *Monaco*, 292 U.S. at 322). Other commentators have described a similar process in other terms. Laurence Tribe has recently labeled “structural inference” as:

[A] form of constitutional extrapolation that seeks to derive rights and principles from an array of sources, including the interactions among, and the spirit behind, constitutional provisions, the basic presuppositions that gave life to those provisions, and the overarching themes that can be gleaned from the architecture of the founding document as a whole.

Laurence H. Tribe, *Saenz Sans Prophecy: Does the Privileges or Immunities Revival Portend the Future—or Reveal the Structure of the Present?*, 113 HARV. L. REV. 110, 110 n.3 (1999). Others have described a similar process as “penumbral reasoning” or “drawing logical inferences by looking at relevant parts of the Constitution as a whole and their relationship to one another.” Brannon P. Denning & Glenn Harlan Reynolds, *Comfortably Penumbral*, 77 B.U. L. REV. 1089, 1092 (1997).

32. 514 U.S. 549 (1995).

33. *See id.* at 567–68.

34. 521 U.S. 507 (1997).

tion Act.³⁵ These are cases in which the Court finds Congress's power just runs out, rather than runs into barriers. *Gibbons* and other cases, however, imply positive limits on otherwise valid authority derived from other parts of the Constitution.

We also do not focus on express prohibitions—such as the Bill of Rights or the *Ex Post Facto* Clause—that explicitly “trump” otherwise valid congressional authority, usually in order to protect individual rights.³⁶ The Bill of Rights expressly limits Congress's exercise of *all* of its powers, but the Intellectual Property Clause does not purport to do so by its own terms, which contains grants of power and limitations on those grants. Thus, Intellectual Property Clause constraints on the general legislative power must be of the implied variety rather than express trumps.

For this reason, we find recent Tenth and Eleventh Amendment cases to be very instructive. The principle of federalism implicit in both Amendments acts as a structural safeguard rather than a substantive prohibition.³⁷ The Court has explained that the Tenth Amendment provides a way of interpreting the Article I grant of legislative power itself, thereby acting as a structural safeguard:

The Tenth Amendment . . . restrains the power of Congress, but this limit is not derived from the text of the Tenth Amendment itself, which, as we have discussed, is essentially a tautology. Instead, the Tenth Amendment confirms that the power of the Federal Government is subject to limits that may, in a given instance, reserve power to the States. The Tenth Amendment thus directs us to determine . . . whether an incident of state sovereignty is protected by a limitation on an Article I power.³⁸

In the course of narrowing Congress's Article I powers, the Court has similarly admitted that it has “understood the Eleventh Amendment to stand not so much for what it says, but for the presupposition . . . which it confirms.”³⁹ Thus, like the limits placed on Congress's general legislative power by the Bankruptcy Clause or the limits on state power implied by the Commerce Clause, the limits of the Tenth and Eleventh Amendments are implied.⁴⁰ The question, then, is how to identify these limits.

35. *See id.* at 534–36.

36. An interesting example of an explicit “trump” outside the context of individual rights is the Export Clause, found in Article I, Section 9 (shortly before the *Ex Post Facto* Clause), which commands that “[n]o Tax or Duty shall be laid on Articles exported from any State.” U.S. CONST. art. I, § 9. *See* Claire R. Kelly & Daniela Amzel, *Does the Commerce Clause Eclipse the Export Clause? Making Sense of United States v. United States Shoe Corp.*, 84 MINN. L. REV. 129, 130–31 (1999).

37. One view of the Bill of Rights is that it also merely puts into writing rights that would exist anyway. But that view is rare today, although it was common in the eighteenth century. *See* Suzanna Sherry, *Natural Law in the States*, 61 U. CIN. L. REV. 171, 172–73 (1992); Suzanna Sherry, *The Founders' Unwritten Constitution*, 54 U. CHI. L. REV. 1127, 1132–33 (1987).

38. *New York v. United States*, 505 U.S. 144, 156–57 (1992).

39. *Blatchford v. Native Village*, 501 U.S. 775, 779 (1991).

40. Because of our interest in evaluating claims that various proposed or enacted statutes concerning intellectual property are unconstitutional, we focus primarily on the Court's interpretive methodology in cases involving implied limitations of the federal legislative power. Obviously, the Court has found

We focus on cases in which the Court has found implied limits on congressional power and describe the sorts of constitutional sources that it has found useful in identifying principles of constitutional weight. Neither the Court nor the scholarly literature has detailed a coherent methodology for cases involving implied limitations. Thus, our project is at least partly descriptive rather than prescriptive. Rather than suggest the interpretive methodology that courts *should* use to identify implied limits, we focus on how the Supreme Court *does* identify such limits. The Court has found limits in a broad range of constitutional provisions, but our attempt is the first to tie these cases together. A coherent description of the Court's approach across contexts is a necessary first step in understanding and evaluating the scope of implied limits on congressional power.

In part II, we describe the methodology that the Court uses in finding implied limits on Congress's constitutional powers. We offer a summary of the methodology in part II.C (for readers who wish to skip its extensive documentation in parts II.A and II.B). In part III, we apply this methodology to the Intellectual Property Clause and inquire whether it might be the source of significant principles that limit congressional power. After examining the history of the Clause, its role in the structure of the Constitution, and relevant precedent in parts III.A, III.B, and III.C, we describe the underlying intellectual property principles derived from these sources in part III.D. Finally, in part IV, we describe current constitutional controversies in intellectual property law—various congressional attempts to evade the language of the Intellectual Property Clause—and we apply our principles of constitutional weight to these statutes.

II. IMPLYING ABSOLUTE LIMITS ON LEGISLATIVE POWER

On a number of recent occasions, the Court has struck down legislation on the ground that the Constitution implicitly constrains congressional power. Although some of the constraints are more tethered to the language of the Constitution than others, none of the constraints finds a basis in any of the express prohibitions that the framers included in the document. An examination of these cases reveals the general principles that animate the Court's thinking in this area. Our interest is not in whether the cases are rightly or wrongly decided but in identifying the interpretive methodology that the Court employs. We examine five constitutional provisions on which the Court has recently focused its attention: the Bank-

implied constitutional limitations that are directed at actors other than Congress. For example, although the sovereign immunity of the federal government from suit by private citizens is not dictated by any express language in the Constitution, the Court has had no difficulty implying immunity outside of the takings context. See *United States v. Lee*, 106 U.S. 196, 207 (1882). Doctrines restraining intergovernmental taxation also rest on implications of the federal system established by the framers rather than on any express constitutional language. See generally *McCulloch v. Maryland*, 17 U.S. (4 Wheat.) 316 (1819). The prohibition on state court injunctions against federal officers is similarly implied rather than express. See *Donovan v. City of Dallas*, 377 U.S. 408, 412–13 (1964); *Tarble's Case*, 80 U.S. (13 Wall.) 397, 406 (1871).

ruptcy Clause, the Eleventh Amendment, the Tenth Amendment, the Commerce Clause, and Article III (as a whole). After briefly describing the context of these cases, we turn to a closer examination of the Court's methods.

A. *Going Beyond Text*

The cases we focus on fall mostly into broad groups, but one case is sui generis. In *Railway Labor Executives' Ass'n v. Gibbons*,⁴¹ the Court struck down a statute that rearranged the priorities of the secured creditors and former employees of the Chicago, Rock Island and Pacific Railroad Company.⁴² Because the statute purported to affect only a single regional bankruptcy, the Court found that it was not "uniform"⁴³ in the sense understood by the framers of the Constitution when they drafted the language granting Congress the power to "establish . . . uniform Laws on the subject of Bankruptcies throughout the United States."⁴⁴ Although the law clearly fell within the modern understanding of Congress's power to regulate interstate commerce, the Court held that allowing Congress to "enact nonuniform bankruptcy laws pursuant to the Commerce Clause . . . would eradicate from the Constitution a limitation on the power of Congress to enact bankruptcy laws."⁴⁵ Following the Court's logic, the statute was not merely unauthorized by the Bankruptcy Clause—Congress was implicitly forbidden from enacting it pursuant to any of its other powers.

In the context of the Eleventh Amendment,⁴⁶ the Court has also gone beyond express language to find limits on Congress's power to subject states to suit in federal court. Building on *Hans v. Louisiana*,⁴⁷ the Court has interpreted the Eleventh Amendment to embody a general constitutional principle of state immunity from suit and thus placed the general principle beyond congressional power to alter.⁴⁸ This interpretation goes well beyond the language of the Eleventh Amendment, which expressly protects a state only from "the Judicial Power of the United States" (not its own judicial power) in certain circumstances: if it is sued "in law or equity" (not admiralty) by "citizens of another state" (not its own citizens) or by "citizens or subjects of a foreign state" (not the foreign state itself).⁴⁹ In *Hans* and cases following it, the Court defined the reach of the Eleventh

41. 455 U.S. 457 (1982).

42. See generally *id.*

43. *Id.* at 468–73.

44. U.S. CONST. art. I, § 8, cl. 4.

45. *Gibbons*, 455 U.S. at 468–69.

46. U.S. CONST. amend. XI ("The Judicial Power of the United States shall not be construed to extend to any suit in law or equity, commenced or prosecuted against one of the United States by Citizens of another State, or by Citizens or Subjects of any Foreign State.").

47. 134 U.S. 1 (1890).

48. See generally MARTIN H. REDISH & SUZANNA SHERRY, FEDERAL COURTS: CASES, COMMENTS, AND QUESTIONS 382–413 (4th ed. 1998).

49. U.S. CONST. amend. XI.

Amendment to encompass the four circumstances we have put in parentheses. In *Hans*, the Court held that a state was immune from suits brought by its own citizens in federal court;⁵⁰ in *Ex parte New York*,⁵¹ the Court extended the protection of the Eleventh Amendment to suits in admiralty;⁵² in *Monaco v. Mississippi*,⁵³ the Court held that the Amendment barred a suit by a foreign nation,⁵⁴ and in *Alden v. Maine*,⁵⁵ the Court held that Congress was barred from abrogating a state's immunity from private suit in that state's own courts.⁵⁶ In addition, the Court ruled in *Seminole Tribe v. Florida*⁵⁷ that the strictures of the Eleventh Amendment limited the reach of other clauses as well, holding that Congress could not use its Commerce Clause powers to abrogate state immunity from private suits in federal court.⁵⁸ These cases resoundingly affirm that the Eleventh Amendment contains several implied limits on congressional power to enforce federal causes of action and also illustrate the methods that the Court uses to discover and define such limits.

Another group of recent cases focuses on limits implied by the Tenth Amendment. In *New York v. United States*,⁵⁹ the Court held that Congress could not constitutionally force the states to make the "Hobson's choice" of either establishing dump sites for low-level radioactive waste or taking title to the waste.⁶⁰ The primary problem with the Low-Level Radioactive Waste Policy Amendments Act of 1985⁶¹ was the method that Congress chose to regulate the disposal of the radioactive waste.⁶² Instead of establishing federal dump sites or requiring some sort of approved private disposal, Congress impermissibly "commandeered" state legislatures,⁶³ treating them like "regional offices" or "administrative agencies of the Federal Government"⁶⁴ by mandating that they take care of the problem.⁶⁵ Five years later in *Printz v. United States*,⁶⁶ the Court held similarly that Congress could not "commandeer" state executive officials.⁶⁷ *Printz* struck

50. See *Hans*, 134 U.S. at 15, 20–21.

51. 256 U.S. 490 (1921).

52. See *id.* at 500.

53. 292 U.S. 313 (1934).

54. See *id.* at 329–30.

55. 527 U.S. 706 (1999).

56. See *Alden*, 527 U.S. at 712. It is not entirely clear whether *Alden* rests on the Eleventh Amendment, the Tenth Amendment, or some general principles of federalism, but the method the Court uses to find implied limitations is the same in all three instances, so the exact constitutional provision at issue is not particularly significant. Because the Court's analysis in the case is so heavily intertwined with *Seminole Tribe*, it is analytically convenient to consider *Alden* as an Eleventh Amendment case.

57. 517 U.S. 44 (1996).

58. See *id.* at 47.

59. 505 U.S. 144 (1992).

60. See *id.* at 176–77.

61. 42 U.S.C. §§ 2021b–2021j (1994).

62. See *New York v. United States*, 505 U.S. at 160–62.

63. See *id.* at 161.

64. *Id.* at 188.

65. See *id.* at 176–77.

66. 521 U.S. 898 (1997).

67. See *id.* at 935.

down the portions of the Brady Handgun Violence Prevention Act⁶⁸ that required local law enforcement officials to perform background checks of gun purchasers.⁶⁹ As in the Eleventh Amendment cases, these cases went beyond the language of the Tenth Amendment to find implied limitations on congressional powers.

A third set of federalism cases raises an analogous but converse issue. The dozens of cases developing the so-called Dormant Commerce Clause doctrine hold that the Commerce Clause's affirmative grant of power to Congress implies a corresponding limit on the states' general power to regulate interstate commerce.⁷⁰ The doctrine prohibits states from passing legislation that either discriminates against interstate commerce or unduly interferes with it.⁷¹

Finally, some relevant cases sound in separation of powers rather than in federalism.⁷² The most thorough examination of implied limits derived from Article III is contained in *Plaut v. Spendthrift Farm, Inc.*⁷³ In *Plaut*, the Court focused on Congress's authority to encroach on principles of judicial finality implicit in Article III, and held that Congress could not direct federal courts to reopen cases that had come to a final judicial conclusion.⁷⁴

In each of these areas, the Court looked to the history and structure of the Constitution to discover principles of constitutional significance not explicitly contained in the text and then applied them to constrain Congress. It is important to note, however, that once the Court identifies an implied limit, it has the same effect as an express limit: Congress cannot transgress it. The hard question is not how to *apply* implied limits but rather how to *identify and define* them. We turn next to a detailed examination of the sources the Court uses to derive implied limits on legislative power.

B. Finding Implied Limits

1. The Relevance of History

One need not be an originalist to find history a useful guide in interpreting at least some provisions of the Constitution. Indeed, the Supreme Court has often turned to historical sources in its search for constitutional meaning. Historical analysis seems especially prominent in cases involving constitutional structure and legislative power, where individual rights are

68. Pub. L. No. 103-159, 107 Stat. 1536 (codified as amended at 18 U.S.C. § 922 (1994)).

69. See *Printz*, 521 U.S. at 933.

70. See, e.g., *South Carolina State Highway Dep't v. Barnwell Bros.*, 303 U.S. 177, 184 (1937).

71. See *id.* at 184 n.2.

72. Although we focus in the text on *Plaut v. Spendthrift Farm, Inc.*, 514 U.S. 211 (1995), another case within this category of implied limits is *Lujan v. Defenders of Wildlife*, 504 U.S. 555, 577 (1992) (holding that Article III impliedly limits Congress's power to grant standing to someone who has not suffered an injury).

73. 514 U.S. 211 (1995).

74. See *id.* at 240.

not directly at stake.⁷⁵ Maybe the Court believes (perhaps mistakenly) that the structure of government has changed less than our vision of individual autonomy or that there are no better sources to inform its interpretation.

To acknowledge that history is relevant, however, only begins the inquiry. Because different theories of constitutional interpretation might make different historical sources relevant, we need to specify which sources the Court relies on. In its search for implied limits on legislative power, the Court has examined at least six different kinds of historical sources. These sources, which we consider in detail below, suggest that the Court is using history primarily to establish, as best it can, what the ratifiers had in mind when they enacted various constitutional provisions. Thus, the Court looks at U.S. preconstitutional history, at direct evidence of the views of both the drafters and the ratifiers of the Constitution, at early congressional and judicial precedent, and at state and popular reactions to judicial decisions in order to discover unstated principles of constitutional significance. In this section, we canvas the Court's use of historical sources but leave the reader to judge the soundness of the Court's historical conclusions.⁷⁶

75. In important individual rights cases, such as *Brown v. Board of Education*, 347 U.S. 483 (1954), and *Roe v. Wade*, 410 U.S. 113 (1973), the majority seems to make a token bow to history and then to ignore it. Individual Justices may favor an originalist approach even in the individual rights context, but this approach has not generally captured a majority. Even the conservative wing of the Court—the Justices most interested in originalist interpretation—do not seem to care, for example, whether previous generations would have thought that the First Amendment protects flag burning. Nor do they seem to look for underlying principles or essential postulates. Laurence Tribe notices and critiques this difference in modes of interpretation in a recent essay. See Tribe, *supra* note 31, at 135–53. One counterexample is the right to jury trial, which the Court defines almost solely by reference to the historical meaning of the document, using the types of sources we discuss in the text. See *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 376–83 (1996); cf. *Carmell v. Texas*, 120 S. Ct. 1620, 1626–31 (2000) (defining the *Ex Post Facto* Clause by reference to its historical meaning).

76. For some assistance in making that judgment, the reader might wish to consult the following sources (among others) in addition to those cited in particular notes in this section: Matthew D. Adler & Seth F. Kreimer, *The New Etiquette of Federalism*: New York, Printz, and Yeskey, 1998 SUP. CT. REV. 71; Akhil Reed Amar, *Of Sovereignty and Federalism*, 96 YALE L.J. 1425 (1987); Evan H. Caminker, Printz, *State Sovereignty, and the Limits of Formalism*, 1997 SUP. CT. REV. 199; Martin S. Flaherty, *Are We to Be a Nation? Federal Power vs. "States' Rights" in Foreign Affairs*, 70 U. COLO. L. REV. 1277 (1999); Vicki C. Jackson, *Federalism and the Uses of and Limits of Law: Printz and Principle?*, 111 HARV. L. REV. 2180 (1998); Richard E. Levy, *New York v. United States: An Essay on the Uses and Misuses of Precedent, History, and Policy in Determining the Scope of Federal Power*, 41 U. KAN. L. REV. 493 (1993); Lawrence C. Marshall, *Fighting the Words of the Eleventh Amendment*, 102 HARV. L. REV. 1342 (1989); William P. Marshall, *The Diversity Theory of the Eleventh Amendment: A Critical Evaluation*, 102 HARV. L. REV. 1372 (1989); Calvin R. Massey, *State Sovereignty and the Tenth and Eleventh Amendments*, 56 U. CHI. L. REV. 61 (1989); Daniel J. Meltzer, *The Seminole Decision and State Sovereign Immunity*, 1996 SUP. CT. REV. 1; Henry Paul Monaghan, *The Sovereign Immunity "Exception"*, 110 HARV. L. REV. 102 (1996); Gene R. Nichol, *Justice Scalia and the Printz Case: The Trials of an Occasional Originalist*, 70 U. COLO. L. REV. 953 (1999); H. Jefferson Powell, *The Oldest Question of Constitutional Law*, 79 VA. L. REV. 633 (1993); Carlos Manuel Vazquez, *What is Eleventh Amendment Immunity?*, 106 YALE L.J. 1683 (1997); John R. Vile, *Truism, Tautology, or Vital Principle? The Tenth Amendment Since United States v. Darby*, 27 CUMB. L. REV. 445 (1997); Ann Woolhandler, *The Common Law Origins of Constitutionally Compelled Remedies*, 107 YALE L.J. 77 (1997).

a. Preconstitutional History: English Legal History, Colonial Practices, and State Practices Under the Articles of Confederation

As the Supreme Court recently unequivocally reminded us, one unstated constitutional principle immunizes unconsenting states from suit.⁷⁷ The Eleventh Amendment expressly prohibits suits only “against one of the United States by Citizens of *another* State, or by Citizens or Subjects of any Foreign State.”⁷⁸ The Court has nevertheless determined that a general principle of immunity underlies the words of the Amendment and has repeatedly rejected *all* private suits against unconsenting states for retrospective monetary relief.

In *Hans v. Louisiana*,⁷⁹ the Court’s first major discussion of state immunity from suit under the Amendment, the Court relied on several historical sources to derive the general constitutional principle, and ultimately concluded that the founding generation simply could not have contemplated a Constitution that abrogated state sovereign immunity.⁸⁰ This conclusion rested in part on the fact that such suits were unknown in “colonial times” or under the Articles of Confederation.⁸¹

More than one hundred years later and armed with database search engines and well-trained law clerks, the Court made more extensive use of preconstitutional history to expand the Eleventh Amendment’s implied limitations on congressional power. In *Alden v. Maine*,⁸² the Court held that Congress could not authorize a private suit against a state even in state court.⁸³ The Court not only looked at the experience of the states under the Articles of Confederation but also went well beyond rehashing previously cited sources.⁸⁴ Justice Kennedy’s majority opinion placed special emphasis on English legal history, looking at various sources—including Blackstone and Maitland—to examine the prerogative of the Crown to assert its immunity from suit.⁸⁵ The Court stressed that this doctrine of sovereign immunity was “well established in English law” when the Constitution was ratified and was “universal in the States” at the time.⁸⁶ English, colonial, and Confederation legal history thus informed the Court’s judgment of the founders’ probable understanding of governmental immunities.

The Eleventh Amendment is not the only context in which the Court has looked to preconstitutional history to find implied limits on congress-

77. See *Alden v. Maine*, 527 U.S. 706, 713 (1999).

78. U.S. CONST. amend. XI (emphasis added).

79. 134 U.S. 1 (1890).

80. See *id.* at 18–19.

81. See *id.* at 15.

82. 527 U.S. 706 (1999).

83. See *id.* at 754.

84. See *id.* at 714–15.

85. See *id.* at 715, 735.

86. *Id.* at 715–16.

sional power. In *Railway Labor Executives' Ass'n v. Gibbons*,⁸⁷ the Court examined state practices under the Articles of Confederation and concluded that the founders took very seriously the need for uniform bankruptcy laws.⁸⁸ The Court then held that Congress could not use the Commerce Clause to avoid the Bankruptcy Clause's express insistence on uniform laws.⁸⁹ Just as state immunity from suit rises to the level of constitutional principle despite its general absence from the text, uniformity in bankruptcy laws is a general constitutional principle that limits Congress's power under *all* clauses and not just under the Bankruptcy Clause in which it appears expressly.

The Court also investigated preconstitutional history in *Plaut v. Spendthrift Farm, Inc.*⁹⁰ when it held that Article III and the inherent meaning of a judicial system prohibited Congress from overriding judicial finality by directing courts to reopen closed cases.⁹¹ Justice Scalia's majority opinion began its discussion of separation of powers by putting the founders in their historical context: "The Framers of our Constitution lived among the ruins of a system of intermingled legislative and judicial powers, which had been prevalent in the colonies long before the Revolution, and which after the Revolution had produced factional strife and partisan oppression."⁹²

The opinion went on to examine in some detail the practice of revolutionary legislatures and assemblies in "correcting" judgments and the growing opposition to such legislative usurpations, which culminated in the separation of powers built into the Federal Constitution.⁹³ From this and other history, Justice Scalia deduced the implied constitutional principle that final judicial pronouncements cannot be modified or overridden by the legislature.⁹⁴ The Court thus invalidated Congress's attempt to use its Commerce Clause power to reopen securities-fraud cases, despite Congress's unquestioned authority to regulate securities transactions generally under the Clause.⁹⁵

Dormant Commerce Clause doctrine is also based in part on preconstitutional history. In *H.P. Hood & Sons, Inc. v. Du Mond*,⁹⁶ Justice Jackson's majority opinion considered the purposes underlying the Commerce Clause in light of events under the Articles of Confederation:

When victory relieved the Colonies from the pressure for solidarity that war had exerted, a drift toward anarchy and commercial warfare between states began. "[Each] State would legislate ac-

87. 455 U.S. 457 (1982).

88. *See id.* at 472.

89. *See id.* at 473.

90. 514 U.S. 211 (1995).

91. *See id.* at 218-19.

92. *Id.* at 219.

93. *See id.* at 219-21.

94. *See id.* at 228.

95. *See Plaut*, 514 U.S. at 227.

96. 336 U.S. 525 (1949).

ording to its estimate of its own interests, the importance of its own products, and the local advantages or disadvantages of its position in a political or commercial view." This came "to threaten at once the peace and safety of the Union."⁹⁷

A more recent case described a "central concern of the Framers . . . [as] the conviction that in order to succeed, the new Union would have to avoid the tendencies toward economic Balkanization that had plagued relations among the Colonies and later among the States under the Articles of Confederation."⁹⁸ Thus, the negative implication of the grant of power over interstate commerce to Congress, according to the Court, was the framers' response to the problems of economic parochialism.⁹⁹

b. Debates at the 1787 Philadelphia Constitutional Convention and in Congress

Another source of evidence for limiting principles is the views of the drafters of the Constitution. For the 1787 Constitution, of course, the drafters are those who met in Philadelphia, and the best source of their views is Madison's notes of the Convention. For later amendments, debates in Congress provide similar evidence of the drafters' intent.

Consistent with the most sophisticated literature on original intent, however, the Court tends not to emphasize the drafters' debates. According to originalist theory, the legitimacy of judicial review depends on the Constitution's status as a popularly ratified document. Thus, the intent of particular drafters—mere proponents of ideas rather than enactors, as James Wilson noted¹⁰⁰—is not as important as how the words were popularly understood at the time. Remarks made by the drafters can illuminate this meaning but are not necessarily dispositive.¹⁰¹

Nevertheless, the Court has sometimes referred to the proceedings in the 1787 Convention. For example, in support of its conclusion in *New York v. United States*¹⁰² that the Tenth Amendment implicitly limited Congress's power to "commandeer" state legislatures, the Court placed some

97. *Id.* at 533.

98. *Hughes v. Oklahoma*, 441 U.S. 322, 325–26 (1979); see also *Oregon Waste Sys., Inc. v. Department of Env'l. Quality*, 511 U.S. 93, 98 (1994) (quoting *Hughes*).

99. See *Hughes*, 441 U.S. at 326.

100. See JAMES MADISON, NOTES OF DEBATES IN THE FEDERAL CONVENTION OF 1787, at 125 (Ohio Univ. Press 1966). On Saturday, June 16, 1787, James Madison recorded that: "With regard to the *power of the Convention*, [James Wilson] conceived himself authorized to *conclude nothing*, but to be at liberty to *propose any thing*." *Id.*

101. See, e.g., Michael C. Dorf, *Integrating Normative and Descriptive Constitutional Theory: The Case of Original Meaning*, 85 GEO. L.J. 1765, 1800–01 (1997); Henry R. Monaghan, *Stare Decisis and Constitutional Adjudication*, 88 COLUM. L. REV. 723, 725–26 (1988); Michael J. Perry, *The Legitimacy of Particular Conceptions of Constitutional Interpretation*, 77 VA. L. REV. 669, 674–86 (1991); Jed Rubenfeld, *The Moment and the Millennium*, 66 GEO. WASH. L. REV. 1085, 1102–03 (1998). Nevertheless, the Court occasionally uses not only the debates of the drafters but also in one case a private letter James Madison wrote some 40 years later. See *West Lynn Creamery, Inc. v. Healy*, 512 U.S. 186, 193 n.9 (1994) (citing an 1829 James Madison letter in support of the Dormant Commerce Clause).

102. 505 U.S. 144 (1992).

weight on the Philadelphia delegates' rejection of the New Jersey Plan in favor of the Virginia Plan.¹⁰³ The rejected New Jersey Plan contemplated giving Congress significant power to regulate the states directly in order to accomplish federal legislative goals.¹⁰⁴ According to the Court, the "lively debate" over the two proposals indicated that the framers had a clear preference for a legislative power directed primarily at individuals rather than at states.¹⁰⁵ Thus, the Constitution could be reasonably construed as authorizing Congress to regulate radioactive waste under the Commerce Clause, but history suggested that the power did not extend to every possible means of regulation when state sovereignty was implicated.¹⁰⁶ The Court relied on the same history in rejecting a congressional attempt to "commandeer" state executives, in *Printz v. United States*.¹⁰⁷

In *Railway Executives' Ass'n v. Gibbons*,¹⁰⁸ the Court conceded that "the debate in the Constitutional Convention regarding the Bankruptcy Clause was meager"¹⁰⁹ but nevertheless examined it closely for clues to the significance of the uniformity requirement.¹¹⁰ The Court concluded that the purpose of the uniformity provision was to "prohibit Congress from enacting private bankruptcy laws"¹¹¹ and to raise the principle of uniformity to constitutional significance.

*Alden v. Maine*¹¹² similarly relied on relatively meager congressional debates on the Eleventh Amendment as evidence that its drafters intended it to embody a preexisting constitutional principle of state immunity rather than to create a new limit on federal judicial power.¹¹³ The Court pointed to the speed and unanimity of the Amendment's adoption in support of its conclusion that it merely corrected the Supreme Court's mistaken interpretation of Article III in *Chisholm v. Georgia*.¹¹⁴ The Court compared the language of the Amendment to the language of earlier drafts, finding significant the fact that although the earlier draft limited "the judicial power"

103. See *id.* at 161, 164–65.

104. See *id.* at 165.

105. *Id.* at 165. In fact, there is substantial evidence to suggest that in giving Congress power to act directly on individual citizens—an innovation not present in the Articles of Confederation—the Constitution was adding rather than substituting powers. The historical evidence points toward the conclusion that the Constitution was intended to give Congress the power to regulate the conduct of individuals and states. See Erik M. Jensen & Jonathan L. Entin, *Commandeering, the Tenth Amendment, and the Federal Requisition Power: New York v. United States Revisited*, 15 CONST. COMMENTARY 355, 359–60 (1998).

106. See *New York v. United States*, 505 U.S. at 188.

107. 521 U.S. 898, 919–20 (1997).

108. 455 U.S. 457 (1982).

109. *Id.* at 471.

110. See *id.*

111. *Id.* at 472.

112. 527 U.S. 706 (1999).

113. See *id.* at 715–18.

114. See *id.* at 724; *Chisholm v. Georgia*, 2 U.S. (2 Dall.) 419 (1793). In fact, the proposal that became the Eleventh Amendment—which was originally introduced immediately after the *Chisholm* decision—languished in Congress for almost four years before obtaining the presidential proclamation of ratification. See, e.g., JOHN V. ORTH, *THE JUDICIAL POWER OF THE UNITED STATES: THE ELEVENTH AMENDMENT IN AMERICAN HISTORY* 20 (1987); John J. Gibbons, *The Eleventh Amendment and State Sovereign Immunity: A Reinterpretation*, 83 COLUM. L. REV. 1889, 1926–27 (1983).

directly, the final draft limited the “constru[ction]” of the judicial power—suggesting to the Court that the judicial power had never extended to suits against states but mistakenly had been construed to do so.¹¹⁵

c. Debates over the Ratification of the Constitution

Perhaps the most frequently cited source of historical evidence for implied limits is the debates over ratification of the Constitution. Supreme Court citations to *The Federalist Papers*, for example, have increased dramatically over the past several decades. Before 1960, annual citations to *The Federalist Papers* never exceeded sixteen, but in succeeding decades, the annual citation rate has gone from twenty-seven (1960–69), to thirty (1970–79), to fifty-six (1980–89), and finally to sixty (1990–98).¹¹⁶ Related evidence used by the Court includes debates in state ratifying conventions and proclamations issued by those conventions. As the Court becomes more historically sophisticated—and as the primary documents become more widely available¹¹⁷—we can expect this list to expand, perhaps ultimately including anti-Federalist literature and Federalist arguments beyond those found in *The Federalist Papers*.

The Court has essentially used the same basic evidence from the ratification debates repeatedly in its Eleventh Amendment cases. In *Hans v. Louisiana*,¹¹⁸ *Monaco v. Mississippi*,¹¹⁹ *Seminole Tribe v. Florida*,¹²⁰ and *Alden v. Maine*,¹²¹ the Court pointed to a series of exchanges between opponents and proponents of the Constitution regarding the reach of the federal judicial power under Article III.¹²² In these exchanges, opponents of the Constitution pointed to the Citizen-State Diversity Clause of Article III—

115. *Alden*, 527 U.S. at 722–23. The same use of the phrase “shall not be construed” rather than “shall not extend” has led other commentators to the rather different conclusion that although Article III did not itself abrogate state sovereign immunity, neither Article III nor the Eleventh Amendment prohibited Congress from doing so. See *Seminole Tribe v. Florida*, 517 U.S. 44, 157–59 (1996) (Souter, J., dissenting); John E. Nowak, *The Scope of Congressional Power to Create Causes of Action Against State Governments and the History of the Eleventh and Fourteenth Amendments*, 75 COLUM. L. REV. 1413, 1422 (1975); Laurence H. Tribe, *Intergovernmental Immunities in Litigation, Taxation, and Regulation: Separation of Powers Issues in Controversies About Federalism*, 89 HARV. L. REV. 682, 693–94 (1976).

116. See Ira C. Lupu, *Time, the Supreme Court, and The Federalist*, 66 GEO. WASH. L. REV. 1324, 1328 (1998). This pattern persists despite a drop in the number of cases decided by the Court. See *id.* at 1328 & nn.22–23.

117. Sources for these documents include THE DOCUMENTARY HISTORY OF THE RATIFICATION OF THE CONSTITUTION (Merrill Jensen ed., 1976 to ongoing) and THE COMPLETE ANTI-FEDERALIST (Herbert J. Storing ed., 1981). The Court’s current primary reliance on *The Federalist Papers* may be misplaced; as one scholar notes, the *Federalist Papers* were not very widely circulated, and “[t]here is no evidence that Publius converted a single Antifederalist.” LINDA GRANT DE PAUW, *THE ELEVENTH PILLAR: NEW YORK STATE AND THE FEDERAL CONSTITUTION* 113–14 (1966).

118. 134 U.S. 1 (1890).

119. 292 U.S. 313 (1934).

120. 517 U.S. 44 (1996).

121. 527 U.S. 706 (1999).

122. See *Alden v. Maine*, 527 U.S. 706, 714–28 (1999); *Seminole Tribe v. Florida*, 517 U.S. 44, 59–73 (1996); *Monaco v. Mississippi*, 292 U.S. 313, 322–28 (1934); *Hans v. Louisiana*, 134 U.S. 1, 12–19 (1890).

which confers jurisdiction in the federal courts over suits “between a State and Citizens of another State”¹²³—and charged that it would allow individuals to haul states into federal court.¹²⁴ In response, James Madison, John Marshall, and Alexander Hamilton all replied that the Clause operated only to allow *states* to sue *citizens* in federal court, and not the reverse.¹²⁵ The Court has used this ratification-era evidence to support its conclusion that Article III was never intended to abrogate the preexisting state immunity from suit.¹²⁶

References to ratification debates are sprinkled throughout the cases we examine. The Court quoted from *The Federalist Papers* in *Plaut v. Spendthrift Farm, Inc.*,¹²⁷ in support of its conclusion that the framers of the Constitution perceived a “sharp necessity to separate the legislative from the judicial power” in order to curb “the crescendo of legislative interference with private judgments of the courts.”¹²⁸ Hamilton’s *Federalist No. 15* and debates in various state ratification conventions were cited in *New York v. United States*¹²⁹ to demonstrate the founders’ desire that the new government act on individuals rather than on states.¹³⁰ The Court in *Alden* pointed to proclamations from the Rhode Island and New York ratifying conventions as part of the relevant historical evidence.¹³¹

d. Reaction to Judicial Decisions

Just as the Court uses the debates over ratification to infer the contemporaneous public interpretation of constitutional provisions, it also uses a variant of that category of evidence in the context of the Eleventh Amendment. Because the Eleventh Amendment was adopted to overturn *Chisholm v. Georgia*,¹³² reaction to that decision might tell us something

123. U.S. CONST. art. III, § 2, cl. 1.

124. See *Hans*, 134 U.S. at 13.

125. See *id.* at 12–14.

126. See *Alden*, 527 U.S. at 716–18; *Seminole Tribe*, 517 U.S. at 70–71 & nn.12–13; *Monaco*, 292 U.S. at 323–24; *Hans*, 134 U.S. at 11–14; see also *Welch v. Texas Highways & Pub. Transp. Dep’t*, 483 U.S. 468, 480–84 & n.10.

In context, of course, these exchanges prove only that the Citizen-State Diversity Clause was not intended to confer jurisdiction over suits against states; it says nothing about whether the Federal Question Clause does so. See *Welch*, 483 U.S. at 504–09 (Brennan, J., dissenting); William A. Fletcher, *A Historical Interpretation of the Eleventh Amendment: A Narrow Construction of an Affirmative Grant of Jurisdiction Rather than a Prohibition Against Jurisdiction*, 35 STAN. L. REV. 1033, 1083–87 (1983); William A. Fletcher, *The Diversity Explanation of the Eleventh Amendment: A Reply to Critics*, 56 U. CHI. L. REV. 1261, 1298 (1989); Herbert Hovenkamp, *Judicial Restraint and Constitutional Federalism: The Supreme Court’s Lopez and Seminole Tribe Decisions*, 96 COLUM. L. REV. 2213, 2241–45 (1996); Vicki C. Jackson, *The Supreme Court, the Eleventh Amendment and State Sovereign Immunity*, 98 YALE L.J. 1, 44–45 (1988); James E. Pfander, *History and State Suability: An “Explanatory” Account of the Eleventh Amendment*, 83 CORNELL L. REV. 1269, 1329–33 (1998).

127. 514 U.S. 211, 221–22 (1995).

128. *Id.* at 221.

129. 505 U.S. 144 (1992).

130. See *New York v. United States*, 505 U.S. at 163, 165–66.

131. See *Alden*, 527 U.S. at 718–19.

132. 2 U.S. (2 Dall.) 419 (1793).

about the meaning of the Amendment. Thus, in cases from *Hans* to *Alden*, the Court has suggested that the *Chisholm* case created “such a shock of surprise throughout the country” that the Eleventh Amendment was immediately proposed.¹³³ The Court in *Alden* also pointed to state legislative reactions to *Chisholm*, which ranged from the Massachusetts legislature’s denunciation of the decision as “repugnant to the first principles of a federal government,” to the Georgia House’s proviso that “anyone attempting to enforce the *Chisholm* decision would be ‘guilty of felony and shall suffer death, without benefit of clergy, by being hanged.’”¹³⁴

e. Early Judicial Precedent

The Court sometimes uses early judicial understandings to confirm its historical conclusions.¹³⁵ For example, in *Plaut*, Justice Scalia’s majority opinion relied on Justice Iredell’s comments in the 1798 case of *Calder v. Bull*¹³⁶ to support the conclusion that the founding generation rejected legislative power to revise or reopen final judgments:

“It may, indeed, appear strange to some of us, that in any form, there should exist a power to grant, with respect to suits depending or adjudged, new rights of trial, new privileges of proceeding, not previously recognized and regulated by positive institutions The power . . . is judicial in its nature; and whenever it is exercised, as in the present instance, it is an exercise of judicial, not of legislative, authority.”¹³⁷

Justice Scalia also looked to the “similar understanding of the separation of powers” of “state courts of the era.”¹³⁸

f. Early Congressional Precedent

An interesting variant on the use of early judicial precedent is the use of early congressional precedent as evidence of contemporaneous understanding of the meaning of the Constitution. The Court has frequently used

133. *Hans v. Louisiana*, 134 U.S. 1, 11 (1889) (calling *Chisholm* “startling and unexpected”); see also *Alden*, 527 U.S. at 720 (emphasizing the “profound shock” caused by the *Chisholm* decision); *Seminole Tribe*, 517 U.S. at 69; *Monaco*, 292 U.S. at 325. As Justice Souter has pointed out in dissent, however, “*Monaco’s ipse dixit* that *Chisholm* created a ‘shock of surprise’ does not make it so. . . . [T]here is ample evidence contradicting the ‘shock of surprise’ thesis.” *Seminole Tribe*, 517 U.S. at 107 n.5 (Souter, J., dissenting). For some of this contradictory evidence, see 5 THE DOCUMENTARY HISTORY OF THE SUPREME COURT OF THE UNITED STATES, 1789–1800, at 251–53, 262–69 (Maeva Marcus ed., 1994) and Maeva Marcus & Natalie Wexler, *Suits Against States: Diversity of Opinion in the 1790s*, 1993 J. SUP. CT. HIST. 73, 83.

134. *Alden*, 527 U.S. at 720 (quoting 15 PAPERS OF ALEXANDER HAMILTON 314 (H. Syrett & J. Cooke eds., 1969)); DAVID P. CURRIE, THE CONSTITUTION IN CONGRESS: THE FEDERALIST PERIOD 1789–1801, at 196 (1997)).

135. The rejection of the *Chisholm* majority’s understanding is, of course, an exception.

136. 3 U.S. (3 Dall.) 386 (1798).

137. *Plaut v. Spendthrift Farm, Inc.*, 514 U.S. 211, 223 (1995) (quoting Justice Iredell’s opinion in *Calder*, 3 U.S. (3 Dall.) at 398).

138. *Plaut*, 514 U.S. at 223.

the existence of early—or longstanding—congressional action as evidence that such action is *constitutional*.¹³⁹ But in the cases we are considering, the Court has sometimes relied on the *absence* of congressional action to conclude that such action is *unconstitutional*. In other words, as Justice Scalia wrote for the Court in *Printz*, “if earlier Congresses avoided use of [a particular] power, we . . . have reason to believe that the power was thought not to exist.”¹⁴⁰

This argument was implicit in *Seminole Tribe*, in which the Court thought it noteworthy that “the Nation survived for nearly two centuries” without the question of the existence of such power being presented to the Court, and Congress itself waited nearly a century before it attempted to use its Commerce Clause powers to abrogate state sovereign immunity.¹⁴¹ *Plaut* may have been the first case to make this reasoning explicit: “Apart from the statute we review today, we know of no instance in which Congress has attempted to set aside the final judgment of an Article III court by retroactive legislation. That prolonged reticence would be amazing if such interference were not understood to be constitutionally proscribed.”¹⁴²

This argument has since become a common historical assertion. Thus, Justice Scalia in *Printz* relied partly on the “absence of executive-commandeering statutes in the early Congresses [and] an absence of them in our later history as well, at least until very recent years.”¹⁴³ In *Alden*, the Court relied on the absence—until “the last generation”—of any federal statutes authorizing suits against states in state courts.¹⁴⁴

2. *Structural Clues and Canons of Construction*

In addition to looking at history, the Court often examines the structure of the Constitution for clues as to the framers’ meaning. The decision in *Plaut v. Spendthrift Farm, Inc.*¹⁴⁵ provides a good example of detailed structural arguments.¹⁴⁶ The Court relied on both history and structure to conclude that “the Framers crafted [Article III] with an expressed understanding that it gives the Federal Judiciary the power, not merely to rule on cases, but to *decide* them, subject to review only by superior courts in the

139. See, e.g., *Marsh v. Chambers*, 463 U.S. 783, 790 (1983) (holding that the congressional tradition of appointing a chaplain supports the conclusion that the state legislative chaplain does not violate Establishment Clause); *Myers v. United States*, 272 U.S. 52, 174–75 (1926) (finding that early congressional indication that the President has sole power to remove executive officers supports the conclusion that the Constitution gives the President that power); see also *Board of County Comm’rs v. Umbehr*, 518 U.S. 668, 686–92 (1996) (Scalia, J., dissenting) (arguing that patronage hiring is constitutional because of its long history).

140. *Printz v. United States*, 521 U.S. 898, 905 (1997).

141. See *Seminole Tribe*, 517 U.S. at 71.

142. *Plaut*, 514 U.S. at 230.

143. *Printz*, 521 U.S. at 916.

144. *Alden*, 527 U.S. at 744.

145. 514 U.S. 211 (1995).

146. See *id.* at 217–18.

Article III hierarchy.”¹⁴⁷ In addition to the historical sources that we have already canvassed, the *Plaut* Court considered the “critical decision” to establish an independent judiciary¹⁴⁸ and the overall structure of Article III, which created “not a batch of unconnected courts but a judicial *department* composed of ‘inferior Courts’ and ‘one supreme Court.’”¹⁴⁹ The Court essentially used the structure of Article III to give a constitutional meaning to the concept of final judgments.¹⁵⁰

In other cases, the Court has explored broader constitutional structures. *Alden v. Maine*¹⁵¹ is an extended paean to the federalism established by “the structure of the original Constitution itself.”¹⁵² Justice Kennedy identified state sovereign immunity as a “separate and distinct structural principle . . . not directly related to the scope of the judicial power established by Article III, but inher[ing] in the system of federalism established by the Constitution.”¹⁵³ *Alden* also contains a more indirect structural argument, which resurrects a common sense argument first seen in *McCulloch*.¹⁵⁴ Just as Marshall found that Maryland lacked the power to tax the federal government because “the power to tax involves the power to destroy,”¹⁵⁵ Justice Kennedy reasoned that giving Congress the power to abrogate state sovereign immunity in the states’ own courts could “threaten the financial integrity of the States.”¹⁵⁶ This argument asks an important question about the structure of the Constitution itself: Why would the framers have carefully crafted a federal system, with powers and responsibilities shared by both the state and national governments, if Congress were to retain an ultimate trump card of such coercive magnitude? *Alden*’s answer is that:

Even today, an unlimited congressional power to authorize suits in state court to levy upon the treasuries of the States for compensatory damages, attorney’s fees, and even punitive damages could create staggering burdens, giving Congress a power and a leverage over the States that is not contemplated by our constitutional design.¹⁵⁷

147. *Id.* at 218–19.

148. *Id.* at 221.

149. *Id.* at 227.

150. *See id.*

151. 527 U.S. 706 (1999).

152. *Id.* at 728.

153. *Id.* at 730. In fact, the opinion does not spend much time on the structure of the Constitution but instead relies on earlier cases to establish the “structural principle.” The constitutional structure itself is considered only in one long paragraph early in the opinion, which consists largely of boilerplate bows to federalism and citations to earlier cases. *See id.* at 713–14. When Justice Kennedy turns explicitly to “structure” in part II.B.4 of the opinion, he does not look at the Constitution itself but only at “the essential principles of federalism and the special role of the state courts in the constitutional design.” *Id.* at 748. Only once in the whole section does Justice Kennedy cite the Constitution, and then only to note that Article III implies that state courts “may be opened” to federal suits generally. *Id.* at 753.

154. *See id.* at 750.

155. *McCulloch v. Maryland*, 17 U.S. (4 Wheat.) 316, 431 (1819).

156. *Alden*, 527 U.S. at 750. The opinion provides no evidence of any such threat, however.

157. *Id.*

The Court similarly investigated the structural components of federalism in *Printz v. United States*.¹⁵⁸ Justice Scalia's majority opinion canvassed various provisions of the Constitution to discover the "essential postulate"¹⁵⁹ that states retain "a residuary and inviolable sovereignty."¹⁶⁰ Both history and structure, according to the Court, point toward a system of dual sovereignty in which "a State's government will represent and remain accountable to its own citizens."¹⁶¹ Justice Scalia linked this structural division of sovereignty to protection against tyranny, citing the classic arguments of *Federalist No. 51*.¹⁶² The Brady Bill undermined this liberty-protecting structure because "[t]he power of the Federal Government would be augmented immeasurably if it were able to impress into its service—and at no cost to itself—the police officers of the 50 States."¹⁶³ Even the structure of separation of powers was pressed into service in Justice Scalia's opinion, with a suggestion that the Brady Bill reduced the power of the executive by allowing Congress to execute laws without the President's participation.¹⁶⁴

The Court made a similarly broad structural argument in *New York v. United States*.¹⁶⁵ Justice O'Connor noted that "the Constitution divides authority between federal and state governments for the protection of individuals."¹⁶⁶ A law forcing the states to either build dumps or take title to waste would obviously have significant economic consequences but, more importantly, permitting such laws would make the states little more than puppets of Congress.¹⁶⁷ Such an interpretation would place Article I prerogatives above the structural goals of the document as a whole and threaten to destabilize the carefully crafted coordinate system of diffuse power—potentially to the detriment of individual citizens.¹⁶⁸ In particular, Justice O'Connor reasoned, straying from the federalist structure of the Constitution might allow *both* state and federal officials "to avoid being held accountable to the voters" for their actions.¹⁶⁹

Finally, in addition to history and structure, the Court relies on standard canons of construction. In *Gibbons*, for example, the Court relied on the interpretive canon that requires every word in a document be given some meaning.¹⁷⁰ The Court thus reasoned that permitting a Commerce Clause end-run would "allow Congress to repeal the uniformity require-

158. 521 U.S. 898, 918–25 (1997).

159. *Id.* at 918 (quoting *Monaco v. Mississippi*, 292 U.S. 313, 322 (1934)).

160. *Id.* at 919 (quoting *THE FEDERALIST* No. 39 (James Madison)).

161. *Id.* at 920.

162. *See id.* at 922.

163. *Id.* For an argument that in fact, the history and structure of the Constitution contemplates exactly the sort of "commandeering" of state executives that the Brady Bill establishes, see Saikrishna Bangalore Prakash, *Field Office Federalism*, 79 VA. L. REV. 1957 (1993).

164. *See Printz*, 521 U.S. at 922–23.

165. 505 U.S. 144 (1992).

166. *Id.* at 181.

167. *See id.* at 188.

168. *See id.* at 181–83.

169. *Id.* at 182.

170. *See Railway Labor Executives' Ass'n v. Gibbons*, 455 U.S. 457, 468–69 (1982).

ment from Art. I, § 8, cl. 4, of the Constitution.”¹⁷¹ In other words, “uniform” would simply have no force or meaning if Congress could ignore it and pass nonuniform bankruptcy legislation with impunity under the Commerce Clause.

3. *Precedent*

If the Court were to search for principles of constitutional weight only in early history and constitutional structure, our constitutional landscape would either become entirely rigid and formalistic, with no capacity for evolution, or it would become unstable, changing radically with every change of views on the Court. Justices are not historians. They do not have the luxury of sitting down with the historical record and studying it over a period of years in order to develop a full-blown theory of the Constitution (even if such a theory were possible). Instead they decide one issue at a time, and in doing so, they often take only tentative steps toward identifying constitutionally significant principles.

Thus, constitutional decision making often looks like common-law reasoning.¹⁷² The Court looks to its own precedent not only to determine whether it provides specific guidance on the question before the Court but also to identify the underlying principles driving that precedential development. In both the Tenth Amendment and the Eleventh Amendment cases, the Court seeks an underlying coherence in the pattern of its own precedent. For example, each time the Court has taken another step beyond the language of the Eleventh Amendment, it has necessarily driven future Courts toward the conclusion that the Eleventh Amendment is not dispositive but is merely a reflection of some “essential postulate” of federal-state relations.¹⁷³ Once the Court decided in *New York v. United States* that state legislatures could not be commandeered without undermining the independence and accountability of state governments,¹⁷⁴ those principles of independence and accountability served to illuminate the history and structure examined in the context of executive commandeering in *Printz*.¹⁷⁵

The full story of the development of precedent—and the related question of *stare decisis*—is obviously beyond the scope of this article. But it is important to note that in identifying principles of constitutional weight the Court often looks to its own previous pronouncements on specific questions, looking for patterns that might justify the application of deeper principles.

171. *Id.* at 473.

172. See generally DANIEL A. FARBER & SUZANNA SHERRY, *DESPERATELY SEEKING CERTAINTY: THE MISGUIDED QUEST FOR CONSTITUTIONAL FOUNDATIONS* (forthcoming); David A. Strauss, *Common Law Constitutional Interpretation*, 63 U. CHI. L. REV. 877 (1996) (arguing that constitutional interpretation often resembles common-law reasoning).

173. *Printz v. United States*, 521 U.S. 898, 918 (1997) (quoting *Monaco v. Mississippi*, 292 U.S. 313, 322 (1933)).

174. See *New York v. United States*, 505 U.S. 144, 168 (1992).

175. See *Printz*, 521 U.S. at 900.

C. *Summary Description of the Court's Interpretive Methodology*

Having examined many of the key cases in which the Court implies constraints on Congress, we now want to step back and describe its general practice. So far, we have seen that the answers in these cases “must be sought in historical understanding and practice, in the structure of the Constitution, and in the jurisprudence of this Court,”¹⁷⁶ but we believe we can be somewhat more precise in identifying the sorts of evidence and arguments that the Court has found convincing when it strikes down federal legislation.

First, in identifying principles of constitutional weight, the Court has examined six categories of historical evidence: preconstitutional history, drafting debates, ratification debates, public reactions, early judicial precedent, and early congressional precedent. The Court does not rank order these evidentiary sources but rather looks at the historical evidence in a holistic manner to determine the likely understanding of the ratifiers of the Constitution. After all, the Court views the ultimate issue in these cases as identifying the intended scope of Congress’s power. It asks: What did the majority of the ratifiers of the Constitution think it meant? Because the Court hardly ever has any direct evidence to answer that question, the best it can do is to draw inferences from the historical sources identified above. It is no surprise that the interpretive process is often unsatisfyingly fuzzy.

A second primary source of information as to the probable intentions of the ratifiers of the Constitution is the structure of the document itself. The Court finds it replete with clues as to the principles that shape the proper scope of the federal legislative power.¹⁷⁷ For example, the document as a whole establishes a federal system under which both the central government and state governments have a variety of rights and responsibilities.¹⁷⁸ The Court believes it is unlikely that the authors of the document wanted to give one side overwhelming leverage over the other.¹⁷⁹ The Court’s respect for the overall structure of the document also leads it to employ familiar canons of construction that give meaning to all of its words. At times, the Court’s approach resembles the mode of contract construction one sees in cases addressing the parties’ failure to provide expressly for a contingency, where the structure of the contract as a whole provides clues to the answer the parties would have provided had they foreseen the problem arising.¹⁸⁰

Finally, the Court uses its own two hundred year history to its advantage, looking at what earlier Courts concluded in examining the same his-

176. *Id.* at 905.

177. *See New York v. United States*, 550 U.S. at 161.

178. *See id.* at 163–64.

179. *See Daniel A. Farber, Pledging a New Allegiance: An Essay on Sovereignty and the New Federalism*, 75 NOTRE DAME L. REV. 1133, 1138 (2000).

180. *See, e.g., Transatlantic Fin. Corp. v. United States*, 363 F.2d 312, 316–20 (1966) (discussing effect of unanticipated closing of the Suez Canal on shipping contract).

tory and structure. In this way, it tries to craft from individual cases and individual questions an overall picture of the underlying principles animating the framers. The principles, which tend to become less tethered over time to the constitutional text itself, then drive the logic of the Court's doctrine in a particular area. Note that, we are not trying to identify a scientific paradigm of decision making but are merely trying to describe the Court's behavior and identify the rhetorical battlefield on which litigants assert their conflicting interpretations of the constitutional text.

In the next section, we apply the Court's approach to the Intellectual Property Clause of the Constitution, crafting what we hope is a persuasive story of its underlying principles from historical and structural sources.

III. PRINCIPLES UNDERLYING THE INTELLECTUAL PROPERTY CLAUSE OF THE CONSTITUTION

In light of the Court's conclusion that the Bankruptcy Clause, the Tenth and Eleventh Amendments, and Article III limit Congress's exercise of its general legislative power, we ask whether the Intellectual Property Clause should be read to impose similar implied limits. Following the Court's lead, we look to history, structure, and precedent to identify principles of constitutional weight that might underlie the Clause.

A. *The Intellectual Property Clause in Historical Perspective*

Borrowing heavily from the work of others who have studied the history of the Clause,¹⁸¹ we examine below the types of historical evidence that the Court has found to be relevant in justifying an implied constitutional constraint.

181. We rely on the work of BRUCE W. BUGBEE, *GENESIS OF AMERICAN PATENT AND COPYRIGHT LAW* (1967); WILLIAM W. CROSSKEY, *1 POLITICS AND THE CONSTITUTION IN THE HISTORY OF THE UNITED STATES* 477-86 (1953); LYMAN RAY PATTERSON, *COPYRIGHT IN HISTORICAL PERSPECTIVE* (1968); Irah Donner, *The Copyright Clause of the U.S. Constitution: Why Did the Framers Include It with Unanimous Approval?*, 36 AM. J. LEGAL HIST. 361 (1992); Karl Fenning, *The Origin of the Patent and Copyright Clause of the Constitution*, 17 GEO. L.J. 109 (1928); Gillian K. Hadfield, *The Economics of Copyright: An Historical Perspective*, 38 COPYRIGHT L. SYMP. (ASCAP) 1 (1992); Frank D. Prager, *Historic Background and Foundation of American Patent Law*, 5 AM. J. LEGAL HIST. 309 (1961); Edward C. Walterscheid, *Inherent or Created Rights: Early Views on the Intellectual Property Clause*, 19 HAMLINE L. REV. 81 (1995) [hereinafter *Early Views*]; Edward C. Walterscheid, *The Early Evolution of the United States Patent Law: Antecedents*, (pts. 1-2) 76 J. PAT. & TRADEMARK OFF. SOC'Y 697, 849 (1994), (pt. 3) 77 J. PAT. & TRADEMARK OFF. SOC'Y 771, 847 (1995), (pts. 4-5) 78 J. PAT. & TRADEMARK OFF. SOC'Y 77, 615, 665 (1996) [hereinafter *Early Evolution*]; Edward C. Walterscheid, *To Promote the Progress of Science and Useful Arts: The Background and Origin of the Intellectual Property Clause of the United States Constitution*, 2 J. INTELL. PROP. L. 1 (1994) [hereinafter *Background and Origin*]; Edward C. Walterscheid, *To Promote the Progress of Useful Arts: American Patent Law and Administration, 1787-1836*, (pt. 2) 80 J. PAT. & TRADEMARK OFF. SOC'Y 11 (1998) [hereinafter *American Patent Law*].

I. Preconstitutional History

a. English Legal History

i. Patent Law

Although the Crown granted monopolies¹⁸² before the reign of Elizabeth I, it was her abuse of the practice that eventually led to strong judicial and statutory pronouncements against grants of exclusive rights to the public detriment.¹⁸³ Her grants included monopolies on saltpeter, alum, ovens and furnaces, window glass, ale, the mining of various metals and ores, sulfur, rapeseed oil, and salt.¹⁸⁴ One commentator notes:

The courtiers were not attracted by the patents for new inventions, leaving those for the poor and often chimerical inventors, but they sought to secure the more valuable licensing patents or else lucrative new monopolies in old industries. . . . In the hands of the corrupt courtiers the system of monopolies, designed originally to foster new arts, became degraded into a system of plunder.¹⁸⁵

It is elementary economics that the inevitable results of granting a monopoly are rising prices and diminished availability of goods, and Elizabethan England proved no exception, suffering from “high prices, inferior goods, and unemployment.”¹⁸⁶ Nonetheless, by a series of brilliant political maneuvers during the 1601 session of Parliament, a struggle termed by some “the most significant in English constitutional history, turning as it did on the whole concept of royal prerogative,”¹⁸⁷ Elizabeth managed to stave off a statutory prohibition of the practice.¹⁸⁸ She was not as successful, however, in controlling the courts.

Even before Parliament finally reacted in 1623, the common-law courts struck down the most “odious” of the grants on public-interest grounds.¹⁸⁹ The most famous case, *Darcy v. Allin*,¹⁹⁰ involved the voiding of a monopoly on playing cards reissued to a groom of the Queen’s Privy Chamber.¹⁹¹ The court held monopolies generally illegal and detrimental to

182. In Elizabethan England, a “monopoly” included not only a right to exclude others from manufacturing a good or practicing an art but also permission to manufacture the good or practice the art oneself. We are not using the term in that sense, nor in its technical economic sense of a “deadweight loss.” See Edmund W. Kitch, *Patents: Monopolies or Property Rights?*, in 8 RESEARCH IN LAW AND ECONOMICS 31, 33 (John Palmer & Richard O. Zorbe, Jr. eds., 1986). Instead, we use it only to describe abusive features of grants of exclusive rights feared by the framers in part because of English history.

183. See *Early Evolution*, *supra* note 181, 76 J. PAT. & TRADEMARK OFF. SOC’Y at 853–54.

184. See *id.* at 854 & n.14.

185. W. HYDE PRICE, THE ENGLISH PATENTS OF MONOPOLY 16–17 (1906) (footnote omitted).

186. *Early Evolution*, *supra* note 181, 76 J. PAT. & TRADEMARK OFF. SOC’Y at 865.

187. *Id.* at 865.

188. See *id.* at 865–67.

189. See generally *id.* at 866–71 (discussing common-law findings that monopoly damaged everyone by raising prices and reducing employment).

190. 74 Eng. Rep. 1131, 77 Eng. Rep. 1260 (Q.B. 1602).

191. See Jacob I. Corré, *The Argument, Decision, and Reports of Darcy v. Allen*, 45 EMORY L.J. 1261, 1263 (1996).

“the liberty of the subject” because they raised prices, reduced the availability of goods, and reduced competition.¹⁹² The court did recognize, however, that one who “by his own charge and industry, or by his own wit or invention doth bring any new trade into the realm”—whether by a truly new invention or by bringing to England a new trade or industry known elsewhere—might usefully receive a monopoly.¹⁹³

The Statute of Monopolies, enacted in 1623, codified the common-law prohibition on monopolies expressed in *Darcy* and has been called “the best known of all the legislative enactments of Parliament [and] certainly . . . among the longest running.”¹⁹⁴ Although it strongly condemned the Crown’s monopolistic practices, it similarly provided that the general prohibition:

shall not extend to any letters patent and grants of privilege for the term of one and twenty years or under, heretofore made, of the sole working or making of any manner of new manufacture within this realm, to the first and true inventor and inventors of such manufactures, which others at the time of making such letter patent and grants did not use, so they be not contrary to the law, nor mischievous to the state.¹⁹⁵

English statutory law thus showed a strong awareness of the costs imposed by monopolies, voiding patents that were “‘lacking in novelty, or contrary to law, or mischievous to the state . . . , or hurt of trade, or generally inconvenient.’”¹⁹⁶ Legislation based on the Statute of Monopolies appeared eventually in New England,¹⁹⁷ and there is little doubt that the framers were aware of these important events and, thus, of the perceived dangers of monopolies.¹⁹⁸

ii. Copyright Law

The framers were also very likely aware of the basic history of copyright law in England,¹⁹⁹ an awareness that probably influenced the form of both the Intellectual Property Clause and the First Amendment.²⁰⁰ At its inception in 1557, the monopoly over printing granted to the Stationers’

192. *Early Evolution*, *supra* note 181, 76 J. PAT. & TRADEMARK OFF. SOC’Y at 868.

193. *Darcy*, 74 Eng. Rep. at 1139; *see also Early Evolution*, *supra* note 181, 76 J. PAT. & TRADEMARK OFF. SOC’Y at 870.

194. *Early Evolution*, *supra* note 181, 76 J. PAT. & TRADEMARK OFF. SOC’Y at 874.

195. 21 Jam., ch. 3, § 5 (1623) (Eng.).

196. Prager, *supra* note 181, at 313. Coke’s Institutes reflects this antimonopoly bias, stating that patents “must not be contrary to law[,] . . . mischievous to the State by raising of prices of commodities at home[,] . . . hurt trade[, or be] generally inconvenient.” 3 INSTITUTES OF THE LAW OF ENGLAND 184 (1628).

197. *See Prager*, *supra* note 181, at 314.

198. *See Background and Origin*, *supra* note 181, at 35–36.

199. *See PATTERSON*, *supra* note 181, at 3; *Background and Origin*, *supra* note 181, at 35–36.

200. *See generally PATTERSON*, *supra* note 181; Marci A. Hamilton, *The Historical and Philosophical Underpinnings of the Copyright Clause*, in 5 OCCASIONAL PAPERS IN INTELLECTUAL PROPERTY FROM BENJAMIN N. CARDOZO SCHOOL OF LAW YESHIVA UNIVERSITY 4 (1999).

Company in London was intended as a means of press control.²⁰¹ By granting the exclusive right to print books and pamphlets to a single group that owed its license to the Crown, the English monarchy was able to repress a new form of potential dissent that it particularly feared. The permission of the Queen or a combination of other governmental and ecclesiastical officials was necessary to print books.²⁰² Authors themselves had no legal right to publish their works.²⁰³ With the right to print in private hands subject to government control, the effect of the legal regime was the widespread suppression of information. John Milton's *Areopagitica* is perhaps the most well-known expression of opposition to this regime of press control.²⁰⁴

The beginning of the end for the Stationers' monopoly and press control in England came with the enactment of the Statute of Anne, almost eighty years before the Constitutional Convention.²⁰⁵ The new law was entitled "An act for the encouragement of learning, by vesting the copies of printed books in the authors or purchasers, of such copies, during the times therein mentioned."²⁰⁶ Although the statute provided for a twenty-one year extension of existing rights held by the Stationers' Company—as consolation to the publishers whose rights were being stripped by the new legislative scheme²⁰⁷—the new statutory grant of rights to authors and purchasers "was aimed at preventing future monopolies and the monopoly of the company itself."²⁰⁸ In spite of the best efforts of the booksellers and the Stationers' Company over the course of the next seventy years, the statute was recognized as establishing a fundamental author's right.²⁰⁹

Beginning in 1769, English courts struggled with the question whether the Statute of Anne complemented or displaced common-law rights that might exist in published works.²¹⁰ The judges of the King's Bench upheld a perpetual common-law copyright in 1769,²¹¹ but in 1773, the Scottish Lords of Session rejected a common-law claim of perpetual copyright.²¹² Lord Kames was particularly eloquent in his condemnation of such a monopoly:

I have no difficulty to maintain that a perpetual monopoly of books would prove more destructive to learning, and even to authors, than a second irruption of Goths and Vandals. And hence with assurance I infer, that a perpetual monopoly is not a branch of the common law or of the law of nature. God planted that law in

201. See PATTERSON, *supra* note 181, at 29–30, 114–42.

202. See *id.* at 37.

203. See *id.* at 64–65.

204. See *id.* at 114.

205. See 8 Anne (1710) (Eng.).

206. 8 Anne, ch. 19 (1710) (Eng.).

207. See CROSSKEY, *supra* note 181, at 480–81.

208. PATTERSON, *supra* note 181, at 144.

209. See *id.* at 151–79.

210. See *id.* at 150, 168–79.

211. See *Millar v. Taylor*, 98 Eng. Rep. 201 (K.B. 1769).

212. See IAN SIMPSON ROSS, *LORD KAMES AND THE SCOTLAND OF HIS DAY* 141 (1972).

our hearts for the good of society; and it is too wisely contrived to be in any case productive of mischief.

Our booksellers, it is true, aiming at present profit, may not think themselves much concerned about futurity. But it belongs to judges to look forward; and it deserves to be duly pondered whether the interest of literature in general ought to be sacrificed to the pecuniary interest of a few individuals. . . . [A] monopoly would put a final end to the commerce of books in a few generations. And therefore, I am for dismissing this process as contrary to law, as ruinous to the public interest, and as prohibited by the statute.²¹³

The next year, the English House of Lords definitively ruled that authors' rights in published works were limited by the Statute, rather than governed by common law.²¹⁴

b. Colonial Practices

While the English courts went back and forth on the relationship between the common law and the Statute of Anne, American colonists experienced even greater uncertainty because the status of English common law itself was extremely unclear.²¹⁵ In addition, it was uncertain whether the Statute of Anne was applicable at all to the colonies.²¹⁶ Not surprisingly, one authority notes that "[f]or all intents and purposes, no [administrative] colonial copyright practice existed."²¹⁷ In any case, cheap American editions of popular English works were published in the colonies without apparent sanction.²¹⁸

As far as patents are concerned, colonial authorities apparently granted patents only on rare occasions due to the absence of any formal

213. *Id.* at 141–42 (quoting THE DECISIONS OF THE COURT OF SESSION UPON THE QUESTION OF LITERARY PROPERTY, EDINBURGH, 1774, at 18–21 (C. James Boswell ed., Edinburgh (1774)). See generally W. Forbes Gray, *Alexander Donaldson and His Fight for Cheap Books*, 38 JURID. REV. 180 (1926); John Murray, *Some Civil Cases of James Boswell, 1772–74*, 52 JURID. REV. 222 (1940).

214. See *Donaldson v. Beckett*, 1 Eng. Rep. 837, 847 (H.L. 1774).

215. As far as the applicability of English common law goes, St. George Tucker referencing Blackstone opined that it would be "[i]n vain . . . [to] attempt, by any general theory, to establish a uniform authority and obligation in the common law of England, over the American colonies, at any period between the first migrations to this country, and that epoch, which annihilated the sovereignty of the crown of England over them." 1 BLACKSTONE'S COMMENTARIES: WITH NOTES OF REFERENCE, TO THE CONSTITUTION AND LAWS OF THE FEDERAL GOVERNMENT OF THE UNITED STATES AND OF THE COMMONWEALTH OF VIRGINIA app. at 405 (St. George Tucker ed., 1803). As to the extreme of common-law copyrights, compare CROSSKEY, *supra* note 181, at 481–82 (finding "the existence of belief there were no such rights is probable"), and *Background and Origin*, *supra* note 181, at 13 & n.40, with Prager, *supra* note 181, at 317–19 (arguing that the choice of the word "secure" in the Intellectual Property Clause indicates a belief on the framers' part that common-law rights preexisted the Constitution).

216. See CROSSKEY, *supra* note 181, at 482 (concluding that "no notion at all was entertained that that statute was law in America"). Fenning asserts without citation that "copyright and invention patent protection was extended to the colonies by the English laws." See Fenning, *supra* note 181, at 116.

217. *Background and Origin*, *supra* note 181, at 20.

218. See CROSSKEY, *supra* note 181, at 482 (citing the American publication of BLACKSTONE'S COMMENTARIES as an example).

patent system.²¹⁹ It is unclear whether patents granted in England were enforceable,²²⁰ and we have virtually no record of the legal enforcement of patents in the colonies.²²¹

c. State Practices Under the Articles of Confederation

The passage of various state laws after the Revolution “plainly show[s] that the English statute [of Anne] and the English decisions were known and taken into consideration.”²²² Many states borrowed both language and time limits from the Statute of Anne, and although a few included a savings clause designed to retain common-law copyright protection, most did not.²²³ The Continental Congress, which under the Articles had no authority to legislate in the area, recommended state enactment of limited copyright protection without a clause securing common-law rights that might exist.²²⁴ Eventually, all states except Delaware provided basic copyright protection, but only South Carolina provided statutory protection for inventions.²²⁵ Interestingly, five states (Connecticut, Georgia, New York, and both Carolinas) required the publication of copyrighted books in “sufficient numbers and at a cheap enough price to satisfy the public demands.”²²⁶

The preamble to the Massachusetts copyright statute²²⁷ and the extant legislative history of the recommendation made by the Continental Con-

219. See Prager, *supra* note 181, at 311–12 (“It is important to note that there was much uncertainty in the early patent practice, throughout its long existence and uniformly in all countries and colonies.”); *Background and Origin*, *supra* note 181, at 14–15; see also *Goldstein v. California*, 412 U.S. 546, 557 n.13 (1973) (listing patents issued by the colonies and states between 1751 and 1787).

220. See *Early Views*, *supra* note 181, at 88–89 & n.46 (“Thus, Fenning was incorrect in stating that [o]f course, copyright and invention patent protection was extended to the colonies by the English Laws.” (citing Fenning, *supra* note 181, at 116)).

221. See *Early Evolution*, *supra* note 181, 78 J. PAT. & TRADEMARK OFF. SOC’Y at 623–31.

222. CROSSKEY, *supra* note 181, at 483; Donner, *supra* note 181, at 378 (“[D]evelopments in England strongly influenced the look of the American copyright laws.”).

223. See CROSSKEY, *supra* note 181, at 483–86.

224. In full, the resolution of May 2, 1783, reads:

Resolved, that it be recommended to the several States secure to the authors or publishers of any new books not hitherto printed, being citizens of the United States, and to their executors, administrators, and assigns, the copy right of such book for a certain time not less than fourteen years from the first publication . . . such copy or exclusive right of printing, publishing, and vending the same, to be secured to the original authors, or publishers, their executors, administrators, and assigns, by such laws and under such restrictions as to the several States may seem proper.

24 JOURNALS OF THE CONTINENTAL CONGRESS 1774–1789, at 326–27 (Washington Gov’t Printing Office 1922) (1783), *cited in* Fenning, *supra* note 181, at 114–15.

225. See Fenning, *supra* note 181, at 115. The statute provided: “The Inventors of useful machines shall have a like exclusive privilege of making or vending their machines for the like term of 14 years, under the same privileges and restrictions hereby granted to, and imposed on, the authors of books.” 4 STATUTES AT LARGE OF SOUTH CAROLINA 618–20 (Thomas Cooper ed., 1837–68), *cited in* BUGBEE, *supra* note 181, at 93.

226. Fenning, *supra* note 181, at 116; see also Hadfield, *supra* note 181, at 10–11.

227. See ACTS AND LAWS OF THE COMMONWEALTH OF MASSACHUSETTS 236 (Boston 1781–83), *cited in* *Background and Origin*, *supra* note 181, at 22.

Whereas the Improvement of Knowledge, the Progress of Civilization, the public Weal of the Community, and the Advancement of Human Happiness, greatly depend of the Efforts of learned and ingenious Persons in the various Arts and Sciences: As the principal Encouragement such Persons can have to make great and beneficial Exertions of this Nature must exist in the le-

gress²²⁸ provide some evidence as to why the protection of writings and inventions was being considered at all. These sources show a mix of utilitarian (“the protection and security of literary property would greatly tend to encourage genius”)²²⁹ and natural law (“nothing is more properly a man’s own than the fruit of his study”)²³⁰ justifications. Interestingly, Adam Smith articulated the utilitarian rationale underlying copyright, in works that appeared shortly before the Constitutional Convention.²³¹ We can only speculate whether the framers were aware of Smith’s justifications for copyright law, but we note that the Preamble to the Intellectual Property Clause includes only the utilitarian (“To promote the Progress of Science”)²³² and not the natural-law rationale.

There is some evidence of states granting patents by special acts of their legislatures in increasing numbers after hostilities with England ceased,²³³ although two states had constitutional provisions that probably would have prevented statutory protection for patents.²³⁴ South Carolina, the only state that provided statutory protection for inventions, required sellers to market patented inventions at a reasonable price.²³⁵

2. *Debates at the 1787 Philadelphia Constitutional Convention*

There is no record of any debate over the Intellectual Property Clause at the Constitutional Convention,²³⁶ but some educated guesses are possible about the circumstances of the drafting and passage of “the first announcement of any modern nation that patents for invention were going to

gal Security of the Fruits of their Study and Industry to themselves; and as such Security is one of the natural Rights of all Men, there being no Property more peculiarly a Man’s own than that which is produced by the Labour of his Mind.

Id.

228. See 24 JOURNALS OF THE CONTINENTAL CONGRESS 1774–1789, at 326–27 (Washington Gov’t Printing Office 1922) (1783) (“[N]othing is more properly a man’s own than the fruit of his study, and that the protection and security of literary property would greatly tend to encourage genius, to promote useful discoveries and to the general extension of arts and commerce.”).

229. *Id.* at 326.

230. *Id.*

231. See Hadfield, *supra* note 181, at 19–28 (exploring Adam Smith’s analysis of copyright).

232. U.S. CONST. art. I, § 8, cl. 8.

233. See Fenning, *supra* note 181, at 115; *Early Evolution*, *supra* note 181, 78 J. PAT. & TRADEMARK OFF. SOC’Y at 668; see, e.g., *Gibbons v. Ogden*, 22 U.S. (9 Wheat.) 1, 221 (1828) (holding that the grant of the exclusive right by the State of New York to operate steam-powered boats in its navigable waterways conflicted with federal-permit scheme).

234. See MD. CONST. of 1776, § 39 (1867), *reprinted in* 4 SOURCES AND DOCUMENTS OF U.S. CONSTITUTIONS 374 (William F. Swindler ed., 1975) (declaring “[t]hat monopolies are odious, contrary to the spirit of a free government, and the principles of commerce; and ought not to be suffered”); N.C. CONST. of 1776, A Declaration of Rights, art. 23, *reprinted in* 7 SOURCES AND DOCUMENTS OF U.S. CONSTITUTIONS 403 (William F. Swindler ed., 1978) (declaring “[t]hat perpetuities and monopolies are contrary to the genius of a free State, and ought not to be allowed”); *Background and Origin*, *supra* note 181, at 31.

235. See Fenning, *supra* note 181, at 116.

236. See Donner, *supra* note 181, at 361; *Early Views*, *supra* note 181, at 92 (“No delegate to the Constitutional Convention has left any record concerning the interpretation or meaning placed on the intellectual property clause by the delegates themselves.”).

be a means of progress."²³⁷ First, the vote on the Clause was unanimous,²³⁸ indicating that the intent of the framers was "rather to clarify, than to change, the existing law."²³⁹ At the time the first drafts of Article I were initially proposed and debated, congressional power over intellectual property had not yet been included,²⁴⁰ and Madison and Pinckney seem to have been the two primary forces behind the addition of the Clause.²⁴¹ We know that Madison was apparently concerned about the lack of uniformity in the protection of literary property and inventions among the states.²⁴² We also know that all proposals floated at the Convention insisted that the protection be only for limited times.²⁴³

The one public comment contemporaneous with the drafting of the Constitution that we have been able to find suggests that granting patents and copyrights was considered a cheap way for the young government to foster scientific progress.²⁴⁴

3. *Debates over Ratification of the Constitution*

The Federalist Papers discuss the Intellectual Property Clause only briefly:

The utility of this power will scarcely be questioned. The copyright of authors has been solemnly adjudged in Great Britain to be a right at common law. The right to useful inventions seems with equal reason to belong to the inventors. The public good fully coincides in both cases with the claims of individuals. The states cannot separately make effectual provision for either of the cases, and most of them have anticipated the decision of this point, by laws passed at the instance of Congress.²⁴⁵

Although Madison may have been misinformed about the nature of authors' rights in England at the time,²⁴⁶ he obviously sought to minimize the potential clash between natural law and utilitarian justifications for intellectual property protection. Several of his Virginia colleagues, however,

237. Prager, *supra* note 181, at 318.

238. See Donner, *supra* note 181, at 361; see also BUGBEE, *supra* note 181, at 1; 2 RECORDS OF THE FEDERAL CONVENTION 508–10 (Max Farrand ed., Yale Univ. Press 1911) (1787).

239. CROSSKEY, *supra* note 181, at 477.

240. See *Background and Origin*, *supra* note 181, at 25.

241. See Fenning, *supra* note 181, at 109–13.

242. See *id.* at 113; see also *Background and Origin*, *supra* note 181, at 22–24 (explaining disuniformity of practice under the Articles of Confederation and Madison's concern).

243. See Fenning, *supra* note 181, at 109–13.

244. See *Remarks on the Amendments to the Federal Constitution*, 6 AMERICAN MUSEUM OR REPOSITORY OF ANCIENT AND MODERN FUGITIVE PIECES, ETC. 303 (AMS Press, Inc. 1965) (1789) [hereinafter AMERICAN MUSEUM], cited in *Background and Origin*, *supra* note 181, at 56 ("As to those monopolies, which, by way of premiums, are granted for certain years to ingenious discoveries in countries, and more necessary in this, as the government has no resources to reward extraordinary merit.")

245. THE FEDERALIST No. 43, at 338 (James Madison) (John C. Hamilton ed., J. B. Lippincott & Co. 1804) (1788).

246. See generally *Donaldson v. Beckett*, 1 Eng. Rep. 837 (H.L. 1774) (holding that an author's rights were severely limited by the Statute of Anne).

did not view protection as being so benign. One of George Mason's reasons for not supporting the proposed Constitution was his fear that "the [C]ongress may grant monopolies in trade and commerce."²⁴⁷

Further confirmation of the general skepticism about protecting intellectual property is found in correspondence between James Madison and Thomas Jefferson. Jefferson shared Mason's misgivings, stating in a letter to Madison that:

[I]t is better . . . to abolish . . . Monopolies, in all cases, than not to do it in any. . . . The saying there shall be no monopolies lessens the incitements to ingenuity, which is spurred on by the hope of a monopoly for a limited time, as of 14 years; but the benefit even of limited monopolies is too doubtful to be opposed to that of their general suppression.²⁴⁸

Madison responded cautiously, "With regard to Monopolies they are justly classed among the greatest nuisances [sic] in Government. But is it clear that as encouragements to literary works and ingenious discoveries, they are not too valuable to be wholly renounced?"²⁴⁹ Although Jefferson was the first administrator of the nascent patent system in the United States, he remained very skeptical of the notion of granting property rights to inventors.²⁵⁰ Later in his life, he also made clear that he rejected any natural-law basis for patent protection.²⁵¹

We have little evidence of debates in state conventions. At the North Carolina convention, James Iredell made the utilitarian argument that copyright protection would "give birth to many excellent writings which would otherwise have never appeared."²⁵² The amendments proposed by several states further confirm that Americans were opposed to any possible congressional power to establish monopolies.²⁵³

247. *Background and Origin*, *supra* note 181, at 37 (citing *The Objections of the Hon. George Mason, One of the Delegates from Virginia, in the Late Continental Convention, to the Proposed Federal Constitution, Assigned as His Reasons for Not Signing the Same*, 2 AMERICAN MUSEUM, *supra* note 244, at 534, 536).

248. 13 THE PAPERS OF THOMAS JEFFERSON 442-43 (Julian P. Boyd ed., 1956).

249. 14 *id.* at 21 (footnote omitted).

250. See 13 THE WRITINGS OF THOMAS JEFFERSON 333-34 (Andrew A. Lipscomb & Albert Ellery Bergh eds., 1903). Jefferson stated, among other things, that:

Inventions then cannot, in nature, be a subject of property. Society may give an exclusive right to the profits arising from them, as an encouragement to men to pursue ideas which may produce utility, but this may or may not be done, according to the will and convenience of the society, without claim or complaint from anybody.

Id. at 334.

251. See *id.* at 333-35.

252. 16 THE DOCUMENTARY HISTORY OF THE RATIFICATION OF THE CONSTITUTION 382 (John P. Kaminski et al. eds., 1986). At the Pennsylvania convention, it was remarked that only the federal government could really effectively provide for nationwide protection for literary works. 2 *id.* at 415 (Merrill Jensen et al. eds., 1976) (quoting Thomas McKean).

253. The New York convention recommended an amendment to make clear that "the congress does not grant monopolies, or erect any company with exclusive advantages of commerce." *Ratification of the New Constitution by the Convention of the State of New York*, 4 AMERICAN MUSEUM, *supra* note 244, at 153, 156, cited in *Background and Origin*, *supra* note 181, at 37-38 & n.124. Massachusetts, New Hampshire, and North Carolina suggested an amendment "that [C]ongress erect no company of merchants,

4. *Early Congressional Practice*²⁵⁴

Eighteenth and nineteenth century Congresses remained cautious in enacting patent and copyright protection, keeping closely to the expressed purpose of the Clause—to “promote the Progress” of science and literature—rather than simply awarding benefits to a limited class of individuals. Indeed, Congress thought quite carefully about how much incentive was necessary to achieve the goals of the Clause: fourteen years was chosen as the term of protection in the first patent statute because apprenticeship terms commonly lasted seven years, and the ability to train two sets of apprentices was thought a fair return for the inventor’s efforts.²⁵⁵

Three isolated exercises of congressional power are arguably to the contrary. The first copyright law provided fourteen years of protection for books, maps, and charts already printed in the United States.²⁵⁶ One might question how the grant of protection for works already created was meant to “promote the Progress of Science,” but retroactive protection in the *first* copyright act was uniquely justified by several considerations. As noted earlier, the state of common-law protection was very unclear.²⁵⁷ The copyright act not only extended statutory protection to existing works but also extinguished any common-law rights beyond the fourteen-year term: thus authors who thought they had perpetual common-law protection were disappointed.²⁵⁸ Moreover, given that protection of various lengths of time had been provided by twelve of the thirteen states under the Articles of Confederation,²⁵⁹ the retroactive feature of the statute may have been a uniformity measure, designed to provide a standard expiration date for books, maps, and charts published before 1790. It might therefore have been an example of the Congress responding to the constitutional language authorizing it to “secure” authors their rights.²⁶⁰

Congress granted retroactive copyright protection only once more before the twentieth century.²⁶¹ In 1831, it created a longer term of protection for new works—twenty-eight years instead of fourteen—and extended protection for existing works for the same period.²⁶² This isolated incident, coming more than forty years after the first copyright act and not repeated

with exclusive advantages of commerce,’” *Background and Origin*, *supra* note 181, at 37–38 & n.124 (quoting *Remarks on the Amendments to the Federal Constitution*, 6 AMERICAN MUSEUM, *supra* note 244, at 303).

254. Because the Court’s first pronouncement on intellectual property was not until 1831, we defer consideration of judicial practices until the discussion of precedent.

255. See Michael D. Davis, *The Patenting of Products of Nature*, 21 RUTGERS COMPUTER & TECH. L.J. 293, 298–99 (1995).

256. See PATTERSON, *supra* note 181, at 197.

257. See *supra* note 215 and accompanying text.

258. See *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591, 605 (1834).

259. See *Background and Origin*, *supra* note 181, at 21–22.

260. This was prior to the decision in *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591, 600 (1834), in which the Court opined that the word “secure” did not refer to existing rights.

261. See Act of Feb. 3, 1831, ch. 16, 4 Stat. 436 (repealed 1909).

262. See *id.*

for another seventy-seven years,²⁶³ is more indicative of congressional reticence than of congressional assertion of authority.

From time to time early Congresses also asserted the power to extend the validity of an individual patent beyond the term set by the patent statute.²⁶⁴ Like the retroactivity of the first copyright act, these individual patent extensions appear to conflict with the utilitarian purpose of the Clause insofar as they award additional protection for existing ingenuity. Moreover, unlike the copyright extensions, there is a sufficient pattern of action to support some historical conclusions. For example, there are circumstances suggesting that these patent extensions were consistent with a limited purpose of promoting innovation. First, unlike the copyright extension of 1831,²⁶⁵ none of the patent-term extensions involved an entire class of patents. More important, we note that the individual patent-term extensions at issue in the nineteenth century do not necessarily look like governmental giveaways.²⁶⁶ Imagine an inventor, who obtained a patent in 1846 for a new plow, but did not perfect a prototype until 1854 and could not find capital to finance a new manufacturing plant until 1858. By the time ground was broken on the new plant, the patent was about to expire, and the chance of recouping the cost of building the plant was therefore greatly reduced. The capital investors behind the project would have been justifiably nervous and considered backing out. In other words, the new plow might never have hit the market—or benefited the public—without a guarantee of a monopoly period to recoup sunk costs. An extension granted by Congress to provide an incentive to build the plant and produce the plow looks much more like a purchase for the public benefit than a gift, and thus, an extension could be justified within the limited utilitarian purposes of the Clause.²⁶⁷ Extensions might be necessary when an inventor receives a patent before her invention is embodied in physical form, an anomaly as to the timing of protection that does not exist in the copyright context. Thus,

263. The Copyright Act of 1909 extended protection retroactively by extending the renewal term to 28 years, resulting in maximum protection for 56 years. *See* Act of Mar. 4, 1909, ch. 320, 35 Stat. 1075 (repealed 1947).

264. *See generally* Bloomer v. McQuewan, 55 U.S. (14 How.) 539 (1852) (involving 1845 Act of Congress extending a particular planing patent for seven extra years, beginning in 1849).

265. *See* Act of Feb. 3, 1831, ch. 16, 4 Stat. 436 (repealed 1909).

266. *See Bloomer*, 55 U.S. at 553–54.

267. We note that in 1861, Congress extended the presumptive term of patent protection from 14 to 17 years. *See* Siemens v. Sellers, 123 U.S. 276, 285 (1887). This extension applied retroactively, but it is unclear whether it was actually meant to result in an increased length of protection because the same act eliminated the possibility of applying for a seven-year discretionary extension that could be awarded by the Patent Office. *See id.* The Supreme Court description of the change does not make it sound like giveaway legislation. *See id.*

Prior to 1861, all patents, as we have seen, were granted for the term of fourteen years, with a right, under certain circumstances, to an extension for seven years longer. This right of extension was attended with many inconveniences and much expense to meritorious patentees, and Congress, by the act of 1861, cut it off, and made the term of all patents seventeen years—a compromise between fourteen and twenty-one years.

Id.

Congress's justifications for patent extensions are not necessarily applicable to copyright.²⁶⁸

B. *Structural and Linguistic Features of the Clause*

Several commentators and the Court itself have suggested that the structure of the Intellectual Property Clause provides substantial clues as to how it should be interpreted. One scholar suggests that “[r]eading the power, then, in light of the [S]tatute of Anne and the then recent decisions of the English courts, it is clear that this power of Congress was enumerated in the Constitution, *for the purpose* of expressing its limitations.”²⁶⁹ In other words, even before we parse language of the Clause, we must first note that the framers made a deliberate (and unanimous) choice to enumerate this power expressly rather than leaving it to be implied from other powers. One strong possibility is that the framers wanted to make clear not only that Congress possessed the power but also that the means of wielding that power were restricted. Why not just give Congress the power “to grant copyrights and patents”?

This question is especially relevant when one remembers the basic drafting principles that the framers employed eschewed the sorts of details that are contained in the Clause.²⁷⁰ One commentator suggests that:

[T]he unusual fact that this particular detail exists in the Intellectual Property Clause in and of itself suggests a key to why such a clause was included. The Clause was intended not so much as an express authority to promote the progress of science and the useful arts, but rather as a means of ensuring authority to do so in a particular way.²⁷¹

The unique nature of the Clause thus may indicate a special purpose on the part of the framers.

1. *The Preamble: “To Promote the Progress of Science and Useful Arts”*

No other grant of power to Congress begins with a prescription of proper legislative purpose.²⁷² One notices first that the language seems to

268. See *infra* text accompanying notes 345–51 for a discussion of potential differences between copyright and patent principles.

269. CROSSKEY, *supra* note 181, at 486.

270. See 2 RECORDS OF THE FEDERAL CONVENTION 137 (Max Farrand ed., rev. ed. 1966). Edmund Randolph said:

In the draught of a fundamental constitution, two things deserve attention:

1. To insert essential principles only, lest the operations of government should be clogged by rendering those provisions permanent and unalterable, which ought to be accommodated to times and events.
2. To use simple and precise language, and general propositions, according to the example of the . . . constitutions of the several states.

Id., quoted in *Background and Origin*, *supra* note 181, at 32.

271. *Background and Origin*, *supra* note 181, at 32–33.

272. See *id.*

take a clear side in the debate over whether natural law or classical economics provides the best justification for protecting intellectual property. The Preamble indicates that the granting of rights is driven by the goal of enhancing public welfare, rather than rewarding an author or inventor for her own sake or lining the pockets of some modern day courtier. If the phrase is an endorsement of the utilitarian rationale, as the Court has so often claimed,²⁷³ then the Clause might be read to prevent Congress from granting “exclusive rights” in a fashion detrimental to the public welfare, a reading that certainly would be consistent with lessons learned from English history.²⁷⁴

2. “By Securing for Limited Times to Authors and Inventors”

As discussed below, the Court in *Wheaton v. Peters*²⁷⁵ found the linking of “Authors and Inventors” critical in determining whether the verb “securing” referred to rights that existed at common law.²⁷⁶ Because inventors clearly had no common-law rights in their creations,²⁷⁷ the Court held that the Clause could not be read to acknowledge any such rights in authors either.²⁷⁸ Crosskey goes so far as to state that the framers meant “to extinguish . . . the perpetual rights which authors had, or were supposed by some to have, under the Common Law.”²⁷⁹ If this interpretation is correct, then we have more structural evidence of the framers’ view of intellectual property as a creature of positive law, designed for the public benefit.

The “limited times” language also seems to support this proposition.²⁸⁰ As we saw in our discussion of the history of the Clause, the notion of limiting the term of protection for intellectual property was likely one mecha-

273. See *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349 (1991); *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 146 (1989); *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984) (“The monopoly privileges that Congress may authorize are neither unlimited nor primarily designed to provide a special private benefit. Rather, the limited grant is a means by which an important public purpose may be achieved.”); *Mazer v. Stein*, 347 U.S. 201, 219 (1954) (“The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in ‘Science and useful Arts.’”).

274. We note that although the Preamble to the Clause is unique, it is not the only clause in Article I, Section 8, that contains limiting language. Even before the Court decided in *Gibbons* that the word “uniform” needed to be taken seriously by Congress, at least one commentator paired the Bankruptcy Clause and the Intellectual Property Clause as two prime examples of “the enumerating of particular governmental powers in order to express limitations upon them[,] . . . a favorite device of the Federal Convention.” CROSSKEY, *supra* note 181, at 486. Three other clauses also contain limitations on grants of power to Congress in Article I, Section 8. U.S. CONST. art. I, § 8, cl. 1 (requiring “all Duties, Imposts and Excises shall be uniform”), cl. 12 (providing Congress the power to raise and support armies but “no appropriations of money to that use shall be for a longer term than two years”), & cl. 17 (limiting the size of the District of Columbia to no more than ten square miles).

275. 33 U.S. (8 Pet.) 591 (1834).

276. See *id.* at 661.

277. See *id.*

278. See *id.* at 663.

279. CROSSKEY, *supra* note 181, at 486.

280. U.S. CONST. art. I, § 8, cl. 8.

nism by which the framers sought to minimize monopoly costs and assure that valuable inventions and writings would inevitably belong to the public.²⁸¹

3. “*The Exclusive Right to Their Respective Writings and Discoveries*”

In light of the historical background and the other language of the Clause, the use of the word “exclusive” is somewhat puzzling. It is hard to see a concern for public welfare in the use of the word “exclusive” because a grant of something less than a full monopoly might still (or better) advance science and the useful arts. At least one scholar makes much of this analysis, arguing that “it would be unconstitutional for Congress to endeavor to provide for . . . [working or compulsory licenses] in either patents or copyrights.”²⁸² We are not convinced that the language is so clear in this regard. It may have merely been intended to indicate that patents and copyrights generally should bear the main attribute of other sorts of personal (and real) property, for example, the right to exclude. Our reading makes some sense, given that even the most “exclusive” right to property at common law was subject to a number of qualifications found in sources as diverse as nuisance law and the takings doctrine.

The framers also may have been hesitant to give Congress the bare power to grant unelaborated rights to authors and inventors. Authors and inventors might lack sufficient incentives if their rights were too watered down. We know that assuring the young nation’s economic prosperity was a goal of the framers and that granting patents was a fiscally conservative way to encourage “Progress” without direct subsidies from a cash-poor federal government.²⁸³ This pragmatic view was espoused by Mill in the years immediately preceding the Convention²⁸⁴ and by the only contemporaneous public comment we have found.²⁸⁵ In this sense, the word “exclusive” may be yet another recognition of the utilitarian rationale for the Intellectual Property Clause. It is also possible that the language is an historical artifact, derived from the Statute of Anne’s use of the words “sole liberty” and “sole right.”²⁸⁶

281. See *supra* notes 181–268 and accompanying text.

282. Fenning, *supra* note 181, at 116.

283. See *Background and Origin*, *supra* note 181, at 34.

284. See Fritz Machlup & Edith Penrose, *The Patent Controversy in the Nineteenth Century*, 10 J. ECON. HIST. 1, 20, 23 (1950).

285. See *Remarks on the Amendments to the Federal Constitution*, 6 AMERICAN MUSEUM, *supra* note 244, at 303, cited in *Background and Origin*, *supra* note 181, at 56 (“As to those monopolies, which, by way of premiums, are granted for certain years to ingenious discoveries in medicine, machines and useful arts; they are common in countries, and more necessary in this, as the government has no resources to reward extraordinary merit.”).

286. Statute of Anne, 8–12 Anne, ch. 19, §§ 1, 11 (1709) (Eng.).

C. Precedent

The Court's own pronouncements are consistent with our analysis of the history and structure of the Clause and suggest refinements of the basic utilitarian principle. The earliest Supreme Court case interpreting the Intellectual Property Clause is *Wheaton v. Peters*.²⁸⁷ The case raised the question of whether any common-law rights in already published works survived the ratification of the Constitution and the passage of the first Copyright Act. The plaintiff argued that the use of the verb "secure" in the text of the Intellectual Property Clause indicated an intention on the part of the framers "not to originate a right, but to protect one already in existence."²⁸⁸ The Court rejected this construction, basing its decision on the fact that the verb clearly referred to both "Authors and Inventors."²⁸⁹ It explained that:

[T]he word *secure*, as used in the [C]onstitution, could not mean the protection of an acknowledged legal right. It refers to inventors, as well as authors, and it has never been pretended, by any one, either in this country or in England, that an inventor has a perpetual right, at common law, to sell the thing invented.²⁹⁰

The case thus establishes copyright law in the United States as a creature of positive, statutory law and provides some support for the notion that the Clause was intended to embody the utilitarian rationale for protection, rather than one based on the natural rights of the author.²⁹¹

In 1879, the Court further confirmed the importance of limiting protection to laws designed to encourage the production of original works.²⁹² The *Trade-Mark Cases*²⁹³ held that 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."²⁹⁴ It is important to note, however, that the Court went on to consider whether the Commerce Clause might authorize the trademark legislation.²⁹⁵ Ultimately, the Court concluded that the trademark legislation was not within the scope of the Commerce Clause because the legislation protected purely intrastate trademarks.²⁹⁶ The 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.²⁹⁷ The *Trade-Mark Cases* thus not only reminds us that promoting originality

287. 33 U.S. (8 Pet.) 591 (1834).

288. *Id.* at 661.

289. *See id.*

290. *Id.*

291. *See id.*

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

293. *Id.*

294. *Id.* In reality, of course, many trademarks are quite creative. The Court's point is that trademark law is concerned with protecting consumer goodwill regardless of the form a trademark may take.

295. *See id.* at 97.

296. *See id.*

297. *See* The Trade-Mark Cases, 100 U.S. at 97.

and inventiveness is an important aspect of the Clause, but it also marks the outer bounds of the underlying constitutional principles,²⁹⁸ we later return to the question of why protecting trademarks is consistent with the principles we identify.²⁹⁹

Two other older cases continue the theme of granting protection only where necessary to encourage creative endeavor. In *Burrows-Giles Lithographic Co. v. Sarony*,³⁰⁰ the Court defined an “Author” as “he to whom anything owes its origin,” and “Writings” as “literary productions . . . by which the ideas in the mind of the author are given visible expression.”³⁰¹ In other words, only originality may be rewarded by copyright law.³⁰² Later, in *International News Service v. Associated Press*,³⁰³ the Court rejected the idea that “one who might happen to be the first to report a historic event” could be given “the exclusive right for any period to spread the knowledge of it.”³⁰⁴ Both cases are thus consistent with the history of skepticism toward monopolistic grants unless warranted to provide incentives.

The Court’s more recent cases are similarly consistent with this cautious approach to protecting intellectual property. In *Graham v. John Deere Co.*,³⁰⁵ the Court drew on historical sources³⁰⁶ to describe the underlying bargain of the Intellectual Property Clause as advancing the public welfare by providing protection to individual inventors, despite “the embarrassment [to the public] of an exclusive patent.”³⁰⁷ Thus, the Court explained 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. Innovation, advancement, and things which add to the sum of useful knowledge are inherent requisites in a patent system which by constitutional command must “promote the Progress of . . . useful Arts.” This is the *standard* expressed in the Constitution and it may not be ignored.³⁰⁸

298. *See id.*

299. *See infra* notes 333–56 and accompanying text.

300. 111 U.S. 53 (1884).

301. *Id.* at 58.

302. *See id.* at 59.

303. 248 U.S. 215 (1918).

304. *Id.* at 234. The Court in *International News Service* held that it had the power under the federal common law of unfair competition to authorize an injunction against the Associated Press’s (AP) competitor prohibiting it from printing the story within 24 hours of AP’s breaking the story. *See id.* at 217. Justice Pitney’s rationale in the majority opinion, however, is persuasively utilitarian, arguing that the failure to grant a brief injunction “would render publication profitless, or so little profitable as in effect to cut off the service by rendering the cost prohibitive in comparison with the return.” *Id.* at 241. Like the *Trade-Mark Cases*, this merely suggests that Intellectual Property Clause principles may accommodate some forms of protection more easily justified by reference to other Article I powers.

305. 383 U.S. 1 (1966).

306. *See id.* at 5.

307. *Id.* at 10–11 (quoting Thomas Jefferson).

308. *Id.* at 6.

As it has frequently done, the Court endorsed the utilitarian rationale for the Intellectual Property Clause,³⁰⁹ citing Jefferson's belief that the "patent monopoly was not designed to secure to the inventor his natural right in his discoveries. Rather, it was reward, an inducement, to bring forth new knowledge."³¹⁰

Twenty-five years after *Graham*, the Court again discussed the nature of the constraints that lie embedded in the Intellectual Property Clause. In *Feist Publications, Inc. v. Rural Telephone Service Co.*,³¹¹ the Court overruled a venerable line of cases that had held a compilation of facts collected by the "sweat of the brow" was protectable under copyright law, even if it was not original as to its selection or arrangement.³¹² In finding that the telephone white pages were unprotected, the Court went out of its way to establish a constitutional basis for its holding,³¹³ reaffirming the interpretation offered earlier in *Burrow-Giles* and the *Trade-Mark Cases* that the framers' use of the words "Authors" and "Writings" in the Intellectual Property Clause meant that only works evidencing some minimal degree of originality could be protected by Congress.³¹⁴ It emphasized that only original writings are works of authorship in the constitutional sense.³¹⁵

Interestingly, unlike the opinions in *Gibbons*³¹⁶ and *Graham*,³¹⁷ the Court seemed relatively uninterested in the history underlying the Intellectual Property Clause, reasoning instead from what it saw as "fundamental axiom[s] of copyright law"³¹⁸ and "bedrock principle[s]"³¹⁹ established by accretion in its case law. According to *Feist*, the foundational principles of copyright that inhere in the Intellectual Property Clause are by now so evident and well-established that they no longer require justification by reference to historical disquisition.³²⁰

These principles are the same ones that run through the history and precedent we have been discussing. In *Feist*, the Court began with the assumption that "[n]o author may copyright his ideas or the facts that he nar-

309. See, e.g., *Sony Corp. v. Universal City Studios*, 464 U.S. 417, 429 (1984); *Mazer v. Stein*, 347 U.S. 201, 219 (1954).

The monopoly privileges that Congress may authorize are neither unlimited nor primarily designed to provide a special private benefit. . . . It is intended to motivate the creative activity of authors and inventors . . . and to allow the public access to the products of their genius after the limited period of exclusive control has expired.

Sony Corp., 464 U.S. at 429.

310. *Graham*, 383 U.S. at 9.

311. 499 U.S. 340 (1991).

312. *Id.* at 352-56, 359-60.

313. See Paul J. Heald, *The Vices of Originality*, 1991 SUP. CT. REV. 143, 144 (noting the Court insisted at least seven times in the opinion that originality is a constitutional requirement).

314. See *Feist*, 499 U.S. at 346-48.

315. See *id.* at 346-47.

316. 455 U.S. 457 (1982).

317. 383 U.S. 1 (1965).

318. *Feist*, 499 U.S. at 344.

319. *Id.* at 347.

320. See *id.* (discussing the essence of copyright).

rates”³²¹ and traced that principle to its earlier holdings that “[o]riginality is a . . . constitutional requirement.”³²² Recognizing that even those authors who merely gather and arrange facts have exerted some effort, the Court nevertheless rejected protection for mere compilers:

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 by-product of a statutory scheme.” It is, rather, “the essence of copyright,” and a constitutional requirement. The primary objective of copyright is not to reward the labor of authors, but “[t]o promote the Progress of Science and useful Arts.”³²³

The Court in this passage clearly again endorsed the vision of the Intellectual Property Clause as a utilitarian trade-off. One finds a similar analysis in *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*³²⁴ The Court in that case explained that it was economics, not natural law, that most strongly influenced the framers: “The Patent Clause itself reflects a balance between the need to encourage innovation and the avoidance of monopolies which stifle competition without any concomitant advance in the ‘Progress of Science and useful Arts.’”³²⁵

D. Intellectual Property Principles of Constitutional Weight

Before drawing these historical, structural, and precedential sources together, we pause for a moment to review how we arrived at this point. Our initial interest arose with the first suggestion that Congress may not be able to overrule *Feist* by providing sui generis protection for databases under its commerce power.³²⁶ The reasoning of *Gibbons* suggested that the Intellectual Property Clause’s originality requirement might implicitly prohibit Commerce Clause protection of some works,³²⁷ but the *Trade-Mark Cases* hinted strongly that it would not prohibit protection of all unoriginal works.³²⁸ Because neither case clearly settled the question of the legitimacy of database protection, we went in search of the major cases in which the Court had found implied constraints on congressional power.³²⁹

Those cases revealed a complex interpretive methodology employed by a Court looking for meaning “in historical understanding and practice, in

321. *Id.* at 345 (citing *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 556 (1985)).

322. *Id.* at 347 (discussing *The Trade-Mark Cases*, 100 U.S. 82 (1879) (holding trademarks are not original and therefore not protectable under the Intellectual Property Clause) and *Burrow-Giles Lithographic Co. v. Saroni*, 111 U.S. 53 (1884) (holding photograph of Oscar Wilde possessed the required minimal creativity for protection)).

323. *Feist*, 499 U.S. at 349 (citations omitted).

324. 489 U.S. 141 (1989).

325. *Id.* at 146.

326. *See Heald*, *supra* note 313, at 168–76.

327. *See supra* note 27.

328. *See supra* note 297 and accompanying text.

329. *See supra* notes 300, 303, 305, 311, 324.

the structure of the Constitution, and in the jurisprudence of this Court."³³⁰ Although the overarching question in implied constraint cases is whether the evidence indicates an understanding by the ratifiers of the Constitution that Congress is not permitted to pass certain kinds of legislation, the Court has often seemed to couch its inquiry as a search for constitutional principles.³³¹

Having completed an examination of the historical evidence, structural provisions, and precedent relevant to identifying principles of intellectual property law that the ratifiers of the Constitution likely presumed would restrain Congress, we discuss in the same primarily narrative manner as the Court the principles that we believe are supported by the evidence.

1. *The Suspect Grant Principle*

After examining the evidence presented above, we are struck by the degree to which the framers of the Constitution must have distrusted the institution of governmental grants of exclusive rights. The cost imposed on the public by grants of exclusive rights was not merely the creature of economic speculation but the lived reality of generations of Englishmen.³³² Fully consistent with English legal history, the Clause seems drafted to embody the same narrow exceptions to the bans on exclusive rights found in the Statute of Monopolies and in the Statute of Anne.³³³ The overwhelming weight of the historical and structural evidence pushes us inevitably to the conclusion that the Intellectual Property Clause was included as both a grant of power to Congress and also an absolute limitation of its power. The framers of the Constitution did not intend to give Congress *carte blanche* as far as copyrights and patents were concerned because the potential for mischief was simply too great.

The first principle we identify, the Suspect Grant Principle, is a triggering principle that tells us to what kind of legislation the limiting language contained in the Clause applies. We conclude that the limiting language of the Clause does not apply to all legislation but rather only to *legislation that imposes monopoly-like costs on the public through the granting of exclusive rights*.

The Suspect Grant Principle embodies a pragmatic approach, which seeks to identify legislation the ratifiers of the Constitution would have found especially worrisome. Therefore, concluding that a particular grant imposes "monopoly-like costs" does not require the degree of damage suffered by consumers under an absolute monopoly (commentators agree that few patents, and even fewer copyrights, constitute true monopolies in the strict sense). Instead, we mean more loosely the potential ability of a rights

330. *Printz v. United States*, 521 U.S. 898, 905 (1997).

331. *See supra* note 313 and accompanying text.

332. *See supra* note 186.

333. *See supra* notes 194–95, 205–09.

holder generally to raise prices beyond what they would be in a competitive market for the particular invention or writing at issue. Monopoly-like costs, then, are noncompetitive prices, product scarcity, or reductions in quality caused by the existence of only one producer—in other words, any of the negative consequences of the Elizabethan scheme of which the framers were likely cognizant. In this sense, even a copyright imposes a constitutionally cognizable cost because the owner will often charge more for the copy than if it were in the public domain.³³⁴ History suggests that the framers would have been concerned only about laws that were in reality likely to result in higher consumer prices. Our use of the word “monopoly” seeks to capture the framer’s worries and not the technical definition of antitrust specialists.

Similarly, by “exclusive rights” we do not mean an absolute right to exclude. Such a property right has never existed in Anglo-American law—even rights in real property are subject to the constraints of nuisance law, eminent-domain principles, and various doctrines of emergency use. Rights to exclude exist on a sliding scale, and different types of property are accompanied by different rights to exclude. Because the framers were likely to have been most concerned, in the context of intellectual property, about rights to exclude that significantly constrained access by the public, we will focus primarily on that type of exclusion.³³⁵

This definitional clarification may help to explain the result in the *Trade-Mark Cases*. The trademark legislation at issue did not impose monopoly-like costs on consumers—the courts have frequently pointed out that the primary purpose of trademark legislation is to reduce consumer confusion, undoubtedly to the public benefit.³³⁶ In fact, economic commentators agree that trademark law reduces consumer search costs, provides incentives for the maintenance of product quality, and provides valuable information about product attributes.³³⁷ Trademark rights do not impose monopoly-like costs.³³⁸ Nor did Congress achieve its goal by granting a

334. See Paul J. Heald, *Reviving the Rhetoric of the Public Interest: Choir Directors, Copy Machines, and New Arrangements of Public Domain Music*, 46 DUKE L.J. 241, 244–45 n.22–23 (1996) (calculating cost to choir directors who must buy protected music rather than photocopy public-domain music).

335. We note here that little controversy exists over whether modern copyrights are an example of a constitutionally granted “exclusive right” in spite of an owner’s less than perfect ability to exclude others due to the fair use doctrine, see 17 U.S.C. § 107 (1994), and other statutory exemptions for unauthorized users of a work. See, e.g., 17 U.S.C. § 110 (1994) (limiting right to prevent various educational and religious performances and displays).

336. See, e.g., *The Trade-Mark Cases*, 100 U.S. 82, 87 (1879).

337. See William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265, 269 (1987).

338. In fact, some of the most well-known trademark doctrines are specifically designed to assure that trademark law does not impose monopoly costs. For example, the functionality doctrine prevents the utilitarian aspects of a trademark from being protected. See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164 (1995). And the genericness doctrine assures that useful common words cannot become the property of a single trademark owner. See *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 116 (1938).

In practice, however, the extension of trademark law to protect product configurations and to privilege the use of trademarks on promotional goods may raise the costs of goods to consumers. See *Paul Heald, Sunbeam Products, Inc. v. The West Bend Co.: Exposing the Malign Application of the*

powerfully exclusive right—owners were not granted exclusive rights to a particular word or symbol, only the ability to prohibit a confusing use of it on another's product.³³⁹

The Suspect Grant Principle thus limits the reach of the substantive principles we discuss. The substantive principles are only triggered when Congress enacts a law that imposes monopoly-like costs through the granting of exclusive rights. We do not argue that all suspect grants are invalid, only that they must comply with the principles underlying the Clause discussed below. Although we believe the protection of trademarks does not even trigger scrutiny under our principles, we will nonetheless pay special attention to how trademark protection is consistent with principles we identify.

2. *The Quid Pro Quo Principle*

The evidence we have surveyed uniformly indicates that the framers intended to require Congress to make suspect grants only in a utilitarian form: Congress may grant exclusive rights only if the grant is an attempt to secure a countervailing benefit to the public.³⁴⁰ We refer to this as the Quid Pro Quo Principle. In other words, an author or inventor may not be given something for nothing; the author or the inventor must give the public something it did not have before to earn a grant of exclusive rights from Congress. To stimulate production, Congress may give peanut growers or copper smelters a tax break, but it may not grant a monopoly in peanut production or copper processing. On the other hand, Congress can (and does) reward an inventor who creates a new fungus-resistant strain of peanuts or invents a new copper-recycling process.

We cannot emphasize strongly enough that the historical, structural, and precedential evidence all indicate that legislation creating a suspect grant must be in the form of a bargain: author or inventor creates, then

Federal Dilution Statute to Product Configurations, 5 J. INTELL. PROP. L. 415, 427 (1998) (“Protecting a product configuration under the *Sunbeam* rationale looks much like the grant of exclusive rights afforded by design patent law.”); Paul J. Heald, *Filling Two Gaps in the Restatement (Third) of Unfair Competition: Mixed-Use Trademarks and the Problem with Vanna*, 47 S.C. L. REV. 783, 787–88 (1996) [hereinafter Heald, *Filling Two Gaps*] (“If Ford, the Atlanta Braves, or any other entity whose marks are likely to be attractive on promotional goods, is granted the exclusive right to exploit its marks on such goods, then consumers will pay higher prices than they would in the presence of open competition.”).

339. This is a point that may be new to those unfamiliar with trademark law. The trademark legislation at issue in the *Trade-Mark Cases*, just as at common law, only protected a trademark “owner” from confusing uses of its trademark on similar goods. A wide variety of unauthorized uses are permitted, as long as consumers are not confused. See *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 307–08 (9th Cir. 1992). It is hard to see how such a limited right would give the trademark owner the power to raise prices.

340. See, e.g., *Brenner v. Manson*, 383 U.S. 519, 534 (1966) (noting “[t]he basic quid pro quo contemplated by the Constitution”); Robert A. Kriess, *Patent Protection for Computer Programs and Mathematical Algorithms: The Constitutional Limitation on Patentable Subject Matter*, 29 N.M. L. REV. 31, 60 (1999) (“The Court reads the Constitution as limiting us to a patent system in which there must be a quid pro quo of public benefit in order for a patent to issue.”).

author or inventor gets reward. The key is the legislative assurance that the public will get something for the exclusive rights granted. Congress cannot imitate Queen Elizabeth by granting a monopoly in the making of ale, simply by prefacing the legislation with a statement that it hopes the monopoly will result in the production of more varieties of and better ale. The economic implausibility of such a claim notwithstanding, the framers have already made the call: only the actual production of some consideration by the author or inventor can support a suspect grant. The framers' acute awareness of the dangers of monopoly explains why they would desire such a constraint on the legislative power.³⁴¹

We note that this principle does not authorize a court to invalidate legislation simply because it does not increase wealth. The test is not whether suspect legislation results in an efficient outcome in reality but rather whether Congress has premised protection on the receipt of some consideration from the author or inventor. In reality, we may not need copyright protection for poetry writers to produce the optimum amount of verse for public consumption. We may not need patent protection for auto engine improvements to provide adequate incentives for advances in that market. Certainly, given the average shelf-life of software, the current term of copyright protection for such works (life of the author plus seventy years) is inefficiently long. The entire patent system itself might result in a net loss to society, but bottom-line efficiency is not the issue. The evidence indicates that consistent with English law, the framers' assumption was that allowing Congress to buy creativity through the granting of exclusive rights would probably redound to the benefit of the republic. In making these bargains, Congress need not realize the efficiency norm with every bit of legislation.

Keeping our eye on the *Trade-Mark Cases*, we note that even if trademark protection constituted a suspect grant, the Quid Pro Quo Principle would easily be satisfied. In return for a marginally diminished supply of words to identify products and services,³⁴² the public receives handy mnemonic devices that reduce search costs and provide incentives for the production of high quality goods.

341. See *supra* note 198.

342. Several important trademark doctrines prevent significant erosion of our word supply. First, generic words cannot be used as trademarks. See *Murphy Door Bed Co. v. Interior Sleep Sys., Inc.*, 874 F.2d 95, 97 (2d Cir. 1989) (holding MURPHY generic and unprotectable as a trademark). Second, descriptive words may only be protected when the putative trademark owner can prove that the primary meaning of the words in the minds of consumers is associated with her product. See *Zatarain's, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 791 (5th Cir. 1983). Even when this can be shown, a descriptive mark can always be used by a competitor to honestly describe his goods. See *id.* at 793. Only "fanciful" (KODAK for film), "arbitrary" (IVORY for soap), and "suggestive" (COPPERTONE for sun-tanning products) trademarks are protected without proof of actual consumer recognition. *Id.* at 791. Landes and Posner suggest the costs of this automatic protection are low given the infinite variety of arbitrary, fanciful, and coined symbols available. See Landes & Posner, *supra* note 337, at 273-74.

3. *The Authorship Principle*

A corollary principle, the Authorship Principle, demands that Congress initially direct exclusive grants to those who provide the public with the new creation. Monopolies are not rewards Congress may grant to favored special-interest groups. In order to provide the maximum assurance that the public will receive its due, the actual creator should receive the grant. Before the Statute of Anne, the Stationers' Company, not authors, owned the exclusive rights to print books. In 1710, Parliament saw that one way to end the monopoly was by granting copyright protection directly to authors.³⁴³ Over the following seventy-five years, the notion of copyright as an author's right became firmly established.³⁴⁴ The framers similarly understood that one way to avoid the abuses that occurred under the Stationer's monopoly was to constrain Congress's choices as to who could receive statutory protection. Of course, given the historical practice of recognizing contractual assignments made by authors, it is unlikely that the framers would have meant to constrain congressional recognition of the rights of someone who had purchased an author's rights. In other words, the American Society of Composers, Authors and Publishers (ASCAP) may buy up copyrights in popular music and enforce them, but Congress could not pass a statute granting ASCAP exclusive rights to publish new music in the United States.

We note that history indicates that a companion "inventorship principle" may not be so strong a constraint on Congress. Both *Darcy v. Allin* and the Statute of Monopolies allowed the Crown to grant exclusive rights to a noninventor who proposed to introduce a new product or new process to the benefit of the realm.³⁴⁵ In theory, these grants benefited the public in much the same way as the traditional grant of rights to an inventor of a truly new process; however, they were awarded not to inventors but to capitalists who needed a special economic incentive to set up shop in the United Kingdom. When Congress grants exclusive rights, it must be buying the American public a new creation, but we suggest that the framers may not have ruled out rewarding importers of new inventions. There is no historical support, however, for a similar relaxing of the definition of "author" with respect to copyright protection.

We can think of two analogous instances of loose notions of inventorship in patent law. First, courts have construed the law to provide protection to those who are the first to isolate a natural substance in such a way that "it [becomes] for every practical purpose a new thing commercially and therapeutically."³⁴⁶ Although one can find dicta that "products of nature" or mere "discoveries" are not patentable,³⁴⁷ a difficult to isolate and valu-

343. See BUGBEE, *supra* note 181, at 52–53.

344. See PATTERSON, *supra* note 181, at 151–79.

345. See *supra* text accompanying notes 183–98.

346. *Parke-Davis & Co. v. H. K. Mulford*, 189 F. 95, 103 (S.D.N.Y. 1911) (Hand, J.).

347. See *id.* at 114.

able natural substance can, in practice, be subject to a patent.³⁴⁸ For example, human gene sequences and naturally occurring substances like adrenaline or EPO are thus protectable subject matter under current law.³⁴⁹ Our point is that the first scientist to purify adrenaline did not strictly speaking “invent” it. Nonetheless, if isolating and purifying adrenaline is expensive and difficult, then providing incentives to do so seems to be fully consistent with the underlying principles of the Intellectual Property Clause.

Second, until recently, patent law excluded evidence of foreign inventive activity in priority contests over new inventions.³⁵⁰ This rule favored American inventors who might not have actually been the first to conceive of (and/or reduce to practice) a particular invention. The rule provided strong incentives for those inventing overseas to make early filings in the U.S. Patent Office, thereby hastening the movement of knowledge to our shores. We do not necessarily conclude that the loose definition of “Inventors” embodied in those doctrines is constitutional but only note that it could be justified in light of history in a way that a grant of copyright protection to nonauthors could not be.³⁵¹ Finally, we note that although trademarks have no author in the constitutional sense, the legal protection extended by Congress may only be exercised by its “owner,” the person responsible for creating the initial connection in consumers’ minds between the word or symbol and a good or service.³⁵²

4. *The Public Domain Principle*

The Intellectual Property Clause is designed to encourage a dual benefit through the grant of exclusive rights to authors and inventors: a present benefit in the form of public access to a new work (even though the cost of the new work may reflect a monopoly cost), and a future benefit of free access to the work when it falls into the public domain. The principle of an inviolable public domain is the necessary implication of the constant emphasis in history and in precedent—and in the wording of the Clause itself—on the requirement that grants be for a limited time. At the expiration of the finite term of protection, the public finally receives the full benefit of Congress’s purchase in its name. The Court in *Graham* recognized this principle in the strongest possible terms: “Congress may not authorize the issuance of patents whose effects are to remove existent knowledge

348. See *id.* at 114–15 (upholding patent in purified form of adrenaline).

349. See, e.g., *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200 (Fed. Cir. 1991).

350. See 35 U.S.C. § 104 (1994), amended by 35 U.S.C. § 104 (Supp. IV 1998).

351. In addition to the historical evidence of disparate treatment of authors and inventors, economic arguments support the distinction. Both the framers and English lawmakers might have recognized that securing capital plays a more important role in the production of new machines and industrial processes than it does in the creation of works of art. By the time of the Statute of Anne, the printing industry in England was up and running. Securing authors their rights was all that was necessary to ensure a steady stream of books to the public. Other industries were not present at all, however, and occasional grants to noninventors might have been the most efficient way to assure their introduction.

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

from the public domain, or to restrict free access to materials already available.”³⁵³ In a very real sense, the public owns an invention or a work of art once the patent or copyright has expired. Congress may not unduly restrict the public’s ultimate right to use the work, fairly purchased through the costs incurred during the period of exclusivity.

We should note that the public domain contains two sorts of items: works whose term of statutory protection has expired, and facts, theorems, scientific principles, and laws of nature that have always been freely accessible to the public.³⁵⁴ The public does not purchase the right to facts, theorems, scientific principles, and laws of nature from authors and inventors; it has always been free to use them. We cannot find any evidence in English legal history that the Crown ever asserted the power to grant exclusive rights over such things, and if it did, such a power surely did not survive the Statute of Monopolies. Given the suspicion with which the framers viewed any monopoly, they certainly could not have intended to give Congress the power to grant exclusive rights over facts or theorems. We have every reason to think that the framers considered both sorts of inhabitants of the public domain equally available for any public use. Finally, to the extent that congressional practice is significant, we note that it is only very recently that Congress, feeling the pressure of well-organized special-interest groups, has considered passing legislation that purports to reprivatize facts or works in the public domain.

As a final note on the questions raised by the *Trade-Mark Cases*, we doubt whether the Public Domain Principle poses problems for the protection of trademarks. Words, shapes, and symbols that function as trademarks do not become the exclusive property of anyone. The red triangle that identifies Bass Ale may not appear on an unauthorized bottle of malt beverage, but red triangles remain available for public use in all other contexts.³⁵⁵ We doubt the framers were concerned about the insignificant erosions trademark law makes into the public domain.

5. *The Flexibility Principle*

The language of the Intellectual Property Clause leaves Congress with significant choices to make about the granting of exclusive rights. Congress clearly has a great deal of flexibility in deciding what subject matter qualifies as a “Writing” or “Invention,” in determining the length of copyright

353. *Graham v. John Deere Co.*, 383 U.S. 1, 5–6 (1965).

354. See, e.g., 17 U.S.C. § 102(b) (1994); *Graham*, 383 U.S. at 5–6. See discussion in Kriess, *supra* note 340, at 68–69.

355. Indeed, once an owner abandons a mark — and under 15 U.S.C. § 1127 (1994), a presumption of abandonment of a registered mark arises after two years of nonuse — a competitor may adopt it for its own use on the same product to which it was original affixed. See *Manhattan Indus., Inc. v. Sweater Bee by Banff*, 627 F.2d 628, 629–30 (2d Cir. 1980) (describing fight over KIMBERLY for women’s clothing after its abandonment by General Mills). One of us has criticized the doctrines governing sports logo and trademark dilution because they do limit mark availability in ways not beneficial to the public. See Heald, *Filling Two Gaps*, *supra* note 338, at 787–88.

and patent protection, in establishing an administrative apparatus to process applications for protection, and in creating remedies for infringement of rights. The framers could have spelled out in detail what our system should look like, but instead, they gave Congress broad discretion within the confines of the Clause. A court should not lightly usurp that discretion.³⁵⁶

6. Summary

When the Court addresses the constitutionality of statutes that might plausibly run afoul of the Intellectual Property Clause, it is likely to allow Congress significant flexibility but only within the constraints of four principles of constitutional weight:

1. *The Suspect Grant Principle*: Scrutiny under the Intellectual Property Clause is only triggered when Congress effects a grant of exclusive rights that imposes monopoly-like costs on the public;
2. *The Quid Pro Quo Principle*: A suspect grant may only be made as part of a bargained-for exchange with potential authors or inventors;
3. *The Authorship Principle*: A suspect grant must initially be made to either the true author of a writing or to the party responsible for a new advance in the useful arts;
4. *The Public Domain Principle*: A suspect grant may not significantly diminish access to the public domain.

If we have correctly analyzed the Court's interpretive methodology in cases involving implied constitutional restraints, then these four principles will guide its decisions regardless of the constitutional provision under which Congress purports to act. The principles are thus applicable to Congress's exercise of its Commerce Clause or treaty powers as well as its Intellectual Property Clause power, but we do not expect them to be any more determinative in individual cases than the principles that drive the Court's Tenth or Eleventh Amendment jurisprudence. They will merely frame the Court's rhetoric, providing the shape for the arguments that the Court will find most persuasive. As a final exercise, we will apply our principles to a number of recent intellectual property statutes questioned by various commentators.

IV. APPLICATION TO RECENT INTELLECTUAL PROPERTY LEGISLATION

During the last twenty-five years, Congress has actively expanded the scope of rights in intellectual and industrial property.³⁵⁷ Although we will

356. See *McClurg v. Kingsland*, 42 U.S. (1 How.) 202, 206 (1843) (“[T]he powers of Congress to legislate upon the subject of patents is plenary by the terms of the Constitution.”). But see *Graham*, 383 U.S. at 6.

357. See, e.g., 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 (1996) (noting expansion of copyright law); James Boyle, *Is Congress Turning the Internet into an In-*

discuss one important expansion that occurred before 1970,³⁵⁸ all the other potentially suspect grants are of recent vintage. For this reason, the Court has never had to define the extent to which the Intellectual Property Clause constrains Congress's general legislative power—until recently, Congress has taken the internal limits of the Clause seriously.³⁵⁹ In response to interest-group pressure, however, and in the dearth of organized defenders of the public interest,³⁶⁰ Congress has recently begun to push the limits of the Clause.³⁶¹

Our paper provides a framework within which to evaluate these recent extensions of protection. Unlike some commentators, however, we do not believe that all of the recent expansions are unconstitutional. We will begin with the legislation we believe to be most problematic under our principles, then address legislation that is somewhat less troublesome, and conclude with explanations of why other criticized statutes are constitutional.

A. *Unconstitutional Grants of Rights*

In light of the principles discussed above, at least two copyright statutes and one hotly contested piece of proposed database legislation are very likely unconstitutional.

1. *Copyright Term Extension*

In 1998, Congress extended the term of protection for new works from life-of-the-author plus fifty years to life-of-the-author plus seventy years.³⁶² Protection for existing works, whose terms had not yet expired, was extended from seventy-five years from the date the copyright was initially secured to ninety-five years from that date.³⁶³ As a result, no more works will fall into the public domain until 2018. We analyze the prospective and retrospective aspects of the term extension separately.

formation Toll Road?, INSIGHT, Jan. 15, 1996, at 24 (criticizing legislative proposals to expand intellectual property rights).

358. See *infra* notes 362, 396, 417.

359. Note that the dearth of statutes going beyond the internal limits of the Intellectual Property Clause until very recently might itself be evidence of the unconstitutionality of such statutes. See *supra* text accompanying notes 139–44. As we noted previously, the few early statutes that extend copyright protection beyond the limits of the Clause are distinguishable. See *supra* text accompanying notes 254–68. Finally, patent extensions on individual patents are not relevant because the history of patent grants differs from the history of copyright grants. See *supra* text accompanying notes 345–51.

360. But see Digital Future Coalition, (visited Nov. 1, 2000) <<http://www.dfc.org>>.

361. See Jaszi, *supra* note 357, at 607–09.

362. See 17 U.S.C. § 302(a) (1994 & Supp. IV 1998).

363. See *id.* § 304(b). The reason for the two provisions was that copyrights in works published before 1976 received a term of protection set at 75 years, but works published thereafter are protected 50 years beyond the life of the author. See *id.* §§ 302(a), 304(b) (1994). The two retroactive schemes were identical in effect, however, and we will therefore limit our discussion to the fixed term provision.

a. Retroactive Application

George Gershwin composed *Piano Concerto in F* in 1925.³⁶⁴ At the time he wrote it, he assumed that his compositions would be protected by copyright law for an initial period of twenty-eight years, renewable for twenty-eight additional years.³⁶⁵ In other words, when he went to sell his new work, he and the music publishing company understood that the right to copy and perform the song could potentially produce an income stream for a maximum of fifty-six years. In 1925, both he and the publisher thus assumed that the work would belong to the public no later than 1981, when anyone would be free to reproduce or record it. In 1976, however, Congress extended the term of protection for unexpired works to a maximum of seventy-five years, pushing to the year 2000 the entrance of *Piano Concerto in F* into the public domain.³⁶⁶ Under the new Copyright Term Extension Act of 1998 (CTEA),³⁶⁷ which extended the grant for an additional twenty years, the song now will not fall into the public domain until 2020 at the earliest.³⁶⁸ The two extensions together provide thirty-nine extra years of income to the copyright owner, a windfall that could not have been anticipated by either Gershwin or the publisher who bought his song.

It is difficult to imagine a more overt violation of the Quid Pro Quo Principle than CTEA. The retroactive extension of the copyright term cannot possibly provide any incentive for Gershwin—or even a living author—to create an already existing work. Granting exclusive rights in musical compositions imposes monopoly-like costs,³⁶⁹ and when Congress makes such a suspect grant it must attempt to purchase a new work. The framers' awareness of the English experience that led to the Statute of Monopolies and the Statute of Anne, and their recognition of the very real cost of granting exclusive rights, drove their decision to prohibit Congress from treating favored interest groups like modern-day courtiers.³⁷⁰ A retroactive grant of copyright protection cannot “promote the Progress of Science” in the way intended by the framers of the Constitution.³⁷¹

In fact, the term extension looks very much like the same sort of abuse condemned by Parliament and the English courts in the two centuries before the Constitutional Convention. Queen Elizabeth granted a number of monopolies to successful courtiers.³⁷² These grants had two primary effects: the exclusive right guaranteed an income stream to the lucky recipient, and

364. See DANIEL T. POLITOSKE, *MUSIC* 480 (5th ed. 1992).

365. See Copyright Act, ch. 320, § 23 (1904) (amended 1976).

366. See 17 U.S.C. § 302 (1994), amended by 17 U.S.C. § 302 (Supp. IV 1998).

367. Sonny Bono Copyright Term Extension Act, Pub. L. No. 105-298, tit. I, sec. 101, § 101, 112 Stat. 2827, 2827 (1998) (codified as amended in scattered sections of 17 U.S.C. (Supp. IV 1998)).

368. See 17 U.S.C. § 302(a) (1994 & Supp. IV 1998).

369. See Heald, *supra* note 334, at 244–45 n.22–23 (1996) (calculating cost to choir directors who must buy protected music rather than photocopy public-domain music).

370. See *supra* notes 182–235 and accompanying text.

371. U.S. CONST. art. I, § 8, cl. 8.

372. See *supra* notes 183–85 and accompanying text.

it resulted in higher prices paid by consumers. Sometimes, perhaps, a grant also resulted in a public benefit. It is possible that the recipient of the monopoly in ale reinvested some of his profits into developing a better tasting beer, or maybe a Stationers' Company member who received a printing patent used his profits to lower production costs or to print new books. We note, however, that the mere potential for public benefit was not enough to save the practice from legal condemnation of the most famous sort. The history of the abusive granting of exclusive rights in England provides one of the clearest examples of the sort of governmental regime the framers were determined to escape.³⁷³ The Intellectual Property Clause restrains Congress by the same means the English courts restrained the monarchy: it mandates that an exclusive right be granted only as the purchase price for a new invention or writing.

CTEA has precisely the same effects as the Elizabethan grant of a monopoly in ale or printing. It guarantees an income stream to a favorite of the legislature, in this case ASCAP, Disney, the Association of American Publishers, the Motion Picture Association of America, and the Music Publishers Association, among others.³⁷⁴ It also results in higher prices to consumers by mandating a significant transfer payment from them to copyright owners for a twenty-year period of time. Although it is entirely possible that the recipients of the income stream will do something beneficial with their extra profit, this possibility is as irrelevant now as it was in 1623 and 1709. Congress must buy American citizens something when it imposes monopoly-like costs upon them.³⁷⁵ The retroactive application of the copyright term is a legislative gift of public funds that makes no attempt whatsoever to assure that the funds are used to purchase something for the people.

The legislative history of CTEA reveals either Congress's fundamental misunderstanding of the scope of its powers under the Intellectual Property Clause or deliberate obfuscation of its real motivation. None of the reasons offered in the Report of the Senate Judiciary Committee³⁷⁶ indi-

373. See *Graham v. John Deere Co.*, 383 U.S. 1, 7 (1965) (noting Americans' "instinctive aversion to monopolies. It was a monopoly on tea that sparked the Revolution"). Others have noted the connection between the East India Company tea monopoly and the uprising in Boston. See Rachel V. Leiterman, Comment, *Smart Companies, Foolish Choices? Product Designs that Harm Competitors*, 15 SANTA CLARA COMPUTER & HIGH TECH. L.J. 159, 161 (1999).

In 1773 in Boston, colonists protested the King's grant of a monopoly to the East India Company by dumping tea into Boston Harbor. The events in Boston eventually led to the American Revolution, "causing many historians to cite antimonopoly sentiments as one of the roots of the struggle for American independence."

Id. (footnote omitted).

374. These, among others, are amici urging the constitutionality of the act in recent federal litigation. See Brief on Behalf of the Sherwood Anderson Literary Estate Trust, et al. at 1, *Eldred v. Reno*, 74 F. Supp. 2d 1 (D.D.C. 1999) (No. 99-0065), available at <http://cyber.law.harvard.edu/eldredreno/amicus_br.pdf>. Eldred and his co-plaintiffs claim the right to use works that would have fallen into the public domain but for CTEA. See *id.* at 30, 39. They make several arguments consistent with ours that CTEA is unconstitutional. See *id.* at 23-43. The case is currently on appeal to the D.C. Circuit.

375. See *supra* notes 254-68, 287-325 and accompanying text.

376. S. REP. NO. 104-315 (1996).

cates an intent on the part of Congress to buy the public new works with the public-to-publisher income stream it mandates.³⁷⁷ The report discusses the need for harmonization with the world's copyright laws by suggesting that because the European Community has moved to life-of-the-author plus seventy years, so should America.³⁷⁸ The desire to cooperate with the international community may be a worthy goal, but it is not a blanket justification for passing otherwise unconstitutional legislation. For instance, granting Heineken the exclusive right to brew beer in the United States might help our relations with Holland, but Congress could not make such a grant. It is also hard to see CTEA as even indirectly designed to provide creative incentives for American authors by increasing protection of their rights in overseas markets. First, the statute makes no mention of minimum standards of protection that our trading partners must maintain. Second, the statute applies retroactively to the work of not only foreign authors but also American ones.³⁷⁹ Even if international harmony were a permissible justification, it is difficult to see how it is advanced by awarding retroactive protection to local interests in addition to foreign ones. No foreign nation is demanding we protect Gershwin's *Piano Concerto in F* (or Mickey Mouse) for another twenty years.

Second, the Committee report suggests that the recipients of the newly mandated income stream might use the money to create new works.³⁸⁰ In other words, the Committee recognized quite perceptively that the legislation is in the form of gift-plus-hope, not quid pro quo. The framers were far too sensitive to the dangers posed by exclusive grants of rights to have authorized Congress to engage in the gift-plus-hope form of grant. Only the quid pro quo form of legislation minimizes the cost of exclusive rights by trying to guarantee the public some return for its expenditure. Similarly, the report expresses the hope that some of the lucky recipients of the twenty-year income stream will use their additional profits to restore or disseminate older works.³⁸¹ Again, this may be a worthy goal, which might be advanced by any number of different forms of legislation, but constitutionally it may not be achieved through the granting of exclusive rights that impose monopoly costs on consumers.

We note again, lest we be misunderstood, that the Quid Pro Quo Principle does *not* "require that each copyrighted work be shown to pro-

377. See *id.* 6–17.

378. See *id.* at 7–8.

The purpose of the bill is to ensure adequate copyright protection for American works in foreign nations and the continued economic benefits of a healthy surplus balance of trade in the exploitation of copyrighted works. The bill accomplishes these goals by extending the current U.S. copyright term for an additional 20 years. Such an extension will provide significant trade benefits by substantially harmonizing U.S. copyright law to that of the European Union while ensuring fair compensation for American creators who deserve to benefit fully from the exploitation of their works.

Id. at 3.

379. See 17 U.S.C. § 304 (Supp. IV 1998).

380. See S. REP. NO. 104-315, at 12–13.

381. See *id.*

mote the useful arts.”³⁸² Congress hardly can be expected always to make good purchases for us. One might argue, as the plaintiffs did in *Mitchell Brothers Film Group v. Cinema Adult Theater*,³⁸³ that Congress has not advanced the public interest by providing pornographers with copyright protection.³⁸⁴ But choosing the type of work to encourage through the granting of exclusive rights is a decision that the Intellectual Property Clause leaves to Congress. What is important is the form of the legislation: the Quid Pro Quo Principle requires that when Congress grants exclusive rights it must do so in the form of a purchase, not a gift. What is purchased, of course, may not always be a good or valuable thing.

b. Prospective Application

Under the term extension legislation, copyright protection for works created after January 1, 1978 is life-of-the-author plus seventy years.³⁸⁵ At first glance, this would seem to satisfy both the Quid Pro Quo and the Public Domain Principles. In the absence of another legislative extension, all works created under the new regime will eventually fall into the public domain. If we focus on the likely intent of the framers of the Constitution, however, it becomes harder to see how protection of such length can be harmonized with the principles underlying the Intellectual Property Clause. We know that the notion of limited terms of protection is pervasive throughout English history, colonial history, practices under the Articles of Confederation, the history of the Constitutional Convention, and the early practice of Congress.³⁸⁶ The difficulty is determining whether anything other than an outright grant of an eternal patent or copyright would violate the public domain principle as embodied in the limited times requirement of the Clause. To put the question pointedly, could Congress constitutionally enact a 100-billion-year copyright or patent term?³⁸⁷

Given the seriousness with which the framers viewed the granting of exclusive rights, it is unlikely that they intended the limited-time provision to be rendered a dead letter by linguistic manipulation. Merely acknowledging that “limited” should be interpreted more narrowly than “finite,” however, does not provide us with a standard to measure whether life-of-the-author plus seventy years is “limited” or constructively infinite.

One way to approach this difficult question might be to look at the values underlying the Quid Pro Quo Principle as an aid in interpreting the

382. *Schnapper v. Foley*, 667 F.2d 102, 112 (D.C. Cir. 1981) (explaining Clause does not forbid Congress from granting copyright protection to works commissioned by the federal government; citing *Mitchell Bros. Film Group v. Cinema Adult Theater*, 604 F.2d 852, 860 (5th Cir. 1979) (explaining Clause does not prevent Congress from granting copyright protection to pornographic films)).

383. 604 F.2d 852 (5th Cir. 1979).

384. *See id.* at 854–55.

385. *See* 17 U.S.C. § 302 (Supp. IV 1998).

386. *See supra* notes 75–144 and accompanying text.

387. *See Goldstein v. California*, 412 U.S. 546, 560 (1973) (stating in dicta that the limited times provision constrains Congress).

limited time provision. In this way, one might argue that a grant of exclusive rights is constructively unlimited, and therefore unconstitutional, if it is not reasonably calculated to purchase new creativity. Conversely, if a term of copyright protection can even plausibly be understood to stimulate some creativity, it should stand. Again, we emphasize that Congress need not discover and implement the optimal length of protection. It may choose a less than perfectly efficient term (we suspect, for example, that the optimal term for the protection of computer software is much shorter than even the former fourteen-year term), but Congress must try to stimulate at least some new creative activity when it extends the term of protection.

Actuarial evidence suggests that extension of protection from life-of-the-author plus fifty to life-of-the-author plus seventy cannot possibly stimulate the creation of any new works. Martha Luehrmann of the Lawrence Berkeley National Lab crunched some numbers in response to the assertion that it would.

[T]he current value to the creator (or publisher, or anyone) of an extra 20 years 50–80 years in the future is absolutely negligible. . . .

If we make the assumption that we will receive [\$]10,000 per year in royalties from our work, and that the risk is such that a bank would give us a loan at about 10% based on the prospective stream of income, then the current value to us of the entire income stream from now (at creation) to 50 years is \$99,000. If we tack on another 30 years of copyright, still at \$10,000 per year of royalties, the additional value of the added thirty years to me, looking from year zero, is only another \$803. If we tack on yet another 20 years worth of royalties, because of the powerful effect of discounting on income so far into the future, the additional value of the entire added 20 years is only \$42.

AND, that assumes that 10% is a reasonable discount rate considering the risk involved [in the assumption] that you will still be receiving that [\$]10,000 per year fifty, eighty, and even 100 years into the future. My guess is that a more reasonable rate would be 30%, not 10%. At 30% the current value to us of the entire income stream from now to 50 years is \$33,330. Tacking on another 30 years adds absolutely zero to that value. Tacking on a further 20 years of course also adds nothing to that value.

Basically, adding another twenty years to the end of the copyright life does nothing from the point of view of either the author or the publisher at year zero. It cannot have any measurable effect on raising the number of works authored. Where it DOES have an affect [sic] though is to the copyright holder whose copyright is about to expire. If my copyright is about to expire, adding another 20 years of our hypothetical case is worth an additional \$33,160. Not an amount to sneeze at.

But adding that 20 years buys the public nothing. It cannot affect the rate of the production of new works. It cannot even give publish-

*ers of new works an added incentive to publish. It just gives a wind-fall to those who hold expiring copyrights.*³⁸⁸

If she is correct, then in the sense of the word most relevant for implementing the framer's intent, the term of life-of-the-author plus seventy years is unlimited. We will not attempt to guess at what precise point an additional length of protection ceases to stimulate creativity, because we believe Congress should have great flexibility in making the economic assumptions that drive that inquiry. It is clear, however, that the current length of protection cannot possibly be designed to stimulate creativity and, in fact, was probably not intended to.³⁸⁹

c. Term Extension and Political Accountability

Another approach may illustrate why CTEA is inconsistent with principles underlying the Intellectual Property Clause. So far, we have discussed two legislative forms through which Congress might direct public monies to the copyright industry. In the first, the quid pro quo form, Congress purchases the public new works by granting exclusive rights to creators. In the gift-plus-hope form, Congress grants exclusive rights to copyright owners, hoping that the funds generated by the grant will be used to create new works.

We have argued that the history and structure of the Intellectual Property Clause indicate that only the first (quid pro quo) form of grant is constitutional, but we have yet to mention a third and clearly constitutional method by which Congress can direct public monies to the copyright industry: outright subsidies. If Congress wants the motion picture industry or Disney or ASCAP or starving poets to have more resources without requiring them to create new works, it can tax the public and send the proceeds directly to the favored group. This form of legislation has essentially the same result as the gift-plus-hope grant of exclusive rights but is clearly constitutional under established doctrines upholding Congress's right to grant subsidies under the Spending Clause.³⁹⁰ In other words, our interpretation of the Intellectual Property Clause does not tie Congress's hands, but

388. Jerome N. Epping, Jr., *Harmonizing the United States and European Community Copyright Terms: Needed Adjustment or Money for Nothing*, 65 U. CIN. L. REV. 183, 214–15 n.192 (1996) (quoting the posting of Martha Luehrmann, Re: actuaries and copyright, to cni-copyright@cni.org (Apr. 25, 1996)) (emphasis added); see also Open Law: Extension Value (visited Oct. 21, 2000) <<http://eon.law.harvard.edu/cgi-bin/opencode/extension.cgi>> (demonstrating the value of copyright extension with a calculator, which makes the same point as Luehrmann and allows you to play with the number).

389. Cf. 144 CONG. REC. H9951–52 (daily ed. Oct. 7, 1998) (statement of Hon. Mary Bono). Sonny wanted the term of copyright protection to last forever. I am informed by staff that such a change would violate the Constitution. I invite all of you to work with me to strengthen our copyright laws in all of the ways available to us. As you know, there is also Jack Valenti's proposal for a term to last forever less one day. Perhaps the Committee may look at that next Congress.

Id. at H9952.

390. See *National Endowment for the Arts v. Finley*, 524 U.S. 596, 587 (1998); cf. *South Dakota v. Dole*, 483 U.S. 203, 207 (1987) (stating that congressional spending must be in pursuit of the general welfare).

rather forces Congress to adopt a different form of legislation to achieve a gift-plus-hope objective.

The Court has indicated, at least in the context of the Tenth Amendment,³⁹¹ that the form of legislation may be critical to realizing values of political accountability and participation built into the Constitution—values that are clearly at stake in legislation like CTEA. When Congress subsidizes an industry under its taxing and spending power, the spotlight of public scrutiny is securely on the legislative chambers in Washington. Subsidies are normally subject to intense debate and criticism—the precise amount of the funds directed from taxpayer to industry is known, and it is easy to identify who is responsible for the transfer of taxpayer resources. In fact, in the Dormant Commerce Clause context, the Court has suggested that the openness of legislative debate over whom to subsidize out of general-revenue funds enhances the potential constitutionality of an otherwise suspect state statute.³⁹² One would imagine, for example, significant political accountability in a congressional vote over whether to subsidize Disney or ASCAP with taxpayer dollars.

The problem with the form of the term-extension legislation should now be evident. It has the same effect as a direct subsidy to Disney or ASCAP but takes a form that diminishes public awareness of the effect of the law and therefore erodes political accountability.³⁹³ Congress has directed a twenty-year income stream of taxpayer dollars to a favored industry with no single consumer suffering so much at any particular moment to raise the alarm. This runs counter to every precaution the framers took to ensure legislative accountability. Congress may subsidize Disney and ASCAP if it wants to, but it must do so out in the open so that the public can clearly see where its dollars are flowing.

The Audio Home Recording Act³⁹⁴ is an example of a constitutionally valid gift-plus-hope statute. As new digital technology was developed that would enable consumers to make multiple copies of a recording with no diminution of quality, the recording industry and the electronics industry engaged in a heated debate over the legality of such technology. The electronics industry wanted to manufacture and sell DATs (digital audio tapes) and DAT-recorders and, later, recordable CDs. The recording industry was justifiably worried that such devices would cut into its profits. The Audio Home Recording Act³⁹⁵ legalizes the devices (and the media, such as DATs or recordable CDs) but requires the manufacturer or importer to

391. See *New York v. United States*, 505 U.S. 144, 168–69 (1992) (comparing the effects of various federal regulatory schemes upon the accountability of state and federal officials).

392. See *West Lynn Creamery, Inc. v. Healy*, 512 U.S. 186 (1994) (striking down Massachusetts law that taxed all milk sold in the state and mandated that the proceeds be spent to support local milk producers, and suggesting that if the proceeds had been directed to the state's general revenue fund, the subsidy would have been constitutional). This case is consistent with Justice O'Connor's discussion of political accountability in *New York v. United States*, 505 U.S. 144, 168–69 (1992).

393. The vote on CTEA was virtually unanimous and the Act was passed with little debate.

394. 17 U.S.C. §§ 1001–1010 (1994).

395. *Id.*

deposit a specified royalty payment into a fund that is then distributed to various copyright holders in the recording industry.³⁹⁶ Congress has thus taxed one group and subsidized another, a compromise between two influential interest groups that could not be slipped past an unsuspecting public.

2. Database Protection

After the Court held, in *Feist Publications, Inc. v. Rural Telephone Service Co.*,³⁹⁷ that the telephone white pages, and by implication other “unoriginal” compilations of facts, could not be protected by copyright law,³⁹⁸ Congress began considering legislation to overturn the decision, using its powers under the Commerce Clause.³⁹⁹

As a practical matter, the *Feist* doctrine still provides substantial protection to those who collect databases. For example, the producer of a directory listing Chinese businesses in New York City was able to enjoin a competitor from copying his collection of facts when he demonstrated the creative choices he made in determining which businesses to include in his list.⁴⁰⁰ An older case, fully consistent with *Feist*, protects the creative choices made in assembling a list of the best restaurants in the United States.⁴⁰¹ It would seem well within the purview of Congress’s power under the Intellectual Property Clause to protect the creative choices made by database compilers, as opposed to protecting the underlying facts themselves. The opinion in *Feist* does an admirable job of explaining what Congress may and may not protect.⁴⁰²

Protection for selection and arrangement, however, was not deemed sufficient by those who have since been lobbying Congress for the right to exclude competitors from the underlying facts themselves. One proposed statute, typical of recent proposals, would protect unoriginal compilations, even against someone who merely “extracts” or “makes available to others” the facts compiled.⁴⁰³ The latest proposed bill protects “facts, data, works of authorship, or any other intangible material capable of being collected and organized in a systematic way”⁴⁰⁴ from the extraction of “all or a

396. See *id.* §§ 1003–1006.

397. 499 U.S. 340 (1991).

398. See *id.* at 363–64.

399. See *supra* notes 383–86 and accompanying text.

400. See *Key Publications, Inc. v. Chinatown Today Publ’g Enters., Inc.*, 945 F.2d 509, 514 (2d Cir. 1991).

401. See *Adventures in Good Eating v. Best Places to Eat*, 131 F.2d 809, 812 (7th Cir. 1942).

402. 499 U.S. at 350–53 (1991).

Facts, whether alone or as part of a compilation, are not original and therefore may not be copyrighted. A factual compilation is eligible for copyright if it features an original selection or arrangement of facts, but the copyright is limited to the particular selection or arrangement. In no event may copyright extend to the facts themselves.

Id. at 350–51.

403. See H.R. 354, 106th Cong. (1999).

404. *Id.*

substantial part of a collection of information gathered.”⁴⁰⁵ An extractor, or someone “who makes [a database] available to others,” is liable if he causes “material harm to the primary or a related market” of the database compiler.⁴⁰⁶

As an illustration of the potential operation of the statute, consider that most airlines have established websites allowing Internet access to massive amounts of flight information.⁴⁰⁷ Customers are encouraged to book flights directly on-line from the airline, thereby eliminating the need for the airline to pay a fee to an independent booking agent, often a travel agent. Currently, travel agents can extract (via download) or make available (by browsing the airline’s website) these collections of information in the course of offering their services to customers. Under *Feist*, the information on airline websites—a collection of facts organized by flight origin, destination, departure and arrival time, and price—would arguably be unoriginal and therefore unprotectable.⁴⁰⁸ Under the proposed database bill, however, it would probably be illegal for a travel agent to offer booking services by using the flight facts collected by the airline without the airline’s permission. Similarly, it would be a violation for an independent real-estate agent to take and use information concerning houses for sale collected by other agents and placed (as in Athens, Georgia) in the Sunday paper or in kiosks around town. Given the difficulty (or impossibility) of gathering this information independently, one can clearly see how protecting facts from exploitation raises the cost of information, rendering *sui generis* database protection a suspect grant.

Several commentators have already suggested that the Intellectual Property Clause constrains Congress from legislating this result.⁴⁰⁹ From our perspective, the primary problem with the proposed legislation is its

405. *Id.* The prior version of this bill defined “substantiality” in both quantitative and qualitative terms. The bill makes it clear that repeated extraction of individual bits of data is actionable, suggesting that a “substantial part” is measured qualitatively and could be quite small in relation to the whole. *See id.*

406. *Id.*

407. *See, e.g.,* Delta Airlines (visited Oct. 21, 2000) <<http://www.delta.com/home/index.jsp>>.

408. *See Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 362–63 (1991) (holding ordering and arrangement of white pages unoriginal as being “mechanical,” “routine,” “practically inevitable,” “entirely typical,” “garden variety,” and “obvious”).

409. *See Dreyfuss, supra* note 7, at 230 (“Restrictions on constitutional grants of legislative power, such as the Copyright clause, would be meaningless if Congress could evade them simply by announcing that it was acting under some broader authority.”); Heald, *supra* note 313, at 168–75; Patry, *supra* note 7, at 361 (“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.”); Pollack, *supra* note 7, at 60 (“Congress may not do an end run around a limitation in one clause of the Constitution by invoking a more general clause . . .”). *But see* Jane C. Ginsburg, *No “Sweat”? Copyright and Other Protection of Works of Information After Feist v. Rural Telephone*, 92 COLUM. L. REV. 338, 367–74 (1992); Michael B. Gerdes, Comment, *Getting Beyond Constitutionally Mandated Originality as a Prerequisite for Federal Copyright Protection*, 24 ARIZ. ST. L.J. 1461 (1992); Phillip H. Miller, Note, *Life After Feist: The First Amendment, and the Copyright Status of Automated Databases*, 60 FORDHAM L. REV. 507 (1991); Anant S. Narayanan, Note, *Standards of Protection for Databases in the European Community and the United States: Feist and the Myth of Creative Originality*, 27 GEO. WASH. J. INT’L L. & ECON. 457 (1993–94).

conflict with the Public Domain Principle.⁴¹⁰ As the Court explained in *Feist*, facts have historically been considered to form a critical part of the public domain, available for anyone to use. Current doctrine protects a compilation of facts from copying to the extent that it evidences some originality in its arrangement, selection, or coordination, but the raw facts themselves must remain available for anyone to exploit.⁴¹¹ To the extent that the bill creates exclusive rights in facts themselves, the history and structure of the Intellectual Property Clause militate against Congress's power to grant such a right.⁴¹²

The fact that the bill exempts independent researchers⁴¹³ does not significantly diminish the conflict with the Public Domain Principle. Neither American nor English law has ever recognized an *absolute* right to exclude,⁴¹⁴ so our inquiry into whether the proposed database legislation constitutes a suspect grant must focus on the relative degree of a database compiler's ability to exclude others. In the database context, the exemption for independent research is unlikely to reduce significantly the database compiler's ability to exercise sole control over his facts. Referring back to our examples, we wonder whether a travel agent would have any effective way to research independently the times, origins, destinations, and prices of all of an airline's domestic and international flights. Using the facts of *Feist* as another example, could a rival white-pages publisher realistically be expected to canvass a phone district door-to-door to compile a competing list of names, addresses, and phone numbers? Or could a real-estate agent independently discover which houses are for sale and at what price? In theory, independent research is always possible, but in practice, extraction from another's compilation is often the only realistic option. Although the legislation does not by its terms absolutely privatize facts, it travels far enough down that road to trigger the application of the principles that underlie the Intellectual Property Clause.⁴¹⁵

410. See Heald, *supra* note 313, at 149–51. Heald has argued elsewhere that the Quid Pro Quo Principle might be satisfied by appropriately drafted database legislation. See Heald, *supra* note 313, at 158.

411. See *Feist*, 499 U.S. at 350–53.

412. We discuss the opinion in *Feist* as bearing on whether database protection offends the Public Domain Principle. The opinion itself speaks in terms of a constitutional “originality requirement” that we (and the Court) see as a vehicle for protecting the public domain. See *Feist*, 499 U.S. at 345–46. We avoid arguing that originality per se is always constitutionally required because we find little evidence in history concerning the qualities a printed work must have had (if any) to be protected under the Statute of Anne. For this reason, we prefer to look directly at whether the proposed bill threatens the public domain.

413. “Nothing in this chapter shall restrict any person from independently gathering information or making available information obtained by means other than extracting it from a collection of information gathered, organized, or maintained by another person through the investment of substantial monetary or other resources.” H.R. 354, 106th Cong. (1999).

414. See *supra* text accompanying note 335.

415. We note also that extraction of “an insubstantial part of a collection of information” is permitted under the proposal. H.R. 354, 106th Cong. (1999) (proposed 17 U.S.C. § 1403(c)). Although this clearly provides a narrow safe harbor for some extractors, we still believe that the proposal seeks to establish exclusive rights in the constitutional sense. The fair use doctrine establishes a similar safe harbor within copyright law. See 17 U.S.C. § 107 (1994). No one has suggested, however, that copyright protection is not the grant of an exclusive right in the constitutional sense.

By contrast, consider a portion of the bill that is almost certainly constitutional under our analysis: one section of the proposed legislation would protect “time sensitive” information, such as news, from a competitor who frequently engages in misappropriation.⁴¹⁶ If this means that only a few hours of postpublication protection is available, as in the *INS* case,⁴¹⁷ then it is harder to see this as a right exclusive enough to constitute a suspect grant. Even if it were, the threat to the public domain seems minimal because a competitor could extract and use the reported facts later the same day. The primary thrust of the rest of the bill, however, would raise the cost of using some facts so significantly that a constitutionally cognizable harm to the public domain would result.

3. *Restoration Act*

In 1994, Congress for the first time revived copyright protection for some works that had fallen into the public domain.⁴¹⁸ In response to international pressure, Congress granted protection to foreign authors whose works had fallen into the public domain in the United States due to non-compliance with copyright formalities under the 1909 Copyright Act (such as failure to file an application for renewal or to attach proper notice on the first published copy),⁴¹⁹ or due to lack of national eligibility.⁴²⁰ If a work meets these criteria, upon proper application to the Copyright Office⁴²¹ its new term of protection in the United States will extend as long as if it had never fallen into the public domain.⁴²² The statute also makes special provision for foreign sound recordings published before 1972,⁴²³ even though American recordings made before that time were not protected. The restoration legislation has already been used to acquire new protection for the drawings of M.C. Escher⁴²⁴ and photographic stills from Godzilla movies.⁴²⁵

416. See H.R. 354, 106th Cong. § 1403(e) (1999) (proposed 17 U.S.C. § 1403(f)).

Nothing in this chapter shall restrict any person from extracting or using information for the sole purpose of news reporting on any subject, including news gathering, dissemination, and comment, unless the information so extracted or used is time sensitive and has been gathered by a news reporting entity, and the extraction or use is part of a consistent pattern engaged in for the purpose of direct competition.

Id.

417. 248 U.S. 215 (1918).

418. See 17 U.S.C. § 104A (1994).

419. See *id.* § 104A(h)(6)(C)(i).

420. See *id.* § 104A(h)(6)(C)(iii). For example, for many years, Russian nationals received no copyright protection in the United States. See *Shostakovich v. Twentieth Century-Fox Film Corp.*, 80 N.Y.S.2d 575, 577 (Sup. Ct. 1948) (denying composer's claim that in the absence of copyright protection he was nonetheless entitled on moral-rights grounds to an injunction preventing exploitation of his music).

421. See 17 U.S.C. § 104A(e) (1994 & Supp. IV 1998).

422. See *id.* § 104A(a)(1)(B).

423. See *id.* § 104A(h)(6)(C)(ii).

424. See *Cordon Art B.V. v. Walker*, 40 U.S.P.Q.2d 1506, 1507 (S.D. Cal. 1996).

425. See *Toho Co. v. William Morrow & Co.*, 33 F. Supp. 2d 1206, 1218 (C.D. Cal. 1998).

The Restoration Act⁴²⁶ may be subject to challenge under either the Public Domain Principle or the Quid Pro Quo Principle. We believe, however, that in light of Congress's need for flexibility, only the Quid Pro Quo Principle presents serious problems. Although this statute takes some works out of the public domain, Congress needs substantial latitude to set the time term for copyright protection and to establish the requisite administrative steps, if any, one must take to obtain the benefit of federal protection. In other words, it can control to a large extent how and when works enter the public domain. We noted earlier that in the constitutional sense, the public domain is primarily inhabited by two sorts of items: works of authorship whose term of protection has expired and items that can never be subject to copyright protection at all, like facts, ideas, and theorems. Although the "restoration" of copyright protection for either of these items in the public domain would raise grave constitutional concerns, the Copyright Restoration Act instead aims to protect a different set of works: those that fell into the public domain for technical or administrative reasons.⁴²⁷ It grants protected status to works that are essentially a windfall to the public, works that would still be protected but for the failure of the author to file a paper, to add a date or a symbol to a copy of a work, or to be born in a country maintaining adequate treaty relations with the United States.⁴²⁸ Congress created these technicalities, which redounded to the benefit of the public; we believe Congress can waive them if it chooses without violating the Public Domain Principle. We do not believe that the history and structure of the Clause establish a constitutional right on the part of consumers to take advantage of administrative technicalities.⁴²⁹

On the other hand, the legislation may not satisfy the Quid Pro Quo Principle. All the works subject to restoration already exist. The public will certainly pay higher prices as a result of the granting of exclusive rights in restored works. For example, the price of newly protected Escher prints and posters will surely rise now that the Escher estate has a monopoly over the sale of new copies of the famous graphic artist's work. What does the public receive in return? Nothing, as far as one can tell from the legislation itself.⁴³⁰ Some have tried to justify the granting of exclusive rights in these

426. 17 U.S.C. § 104A (1994 & Supp. IV 1998).

427. See David Nimmer, *The End of Copyright*, 48 VAND. L. REV. 1385, 1410 n.158 (1995) (noting that Professor Perlmutter's testimony before Congress "maintains that no such problems attend recapture of works that lapsed due to formal defects," although "[i]f a work has fallen into the public domain because its term of protection has expired, it would violate the 'limited times' requirement to revive it").

428. See 17 U.S.C. § 104A(h)(6)(C) (1994).

429. We do not take a position on the Compensation Clause claims of subsequent authors who, having made use of restored works to create derivative works, must now pay licensing fees if they wish to continue to exploit those works. See *id.* § 104A(d)(3)(A) (Supp. IV 1998); see also Tung Yin, *Reviving Fallen Copyrights: A Constitutional Analysis of Section 514 of the Uruguay Round Agreements Act of 1994*, 17 LOY. L.A. ENT. L.J. 383, 406-08 (1997) (expressing concerns under the Just Compensation Clause about the constitutionality of reviving copyrights).

430. Congress has not even required that owners of restored works deposit a copy of the work with the Library of Congress, a normal part of the registration requirement. Compare 17 U.S.C. § 404A (1994 & Supp. IV 1998) (discussing copyrights of restored works), with *id.* § 407 (discussing the deposit of copies

public domain works on grounds of international harmony.⁴³¹ But the only foreign relations argument consistent with the *Quid Pro Quo* Principle is based on a conclusion that improving international relations would result in better overseas markets for American copyrighted goods, thereby stimulating their production. The terms of restoration legislation, however, do not lend themselves to this conclusion: the statute is in the form of a gift. Perhaps Congress could restore copyrights in legislation structured more directly to purchase new works. For example, if Russia only protected works of American origin for ten years, then maybe Congress could restore copyright status to Russian works so long as the statute expressly required an extension of the term of protection for American works in Russia. In other words, international harmony may be a worthy goal, but under the Intellectual Property Clause it is not an objective that can be advanced by the granting of exclusive rights that impose monopoly-like costs unless there is a concomitant benefit.

We repeat a point made earlier, that the mere desire to improve international relations cannot free Congress from preexisting constitutional restraints. For example, our relations with foreign nations might improve if the governments of American states were required to dispose of foreign radioactive waste. We doubt, however, that the Court would allow the strictures against the federal commandeering of state governments spelled out in *New York v. United States*⁴³² and *Printz v. United States*⁴³³ to be avoided by mere reference to foreign relations goals.

4. *An Aside on the Treaty Power*

We have seen that two of the suspect grants—the CTEA and the Restoration Act—have been defended as attempts to improve international relations by “harmonizing” American and foreign law.⁴³⁴ Although these attempts are unsuccessful for the reasons we have identified, they lead us to an interesting question: What if the United States were to enter into an international *treaty* that required American law to change in ways that would violate the principles we have identified?

The Supreme Court has held that the treaty power confers on Congress independent authority beyond the other enumerated powers. Thus, in *Missouri v. Holland*,⁴³⁵ the Court upheld a federal statute prohibiting the killing of migratory birds even though such a statute would (under existing

with the Library of Congress).

431. See Thomas Gordon Kennedy, *GATT-Out of the Public Domain: Constitutional Dimensions of Foreign Copyright Restoration*, 15 ST. JOHN'S J. LEGAL COMMENT. 545, 545 (1996) (“The United States has elected to heal the wounds in the international intellectual property community.”).

432. 505 U.S. 144 (1992).

433. 521 U.S. 898 (1997).

434. For further discussion of how these and other recent intellectual property statutes are attempts at harmonization, see Kenneth D. Crews, *Harmonization and the Goals of Copyright: Property Rights or Cultural Progress?*, 6 IND. J. GLOBAL LEGAL STUD. 117 (1998).

435. 252 U.S. 416 (1920).

precedent) have been beyond Congress's power;⁴³⁶ the law was nevertheless valid because it was enacted pursuant to a treaty.⁴³⁷ Neither the Tenth Amendment nor the limited reach of the Commerce Clause rendered the statute unconstitutional.⁴³⁸ But despite *Missouri v. Holland*, the Court also made clear in *Reid v. Covert*⁴³⁹ that explicit constitutional limits—such as the First and Sixth Amendments—do limit the treaty power as well as other powers.⁴⁴⁰ Thus, Congress cannot enact legislation to enforce treaties if that legislation would deprive citizens of their constitutional rights.⁴⁴¹ If Congress were to enact legislation violating intellectual property principles, would it be governed by *Holland* or by *Reid*?

The distinction between *Holland* and *Reid* is twofold. First, *Holland* might be construed as holding only that the treaty power can supplement Congress's other powers when they run out,⁴⁴² whereas *Reid* governs when there is a constitutional limit on otherwise valid congressional authority.⁴⁴³ Under this interpretation, the treaty power is of no help to the defenders of the suspect copyright legislation. As we noted in our introduction, the principles of constitutional weight that we are discussing are *limits* on otherwise valid congressional power rather than examples of an enumerated power running out and simply not encompassing a particular statute. The fact that our principles are implied rather than explicit is irrelevant; once the Court identifies an implied limit, it is treated for all intents and purposes as if it were written expressly in the text.

The second difference between *Holland* and *Reid* also fails to uphold treaty-based legislation that exceeds the underlying principles of the Intellectual Property Clause. Some language in *Holland* and *Reid* lends itself to distinguishing between limits based on federalism (which do not constrain the treaty power) and other types of limits on congressional authority (which do).⁴⁴⁴ However we might characterize our intellectual property

436. See *id.* at 435.

437. Several commentators have suggested that in light of the recent Tenth and Eleventh Amendment cases, *Holland* might no longer be good law. See Curtis A. Bradley, *The Treaty Power and American Federalism*, 97 MICH. L. REV. 390 (1998); James A. Deaken, Note, *A New Miranda for Foreign Nationals? The Impact of Federalism on International Treaties That Place Affirmative Obligations on State Governments in the Wake of Printz v. United States*, 31 VAND. J. TRANSNAT'L L. 997 (1998); Thomas Healy, Note, *Is Missouri v. Holland Still Good Law? Federalism and the Treaty Power*, 98 COLUM. L. REV. 1726 (1998). For contrary views, see LOUIS HENKIN, FOREIGN AFFAIRS AND THE UNITED STATES CONSTITUTION 191–94 (2d ed. 1996); Gerald L. Neuman, *The Global Dimension of RFRA*, 14 CONST. COMMENTARY 33, 41–49 (1997); Martin S. Flaherty, *Are We to Be a Nation? Federal Power vs. "States' Rights" in Foreign Affairs*, 70 U. COLO. L. REV. 1277 (1999); Carlos Manuel Vázquez, Breard, Printz, and the Treaty Power, 70 U. COLO. L. REV. 1317 (1999). The Court has suggested obliquely that at least the Eleventh Amendment may constrain exercises of the treaty power. See *Breard v. Greene*, 523 U.S. 371, 377 (1998).

438. See *Holland*, 252 U.S. at 433–35.

439. 354 U.S. 1 (1957).

440. See *id.* at 16–19; see also *Boos v. Barry*, 485 U.S. 312, 324 (1988).

441. See *Reid*, 354 U.S. at 18.

442. See *Holland*, 252 U.S. at 432–35.

443. See *Reid*, 354 U.S. at 18–19.

444. See, e.g., *id.* at 18 (“To the extent that the United States can validly make treaties, the people and the states have delegated their power to the National Government and the Tenth Amendment is

principles, they are certainly not derived from federalism, and thus, they are not within the purview of *Holland*.⁴⁴⁵ Consequently, even an international treaty would not provide a justification for Congress to exceed constitutional limits on its power—including the implied limits we are considering.

B. *Hard Cases*

We have just discussed several forms of legislation that we believe clearly violate the principles underlying the Intellectual Property Clause. But as we noted earlier, the Court's identification of essential postulates or fundamental principles does not always yield clear answers. It should come as no surprise, then, that plausible arguments can be made both for and against the constitutionality of several other recently enacted statutes. Indeed, a number of the statutes we discuss in this section have been attacked by commentators. Although we disagree with some of their arguments, we find them worthy of serious consideration.

1. *Biotech-Process Patents and Design Protection for Boat Hulls*

Both the Quid Pro Quo Principle and the Public Domain Principle suggest that Congress cannot grant exclusive rights in existing utilitarian product features. The history and structure of the Clause make clear that Congress, for example, could not tomorrow grant someone a patent on the wheel and all wheel-based technology. As the Court opined in *Graham*:

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. Innovation, advancement, and things which add to the sum of useful knowledge are inherent requisites in a patent system which by constitutional command must "promote the Progress of . . . useful Arts." This is the *standard* expressed in the Constitution and it may not be ignored.⁴⁴⁶

The opinion suggests that Congress must require that a patented item embody some sort of inventive step in order to earn its creator a grant of exclusive rights.

The Patent Act⁴⁴⁷ requires this inventiveness in § 103(a), which states that:

no barrier."); *Holland*, 252 U.S. at 434 ("No doubt the great body of private relations usually fall within the control of the State, but a treaty may override its power.").

445. We do not need to enter the morass of whether the Treaty Clause provides the exclusive method for entering into treaties. Compare Bruce Ackerman & David Golove, *Is NAFTA Constitutional?*, 108 HARV. L. REV. 801 (1995), and David M. Golove, *Against Free-Form Formalism*, 73 N.Y.U. L. REV. 1791 (1998), with Laurence H. Tribe, *Taking Text and Structure Seriously: Reflections on Free-Form Method in Constitutional Interpretation*, 108 HARV. L. REV. 1221 (1995). Either way, a treaty cannot provide a justification for Congress to exceed constitutional limits on its power.

446. *Graham v. John Deere Co.*, 383 U.S. 1, 6 (1966) (quoting U.S. CONST. art. I, § 8, cl. 8).

447. 35 U.S.C. §§ 1–376 (1994).

[A patent in a new invention may not be granted] if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.⁴⁴⁸

This requirement of “nonobviousness” has been the established standard for inventiveness since at least as early as the Court’s decision in *Hotchkiss v. Greenwood*.⁴⁴⁹ For at least one hundred and fifty years, the Patent Office has been required to deny an application if someone skilled in the relevant art could have easily anticipated the advance sought to be patented.⁴⁵⁰ An invention must not only be new, in the sense that no one has conceived of it before, but it must be a significant advance over the prior art. Of course, under the flexibility principle, Congress has substantial discretion in determining how high a degree of innovation it will require.⁴⁵¹ Two recent statutes, however, raise the question of whether merely requiring novelty, without nonobviousness, is sufficient in light of the history and structure of the Intellectual Property Clause.

When it amended the Patent Act in 1996, Congress eliminated the nonobviousness requirement for some biotechnological processes.⁴⁵² Currently, a “biotechnological process using or resulting in a composition of matter that is novel under section 102 and nonobvious under subsection (a) of this section shall be considered nonobvious if [the composition of matter and process are claimed in the same patent application and are owned by the same person].”⁴⁵³ In other words, a biotech process that produces a patentable composition of matter need only be novel to receive a separate patent.⁴⁵⁴

Similar sui generis protection has also recently been afforded to the builders of boat hulls.⁴⁵⁵ No longer must a boat-hull designer prove that her hull is a nonobvious improvement over the prior art.⁴⁵⁶ Protection is afforded a boat hull that is “the result of the designer’s creative endeavor that provides a distinguishable variation over the prior work pertaining to similar articles which is more than merely trivial and has not been copied from another source.”⁴⁵⁷ The statute requires something more than mere novelty— but not much.

448. *Id.* § 103(a) (Supp. IV 1998).

449. 52 U.S. (11 How.) 248 (1850).

450. See 35 U.S.C. § 103 (1994); *Graham*, 383 U.S. at 10–11.

451. See *Graham*, 383 U.S. at 6. (“Within the limits of the constitutional grant, the Congress may, of course, implement the stated purpose of the Framers by selecting the policy which in its judgment best effectuates the constitutional aim.”)

452. See 35 U.S.C. § 103(b)(1) (Supp. IV 1998).

453. *Id.*

454. Technically, the process would have to be useful too, see 35 U.S.C. § 102 (1994), but we think that by definition any process that creates patentable subject matter must be useful.

455. See 17 U.S.C. § 1301(a)(2) (Supp. IV 1998).

456. Compare 35 U.S.C. § 103 (Supp. IV 1998), with 17 U.S.C. § 1301(b)(1) (Supp. IV 1998).

457. 17 U.S.C. § 1301(b)(1) (Supp. IV 1998).

The lowering of the traditional requirement for protection of biotech processes and boat hulls pushes the Flexibility Principle to its limit. We explore below whether Congress can set a *de minimis* level of inventiveness or whether it must premise the grant of exclusive rights on the production of something not so obvious to the eyes of those skilled in the relevant art. In particular, we focus on the intertwined aspects of the Authorship and Quid Pro Quo Principles and ask whether the framers would have believed that rewarding novelty without inventiveness rewarded a true author or inventor and benefited the public? Although we believe the question is close, we are ultimately persuaded that new biotech-process protections are consistent with the principles we have identified, but that the expanded protection for boat hulls may not be.

Ideally, one would like to find convincing evidence of what meaning the framers and ratifiers of the Constitution attached to the word “Inventors.” Did the concept of invention signify mere novelty or something more? We have found two conflicting lines of evidence in preconstitutional English practice. First, it appears that the nonobviousness test, as we know it today, did not develop in England until the middle of the nineteenth century.⁴⁵⁸ Lack of an inventive step was apparently not a defense in a patent infringement suit in England at the time of the drafting and ratification of the Constitution.⁴⁵⁹ So, to the extent the framers were aware of the operation of English patent law, they would not have assumed that only nonobvious creations merited the grant of exclusive rights. We should note, however, that the first English patent treatise was not published until 1803⁴⁶⁰ and that the “compilations of judicial precedent are totally silent on patents for the period 1614–1766 [with one exception],”⁴⁶¹ making it very difficult to guess the framers’ understanding of the technicalities of English patent law beyond a rudimentary awareness of *Darcy v. Allin* and the Statute of Monopolies.⁴⁶²

The Statute of Monopolies itself provides few clues, given that it did not set up any sort of administrative criteria for the granting of patents beyond authorizing the Crown to grant exclusive rights to the “first and true inventor [of] any manner of new manufacture within this realm.”⁴⁶³ We know little about how the Crown interpreted that language, but we do

458. See HAROLD G. FOX, *MONOPOLIES AND PATENTS: A STUDY OF THE HISTORY AND FUTURE OF THE PATENT MONOPOLY* 230–34 (1947).

459. See *id.* at 227.

The present requirement of inventive ingenuity is simply a refinement which has been added to the patent law by the courts as the history of patent litigation has developed. There is no justification in the Statute [of Monopolies] itself and there is no justification in the meaning of the word as it was used at the time of the Statute.

Id. Fox then traces when the requirement was first applied in the mid-nineteenth century. See *id.* at 230–34.

460. See CHRISTINE MACLEOD, *INVENTING THE INDUSTRIAL REVOLUTION: THE ENGLISH PATENT SYSTEM, 1660–1800*, at 62 (1988).

461. *Id.* at 68.

462. See *supra* text accompanying notes 182–98.

463. 20 *Jam.*, ch. 3, §§ 5–14 (1623) (Eng.).

know that a grant given to a “man [who] by his wit or invention doth bring any new trade into the realm”⁴⁶⁴ would be approved by the common-law courts. These courts observed that “the king may grant to [an inventor] a monopoly patent for some reasonable time, until the subject may learn the same, in consideration for the good that he doth bring by his invention to the commonwealth: otherwise not.”⁴⁶⁵ Thus, “inventors” included those who by their efforts introduced products into the realm that they did not themselves invent.⁴⁶⁶

The English courts, therefore, appear to have keyed on the notion that an invention must result in some tangible good within the realm.⁴⁶⁷ Unlike current American law, a patented invention had to embody a better product or a better method of operation.⁴⁶⁸ As a result, courts were liable to strike down patents as being “mere improvements” over the prior art, on the theory that a simple improvement did not constitute sufficient “consideration” for the exclusive rights granted.⁴⁶⁹ The rule against the patenting of improvements was not modified until 1776, by Judge Mansfield in *Morris v. Bramson*.⁴⁷⁰ Again, we do not know if *Morris* was known to the framers or what they would have thought about it.⁴⁷¹

To summarize, at the time of the drafting of the Constitution, (1) Lack of an inventive step was not an express defense to a patent infringement suit, (2) improvements to existing articles of manufacture had only just become patentable, and (3) a patentable machine or process had to offer some tangible public benefit.

We can only speculate as to the framers’ level of awareness of these facts, and we hesitate to conclude on the basis of history alone that the word “Inventor” in the Intellectual Property Clause was meant fully to embody the modern day concept of nonobviousness. Stepping back and re-considering the whole of the historical and structural arguments we have canvassed in this article, however, we are willing to argue that the framers did understand something like the notion of the public receiving “consideration” for the monopoly grant.⁴⁷² Mere novelty was never enough by itself in England to support a patent grant, and we believe it plausible to argue that the framers did not intend a lesser standard to be applied by

464. *Darcy v. Allin*, 74 Eng. Rep. 1131, 1139, 77 Eng. Rep. 1260 (Q.B. 1602).

465. *Id.*

466. *See id.*

467. *See FOX*, *supra* note 458, at 233–34.

468. *See id.*

469. *See Bircot’s Case*, 3 Coke’s Institutes 184 (Ex. 1572), *cited in MACLEOD*, *supra* note 460, at 67–68; *Early Evolution*, *supra* note 181, 77 J. PAT. & TRADEMARK OFF. SOC’Y at 852.

470. 1 Web. Pat. Cas. 51 (K.B. 1776).

471. The holding in *Morris* was inevitable—virtually all valuable inventions are improvements over prior inventions. We suspect that the death of the prohibition on the protection of “mere improvements” in *Morris* led directly to the development of the nonobviousness doctrine. Both are the means by which a court can deny protection to an invention that is not a significant contribution to the art.

472. *See supra* text accompanying notes 245–51; *see also Graham v. John Deere Co.*, 383 U.S. 1, 9 (1965) (discussing Jeffersonian notion that an invention must be “worth to the public the embarrassment of an exclusive patent”).

Congress. In other words, Congress must require something more than mere novelty.

We find evaluating the new biotech process and boat-hull statutes difficult because Congress arguably did require more than novelty in both of those cases. In the case of biotech processes, the inventor must prove that the process results in independently patentable subject matter.⁴⁷³ One could argue that this is a guarantee that protecting the process will generate something of value to the public.⁴⁷⁴

In the case of boat hulls, protection is premised not only on novelty but also on attractiveness and a greater than trivial “distinguishable variation” over the prior art.⁴⁷⁵ The appearance or distinguishing features of a functional utilitarian item would seem historically irrelevant, and it is unclear whether requiring a variation unrelated to performance or utility constitutes a sufficient attempt to provide the public consideration for the grant of exclusive rights. Merely requiring originality in the copyright (*Feist*)⁴⁷⁶ sense may not be enough to justify patent-like protection of utilitarian works. We note, however, that copyright protection for computer software and semiconductor mask works—two purely functional creations—is also currently premised on the same minimal requirement of copyright-like originality. As befits hard cases and disagreement between coauthors, we reserve judgment on this critical issue for another day.

2. *Orphan Drugs*

In 1983, Congress enacted special protection for “orphan drugs” in response to concerns that drug companies were failing to seek approval of or to market drugs useful to members of small patient populations.⁴⁷⁷ An orphan drug is defined as one formulated to treat a disease

which (A) affects less [sic] than 200,000 persons in the United States, or (B) affects more than 200,000 in the United States and for which there is no reasonable expectation that the cost of developing and making [the drug] available in the United States . . . will be recovered from sales in the United States.⁴⁷⁸

The statute provides incentives for the research, development, and marketing of such drugs by providing a seven-year monopoly to the first

473. See 35 U.S.C. § 103(b)(2) (Supp. IV 1998).

474. See Karen I. Boyd, *Nonobviousness and the Biotechnology Industry: A Proposal for a Doctrine of Economic Nonobviousness*, 12 BERKELEY TECH. L.J. 311, 337–41 (1997) (arguing that special considerations in the biotech industry merit a loosening of the nonobviousness standard). The conclusion that Congress is attempting to purchase something for the public by granting exclusive rights is further bolstered by the fact that the exclusive rights in the biotech process automatically expire at the time the patent on the product does. See 35 U.S.C. § 103(b)(2)(B) (Supp. IV 1998).

475. 17 U.S.C. § 1301(b)(1) (Supp. IV 1998).

476. See *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991).

477. See Orphan Drug Act, 21 U.S.C. §§ 360aa–360ee (1994).

478. *Id.* § 360bb(a)(2).

person to obtain FDA approval for an orphan drug.⁴⁷⁹ Protection may be granted whether or not the drug is (or can be) patented and irrespective of the length of time it has been known to the scientific community.⁴⁸⁰

The potential for noninventors to obtain exclusive rights to the sale of public-domain drugs has prompted at least one commentator to argue that the statute is unconstitutional.⁴⁸¹ Professor John Flynn makes three main arguments against the statute.⁴⁸² Initially, he argues that in granting rights to those who merely develop a drug, the statute impermissibly extends rights to noninventors.⁴⁸³ But as we have noted, the history of the Intellectual Property Clause provides good reason to allow Congress the leeway to define the term "Inventors" rather loosely.⁴⁸⁴ Congress should have the authority to define the word, as the English courts did, as one who brings a beneficial new product to the realm,⁴⁸⁵ even if he did not "invent" it in the strictest sense of the term.

Flynn's other arguments raise more serious questions. He concludes that the statute does not promote the progress of science because it does not require any standard of novelty or inventiveness and thus violates what we have labeled the Quid Pro Quo Principle.⁴⁸⁶ Indeed, the statute permits protection of drugs known for decades.⁴⁸⁷ The legislation is undoubtedly a suspect grant, establishing exclusive rights that impose monopoly-like costs. The evidence, not surprisingly, shows that rights granted to orphan-drug manufacturers allow them to charge monopoly prices.⁴⁸⁸

479. See *id.* § 360cc (Supp. IV 1998). The granting of exclusive rights in this section is quite interesting. The statute does not use the words "exclusive right" or "monopoly," but rather effects the same end by prohibiting the FDA from issuing approval to any other manufacturer of the drug for seven years. See *id.* The period of true exclusivity, however, may be transitory. Because the FDA is willing to grant multiple manufacturers approval for different uses of the same orphan drug, physicians sometimes have the opportunity in practice to write a prescription for the product of several different sellers of the approved drug.

480. See *id.*

481. See Flynn, *supra* note 7.

482. See *id.*

483. See *id.* at 405–06.

484. See text accompanying notes 348–51; see also FOX, *supra* note 458, at 227.

At common law there was required as consideration the introduction of a new manufacture; the true and first inventor meant, at common law, not only the first person who discovered a new process but also a person who brought into England a process or machine not previously worked in England.

Id.

485. This situation is not, as Flynn suggests, equivalent to the granting of patent rights to a noninventor. See Flynn, *supra* note 7, at 406 n.56. The Orphan Drug Act does not purport to affect the rights of patentees. Any company seeking to manufacture a patented drug must first obtain the permission of the patent owner. See *id.* at 425.

486. See *id.* at 405.

487. See *id.* at 400–01. Flynn points out that Taxol was first isolated thirty years ago from the bark of Pacific Yew trees as the result of government funded research. See *id.* at 400. At the time the article was written, Bristol-Meyers Squibb held the orphan drug designation for Taxol and the exclusive right to harvest Pacific Yew trees on federal lands. See *id.* at 401.

488. See *id.* at 397 ("Congressional critics of the Act have reported that the prices charged for some orphan drugs are so high that they are effectively denied to orphan disease sufferers . . ."); *id.* at 398 ("Marketing exclusivity for a seven year period has meant the discretion to engage in monopoly pricing resulting in profits far in excess of research and FDA approval costs.").

Nevertheless, we do not agree with Flynn's suggestion that the Quid Pro Quo Principle is violated. The legislation may not be perfect, but it seems to be in the form of a purchase. No drug manufacturer can receive the seven-year exclusivity without doing the research and expending the resources to obtain FDA approval for the drug.⁴⁸⁹ The reward of exclusive rights is premised on the public receiving something: a valuable new drug on the market that would otherwise not be marketed.⁴⁹⁰ The company must pay a price and the public is guaranteed a benefit.

Flynn also argues that the legislation is unconstitutional because it grants exclusive rights to items that are in the public domain.⁴⁹¹ The Public Domain Principle does pose a threat to the legislation because the statute clearly permits the granting of exclusive marketing rights to a drug that is the subject of an expired patent or that was never patented but has been known to scientists for years. We wonder, however, how serious a threat the Orphan Drug Act poses to the public domain. First of all, protection is only granted for drugs that have not yet received FDA approval and that for economic reasons will not otherwise be brought to market.⁴⁹² In other words, the chemical formulas for some of these drugs may technically be in the public domain, but the drugs themselves will never be mass produced and made available to the public in the absence of government intervention.⁴⁹³ The legislation does not in practical terms take anything from the public; on the contrary, it aims to make something more widely available.⁴⁹⁴ Although these drugs might technically be in the public domain, they are not of any use to the public unless they are developed and approved; unlike books or musical compositions, it is not possible for a member of the public simply to "use" a drug in the public domain.⁴⁹⁵

489. See 21 U.S.C. § 360cc(a) (Supp. IV 1998).

490. See *id.* § 360bb(2) (requiring that there be no reasonable expectation that the drug be marketed in order to qualify as an "orphan").

491. See Flynn, *supra* note 7, at 412.

492. See 21 U.S.C. § 360bb(a) (1994 & Supp. IV 1998).

493. In this sense, the legislation looks a bit like the sporadic nineteenth century practice of extending individual patent grants in order to assure a patented product came to market. See *supra* text accompanying notes 264–67.

494. We also note that the statute does not forbid other drug manufacturers, private or public researchers, or individuals from experimenting with, analyzing, or using the claimed drug; it merely forbids the FDA from giving marketing approval for seven years to anyone other than the first approved applicant. See 21 U.S.C. § 360cc (Supp. IV 1998). To the extent that orphan drug status embodies a weaker bundle of exclusive rights than patent rights, it poses less of a threat to the public domain.

495. Another criticism of the legislation might be that it causes an inefficient diversion of resources to the development of orphan drugs at the expense of the development of other drugs that might be more valuable to the public. The accuracy of this claim is irrelevant to the constitutional question because the Intellectual Property Clause does not mandate that Congress act efficiently, as long as it purchases *something* in the public's name.

The Hatch-Waxman Act provides another example of a statute that both contains a loose notion of inventorship and grants exclusive rights in exchange for something of value to the public. The Act permits a pharmaceutical company that doubts the validity of a drug patent to bring that invalidity to the attention of the FDA and apply for fast-track approval for its own version of the drug. See *id.* § 355(j) (1994 & Supp. IV 1998). If the challenger prevails—or the patentee does not respond—the challenger is entitled to a 180-day period of exclusivity vis-à-vis any other applicants. See *id.*

3. *The Work-for-Hire Doctrine and NASA Inventions*

The Copyright Act provides that in the case of “a work prepared by an employee within the scope of his or her employment,”⁴⁹⁶ the copyright owner is “the employer or other person for whom the work was prepared . . . unless the parties have expressly agreed otherwise in a written instrument signed by them.”⁴⁹⁷ Under the Act, the copyright in a software program written by a corporate employee as part of his duties belongs to the corporation and not the employee.⁴⁹⁸ Several commentators have suggested that this might be considered a grant of rights to nonauthors in violation of the Intellectual Property Clause.⁴⁹⁹ Because history indicates that “Author” should be construed more narrowly than “Inventor,” we take this claim especially seriously.

History demonstrates that the Authorship Principle is probably not violated by the work-for-hire doctrine. The Statute of Anne altered the relationship between printers and authors, vesting the copyright initially with the person who created the work.⁵⁰⁰ The work-for-hire doctrine does not leave authors at the mercy of the publishing industry, but merely switches the default option for construing contracts between employees and the employers for whom they are paid to create.⁵⁰¹ Before the enactment of the 1976 work-for-hire statute, courts recognized that the enforceability of employment contracts that assign the ownership of copyrighted works produced by an employee in the course of his or her employment to his or her employer.⁵⁰² The work-for-hire statute has the same effect as prior private contractual provisions vesting copyright ownership in the employer, except that it saves the employer from having to add express contract language regarding transfer of copyright ownership. The question of ownership is still open to negotiation,⁵⁰³ although the negotiating edge may be shifted to the employer. This change in the power dynamics of employer-employee relations does not rise to the level of a suspect grant of exclusive rights to the employer. We understand how some creative workers may be blind-sided

§ 355(j)(5)(B)(iv) (Supp. IV 1998). This period provides a clear reward to a party that in layman's terms could not be called the “inventor” of the drug, in exchange for its efforts in overturning an invalid patent.

496. 17 U.S.C. § 101 (Supp. IV 1998) (defining “work made for hire”).

497. *Id.* § 201(b) (1994).

498. *See id.*

499. *Cf.* Rochelle Cooper Dreyfuss, *The Creative Employee and the Copyright Act of 1976*, 54 U. CHI. L. REV. 590, 600 (1987) (“Academics could claim that the work for hire provisions of the 1976 Act are unconstitutional under both the first amendment and the copyright clause.”).

500. *See* 8 Anne, ch. 19 (1710) (Eng.); *see also* 1 KEVIN GARRETT M.A. ET AL., COPINGER AND SKONE JAMES ON COPYRIGHT 2–15 (14th ed. 1999).

501. *See* Dreyfuss, *supra* note 499, at 595.

502. *See, e.g.*, *Southern Music Publ'g. Co. v. Walt Disney Prods.*, 73 F. Supp. 580, 583 (S.D.N.Y. 1947).

503. *See* Dreyfuss, *supra* note 499, at 627–30.

by the statute, but unfairness in labor relations is not what triggers Intellectual Property Clause scrutiny.⁵⁰⁴

A similar statute, which provides for federal ownership of inventions made as part of contracts entered into by the National Aeronautics Space Agency (NASA),⁵⁰⁵ is even less likely to be found unconstitutional. All of the arguments in favor of the constitutionality of the work-for-hire statute apply to the NASA statute as well. In addition, given the historically broader meaning of the word “Inventor” likely understood by the framers, it is not difficult to construe the federal government—as a funder of creativity for the realm—as an “Inventor” in the constitutional sense.

4. *Antibootlegging Statutes*

In 1994, Congress plugged a hole in copyright law that had left no federal remedy for the unauthorized recording of some sorts of live musical performances.⁵⁰⁶ The new criminal statute makes it a violation of federal law “knowingly and for purposes of commercial advantage or private financial gain [to fix] the sounds or sounds and images of a live musical performance.”⁵⁰⁷ The prohibition applies even if the underlying music is in the public domain or has never been fixed in any form by the performers or is not being simultaneously recorded by the performers.⁵⁰⁸ A separate statute provides civil liability for the same conduct but omits the scienter and commercial-gain requirements.⁵⁰⁹ The Eleventh Circuit recently held that Congress properly protected unfixed performances under the Intellectual Property Clause but suggested that the lack of a time term for protection might be problematic.⁵¹⁰ We agree with the Eleventh Circuit that Congress has the power to grant protection and that the protection must be for a limited time, although the argument is not straightforward.

504. We note that under the statute, the corporation is considered both the owner *and* the author of the copyright. See 17 U.S.C. § 201(b) (1994). The ownership rights can be transferred by contract, but the authorship cannot be. The practical effect is in the term of the copyright: human copyrights last life-plus-70-years; corporate copyrights last 95 years from publication or 120 years from creation.

505. See 42 U.S.C. § 2457 (1994).

506. See 18 U.S.C. § 2319A (1994).

507. *Id.* § 2319A(a)(1).

508. Copyright law has long protected the performance of music that was fixed in some tangible form prior to performance. The 1976 Copyright Act made clear that the simultaneous recording of music would satisfy the fixation requirement. See 17 U.S.C. § 101 (Supp. IV 1998) (establishing “‘fixed’ for the purposes of this title if a fixation of the work is being made simultaneously with its transmission”).

509. See 17 U.S.C. § 1101 (1994) (“Anyone who, without the consent of the performer or performers involved fixes the sound or sounds and images of a live musical performance in a copy or phonorecord . . . shall be subject to the remedies provided in sections 502 through 505 . . .”). We note that the proper plaintiff in an action to enforce § 1101 is rather unclear. It might be the performers, but they are seldom the copyright owners, who are the only parties entitled to remedies under §§ 502–505. Perhaps the copyright owner of the underlying music could bring an action, but owners already had this right before § 1101 was passed, and, in many instances, there is no copyright owner at all because the music performed is in the public domain.

510. See *United States v. Moghadam*, 175 F.3d 1269, 1281–82 (11th Cir. 1999) (noting the lack of a time limit on protection but refusing to address the issue because the defendant did not raise it).

As an initial matter, we consider whether the antbootlegging statutes constitute suspect grants that trigger the Public Domain Principle. Although these laws prevent certain recordings from falling into the public domain, neither seems on its face to grant exclusive rights that impose monopoly-like costs on the public. The statutes deny the bootlegger the right to exploit the recording, but they do not grant the performer the legal right to possession of the recording⁵¹¹ or the right to register a copyright in the recording.⁵¹² It is hard to see how the public suffers the sort of cost the framers were concerned about if no one can exploit the recording. The laws do not encourage the dissemination of new works, but we see no principle of constitutional weight that requires Congress to force the exploitation and dissemination of all creations.⁵¹³

We are troubled, however, by the possibility of collusion between the bootlegger and performer after the bootlegger is caught. The bootlegger might rationally decide to turn over his recording and assign all his rights in return for a promise that the performer will not sue the bootlegger under § 1101. Once the performer has the recording, the performer could mass produce and distribute the recording. Under § 1101(a)(1), the performer would then have an eternal right to prevent anyone from reproducing copies of the performance,⁵¹⁴ a monopoly that triggers scrutiny under the Intellectual Property Clause.

Under the Quid Pro Quo Principle, we ask first if the public receives anything in exchange for the ultimate grant of exclusive rights to the performer. The primary public benefit is the additional incentive it gives performers to perform without fear that a bootlegger will record an inferior performance. The statute creates a minimal, but discernible incentive. Musical groups are likely to have less apprehension about playing in public and should play marginally more. We perceive that Congress is buying the public something through the grant of protection.⁵¹⁵

The Public Domain Principle raises more serious questions. Neither of the two statutes contains any express limitation on the term of protec-

511. The remedies listed in § 1101 refer to §§ 502–505 of the Copyright Act as codified, which do not provide for forfeiture of infringing copies to the copyright owner, although the court may provide for the “reasonable disposition” of them. See 17 U.S.C. § 503(b) (1994).

512. Only the author or its assigns may register. See 17 U.S.C. §§ 201, 408 (1994). The “author” of a recording is the person who did the recording, just as the author of a photo is the photographer, not the subject of the portrait. Cf. *Burrow-Giles Lithographic v. Sarony*, 111 U.S. 53, 60 (1884) (holding that a photograph is an “original work of art” by the photographer).

513. Cf. *Harper & Row, Publishers, Inc. v. Nation Enter.*, 471 U.S. 539, 564 (1985) (giving unpublished works stronger protection than published works under the fair use doctrine).

514. See *Moghadam*, 175 F.3d at 1281 (“[T]he protection created by the anti-bootlegging statute is apparently perpetual and contains no express time limit . . .”).

515. A secondary question is whether an unfixed musical performance should be considered a “writing,” but we see nothing in the history or structure of the Clause to limit Congress’s authority to define “writings” broadly to include many different types of creations. Just as the word “speech” in the First Amendment has been interpreted broadly to include many things that are not oral utterances, the word “Writings” is capable of a similarly broad construction without upsetting the expectations of the framers and ratifiers of the Constitution. Of course, Congress could not define “Writings” so broadly that it included, for example, such traditional components of the public domain as ideas.

tion.⁵¹⁶ It appears that an unauthorized recording of a musical event would never enter the public domain under the statutes. Under § 1101, if a private citizen attends a Fourth of July celebration at the county fairgrounds and records the local brass band's rendition of the *Star-Spangled Banner*, neither she, her assigns or heirs, nor "anyone" may ever "transmit[] or otherwise communicate[] to the public the sounds or . . . distribute[] or offer[] to distribute [it]" without the consent of the performer.⁵¹⁷ The performer's potential ability to control copies of that recording indefinitely seems to violate the mandate that protection only be for "limited times."⁵¹⁸

C. *Valid Grants*

We would like to conclude our illustration of the operation of the principles underlying the Intellectual Property Clause by looking at several statutes to which they pose no threat. These statutes, like the protection at issue in the *Trade-Mark Cases*, are commonly thought of as protecting intellectual property but are nevertheless constitutional exercises of power under the Commerce Clause.

1. *Manufacturing Clause*

Until 1986, the Copyright Act prohibited the mass importation of most works by American authors that were printed overseas.⁵¹⁹ Although one might characterize the legislation as a suspect grant of exclusive rights (albeit to the whole class of American printers rather than to just one lucky recipient) that imposed monopoly-like costs,⁵²⁰ we doubt that the Manufacturing Clause was the sort of grant that the framers were worried about. The primary purpose of the legislation was to benefit American printers at the expense of foreign printers. We fail to see in the history and the structure of the Clause any constitutional principle protecting the health of foreign businesses. To be sure, American consumers and authors were caught in the crossfire. Consumers paid higher prices for books that could have been printed more cheaply overseas, and authors probably found that the

516. It would be difficult to imply a limit based on the sections of the Copyright Act that deal with duration of protection, *see* 17 U.S.C. §§ 302–305 (1994 & Supp. IV 1998), given that those sections are directed at limiting the rights of an author or his assigns. Even if the bootlegger (the most likely statutory "author" of the recording) could validly register his copyright, which we doubt, §§ 302–305 would not seem to limit the right of the performer who is the likely plaintiff in an enforcement suit.

517. 17 U.S.C. § 1101 (1994).

518. *See United States v. Moghadam*, 175 F.3d 1269, 1281 (11th Cir. 1999) (noting that "[o]n its face, the protection created by the anti-bootlegging statute is apparently perpetual and contains no express time limit," and opining that it may violate "the 'Limited Times' requirement [that] forbids Congress from conferring intellectual property rights of perpetual duration").

519. *See* 17 U.S.C. § 601(a) (Supp. IV 1998); *Authors League of Am., Inc. v. Oman*, 790 F.2d 220, 221 (2d Cir. 1986) (holding the manufacturing clause did not violate the First Amendment or the Intellectual Property Clause).

520. One would logically have to assume that competition with cheaply printed imports would have resulted in marginally lower book prices here.

higher cost of printing resulted in marginally diminished profits. Congress, however, effected this adjustment in market relationships among consumer, authors, publishers, and printers, through a border-control mechanism—an import ban. Although we have not canvassed the history of federal power in this area, we would be surprised to find anything in the history or the structure of the Constitution to indicate that Congress had anything less than plenary power in the area of border control. England, the colonies, the states under the Articles of Confederation, and the early Republic all exercised their prerogative to favor local industries at the expense of foreign competition and, often indirectly, local consumers. We do not believe the framers or ratifiers understood the term “exclusive rights” to encompass the advantages gained under protectionist border control legislation.

2. *Federal Trade-Secret Law*

Although liability for the misappropriation of trade secrets is generally a creature of state law,⁵²¹ Congress in 1996 imposed criminal sanctions on anyone who “with intent to convert a trade secret, . . . knowing that the offense will, injure any owner of that trade secret, knowingly . . . steals, or without authorization appropriates . . . such information.”⁵²² Arguably, the Intellectual Property Clause prohibits Congress from enacting trade-secret legislation because the law of trade secrecy protects entities that are not authors or inventors in the constitutional sense, as the “owner” of a trade secret does not have to create it.⁵²³

We believe, however, that the legislation is not a suspect grant and therefore does not come under Intellectual Property Clause scrutiny. As one of us has noted elsewhere, traditional civil liability for the misappropriation of trade secrets does not establish anything that looks like exclusive rights for trade-secret owners.⁵²⁴ Rather than creating a new property right, trade-secret doctrine merely provides augmented remedies for injuries to existing common-law rights. Virtually all actionable misappropriations of trade secrets are accomplished either through a breach of contract (e.g., the breach of an express or implied promise of confidentiality) or through the tort of trespass (e.g., industrial espionage).⁵²⁵ Trade-secret doctrine merely makes available the full panoply of tort and contract remedies for a misappropriation. Statutory protection for trade secrets does not create a new wrong but rather provides additional tort remedies for a breach of contract

521. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION §§ 39–45 (1995).

522. Economic Espionage Act of 1996, 18 U.S.C. § 1832 (Supp. II 1996).

523. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 39 (1995) (“A trade secret is any information that can be used in the operation of a business or other enterprise and that is sufficiently valuable and secret to afford an actual or potential economic advantage over others.”).

524. See Paul J. Heald, *Federal Intellectual Property Law and the Economics of Preemption*, 76 IOWA L. REV. 959, 976–80 (1991); Paul J. Heald & Michael L. Wells, *Remedies for the Misappropriation of Intellectual Property by State and Municipal Governments Before and After Seminole Tribe: The Eleventh Amendment and Other Immunity Doctrines*, 55 WASH. & LEE L. REV. 849, 859–60 (1998).

525. See Heald & Wells, *supra* note 524, at 858–59.

and additional contract remedies for a trespass. Thus, if Congress enacted civil liability under the Commerce Clause for the misappropriation of trade secrets, it would not impose new monopoly costs on the public but merely provide an extra deterrent against potential tortfeasors or contract breachers.

As with civil liability, the criminal statute does not provide sanctions for merely using, developing, discovering, reverse-engineering, or selling a trade secret. It does not grant any rights in a secret against the world but merely punishes individuals who intentionally “convert a trade secret.”⁵²⁶ We interpret the intentional conversion requirement as premising criminal liability on civil culpability and therefore merely adding another layer of deterrence upon that already provided by state law. In other words, Congress has identified certain breaches of contract and certain torts that are especially pernicious to the economy and has created extra disincentives to their commission. We do not believe that the history or structure of the Intellectual Property Clause provides any reason to believe that the framers or ratifiers of the Constitution would have viewed this sort of law with the suspicion they reserved for monopoly-like grants.

3. *Compulsory Licenses*

At least one author has suggested that Congress lacks the power to enact a system of compulsory licensing for intellectual property.⁵²⁷ Congress has in fact enacted a compulsory-licensing scheme for sound recordings⁵²⁸ and multiple statutory provisions of compulsory licensing exist for patents.⁵²⁹ In addition, by denying a motion for an injunction and requiring the payment of a reasonable royalty as a remedy, a court can enforce what is essentially a compulsory license.⁵³⁰ Thus, the question is raised whether Congress can grant something less than absolutely exclusive rights to authors and inventors.

We have previously noted the ambiguity inherent in the term “exclusive rights” in the Intellectual Property Clause.⁵³¹ History provides little rationale for a requirement that all grants provide the strongest possible pro-

526. 18 U.S.C. § 1832(a) (Supp. II 1996).

527. See Fenning, *supra* note 181, at 116 (“The words finally chosen for the Constitution seem to allow no limitations on the ‘exclusive’ right such as requirements for working or compulsory licenses. It seems clear that it would be unconstitutional for Congress to endeavor to provide either type of limitations in either patents or copyrights.”).

528. See 17 U.S.C. § 114(d)(2) (Supp. IV 1998).

529. See 42 U.S.C. § 7608 (1994) (authorizing Attorney General to certify to federal district court under certain circumstances the need for a mandatory license to use patented air pollution technology); 28 U.S.C. § 1498(b) (Supp. IV 1998) (providing that the only remedy against the United States for patent infringement is an award of just compensation).

530. See ROBERT P. MERGES ET AL., *INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE* 302 (1997) (“In *Foster v. American Mach. & Foundry Co.*, 492 F.2d 1317 (2d Cir. 1974), for example, the court upheld what amounted to a compulsory license: a reasonable royalty damage award . . . but no injunction.”).

531. See *supra* text accompanying note 335.

tection to authors and inventors. Indeed, both the history and the structure of the Clause—with its language tending to curtail the size of potential grants—suggest that more limited grants are preferable. Putting ourselves in the shoes of the framers, and fully cognizant of the fear and distrust of monopolies that animated their drafting of the Clause, we simply do not perceive a concomitant worry about possible congressional attempts to limit monopolies in constructive ways.⁵³² Thus, there is no support in our principles for a requirement of absolute exclusivity.

V. CONCLUSION

The question of the constitutionality of compulsory licensing schemes for intellectual property provides an appropriate place to end our discussion of the extent to which the Intellectual Property Clause constrains congressional action. Our answer to the compulsory-licensing question is openly sensitive to the actual intentions of the framers in drafting the document and the actual meaning likely perceived by those who ratified it. We adopted this rhetorical stance not because we take sides in the perennial debate over the form constitutional interpretation should take, but because when the Court discusses implied constraints on legislative enactments, it seems to find this the most persuasive approach.

In trying to describe the probable intentions underlying the Intellectual Property Clause, we have eschewed any attempt to imagine what the framers might have thought about any of the specific pieces of legislation; instead, we have tried to identify the sort of principles that animated them when they drafted the Constitution. We believe—as we tried to demonstrate in part II—that the Court consistently searches for underlying principles in other cases involving implied constraints. For example, in *Alden v. Maine*,⁵³³ the Court did not try to discover whether James Madison—or any other framer—had ever considered the constitutionality of requiring states to pay overtime to their employees. Rather, it looked to the history and the structure of the Constitution to make an intelligent guess about the broader principles that underlie the relationship between state and federal governments.⁵³⁴ Similarly, looking to the history and the structure of the Intellectual Property Clause permits us to identify the sorts of principles that most likely guided the understandings of the writers and ratifiers of the Constitution.

532. Some gross intrusions on intellectual property rights are almost certainly regulated by the Just Compensation Clause. See *Ruckelshaus v. Monsanto Co.*, 467 U.S. 986, 1013 (1983) (holding certain section of FIFRA constituted a constitutional taking of Monsanto's trade secrets); *James v. Campbell*, 104 U.S. 356, 358 (1881) (stating in dicta that the United States may not constitutionally use a patent without paying just compensation to its owner); Thomas F. Cotter, *Do Federal Uses of Intellectual Property Implicate the Fifth Amendment?*, 50 FLA. L. REV. 529, 537–38 (1998); Heald & Wells, *supra* note 524, at 855–73 (discussing the Just Compensation Clause as it applies to intellectual property).

533. 527 U.S. 706 (1999).

534. See *id.* at 759–60.

The most important of these principles—the Suspect Grant, the Quid Pro Quo, the Public Domain, the Authorship, and the Flexibility Principles—suggest that Congress has generally been faithful to the framers' original vision. In fact, as good pragmatists, we would be suspicious if under our analysis very many intellectual property statutes turned out to be unconstitutional.⁵³⁵ In the few cases in which our analysis yields a clear determination of unconstitutionality—in particular the Copyright Term Extension Act⁵³⁶—Congress's action was a recent response to intense interest group pressure, which might have suppressed that body's historic constitutional good sense in the intellectual property context. A small handful of other statutes are also troublesome but not so clearly unconstitutional, and we hope that our analysis illuminates the debates.

Our conclusions about particular statutes are by necessity not driven by single “smoking gun” bits of evidence or interpretations of crystal-clear constitutional phraseology. Like the Court, our approach in these matters is extremely holistic. First, by reading the Court's opinions in cases involving implied constraints, we determined what information about the Intellectual Property Clause was potentially relevant to the constitutional issue. Then we canvassed the relevant information—primarily historical and structural evidence—to sort out and identify principles of constitutional weight underlying the Clause. With so many factors bearing on the proper interpretation of the Clause, conclusions about individual statutes are necessarily somewhat fluid.

For those not persuaded by—or not interested in—our specific conclusions on particular intellectual property statutes, we hope that we have focused attention on what is likely a significant constitutional issue in the new century. As the Supreme Court becomes once again willing to interpret Congress's enumerated powers narrowly, Congress is looking for ways around the constraints. Inevitably, the resulting statutes will raise the question we address in this paper: can Congress avoid the effect of Supreme Court decisions by a simple change in clauses? From the CTEA to the Violence Against Women Act to the newly reformulated Religious Freedom Restoration Act, this *pas de deux* between Congress and the Court will continue. Ours is simply the first effort to identify the steps.

535. See Daniel A. Farber, *The Case Against Brilliance*, 70 MINN. L. REV. 917, 917 (1986).

536. Sonny Bono Copyright Term Extension Act, Pub. L. No. 105-298, tit. I, sec. 101, § 101, 112 Stat. 2827, 2827 (1998) (codified as amended in scattered sections of 17 U.S.C. (Supp. IV 1998)).

