ELDRED'S AFTERMATH: TRADITION, THE COPYRIGHT CLAUSE, AND THE CONSTITUTIONALIZATION OF FAIR USE

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Eldred v. Ashcroft[1] offered the Supreme Court broad issues about the scope of Congress's constitutional power to legislate in the area of intellectual property. In 1998, Congress added twenty years to the term of all

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1. 537 U.S. 186 (2003). For analysis of how *Eldred* may affect the constitutional law of intellectual property and associated scholarship, see Pamela Samuelson, *The Constitutional Law of Intellectual Property After Eldred v. Ashcroft*, 50 J. COPYRIGHT SOC'Y U.S.A. (forthcoming 2003).

copyrights, both existing and future copyrights.[2] But for this term extension, works created during the 1920s and 1930s would be entering the public domain. Now such works will remain under copyright until 2018 and beyond. *Eldred v. Ashcroft* rejected two challenges to the constitutionality of the copyright extension. The first challenge contended that Congress had exceeded its power to grant copyrights for "limited Times" in order to "promote the Progress of Science."[3] The purpose of copyright protection is to provide an incentive to create works, but nothing Congress did in 1998 could provide an incentive to create works in the 1920s.[4] However, the Court declined to impose the sort of limits it has recently imposed on other powers of Congress, especially Congress's power to regulate commerce. Rather, the Court held that the Constitution left it to Congress to choose the intellectual property regime that best serves the purposes of the Copyright Clause.[5] *Eldred* also rejected a First Amendment challenge to the constitutionality of the term extension. The plaintiffs had argued that the term extension was a content-neutral regulation that should be subject to intermediate scrutiny under the First Amendment.[6] The Court, however, reasoned that First Amendment scrutiny was unnecessary where Congress had not "altered the traditional contours of copyright."[7] The Copyright Clause was adopted around the same time as the First Amendment, and so copyright was probably not considered inconsistent with the First Amendment.[8] Moreover, copyright law itself provides traditional First Amendment safeguards, such as fair use and the freedom to copy ideas from protected works.[9]

As *Eldred* made its way from the trial court to the D.C. Circuit to the Supreme Court, the case drew increasing attention from both lawyers and the public. Interest in the case went well beyond the interests at

2. Copyright Term Extension Act (CTEA), Pub. L. 105-298, § 102(b) & (d), 112 Stat. 2827–28 (amending 17 U.S.C. §§ 302, 304) (cited in *Eldred*, 537 U.S. at 193).

3. U.S. CONST., art. I, § 8, cl. 8.

4. The *Eldred* Court summarized Petitioners' argument:

> Petitioners dominantly advance a series of arguments all premised on the proposition that Congress may not extend an existing copyright absent new consideration from the author. . . . Petitioners contend that the CTEA's extension of existing copyrights (1) overlooks the requirement of 'originality,' (2) fails to 'promote the Progress of Science,' and (3) ignores copyright's quid pro quo.

Eldred, 537 U.S. at 210.

5. *See id.* at 222 ("As we read the Framers' instruction, the Copyright Clause empowers Congress to determine the intellectual property regimes that, overall, in that body's judgment, will serve the ends of the Clause.").

6. *See id.* at 218 ("Petitioners separately argue that the CTEA is a content-neutral regulation of speech that fails heightened judicial review under the First Amendment.").

7. *Id.* at 221.

8. *See id.* at 219.

9. *See id.* at 218–22.

stake, involving whether such works as *The Great Gatsby* (published 1925), *Gone With The Wind* (published 1936), or "Happy Birthday to You" (published 1935) would finally go into the public domain. Rather, the case came to symbolize the increasing tension in intellectual property rights.[10] Congress and the courts have increased copyright protection in a number of ways, including the term extension. The parties filing amicus briefs in the Supreme Court included the Free Software Foundation, authors and publishers (on both sides of the issue), libraries, archives, consumer groups, and various bodies interested in constitutional law. The case promised ramifications well beyond the specific issue—the copyright status of works published before 1923. For example, the Free Software Foundation was not concerned about being able to use software published in the 1920s.[11] Rather, it sought to ensure that Congress generally would be limited in its ability to shrink the public domain.[12]

In terms of legal doctrine, *Eldred* offered an opportunity to address issues that have becoming increasingly important but have little Supreme Court case law directly on point: the extent of Congress's power to legislate in the area of intellectual property, and the limits that the First Amendment places on intellectual property protection. Intellectual property protection has expanded in every area. Patent now covers subject matter long thought unpatentable, such as business methods[13] and

10. Considerable recent scholarship questions the recent expansions in the scope of intellectual property protection. *See, e.g.*, JAMES BOYLE, SHAMANS, SOFTWARE, AND SPLEENS: LAW AND THE CONSTRUCTION OF THE INFORMATION SOCIETY (1996); JESSICA LITMAN, DIGITAL COPYRIGHT (2001); Keith Aoki, *Authors, Inventors and Trademark Owners: Private Intellectual Property and the Public Domain*, 18 COLUM.-VLA J.L. & ARTS 1, 191 (1994–1995); James Boyle, *The Second Enclosure Movement and the Construction of the Public Domain*, 66 LAW & CONTEMP. PROBS. 33 (2003); 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 (1996); Peter Jaszi, *Toward a Theory of Copyright: The Metamorphoses of "Authorship"*, 1991 DUKE L.J. 455 (1991); Jessica A. Litman, *The Public Domain*, 39 EMORY L.J. 965 (1990); William F. Patry, *The Copyright Term Extension Act of 1995: Or How Publishers Managed to Steal the Bread From Authors*, 14 CARDOZO ARTS & ENT. L.J. 661 (1996); Lloyd L. Weinreb, *Copyright for Functional Expression*, 111 HARV. L. REV. 1149, 1154 (1998) (discussing the "seemingly inexorable expansion of copyright"); Pamela Samuelson, *The Copyright Grab*, 4.01 WIRED, Jan. 1996, at 134. For a broad view, see Anupam Chander, *The New, New Property*, 81 TEX. L. REV. 715 (2003).

11. For a discussion of the role of the free software movement, see Joseph Scott Miller, *Allchin's Folly: Exploding Some Myths About Open Source Software*, 20 CARDOZO ARTS & ENT. L.J. 491 (2002).

12. On the free software movement as a paradigm shift in the creation of intellectual works, see Yochai Benkler, *Coase's Penguin, or, Linux and The Nature of the Firm*, 112 YALE L.J. 369 (2002). On how open source licenses use the restrictions of intellectual property law to keep software code effectively in the public domain, see David McGowan, *Legal Implications of Open-Source Software*, 2001 U. ILL. L. REV. 241 (2001); Stephen M. McJohn, *The Paradoxes of Free Software*, 9 GEO. MASON L. REV. 25 (2000).

13. State Street Bank & Trust Co. v. Signature Fin. Group, 149 F.3d 1368, 1375 (Fed. Cir. 1998).

software.[14] Federal trademark law has expanded steadily—both incrementally in some areas, and wholesale with the addition of anti-dilution measures and anti-cybersquatting provisions to the Lanham Act.[15] The copyright statute is overflowing with new types of protection. Just how far intellectual property protection can extend has become a vital issue.

Because there was so little case law on point, *Eldred* was an unusually difficult case to predict. *Eldred* raised important issues with respect to interpreting two parts of the Constitution: the First Amendment and the Copyright Clause. *Eldred* was not a part of a line of cases that might give some basis for the expected analysis. To the contrary, both issues raised constitutional issues largely left open by Supreme Court case law. The Court has reams of opinions on the First Amendment, but none directly addressing the full interplay between the First Amendment and the Copyright Clause. Likewise, the Court has decided many copyright cases, but always in the context of applying the copyright statute. Although the Court has given some attention to the Copyright Clause of the Constitution in those cases, it has never examined the full bounds of Congress's power under the Clause.[16] Thus, the *Eldred* Court was not facing the application of constitutional principles in a new fact setting. Rather, it was interpreting constitutional questions that the Court had never squarely addressed.

The plaintiffs developed several related but subtly distinct theories to attack the constitutionality of the copyright extension.[17] Over the various stages of the litigation, they honed the strongest arguments, based on a synthesis of judicial authority, historical arguments, and policy considerations. They crafted the issues to present the strongest available

14. *See* Dan Burk, Patenting Speech, 79 TEX. L. REV. 99, 136 (2000) (citing AT&T Corp. v. Excel Communications, Inc., 172 F.3d 1352 (Fed. Cir. 1999); *In re* Alappat, 33 F.3d 1526 (Fed. Cir. 1994)).

15. On the development and expansion of trademark law, see Kenneth L. Port, *The Congressional Expansion Of American Trademark Law: A Civil Law System In The Making*, 35 WAKE FOREST L. REV. 827 (2000).

16. The Court has addressed specific limits on the powers of Congress to protect intellectual property. *See* Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340 (1991) (holding that originality was constitutionally required for copyright protection); Harper & Row Publishers Inc. v. Nation Enters., 471 U.S. 539 (1985) (holding that the First Amendment did not preclude infringement liability for publishing unauthorized excerpts from ex-President's autobiography); Trade-Mark Cases, 100 U.S. 82 (1879) (holding that trademarks were not works of authorship that could be protected under the Copyright Clause). But none of those decisions concerned the outer limits of Congress's power under the Clause as a whole. *Feist*, by comparison to *Eldred*, takes a more direct approach to enforcing the limitations on congressional power under the Patent and Copyright Clause. *See* Samuelson, *supra* note 1 (contrasting *Feist*'s emphasis on constitutional limits on copyright to *Eldred*'s deferential standard).

17. *See* Samuelson, *supra* note 1 (analyzing the "complex, yet powerful" constitutional arguments crafted by counsel for Eldred, and the Court's one-dimensional response).

arguments, while avoiding some pitfalls in the case law. Not least, they elicited from the federal court of appeal a categorical statement that cried out for Supreme Court review: the proclamation that copyright is categorically immune from First Amendment review.[18] All the arguments could be broadly characterized as variants on a basic theme. Copyright is limited by both the scope of the Copyright Clause and by the First Amendment. Copyright legislation, because it gives individuals exclusive rights and thus the ability to restrict expression, must have some countervailing public benefit. Adding twenty years to copyright for works created decades ago has no public benefit, rather it is a windfall to the copyright holders. Thus, the copyright extension lacks a constitutional basis.

The plaintiffs also laid a strong factual basis for the challenge. A single plaintiff would have been sufficient to bring a test case challenging the constitutionality of the copyright extension. Instead, to make the adverse consequences of the extension concrete, a coalition of plaintiffs and amici came together, including publishers of classic books (both online and press), an Internet archive, music publishers, libraries, artists of many stripes, film preservationists, and more.

This Article explores the consequences of *Eldred* for intellectual property law and for constitutional law. The first two parts seek to place Eldred within the larger First Amendment and federalism case law.[19] As Part I discusses, with respect to First Amendment law generally, *Eldred* could well be read as the first First Amendment case to use "traditionalism" to define the scope of protected rights. Such a reading would represent a considerable change in First Amendment law. Part II discusses how to reconcile *Eldred* with the line of recent federalism cases, which it seemed to ignore. The rest of the Article looks to the effects of *Eldred*. As Part III discusses, with respect to copyright, *Eldred* leaves open the possibility of First Amendment scrutiny of nontraditional

18. Eldred v. Reno, 239 F.3d 372, 375–76 (D.C. Cir. 2001) (citing United Video v. FCC, 890 F.2d 1173, 1176–78 (D.C. Cir. 1989)).

19. As initial commentary indicated, the *Eldred* opinion itself offered surprisingly little discussion of how it fit into either the First Amendment or the Article I federalism case law. *See* Jack Balkin, *Is the Digital Millennium Copyright Act Unconstitutional under Eldred v. Ashcroft?* (January 18, 2003), *at* http://balkin.blogspot.com/2003_01_12_balkin_archive.html#87596430 (discussing whether, with respect to the First Amendment, *Eldred*'s deference toward traditional copyright protection would not extend to recent innovations in the Digital Millennium Copyright Act); Orin Kerr, *Eldred And Limited Powers* (Jan. 17, 2003), *at* http://volokh.blogspot.com/2003_01_12_volokh_archive.html (suggesting that although *Eldred* may seem inconsistent with the Court's recent Commerce Clause cases, *Eldred* did not involve the same conflict between state and federal powers); Eugene Kontorovich, *Constitutional Law And Tradition* (Jan. 18, 2003), *at* http://volokh.blogspot.com/2003_01_12_volokh_archive.html (suggesting that *Eldred*'s First Amendment result represented a reliance on tradition, which could lead to similar reliance in other First Amendment areas).

copyright protection. Congress has added various nontraditional protections to the copyright statute, such as protection for anti-circumvention technologies, for copyright management information, and other types of proposed protection against consumer copying. Such provisions may still be susceptible to challenge after *Eldred*. Part IV analyzes whether, within copyright law, *Eldred* could affect the ever-changing role of the fair use doctrine. Fair use has been threatened by various judicial decisions, legislation, and academic theories. *Eldred*, however, firmly grants fair use constitutional status, by making it a basis for the constitutionality of copyright law in general. Fair use may now also play a greater role in protecting expressive interests with respect to use of copyrighted works. Finally, Part V analyzes whether *Eldred* could also affect the interplay between federal and state intellectual property law. The Supremacy Clause gives Congress the primary role in regulating intellectual property, but courts have been relatively reluctant to read the federal copyright statute as preempting state law. *Eldred* gives strength to arguments that federal policies central to copyright, such as fair use and the idea/expression dichotomy, should not be frustrated by conflicting state law in such areas as software licensing and database protection.

I. *ELDRED*'S FIRST AMENDMENT ANALYSIS AS TRADITIONALISM

A. *Framing the First Amendment Issue in* Eldred

The free speech issue in *Eldred* was whether extending the term of existing copyrights by twenty years violated the First Amendment.[20] Copyright, by its nature, restricts expression. A copyright holder generally has the exclusive rights to make copies of the work, distribute copies to the public, adapt the work, perform the work publicly and display the work publicly.[21] Such restrictions raise the issue of freedom of speech for others who wish to use the work in their own expressive capacity.

The *Eldred* plaintiffs did not take the position that copyright is a content-based restriction on speech, which would require strict scrutiny. Copyright depends on the content of the relevant work, but does not differentiate between works based on viewpoint.[22] The plaintiffs contended that copyright is a content-neutral restriction on speech, subject to the sort of intermediate scrutiny applied in *Turner Broadcasting System, Inc.*

20. *See* Eldred v. Ashcroft, 537 U.S. 186, 218–19 (2003).
21. *See* 17 U.S.C. § 106 (2000).
22. *See, e.g.*, Bartnicki v. Vopper, 532 U.S. 514 (2001).

v. FCC.[23] Thus, the restriction would be constitutional only "if it advances important governmental interests unrelated to the suppression of free speech and does not burden substantially more speech than necessary to further those interests."[24]

The justifications for extending the term of existing copyrights might best be characterized as plausible. The primary purpose of copyright protection is to provide an incentive to create works.[25] That purpose is hardly served by extending the copyrights of existing works. However, such retrospective extension has been defended on several grounds. By consistently making all extensions retroactive, Congress could assure authors of the benefit of extensions that occurred after creation.[26] This assurance would add to the initial incentive to create the work.[27] The extension also was thought to harmonize U.S. law with the longer copyright terms in some jurisdictions, thus assuring U.S. authors of equal treatment abroad, permitting the U.S. to play a strong role in shaping international intellectual property regimes, and creating more incentives for foreign works to be distributed in the U.S.[28] Another rationale was that longer copyright terms would encourage copyright holders to invest in the "restoration and public distribution of their works."[29] Thus, there were colorable arguments served by the term extension.

Nevertheless, as many commentators have shown in the past few years, the strength of those arguments is dubious.[30] If the Court applied

23. 512 U.S. 622 (1994), *aff'd*, 520 U.S. 180 (1997). Plaintiffs relied on Neil Weinstock Netanel, *Locating Copyright Within the First Amendment Skein*, 54 STAN. L. REV. 1 (2001). *See also* Floyd Abrams, *First Amendment and Copyright*, 35 J. COPYRIGHT SOC'Y U.S.A. 1 (1987); C. Edwin Baker, *First Amendment Limits on Copyright*, 55 VAND. L. REV. 891 (2002); Yochai Benkler, *Free As the Air to Common Use: First Amendment Constraints on the Enclosure of the Public Domain*, 74 N.Y.U. L. REV. 354 (1999); Robert Denicola, *Copyright and Free Speech: Constitutional Limitations on the Protection of Expression*, 67 CAL. L. REV. 283 (1979); Paul Goldstein, *Copyright and the First Amendment*, 70 COLUM. L. REV. 983 (1970); Melville B. Nimmer, *Does Copyright Abridge the First Amendment Guarantees of Free Speech and Press?*, 17 UCLA L. REV. 1180 (1970); L. Ray Patterson, *Free Speech, Copyright, and Fair Use*, 40 VAND. L. REV. 1 (1987); Jed Rubenfeld, *The Freedom of Imagination: Copyright's Constitutionality*, 112 YALE L.J. 1 (2002); Diane Leenheer Zimmerman, *Information as Speech, Information as Goods: Some Thoughts on Marketplaces and the Bill of Rights*, 33 WM. & MARY L. REV. 665 (1992).

24. U.S. v. O'Brien, 391 U.S. 367, 377 (1968).

25. *See Eldred*, 537 U.S. at 212.

26. *See id.* at 204.

27. *See id.* at 205.

28. *See id.* at 206 n.13 (citing Graeme W. Austin, *Does the Copyright Clause Mandate Isolationism?*, 26 COLUM.-VLA J. L. & ARTS 17, 59 (2002)).

29. *Eldred*, 537 U.S. at 207.

30. *See Commentary on Copyright Term Extension*, *at* http://www.law.asu.edu/HomePages/Karjala/OpposingCopyrightExtension/commentary.html (collecting commentary criticizing the policy and constitutionality of the copyright term extension).

rigorous First Amendment scrutiny, they would probably not be sufficient to uphold the statute. The copyright extension would have difficulty meeting both parts of that test. Whether the extension advanced important governmental interests was questionable. In addition, the copyright extension by definition burdened speech. Since the extension applied across the board to all copyrights, it would very likely burden more speech than necessary.[31] So application of intermediate scrutiny would make it difficult for the copyright extension to pass muster. The key to the First Amendment case, then, was whether or not the Court chose to apply intermediate scrutiny.[32]

The *Eldred* Court refused to do so.[33] Rather, the Court held that copyright protection is generally not subject to First Amendment scrutiny.[34] The Court based this conclusion on several grounds. First, the Copyright Clause and First Amendment were adopted close together in time. This indicated that the Framers regarded copyright as consistent with the First Amendment.[35] Second, the Court considered that copyright and the First Amendment were also consistent in effect. Copyright is a restriction on speech, but its purpose is the same as the First Amendment—to promote speech.[36] By giving authors exclusive rights, copyright provides a strong incentive for the creation and dissemination of works.[37] Copyright law also has "built-in First Amendment accommodations."[38] Copyright protects only creative expression; it is not copyright infringement to copy ideas from a copyrighted work.[39] Thus,

31. The expansion of copyright beyond its incentive rationale has been widely noted. A key piece in the literature was written by a law professor who later became one of the Justices to decide *Eldred*, which added a nice twist to guessing the possible outcome. *See* Stephen Breyer, *The Uneasy Case for Copyright: A Study of Copyright in Books, Photocopies, and Computer Programs*, 84 HARV. L. REV. 281 (1970) (early piece recognizing that copyright protection was broader than necessary, even before the considerable broadening under the 1976 Act).

32. *See* Netanel, *supra* note 23; *see also* Rebecca Tushnet, *Copyright as a Model for Free Speech Law: What Copyright Has in Common With Anti-Pornography Laws, Campaign Finance Reform, and Telecommunications Regulation*, 42 B.C. L. REV. (2000) (discussing how copyright is difficult to square with First Amendment doctrine).

33. *See Eldred*, 537 U.S. at 221.

34. *See id.*

35. *See id.* at 219.

36. *See id.*

37. *See id.* ("[T]he Framers intended copyright itself to be the engine of free expression. By establishing a marketable right to the use of one's expression, copyright supplies the economic incentive to create and disseminate ideas." (quoting Harper & Row Publishers Inc. v. Nation Enters., 471 U.S. 539, 558 (1985)). A recent article opens up an area that has received too little attention: the incentives of users to further disseminate works. *See* Lior Jacob Strahilevitz, *Charismatic Code, Social Norms, and the Emergence of Cooperation on the File-Swapping Networks*, 89 VA. L. REV. 505 (2003).

38. *See Eldred*, 537 U.S. at 219.

39. *See id.* at 217–21.

copyright does not restrict communication of ideas. In addition, copyright also authorizes fair use of copyrighted works. Thus, others may copy works for such purposes as education, criticism, news reporting, or research.[40] Relying on these "traditional First Amendment safeguards" contained within copyright law, the Court held that First Amendment scrutiny is unnecessary where "Congress has not altered the traditional contours of copyright protection."[41]

A striking aspect of the First Amendment discussion in *Eldred* is the limited discussion of precedent. The Court made no effort to sift through its voluminous First Amendment case law, determine which of the many tests apply, and apply that test to the case at bar. Rather, the Court relied on two facts: (1) copyright has been around as long as the First Amendment, and (2) copyright contains limitations that serve to protect the freedom to distribute ideas.[42] The Court indicated that because Congress had been restricting speech through copyright since the founding of the nation, such restrictions were implicitly authorized.[43] Such an approach to constitutional interpretation can be understood as "traditionalism."[44]

B. *The Traditionalist Mode of Constitutional Interpretation*

Constitutional interpretation has several well-known approaches, which can be characterized as looking primarily to text, structure, history, ethos, and doctrine, each with variants.[45] Textualism seeks to be guided by the very words of the Constitution.[46] Intentionalists seek to

40. *See id.* at 219–20.
41. *Id.* at 221.
42. *See id.* at 219.
43. *See id.*
44. For an early commentator suggesting that *Eldred* be best explained as traditionalism, see Eugene Kontorovich, *Constitutional Law and Tradition* (Jan. 18, 2003), *at* http://volokh.blogspot.com/2003_01_12_volokh_archive.html ("Basically the Court's opinion says this is constitutional because no one, especially the Framers' generation, ever thought it was unconstitutional.") and Philippe de Croy, *Constitutional Law and Tradition* (Jan. 18, 2003), *at* http://volokh.blogspot.com/2003_01_12_volokh_archive.html (citing to Justice Scalia's classic statement of traditionalism in *Rutan* and expressing skepticism that *Eldred* would have much effect on First Amendment law in other areas). On traditionalism as a principle of constitutional interpretation generally, see Katharine T. Bartlett, *Tradition, Change, and the Idea of Progress in Feminist Legal Thought*, 1995 WIS. L. REV. 303; Anthony T. Kronman, *Precedent and Tradition*, 99 YALE L.J. 1029 (1990). Justice Scalia's use of traditionalism can be seen as part of a consistent judicial philosophy. *See* Eric J. Segall, *Justice Scalia, Critical Legal Studies, and the Rule of Law*, 62 GEO. WASH. L. REV. 911 (1994). Other commentators have criticized Justice Scalia's use of tradition. *See, e.g.,* Steven R. Greenberger, *Justice Scalia's Due Process Traditionalism Applied to Territorial Jurisdiction: The Illusion of Adjudication Without Judgment*, 33 B.C. L. REV. 981 (1992); David A. Strauss, *Tradition, Precedent, and Justice Scalia*, 12 CARDOZO L. REV. 1699 (1991).
45. 1 LAURENCE H. TRIBE, AMERICAN CONSTITUTIONAL LAW, 31 (3d ed. 2000).
46. *Id.* at 32.

determine what the Founders intended.[47] Structuralists seek to implement an overarching constitutional architecture.[48] Originalists seek the meaning of the Constitution as originally adopted and understood.[49]

"Traditionalism," a variant of originalism, is a term for a specific type of reliance on tradition.[50] Appeals to tradition are very common in constitutional law.[51] In some areas, such as personal jurisdiction, tradition plays an important part, although its precise role is unsettled and may be challenged by application to new contexts.[52] "Traditionalism" refers to a specific means of employing tradition in constitutional interpretation. In deciding whether an activity is constitutionally protected, a traditionalist approach looks to whether such activity was generally considered protected from government regulation.[53] Such a use of "negative precedent" has been followed in several areas of law, most notably in substantive due process cases.[54] Thus, traditionalist interpretation relies on long-standing practices to define the scope of protected rights, rather than abstract reasoning about what the scope of rights should be.

Like any mode of constitutional interpretation, traditionalism has advantages and pitfalls. Tradition can be a salutary safeguard on judicial competence, preventing judges from concocting new theories with unexpected effects.[55] Traditionalism can also be used to safeguard social cohesion and institutional legitimacy from being undermined by new judicially-created rights.[56] However, traditionalism can also mean sanc-

47. *Id.* at 47.

48. *Id.* at 40.

49. *Id.* at 48.

50. ANTONIN SCALIA, A MATTER OF INTERPRETATION: FEDERAL COURTS AND THE LAW (1997).

51. *See* David Luban, *Legal Traditionalism*, 43 STAN. L. REV. 1035 (1991) (discussing traditionalism in law generally and distinguishing between traditionalism and reliance on precedent).

52. *See, e.g.*, Catherine T. Struve & R. Polk Wagner, *Realspace Sovereigns in Cyberspace: Problems with the Anticybersquatting Consumer Protection Act*, 17 BERKELEY TECH. L.J. 989 (2002).

53. The use can cut both ways, to permit regulation. *See* Deborah A. Widiss, *Reviewing History: The Use of the Past as Negative Precedent in* United States v. Virginia, 108 YALE L.J. 237 (1998).

54. *See* L. Benjamin Young, Jr., *Justice Scalia's History and Tradition: The Chief Nightmare in Professor Tribe's Anxiety Closet*, 78 VA. L. REV. 581 (1992).

55. *See* Jay S. Bybee, *Common Ground: Robert Jackson, Antonin Scalia, and a Power Theory of the First Amendment*, 75 TUL. L. REV. 251 (2000).

56. Aaron J. Rappaport, *Beyond Personhood and Autonomy: Moral Theory and the Premises of Privacy*, 2001 UTAH L. REV. 441, 496; *see also* J. Richard Broughton, *The Jurisprudence of Tradition and Justice Scalia's Unwritten Constitution*, 103 W. VA. L. REV. 19, 22–23 (2000) ("Thus, Scalia's traditionalism both gives life to the Constitution and provides the discipline necessary among those charged with determining its meaning."); Timothy L. Raschke Shattuck, *Justice Scalia's Due Process Methodology: Examining Specific*

tioning historical types of state regulation, without respect to whether they in fact are compatible with our understanding of liberty.[57] It can serve to entrench power and unfair majoritarianism.[58] Moreover, traditionalism can facilitate result-oriented analysis, through "pick and choose" interpretivism. A judge may choose to invoke tradition where the outcome suits her, and rely on other forms of interpretation when it does not.[59] The mechanics of applying tradition are also problematic, as with any reliance on precedent. First, there are great historical problems in accurately identifying a tradition. Indeed, many Supreme Court cases feature Justices advocating inconsistent views of historical traditions.[60] For courts to truly identify tradition would require historical research well beyond the resources of appellate courts.[61] Even if the historical facts are not disputed, what constitutes a tradition and how broadly to define that tradition are unclear.[62] Depending on the level of generality used, the tradition in question could be narrowly or broadly understood.[63]

Although traditionalism has become part of the established analysis in some areas of constitutional law, traditionalism has not been part of First Amendment analysis. Justice Scalia has several times unsuccessfully argued for reliance on tradition to define free speech rights. His classic statement of traditionalism came in *Rutan v. Republican Party of Illinois*.[64] The issue in *Rutan* was whether it violated

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Traditions, 65 S. CAL. L. REV. 2743, 2789 (1992) (arguing that "well-established traditions and consensus should be determinative of due process in most cases").

57. *See* Daniel J.H. Greenwood, *Beyond the Counter-Majoritarian Difficulty: Judicial Decision-Making in a Polynomic World*, 53 RUTGERS L. REV. 781 (2001).

58. *See* Strauss, *supra* note 44, at 1708.

59. David Schultz, *Scalia on Democratic Decision Making and Long Standing Traditions: How Rights Always Lose*, 31 SUFFOLK U. L. REV. 319 (1997). Schultz discusses tensions on the Court over interpretive approaches, relying on JAMES F. SIMON, THE CENTER HOLDS: THE POWER STRUGGLE INSIDE THE REHNQUIST COURT (1995) and CHRISTOPHER E. SMITH, JUSTICE ANTONIN SCALIA AND THE SUPREME COURT'S CONSERVATIVE MOMENT (1993).

60. *See, e.g.*, Ron Shinn, Note, *Adler v. Duval County School Board*, 54 OKLA. L. REV. 775 (2001) (discussing reliance on tradition in both majority and dissenting opinions).

61. *See* A.C. Pritchard & Todd J. Zywicki, *Finding the Constitution: An Economic Analysis of Tradition's Role in Constitutional Interpretation*, 77 N.C. L. REV. 409 (1999).

62. *See* Richard H. Fallon, Jr., *A Constructivist Coherence Theory of Constitutional Interpretation*, 100 HARV. L. REV. 1189 (1987); Wilson R. Huhn, *Teaching Legal Analysis Using a Pluralistic Model of Law*, 36 GONZ. L. REV. 433 (2000–2001); *see also* Matthew D. Umhofer, *Confusing Pursuits: Sacramento v. Lewis and the Future of Substantive Due Process in the Executive Setting*, 41 SANTA CLARA L. REV. 437 (2001) (discussing competing approaches to defining relevant tradition).

63. *See* Kathleen M. Sullivan, *The Supreme Court, 1991 Term—Foreword: The Justices of Rules and Standards*, 106 HARV. L. REV. 22, 82 (1992) ("Justice Scalia's *R.A.V.* opinion approached First Amendment tradition at a much higher level of generality than his *Michael H.* opinion approached privacy.").

64. 497 U.S. 62 (1990).

the First Amendment for patronage practices in government employment (such as promotions and transfers) to be based on political affiliation.[65] Applying strict scrutiny First Amendment analysis, the majority held that such practices were unconstitutional because they were not narrowly tailored to serve vital government interests.[66] Justice Scalia dissented, arguing that the application of strict scrutiny to such practices was a misinterpretation of the First Amendment.[67] Rather, such patronage practices dated back to before the time of the First Amendment.[68] Accordingly, the First Amendment should be interpreted in light of the contemporaneous tradition, rather than the Court's own abstract reasoning.

> The provisions of the Bill of Rights were designed to restrain transient majorities from impairing long-recognized personal liberties. They did not create by implication novel individual rights overturning accepted political norms. Thus, when a *practice not expressly prohibited by the text of the Bill of Rights bears the endorsement* of a long tradition of open, widespread, and unchallenged use that dates back to the beginning of the Republic, we have no proper basis for striking it down. Such a venerable and accepted tradition is not to be laid on the examining table and scrutinized for its conformity to some abstract principle of First Amendment adjudication devised by this Court. To the contrary, such traditions are themselves the stuff out of which the Court's principles are to be formed. They are, in these uncertain areas, the very points of reference by which the legitimacy or illegitimacy of *other* practices is to be figured out. When it appears that the latest "rule," or "three-part test," or "balancing test" devised by the Court has placed us on a collision course with such a landmark practice, it is the former that must be recalculated by us, and not the latter that must be abandoned by our citizens.[69]

65. *See id.* at 70.

66. *See id.* at 96 (Scalia, J., dissenting).

67. *See id.* at 70 n.4.

68. *See id.*

69. *Id*. at 95–96 (emphasis in original)(footnote omitted); *see* DANIEL A. FARBER, THE FIRST AMENDMENT 204–05 (2d ed. 2003) (quoting the language from Justice Scalia's dissent in *Rutan* and discussing how adoption of such an approach would considerably alter the landscape of First Amendment jurisprudence). Justice Scalia has also urged traditionalism in dissents in other areas. *See, e.g.*, United States v. Virginia, 518 U.S. 515, 566 (1996) (Justice Scalia dissenting from Court's holding that Virginia violated the Equal Protection Clause by maintaining separate men's and women's military colleges: "It counts for nothing the long tradition, enduring down to the present, of men's military colleges supported by both States and the Federal Government"). *United States v. Virginia* makes an interesting comparison to

Despite the urging of Justice Scalia in *Rutan* and several subsequent dissents (often quoting the very language above), the Court as a whole has never adopted traditionalism as part of its First Amendment analysis.[70] Indeed, reliance on traditionalism would "have broad implications for First Amendment doctrine."[71] The fact that a practice is a long-standing tradition does not generally shield it from First Amendment scrutiny. To the contrary, the course of First Amendment jurisprudence has been one of giving protection to speech that had been traditionally regulated.[72] Before the twentieth century, the First Amendment had seldom been used to prevent state regulation of speech. The Court, however, steadily increased the categories of speech that were protected as well as the level of scrutiny that would apply to state regulation. The Court did not shy at protecting a category of speech simply because it had not been protected before. However, some traditionalism is implicit in First Amendment case law. For example, courts have accorded states great discretion in regulating speech in institutions such as schools and prisons. There "can be little doubt that the strong tradition of restricting speech within these institutions had much to do with the decisions."[73]

C. Eldred's *Application of Traditionalist Analysis*

Eldred took an approach along traditionalist lines. The Court placed great weight on tradition, and declined to engage in abstract reasoning about what limits the First Amendment placed on copyright protection. To the contrary, the Court looked to "traditional First Amendment safeguards" within copyright itself.[74] The idea/expression dichotomy ensured that although an author's expression may be protected by copyright, ideas may always be freely copied. Fair use ensures that even expression may be copied, where the balance of relevant factors tips in favor of fair use. Beyond those traditional practices, the Court found it unnecessary to determine whether First Amendment interests were properly balanced. In short, the Court relied exclusively on tradition in respecting Congress's power to define copyright protection. *Eldred* thus treated copyright the way that Justice Scalia would have treated patronage practices in *Rutan*. Because copyright has been around since the time of the First Amendment and has been generally unchallenged, the First Amendment would not be interpreted to put limits on it.

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the *Eldred* case, because the majority opinion, authored by Justice Ginsburg, took a much less deferential approach to tradition than her opinion in *Eldred*. *See* de Croy, *supra* note 44.

70. *See* Farber, *supra* note 69.
71. *Id.* at 204.
72. *See id.* at 204–05.
73. *Id.*
74. Eldred v. Ashcroft, 537 U.S. 186, 219 (2003).

Eldred next used a different type of tradition in defining the scope of copyright's insulation. The Court rejected the dubious statement by the court below that copyright was categorically immune from First Amendment scrutiny.[75] Few categories of speech are categorically immune from First Amendment scrutiny. Such immunity obtains in limited areas where the speech is deemed to lack any social value, such as threats.[76] To completely insulate copyright from First Amendment scrutiny would permit Congress to pass any type of restriction on speech it wished simply by making it part of Chapter 17 of the United States Code, the Copyright Act. For example, in *Reno v. ACLU*,[77] the Court struck down certain regulation of the Internet as contrary to the First Amendment. Congress could simply reenact the same regulation characterized as copyright law. To avoid such broad immunity, the *Eldred* Court restricted its ruling, relying once again on tradition. First Amendment scrutiny would not apply where Congress had "not altered the traditional contours of copyright."[78]

Eldred did not explicitly invoke the *Rutan* line of cases, or classify itself as relying on traditionalism, but the opinion lends itself to interpretation as relying on traditionalism. One could simply construe it as relying on text and structure, interpreting the Constitution as a whole. The Copyright Clause and the First Amendment were roughly contemporaneous, so the First Amendment should not be read as limiting the powers granted under the Copyright Clause. Such a reading, however, runs afoul of at least two objections. First, the Court relied primarily on matter arising after the adoption of the Constitution and Bill of Rights, such as the fair use doctrine, the idea/expression dichotomy, and congressional and judicial formation of the contours of copyright law.[79] Second, the *Eldred* Court expressly disavowed the lower court's ruling that copyright legislation is categorically immune from First Amendment scrutiny.[80] In defining the interplay between copyright and the First Amendment, it looked not to lines set by the text or structure of the Constitution, but rather to the traditional contours of copyright law.[81]

An intentionalist interpretation of *Eldred* is unsatisfactory, for similar reasons. The Court did not bolster its approach with an analysis of the Framers' intention with respect to the interplay between the Copyright Clause and the First Amendment. The Court recognized that the purpose

75. *See id.* at 221.
76. *See* Virginia v. Black, 123 S. Ct. 1536 (2003).
77. 521 U.S. 844 (1997).
78. *Eldred*, 537 U.S. at 221.
79. *See id.* at 217–22.
80. *See id.* at 221.
81. *See id.*

of copyright was to promote the creation and dissemination of expression.[82] The First Amendment and the Copyright Clause were adopted around the same time, indicating a general understanding on the part of the Framers that copyright was consistent with freedom of speech. Beyond that general recognition, the Court did not look to the intent of the Framers in implementing copyright. Notably, the Court has freely exercised First Amendment scrutiny when Congress has used its other powers in ways that unduly restrict the freedom of speech. *Eldred* did not offer any reason why that would have been the intention of the Framers.

Eldred's summary treatment of First Amendment law also accords with a traditionalist reading. *Eldred* made little attempt to fit the case within the abstract approach typical of First Amendment law (and contrary to a traditionalist approach). *Eldred* makes little discussion of First Amendment law generally and how the case fits within it. Rather, it treats copyright as *sui generis*. *Eldred* also made short work of the plaintiff's attempt to fit the case within the overall structure of First Amendment doctrine. In rejecting the argument that the long line of intermediate scrutiny cases applied, the Court distinguished them simply by saying that "the First Amendment securely protects the freedom to make—or decline to make—one's own speech; it bears less heavily when speakers assert the right to make other people's speeches."[83] The Court thus indicated that originality is a key factor in First Amendment protection, but the originality of speech has never been part of the various tests for evaluating laws that restrict speech. Many of the Supreme Court's own cases struck down restrictions on speech or expressive activity that consisted of distributing the speech of others. Indeed, First Amendment protections have applied even where the speech was obtained through illegal means, such as a recording of a phone conversation about union negotiations[84] and the *New York Times* publishing secret Defense Department documents about the Vietnam War.[85] So originality is hardly a requirement for First Amendment protection. Moreover, the Court's language about "other people's speeches" does not note that many copyrights are owned not by the original creator, but by employers or transferees. So "other people's speeches" must mean that speech can be owned, for First Amendment purposes—another

82. *See id.* at 219.

83. *Id.* at 221.

84. Bartnicki v. Vopper, 532 U.S. 514 (2001).

85. New York Times Co. v. United States, 403 U.S. 713 (1971); *see* Eugene Volokh, *Freedom of Speech and Intellectual Property: Some Thoughts After* Eldred*,* 44 Liquormart*, and* Bartnicki, HOUS. L. REV., (forthcoming IP Symposium Issue 2003) (giving several reasons why nonoriginal speech may be constitutionally valuable).

novel doctrine that would bear analysis under the case law. Finally, copyright infringement often involves more than simply copying others' speech. Rather, it can be using the work of another as a basis to create a new creative work. So the Court's reference to "the speech of others" cannot be the full basis for creating a First Amendment enclave for copyright.

In short, *Eldred* may be best read as applying a traditionalist approach. The Court did not explicitly invoke traditionalism, but it did not explicitly invoke any interpretive approach or even any major First Amendment doctrine. *Eldred* relied on tradition to define whether the speech was protected (by holding that copyright is generally immune from First Amendment protection), to supply safeguards based on tradition rather than abstract tests (the traditional built-in safeguards of fair use and the idea/expression dichotomy) and to define the scope of protection (by limiting its ruling to the "traditional contours of copyright protection"). Such a traditionalist approach may well be the only way to generally uphold copyright legislation in the long run. If copyright were subject to First Amendment scrutiny, then upholding copyright would require finding some countervailing advantage to the speech restrictions inherent in copyright. The steady broadening of copyright protection would make it quite difficult to do so in a number of areas.[86] Moreover, opening copyright up to First Amendment scrutiny could require an endless series of cases.

The question that then arises is what role *Eldred* will play in future First Amendment case law.[87] As noted above, reliance on tradition to define the scope of protected rights represents a new turn in First Amendment case law. Here, the many vices of traditionalism raise their head. Tradition is easy to invoke, but difficult to define and prove. Justices are likely to have different views of both the relevant traditions and the role of tradition in a particular case (just as Justice Stevens' dissent in *Eldred* disputes the majority's conclusion that there was a long-standing congressional practice of making copyright extensions retroactive). So *Eldred* is unlikely to change the Court's overall approach to First Amendment issues in a determinative way.[88] Where *Eldred* could play a role is in the application of the First Amendment in the area of

86. *See* Rubenfeld, *supra* note 23 (suggesting that a "good deal" of copyright, such as the exclusive right to prepare derivative works, is inconsistent with the First Amendment).

87. A related issue is the extent of freedom of expression in jurisdictions worldwide. *See* Graeme W. Austin, *Social Policy Choices and Choice of Law for Copyright Infringement in Cyberspace*, 79 OR. L. REV. 575 (2000).

88. *See* de Croy, *supra* note 44 (expressing skepticism that Justices will "adhere to the same principles of interpretation across widely divergent sorts of constitutional cases, even when those principles produce outcomes they dislike").

intellectual property protection. As discussed below in Part III, *Eldred* insulated traditional copyright from First Amendment scrutiny, but implicitly left open to scrutiny non-traditional forms of intellectual property.

II. *ELDRED*'S ENUMERATED POWERS ANALYSIS: TRADITIONALISM AND FEDERALISM

A. Eldred *as a Departure from Federalism Precedent*

The second constitutional issue in *Eldred* was whether the copyright extension exceeded the powers of Congress under the Copyright Clause.[89] This argument drew strength from the recent trend of the Court to read real limits into Congress's enumerated powers under Article I of the Constitution, sometimes called the "new federalism."[90] For decades the Court had accorded great deference to Congress with respect to defining the scope of congressional powers. In particular, the Court had held that Congress's power to regulate commerce extended very far. Indeed, so great was the Court's deference that many wondered whether there was any practical limit to the extent of the commerce power. The tide turned in *United States v. Lopez*,[91] where the Court held that the power to regulate commerce did not authorize a federal statute prohibiting possession of guns in schools. Subsequently, *United States v. Morrison* held that the power to regulate commerce did not authorize portions of the Violence Against Women Act, which regulated gender-based crimes.[92] In these cases, the Court made clear that Congress's power would be broadly construed, but was subject to outer limits.[93] In particular, the Court scrutinized congressional action closely because the greater the power of the federal government under the Commerce Clause, the less room left for states to regulate.

89. *See* Eldred v. Ashcroft, 537 U.S. 186, 194 (2003).

90. *See, e.g.*, Philip P. Frickey & Steven S. Smith, *Judicial Review, the Congressional Process, and the Federalism Cases: An Interdisciplinary Critique*, 111 YALE L.J. 1707 (2002).

91. 514 U.S. 549 (1995); *see* Barry Cushman, *Formalism and Realism in Commerce Clause Jurisprudence*, 67 U. CHI. L. REV. 1089 (2000); Lino A. Graglia, *United States v. Lopez: Judicial Review Under the Commerce Clause*, 74 TEX. L. REV. 719 (1996); Stephen M. McJohn, *The Impact of United States v. Lopez: The New Hybrid Commerce Clause*, 34 DUQ. L. REV. 1 (1995). On federalism as a structural approach to constitutional interpretation generally, see Michael W. McConnell, *Federalism: Evaluating the Founders' Design*, 54 U. CHI. L. REV. 1484 (1987).

92. 529 U.S. 598 (2000).

93. Bradley A. Harsch, Brzonkala, Lopez, *and the Commerce Clause Canard: A Synthesis of Commerce Clause Jurisprudence*, 29 N.M. L. REV. 321 (1999) (criticizing *Lopez* as setting an unworkable standard).

The *Eldred* plaintiffs sought to ride that wave of change in the Court's approach to scrutiny of Congress's enumerated powers. They argued that the copyright extension similarly exceeded the outer limits of the Copyright Clause.[94] Congress could not use the commerce power to regulate anything even indirectly linked to commerce. Likewise, Congress's power to grant copyright for limited times to promote creativity could not be stretched to granting copyrights with no real time limit on works that had been created decades ago.[95] Indeed, the textual argument for limits on the copyright power seemed even stronger than that for the commerce power, because the Copyright Clause itself contained a preamble with limiting language.[96]

Eldred, however, declined the opportunity to define the outer limits of the Copyright Clause. The Court did not read the Copyright Clause itself to impose limits on the intellectual property regime chosen by Congress. Thus, copyright legislation would not be subject to review of whether it indeed served the avowed purpose of the Clause, to further the "Progress of Science." Rather, *Eldred* largely left it to Congress to choose how to regulate in the area of intellectual property: "As we read the Framers' instruction, the Copyright Clause empowers Congress to determine the intellectual property regimes that, overall, in that body's judgment, will serve the ends of the Clause."[97]

One can read *Eldred* as inconsistent with the Commerce Clause cases.[98] In the Commerce Clause area, the Court imposed real limits on the extent of an enumerated congressional power. In *Eldred*, the Court did not define any such limit. Moreover, the Justices in the majorities in *Lopez* and *Morrison* (putting limits on the Commerce Clause) joined the majority in *Eldred* (declining to put limits on the Copyright Clause). To put limits on one Article I power but not another seems quite inconsis-

94. *See Eldred*, 537 U.S. at 193. For a philosophical approach toward construing the Copyright Clause, see Craig Allen Nard, *Legitimacy and the Useful Arts*, 10 HARV. J.L. & TECH. 515 (1997).

95. Paul J. Heald & Suzanna Sherry, *Implied Limits on the Legislative Power: The Intellectual Property Clause as an Absolute Constraint on Congress*, 2000 U. ILL. L. REV. 1119 (proposing a framework for analyzing Congress's power under the Intellectual Property Clause, and arguing that copyright extension clearly exceeded Congress's constitutional authority).

96. *See* U.S. CONST., art. I, § 8 ("Congress shall have Power . . . to promote the Progress of Science . . . by securing [to Authors] for limited Times . . . the exclusive Right to their . . . Writings."). Some have noted that the phrase "to promote the Progress of Science" could literally be read as the grant of power in the Clause, but the Clause is more often read as a power to grant exclusive rights.

97. *Eldred*, 537 U.S. at 222.

98. *See* Kerr, *supra* note 19; de Croy, *supra* note 44 (discussing the apparent discrepancy between *Lopez* and *Eldred*).

tent. More than one commentator regarded the "strict constructionists" on the Court as abandoning the "principles of limited government."[99]

B. *Distinguishing the* Eldred *Approach to Federalism*

There are several ways one might seek to distinguish the Commerce Clause cases from *Eldred*. One could characterize the cases as involving different types of boundaries. The Commerce Clause cases were core federalism cases, dealing with the balance of federal and state powers.[100] The Court was deciding which matters could be regulated by Congress and which matters were left to the states.[101] By striking down federal laws regulating possession of guns in school zones and regulating gender-based crimes, the Court left those areas open to exclusive state regulation. Broadly stated, the cases permit federal legislation in commercial areas and state legislation in social areas.[102] Indeed, the limits to the Commerce Clause were defined in part by looking to areas of "traditional" state authority.[103] *Eldred*, by contrast, was not specifically about a balance between federal and state powers. Striking down the copyright term extension would not have left it to states to pass such extensions. Rather, the relevant boundary was between federal regulation and no regulation at all.[104] In this reading, "*Lopez* and *Morrison* are less about limited government than they are about limited federal government."[105] So if federalism is about the balance between state and federal interests, then *Eldred* might not implicate federalism as directly as did the Commerce Clause cases.

Although *Eldred* was not about a specific conflict between federal power and state power, it does affect the balance of those powers. Congress's power to regulate intellectual property carries with it the power to preempt state regulation of the same subject matter. The federal copyright and patent laws both preempt state law.[106] Accordingly, the greater power Congress has to regulate intellectual property, the less power

99. Glenn Reynolds, *Copyrights and Creativity* (Jan. 16, 2003), *at* http://web.archive.org/web/20030207033652/http://www.msnbc.com.news/856672.asp.

100. *See* Kerr, supra note 19.

101. *See* Grant S. Nelson & Robert J. Pushaw, Jr., *Rethinking the Commerce Clause: Applying First Principles to Uphold Federal Commercial Regulations but Preserve State Control Over Social Issues*, 85 IOWA L. REV. 1 (1999).

102. *Id.*

103. *See* James B. Staab, *The Tenth Amendment and Justice Scalia's "Split Personality,"* 16 J.L. & POL. 231 (2000).

104. Kerr, *supra* note 19.

105. *Id.*

106. For a discussion of the preemption effects of *Eldred*, see *infra* Part V.

states have.[107] The shift in balance is not hypothetical. For example, *Feist Publications v. Rural Telephone Service*[108] held that Congress could not grant copyright to works that lacked originality, such as compilations of data with no creative components. Accordingly, database proprietors have since relied on state law, such as contract, trade secret or misappropriation. A shift in congressional power thus does affect the balance of federal and state powers.

One could also distinguish the Commerce Clause cases as involving far greater extensions of federal power. The Constitution grants Congress simply the power to regulate commerce between the states. Congressional legislation under this power had gone far beyond a literal reading of the words. The recent Commerce Clause cases can be read as permitting Congress to legislate far beyond the literal language of the Clause, but to recognize that at some point the words must have some meaning. If the activity is "truly local," and infringes an area of "traditional state interests," then some outer limit must be recognized or the concept of enumerated powers loses its meaning.[109]

Eldred, one could argue, did not approach such outer limits. The Copyright Clause authorizes Congress to grant copyrights, and the copyright extension was about copyrights. The argument in *Eldred* was that Congress was going beyond the literal language of the Copyright Clause. The Court, however, still allows Congress to go well beyond the literal language of the Commerce Clause. Only when Congress went to the outer limits of the broadest possible reading of the Commerce Clause did the Court step in. By analogy, there might be issues if Congress started using the Copyright Clause as a basis for unrelated legislation. In *Eldred*, Congress was not using the Copyright Clause to regulate unrelated subject matter, such as guns in schools or gender-related violence. The copyright extension was still about copyrights, whereas the regulations in the Commerce Clause cases had little to do with commerce.

The counterargument is that Congress was approaching such outer limits with the copyright extension. If the Copyright Clause serves as an incentive to produce works, then extending copyright on works created in the 1920s (and adding twenty years to today's works, thus extending the term from 2073 to 2093) is just as tenuous as the connection between guns in schools and interstate commerce. Moreover, the language of the

107. *See* Alice Haemmerli, *Insecurity Interests: Where Intellectual Property and Commercial Law Collide*, 96 COLUM. L. REV. 1645, 1653 (1996) ("Copyrights, patents, and trademarks are all subjects of federal statutes, and all present federalism problems in the commercial law context. In each case, the question is whether, and to what extent, federal law preempts state law under the Supremacy Clause.").

108. 499 U.S. 340 (1991).

109. *See* United States v. Lopez, 514 U.S. 549.

Copyright Clause itself is much more limited than the Commerce Clause. The Copyright Clause has a limiting preamble ("To promote the Progress of Science . . .") and grants Congress only the very specific power to grant copyrights and patents. The Commerce Clause grants Congress a general power to regulate (as opposed to granting specific exclusive rights) over a huge subject matter (interstate commerce). So if the huge, undefined area has definite limits, surely the narrow, specialized area has limits. However, *Eldred* did not merely hold that the copyright extension did not surpass the relevant limits; rather, the Court did not define any limits at all. So the text of the clauses fails to distinguish the two lines of cases.

Perhaps the most convincing distinction between the Commerce Clause cases and *Eldred* lies with a traditionalist interpretation. The Court upheld regulation in *Eldred* that was consistent with tradition, and struck down the regulations in the Commerce Clause cases that were not consistent with tradition. The Court had quite different views of congressional practices under the Commerce Clause and Copyright Clause. During the early times of the nation, Congress legislated much more narrowly under the Commerce Clause.[110] Once Congress did start to expand its approach, the early Supreme Court resisted. Many of the early cases construed the commerce power quite narrowly.[111] Early Supreme Court cases held that the power to regulate interstate commerce did not extend to regulation of manufacturing of goods for commerce,[112] mining of coal to be shipped in interstate commerce,[113] wages of workers dealing with products shipped in commerce,[114] pensions of railroad workers,[115] or major league baseball.[116] The Court subsequently rejected such limitations on the commerce power, and regularly upheld federal legislation in such areas, where there was an effect on interstate commerce.[117] Congress then proceeded to rely on the commerce power to legislate in areas only indirectly related to commerce. The Court acquiesced in those cases as well.[118] So at the time of *Lopez*, there was no relevant tradition dating back to the time of the Constitution. Rather, the Commerce Clause had been used narrowly by Congress, then more broadly, then narrowed by

110. *Id.*
111. *Id*.
112. *See* United States v. E. C. Knight Co., 156 U.S. 1 (1895).
113. *See* Carter v. Carter Coal Co., 298 U.S. 238 (1936).
114. *See* A. L. A. Schechter Poultry Corp. v. United States, 295 U.S. 495 (1935).
115. *See* R.R. Ret. Bd. v. Alton R.R. Co., 295 U.S. 330, 362 (1935).
116. *See* Fed. Baseball Club of Baltimore, Inc. v. Nat'l League, 259 U.S. 200 (1922).
117. *See* United States v. Lopez, 514 U.S. 549 (1995) (discussing cases shifting approach to interpretation of Commerce Clause powers).
118. *See id.*

Court decisions, then greatly broadened by Congress and Court decisions.

In finally imposing outer limits on the commerce power, the Court looked explicitly to tradition. *Lopez* indicated that the federal commerce power did not extend to regulation of noneconomic activity that was of "traditional concern" to states.[119] Such areas would include family law, education, and criminal law, where they governed noncommercial aspects of life. By contrast, federal power to regulate purely commercial activity remained strong after *Lopez*, even where the link to *interstate* commerce was indirect. In short, *Lopez* represented a view of federalism that allocated commercial regulation to Congress and social regulation to the States.[120] Thus, *Lopez* is consistent with traditionalism both in overruling federal regulation (which had not been sanctioned by tradition) and in defining the scope of the relevant federal power (by reference to tradition).

Eldred's reading of the copyright extension would also fit comfortably within a traditionalist interpretation. Indeed, the primary reason that the Court upheld the copyright extension is that it saw it as continuing a long-standing tradition in copyright legislation.[121] The Court gave great weight to an "unbroken congressional practice" of making each extension of copyright apply to existing copyrights.[122] In so doing, the Court obliquely took the traditionalist view of valuing experience over abstract reasoning, pronouncing the traditionalist mantra that "a page of history is worth a volume of logic."[123]

Additional support for a traditionalist reading of *Eldred* comes in the Court's characterization of the issues, which held the very novelty of plaintiff's arguments against them. It framed the constitutional arguments against the statute as "several novel readings" of the Copyright Clause, before rejecting them seriatim.[124] The majority opinion further disparaged the plain novelty of Justice Breyer's suggested constitutional analysis.[125] The Court's final paragraph chose reliance on long-standing practice over "inventive constitutional interpretation."[126] In short, as with the First Amendment argument, a primary reason for rejecting the plaintiff's arguments was that such arguments had not been raised before.

119. *See id.*
120. *See* Nelson & Pushaw, *supra* note 101.
121. *See* Eldred v. Ashcroft, 537 U.S. 186, 200 (2003).
122. *See id.*
123. *Id.* (quoting New York Trust Co. v. Eisner, 256 U.S. 345, 349 (1921)).
124. *See id.* at 222.
125. *See id.* at 205 n.10.
126. *Id.* at 222.

If *Eldred* has a place within federalism doctrine, it would be as a counterweight. The Commerce Clause cases raised many issues as to whether the Court will restrict congressional power in other areas. Where such federal powers (like *Eldred* and unlike the commerce power cases) have not been restricted by earlier Supreme Court cases, *Eldred* would counsel restraint by the Court. As to the more specific area of federalism and intellectual property, *Eldred* would have effects in at least two areas. First, there have been a number of proposals to implement new types of intellectual property protection, which would be substantially different from traditional intellectual property law. Congress did implement *sui generis* protection for microchip architecture,[127] but much more innovative proposals have been made to tailor intellectual property protection for changes in technology and culture.[128] *Eldred*'s Copyright Clause analysis, unlike its First Amendment analysis, did not limit its deference to "traditional" forms of protection.[129] Accordingly, *Eldred* would apparently authorize Congress to pursue such non-traditional forms of protection (subject of course to other constitutional limits, such as the First Amendment).[130] The second area in which *Eldred* may affect federalism is in preemption analysis. Federalism implicates the choice between federal and state regulation in intellectual property, as in numerous other spheres.[131] As Part V below discusses in more detail, *Eldred* may lead to greater federal control (and a less restrictive regime than some state laws) in the area of intellectual property.

III. FIRST AMENDMENT SCRUTINY OF COPYRIGHT AFTER *ELDRED*

A. *What are the "Traditional Contours of Copyright Law"?*

Eldred refused to apply First Amendment scrutiny to the copyright extension.[132] The Court's language was broad enough that copyright, both in general and as applied to particular cases, is likely not to be subject to First Amendment scrutiny. After *Eldred*, parties will generally be

127. Semiconductor Chip Protection Act, 17 U.S.C. §§ 901-14 (2000).

128. *See, e.g.,* Pamela Samuelson et al., *A Manifesto Concerning the Legal Protection of Computer Programs*, 94 COLUM. L. REV. 2308 (1994); Molly A. Holman & Stephen R. Munzer, *Intellectual Property Rights in Genes and Gene Fragments: A Registration Solution for Expressed Sequence Tags*, 85 IOWA L. REV. (2000); Mark Aaron Paley, *A Model Software Petite Patent Act*, 12 SANTA CLARA COMPUTER & HIGH TECH. L.J. 301 (1996).

129. *See supra* Part I.

130. *See* discussion at *supra* Part I and *infra* Part III.

131. John F. Duffy, *Harmony and Diversity in Global Patent Law*, 17 BERKELEY TECH. L.J. 685 (2002) (discussing federalism analysis in areas "from corporate law, international antitrust law, local and international taxation, tort law, securities regulation, and environmental law").

132. *See supra* Part I.

unable to contend that the First Amendment shields them from liability for copyright infringement. Rather, they must rely on the internal protections of copyright law such as fair use, the idea/expression dichotomy, and first sale.[133] Nevertheless, *Eldred* was still careful to leave the door slightly open. It expressly rejected the lower court's flat statement that copyright is "categorically immune from challenges under the First Amendment."[134] Rather, the Court stated that First Amendment scrutiny would be unnecessary where "Congress has not altered the traditional contours of copyright protection."[135] Presumably, legislation that goes beyond the traditional contours of copyright would be subject to First Amendment scrutiny. This does not mean that non-traditional copyright protection will be invalid; it just means that it will be subject to a higher level of scrutiny than traditional protection. A key question after *Eldred* is defining the "traditional contours of copyright protection."[136] The problem of "tradition" thus raises its head once again, with all the various problems of defining and comparing tradition.[137]

Eldred itself indicates that the "traditional contours" of copyright will not be measured strictly by the form of copyright around the time of the Constitution. The first copyright statute of 1790 provided 14 years of protection for published maps, charts, and books.[138] Until 1976, copyright applied only to published works (subject to some narrow exceptions).[139] The present copyright statute is much broader in all respects. Far beyond maps, charts and books, copyright now applies to any tangible form of creative work.[140] The term has gone from 14 years to the life of the author plus 70 years.[141] Protection no longer depends on publication, so innumerable unpublished works (such as letters, doodles, emails, artworks and so on) are copyrighted.[142] The exclusive rights are also broader, including rights such as the right to prepare derivative

133. On the difficulties of relying on the idea/expression dichotomy, see Alfred C. Yen, *A First Amendment Perspective on the Idea/Expression Dichotomy and Copyright in a Work's Total Concept and Feel*, 38 EMORY L.J. 393 (1989).

134. Eldred v. Ashcroft, 537 U.S. 186, 221 (2003).

135. *Id.* For an analysis of the likely constitutional issues in intellectual property law after *Eldred*, see Samuelson, *supra* note 1.

136. An interesting question would arise if Congress gave copyright-like protection under a newly named form of intellectual property, as some have proposed. *See* Pamela Samuelson et al., *supra* note 128.

137. *See* discussion in *supra* Part I.

138. *See Eldred*, 537 U.S. at 229–32 (Stevens, J., dissenting).

139. *See id.* at 193.

140. *See* 17 U.S.C. § 102(a) (2000) ("Copyright protection subsists . . . in original works of authorship fixed in any tangible medium of expression . . . .")

141. William Patry, *The Failure of the American Copyright System: Protecting the Idle Rich*, 72 NOTRE DAME L. REV. 907 (1997).

142. *See* 17 U.S.C. § 102 (2000) (protection now depends only on fixation, not publication).

works.[143] *Eldred* nevertheless deemed present-day copyright to share the same contours as its 1790 predecessor.[144] Moreover, in looking to the traditional form of copyright, the Court included copyright's built-in First Amendment protections, such as fair use and the idea/expression dichotomy.[145] Those "traditional" protections were to be found nowhere in the copyright statute until the 1976 Act, but were rather incorporated by judicial opinions long after the first copyright statute.[146] Given *Eldred*'s broad approach to tradition, a clear definition of the traditional contours of copyright is likely to be hard to find.

Rather, the question will arise with particular legislative enactments, such as the anti-circumvention provisions added by the 1998 Digital Millennium Copyright Act.[147] The anti-circumvention provisions provide a measure of legal protection, where a copyright holder has used technical means to prevent access to a work (such as scrambling a cable television signal) or to prevent copying of a work (such as the anti-copying code on some CDs).[148] The anti-circumvention provisions make it illegal to circumvent anti-access technology, or to traffic in devices or services to circumvent either anti-access or anti-copying technology.[149] It would violate the anti-circumvention provisions to unscramble the scrambled cable signal to a home (for circumventing an anti-access measure) or to sell unauthorized cable boxes (for trafficking in circumvention devices).[150]

A strong argument can be made that the anti-circumvention provisions go well beyond the "traditional contours" of copyright protection,

143. *See* 17 U.S.C. § 106 (2000).

144. *See supra* Part I.

145. *See supra* Part I.

146. *See* 17 U.S.C. § 107 (2000) (codification of fair use introduced by 1976 Act).

147. *See* Balkin, *supra* note 19 (early comment after *Eldred* arguing that DMCA is clearly an untraditional form of copyright protection, ripe for First Amendment scrutiny). For a description of the DMCA and its enactment, see Jane C. Ginsburg, *Copyright Legislation for the "Digital Millennium"*, 23 COLUM.-VLA J.L. & ARTS 137 (1999). For trenchant criticism of the provisions, see Glynn S. Lunney, Jr., *The Death of Copyright: Digital Technology, Private Copying, and the Digital Millennium Copyright Act*, 87 VA. L. REV. 813 (2001); Pamela Samuelson, *Intellectual Property and the Digital Economy: Why the Anti-Circumvention Regulations Need to be Revised*, 14 BERKELEY TECH. L. J. 519 (1999); Alfred Yen, *What Federal Gun Control Can Teach Us About the DMCA's Anti-Trafficking Provisions* (Mar. 21, 2003), *at* http://ssrn.com/abstract_id=388081 (adding suggestions for reforming the DMCA). *See also* Jane C. Ginsburg, *Copyright Use and Excuse on the Internet*, 24 COLUM.-VLA J.L. & ARTS 1, 14–20 (2000); David Nimmer, *Back From The Future: A Proleptic Review of the Digital Millennium Copyright Act*, 16 BERKELEY TECH. L. J. 855 (2001).

148. *See* 17 U.S.C. § 1201 (2000).

149. *See* 17 U.S.C. § 1201.

150. *See* Digital Millennium Copyright Act of 1998, U.S. Copyright Office Summary (Dec. 1998).

and are thus subject to First Amendment scrutiny.[151] The copyright statute had never provided explicit protection for anti-copying or anti-access technology.[152] This type of protection is also quite different from the traditional exclusive rights of the copyright holder: the rights to make and distribute copies, to adapt the work, and to perform or display the work publicly. The exclusive rights never implicated access to the work, as such. Someone in possession of a copyrighted book could freely read the book.[153] The anti-circumvention provisions make it illegal to access a copy of an encrypted work, even if one owns the copy.

In addition, the anti-circumvention provisions do not contain copyright's traditional built-in First Amendment safeguards. The anti-circumvention provisions do not have a general exception for fair use.[154] Nor do they respect the idea/expression dichotomy, as unauthorized access or trafficking would violate the literal language of the provision, even if the purpose is to gain access only to the ideas or other unprotected material in the work.[155] Thus, anti-circumvention measures could effectively protect even public domain material.[156] In addition, the anti-circumvention provisions may have the effect of reducing the fair use rights in a work. Someone might have a copy of a work, and wish to make a copy that would be protected by fair use. If the copy is protected by anti-copying technology (such as encryption), it would violate the anti-trafficking provisions for someone else to provide the necessary device or services to circumvent the anti-copying technology, even if fair use authorized the making of the copy.[157] For example, suppose Reader had a copy of a copyrighted novel in electronic form. The electronic book contains code that prevents Reader from making additional copies. Reader wishes to make a copy of a short passage for nonprofit teaching purposes, presumably a fair use. If Decoder posted an encryption pro-

151. *See* Balkin, *supra* note 19 (characterizing DMCA as a "new species of intellectual property protection").

152. *See* sources cited *supra* note 147.

153. *Cf.* 17 U.S.C. § 106 (2000).

154. Dan L. Burk & Julie E. Cohen, *Fair Use Infrastructure for Rights Management Systems*, 15 HARV. J.L. & TECH. 41, 47–54 (2001); David Nimmer, *A Riff on Fair Use in the Digital Millennium Copyright Act*, 148 U. PA. L. REV. 673 (2000); Pete Singer, *Mounting A Fair Use Defense To The Anti-Circumvention Provisions Of The Digital Millennium Copyright Act*, 28 U. DAYTON L. REV. 111 (2002); *see also* Julie E. Cohen, *A Right To Read Anonymously: A Closer Look at "Copyright Management" in Cyberspace*, 28 CONN. L. REV. 981 (1996).

155. *See* Pamela Samuelson & Suzanne Scotchmer, *The Law and Economics of Reverse Engineering*, 111 YALE L.J. 1575 (2002).

156. Kenneth W. Dam, *Self-Help in the Digital Jungle*, 28 J. LEGAL STUD. 393 (1999) (arguing that such enforcement would nevertheless provide efficient incentives for distribution of information).

157. *See* sources cited *supra* note 147.

gram that Reader could use to make the fair use copy, Decoder would violate the anti-circumvention provisions by trafficking in a device to circumvent anti-copying technology.[158]

The provisions are drafted very broadly indeed, as the case law shows. Researchers that publish reports about flaws in anti-circumvention technologies may violate the DMCA, by "trafficking" in anti-circumvention services (i.e. providing information on how to circumvent such technologies).[159] Merely linking on a webpage to sites where anti-circumvention programs are given away was held to give rise to liability.[160] Manufacturers have used the provisions as a litigation tool, to prevent the sale of devices that are made to be compatible—even such devices as garage door openers and toner cartridges for printers.[161] In short, the anti-circumvention provisions are an entirely new type of protection for copyright holders, with none of the traditional safeguards for freedom of ideas.[162] Such new rights would seem a prime candidate for First Amendment scrutiny. If the rights are different from traditional copyright, and the traditional safeguards are lacking, then the presumptions of tradition do not shield them from scrutiny.

Arguments can be made, however, that the anti-circumvention provisions do fit within the traditional contours of copyright law. They may be different from previous statutes, the argument would run, but serve the same purposes. Copyright law has long recognized secondary liability. Contributory infringement applies where "one who, with knowledge of the infringing activity, induces . . . or materially contributes to the infringing conduct of another."[163] Vicarious liability applies where "the right and ability to supervise coalesce with an obvious and direct financial interest in the exploitation of the copyrighted materials—even in the absence of actual knowledge that the copyright monopoly is being impaired."[164] The

158. *See, e.g.*, Samuelson & Scotchmer, *supra* note 155.

159. *See Freedom to Tinker*, *at* http://www.freedom-to-tinker.com (a website collecting materials and opinions regarding the DMCA).

160. *See* Universal City Studios v. Corley, 273 F.3d 429 (2d Cir. 2001).

161. *See* Electronic Frontier Foundation (EFF), *Intellectual Property—Digital Millennium Copyright Act (DMCA) Archive*, *at* www.eff.org/IP/DMCA/ (files on *Lexmark v. Static Control Components* and *Chamberlain v. Skylink*); *see also Law Professors File Amicus Brief in DMCA Suit Over Printer Cartridges*, 65 BNA PATENT, TRADEMARK AND COPYRIGHT REPORT 299 (Jan. 31 2003) (discussing amicus brief filed by law professors in *Lexmark* case, arguing the DMCA anti-circumvention provisions should not apply).

162. Indeed, one could even characterize them as granting patent-like protection to copyright subject matter. *See* Eugene Quinn, *An Unconstitutional Patent in Disguise: Did Congress Overstep its Constitutional Authority in Adopting the Circumvention Prevention Provisions of the Digital Millennium Copyright Act?*, 41 BRANDEIS L.J. 33 (2002).

163. Gershwin Publ'g v. Columbia Artists Mgmt., 443 F.2d 1159, 1162 (2d Cir. 1971).

164. Shapiro, Bernstein & Co. v. H.L. Green Co., 316 F.2d 304, 307 (2nd Cir. 1963). The best known secondary liability case is perhaps *A & M Records. v. Napster*, 239 F.3d 1004 (9th Cir. 2001). *See also* Stacey L. Dogan, *Is Napster a VCR? The Implications of Sony for*

anti-circumvention provisions have been characterized as necessary to adapt secondary liability to an age of digital works and computer networks.[165] Because it is so easy to make and distribute copies of digital works, it is thought that copyright owners need to rely on anti-access and anti-copying technology. If circumvention devices and services were not illegal, then such reliance would be impossible. The anti-circumvention provisions could arguably be characterized as adapting vicarious liability for the digital age, thus remaining within the traditional contours of copyright law.[166]

Other considerations in *Eldred* might also bring anti-circumvention provisions into the purview of the "traditional contours of copyright". *Eldred* gave considerable weight to the argument that the copyright extension was necessary to bring the U.S. copyright term into harmony with the copyright term in other jurisdictions.[167] Likewise, the anti-circumventions provisions have been justified as fulfilling the copyright treaty of obligations of the U.S.[168] In addition, the anti-circumvention provisions have been seen as securing the author's rights of integrity and attribution.[169] An author can use anti-circumvention technology to ensure that her work is not distorted and that she receives proper attribution for her creation. Similar protections already exist in the copyright statute, under the rights to adapt the work and the moral rights in works of visual art.[170]

In short, the argument would be that the anti-circumvention provisions fall within the traditional contours of copyright law in the same way that the copyright extension did. The anti-circumvention provisions do increase the rights of a copyright holder, but that was true of the term extension. *Eldred* held that extending the copyright term from 14 years to the life of the author plus 70 years does not change the contours of

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Napster and Other Internet Technologies, 52 HASTINGS L.J. 939 (2001); Alfred C. Yen, *Internet Service Provider Liability for Subscriber Copyright Infringement, Enterprise Liability, and the First Amendment*, 88 GEO. L.J. 1833 (2000).

165. David L. Clark, *Digital Millennium Copyright Act: Can It Take Down Internet Infringers?*, 6 COMP. L. REV. & TECH. J. 193, 195 (2002) ("In theory, the DMCA changes neither the traditional protections granted by a copyright nor the traditional defenses to claims of infringement—it is instead aimed at technological methods for enforcing copyrights in the digital age.").

166. *See* sources cited *supra* note 147.

167. *See* Eldred v. Ashcroft, 537 U.S. 186, 205–06 (2003).

168. *See* Samuelson, *supra* note 147 ("Although the WIPO Copyright Treaty requires countries to provide 'adequate protection' against the circumvention of technical measures used by copyright owners to protect their works from infringement, the DMCA went far beyond treaty requirements in broadly outlawing acts of circumvention of access controls and technologies that have circumvention-enabling uses.").

169. *See* Ginsburg, *Copyright Use and Excuse on the Internet*, supra note 147.

170. *See* Visual Artists Rights Act of 1990, 17 U.S.C. § 106A (2000).

copyright protection.[171] One could argue that the anti-circumvention provisions are similar, because they build upon existing protections.

B. *Choosing a Level of Scrutiny*

If a court decided that legislation (such as the anti-circumvention provisions) did fall outside the traditional contours of copyright protection, the legislation would be subject to First Amendment scrutiny. The next question would be, which of the many variations of First Amendment analysis would apply.[172] *Eldred* held that the sort of intermediate scrutiny applied in *Turner* was not appropriate, because copyright infringement concerns using the speech of others.[173] As discussed above, that distinction lacks much grounding in First Amendment law.[174] In addition, provisions like the anti-trafficking provisions do regulate the defendants' own speech. The anti-trafficking provisions prohibit not the use of other's copyrighted speech, but the trafficking of one's own circumvention software.

Perhaps the best guidance on this issue comes from two earlier Supreme Court cases analyzing conflicts between non-traditional forms of intellectual property protection and First Amendment rights, *Zacchini v. Scripps-Howard Broadcasting Co.*,[175] and *San Francisco Arts & Athletics v. United States Olympic Committee*.[176] *Zacchini* held that imposition of liability for infringing a performer's right of publicity did not violate the First Amendment.[177] The defendant television station had secretly taped the entire act of a "human cannonball" and broadcast it without permission.[178] There was a strong state interest in providing intellectual property protection, in providing an incentive for the production of such entertainment.[179] The Court noted the similarity to the incentive role of copyright and patent law.[180] That interest was particularly strong in *Zacchini*, where the entire act had been recorded and broadcast. Moreover, granting exclusive rights still permitted public access to the information (through the human cannonball's own performances) and permitted others to engage in

171. *See Eldred*, 537 U.S. at 221.
172. *See* Universal City Studios v. Corley, 273 F.3d 429, 449–51 (2d Cir. 2001).
173. *See Eldred*, 537 U.S. at 220.
174. *See supra* text accompanying notes 83–84.
175. 433 U.S. 562 (1977); *see* Pamela Samuelson, *Reviving Zacchini: Analyzing First Amendment Defenses in Right Of Publicity and Copyright Cases*, 57 TUL. L. REV. 836 (1983) (discussing interplay between the right of publicity and the First Amendment, particularly the role of the fair use doctrine).
176. 483 U.S. 522 (1987).
177. *Zacchini*, 433 U.S. at 578.
178. *Id.* at 563.
179. *Id.* at 573.
180. *Id.*

similar performances, rather than simply free riding with a camera. The means of protection were deemed sufficiently tailored to an important state interest to survive First Amendment scrutiny.[181] But note how demanding the scrutiny was. Had such scrutiny applied in *Eldred*, the weak justifications for the extension of copyright on works from the 1920s probably would not have passed such scrutiny. So *Zacchini* shows that, where First Amendment scrutiny applies, it may be quite demanding.[182]

San Francisco Arts & Athletics also upheld a non-traditional form of intellectual property protection. A special provision of the federal trademark statute gave the United States Olympic Committee (USOC) the right to prevent others from making various commercial and promotional uses of the word "Olympic."[183] The provision gave the USOC much greater rights than it could have under traditional trademark law. First, it was given protection in the word "Olympic," even though such a generic term would usually not be protectable as a trademark. Secondly, it could prevent uses by others, even if there was no showing that the use was likely to cause confusion among consumers. This departure from the "likelihood of confusion" standard abandoned the basic purpose of trademark law, to prevent consumer confusion and deception. Nevertheless, the Court held that the regulation passed intermediate scrutiny, meaning that the restrictions on speech were no greater than necessary to further a substantial governmental interest.[184] The USOC's own activities had created much of the value attached to the word "Olympic." Granting exclusive rights provided an incentive for the USOC to continue such activities, with their broader benefits for international goodwill. Although the protection was broader than normal trademark protection, they were deemed no broader than necessary to ensure that the USOC reaped the benefits of its promotion of the Olympic movement.[185]

San Francisco Arts & Athletics shows that expansion of a form of intellectual property beyond its traditional contours (and dropping traditional safeguards for freedom of expression) remains permissible under the First Amendment. In general terms, the implications for the scrutiny of copyright's anti-circumvention provisions would be as follows. If the provisions are deemed to go beyond the traditional contours of copyright protection, they would be subject to First Amendment scrutiny. Such scrutiny would be much more exacting than the deferential approach *Eldred* accorded to traditional protections. The provisions

181. *See id.* at 578.

182. *But cf.* Comedy III Prods., Inc. v. Gary Saderup, Inc., 21 P.3d 797 (Cal. Sup. Ct. 2001) (Pre-*Eldred* decision analyzing right of publicity as commercial speech).

183. *See San Francisco Arts & Athletics*, 483 U.S. at 526.

184. *See id.* at 537–40.

185. *Id.* at 540.

would be subject to attack in particular on the grounds that they go well beyond the extent necessary to protect the rights of copyright holders. However, the mere fact that they lack the traditional safeguards (fair use and the idea/expression dichotomy) would not be dispositive. Rather, a more extensive examination of how the particular form of protection served the relevant interests would be required.

C. *First Amendment Scrutiny for Other Forms of Intellectual Property Protection After* Eldred

A brief review of other areas of intellectual property beyond copyright suggests that *Eldred* will not shield them from First Amendment scrutiny. *Eldred*'s rationale for not applying First Amendment scrutiny to copyright legislation rested on two types of tradition: copyright dates from the time of the First Amendment and copyright has built-in First Amendment safeguards. First Amendment protection has been raised in trademark,[186] trade secret,[187] and even patent law.[188] Each raises slightly different issues with respect to "tradition."

Federal trademark protection does not date back to the time of the First Amendment, so federal trademark protection does not have the hallmark of tradition. State law, however, has protected trademark from earlier times. So the question might become whether the specific type of trademark protection goes beyond trademark's traditional contours. Trademark has steadily increased its areas of coverage.[189] Likely candidates for non-traditional status would be false advertising, anti-dilution protection, and the Anti-Cybersquatting Consumer Protection Act.[190] Even the basic theory of trademark infringement itself could be seen as unmoored from its traditional basis. Trademarks were once a specific type of designation of source. Now trademark infringement includes such theories as false endorsement, reverse confusion, and initial interest

186. *See, e.g.*, Robert J. Shaughnessy, *Trademark Parody: A Fair Use and First Amendment Analysis*, 72 VA. L. REV. 1079 (1986) (discussing a common problem, the conflict between rights of trademark owners and the free speech rights of other to refer to those marks).

187. Adam W. Johnson, *Injunctive Relief in the Internet Age: The Battle Between Free Speech and Trade Secrets*, 54 FED. COMM. L.J. 517 (2002).

188. *See* Burk, *supra* note 14, at 150.

189. *See* Thomas F. Cotter, *Owning What Doesn't Exist, Where It Doesn't Exist: Rethinking Two Doctrines from the Common Law of Trademarks*, 1995 U. ILL. L. REV. 487 (1995) (discussing common law trademark); Mark Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687 (1999); Kenneth Port, *The Congressional Expansion of American Trademark Law: A Civil Law System in the Making*, 35 WAKE FOREST L. REV. 827 (2000).

190. *See* 15 U.S.C. § 1125 (2000).

confusion.[191] Moreover, the symbols protected as marks were once only words, names, or specific types of emblems and artistic figures used to designate products.[192] After the Supreme Court decision in *Qualitex Co. v. Jacobson Products Co, Inc.*,[193] almost anything can potentially qualify as a mark, even mere colors, sounds, or fragrances, not to mention the broad and ill-defined category of trade-dress. So present day trademark law could be deemed to have expanded beyond its traditional contours.

However, trademark law does contain features that could be considered built-in First Amendment safeguards. Ownership of a trademark does not confer exclusive rights to use the symbol; rather, it only gives the right to prevent others from using it in a way that may confuse consumers (or dilute the mark). Trademark law also recognizes fair use (albeit a much narrower version than copyright law).[194] Courts have also recognized defenses such as parody and nominative use, that also leave breathing space for expressive use of others' marks.[195] Finally, the recent Supreme Court decision *Moseley v. V Secret Catalogue, Inc.*[196] cut back considerably on the reach of the anti-dilution provision, which was perhaps the most likely trademark provision to threaten freedom of expression. So affirming First Amendment scrutiny of trademark law may not drastically change its landscape.

Trade secret law has only recently become embroiled in First Amendment scrutiny.[197] Trade secret cases most often involve little expressive interest, involving allegations of misappropriation of such matter as customer lists, manufacturing formulas, or blueprints for machines. Trade secret protection as such is a relatively recent development. The earlier cases relied on various conflicting and vague rationales, before the law gained some uniformity with the Restatement of Torts in 1939.[198] However, trade secret as a form of idea protection could fit within "traditional" forms of property protection.[199] Trade secret

191. *See, e.g.*, Eli Lilly & Co. v. Natural Answers, Inc., 233 F.3d 456, 464 (7th Cir. 2000) (initial interest confusion); Dreamwerks Prod. Group, Inc. v. SKG Studio, 142 F.3d 1127 (9th Cir. 1998) (reverse confusion).

192. *See* Glynn S. Lunney, Jr., *Trademark Monopolies*, 48 EMORY L.J. 367 (1999).

193. 514 U.S. 159 (1995).

194. *See, e.g.*, Sunmark, Inc. v. Ocean Spray Cranberries, Inc., 64 F.3d 1055 (7th Cir. 1995).

195. *See, e.g.*, The New Kids on the Block v. News America Publ'g, Inc., 971 F.2d 302 (9th Cir. 1992).

196. 537 U.S. 418 (2003).

197. *See, e.g.*, DVD Copy Control Ass'n v. Bunner, 93 Cal. App. 4th 648 (6th Dist. 2001); Dendrite Int'l, Inc. v. Doe, 342 N.J. Super. 134 (App. Div. 2001); Ford Motor Co. v. Lane, 67 F. Supp. 2d 745 (E.D. Mich. 1999).

198. RESTATEMENT OF TORTS § 757 (1939).

199. *See* Andrew Beckerman-Rodau, *Are Ideas Within the Traditional Definition of Property?: A Jurisprudential Analysis*, 47 ARK. L. REV. 603 (1994). On application of the

protection could be seen as simply enforcing traditional rules against breach of confidential relationships. Indeed, the *Eldred* approach to tradition could cut the other way with respect to trade secrets. Courts have generally held that enforcement of contracts does not implicate the First Amendment because enforcement of private agreements is not state action. Under *Eldred*, this could qualify as a long-standing tradition, which would foreclose First Amendment scrutiny.[200] So to the extent that trade secret law serves to enforce duties of confidentiality, *Eldred* might indicate that it would be relatively free from First Amendment scrutiny. However, a strong counterargument would be that the sort of cases in which First Amendment issues arise (such as a whistleblower informing a newspaper of product defects) are outside the traditional scope of contract law.

Turning to patent law, the argument that a finding of patent infringement would violate the First Amendment has been rare. A patent grants rights to exclude others from making, using, and selling an invention,[201] so expressive activity is rarely at issue in a patent infringement case. However, the subject matter of patent law has steadily increased, to where patent protection can now cover expressive activity.[202] Patent law has become so broad that it could cover the methods of "disciplines ranging from the social sciences to the law."[203] The writing and dissemination of computer software, for example, could be expressive activity but also covered by the patent laws.[204]

Would First Amendment scrutiny apply to patent protection? Patent protection is traditional, in the same sense as the *Eldred* Court applied it to copyright. The same clause of the Constitution grants Congress the power to grant copyrights and patents. The first patent statute is roughly contemporaneous with the first copyright statute. Nevertheless, some distinctions could be made with respect to patent protection. First, the subject matter of patent has gone far beyond its traditional boundaries. Copyright subject matter has also spread, but from the beginning, copyright has applied to expressive subject matter, such as books. The application of patent to expressive subject matter is much more recent. For that very reason,

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First Amendment to mere possession of information, see Rodney A. Smolla, *Information as Contraband: The First Amendment and Liability for Trafficking in Speech*, 96 NW. U.L. REV. 1099 (2002).

200. *See supra* Part I.

201. *See* 35 U.S.C. 271(a) (2000).

202. *See* Burk, *supra* note 14, at 145–50.

203. *See* John R. Thomas, *The Patenting of the Liberal Professions*, 40 B.C. L. REV. 1139, 1142 (1999).

204. *Id.*; *see also* Mark A. Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 DUKE L.J. 147, 233 (1998).

patent law does not contain built-in First Amendment safeguards.[205] Thus, it would seem that patent would be subject to more rigorous First Amendment scrutiny than copyright, to the extent that it regulates expressive activity.

In addition to existing intellectual property protection, a number of proposals have been made in Congress to strengthen intellectual property rights. Some could have drastic effects on free expression. For example, proposed digital rights legislation could effectively "outlaw general purpose computers and most open source software by requiring that devices and software capable of playing digital content have standard DRM technologies built into them."[206] Such legislation imposes considerable restraint on expression and the distribution of expressive works. Thus, it is likely to lead to further First Amendment challenges. Moreover, if it departs from the traditional contours of copyright protection, it will be subject to stricter First Amendment review.

IV. THE CONSTITUTIONALIZATION OF FAIR USE

Eldred placed great reliance on fair use as a built-in First Amendment safeguard in copyright law. Because copyright contained such safeguards as fair use and the idea/expression dichotomy, additional First Amendment scrutiny was unnecessary. *Eldred* thus rested the constitutional status of copyright on fair use.

Before *Eldred*, the Supreme Court had addressed the interplay between fair use and the First Amendment, but never in such broad terms. *Harper & Row Publishers v. Nation Enterprises*,[207] for example, refused to broaden the scope of fair use for a particular type of case. In *Harper & Row*, *The Nation* magazine obtained a pre-publication copy of President Gerald Ford's autobiography and published brief excerpts without permission.[208] The Court rejected the argument that the First Amendment required that fair use protect such copying of historically important material:

> In view of the First Amendment protections already embodied in the Copyright Act's distinction between copyrightable expres-

205. *See* Maureen A. O'Rourke, *Toward a Doctrine of Fair Use in Patent Law*, 100 COLUM. L. REV. 1177 (2000); Donna M. Gitter, *International Conflicts Over Patenting Human DNA Sequences in the United States and the European Union: An Argument for Compulsory Licensing and a Fair-Use Exemption*, 76 N.Y.U. L. REV. 1623 (2001).

206. *The Berkeley Center for Law and Technology DRM Conference: Schedule of Events*, *at* www.law.berkeley.edu/institutes/bclt/drm/schedule.html (last visited Sept. 16, 2003).

207. 471 U.S. 539 (1985).

208. *Id.* at 543.

> sion and uncopyrightable facts and ideas, and the latitude for scholarship and comment traditionally afforded by fair use, we see no warrant for expanding the doctrine of fair use to create what amounts to a public figure exception to copyright.[209]

Harper & Row addressed only the interplay between fair use and the First Amendment in a single case.[210] *Eldred*, by contrast, relied on fair use to uphold the copyright extension of many copyrighted works. *Eldred* thus rests the very constitutionality of copyright law on fair use.

The fair use doctrine has always been notoriously difficult to define.[211] For much of its history, fair use was simply a judge-made doctrine that courts used to find no infringement in particular cases.[212] Courts did not strictly define the scope of fair use, or even whether it was a defense or a limitation on the scope of the exclusive rights. The 1976 Act finally expressly adopted fair use. Section 107 now flatly declares that fair use is not infringement,[213] but the statute does little to define the scope of fair use.[214] Rather, it simply instructs the court to look to several factors in deciding if a use is fair or not: the nature of the use; the nature of the copyrighted work; the amount and substantiality of the use; and the effect on the potential market for the copyrighted work.[215]

The continuing viability of fair use has come into question. Some have argued that the scope of fair use should narrow with improvements in technology and licensing. Fair use is sometimes defined as simply a response to market failure, permitting uses where negotiating for permission would be prohibitively expensive.[216] Thus, an out-of-print book is

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209. *Id.* at 560.

210. *See* Kenneth D. Crews, *Fair Use of Unpublished Works: Burdens of Proof and the Integrity of Copyright*, 31 ARIZ. ST. L.J. 1, 13–16 (1999) (calling for a critical reexamination of the approach in *Harper & Row*).

211. *See* WILLIAM F. PATRY, THE FAIR USE PRIVILEGE IN COPYRIGHT LAW (2d ed. 1995); William W. Fisher III, *Reconstructing the Fair Use Doctrine*, 101 HARV. L. REV. 1661 (1988).

212. *See* Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105 (1990).

213. 17 U.S.C. § 107 (2000).

214. *See* Jay Dratler, Jr., *Distilling the Witches' Brew of Fair Use in Copyright Law*, 43 U. MIAMI L. REV. 233 (1988).

215. *See* 17 U.S.C. § 107 (2000).

216. *See* Wendy J. Gordon, *Fair Use as Market Failure: A Structural and Economic Analysis of the* Betamax *Case and its Predecessors*, 82 COLUM. L. REV. 1600 (1982) (seminal article, often narrowly misread); William M. Landes & Richard A. Posner, *An Economic Analysis of Copyright Law*, 18 J. LEGAL STUD. 325 (1989). There are a number of other theoretical justifications for fair use. *See, e.g.,* Benjamin G. Damstedt, Note, *Limiting Locke: A Natural Law Justification for the Fair Use Doctrine*, 112 YALE L.J. 1179 (2003); Wendy J. Gordon, *A Property Right in Self-Expression: Equality and Individualism in the Natural Law of Intellectual Property*, 102 YALE L.J. 1533 (1993). Non-economic theories can also lead to a narrow view of fair use. *See* Linda J. Lacey, *Of Bread and Roses and Copyrights*, 1989 DUKE L.J. 1532.

subject to broader fair use than one available on the market.[217] Under the broadest interpretation of that approach, fair use would dwindle away as it became less necessary, in light of digital rights management systems and the like.[218] Fair use thus could become a "step-child of copyright law."[219] Commentators have indeed noted a trend toward a narrowing of fair use.[220] A recent Second Circuit opinion questioned whether fair use had any constitutional basis: "Preliminarily, we note that the Supreme Court has never held that fair use is constitutionally required, although some isolated statements in its opinions might arguably be enlisted for such a requirement."[221]

After *Eldred*, however, fair use attains constitutional status. Under the *Eldred* analysis, the availability of fair use is central to the constitutional basis of copyright protection. Thus, fair use after *Eldred* assumes a position analogous to the doctrine of originality after the Supreme Court's 1992 decision in *Feist Publications, Inc. v. Rural Telephone Service*.[222] The fair use doctrine can now also be more explicitly used to

217. Ann Bartow, *Educational Fair Use in Copyright: Reclaiming the Right to Photocopy Freely*, 60 U. PITT. L. REV. 149 (1998) (discussing market failure analysis); Robert P. Merges, *Are You Making Fun of Me?: Notes on Market Failure and the Parody Defense in Copyright*, 21 AIPLA Q.J. 305 (1993).

218. *See* WORKING GROUP ON INTELLECTUAL PROPERTY RIGHTS, INFO. INFRASTRUCTURE TASK FORCE, INTELLECTUAL PROPERTY AND THE NATIONAL INFORMATION INFRASTRUCTURE (1995); *see also* Paul Goldstein, COPYRIGHT'S HIGHWAY: FROM GUTENBERG TO THE CELESTIAL JUKEBOX (1994); Tom W. Bell, *Fair Use vs. Fared Use: The Impact of Automated Rights Management on Copyright's Fair Use Doctrine*, 76 N.C. L. REV. 557 (1998); I. Trotter Hardy, *Property (and Copyright) in Cyberspace*, 1996 U. CHI. LEGAL F. 217; Michael J. Meurer, *Price Discrimination, Personal Use and Piracy: Copyright Protection of Digital Works*, 45 BUFF. L. REV. 845 (1997).

219. Lydia Pallas Loren, *Redefining the Market Failure Approach to Fair Use in an Era of Copyright Permission Systems*, 5 J. INTELL. PROP. L. 1 (1997) (criticizing market failure approach).

220. *See* Thomas F. Cotter, *Gutenberg's Legacy: Copyright, Censorship, and Religious Pluralism*, 91 CAL. L. REV. 323, 329 (2003) (noting a "shrinking doctrine of fair use"); Glynn S. Lunney, Jr., *Reexamining Copyright's Incentives—Access Paradigm*, 49 VAND. L. REV. 483, 546 (1996) ("As Congress and various courts have expanded the scope of the author's protected interest, so too have they narrowed the scope of the fair use doctrine."); Stephen M. McJohn, *Fair Use and Privatization in Copyright*, 35 SAN DIEGO L. REV. 61, 77 (1998); Maureen Ryan, *Cyberspace as Public Space: A Public Trust Paradigm for Copyright in a Digital World*, 79 OR. L. REV. 647, 675 (2000) ("Unfortunately, however, fair use applications are shrinking along with other traditional limitations"); *see also* Kenneth Crews, *Fair Use of Unpublished Works: Burdens of Proof and the Integrity of Copyright*, 31 ARIZ. ST. L.J. 1 (1999).

221. Universal City Studios v. Corley, 273 F.3d 429, 458 (2d Cir. 2001).

222. Another possible outcome of *Eldred* could be increasing use of tradition in construing the Copyright Act itself. Considerable scholarship already is in place for such an endeavor. *See, e.g.*, I. Trotter Hardy, *Computer RAM "Copies": Hit or a Myth? Historical Perspectives on Caching as a Microcosm of Current Copyright Concerns*, 22 U. DAYTON L. REV. 423 (1997).

protect First Amendment values.[223] Thus, courts would be better able to go beyond the specific factors listed in the statute. Fair use is a flexible doctrine well suited to addressing the many factors that affect issues of free expression.[224]

A case that illustrates how fair use could be used to explicitly protect First Amendment values is *Veeck v. Southern Building Code Congress International*.[225] In *Veeck*, a non-profit entity had authored a model building code.[226] It also sold copies of the code.[227] Two towns in Texas adopted the model code as their municipal building codes.[228] A local resident, after unsuccessfully seeking copies from the town offices, bought a copy from the non-profit and posted it on a website.[229] Such activity could be copyright infringement, for making copies and for distributing copies to the public. The case thus raised the issue of copyright protection for privately authored codes that are adopted into law. The court held that once the codes had been adopted into law, they become uncopyrighted under the "merger doctrine."[230] As first authored, codes represented original, creative expression which would normally be copyrightable.[231] However, the court reasoned, once adopted as law, the codes become "ideas" or "facts," which are not protectable under the idea/expression dichotomy.[232] To the extent the codes contained expression, they were inseparable from the unprotectable ideas and facts, and therefore unprotected under the merger doctrine.

The result in *Veeck* (that some unauthorized use of copyrighted works may be required to permit nonprofit dissemination of local law) may be sound, but fair use could now provide a more satisfactory basis for the result. Before *Eldred*, fair use may not have seemed appropriate. If copies of the code could be easily purchased, then the market-oriented approach to fair use would not excuse making unauthorized copies. After

223. On how to address First Amendment values using fair use, see Jonathan Dowell, *Bytes and Pieces: Fragmented Copies, Licensing, and Fair Use in a Digital World*, 86 CAL. L. REV. 843 (1998); Michael Madison, *Complexity And Copyright In Contradiction*, 18 CARDOZO ARTS & ENT. L.J. 125 (2000). Other doctrines of copyright, such as first sale, could also play such a role. *See* Justin Graham, P*reserving the Aftermarket in Copyrighted Works: Adapting the First Sale Doctrine to the Emerging Technological Landscape*, 2002 STAN. TECH. L. REV. 1 (2002).

224. Indeed, fair use could even be used to address the specific issue of copyright term—the subject of *Eldred*—by increasing the availability of fair use for later in the copyright term. *See* Joseph P. Liu, *Copyright and Time: A Proposal*, 101 MICH. L. REV. 409 (2002).

225. 293 F.3d 791 (5th Cir. 2002) (en banc).

226. *Id.* at 793.

227. *Id.* at 794.

228. *Id.* at 793.

229. *Id.*

230. *Id.* at 802.

231. *See id.* at 794.

232. *Id.* at 801.

Eldred, however, the First Amendment interest in freely distributing local law to those interested in it would take precedence. Moreover, application of the merger doctrine is a blunt instrument because it entails holding that the model code loses all copyright protection once adopted. Thus, merger would permit not just nonprofit uses in areas where the code had been adopted, but also free copying and use, even if for strictly commercial purposes in jurisdictions where the code was not the law. Fair use would permit a more nuanced approach.

A greater objection to application of the merger doctrine follows from the nature of the case law system. Copyrighted works can become part of the law in contexts well beyond adoption of model codes. For example, various leading copyright cases involve analysis of such works as the novel *Gone With the Wind*,[233] the song "Pretty Woman,"[234] and President Gerald Ford's autobiography.[235] In a real sense, such works have become part of copyright law. In order to determine whether fair use applies in a case, parties must determine whether the facts of those cases (including the copyrighted works) apply by analogy to the case at issue. Applying *Veeck* logically would lead to the absurd result that a copyrighted works lose copyright status is they become part of the facts of precedential cases. By contrast, the fair use doctrine after *Eldred* can be used to authorize free expression without the doctrinal problems of the merger doctrine.

Fair use can also be used to address First Amendment concerns with respect to non-traditional forms of copyright protection. As discussed above, the anti-circumvention provisions do not contain an exception for fair use. A number of commentators have argued that an implied fair use exception should nevertheless be read into the statute.[236] After *Eldred*, it is clear that the anti-circumvention provisions are ripe for First Amendment scrutiny, in large part because they lack the traditional built-in First Amendment protection of fair use. A court could avoid the First Amendment analysis with the common approach of construing the statute to contain First Amendment safeguards—by reading in an implied exception for fair use.

A twist on fair use as speech protection is presented in the area of reverse engineering.[237] Courts and commentators have strongly supported

233. *See* Suntrust Bank v. Houghton-Mifflin Co., 268 F.3d 1257 (11th Cir. 2001).
234. *See* Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569 (1994).
235. *See* Harper & Row Publ'rs, Inc. v. Nation Enters., 471 U.S. 539 (1985).
236. *See supra* note 147 and accompanying text (commenting on the DMCA).
237. *See* Robert A. Kreiss, *Accessibility and Commercialization in Copyright Theory*, 43 UCLA L. REV. 1 (1995) (discussing the importance of fair use in facilitating reverse engineering).

the application of fair use for reverse engineering.[238] Whether seeking to study the functional aspects of a work is protected activity under the First Amendment is an interesting question.[239] Regardless of whether reverse engineering is deemed to be protected speech or not, the rationale of *Eldred* would support using fair use to protect reverse engineering. *Eldred* emphasized that copyright's built-in safeguards (fair use and the idea/expression dichotomy) permit the free use of ideas from copyrighted works.[240] Functional aspects of works are not protected by copyright, and thus fair use would help preserve this traditional distinction.

V. *ELDRED'S* EFFECTS ON PREEMPTION AND INTELLECTUAL PROPERTY

Some of the greatest restrictions on an individual's rights to use and disseminate information may, ironically, be those she has agreed to. It is customary to provide information subject to licenses. When software is sold, or web-sites accessed, or information downloaded (be it software, music, data), there is likely to be a license to which the recipient purportedly agrees. Such agreement is often more a legal fiction than reality, but courts have shown a tendency to enforce such shrink-wrap or click-through licenses. Among other things, the license terms often provide that the recipient waives certain rights under copyright law, such as fair use or first sale rights.[241] Moreover, the recipient will likely agree to restrictions on information that would not be protected by copyright, such

238. Julie E. Cohen, *Reverse Engineering and the Rise of Electronic Vigilantism: Intellectual Property Implications of "Lock-Out" Programs*, 68 S. CAL. L. REV. 1091 (1995); Dennis S. Karjala, *Copyright Protection of Computer Documents, Reverse Engineering, and Professor Miller*, 19 U. DAYTON L. REV. 975 (1994); Mark A. Lemley and David McGowan, *Legal Implications of Network Economic Effects*, 86 CAL. L. REV. 479 (1998); David A. Rice, *Sega and Beyond: A Beacon for Fair Use Analysis . . . At Least as Far as It Goes*, 19 U. DAYTON L. REV. 1131 (1994).

239. A related issue is the extent to which software is protected speech. *See* Robert C. Post, *Encryption Source Code and the First Amendment*, 15 BERKELEY TECH. L.J. 713 (2000); Amy E. McCall, *The DMCA and Researchers' First Amendment Rights*, 3 PGH. J. TECH. L. & POLICY 2 (Spring 2002), *at* http://www.pitt.edu/~sorc/techjournal/articles/Vol3McCall.pdf.

240. *See* Eldred v. Ashcroft, 537 U.S. 186, 219–20 (2003).

241. *See* David Nimmer et al., *The Metamorphosis of Contract into Expand*, 87 CAL. L. REV. 17, 30 (1999); David A. Rice, *Public Goods, Private Contract and Public Policy: Federal Preemption of Software License Provisions Against Reverse Engineering*, 53 U. PITT. L. REV. 543, 554 (1992); *see also* Apik Minassian, *The Death of Copyright: Enforceability of Shrinkwrap Licensing Agreements*, 45 UCLA L. REV. 569 (1997) (noting some conflict between enforcement of contract and copyright norms).

as ideas, data, or functional aspects of works. So state contract law may be used to give protections that federal copyright law does not.[242]

The question then arises whether the federal copyright statute preempts state contract law.[243] To the extent that copyright law preempts such restrictive clauses, the federal statute serves to preserve the free flow of information, acting as a sort of consumer protection statute.[244] Recent decisions, however, have tended not to find that federal copyright law preempts contract law.[245] *Eldred* could help change that trend.

To the extent that federal law preempts regulation in an area, state law is invalid. Courts apply three types of preemption:

> *Explicit preemption*. A federal statute may expressly preempt state law in the relevant field, completely or partly.
>
> *Field preemption*: If federal law occupies the entire field, then there is no room for application of state law.
>
> *Conflict preemption*: State law is preempted if it would be impossible to comply with both state and federal law, or
>
> state law stands in the way of accomplishment of the objectives of the federal law.[246]

The Copyright Act contains an express preemption provision, which preempts any state law rights that are equivalent to any of the exclusive rights of a federal copyright.[247] Several leading decisions have held that this provision does not preempt state contract law.[248] The provision applies to rights that are equivalent to the exclusive rights of a copyright holder.[249] Rights under a contract, however, are not exclusive rights in this sense. Rather, they govern only the parties to the contract. The few

242. *See* Michael J. Madison, *Legal-Ware: Contract and Copyright in the Digital Age*, 67 FORDHAM L. REV. 1025 (1998).

243. *See* Julie E. Cohen, Lochner *in Cyberspace: The New Economic Orthodoxy of "Rights Management"*, 97 MICH. L. REV. 462 (1998).

244. Mark A. Lemley, *Beyond Preemption: The Law and Policy of Intellectual Property Licensing*, 87 CAL. L. REV. 111, 114–15 (1999) (citing Whit Diffie and Glynn Lunney).

245. *See, e.g.*, Bowers v. Baystate Techs., Inc., 320 F.3d 1317 (Fed. Cir. 2003) (holding that shrinkwrap licenses that override the fair use defense were not preempted by federal copyright law); ProCD, Inc. v. Zeidenberg, 86 F.3d 1447 (7th Cir. 1996) (holding that license that prohibited copying of noncopyrightable information was not preempted). On preemption of contract by copyright, see Tom W. Bell, *Escape from Copyright: Market Success vs. Statutory Failure in the Protection of Expressive Works*, 69 U. CIN. L. REV. 741 (2001) (arguing that contract provides a better alternative to copyright protection); Maureen A. O'Rourke, *Drawing the Boundary Between Copyright and Contract: Copyright Preemption of Software License Terms*, 45 DUKE L.J. 479 (1995).

246. *See, e.g.*, Jones v. Rath Packing Co., 430 U.S. 519, 526 (1977).

247. *See* 17 U.S.C. § 301 (2000).

248. *See Baystate*, 320 F.3d at 1317; *ProCD*, 89 F.3d at 1447.

249. *See* 17 U.S.C. § 301.

cases on point, then, have generally held that explicit statutory preemption does not apply to contracts.[250]

However, courts have been puzzlingly reluctant to analyze the other type of preemption which might apply, conflict preemption.[251] Even if such contractual provisions are not explicitly preempted, they could conflict with federal copyright law.[252] Contracts often contain restrictions that would be permitted by copyright law.[253] Software licenses might contain clauses prohibiting reverse engineering, which would otherwise be fair use.[254] Database licenses may prohibit copying or distribution of facts, which are not protected by law. Non-disclosure agreements likewise prohibit restrictions on non-copyrightable material, such as functional matter, facts or ideas. In patent law, a line of cases has held conflict preemption applicable to state law that interfered with the underlying goals of federal patent law.[255] The Supreme Court invalidated state statutes that simply prohibited copying and selling an unpatented product.[256] However, in the copyright area, courts have been more reluctant to find conflict preemption. One possible reason for the difference is that the copyright statute, unlike the patent statute, has an explicit preemption provision. Courts implicitly approach copyright preemption as if only explicit preemption were at issue.[257]

Eldred could strengthen the argument that conflict preemption survives in copyright. Under *Eldred*, such copyright doctrines as fair use and the idea/expression dichotomy are not simply details of copyright law. Rather, they are necessary for copyright law as such to be constitutionally permissible. In that case, they must represent bed-rock policy of

250. *But see* Vault Corp. v. Quaid Software Ltd., 847 F.2d 255 (5th Cir. 1988) (applying preemption to enforcement of software license terms, where license effectively denied rights provided by Section 117 of the Copyright Act).

251. Courts generally fail even to discuss the conflict preemption analysis. *See, e.g.*, *Baystate*, 320 F.3d at 1317. In *Baystate*, despite an amicus brief spelling out the relevant Supremacy Clause analysis, conflict preemption was not discussed by the majority or even the dissenting judge, who would have held preemption available. *See also* ROBERT MERGES ET AL., INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE 846–48 (3d ed. 2003) (discussing distinctions between different modes of preemption in copyright).

252. *See* Julie E. Cohen, *Copyright and the Jurisprudence of Self-Help*, 13 BERKELEY TECH. L.J. 1089, 1130 (1998); Dennis S. Karjala, *Federal Preemption of Shrinkwrap and On-Line Licenses*, 22 U. DAYTON L. REV. 511 (1997); Mark A. Lemley, *Intellectual Property and Shrinkwrap Licenses*, 68 S. CAL. L. REV. 1239, (1995).

253. *See* Rice, *supra* note 241.

254. *See* Brandon L. Grusd, Note, *Contracting Beyond Copyright:* ProCD, Inc. v. Zeidenberg, 10 HARV. J.L. & TECH. 353 (1997).

255. Maureen A. O'Rourke, *Copyright Preemption After the ProCD Case: A Market-Based Approach*, 12 BERKELEY TECH. L.J. 53 (1997).

256. *See* Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141 (1989); Compco Corp. v. Day-Brite Lighting, 376 U.S. 234 (1964); Sears, Roebuck & Co. v. Stiffel, 376 U.S. 225 (1964).

257. *See* Goldstein v. California, 412 U.S. 546 (1973) (pre-1976 preemption case).

copyright law. State law that is inconsistent with such policy could accordingly face a strong preemption argument.[258]

This is far from saying that contract law would be preempted whenever it restricted copying or dissemination of information. A valid role of contracts is to regulate flow of information.[259] Only in extreme cases, where contract practice threatens to completely undo federal copyright policy would preemption apply. A prime example might be provisions in mass-marketing licensing agreements, with clauses that purport to completely prohibit reverse-engineering.[260] Enforcement of such a clause would effectively allow software to be widely sold, without anyone able to legally examine its functional, noncopyrightable features.

Thus, *Eldred* also plays a role in federalism, to the extent it affects the balance between federal and state intellectual property protection. This brand of federalism, in a sense, cuts against the grain of the Commerce Clause cases, because it would have the effect of decreasing the scope of state law. It would, however, be entirely consistent with the underlying philosophy of the Commerce Clause cases, which is to maintain the constitutionally mandated federal-state balance, because it would apply preemption due to the exercise of a specific congressional power. The Court has been vigilant in maintaining the right of state law, rather than federal law, to govern areas of the common law.[261] Copyright, in contrast, is a federal statute promulgated under a specific grant of federal law.

The traditionalist reasoning of *Eldred* would also have some applicability to govern another issue in the area of intellectual property and the First Amendment, the enforceability of contracts that restrict the flow of information. *Eldred* may put paid to another argument against enforcing contracts that restrict information. Some have argued that enforcement of a contract that restricts information could violate the First Amendment. After *Eldred*, succeeding with such an argument becomes more difficult. Contractual provisions restricting information have long been enforced, and such tradition could weigh against a perceived change in First Amendment law.

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258. *See* Paul Heald, *Federal Intellectual Property Law and the Economics of Preemption*, 76 IOWA L. REV. 959, 972 (1991) ("Whereas the fulcrum of the economic balance struck by patent law is the standards for patentability, the most important economic pressure point in copyright law is not the question of copyright ability but the question of fair use.").

259. *See* J.H. Reichman & Jonathan A. Franklin, *Privately Legislated Intellectual Property Rights: Reconciling Freedom of Contract with Public Good Uses of Information*, 147 U. PA. L. REV. 875 (1999).

260. *See* Maureen A. O'Rourke, *Drawing the Boundary Between Copyright and Contract: Copyright Preemption of Software License Terms*, 45 DUKE L.J. 479 (1995) (suggesting limited application of preemption of contract terms).

261. Paul Lund, *The Decline of Federal Common Law*, 76 B.U. L. REV. 895 (1996).

CONCLUSION

The specific issue in *Eldred* was the constitutionality of the copyright term extension, but the case explored broader issues that the Court has largely left unresolved: the extent of Congress's power under the Copyright Clause and the extent to which the First Amendment controls the Copyright Clause. With respect to both issues, *Eldred*'s broad holdings gave little constitutional protection to the public domain. The Court did not impose the sort of restrictions that it has recently introduced on other congressional powers, such as the power to regulate commerce. Rather, after *Eldred*, Congress may generally choose the intellectual property regime, without judicial review of whether legislation truly serves the purposes of the Clause. Likewise, the First Amendment will generally not restrict intellectual property legislation. Rather, the internal controls of copyright law, such as fair use and the idea/expression dichotomy must serve to protect expressive interests.

Eldred thus upheld broad powers of Congress to regulate intellectual property, against both First Amendment and Copyright Clause challenges. However, the decision may provide tools that serve to protect aspects of the public domain. *Eldred* insulated traditional copyright protection from First Amendment scrutiny, but opened the door for scrutiny of the more dangerous innovations in copyright law. *Eldred* also put the doctrine of fair use on a firm constitutional footing. It further provides a basis for stronger arguments for applying preemption to contract provisions that restrict the flow of information and ideas. *Eldred*'s legacy, thus, may be oddly asymmetrical. Its direct effect was to leave works created in the early part of the twentieth century under copyright protection. At the same time, with respect to the cutting edge of copyright law, such as digital rights management, technology law, and information licensing, *Eldred* may provide support for freedom of expression and innovation.