

A Constitutional Idea-Expression Doctrine: Qualifying Congress' Commerce Power When Protecting Intellectual Property Rights

Yavar Bathaee *

I. INTRODUCTION	443
II. USING ALTERNATE CONGRESSIONAL POWERS TO PROTECT EXPRESSIVE WORKS.....	445
A. <i>THE COMMERCE CLAUSE</i>	446
1. <i>United States v. Moghadam</i>	449
2. <i>United States v. Martignon</i>	453
3. <i>Kiss Catalog, Ltd. v. Passport International Productions, Inc.</i>	455
B. <i>THE TREATY POWER</i>	457
C. <i>THE SPENDING POWER</i>	458
D. <i>PROBLEMS ARISING FROM PROTECTING WORKS WITHIN THE SUBJECT MATTER OF COPYRIGHT UNDER AN ALTERNATIVE CONSTITUTIONAL POWER</i>	460
1. Enforcing the Asymmetrical Examination and Registration Processes of Copyright and Patent Law	461
2. Difficulties in Defining the Property Right	463

A PDF version of this article is available online at <http://law.fordham.edu/publications/article.html?pubID=200&id=2585>. Visit <http://www.iplj.net> for access to the complete Journal archive.

* J.D. Candidate, Fordham University School of Law, 2008; B.S. Computer Science and Engineering, University of California, Davis, 2004. I would like to thank Professor Alan Hartnick for his help with this note and my family for their love and support.

III. THE IDEA-EXPRESSION DICHOTOMY AND ITS COROLLARY DOCTRINES: FACILITATING COPYRIGHT PROTECTION	464
A. <i>THE PRAGMATIC GENESIS OF THE IDEA-EXPRESSION DISTINCTION</i>	465
B. <i>THE MODERN APPLICATION OF THE IDEA-EXPRESSION DOCTRINE AND ITS COROLLARIES</i>	468
1. The Line Between Utility and Expression in Computer Software	469
2. Conceptual Separability	476
3. Contracting Protection When Idea and Expression Merge	480
4. The Doctrine of Fair Use: Policing the Boundaries of Idea and Expression.....	483
IV. IDEA-EXPRESSION AS A CONSTITUTIONAL DOCTRINE.....	488
A. <i>MAINTAINING THE DIVISION BETWEEN PATENT AND COPYRIGHT LAW</i>	492
B. <i>INDETERMINATE DELINEATION OF PROPERTY, TRANSACTIONAL CERTAINTY, AND DUE PROCESS RIGHTS</i>	495
C. <i>AMORPHOUSLY DEFINED PROPERTY RIGHTS AND CRIMINAL LIABILITY</i>	496
D. <i>A TEXTUAL DERIVATION OF IDEA-EXPRESSION</i>	498
V. A CONSTITUTIONAL DOCTRINE OF IDEA-EXPRESSION, ALTERNATE CONGRESSIONAL POWERS, AND THE CANON OF HORIZONTAL SUBORDINATION.....	501
A. <i>THE NATURE OF THE PROBLEM: THREE POSSIBILITIES</i>	502
B. <i>FASHIONING A TEST TO BALANCE THE COMMERCE AND INTELLECTUAL PROPERTY CLAUSES</i>	505
C. <i>THE TEST</i>	507
VI. CONCLUSION.....	512

I. INTRODUCTION

The idea-expression doctrine has become an axiom of copyright law.¹ The doctrine ensures that the property rights created by the copyright and patent laws are well defined.² It maintains the division between private right and public domain.³ By drawing a line between what can and cannot be protected by a copyright, it provides comfort and certainty to those who draw on the ideas of others.⁴ The doctrine is central to the constitutional mandate of promoting the useful arts and sciences because it maintains the vital division between the patent and copyright laws that facilitates subject matter based regulation in patents and subject matter independent regulation in copyrights.⁵ Such a division safeguards the delicate balance between the First Amendment and the incentive based intellectual property laws.⁶

Yet, when Congress acts pursuant to its Commerce,⁷ Treaty,⁸ or Taxing and Spending powers,⁹ rather than the power granted to it under the Intellectual Property Clause,¹⁰ does this fundamental doctrine of copyright law nevertheless apply? The answer to this question depends on two seemingly intractable questions: First, whether congressional grants of power qualify one another, and

¹ See *infra* note 110.

² See *infra* notes 241–252 and accompanying text.

³ See *infra* note 215.

⁴ See *infra* Part III.A.

⁵ See *infra* notes 241–252 and accompanying text.

⁶ Cf. *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984) (“Because this task involves a difficult balance between the interests of authors and inventors in the control and exploitation of their writings and discoveries on the one hand, and society’s competing interest in the free flow of ideas, information, and commerce on the other hand, our patent and copyright statutes have been amended repeatedly.”); see also *Eldred v. Ashcroft*, 537 U.S. 186, 190 (2003) (“[The idea-expression doctrine] strikes a definitional balance between the First Amendment and copyright law by permitting free communication of facts while still protecting an author’s expression.” (citing *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 556 (1985))).

⁷ U.S. CONST. art I, § 8, cl. 3.

⁸ *Id.* art. II, § 2, cl. 2.

⁹ *Id.* art I, § 8, cl. 1.

¹⁰ *Id.* at cl. 8.

second, whether the idea-expression doctrine is a constitutional requirement. If the idea-expression doctrine is a constitutional doctrine, and if an exercise of congressional power under an alternate grant would circumvent the doctrine's constraints, then the two provisions would be in conflict, requiring one constitutional provision to yield to the other.

This Note will argue that the idea-expression doctrine is a constitutional requirement embedded in the Intellectual Property Clause's distinction between the useful arts and sciences. This Note will further argue for the application of a new test that balances the purposes of the qualifying doctrine against the purpose of the constitutional provision being qualified.

Part II of this Note will discuss the constitutional grants of power that can be used to promulgate copyright-like legislation and the tension inherent in using an alternate grant of constitutional power to circumvent the requirements of the Intellectual Property Clause. Part III of this Note will survey the facets of the idea-expression doctrine and its corollaries to illustrate the doctrine's underlying purposes. Part IV will argue that the idea-expression dichotomy finds its constitutional source in the distinction between the useful arts and sciences. By mentioning both kinds of works, the Constitution may have contemplated a division between a regime of protection that provides monopolies for ideas after careful examination of subject matter, and a regime that protects only expression regardless of the subject matter.

Conflicts between constitutional grants of power have been resolved in two traditional ways. First, the more subject-matter specific grant of power must qualify the more general one.¹¹ The second possible way to resolve the conflict is to allow congressional action to the extent of the broadest constitutional grant of power.¹² This would make the Commerce Clause the final arbiter of congressional power. This Note will instead propose a new canon of constitutional construction to resolve conflicts between horizontal constitutional provisions. Part V introduces the Horizontal Subordination test, a balancing test that determines

¹¹ See *infra* note 33 and accompanying text.

¹² See *infra* note 34 and accompanying text.

whether one constitutional provision should qualify another. Applying this test will ensure that the delicate balance of enumerated and limited federal powers persists amidst overlapping constitutional grants of congressional power.

II. USING ALTERNATE CONGRESSIONAL POWERS TO PROTECT EXPRESSIVE WORKS

The copyright and patent laws find their constitutional support in the Intellectual Property Clause of the Constitution, which grants Congress the power to protect writings and inventions for limited times. Yet, many such works could also be regulated under other constitutional grants of power. For example, many copyrighted works travel through or substantially affect interstate commerce,¹³ bringing their protection within the purview of the Interstate Commerce Clause of the Constitution.¹⁴ This section will discuss the various alternate sources of constitutional power that can be used to protect intellectual property rights that are similar to those conferred under the copyright and patent laws.

This section will discuss the Commerce Clause, the Treaty Power, and the Taxing and Spending Power as alternate means of protecting intellectual property rights. This section will also describe the problems inherent in employing an alternate congressional power to accomplish legislative goals that would typically be subject to the constraints of the Intellectual Property Clause. Among the problems that arise are difficulties in delineating the metes and bounds of the intellectual property right being conferred and in maintaining the current division between patent and copyright law.

¹³ A recording artist's success, for example, is generally measured by national, and even international, sales. *See, e.g.*, Robert Palmer, *The Year's Best: 1984 In Review; Pop Music Made A Comeback And Video Helped It Out*, N.Y. TIMES, Dec. 30, 1984, § 2, at 19 (describing artists' success in terms of national album sales). With the advent of music videos, music is very much a business dependent on interstate sales. *Id.*

¹⁴ *See United States v. Moghadam*, 175 F.3d 1269, 1276 (11th Cir. 1999) ("Generally speaking, performing artists who attract bootleggers are those who are sufficiently popular that their appeal crosses state or national lines.").

A. *The Commerce Clause*

The Commerce Clause allows Congress to regulate economic activity that substantially affects interstate commerce.¹⁵ Although the current interpretation of the Commerce Clause supports legislation that meets the test articulated in *United States v. Lopez*,¹⁶ the Commerce Clause had not always been so expansively interpreted.¹⁷

One of the earliest attempts to regulate intellectual property rights under the Commerce Clause failed because of a narrow interpretation of the clause. The Supreme Court decided the validity of a federal intellectual property statute in *The Trademark Cases*.¹⁸ The statute in that case imposed criminal sanctions for violating trademark rights.¹⁹ After finding that the power to pass

¹⁵ See *United States v. Lopez*, 514 U.S. 549, 560 (1995) (“[T]he proper test requires an analysis of whether the regulated activity ‘substantially affects’ interstate commerce.”); *Wickard v. Filburn*, 317 U.S. 111, 128–29 (1942) (upholding congressional regulation of home-grown wheat).

¹⁶ *United States v. Lopez* required, among other things, legislative findings, a jurisdictional element, and a logical nexus between the economic activity and interstate commerce. See 514 U.S. at 560–64.

¹⁷ See, e.g., *Cooley v. Bd. of Wardens of the Port of Philadelphia*, 53 U.S. (12 How.) 299, 306 (1851) (finding that state regulation that affected intrastate activity was not a regulation of interstate commerce); *Gibbons v. Ogden*, 22 U.S. (9 Wheat.) 1, 3 (1824) (“The power of regulating commerce extends to the regulation of navigation. The power to regulate commerce extends to every species of commercial intercourse between the United States and foreign nations, and among the several States. It does not stop at the external boundary of a State. But it does not extend to a commerce which is completely internal.”) (emphasis omitted).

¹⁸ 100 U.S. 82 (1879).

¹⁹ Act of August 14, 1876, ch. 274, §§ 4–5, 19 Stat. 141, 141–42. The statute stated the following:

Section 4. That any person or persons who shall, with intent to defraud any person or persons, knowingly and willfully cast, engrave, or manufacture, or have in his, her, or their possession, or buy, sell, offer for sale, or deal in, any die or dies, plate or plates, brand or brands, engraving or engravings, on wood, stone, metal, or other substance, moulds, or any false representation, likeness, copy, or colorable imitation of any die, plate, brand, engraving, or mould of any private label, brand, stamp, wrapper, engraving on paper or other substance, or trade-mark, registered pursuant to the statutes of the United States, shall, upon conviction thereof, be punished as prescribed in the first section of this act.

Section 5. That any person or persons who shall, with intent to defraud any person or persons, knowingly and willfully make, forge, or counterfeit, or have in his, her, or their possession, or buy, sell, offer for sale, or deal in, any representation,

the legislation could not be derived from the Intellectual Property Clause of the Constitution,²⁰ the Court turned to the Commerce Clause for an affirmative grant of congressional power.²¹ In doing so, the Court searched for a jurisdictional element in the statute,²² noting that “[i]f . . . the statute described persons engaged in a commerce between the different States, and related to the use of trade-marks in such commerce, it would be evident that Congress believed it was acting under the clause of the Constitution which authorizes it to regulate commerce among the States.”²³

The Court found no such jurisdictional element in the statute.²⁴ Noting the broad language of the provision, the Court stated that the Act’s “broad purpose was to establish a universal system of trade-mark registration . . . without regard to the character of the trade to which it was to be applied or the residence of the owner”²⁵ The Court then struck down the legislation as a constitutionally inadequate exercise of congressional power.²⁶ Implicit in the Supreme Court’s opinion in the *Trademark Cases* is

likeness, similitude, copy, or colorable imitation of any private label, brand, stamp, wrapper, engraving, mould, or trade-mark, registered pursuant to the Statutes of the United States, shall, upon conviction thereof, be punished as prescribed in the first section of this act.

Id.

²⁰ *Trademark Cases*, 100 U.S. at 94 (“[W]e are unable to see any such power in the constitutional provision concerning authors and inventors, and their writings and discoveries.”).

²¹ *See id.* at 94–95.

²² *See id.* at 97. The Supreme Court still searches for a jurisdictional element in its modern Commerce Clause jurisprudence. *See* *United States v. Morrison*, 529 U.S. 598, 613 (2000) (“[The statute] contains no jurisdictional element establishing that the federal cause of action is in pursuance of Congress’ power to regulate interstate commerce.”); *United States v. Lopez*, 514 U.S. 549, 562 (1995) (“[The Statute] has no express jurisdictional element which might limit its reach to a discrete set of firearm possessions that additionally have an explicit connection with or effect on interstate commerce.”); *United States v. Moghadam*, 175 F.3d 1269, 1275 (11th Cir. 1999) (“[The statute] also contains no jurisdictional element as is commonly found in criminal statutes passed under authority of the Commerce Clause. That is, there is no requirement that, for example, the bootleg copies or phonorecords have traveled in interstate or foreign commerce.”).

²³ *Trademark Cases*, 100 U.S. at 97.

²⁴ *See id.* at 98.

²⁵ *Id.*

²⁶ *See id.* at 99 (“The questions in each of these cases being an inquiry whether these statutes can be upheld in whole or in part as valid and constitutional, must be answered in the negative . . .”).

the premise that federal law not supported by the Copyright Clause of the Constitution can nevertheless find support in the Commerce Clause.²⁷ The fact that the Court turned to the Commerce Clause as a source of congressional power might imply that the Court would have sustained the legislation if the Commerce Clause so allowed.²⁸

The Supreme Court has often searched for alternate forms of congressional power to support legislation.²⁹ The mere fact that legislation cannot be promulgated under the Commerce Clause does not mean that § 5 of the 14th Amendment could not grant Congress the requisite power.³⁰ Despite the general rule that alternate congressional powers can support the same legislation, the narrow scope of congressional power granted by the Copyright Clause can be seen as an exception to this rule.³¹ The Copyright Clause, applying to subject matter that is narrower than the subject

²⁷ The structure of the Court's analysis supports this premise. *See id.* at 94–95, 97 (turning to the Commerce Clause for support after dismissing the argument that the legislation could find support in the Intellectual Property Clause).

²⁸ *See* Michael B. Gerdes, Comment, *Getting Beyond Constitutionally Mandated Originality as a Prerequisite for Federal Copyright Protection*, 24 ARIZ. ST. L.J. 1461, 1469 (1992) (“[T]he Court recognized that Congress still could rely on the Commerce Clause as an alternative source of legislative power. Although the Court ultimately held the legislation to be unconstitutional, the determination was due primarily to the prevailing narrow view of ‘interstate’ commerce and the issue of severability.”) (citations omitted); *see also* Brian Danitz, Comment, *Martignon And Kiss Catalog: Can Live Performances Be Protected?*, 15 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1143, 1163 (2005) (“Although that Court found that the Act was not justified by the Commerce Clause either, under the modern concept of the Commerce Clause, the Act would have been upheld.”).

²⁹ *See* *Kimel v. Fla. Bd. of Regents*, 528 U.S. 62, 78–80 (2000) (“Because we found the ADEA valid under Congress’ Commerce Clause power, we concluded that it was unnecessary to determine whether the Act also could be supported by Congress’ power under § 5 of the Fourteenth Amendment. Resolution of today’s cases requires us to decide that question.” (citing *EEOC v. Wyoming*, 460 U.S. 226, 243 (1983))); *Seminole Tribe of Fla. v. Florida*, 517 U.S. 44, 59–60 (1996) (searching for power to abrogate state sovereign immunity under the Indian Commerce Clause after noting that the lower court did not find the abrogation a valid exercise of the Interstate Commerce Clause or § 5 of the 14th Amendment). *See generally* *Heart of Atlanta Motel, Inc. v. United States*, 379 U.S. 241 (1964).

³⁰ *See* *Kimel*, 528 U.S. at 80 (turning to Section 5 of the 14th Amendment to support abrogation of state sovereign immunity).

³¹ *See* U.S. CONST. art. I, § 8, cl. 8.

matter regulated by the Commerce Clause,³² may either qualify the protection of similar subject matter under the Commerce Clause³³ or preclude regulation of the same subject matter under any other constitutional grant of power.³⁴

1. *United States v. Moghadam*

In determining whether copyright-like statutes could be upheld under the Commerce Clause, modern courts have grappled with the interpretive question of whether a narrower constitutional provision qualifies a more general one or precludes any other exercise of congressional power altogether. The Eleventh Circuit in *United States v. Moghadam*³⁵ held that the Commerce Clause could support legislation imposing criminal sanctions for the bootlegging of live performances.³⁶ The difficulty in upholding such a law as a valid exercise of the Intellectual Property Clause is that live performances lack fixation.³⁷ After noting that an articulation of congressional power is not required in the statute,³⁸

³² Compare *id.* (“[S]ecuring for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”), with *id.* at cl. 3 (“To regulate Commerce with foreign Nations, and among the several States, and with the Indian Tribes.”).

³³ This would be a direct consequence of applying the canon of statutory interpretation mandating that specific provisions qualify general ones. The Supreme Court has applied this canon before. See, e.g., *Simpson v. United States*, 435 U.S. 6, 15 (1978) (“Finally, our result is supported by the principle that gives precedence to the terms of the more specific statute where a general statute and a specific statute speak to the same concern, even if the general provision was enacted later.” (citing *Preiser v. Rodriguez*, 411 U.S. 475, 489–90 (1973))).

³⁴ Such an interpretation would be the only other preclusive alternative to applying the narrower provision as qualifying the more general. See, e.g., *id.* at 489 (“[T]he question remains whether the specific federal habeas corpus statute, explicitly and historically designed to provide the means for a state prisoner to attack the validity of his confinement, must be understood to be the exclusive remedy available in a situation like this where it so clearly applies.”).

³⁵ 175 F.3d 1269 (11th Cir. 1999).

³⁶ See *id.* at 1277 (“We hold that the anti-bootlegging statute has a sufficient connection to interstate and foreign commerce to meet the *Lopez* test.”).

³⁷ *Id.* (“[W]e assume *arguendo* that the [Intellectual Property] Clause could not sustain this legislation because live performances, being unfixed, are not encompassed by the term ‘Writings’ which includes a fixation requirement.”).

³⁸ See *id.* at 1275 n.10 (“Congress’s failure to cite the *Commerce Clause* as grounds for [the statute] does not eliminate the possibility that the *Commerce Clause* can sustain this legislation.”); see also *Woods v. Cloyd W. Miller Co.*, 333 U.S. 138, 144 (1948) (“The

the Eleventh Circuit, citing *The Trademark Cases* for support,³⁹ noted that “the fact that legislation reaches beyond the limits of one grant of legislative power has no bearing on whether it can be sustained under another.”⁴⁰

The *Moghadam* court entertained the argument that legislation that fails under one constitutional grant of congressional power cannot in some instances be upheld under another.⁴¹ The Eleventh Circuit examined the Supreme Court’s decision in *Railway Labor Executives’ Ass’n v. Gibbons*.⁴² That case involved a statute purportedly enacted under Congress’ commerce power that overlapped with the protections afforded under the Bankruptcy Clause of the Constitution.⁴³ The Court in *Railway Labor* refused to uphold the statute under the Commerce Clause after invalidating it under the Bankruptcy Clause.⁴⁴ The Court reasoned that “if we were to hold that Congress had the power to enact non-uniform

question of the constitutionality of action taken by Congress does not depend on recitals of the power which it undertakes to exercise.”); LAURENCE H. TRIBE, *AMERICAN CONSTITUTIONAL LAW* 307 n.6 (2d ed. 1988) (“An otherwise valid exercise of congressional authority is not, of course, invalidated if Congress happens to recite the wrong clause . . . or, indeed, if Congress recites no clause at all.” (citing *Woods*, 333 U.S. at 144)); cf. *EEOC v. Wyoming*, 460 U.S. 226, 243 n.18 (1983) (“It is in the nature of our review of congressional legislation defended on the basis of Congress’ powers under § 5 of the *Fourteenth Amendment* that we be able to discern some legislative purpose or factual predicate that supports the exercise of that power. That does not mean, however, that Congress need anywhere recite the words ‘section 5’ or ‘*Fourteenth Amendment*’ or ‘equal protection.’” (citing *Fullilove v. Klutznick*, 448 U.S. 448, 476–78 (1980))); *Ramirez v. P.R. Fire Serv.*, 715 F.2d 694, 698 (1st Cir. 1983) (“The omission of any ritualistic incantation of powers by the Congress is not determinative, for there is no requirement that the statute incorporate buzz words such as ‘*Fourteenth Amendment*’ or ‘section 5’ or ‘equal protection.’” (citing *EEOC v. Wyoming*, 460 U.S. at 243 n.18)).

³⁹ See *Moghadam*, 175 F.3d at 1278 (“Although the 1876 Act did not survive due to the restrictive view of the *Commerce Clause* prevailing at that time, the Supreme Court’s analysis in the *Trade-Mark Cases* stands for the proposition that legislation which would not be permitted under the Copyright Clause *could* nonetheless be permitted under the *Commerce Clause*, provided that the independent requirements of the latter are met.”).

⁴⁰ *Id.* at 1277 (citing *Heart of Atlanta Motel, Inc. v. United States*, 379 U.S. 241, 250 (1964)); see also *Authors League of Am., Inc. v. Oman*, 790 F.2d 220, 224 (2d Cir.1986) (“[T]he copyright clause is not the only constitutional source of congressional power . . .”).

⁴¹ See *Moghadam*, 175 F.3d at 1280.

⁴² 455 U.S. 457 (1982).

⁴³ *Id.* at 466; see also U.S. CONST. art. I, § 8, cl. 4.

⁴⁴ *Ry. Labor*, 455 U.S. 468–69.

bankruptcy laws pursuant to the *Commerce Clause*, we would eradicate from the Constitution a limitation on the power of Congress to enact bankruptcy laws.”⁴⁵

The same difficulty arose in *Moghadam*. Since the Intellectual Property Clause is dramatically narrower than the Commerce Clause, upholding the statute under the broader clause would enable Congress to circumvent the boundaries of the Intellectual Property Clause. In that case the statute would protect subject matter normally protected under the Intellectual Property Clause, but without the fixation requirement.⁴⁶ The Eleventh Circuit acknowledged that “in some circumstances the *Commerce Clause* indeed may be used to accomplish that which may not have been permissible under the [Intellectual Property] Clause. We hold that the instant case is one such circumstance in which the *Commerce Clause* may be thus used.”⁴⁷

The *Moghadam* court held that because the term “writings” in the Intellectual Property Clause imposes the fixation requirement, the term does not create a constitutional ceiling on the types of works that can be protected by Congress, and, therefore, the tension between broad and narrow clauses noted in the *Railway Labor* case was not a preclusive issue in the case before the court.⁴⁸

The Eleventh Circuit then turned to the question of whether the statute was a proper exercise of the commerce power. Just as the Supreme Court did in the *Trademark Cases*, the *Moghadam* court searched for a jurisdictional element and found none.⁴⁹ The Eleventh Circuit, however, held that the absence of such an element was not dispositive and upheld the statute, stating that “[t]he link between bootleg compact discs and interstate commerce

⁴⁵ *Id.*

⁴⁶ *See Moghadam*, 175 F.3d at 1280.

⁴⁷ *Id.*

⁴⁸ *See id.* at 1280–81 (“The grant itself is stated in positive terms, and does not imply any negative pregnant that suggests that the term ‘Writings’ operates as a ceiling on Congress’ ability to legislate pursuant to other grants.”).

⁴⁹ *Id.* at 1275 (“[T]here is no requirement that, for example, the bootleg copies or phonorecords have traveled in interstate or foreign commerce.”); *see supra* text accompanying notes 20–27 (discussing the *Trademark Cases*).

and commerce with foreign nations is self-evident.”⁵⁰ The court cited two reasons. First, the court analogized the case to *Wickard v. Filburn*⁵¹ and noted that the existence of bootlegged works depresses the market for legitimate copies of the work.⁵² Second, the *Moghadam* court noted that the very fact that bootlegging of a work occurs coupled with a market for such bootlegs implies that the artists involved are recognized nationally.⁵³

The *Moghadam* opinion illustrates that once a court decides that legislation can be sustained under the Commerce Clause even though the legislation cannot be sustained under the Intellectual Property Clause, the issue of whether the statute is a valid exercise of the commerce power is rarely difficult to resolve. The crucial issue is whether the Intellectual Property Clause qualifies or precludes the exercise of power under an alternative constitutional power. The *Moghadam* court held that even though an exercise of power under the Commerce Clause would circumvent the fixation requirement under the Intellectual Property Clause, “[c]ommon sense does not indicate that extending copyright-like protection to a live performance is fundamentally inconsistent with the [Intellectual Property] Clause.”⁵⁴ Thus, the *Moghadam* court decided not to impose any constraints on Congress when its plenary commerce authority overlaps with its power to protect intellectual property.⁵⁵ The core of the issue is whether regulating under the Commerce Clause would undermine the integrity of the narrower Intellectual Property Clause. The *Moghadam* court decided this issue in the negative.⁵⁶

⁵⁰ See *Moghadam*, 175 F.3d at 1276.

⁵¹ 317 U.S. 111 (1942).

⁵² *Wickard* held that the federally imposed wheat production caps applied to home-grown wheat because of the effect of the illegitimate wheat on the national market. 317 U.S. at 127–28.

⁵³ See *Moghadam*, 175 F.3d at 1276 (“Generally speaking, performing artists who attract bootleggers are those who are sufficiently popular that their appeal crosses state or national lines.”).

⁵⁴ *Id.* at 1281.

⁵⁵ However, the court withheld definitive judgment regarding the use of the Commerce Clause to circumvent the Intellectual Property Clause where the two clauses are fundamentally inconsistent. See *id.* at 1281 n.12.

⁵⁶ See *id.* at 1281–82.

2. *United States v. Martignon*

The most notable case after *Moghadam* is *United States v. Martignon*.⁵⁷ In that case, the Second Circuit considered the validity of an anti-bootlegging statute.⁵⁸ The statute was a product of the Uruguay Round of the General Agreements on Tariffs and Trade (GATT), specifically the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs).⁵⁹ Upon congressional approval of TRIPs, Congress codified the provisions of the statute in 1994.⁶⁰ The statute imposed criminal sanctions on bootlegging activity.⁶¹ This was the same statute at issue in *Moghadam*. The Second Circuit, however, framed the issue as “whether the Copyright Clause’s limitations also limit Congress’ power to regulate creative works under the Commerce Clause.”⁶²

The court examined the text of the Copyright Clause directly, noting that “it is not clear from the wording of the Copyright Clause where the grant of power ends and where the limitation(s)

⁵⁷ 346 F. Supp. 2d 413 (S.D.N.Y. 2004), *vacated*, 492 F.3d 140 (2d Cir. 2007).

⁵⁸ *See generally id.* The anti-bootlegging statute discussed in *Martignon* is codified at 18 U.S.C. § 2319A (2000 & Supp. II. 2002) (current version at 18 U.S.C.A. § 2319A (West 2006)). The portion of the statute at issue in the case provided as follows:

(a) OFFENSE.—Whoever, without the consent of the performer or performers involved, knowingly and for purposes of commercial advantage or private financial gain—

(1) fixes the sounds or sounds and images of a live musical performance in a copy or phonorecord, or reproduces copies or phonorecords of such a performance from an unauthorized fixation;

(2) transmits or otherwise communicates to the public the sounds or sounds and images of a live musical performance; or

(3) distributes or offers to distribute, sells or offers to sell, rents or offers to rent, or traffics in any copy or phonorecord fixed as described in paragraph (1), regardless of whether the fixations occurred in the United States;

shall be imprisoned for not more than 5 years

Id.

⁵⁹ *Martignon*, 346 F. Supp. 2d at 420; *see* Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, Legal Instruments—Results of the Uruguay Round, 33 I.L.M. 1125 (1994) [hereinafter “TRIPs”].

⁶⁰ Uruguay Round Agreements Act, Pub. L. No. 103-465, 108 Stat. 4809 (1994) (codified as amended at 18 U.S.C. § 2319A (2000)).

⁶¹ *See* 18 U.S.C. § 2319A.

⁶² *Martignon*, 492 F.3d at 144.

begin(s).”⁶³ The court noted that in *Heart of Atlanta*, the court upheld civil rights litigation under § 5 of the Fourteenth Amendment despite its invalidity under the commerce clause.⁶⁴ Conversely, the court also noted that some cases, such as *Gibbons*, which held that because the bankruptcy and commerce clauses are “intimately connected,” legislation that fails under the Bankruptcy Clause could not be enacted as Commerce legislation.⁶⁵

Given the indeterminacy in the case law, the Second Circuit noted that there were two ways to determine whether commerce legislation falls within the scope of the Intellectual Property Clause.⁶⁶ The first approach would require the court to examine the text of the Constitution to decide whether legislation could plausibly fall within the scope of the Intellectual Property Clause.⁶⁷ Interpreting the word “secure,” the court noted that any law that “creates, bestows, or allocates rights” would fall within the bounds of the Clause under such an approach.⁶⁸ Using a second approach, the court could examine the history and context of the clause to determine its scope.⁶⁹ Under this approach, the court noted that for a law to be considered a copyright law it would have to at least confer property rights.⁷⁰

The court noted that under either approach, the statute would not fall within the scope of the Intellectual Property Clause. The court reasoned that the statute was a criminal law, neither creating nor allocating property rights to authors and inventors.⁷¹ Under the first approach, the criminal law would not create, bestow, or allocate rights, and under the second approach, the law did not create any property rights.⁷² The statute did not grant private rights to exclude others from a property interest in the live

⁶³ *Id.* at 145.

⁶⁴ *See id.* at 146 (citing *Heart of Atlanta*, 379 U.S. at 260–61).

⁶⁵ *Id.* (citing *Gibbons*, 455 U.S. at 465–66).

⁶⁶ *Martignon*, 492 F.3d at 149–50.

⁶⁷ *Id.*

⁶⁸ *Id.* at 150.

⁶⁹ *Id.*

⁷⁰ *Id.* at 151.

⁷¹ *Martignon*, 492 F.3d at 151.

⁷² *Id.*

performance.⁷³ Instead, the law granted government the power to protect the interests of owners of preexisting property rights.⁷⁴

Another integral part of the court's scope analysis was the comparison of the rights created under the statute to the rights created under § 106 of the Copyright Act.⁷⁵ The court made the comparison to determine how different the statute was from the Copyright Act, which would clearly be within the scope of the Intellectual Property Clause of the Constitution. Ultimately, the court noted that § 2319A does not create, bestow, or allocate property rights in expression, it does not share the defining characteristics of other laws that are concededly "copyright laws," and it differs significantly from the Copyright Act that was passed pursuant to the Copyright Clause (and that is valid under it)." Accordingly, the Second Circuit held that the law fell outside of the scope of the Intellectual Property Clause of the Constitution, avoiding the direct balancing of the Clauses.⁷⁶

3. *Kiss Catalog, Ltd. v. Passport International Productions, Inc.*

A district court in California considered a similar issue. In *Kiss Catalog, Ltd. v. Passport International Productions, Inc.*,⁷⁷ a judge in the Central District of California considered whether an anti-bootlegging statute could be sustained under the Commerce Clause even if it violated the limited times provision of the Intellectual Property Clause.⁷⁸ That court, however, avoided the question altogether by holding that the statute did not fall under the subject matter regulated under the mandate of the Intellectual Property Clause.⁷⁹ This removed any possibility the statute circumvented the Constitution's originality and limited times requirements because it was not subject to those requirements in the first place.

⁷³ *Id.*

⁷⁴ *Id.*

⁷⁵ *Id.*

⁷⁶ *Id.*

⁷⁷ 405 F. Supp. 2d 1169 (C.D. Cal. 2005).

⁷⁸ *Id.* at 1171.

⁷⁹ *Id.* at 1176.

Unfettered by a qualifying Intellectual Property, the court found the statute constitutional under the Commerce Clause.⁸⁰

The court noted that:

[O]nce the Court concludes that the Statute does not fall within the purview of the [Intellectual Property] Clause, it need not consider whether it complies with the limitations of the [Intellectual Property] Clause. To do so imports into the Commerce Clause limits that clause does not have. That the Statute might provide “copyright-like” or “copyright-related” protection to matters clearly not covered by the [Intellectual Property] Clause is not important. One need only find an alternative source of constitutional authority.⁸¹

The court found the fact that the legislation was “copyright-like” immaterial,⁸² and rather emphasized the fact that constitutional sources of authority are fungible.⁸³ Like the court in *Moghadam*, the *Kiss Catalog* court avoids the tension between the Commerce and Copyright Clauses by finding no conflict at all.⁸⁴ Doing so avoids the question of whether the Intellectual Property Clause qualifies the exercise of Commerce Clause power when the exercise of that power results in copyright-like legislation.

The broadest interpretation of *Kiss Catalog* would imply that subject matter that does not fall under the current application of the Intellectual Property Clause could be regulated under an alternative source of constitutional power.⁸⁵ The difficulty of such an interpretation is that it becomes problematic if one assumes that Congress is not exercising the ceiling of its Intellectual Property Clause powers. If Congress later decides to regulate subject matter it can but has not before regulated under the Intellectual Property Clause, what happens to existing Commerce Clause legislation on

⁸⁰ *Id.*

⁸¹ *Id.* at 1175.

⁸² *Id.*

⁸³ *Id.*; see also *supra* note 38 and accompanying text.

⁸⁴ *Kiss Catalog*, 405 F. Supp. 2d at 1175 (citing *United States v. Moghadam*, 175 F.3d 1269, 1280).

⁸⁵ See *id.* at 1176.

point? A court following *Kiss Catalog* would eventually have to confront the question this court avoided—whether the narrower clause qualifies the more general.

B. The Treaty Power

Article II of the Constitution vests power in the executive to negotiate and sign treaties that receive the full force of United States law upon ratification by two-thirds of the Senate.⁸⁶ The product of this power, when coupled with the Supremacy Clause,⁸⁷ receives preemptive force against the states.⁸⁸ Thus, a treaty signed by the President and ratified by the Senate would not be differentiable in effect from a law passed through the traditional legislative process.⁸⁹ Yet because such a law would be passed pursuant to an Article II power, the constraints of the Article I Intellectual Property Clause may not fully apply.

Although a treaty cannot authorize what the Constitution does not allow,⁹⁰ the line between what the Constitution prohibits and what it does not affirmatively permit is blurry at best. Arguably

⁸⁶ U.S. CONST. art. II, § 2, cl. 2 (“[The President] shall have the power, by and with the Advice and Consent of the Senate, to make Treaties, provided two thirds of the Senators present concur.”).

⁸⁷ *Id.* art. VI, cl. 2 (noting that treaties become the supreme law of the land upon ratification).

⁸⁸ See *Hines v. Davidowitz*, 312 U.S. 52, 62–63 (1941) (“When the national government by treaty or statute has established rules and regulations touching the rights, privileges, obligations or burdens of aliens as such, the treaty or statute is the supreme law of the land. No state can add to or take from the force and effect of such treaty or statute.”); *Chae Chan Ping v. United States*, 130 U.S. 581, 600 (1889) (“The treaties were of no greater legal obligation than the act of congress. By the [C]onstitution, laws made in pursuance thereof, and treaties made under the authority of the United States, are both declared to be the supreme law of the land, and no paramount authority is given to one over the other.”); *Paradis v. Ghana Airways Ltd.*, 348 F. Supp. 2d 106, 114 (S.D.N.Y. 2004) (finding that a state law was preempted by an air carriage treaty).

⁸⁹ See *Chae Chan Ping*, 130 U.S. at 600.

⁹⁰ See *Asakura v. City of Seattle*, 265 U.S. 332, 341 (1924) (“The treaty-making power of the United States is not limited by any express provision of the Constitution, and, though it does not extend ‘so far as to authorize what the Constitution forbids,’ it does extend to all proper subjects of negotiation between our government and other nations.”); *Missouri v. Holland*, 252 U.S. 416, 433–34 (1924) (“The treaty in question does not contravene any prohibitory words to be found in the Constitution. The only question is whether it is forbidden by some invisible radiation from the general terms of the Tenth Amendment.”).

constraints in Article I do not extend to treaties promulgated under Article II.⁹¹ If the Intellectual Property Clause does not prohibit copyright-like legislation that does not impose the constitutional constraints of the Clause, such as the limited times provision, under the authority of another constitutional power, a treaty that disposes of such a requirement would not conflict with the Article I provision. And even if there is a conflict, it can be argued that the horizontal constraints in the Article I provisions do not carry over to an exercise of an Article II power.⁹² Such an argument, however, is beyond the scope of this Note.⁹³

C. *The Spending Power*

Congress has broad powers to spend federal funds on state programs.⁹⁴ This broad power can be used to condition the grant of federal funds on state compliance with federally imposed conditions and is subject to several constraints. First, the condition on federal funds must be unambiguously stated.⁹⁵ Second, the use of the federal funds must be for the “general welfare.”⁹⁶ Third, the use of federal funds must relate to a federal program.⁹⁷ Fourth,

⁹¹ See Caroline T. Nguyen, Note, *Expansive Copyright Protection for All Time? Avoiding Article I Horizontal Limitations Through the Treaty Power*, 106 COLUM. L. REV. 1079, 1113–17 (2006) (arguing that the horizontal limitations of Article I can be circumvented when Congress acts pursuant to its Article II power).

⁹² See *id.*

⁹³ For an excellent discussion of the effect of the Article II treaty power on the Article I Intellectual Property Clause see generally *id.* at 1113–17.

⁹⁴ See *South Dakota v. Dole*, 483 U.S. 203, 206–07 (1987).

⁹⁵ See *Pennhurst State Sch. & Hosp. v. Halderman*, 451 U.S. 1, 17 (1981) (“[L]egislation enacted pursuant to the spending power is much in the nature of a contract—in return for federal funds, the States agree to comply with federally imposed conditions. The legitimacy of Congress’ power to legislate under the spending power thus rests on whether the State voluntarily and knowingly accepts the terms of the ‘contract.’” (citing *Steward Mach. Co. v. Davis*, 301 U.S. 548, 585–98 (1937); *Harris v. McRae*, 448 U.S. 297 (1980))).

⁹⁶ See *Dole*, 483 U.S. at 207 (“The first of these limitations is derived from the language of the Constitution itself—the exercise of the spending power must be in pursuit of ‘the general welfare.’” (citing *Helvering v. Davis*, 301 U.S. 619, 640–41 (1937); *United States v. Butler*, 297 U.S. 1, 65 (1936))).

⁹⁷ See *Massachusetts v. United States*, 435 U.S. 444, 461 (1978) (“[The conditions must be] reasonably related to the federal interest in particular national projects or programs.”).

another provision of the Constitution may curtail the spending power.⁹⁸

One can easily conceive of a federal funding program that conditions federal funds on state implementation of a federal scheme of copyright-like protection. The validity of these state laws would largely depend on whether the Intellectual Property Clause would qualify the spending power and whether the state law would be preempted by the federal copyright scheme.

Section 301 of the Copyright Act requires that all state laws regulating the subject matter within the purview of the Copyright Act and that provide rights equivalent to those afforded by the Act must be preempted.⁹⁹ A state law that regulates copyright-like subject matter would fall under the umbrella of subject matter typically regulated by the Copyright Act.¹⁰⁰ If the statute did not protect distribution, copying, or derivative work rights that were

⁹⁸ See *Lawrence County v. Lead-Deadwood School. Dist.*, 469 U.S. 256, 269–70 (1985) (“Congress may impose conditions on the receipt of federal funds, absent some independent constitutional bar.”); *Buckley v. Valeo*, 424 U.S. 1, 91 (1976) (per curiam); *King v. Smith*, 392 U.S. 309, 333 n.34 (1968) (“There is of course no question that the Federal Government, unless barred by some controlling constitutional prohibition, may impose the terms and conditions upon which its money allotments to the States shall be disbursed, and that any state law or regulation inconsistent with such federal terms and conditions is to that extent invalid.” (citing *Ivanhoe Irrigation Dist. v. McCracken*, 357 U.S. 275, 295 (1958); *Oklahoma v. Civil Comm’n*, 330 U.S. 127, 143 (1947))).

⁹⁹ See 17 U.S.C. § 301(a) (2000) (“[A]ll legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright . . . are governed exclusively by this title.”); see also *Ritchie v. Williams*, 395 F.3d 283, 285–86 (6th Cir. 2005) (noting that only rights equivalent to those protected under the copyright act would be preempted); *Data Gen. Corp. v. Grumman Sys. Support Corp.*, 36 F.3d 1147, 1164 (1st Cir. 1994) (“Section 301(a) precludes enforcement of any state cause of action which is equivalent in substance to a federal copyright infringement claim.”).

¹⁰⁰ Works that would not receive federal copyright protection can still fall under the subject matter regulated by the copyright act. See *Wrench LLC v. Taco Bell Corp.*, 256 F.3d 446, 455 (6th Cir. 2001) (“The scope of the Copyright Act’s subject matter extends beyond the tangible expressions that can be protected under the Act to elements of expression which themselves cannot be protected.”); *NBA v. Motorola, Inc.*, 105 F.3d 841, 849 (2d Cir. 1997) (“Section 301 preemption bars state law misappropriation claims with respect to uncopyrightable as well as copyrightable elements.”).

equivalent to those afforded by § 106 of the Copyright Act, such a law would be valid.¹⁰¹

That is, unless the four requirements of the Taxing and Spending Power test—which leave open the possibility that another clause in the Constitution could curtail congressional power¹⁰²—would bar a condition on federal funds that would demand the implementation of a federal quasi-copyright scheme. The fourth requirement notes that another provision of the Constitution can constrain the spending power. Thus, under the Taxing and Spending Power, a court would have to face the same issue it faces under Commerce Clause cases¹⁰³—whether a law passed under an alternative legislative power could be used to circumvent the constraints of a narrower provision.

D. Problems Arising from Protecting Works Within the Subject Matter of Copyright Under an Alternative Constitutional Power

Regardless of which constitutional power is used as an alternative to the Intellectual Property Clause of the Constitution, the validity of such an exercise of power would depend on the tradeoff made between applying the constraints of a narrow constitutional provision and a policy of allowing Congress to exercise their broader constitutional powers to effectuate an identical purpose without the same constraints. Does the fact that a constitutional provision targets a specific type of subject matter make it the exclusive arbiter of that subject matter? At the core of such determinations are important policy considerations. Are the originality¹⁰⁴ and “Limited Times”¹⁰⁵ requirements embedded in the Intellectual Property Clause vital to the maintenance of a federal intellectual property protection scheme?

¹⁰¹ See *supra* note 99; see also § 301(b)(3). Section 301(b)(3) is the mirror image of 301(a), noting that laws that are not equivalent will not be preempted. *Id.*

¹⁰² See *supra* note 99 and accompanying text.

¹⁰³ See discussion *supra* Part II.A.

¹⁰⁴ See *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 358 (1991) (“Originality requires only that the author make the selection or arrangement independently (i.e., without copying that selection or arrangement from another work), and that it display some minimal level of creativity.”).

¹⁰⁵ U.S. CONST. art. I, § 8, cl. 8.

The constitutional and judicially imposed requirements derived from the Intellectual Property Clause address themselves to two broader problems. First, because American courts have interpreted the Intellectual Property Clause as allowing a division between patent and copyright law,¹⁰⁶ maintaining the more stringent requirements for obtaining a patent depends on a wall of separation between the subject matter protected by copyright and patent laws.¹⁰⁷ Otherwise, individuals will be faced with an incentive to forgo the intensive patent examination process in favor of the more lax requirements of copyright law. Second, absent the requirements of originality, idea-expression, and fixation, there would be significant difficulty in defining the property right protected by federal copyright law.

1. Enforcing the Asymmetrical Examination and Registration Processes of Copyright and Patent Law

While copyright law has created a division between the protection of idea and expression,¹⁰⁸ the patent law makes no such distinction.¹⁰⁹ The idea-expression doctrine has become an axiomatic fixture of the federal scheme of copyright protection.¹¹⁰ The most obvious function of this doctrine is to enforce the

¹⁰⁶ See *Eldred v. Ashcroft*, 537 U.S. 186, 217 (2003) (“Further distinguishing the two kinds of intellectual property, copyright gives the holder no monopoly on any knowledge. A reader of an author’s writing may make full use of any fact or idea she acquires from her reading. The grant of a patent, on the other hand, does prevent full use by others of the inventor’s knowledge.”) (citation omitted); *Alfred Bell & Co. v. Catalda Fine Arts*, 191 F.2d 99, 103 (2d Cir. 1951) (“On that account, we have often distinguished between the limited protection accorded a copyright owner and the extensive protection granted a patent owner.”).

¹⁰⁷ See *Alfred Bell & Co.*, 191 F.2d at 103 (maintaining that a distinction between a stronger patent protection and a weaker copyright protection requires that the two bodies of law be kept distinct).

¹⁰⁸ See 17 U.S.C. § 102(b) (2000).

¹⁰⁹ See 35 U.S.C. § 101 (“Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.”); see also *Nat’l Med. Care, Inc. v. Espiritu*, 284 F. Supp. 2d 424, 434 (S.D. W. Va. 2003) (“A patent is required to protect an idea isolated from any original expression.”).

¹¹⁰ See *Reyher v. Children’s Television Workshop*, 533 F.2d 87, 90 (2d Cir. 1976) (“It is an axiom of copyright law that the protection granted to a copyrightable work extends only to the particular expression of an idea and never to the idea itself.”).

separation between the subject matter protected by patents and copyrights. Patents protect ideas and copyrights protect the expression of ideas.¹¹¹ The government vests the patent property right under more stringent conditions,¹¹² and copyright protection under a lax if not non-existent examination process.¹¹³

Absent this separation, individuals could choose which type of property right they prefer. Although protection of patents are quite different than the protections afforded under the copyright laws in that copyright protection does not extend to ideas,¹¹⁴ individuals weighing the benefits of protection against the substantial cost of the patent examination and prosecution process may chose to employ the copyright laws rather than the patent laws if both the patent and the copyright schemes protected ideas. Given the ability to protect the underlying idea of a work, the Copyright Act could be used to create government sanctioned monopolies not too different in effect from a patent. In other words, if given the choice between a long, onerous, and costly patent examination process and the lax registration requirements for enforcing copyrights in court, there is little incentive to choose the intellectual property right that is more difficult to obtain.

Legislation under an alternative grant of congressional power would pose the same problem posed by removing the wall of separation between idea and expression in copyright. If the idea-expression doctrine is not incorporated into the alternative grant of power, individuals will be faced with the aforementioned incentive to subvert the stringent requirements of the patent laws by seeking the protection of ideas under an alternative copyright-like statute.

¹¹¹ See *Mazer v. Stein*, 347 U.S. 201, 217 (1954) (“Unlike a patent, a copyright gives no exclusive right to the art disclosed; protection is given only to the expression of the idea—not the idea itself.”); *Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d 1240, 1252 (3d Cir. 1983) (discussing the idea-expression dichotomy in terms of the division between patent and copyright protection).

¹¹² See *Mazer*, 347 U.S. at 215 (“[D]esign patents require the critical examination given patents to protect the public against monopoly.”).

¹¹³ While registration is *prima facie* evidence of the validity of a copyright, see 17 U.S.C. § 410(c), registration does not require a thorough examination process.

¹¹⁴ See *id.* § 102(b).

2. Difficulties in Defining the Property Right

Many of the judicial doctrines in copyright law serve the objective of protecting the intangible.¹¹⁵ Intellectual property rights are, to some extent, a legal fiction.¹¹⁶ The law vests property rights in the intangible. The material world does not provide the traditional metes and bounds to products of the mind as it does to property composed of matter. It falls upon the law to serve the function of defining to what extent a property right vests in such works.

The fixation requirement reduces the intractable problem of protecting something that exists only in the mind. By requiring works to be expressed in a tangible and permanent medium prior to being protected,¹¹⁷ the fixation requirement reinforces the barrier between idea and expression at the core of copyright protection.¹¹⁸ A work cannot be protected until it is expressed and works that exist only in the mind receive no special treatment.

Absent a requirement that works be fixed, courts will have to grapple with the metaphysical question of defining the limits of a property right that has no permanent physical manifestation. While an unauthorized recording of a live musical performance,

¹¹⁵ See *White-Smith Music Publ'g Co. v. Apollo Co.*, 209 U.S. 1, 11 (1908) (“Musical compositions mentioned as the subject of copyright are tangible and legible embodiments of the intellectual product of the musician, and not the intangible intellectual product itself.”); *United States v. Gottesman*, 724 F.2d 1517, 1520 (11th Cir. 1984) (“We hold that the intangible idea protected by the copyright is effectively made tangible by its embodiment upon the [medium].”).

¹¹⁶ Report, American Bar Association Jurisdiction in Cyberspace Project, *Achieving Legal and Business Order in Cyberspace: A Report on Global Jurisdiction Issues Created by the Internet*, 55 BUS. LAW. 1801, 1899 (“All intellectual property interests are intangible, and legal fictions are used to localize these interests.”).

¹¹⁷ See 17 U.S.C. § 101; see also *Williams Elecs., Inc. v. Artic Int'l, Inc.*, 685 F.2d 870, 873–74 (3d Cir. 1982) (“The fixation requirement is defined in section 101 in relevant part as follows: A work is ‘fixed’ in a tangible medium of expression when its embodiment in a copy or phonorecord, by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.”).

¹¹⁸ For example, the inability to mark off the metes and bounds of speech during an interview with Ernest Hemingway prevented a court deciding whether to protect the contents of the interview from granting a common law copyright. This was largely due to a lack of fixation. See *Estate of Hemingway v. Random House, Inc.*, 23 N.Y.2d 341, 346 (1968).

for example, may give rise to liability, it is unclear where liability stops. What constitutes a live performance? When does the performance end? Is the author entitled to a sequence of three repetitive notes performed live? Many of the answers that one naturally provides to solve these problems stem from the rich doctrine developed in copyright law. For example, the repetitive notes may invoke the merger doctrine. Yet when Congress enacts legislation pursuant to its commerce power, do these doctrines come with such legislation?

The next section will discuss an important doctrine of copyright law—the idea-expression doctrine. This doctrine is the encapsulating term for the notion that copyright protects expression not ideas and the facilitating corollary doctrines of fair use and merger. After discussing the origins, purpose, and facilitating doctrines of the idea-expression doctrine, this Note will again pose the question of what effect copyright doctrines have on legislation promulgated pursuant to an alternative grant of constitutional power. This Note will argue that the doctrine of idea-expression and its corollaries are constitutional requirements that must constrain any alternative constitutional power when used to pass copyright-like legislation.

III. THE IDEA-EXPRESSION DICHOTOMY AND ITS COROLLARY DOCTRINES: FACILITATING COPYRIGHT PROTECTION

Apart from the doctrine's most obvious application—maintaining the separation between patent and copyright protection—the doctrine delineates the scope of intellectual property rights through several corollary doctrines. The Fair Use doctrine, for example, allows some flexibility in the property right to ensure that others can build on the ideas that protected expression is predicated on.¹¹⁹ Part of the primary function of the Fair Use doctrine is not only to provide access to the underlying ideas of a work, but also to keep idea and expression separate from

¹¹⁹ See *Eldred v. Ashcroft*, 537 U.S. 186, 190 (2003) (“[T]he ‘fair use’ defense allows the public to use not only facts and ideas contained in a copyrighted work, but also expression itself in certain circumstances.”).

each other.¹²⁰ It allows individuals to distinguish idea from expression and to determine at what point private rights end and the public domain begins.¹²¹

Likewise, the judicially created conceptual separability tests also enforce the line between idea and expression. Coupled with the Merger Doctrine, courts ensure that underlying ideas are easily accessible to the public by preventing the protection of works in which expression and ideas are indistinguishable from one another. This section will explore the origins of the idea-expression doctrine along with its modern applications through various judicially created doctrines. This section will also look at specific examples in which idea and expression typically run a high risk of merger, such as in computer software and functional art. The doctrine is not only a judicially created policy, but also the cornerstone of maintaining intellectual property rights without compromising the public benefit for which such rights were created in the first place.

A. The Pragmatic Genesis of the Idea-Expression Distinction

The early distinction between idea and expression was premised on the intangibility of ideas. Since one cannot divine what exists in another's mind, ideas cannot be protected until they are expressed.¹²² The difficulty lies in establishing the metes and bounds of a property right that exists solely in the mind and in the little use such an embodiment of an idea would have to the cumulative creation of new works.¹²³

¹²⁰ See *id.* at 219 (“[Fair Use] distinguishes between ideas and expression and makes only the latter eligible for copyright protection.”).

¹²¹ See *Atari Games Corp. v. Nintendo of Am. Inc.*, 975 F.2d 832, 844 (Fed. Cir. 1992) (“[Reverse engineering fair use allows users] to distinguish the protected from the unprotected elements of [a computer program].”).

¹²² See *infra* notes 125–126 and accompanying text.

¹²³ See *Clayton v. Stone & Hall*, 5 F. Cas. 999, 1003 (C.C.S.D.N.Y. 1829) (No. 2,872) (“The term ‘science’ cannot, with any propriety, be applied to a work of so fluctuating and fugitive a form as that of a newspaper or price-current, the subject-matter of which is daily changing, and is of mere temporary use.”). Courts attempting to fix common law copyright protection in unfixed works have struggled with defining the property right. The New York Court of Appeals considered a claim by the estate of Ernest Hemingway seeking to protect Hemingway’s utterances during an interview under a theory of common law copyright. See *Estate of Hemingway*, 23 N.Y.2d at 346 (1968). That court

Early courts that decided whether the ideas underlying works are copyrightable examined the approach taken by English courts interpreting the Statute of Anne.¹²⁴ The Supreme Court in *Holmes v. Hurst*¹²⁵ quoted Justice Erle in *Jefferys v. Boosey* in defining the property right vested by the copyright laws and noted that “[t]he subject of property is the order of words in the author’s composition, not the words themselves . . . nor the ideas expressed by those words, they existing in the mind alone, which is not capable of appropriation.”¹²⁶

A second difficulty that gave rise to the distinction between idea and expression is the possibility of protecting both the expressive and utilitarian elements of a copyrighted work. The origin of the doctrine is largely attributable to the seminal Supreme Court Case of *Baker v. Selden*.¹²⁷ In that case the Court decided whether a book that included forms for a method of bookkeeping were protected under the copyright laws.¹²⁸ The Supreme Court held that the forms were not protected because doing so may result in protecting the method of accounting concomitant with using the forms to record financial data.¹²⁹

Although the Court did not do so explicitly, it implicitly announced a distinction between ideas and the expression of ideas. The Court noted that the illustrations in the book describing the method of bookkeeping:

are the mere language employed by the author to convey his ideas more clearly. Had he used words of description instead of diagrams (which merely

stated that “[a]ssuming, without deciding, that in a proper case a common-law copyright in certain limited kinds of spoken dialogue might be recognized, it would, at the very least, be required that the speaker indicate that he intended to mark off the utterance in question from the ordinary stream of speech, that he meant to adopt it as a unique statement and that he wished to exercise control over its publication.” *Id.* at 349.

¹²⁴ See, e.g., *Holmes v. Hurst*, 174 U.S. 82, 85–86 (1899); *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591, 595 (1834); *Sarony v. Burrow-Giles Lithographic Co.*, 17 F. 591, 593 (C.C.S.D.N.Y. 1883); *Myers v. Callaghan*, 5 F. 726, 732 (C.C.N.D. Ill. 1881); *Lawrence v. Dana*, 15 F. Cas. 26, 34 (C.C. D. Mass. 1869) (No. 8,136).

¹²⁵ *Holmes*, 174 U.S. 82.

¹²⁶ *Id.* at 86 (quoting *Jefferys v. Boosey*, (1854) 10 Eng. Rep. 681, 702 (H.L.)).

¹²⁷ 101 U.S. 99 (1879).

¹²⁸ *Id.* at 100–01.

¹²⁹ *Id.* at 107.

stand in the place of words), there could not be the slightest doubt that others, applying the art to practical use, might lawfully draw the lines and diagrams which were in the author's mind, and which he thus described by words in his book.¹³⁰

The Court further noted that given the purpose of the copyright laws—to spur the creation of new works based on old ideas—protecting the system of bookkeeping described in the book would mean that “knowledge could not be used without incurring the guilt of piracy of the book.”¹³¹ The book would protect not just the expressive description of the method of bookkeeping but the method itself.¹³²

The fundamental risk in protecting the utility of the work is that such protection would lock up the ideas underlying the method of bookkeeping because the method of bookkeeping—the process itself—is the underlying idea of the work. Accordingly, the *Baker* Court noted:

The description of the art in a book, though entitled to the benefit of copyright, lays no foundation for an exclusive claim to the art itself. The object of the one is explanation; the object of the other is use. The former may be secured by copyright. The latter can only be secured, if it can be secured at all, by letters-patent.¹³³

Thus, the difficulty in divorcing the idea behind a utilitarian work from the utility of the work gave rise to a distinction between the protections of the patent and copyright laws.

The distinction between idea and expression arose because of two problems inherent in protecting ideas. First, because an idea is intangible and unexpressed, the contours of a property right in ideas would be amorphously defined. Second, in works straddling the line between being utilitarian and expressive, protecting the utilitarian aspects of the work would mean possibly protecting the

¹³⁰ *Id.* at 103.

¹³¹ *Id.* at 103–04.

¹³² *Id.* at 103–04.

¹³³ *Id.* at 105.

ideas intertwined with the utility of the work. The purpose of making the distinction is one of necessity; absent such a distinction the property right would not take concrete form.

B. The Modern Application of the Idea-Expression Doctrine and Its Corollaries

The judicially created doctrine has given rise to codification in § 102 of the Copyright Act of 1976.¹³⁴ That provision states that “[i]n no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.”¹³⁵

The idea-expression dichotomy embodies the premise that “[u]nlike a patent, a copyright gives no exclusive right to the art disclosed; protection is given only to the expression of the idea—not the idea itself.”¹³⁶ This doctrine has been applied in several situations, primarily when either protecting the expression would potentially protect the underlying ideas of the work or when a work is so intertwined with the underlying ideas that the two cannot be distinguished.¹³⁷

Two types of works are problematic when distinguishing between protectable expression and unprotectable ideas. First, functional art tends to blur the lines between idea and expression because the artistic features of a work may also serve some functional purpose.¹³⁸ Second, software—in its most expressive

¹³⁴ See H.R. Rep. 94-1476, 57 (“Section 102(b) in no way enlarges or contracts the scope of copyright protection under the present law. Its purpose is to restate, in the context of the new single Federal system of copyright, that the basic dichotomy between expression and idea remains unchanged.”).

¹³⁵ 17 U.S.C. § 102(b) (2000).

¹³⁶ *Mazer v. Stein*, 347 U.S. 201, 217–18 (1954) (citations omitted).

¹³⁷ See *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 364 (1991) (stating that a compilation of facts in a directory lacks originality); *Baker*, 101 U.S. at 103 (stating that a copyright on a work of mathematical science cannot give an exclusive right over the methods of operation or the diagrams used to explain those methods).

¹³⁸ See *Stein v. Rosenthal*, 103 F. Supp. 227, 231 (S.D. Cal. 1952), *aff'd*, 205 F.2d 633 (9th Cir. 1953) (addressing the issue of whether a registered sculpture is utilitarian in purpose and character).

form being written in a computer language and in its most utilitarian form no more than a series of machine instructions—tends to straddle the line between a method of operation and an expressive literary work.¹³⁹

This section will examine the application of the idea-expression doctrine within the context of computer software and utilitarian works of art. Moreover, this section will also discuss two doctrinal corollaries to the idea-expression doctrine, the Merger and Fair Use Doctrines.

1. The Line Between Utility and Expression in Computer Software

The idea-expression dichotomy has given rise to extensive litigation over copyright protection of the non-literal elements of software.¹⁴⁰ Computer software, being no more than a series of computer instructions, can be viewed as indistinguishable from a recipe¹⁴¹ or, as the styled by the statute, “a method of operation.”¹⁴²

¹³⁹ See Pamela Samuelson et. al, *Manifesto Concerning the Legal Protection of Computer Programs*, 94 COLUM. L. REV. 2308, 2351 (1994) (noting that § 102(b) precludes copyrighting of methods of operation, but program behavior can be copyrightable when it is expressive).

¹⁴⁰ Jack George Abid, *Software Patents On Both Sides Of The Atlantic*, 23 J. MARSHALL J. COMPUTER & INFO. L. 815, 822 (2005) (“With copyright protection for software well established, software firms, especially in the U.S., began to seek broader intellectual property protection for their software by filing copyright infringement suits alleging non-literal infringement against competing firms using questionable tactics.”); Jacob A. Gantz, *[Private] Order[ing] in the Court?: How the Circuit Courts Should Resolve the Current Conflict Over Reverse Engineering Clauses in Mass Market Licenses*, 36 RUTGERS L.J. 999, 1004 (2005) (“After Apple, a ‘second generation’ of cases arose that challenged the limits of protection afforded to computer software.” (quoting ROBERT P. MERGES ET AL., *INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE* 872 (Aspen 3d ed. 2003))).

¹⁴¹ Some courts have chosen to protect, although not directly, recipes. See *Fargo Mercantile Co. v. Brechet & Richter Co.*, 295 F. 823, 828 (8th Cir. 1924) (“[Recipes] are not a mere advertisement; they are original compositions, and serve a useful purpose, apart from the mere advertisement of the article itself. They serve to advance the culinary art.”). Yet, most courts do not protect recipes unless the author elaborates on the recipe. See *Publ’ns Int’l v. Meredith Corp.*, 88 F.3d 473, 480 (7th Cir. 1996) (“The recipes involved in this case comprise the lists of required ingredients and the directions for combining them to achieve the final products. The recipes contain no expressive elaboration upon either of these functional components, as opposed to recipes that might spice up functional directives by weaving in creative narrative. We do not express any

Yet, courts have long since protected software as literary works since the source code and object code often express the ideas underlying what the program ultimately accomplishes.¹⁴³

A program, being a functionally driven work, is often difficult to parse for idea and expression.¹⁴⁴ Courts have been faced with a choice either to protect only the literal elements of the work, such as the instructions or computer language expression, or to protect the non-literal elements just as courts protect the plot of a novel or other literary work.¹⁴⁵ Courts have chosen to walk the fine line of protecting both literal and non-literal elements of source code, but only to the extent that they are expressive and do not embody the underlying ideas of the code.¹⁴⁶

The most prominent debate over the protection of non-literal elements of source code is whether the structure, sequence, and organization of a computer program can be protected.¹⁴⁷ On one hand, the true value in source code is the organizational approach taken by the author, simply because one method of writing a

opinion whether recipes are or are not per se amenable to copyright protection, for it would be inappropriate to do so.”)

¹⁴² 17 U.S.C. § 102(b) (2000).

¹⁴³ *Brown Bag Software v. Symantec Corp.*, 960 F.2d 1465, 1476–77 (9th Cir.1992) (“[A]t least some computer programs bear significant similarities to literary works.”); *Vault Corp. v. Quaid Software Ltd.*, 847 F.2d 255, 259 (5th Cir.1988) (noting that the copyright act treats software as literary works.”).

¹⁴⁴ *See Gates Rubber Co. v. Bando Chem. Indus., Ltd.*, 9 F.3d 823, 834 (10th Cir. 1993) (“Determining which elements of a program are protectable is a difficult task.”); *see also* Peter S. Menell, *An Analysis of the Scope of Copyright Protection for Application Programs*, 41 STAN. L. REV. 1045, 1046 (1989) (“Computer software, by its very nature as written work intended to serve utilitarian purposes, defies easy categorization within our intellectual property system.”).

¹⁴⁵ *Menell, supra* note 144, at 1046 (noting the emergence of copyright infringement suits involving non-literal forms of copying).

¹⁴⁶ *Id.* at 1049.

¹⁴⁷ *Compare Whelan Assocs., Inc. v. Jaslow Dental Labs., Inc.*, 797 F.2d 1222, 1248 (3d Cir. 1986) (protecting structure, sequence, and organization), *with* *Computer Assocs. Int’l, Inc. v. Altai, Inc.*, 775 F.Supp. 544, 560–61 (E.D.N.Y. 1991), *aff’d*, 982 F.2d 693 (2d Cir. 1992) (holding that such protection would be too broad). The United States Copyright Office does not register works based solely on the structure, sequence, and organization of a computer program. U.S. Copyright Office, Copyright Registration for Computer Programs (Circular 61), <http://www.copyright.gov/circs/circ61.pdf> (last visited Oct. 8, 2007).

program may be more efficient than another that accomplishes the same functional task.¹⁴⁸

This is particularly true in the realm of object-oriented programming,¹⁴⁹ which requires programmers to create a hierarchy of objects or data structures.¹⁵⁰ Object-oriented programming allows a programmer to define an object,¹⁵¹ for example a cat, give the object properties inherent in all cats, and when the programmer wants to create a narrower version of such an object, such as a lion, she would avoid reinventing the wheel¹⁵² by inheriting a new object “lion” as a kind of “cat.” The hierarchy created by the programmer may warrant protection, although such a hierarchy is not explicit in the code.

Even in sequential programming models, there is essentially some ingenuity in between the lines. Instructions are grouped into subroutines, and subroutines are executed in a particular order, giving rise to an ultimate functional effect.

Moreover, there is the problem of abstraction that exists in virtually any literary work.¹⁵³ Just as a Shakespearian sonnet can be characterized as an aggregation of characters, an aggregation of words, an aggregation of sentences, or the overarching structure of iambic pentameter, so too can computer software be characterized in myriad different ways. Yet, there is a problem unique to

¹⁴⁸ See *Computer Assocs. Int'l v. Altai, Inc.*, 982 F.2d 693, 708 (2d Cir. 1992) (noting that efficiency concerns may narrow the universe of ways individuals can write a computer subroutine).

¹⁴⁹ For an excellent discussion about object oriented programming, see Jacqueline D. Lipton, *IP's Problem Child: Shifting the Paradigms for Software Protection*, 58 HASTINGS L.J. 205, 228–29 (2006).

¹⁵⁰ See *id.* at 228.

¹⁵¹ See *id.*

¹⁵² See *id.* at 229.

¹⁵³ See *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (L. Hand, J.) (“Upon any work, and especially upon a play, a great number of patterns of increasing generality will fit equally well, as more and more of the incident is left out. The last may perhaps be no more than the most general statement of what the play is about, and at times might consist only of its title; but there is a point in this series of abstractions where they are no longer protected, since otherwise the playwright could prevent the use of his ‘ideas’, to which, apart from their expression, his property is never extended.” (citing *Holmes v. Hurst*, 174 U.S. 82, 86 (1899))); see also Michael D. Murray *Copyright, Originality, and the End of the Scènes à Faire and Merger Doctrines for Visual Works*, 58 BAYLOR L. REV. 779, 791–93 (2006) (discussing the *Nichols* case).

computer programs. The lower the level of abstraction, the more computer software approaches becoming no more than a method or system of operation.¹⁵⁴

The Third Circuit first dealt with this problem by applying a broad rule expansively protecting the non-literal elements of code. That court in *Whelan Associates, Inc. v. Jaslow Dental Laboratories, Inc.*,¹⁵⁵ addressed the question of whether a program created by translating a program written in one programming language into another could be an infringement of the original work.¹⁵⁶ In essence, the court had to decide whether the underlying structure of the code was protected or whether only the literal elements of the code were protected.¹⁵⁷

In holding that copyright law protected the organization of the computer program the court reasoned:

As the program structure is refined, the programmer must make decisions about what data are needed, where along the program's operations the data should be introduced, how the data should be inputted, and how it should be combined with other data. The arrangement of the data is accomplished by means of data files . . . and is affected by the details of the program's subroutines and modules, for different arrangements of subroutines and modules may require data in different forms. Once again, there are numerous ways the programmer can solve the data-organization problems she or he

¹⁵⁴ *Eng'g Dynamics v. Structural Software*, 26 F.3d 1335, 1341 (5th Cir. 1994) ("But as one moves away from the literal code to more general levels of a program, it becomes more difficult to distinguish between unprotectible ideas, processes, methods or functions, on one hand, and copyrightable expression on the other."); *Lotus Dev. Corp. v. Paperback Software Int'l*, 740 F. Supp. 37 (D. Mass. 1990) ("Drawing the line too liberally in favor of copyright protection would bestow strong monopolies over specific applications upon the first to write programs performing those applications and would thereby inhibit other creators from developing improved products. Drawing the line too conservatively would allow programmer's efforts to be copied easily, thus discouraging the creation of all but modest incremental advances.") (quoting Menell, *Scope of Copyright Protection for Programs*, 41 STAN. L. REV. 1045, 1047-48 (1989)).

¹⁵⁵ 797 F.2d 1222 (1986).

¹⁵⁶ *Id.* at 1224.

¹⁵⁷ *Id.*

faces. Each solution may have particular characteristics—efficiencies or inefficiencies, conveniences or quirks—that differentiate it from other solutions and make the overall program more or less desirable.¹⁵⁸

The Third Circuit thus implicitly noted that the ultimate choice in the mode of dealing with the data-organization problems posed by a programming task were in effect the valuable aspects of a computer program.¹⁵⁹ The court emphasized the comparative value of the structure of a program in comparison to the value of the actual coding by noting that “the coding process is a comparatively small part of programming.”¹⁶⁰

The *Whelan* court chose to protect non-literal elements because other types of literary works can be infringed upon even though there is no literal copying of the original work.¹⁶¹ Since computer programs have been interpreted to be literary works¹⁶² the same reasoning should therefore apply. The court thus articulated the following test:

¹⁵⁸ *Id.* at 1230.

¹⁵⁹ *See id.*

¹⁶⁰ *Id.* at 1231.

¹⁶¹ *Id.* at 1234 (“The copyrights of other literary works can be infringed even when there is no substantial similarity between the works’ literal elements.”); *Twentieth Century-Fox Film Corp. v. MCA, Inc.*, 715 F.2d 1327, 1329 n.5 (9th Cir. 1983) (noting similarities in the plots of two different literary works); *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930) (noting that copyright must protect against immaterial variations on literal elements).

¹⁶² *Atari Games Corp. v. Oman*, 888 F.2d 878, 885 n.8 (D.C. Cir. 1989); *Vault Corp. v. Quaid Software Ltd.*, 847 F.2d 255, 259 (5th Cir. 1988) (noting that software is protected as a literary work under the 1976 Act); *Williams Elecs., Inc. v. Artic Int’l, Inc.*, 685 F.2d 870, 875 (3d Cir. 1982) (“[A] computer program can be the subject of a copyright as a literary text.”); *Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d 1240, 1249 (3d Cir. 1983); *Stern Elecs., Inc. v. Kaufman*, 669 F.2d 852, 855 n.3 (2d Cir. 1982) (“Written computer programs are copyrightable as literary works.”); *Corsearch, Inc. v. Thomson & Thomson*, 792 F. Supp. 305, 322 n.10 (S.D.N.Y. 1992) (noting that definition of a literary work includes databases); *see also* H.R. Rep. No. 94-1476, at 54 (1976) (“[The definition of literary work] includes computer data bases and computer programs to the extent that they incorporate authorship in the programmer’s expression of original ideas, as distinguished from the ideas themselves.”); S. Rep. No. 94-473, at 50–51 (1975).

[T]he line between idea and expression may be drawn with reference to the end sought to be achieved by the work in question. In other words, *the purpose or function of a utilitarian work would be the work's idea, and everything that is not necessary to that purpose or function would be part of the expression of the idea.* Where there are various means of achieving the desired purpose, then the particular means chosen is not necessary to the purpose; hence, there is expression, not idea.¹⁶³

Conflating computer programs with other literary works, however, proved dangerous. Protecting computer programs as literary works could result in simultaneously protecting the underlying method of operation or idea. This heightened risk of overprotecting computer programs may counsel against a more cautious protection. Soon after *Whelan*, courts began to question the Third Circuit's reasoning.¹⁶⁴ Among the most prominent criticisms of the *Whelan* decision was that the *Whelan* rule of protecting the structure, sequence, and organization of a computer program implicitly assumed that idea could always be separated from expression in computer programs, allowing a court to protect only the portions of a computer program that warrant copyright protection. In quoting Professor Nimmer's treatise, the court in *Computer Associates International v. Altai, Inc.* stated that "[t]he crucial flaw in this reasoning is that it assumes that only one 'idea,'

¹⁶³ *Whelan*, 797 F.2d at 1236 (citation omitted).

¹⁶⁴ See *CMAX/Cleveland, Inc. v. UCR, Inc.*, 804 F. Supp. 337, 352 (1992) ("The sheer simplicity of the Third Circuit's idea/expression analysis tempts the Court to adopt its test. Unfortunately, the simplicity that makes the test so attractive, also makes it conceptually overbroad and descriptively inadequate." (internal quotation marks omitted)); *Computer Assocs. Int'l, Inc. v. Altai, Inc.*, 775 F. Supp. 544, 560-61 (E.D.N.Y. 1991), *aff'd*, 982 F.2d 693 (2d Cir. 1992) ("*Whelan*, therefore, is fundamentally flawed . . . by failing to distinguish between the static and dynamic views of a program."); see also 3 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT, § 13.03[F][1] (2006) [hereinafter "NIMMER"] ("The crucial flaw in this reasoning is that it assumes that only one 'idea,' in copyright law terms, underlies any computer program, and that once a separable idea can be identified, everything else must be expression."); Steven R. Englund, *Idea, Process, or Protected Expression?: Determining the Scope of Copyright Protection of The Structure of Computer Programs*, 88 MICH. L. REV. 866, 882 (1990).

in copyright law terms, underlies any computer program, and that once a separable idea can be identified, everything else must be expression.”¹⁶⁵ Applying the structure, sequence, and organization test in *Whelan* could thus overprotect works such that copyright protection would extend to unprotectable ideas underlying a work.

The debate over the scope of protection to be afforded the non-literal elements of computer programs illustrates the intertwined nature of idea and expression in utilitarian works. The *Altai* court clearly noted the problem specifically inherent to computer programs:

[A] computer program is made up of sub-programs and sub-sub-programs, and so on. Each of those programs and sub-programs has at least one idea. Some of them could be separately copyrightable; but many of them are so standard or routine in the computer field as to be almost automatic statements or instructions written into a program.¹⁶⁶

The *Altai* court attributed the difficulty in deciding the scope of protection to the same abstraction problem that Judge Learned Hand noted in the *Nichols* case.

Thus, one of the principle roles of the idea-expression doctrine is to police the line between the protected expression and unprotected utility that inherently exists when the Copyright Act protects computer programs. Moreover, whether and to what extent a computer program is protected by the Copyright Act directly depends on how the line between idea and expression is drawn.

¹⁶⁵ *Altai*, 775 F. Supp. at 559 (quoting 3 NIMMER, *supra* note 164, at § 13.03[F][1]).

¹⁶⁶ *Id.* at 559. The *Altai* court further noted a distinction between text and behavior. Quoting the testimony of an expert witness, the *Altai* court noted that “there is no necessary relationship between the sequence of operations in a program, which are part of behavior, and the order or sequence in which those operations are set forth in the text of the program—the source code and object code [T]he order in which sub-routines appear in the program text is utterly irrelevant, and the two views of a computer program, as text and as behavior, are quite distinct.” *Id.* (internal quotation marks omitted).

2. Conceptual Separability

The Copyright Act protects works of applied art. Yet, such works embody both artistic expression and utilitarian function. Federal courts have struggled with the task of determining to what extent such works are protected under the Copyright Act. In doing so, courts have attempted to separate the expressive elements of utilitarian art from the utilitarian elements in accord with the definition of a “[p]ictorial, graphic, and sculptural work[.]” under § 101 of the Copyright Act.¹⁶⁷

The current version of the statute codifies the holding in *Mazer v. Stein*.¹⁶⁸ That Court confronted a work that was both a statue and a table lamp.¹⁶⁹ The Court noted that “[w]e find nothing in the copyright statute to support the argument that the intended use or use in industry of an article eligible for copyright bars or invalidates its registration. We do not read such a limitation into the copyright law.”¹⁷⁰ The Supreme Court thus allowed the protection of works that are at once utilitarian and expressive.

With the idea-expression dichotomy still in place, the fundamental challenge in endorsing the holding in *Mazer* is

¹⁶⁷ 17 U.S.C. § 101 (2000) (“Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.”).

¹⁶⁸ *Mazer v. Stein*, 347 U.S. 201 (1954). The house report notes that the bill affirms the ruling in *Mazer*. H.R. Rep. No. 94-1476, at 105 (1976); see also *Brandir Int’l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1147 (2d Cir. 1987); *Kieselstein-Cord v. Accessories By Pearl, Inc.*, 632 F.2d 989, 992 (2d Cir. 1980); *Davis v. United Artists, Inc.*, 547 F. Supp. 722, 726 n.11 (S.D.N.Y. 1982); Beth F. Dumas, *The Functionality Doctrine in Trade Dress and Copyright Infringement Actions: A Call for Clarification*, 12 HASTINGS COMM. & ENT L.J. 471, 473 n.17 (1990) (After the Supreme Court’s decision in *Mazer v. Stein*, 37 C.F.R. § 202.10(c) (1979) codified the holding, and it can be argued that the statute adopts the regulation’s rule. The provision promulgated the following rule—(c) If the sole intrinsic function of an article is its utility, the fact that the article is unique and attractively shaped will not qualify it as a work of art. However, if the shape of a utilitarian article incorporates features, such as artistic sculpture, carving, or pictorial representation, which can be identified separately and are capable of existing independently as a work of art, such features will be eligible for registration.”)

¹⁶⁹ *Mazer*, 347 U.S. at 202–03.

¹⁷⁰ *Id.* at 218.

protecting the expressive component of such works while leaving the underlying utility to the public domain or to the law of patents. The standard to be used when policing the line between utility and art has given rise to a broader debate over whether a work is “conceptually separable.”¹⁷¹

The principle case giving rise to the distinction between works of art that are and are not conceptually separable is the Second Circuit opinion in *Kieselstein-Cord v. Accessories by Pearl, Inc.*,¹⁷² in which that court determined whether decorative belt buckles were copyrightable subject matter.¹⁷³ Noting that the buckles possessed ornamental elements that are conceptually separable from the utilitarian function of the belt,¹⁷⁴ the Second Circuit particularly cited the use of the buckles on other parts of the body besides the waist.¹⁷⁵ The court then compared such a product to jewelry,¹⁷⁶ which at the time had been protected under copyright law.¹⁷⁷ In protecting the belt buckles by denying summary judgment on the copyrightability issue, the *Kieselstein-Cord* court endorsed a rule that interpreted the Copyright Act’s protections to “extend only to ornamental or superfluous designs contained within useful objects while denying [such protections] to artistically designed functional components of useful objects.”¹⁷⁸

¹⁷¹ The House Report to the 1976 Act notes that separability can be either physical or conceptual. H.R. Rep. No. 94-1476, at 55 (1976); *Kieselstein-Cord*, 632 F.2d at 993 (noting that the legislative history allows either physical or conceptual separability as a condition for protection).

¹⁷² *Kieselstein-Cord*, 632 F.2d at 989.

¹⁷³ *Id.* at 990–91.

¹⁷⁴ *Id.* at 993.

¹⁷⁵ *Id.* (“We see in appellant’s belt buckles conceptually separable sculptural elements, as apparently have the buckles’ wearers who have used them as ornamentation for parts of the body other than the waist.”).

¹⁷⁶ *Id.*

¹⁷⁷ The *Kieselstein-Cord* court cited three cases for this proposition: *Boucher v. Du Boyes, Inc.*, 253 F.2d 948, 949 (2d Cir. 1958) (holding that costume jewelry, particularly earrings were within the subject of the statute); *Cynthia Designs, Inc. v. Robert Zentall, Inc.*, 416 F. Supp. 510, 511–12 (S.D.N.Y. 1976) (protecting a pendent rendering a t-shirt); and *Trifari, Krussman & Fishel, Inc. v. Charel Co.*, 134 F. Supp. 551, 552–53 (S.D.N.Y. 1955) (protecting what plaintiff in that case characterized as “junk jewelry,” or costume jewelry).

¹⁷⁸ *Kieselstein-Cord*, 632 F.2d at 996.

The decision to protect works that are conceptually or physically separable has given rise to several fragmented tests. One such test emerged when the Second Circuit revisited its holding in *Kieselstein-Cord* in 1985 in the case of *Carol Barnhart Inc. v. Economy Cover Corp.*¹⁷⁹ Instead of overruling the decision, that court distinguished the case on the grounds that the ornamental components of the torso mannequins in that case were necessary to the utility of the work.¹⁸⁰ The *Carol Barnhart* court observed that the ornamental elements of the torso mannequins were “inextricably intertwined with the utilitarian feature, the display of clothes.”¹⁸¹

Judge Newman, dissenting in *Carol-Barnhart*, articulated another test for conceptual separability that inquired whether “the article . . . stimulate[s] in the mind of the beholder a concept that is separate from the concept evoked by its utilitarian function.”¹⁸² Commentators have referred to this test as the “temporal displacement” test.¹⁸³

Yet another test emerged from Professor Robert C. Denicola’s famous article,¹⁸⁴ which attempted to create a clearer test for conceptual separability.¹⁸⁵ In seeking a workable rule, Professor Denicola made an important concession about the endeavor and noted that “[i]n truth, of course, there is no line, but merely a spectrum of forms and shapes responsive in varying degrees to utilitarian concerns.”¹⁸⁶ Setting criteria for a more ideal test,

¹⁷⁹ 773 F.2d 411 (2d Cir. 1985).

¹⁸⁰ *Id.* at 419.

¹⁸¹ *Id.*

¹⁸² *Id.* at 422 (Newman, J., dissenting).

¹⁸³ See WILLIAM PATRY, *LATMAN’S THE COPYRIGHT LAW* 43–45 (6th ed. 1986); Eric Setliff, *Copyright and Industrial Design: An “Alternative Design” Alternative*, 30 COLUM. J.L. & ARTS 49, 58 (2006); see also John B. Fowles, *The Utility of a Bright Line Rule in Copyright Law: Freeing Judges from Aesthetic Controversy and Conceptual Separability in Leicester v. Warner Bros.*, 12 UCLA ENT. L. REV. 301, 313 (2005); Dana Beldiman, *Protecting The Form But Not The Function: Is U.S. Law Ready For A New Model?*, 20 SANTA CLARA COMPUTER & HIGH TECH. L.J. 529, 545 (2004); Richard G. Frenkel, *Intellectual Property In The Balance: Proposals For Improving Industrial Design Protection in the Post-TRIPS Era*, 32 LOY. L.A. L. REV. 531, 549 (1999).

¹⁸⁴ Robert C. Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV. 707 (1983).

¹⁸⁵ *Id.* at 741.

¹⁸⁶ *Id.*

Professor Denicola noted that “[o]nly a model appealing directly to the considerations underlying the separability standard can avoid purely arbitrary distinctions.”¹⁸⁷

The Second Circuit, in the 1987 of *Brandir International, Inc., v. Cascade Pacific Lumber Co.*,¹⁸⁸ restated Professor Denicola’s test as requiring that when “design elements reflect a merger of aesthetic and functional considerations, the artistic aspects of a work cannot be said to be conceptually separable from the utilitarian elements. Conversely, where design elements can be identified as reflecting the designer’s artistic judgment exercised independently of functional influences, conceptual separability exists.”¹⁸⁹

The several tests that have emerged to determine the issue of conceptual separability illustrate the difficulty in policing the line between utilitarian function and artistic expression. By maintaining a distinction between a work’s utilitarian function and its artistic elements, courts ensure that authors cannot protect utility under the guise of copyright, and in turn circumvent the thorough examination process required to obtain patent

¹⁸⁷ *Id.*

¹⁸⁸ 834 F.2d 1142 (2d Cir. 1987).

¹⁸⁹ *Id.* at 1145. The *Brandir* court noted that the Denicola test had several benefits:

First, the approach is consistent with the holdings of our previous cases. In *Kieselstein-Cord*, for example, the artistic aspects of the belt buckles reflected purely aesthetic choices, independent of the buckles’ function, while in *Carol Barnhart* the distinctive features of the torsos—the accurate anatomical design and the sculpted shirts and collars—showed clearly the influence of functional concerns. Though the torsos bore artistic features, it was evident that the designer incorporated those features to further the usefulness of the torsos as mannequins. Second, the test’s emphasis on the influence of utilitarian concerns in the design process may help, as Denicola notes, to alleviate the de facto discrimination against nonrepresentational art that has regrettably accompanied much of the current analysis. Finally, and perhaps most importantly, we think Denicola’s test will not be too difficult to administer in practice. The work itself will continue to give mute testimony of its origins. In addition, the parties will be required to present evidence relating to the design process and the nature of the work, with the trier of fact making the determination whether the aesthetic design elements are significantly influenced by functional considerations.

Id. at 1145–46 (internal quotation marks omitted).

protection.¹⁹⁰ This analytical process may not be required if the idea-expression dichotomy is not a constitutional restraint on copyright-like protection, this in turn will allow authors to undermine the patent laws by taking advantage of legislation passed under a different constitutionally enumerated power.

3. Contracting Protection When Idea and Expression Merge

The expression of a complex idea may take infinitely distinct shapes, yet the expression of a simple idea can often easily be enumerated and finite. Protecting the few ways to express an idea would essentially create a monopoly in the idea in favor of whoever copyrights every permutation of the idea's expression first.¹⁹¹ For example, protecting the phrase "have a nice day" may preclude another author from using the phrase "have a good day." More clever individuals can simply seek protection of both phrases and monopolize the idea underlying the salutation.

The idea-expression doctrine has given rise to a corollary doctrine called the "merger doctrine."¹⁹² This doctrine ensures that when idea and expression merge neither can be expansively protected under copyright.¹⁹³ At the base of the doctrine is the assumption that copyright protection in such cases would allow monopolization of ideas without having to undergo patent examination,¹⁹⁴ and when the work is not patentable, the doctrine prevents the impermissible protection of ideas.¹⁹⁵

¹⁹⁰ *Mazer v. Stein*, 347 U.S. 201, 215 (1954) (noting the plaintiff's argument that protecting the utilitarian work, in that case the table lamp, would undermine the extensive patent examination process and prevent the monopolization of the utility of the work).

¹⁹¹ See *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971) ("The guiding consideration in drawing the line is the preservation of the balance between competition and protection reflected in the patent and copyright laws. What is basically at stake is the extent of the copyright owner's monopoly—from how large an area of activity did Congress intend to allow the copyright owner to exclude others?").

¹⁹² See *Toro Co. v. R & R Prods. Co.*, 787 F.2d 1208, 1212 (8th Cir. 1986) (describing idea-expression and merger as close cousins).

¹⁹³ See *Kern River Gas Transmission Co. v. Coastal Corp.*, 899 F.2d 1458, 1463 (5th Cir. 1990) ("The doctrine holds that when the expression of an idea is inseparable from the idea itself, the expression and idea merge.").

¹⁹⁴ *Kalpakian*, 446 F.2d at 742 ("When the idea and its expression are thus inseparable, copying the expression will not be barred, since protecting the expression in such

The doctrine has been applied to myriad cases, including notable cases involving jewelry,¹⁹⁶ computer software,¹⁹⁷ sports statistics,¹⁹⁸ maps,¹⁹⁹ and sweepstakes rules.²⁰⁰ The constant among all of these cases is that the protection of expression is tantamount to protecting ideas. For example, in *Southco, Inc. v. Kanebridge Corp.*,²⁰¹ the Third Circuit considered whether a numbering system developed to identify and market screws can be protected under the Copyright Act.²⁰² A series of numbers were used to encode the attributes of a particular screw.²⁰³ For instance,

circumstances would confer a monopoly of the idea upon the copyright owner free of the conditions and limitations imposed by the patent law.”) (internal quotation marks omitted).

¹⁹⁵ See *CCC Info. Servs. v. MacLean Hunter Mkt. Reports*, 44 F.3d 61, 68 (2d Cir. 1994) (“It is also well established that, in order to protect the immunity of ideas from private ownership, when the expression is essential to the statement of the idea, the expression also will be unprotected, so as to insure free public access to the discussion of the idea.”); *Kregos v. Associated Press*, 937 F.2d 700, 705 (2d Cir. 1991) (“The fundamental copyright principle that only the expression of an idea and not the idea itself is protectable has produced a corollary maxim that even expression is not protected in those instances where there is only one or so few ways of expressing an idea that protection of the expression would effectively accord protection to the idea itself.”) (citations omitted); *Educ. Testing Servs. v. Katzman*, 793 F.2d 533, 539 (3d Cir. 1986) (“When the idea and the expression of the idea coincide, then the expression will not be protected in order to prevent creation of a monopoly on the underlying art.”) (internal quotation marks omitted).

¹⁹⁶ See, e.g., *Herbert Rosenthal Jewelry Corp. v. Honora Jewelry Co.*, 509 F.2d 64 (2d Cir. 1974) (jewel encrusted turtle pin); *Kalpajian*, 446 F.2d at 738 (jewel encrusted bee pin); *Behnam Jewelry Corp. v. Aron Basha Corp.*, 45 U.S.P.Q.2d (BNA) 1078, 1093 (S.D.N.Y. 1997) (baby shoe pendant).

¹⁹⁷ See *Apple Computer, Inc., v. Franklin Computer Corp.*, 714 F.2d 1240, 1252 (3d Cir. 1983) (rejecting the application of the doctrine to operating system attributes that prevented the cloning of Apple computers).

¹⁹⁸ See *Kregos*, 937 F.2d at 700.

¹⁹⁹ See, e.g., *Kern River Gas Transmission Co. v. Coastal Corp.*, 899 F.2d 1458, 1463 (5th Cir. 1990) (applying the doctrine to a map indicating the location of a pipeline).

²⁰⁰ See *Morrissey v. Procter & Gamble Co.*, 379 F.2d 675, 679 (1st Cir. 1967) (applying the doctrine to contest rules and finding that the rules were so simple that idea and expression had merged).

²⁰¹ 390 F.3d 276 (3d Cir. 2004).

²⁰² *Id.* at 277–78.

²⁰³ *Id.* (“Southco has referred to one of the numbers at issue in this case, part number 47-10-202-10, to show how the system works. The first two digits (47) show that the part falls within a class of captive screws. Other digits indicate characteristics such as thread size (632), composition of the screw (aluminum), and finish of the knob (knurled).”) (internal quotation marks omitted).

the first two digits could indicate the thread size of the screw.²⁰⁴ The nine digit number in that case had 10^9 different permutations.²⁰⁵ Yet only a small subset of the possible combinations would have made any sense to a contractor choosing a screw.²⁰⁶ The sequence could thus be viewed as a series of numbers or a method of encoding.²⁰⁷ The court chose not to protect the sequence of numbers.²⁰⁸ The result of doing otherwise is readily apparent. Protecting the sequence as a sequence of integers would allow individuals to register all 10^9 permutations, or more feasibly, the subset of valid permutations. If, however, the court decided that the sequence was protected as a method of encoding, it would have protected a method of operation, which copyright law is bound not to protect.²⁰⁹

The facts of the *Southco* case illustrate two principle functions of the merger doctrine. First, the doctrine applies to short works expressing simpler ideas and precludes the monopolization of idea through the protection of expression. Although the court in *Southco* did not rest its decision on merger grounds, the doctrine prevented the numbering system from being monopolized by simply copyrighting every valid permutation of the nine-digit

²⁰⁴ *Id.*

²⁰⁵ This number is the product of the number of possible numbers that can occupy each of the available spaces in the sequence. In this case there are ten different digits that can occupy each of the nine spaces.

²⁰⁶ This is because the method of encoding imposes some constraints on what can constitute a valid sequence of numbers. To be sure, *Southco* probably doesn't manufacture a 1 m screw with 1 mm thread. If *Southco* makes only twenty types of screws, only twenty of the number sequences can be valid.

²⁰⁷ *Southco*, 390 F.3d at 289–90 (“Put differently, the problem in this case is whether the *Southco* part numbers are words, short phrases, names or titles, or whether they are instead a compilation of data, a system of classification, or something else. Indeed, the part numbers seem to fall into the gray area between a short phrase and a more extensive work.”).

²⁰⁸ *Id.* at 287.

²⁰⁹ See 17 U.S.C. § 102(b) (2000). The Eighth Circuit confronted a part numbering system similar to the one in *Southco* and held that the merger doctrine was inapplicable. See *Toro Co. v. R & R Products Co.*, 787 F.2d 1208, 1212 (8th Cir. 1986) (“We do not believe that the idea of a parts numbering system is susceptible of only a very limited number of expressions. Such systems will vary in complexity and composition as the type of information attempted to be encoded into the designation and the method of encoding varies. Granting a particular company a copyright in its own system or systems would not necessarily monopolize the idea of a parts numbering system.”).

sequence. Second, the doctrine ensures that seeking protection of the expression cannot protect methods of encoding for which short expression is often shorthand. Serial numbers, for example, often encode information about the product. The sequence of numbers may embody an unsophisticated encoding scheme—such as a numbering of produced products—or the sequence may embody a more complex system like the screws in *Southco*. Both systems, however, are prevented from receiving expansive protection by virtue of the merger doctrine.

The merger doctrine thus assists in maintaining the amorphous line between idea and expression. Absent the existence of this doctrine, short phrases could be removed from the public lexicon and methods of encoding could be protected without going to the trouble of seeking patent protection. The merger doctrine is thus a necessary corollary of maintaining a distinction between idea and expression.

4. The Doctrine of Fair Use: Policing the Boundaries of Idea and Expression

A complementary doctrine to the idea-expression doctrine is the doctrine of fair use, which congress codified in § 107 of the Copyright Act.²¹⁰ That provision provides that “[n]otwithstanding the provisions of sections 106 . . . the fair use of a copyrighted work . . . for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright.”²¹¹ The fair use defense can be characterized as both an affirmative defense and as an exception to the statutory property right created by federal copyright law.

When considering whether a use is fair, courts consider the four non-exclusive²¹² statutory factors:

²¹⁰ 17 U.S.C. § 107.

²¹¹ *Id.*

²¹² See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 577 (1994) (“The task is not to be simplified with bright-line rules, for the statute, like the doctrine it recognizes, calls for case-by-case analysis.”); *New Era Publ’ns Int’l v. Henry Holt & Co.*, 873 F.2d 576,

- (1) [T]he purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for or value of the copyrighted work.²¹³

The ultimate goal of weighing the Fair Use factors is to determine whether subordinating the copyright holder's interests would serve the purposes of copyright.²¹⁴

Much of the judicial doctrine of Fair Use is justified by the same need to subordinate the copyright to the broader policy directive of "promoting the useful arts and sciences."²¹⁵ The doctrine has also been used as a means of policing the boundaries between idea and expression in works that straddle the line between utilitarian and expressive.²¹⁶ The Federal Circuit noted

588–89 (2d Cir. 1989) ("The Copyright Act itself lists four non-exclusive factors—I emphasize non-exclusive—to consider in this inquiry."); *Stewart v. Abend*, 495 U.S. 207, 236–37 (1990) ("Congress provided examples of fair use . . . and listed four non-exclusive factors that a court must consider in determining whether an unauthorized use is not infringing...."); *Rogers v. Koons*, 751 F. Supp. 474, 479 (S.D.N.Y. 1990) (noting that the factors are non-exclusive).

²¹³ 17 U.S.C. § 107.

²¹⁴ See *Campbell*, 510 U.S. at 578 (citation omitted) ("All [factors] are to be explored, and the results weighed together, in light of the purposes of copyright.").

²¹⁵ See *id.* at 575 n.5 ("The exclusion of facts and ideas from copyright protection serves that goal as well." (citing *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 359 (1991))); *Wainwright Sec. Inc. v. Wall St. Transcript Corp.*, 558 F.2d 91, 94 (2d Cir. 1977) ("The fair use doctrine offers a means of balancing the exclusive rights of a copyright holder with the public's interest in dissemination of information affecting areas of universal concern, such as art, science and industry."); *Berlin v. E.C. Publ'ns, Inc.*, 329 F.2d 541, 543–44 (2d Cir. 1964) ("[C]opyright protection is designed 'To promote the Progress of Science and useful Arts,' and the financial reward guaranteed to the copyright holder is but an incident of this general objective, rather than an end in itself."); see also Note, *Universal City Studios, Inc. v. Sony Corp.: "Fair Use" Looks Different on Videotape*, 66 VA. L. REV. 1005, 1012 (1980) [hereinafter "Note, *Universal City Studios*"] ("Fair use applies where the exclusivity of an author's rights would retard, rather than promote, the progress of art, science, and history.").

²¹⁶ See, e.g., *Assessment Techs. of WI, LLC v. WIREdata, Inc.*, 350 F.3d 640, 644 (7th Cir. 2003) ("AT would lose this copyright case even if the raw data were so entangled

this function of Fair Use in *Atari Games Corp. v. Nintendo of America Inc.*,²¹⁷ in stating that:

The fair use reproductions of a computer program must not exceed what is necessary to understand the unprotected elements of the work. This limited exception is not an invitation to misappropriate protectable expression. Any reproduction of protectable expression must be strictly necessary to ascertain the bounds of protected information within the work.²¹⁸

The *Atari* court noted that fair use played a vital role in balancing the rights of the copyright holder with public interest in building on pre-existing ideas.²¹⁹ The fair use defense thus prevents authors from claiming a property interest that is so expansive that the ultimate objectives of the copyright act are undermined.²²⁰

with Market Drive that they could not be extracted without making a copy of the program.”); *Bowers v. Baystate Techs., Inc.*, 320 F.3d 1317, 1336 (Fed. Cir. 2002) (“Enforcement of a total ban on reverse engineering would conflict with the Copyright Act itself by protecting otherwise unprotectable material.”); *Sony Computer Entm’t, Inc. v. Connectix Corp.*, 203 F.3d 596, 602 (9th Cir. 2000) (“The unprotected ideas and functions of the code therefore are frequently undiscoverable in the absence of investigation and translation that may require copying the copyrighted material. We conclude that, under the facts of this case and our precedent, Connectix’s intermediate copying and use of Sony’s copyrighted BIOS was a fair use for the purpose of gaining access to the unprotected elements of Sony’s software.”); *Sega Enters. v. Accolade, Inc.*, 977 F.2d 1510, 1520 (9th Cir. 1992) (“The need to disassemble object code arises, if at all, only in connection with operations systems, system interface procedures, and other programs that are not visible to the user when operating—and then only when no alternative means of gaining an understanding of those ideas and functional concepts exists. In our view, consideration of the unique nature of computer object code thus is more appropriate as part of the case-by-case, equitable ‘fair use’ analysis authorized by section 107 of the Act.”).

²¹⁷ 975 F.2d 832 (Fed. Cir. 1992).

²¹⁸ *Id.* at 843.

²¹⁹ *See id.* at 842 (“The Copyright Act thus balances ‘the interests of authors . . . in the control and exploitation of their writings . . . on the one hand, and society’s competing interests in the free flow of ideas, [and] information . . . on the other hand.’” (quoting *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 429–30 (1984))) (omissions and alterations in original).

²²⁰ *See id.* (citing *Feist*, 499 U.S. at 349–50).

Moreover, the factors themselves specifically enforce the distinction between idea and expression. The first factor, for example, inquires into the purpose and character of the use largely to determine whether the use is an attempt to ascertain what parts of the work are unprotected ideas rather than a naked attempt to profit from misappropriation.²²¹ This distinction has been labeled as one between commercial and productive use.²²² The difficulty is that profit-motive is not always mutually exclusive with other more benign uses.²²³

Courts applying the first factor have therefore instead focused on the direct interplay between the doctrine and the constitutional mandate to promote the useful arts and sciences by determining

²²¹ See *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 562 (1985) (“The fact that a publication was commercial as opposed to nonprofit is a separate factor that tends to weigh against a finding of fair use. ‘[E]very commercial use of copyrighted material is presumptively an unfair exploitation of the monopoly privilege that belongs to the owner of the copyright.’” (quoting *Sony Corp. of Am.*, 464 U.S. at 451)); *Pac. & S. Co. v. Duncan*, 744 F.2d 1490, 1496 (11th Cir. 1984) (“This commercial nature of the use militates quite strongly against a finding of fair use”); *Nat’l Rifle Ass’n v. Handgun Control Fed’n*, 844 F. Supp. 1178, 1181 (N.D. Ohio 1992) (“What is necessary is a showing by a preponderance of the evidence that some meaningful likelihood of future harm exists. If the intended use is for commercial gain, that likelihood may be presumed. But if it is for a noncommercial purpose, the likelihood must be demonstrated.”); *Ass’n of Am. Med. Colls. v. Mikaelian*, 571 F. Supp. 144, 153 (D. Pa. 1983) (“[A] court should not strain to apply the fair use defense when it is being invoked by a profit-making defendant that has made extensive verbatim use of the plaintiff’s copyrighted materials.”).

²²² See *Universal City Studios v. Sony Corp. of Am.*, 659 F.2d 963, 970 (9th Cir. 1981), *reversed*, *Sony Corp. of Am.*, 464 U.S. 417 (“Despite the nebulous character of the doctrine, previous case law and the general copyright scheme do provide us with considerable guidance. As the first sentence of [§] 107 indicates, fair use has traditionally involved what might be termed the ‘productive use’ of copyrighted material.”). The Ninth Circuit in that case seemed to derive the term from commentary classifying certain types of uses as “productive uses,” in that such uses “incorporate[] the copyrighted material in a developmental process, that is, in creating a second work or carrying on research or education.” Note, *Universal City Studios*, *supra* note 215, at 1013.

²²³ See *Salinger v. Random House, Inc.*, 650 F. Supp. 413, 425 (S.D.N.Y. 1986) (“In fact, publishers of educational textbooks are as profit-motivated as publishers of scandal-mongering tabloid newspapers. And a serious scholar should not be despised and denied the law’s protection because he hopes to earn a living through his scholarship. The protection of the statute should not turn on sackcloth and missionary zeal. It rather directs the court to make an appraisal of social usefulness and of commercial fair play.”).

whether the new work is “transformative.”²²⁴ The Supreme Court has reasoned that transformative uses weigh in favor of fair use because “the goal of copyright . . . is generally furthered by the creation of transformative works.”²²⁵ By determining whether a work is transformative a court in turn determines whether such a fair use furthers the broader policy objectives of allowing the public to build on ideas²²⁶ or facts,²²⁷ precisely the same objective sought through the application of the idea-expression doctrine.

Likewise, when applying the second factor courts have turned to the nature of the work, expanding copyright protection when the work is creative and contracting protection when the work is factual or utilitarian.²²⁸ In sum, the second factor safeguards against the monopolization of facts, utility, and ideas under the guise of copyright protection. Fair Use can therefore be viewed as complimentary to the idea-expression doctrine, safeguarding

²²⁴ See, e.g., *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994) (“The central purpose of this investigation is to see . . . whether the new work merely ‘supersede[s] the objects’ of the original creation . . . or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message; it asks, in other words, whether and to what extent the new work is ‘transformative.’”) (citations omitted).

²²⁵ *Id.*

²²⁶ See *supra* note 22 and accompanying text.

²²⁷ See *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 350 (“Facts, whether alone or as part of a compilation, are not original and therefore may not be copyrighted.”).

²²⁸ See *Diamond v. Am-Law Pub. Corp.*, 745 F.2d 142, 148 (2d Cir. 1984) (citing *MCA, Inc. v. Wilson*, 677 F.2d 180 (2d Cir. 1981) (“The work in question was avowedly informational, and such works may be more freely published under Section 107 than those of a creative nature.”); *Universal City Studios v. Sony Corp. of Am.*, 659 F.2d 963, 972 (9th Cir. 1981) (“If a work is more appropriately characterized as entertainment, it is less likely that a claim of fair use will be accepted.”); *Rosemont Enters., Inc. v. Random House, Inc.*, 366 F.2d 303, 307 (2d Cir. 1966) (“Whether the privilege may justifiably be applied to particular materials turns initially on the nature of the materials, e.g., whether their distribution would serve the public interest in the free dissemination of information and whether their preparation requires some use of prior materials dealing with the same subject matter. Consequently, the privilege has been applied to works in the fields of science, law, medicine, history and biography.”); *Monster Commc’ns v. Turner Broad. Sys.*, 935 F. Supp. 490, 494 (S.D.N.Y. 1996) (quoting *Amsinck v. Columbia Pictures Indus.*, 862 F. Supp. 1044, 1050 (S.D.N.Y. 1994)) (“The second of the factors, the nature of the copyrighted work, focuses on the degree of creativity of the copyrighted work. ‘[T]he more creative a work, the more protection it should be accorded from copying.’”) (alteration in original).

against the rigid application of the copyright laws to the detriment of the public interest.²²⁹

IV. IDEA-EXPRESSION AS A CONSTITUTIONAL DOCTRINE

The distinction between idea and expression is largely a judicial and statutory construct.²³⁰ Yet, the Constitution on its face makes a distinction between “science and useful arts.”²³¹ This distinction can be interpreted as distinguishing between utilitarian works and the expression of knowledge. Utilitarian works are often intertwined with the ideas giving rise to their design,²³² yet

²²⁹ See *Campbell*, 510 U.S. at 577; *Iowa State Univ. Research Found., Inc. v. Am. Broad. Cos.*, 621 F.2d 57, 60 (2d Cir. 1980) (“The doctrine of fair use, originally created and articulated in case law, permits courts to avoid rigid application of the copyright statute when, on occasion, it would stifle the very creativity which that law is designed to foster.”).

²³⁰ See 17 U.S.C. § 102(b) (2000); accord *Baker v. Seldon*, 101 U.S. 99, 107 (1879) (holding that the accounting process underlying accounting forms was not within the subject matter of copyright).

²³¹ U.S. CONST. art. I, § 8, cl. 8.

²³² See 17 U.S.C. § 101 (“A ‘useful article’ is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a ‘useful article.’”); *Fabrica Inc. v. El Dorado Corp.*, 697 F.2d 890, 893 (9th Cir. 1983) (“[I]f an article has *any* intrinsic utilitarian function, it can be denied copyright protection except to the extent that its artistic features can be identified separately and are capable of existing independently as a work of art.”); *Custom Chrome Inc. v. Ringer*, 35 U.S.P.Q.2D (BNA) 1714, 1716 (D.D.C. 1995) (noting that copyright protects utilitarian works to the extent that they are conceptually separable from protectable expression). The difficulty in protecting non-literal elements of computer programs reflects the intertwining of idea and expression in utilitarian works. See *Johnson Controls, Inc. v. Phoenix Control Sys., Inc.*, 886 F.2d 1173, 1175 (9th Cir. 1989) (noting that the non-literal elements of code can be protected to the extent that the work embodies expression rather than ideas); *Whelan Assocs., Inc. v. Jaslow Dental Lab., Inc.*, 797 F.2d 1222, 1248 (3d Cir. 1986) (holding that the structure, sequence, and organization of code can be protected under copyright). “Courts, however, have struggled to define what other elements of a computer program, literal and/or non-literal, to which a computer program’s copyright protection extends.” *Digital Commc’ns Assocs., Inc. v. Softklone Distrib. Corp.*, 659 F. Supp. 449, 455 (D. Ga. 1987); see also *Computer Assocs. Int’l v. Altai, Inc.*, 982 F.2d 693, 708 (2d Cir. 1992) (“While, hypothetically, there might be a myriad of ways in which a programmer may effectuate certain functions within a program,—i.e., express the idea embodied in a given subroutine—efficiency concerns may so narrow the practical range of choice as to make only one or two forms of expression workable options.”).

the sciences, or the expression of knowledge, while embodying ideas, can be reformulated and expressed in different terms.²³³

Commentators, however, have concluded that the phrase “must be read as largely in the nature of a preamble, indicating the purpose of the power but not in limitation of its exercise.”²³⁴ Although the phrase can be interpreted as part of an aspiration preamble,²³⁵ it is clear that the distinction could not have been meaningless, or else a simple and broad constitutional mandate to

²³³ See *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930) (L. Hand, J.) (“[T]he right cannot be limited literally to the text, else a plagiarist would escape by immaterial variations”). Later in this decision Judge Hand further delves into the notion that ideas can be restated in different ways with the following example:

[W]e do not doubt that two plays may correspond in plot closely enough for infringement. How far that correspondence must go is another matter. Nor need we hold that the same may not be true as to the characters, quite independently of the “plot” proper, though, as far as we know, such a case has never arisen.

Id. Judge Hand goes on to state the proposition that the same plot can be restated in different ways by using Shakespeare’s *Twelfth Night* as an example. Judge Hand opined that

[i]f *Twelfth Night* were copyrighted, it is quite possible that a second comer might so closely imitate Sir Toby Belch or Malvolio as to infringe, but it would not be enough that for one of his characters he cast a riotous knight who kept wassail to the discomfort of the household, or a vain and foppish steward who became amorous of his mistress.

Id.

²³⁴ 1 NIMMER, *supra* note 164, at § 103 [A] (citations omitted).

²³⁵ The provision can be interpreted as conflating the vesting of private with a broader public benefit. James Madison commented on the clause noting that “[t]he utility of this power will scarcely be questioned. The copyright of authors has been solemnly adjudged, in Great Britain, to be a right of common law *The public good fully coincides in both cases, with the claims of individuals.* The States cannot separately make effectual provision for either of the cases, and most of them have anticipated the decision of this point, by laws passed at the instance of Congress.” THE FEDERALIST NO. 43 (James Madison) (emphasis added). The national character of the rights afforded under the copyright clause reinforce the premise that protecting intellectual property rights uniformly is in direct accord with the interests of the several states. See *Goldstein v. California*, 412 U.S. 546, 558 (1973) (“The interests of a State which grants copyright protection may, however, be adversely affected by other States that do not; individuals who wish to purchase a copy of a work protected in their own State will be able to buy unauthorized copies in other States where no protection exists.”).

protect works would have done just as well.²³⁶ The distinction can serve as the basis for a constitutional requirement that the task of protecting ideas and expression are distinct undertakings.

This section will argue that the distinction between idea and expression is a constitutional requirement rather than a judicial division of labor between the copyright and patent laws. The constitutional nature of the doctrine is particularly relevant when federal law affords copyright-like protection under an alternative constitutional grant of power such as the Commerce Clause or Treaty Power.

This section will interpret Article I, Section 8 Clause 8 of the Constitution to embody the dichotomy between idea and expression. This section will further argue that if the doctrine is a constitutional requirement such requirement must sometimes constrain an exercise of congressional power under an alternative constitutional grant or else authors could protect their works without the constraints of the doctrine and potentially monopolize both the expression of ideas and the underlying ideas themselves.

As the analytical corollaries of the idea-expression doctrine indicate, the idea-expression doctrine has five indispensable purposes:

1. the doctrine ensures that the protection of ideas remain within the province of patent law and are subject to rigorous patent examination;
2. the doctrine ensures that the public domain can continue to use necessary elements of expression, such as numbers, short pairings of words, or combinations of letters;

²³⁶ The qualifying phrase explains why certain works should be protected. Without a direct indication that the protection was to serve the public interest, many of the balancing features of copyright, such as the idea-expression doctrine, the doctrine of merger, and the defense of fair use could not have evolved because protecting the underlying ideas and facts of a work would not be a priority. *See* *Wainwright Securities Inc. v. Wall Street Transcript Corp.*, 558 F.2d 91 (2d Cir. 1977) (“The doctrine offers a means of balancing the exclusive right of a copyright holder with the public’s interest in dissemination of information affecting areas of universal concern, such as art, science, history, or industry.”); *see also infra* note 215 and accompanying text.

3. the doctrine carefully facilitates non-literal protection of computer software without conferring patent-like protection on computer programs;
4. the doctrine minimizes the impact of copyright protection on First Amendment rights; and
5. the doctrine ensures that individuals can determine the metes and bounds of naturally amorphous intellectual property rights.

The functional purposes of the idea-expression doctrine support the constitutional mandate at the heart of the Copyright Clause. Promoting the progress of the useful arts and sciences means, among other things, ensuring that a property right is well defined and discretely protected. It also means that any property rights given to products of the mind are carefully balanced with other fundamental constitutional rights. To be sure, an intellectual property right that creates a property right at the expense of the First Amendment right would defeat the very principle underlying the Constitution's authorization to protect intellectual property.

If one considers the protection of intellectual property as a bargain between the government and the author,²³⁷ the property right must come at the expense of the public being able to build on the ideas of the work and to eventually build on the expressive elements.²³⁸ The Copyright Clause demands a practical balancing of interests.²³⁹ This pragmatic balancing requires the consideration of functional problems. Many of the functional problems have been solved by copyright law's rich doctrine. Protecting expressive works absent the tradition of doctrines that have developed over the years may undermine the delicate balance of interests achieved by the Copyright Act.

Yet for such doctrines to apply they must be elevated to constitutional stature, or else they will not impose any constraints

²³⁷ See *Mazer v. Stein*, 347 U.S. 201, 219 (1954) ("The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in 'Science and useful Arts.'").

²³⁸ See *id.*

²³⁹ See *Wainwright*, 558 F.2d at 94.

on other exercises of constitutional power. This section will argue that the idea-expression doctrine is a constitutional doctrine. The idea-expression doctrine has solved many of the pragmatic problems that arise when protecting expression to a different degree than ideas. A third category of protection that does not make the distinction between idea and expression could threaten the divide between patent and copyright law.

Many of the arguments for a constitutionally required idea-expression doctrine are pragmatic. The doctrine would facilitate the asymmetric examination and registration requirements of existing patent and copyright laws.²⁴⁰ The doctrine would better define the property right being given to an author, and alleviate vagueness and lack of notice issues when criminal sanctions are imposed for misappropriating of works subject to amorphous delineation. Moreover, while existing copyright and patent laws may successfully promote the useful arts and sciences, a third class of protections that are accompanied by criminal sanctions may chill the creation of derivative works, undermining the Copyright Clause's policy of promoting the useful arts and sciences.

Functional reasons alone do not warrant interpreting the Copyright Clause to embody an idea-expression dichotomy. The Intellectual Property Clause of the Constitution can be interpreted to mandate a difference in protection between idea and expression. This section will also propose a textual argument to support such a distinction and in turn support a constitutional idea-expression doctrine.

A. Maintaining the Division Between Patent and Copyright Law

Protecting intellectual property rights similar to those governed by the copyright and patent laws would undermine the divisions between copyright and patent. Copyright law does not require that an invention be novel, instead it requires only originality.²⁴¹ That

²⁴⁰ See *infra* note 245–247 and accompanying text.

²⁴¹ See *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991) (“Originality does not signify novelty; a work may be original even though it closely resembles other works so long as the similarity is fortuitous, not the result of copying.”); *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 910 (2d Cir. 1980) (“Although

is, authors that independently produce the same work without access to each other's works would not be liable for infringement.²⁴² Patents, on the other hand, condition the property right on the invention being new and non-obvious.²⁴³ Only the first of two independent inventors would receive the property right, regardless of access considerations.²⁴⁴ One inventor would be an innovator in the eyes of the law and the other an infringer.

These differences have given rise to very different examination processes and protections. Patents are subject to rigorous examination; copyrights are not.²⁴⁵ To enforce this distinction, either patent law cannot protect the same subject matter as copyright law,²⁴⁶ or the works must provide different protections that are in proportion to the difficulty of obtaining the property

novelty, uniqueness and ingenuity are not required, independent creation is." (citing *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 490 (2d. Cir. 1976))).

²⁴² See *Rottlund Co. v. Pinnacle Corp.*, 452 F.3d 726, 732 (8th Cir. 2006) ("Independent creation, on the other hand, can rebut a presumption of copying after the copyright plaintiff establishes access and substantial similarity." (citing *Taylor Corp. v. Four Seasons Greetings, LLC*, 403 F.3d 958 (8th Cir. 2005))); *Ty, Inc. v. GMA Accessories, Inc.*, 132 F.3d 1167, 1169 (7th Cir. 1997) ("[I]f independent creation results in an identical work, the creator of that work is free to sell it." (citing *Selle v. Gibb*, 741 F.2d 896, 901 (7th Cir. 1984))).

²⁴³ See 35 U.S.C. §§ 101–03 (2000) amended by 35 U.S.C. § 102(e) (Supp. II 2002).

²⁴⁴ See *Deering v. Winona Harvester Works*, 155 U.S. 286, 302 (1894) ("If Steward were in fact the first to invent the pivotal extension to a butt adjuster, he is entitled to a patent therefor."); *Eli Lilly & Co. v. Aradigm Corp.*, 376 F.3d 1352, 1365 (Fed. Cir. 2004) (citing *Slip Track Sys., Inc. v. Metal-Lite, Inc.*, 304 F.3d 1256, 1262 (Fed. Cir. 2002)) ("[A] party that does not have the earliest effective filing date needs only to demonstrate by a preponderance of the evidence that it was the first to invent if the two patents or applications at issue were co-pending before the PTO.>").

²⁴⁵ See *Mazer v. Stein*, 347 U.S. 201, 215 (1954) ("[D]esign patents require the critical examination given patents to protect the public against monopoly."); *Stein v. Expert Lamp Co.*, 188 F.2d 611, 612–13 (7th Cir. 1951) ("Congress has provided two separate and distinct classes or fields of protection, the copyright and the patent. . . . The Copyright Office makes no examination or search as to the originality or novelty of the claimed 'work of art.' Applications for design patents are . . . subject to an examination in which the examiner searches through all available publications, prior patents and all prior art available, to determine if the design possesses the qualities requisite to granting a design patent.").

²⁴⁶ The idea-expression doctrine ensures that overlaps between patentable and copyrightable subject matter are resolved. The doctrine serves a sorting purpose, preventing idea-intertwined works from gaining protection without being subject to rigorous patent examination.

right.²⁴⁷ Regardless of how such a division occurs, such a division is necessary to facilitate divergent doctrines.

One can easily conceive of a statute conferring protection on works that could receive either patent or copyright protection but that either vests more rights than copyright or less rights than patent. Or the statute could require more lax examination than patents yet protect the idea underlying the work just the same. Such a statute would provide an incentive not to use existing patent laws as a means of protecting works when more lax examination will yield equivalent protection of the underlying ideas of the work.²⁴⁸ A similar incentive might exist not to seek copyright protection because a copyright-like work could receive a patent-like monopoly under a different statute with more lax examination requirements than patents.²⁴⁹

Another possible complication may arise if one can seek overlapping protections of the work.²⁵⁰ A copyright could receive protection under the copyright laws and receive even more protections under a third criminal statute. The addition of further sanctions for misappropriation of a copyright would bolster the strength of the copyright and tip the delicate balance between

²⁴⁷ Patents are protected for twenty years and bestow a complete monopoly in the underlying ideas of an invention. *See* 35 U.S.C. § 154(a)(2) (“[S]uch grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed . . .”). Copyrights protect the work for a longer duration, typically the author’s life plus seventy years, *see* 17 U.S.C. § 302(a), but the property right is substantially weaker. *Cf.* *Data Gen. Corp. v. Grumman Sys. Support Corp.*, 36 F.3d 1147, 1170 (1st Cir. 1994) (noting that copyrights create less market power than patents).

²⁴⁸ *Cf.* *Lotus Dev. Corp. v. Borland Int’l., Inc.*, 49 F.3d 807, 819 (1st Cir. 1995) (Boudin, J., concurring) (“It is no accident that patent protection has preconditions that copyright protection does not—notably, the requirements of novelty and non-obviousness—and that patents are granted for a shorter period than copyrights.”).

²⁴⁹ The anti-bootlegging statute in *Moghadam* is an excellent example. The statute imposed a bar on misappropriating live performances without the requirements of fixation. *See United States v. Moghadam*, 175 F.3d 1269, 1273–75 (11th Cir. 1999).

²⁵⁰ Although overlaps between patent and copyright protection already occur, the idea-expression doctrine has mediated between doctrines to retain the delicate balance implicit in each statutory scheme. A third form of protection that is unconstrained by such a mediating mechanism may destroy the balance struck between protection and innovation in both patent and copyright statutory schemes.

protection and public benefit.²⁵¹ A copyright scheme that receives reinforcements from alternative commerce statutes would make it difficult to determine, a priori, where the line between private monopoly and public domain falls.²⁵²

B. Indeterminate Delineation of Property, Transactional Certainty, and Due Process Rights

The idea-expression doctrine facilitates a more concise definition of the property rights granted by the Copyright Act. Without the doctrine the property right being conferred by an alternate statute may be difficult to delineate and in turn protect. One of the most fundamental protections afforded property are rights under the Due Process Clauses of the Fifth and Fourteenth Amendments.²⁵³ Procedural Due Process protects the deprivation of property from arbitrary government conduct by imposing procedural constraints.²⁵⁴ It becomes difficult to determine when such procedural requirements must be afforded an owner of intellectual property.²⁵⁵

²⁵¹ See *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971) (“The guiding consideration in drawing the line is the preservation of the balance between competition and protection reflected in the patent and copyright laws. What is basically at stake is the extent of the copyright owner’s monopoly—from how large an area of activity did Congress intend to allow the copyright owner to exclude others?”).

²⁵² The Fair Use Doctrine has been criticized for possessing the same deficiency. The indeterminate nature of the four factors makes it difficult to predict where the line between liability and fair use lies. See James Gibson, *Risk Aversion And Rights Accretion In Intellectual Property Law*, 116 YALE L.J. 882, 889 (2007) (“The case law has been particularly unhelpful. The Supreme Court’s first incursions into fair use immediately struck a chord that still resonates in the jurisprudence: the doctrine’s equitable, fact-specific, and thus indeterminate nature. Those who were hoping for hard and fast rules were out of luck, and have remained so since. From the ex post perspective of the defendant already embroiled in expensive litigation, an adaptable, equitable defense is useful. But for the prospective defendant wondering whether a given act will prove to be infringing, fair use is too ambiguous to provide much ex ante guidance.”).

²⁵³ U.S. CONST. amend. XIV; U.S. CONST. amend. V.

²⁵⁴ See *Carey v. Phipus*, 435 U.S. 247, 259 (1978) (“Procedural due process rules are meant to protect persons not from the deprivation, but from the mistaken or unjustified deprivation of life, liberty, or property.”).

²⁵⁵ Cf. *Tenoco Oil Co. v. Dep’t of Consumer Affairs*, 876 F.2d 1013, 1021 (1st Cir. 1989) (noting that the due process rights depend on how property is defined).

It also becomes difficult to determine what Due Process rights a potential infringer that independently creates the same work will be afforded. The Supreme Court has noted that “[i]t is established that a law fails to meet the requirements of the Due Process Clause if it is so vague and standardless that it leaves the public uncertain as to the conduct it prohibits.”²⁵⁶ Without idea-expression it becomes difficult for the law to determine whether someone is a pirate or a resourceful innovator, whether the law encourages his behavior or can deprive him of the fruits of his intellectual labor.

This problem of defining the boundaries of one’s rights will always be a side effect of protecting intangible rights. Courts must decide the scope of the intangible rights the Copyright Act affords individuals. Courts face the same issue when protecting intangible substantive Due Process rights, or in preventing statutes grounded in animus under the Equal Protection Clause of the Constitution. It is clear that the scope of intangible rights is a judicially manageable issue.

However, the idea-expression doctrine mitigates much of the indeterminacy inherent in the process of delineating such rights by ensuring that certain elements of a work—its ideas—are certainly not included in the bundle of rights afforded under federal copyright law. The goal of doctrinal stability is to facilitate certain forms of private conduct, not necessarily to ensure that post hoc judicial determinations can be made. Certainty in standards of conduct provides clear notice to individuals, thus increasing the probability that private parties will transact. With intellectual property rights, such as copyrights, which depend on the use of ideas and prior expression, transactional certainty will ensure that private parties will not have to factor the risk of erroneous deprivation into their transactions.

C. Amorphously Defined Property Rights and Criminal Liability

The anti-bootlegging statute in *United States v. Moghadam* imposed criminal sanctions of five to ten years in prison for an unauthorized fixation of a live performance.²⁵⁷ Yet unlike a statute

²⁵⁶ *Giaccio v. Pa.*, 382 U.S. 399, 402 (1966).

²⁵⁷ *See* 18 U.S.C. § 2319A (2006).

punishing the violation of another's rights to tangible property, the rights being protected by such a criminal statute are not as well defined. Questions of what constitutes a live performance or an unauthorized fixation loom beneath the seemingly clear text. Intellectual property rights are defined by the law that gives rise to their creation. Much of intellectual property body of doctrine can be indeterminate absent judicial review. This uncertainty in turn often chills the use of public domain ideas that might find protection in the copyright laws.

Those seeking to use copyrighted works are often faced with the prospect of facing civil liabilities should their estimations of the scope of a work's intellectual property rights prove incorrect.²⁵⁸ Criminal sanctions, however, would preclude infringers from even attempting to assert a fair use defense. Thus, not only would criminal sanctions eviscerate the fair use defense, but the overall chilling effect on the production of new works is much greater.

Being faced with the improbable prospect of facing civil damages for copyright infringement may make an undertaking nevertheless worth it. One would simply multiply the probability of being found liable for infringement by the amount of damages one expects. Criminal sanctions, however, may never be worth the risk. Individuals seeking to create works that may result in criminal sanctions may be deterred from the undertaking altogether.²⁵⁹ If such a statute is free of the constraints of the idea-expression doctrine, individuals seeking to use what should be public domain will not have the additional comfort of knowing that certain portions of the work can never be part of the property right and will certainly be chilled from using any part of the work.

At the core of the Intellectual Property Clause's charge is to promote the useful arts and sciences.²⁶⁰ An integral part of promoting such works through property incentives is allowing the

²⁵⁸ Gibson, *supra* note 252, at 885.

²⁵⁹ This reasoning has been employed in the context of criminal laws that may chill First Amendment expression. *See* U.S. v. X-Citement Video, Inc., 513 U.S. 64, 77–78 (1994) (applying scienter requirement in a criminal statute to apply to both the sexually explicit nature of a work and the age of the performers in sexually explicit film in order to avoid a chilling effect on First Amendment expression).

²⁶⁰ *See* U.S. CONST. art. I, § 8, cl. 8.

public an intellectual base to build on. Indeed, there are few ideas that owe nothing to another's work. Ideas fuel ideas. Absent the flexibility to build on the works of others one cannot expect a property rights incentive scheme such as the one contemplated by the Constitution to work. If the property rights created under alternate exercises of power are not bound by the doctrines developed to define and delineate the scope of the property right being awarded, then such laws are free to chill the creation of the works that the copyright and patent laws intend to facilitate and encourage.

D. A Textual Derivation of Idea-Expression

The idea-expression doctrine is implicit in the language of the Constitution's Intellectual Property Clause. That clause states the following "To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."²⁶¹ The phrase "promote the progress of science and the useful arts" has been interpreted as a mere preamble, stating the broad purpose of the clause. Professor Nimmer notes that "this introductory phrase is in the main explanatory of the purpose of copyright, without in itself constituting a rigid standard against which any copyright act must be measured. Its effect at most is to suggest certain minimal elements to be contained in copyright legislation."²⁶²

The predominant interpretation of this phrase has been as constitutional garnish of only aesthetic relevance. The phrase is, however, far more than an explanation of the broader purposes of the provision. It makes a distinction between types of works. By defining the clause's purpose in terms of what it protects, the distinction between the useful arts and sciences implies that the useful arts are not the sciences, and that the constitutional mandate is to protect both. These two types of works are not equivalent or else an encapsulating phrase could have been used. Beneath this distinction is the idea-expression doctrine. Copyright is to protect one form of work, while patents are to protect the other.

²⁶¹ *Id.*

²⁶² NIMMER, *supra* note 164, at § 1.03.

A possible purpose behind this distinction is that the useful arts, unlike the sciences may require content specific determinations by the government. The determination of what is or is not useful is a subject matter specific one. Separating the works would allow one form of work to be regulated without regard to subject matter, while another form of work could be regulated after a thorough subject matter inquiry.

This interpretation is consistent with avoiding the evils of the early interpretations of the clause, which contemplated content controls on what could be protected under copyright law.²⁶³ Subject matter determinations led to the invalidation of copyrights in obscene materials because they failed to promote the useful arts and sciences.²⁶⁴ The inherent chilling effect of government subject matter regulation led to a firm division between the subject matter specific protections of patent law and the subject matter independent protections of copyright law.²⁶⁵ This division could have been what was intended in the distinction between the useful arts and sciences in the Constitution. The distinction may have been made to avoid subject matter regulation of literary and artistic works, and in turn relieve the inherent tension between protecting copyrightable works and rights afforded under the First Amendment.

²⁶³ See *Mitchell Bros. Film Group v. Cinema Adult Theater*, 604 F.2d 852, 860 (5th Cir. 1979) (“Congress could reasonably conclude that the best way to promote creativity is not to impose any governmental restrictions on the subject matter of copyrightable works. By making this choice Congress removes the chilling effect of governmental judgments on potential authors and avoids the strong possibility that governmental officials (including judges) will err in separating the useful from the non-useful.”).

²⁶⁴ See *Martinetti v. Maguire*, 16 F. Cas. 920 (C.C.D. Cal. 1867) (No. 9173) (“Hence, it expressly appears that congress is not empowered by the constitution to pass laws for the protection or benefit of authors and inventors, except as a means of promoting the progress of ‘science and useful arts.’ For this reason, an invention expressly designed to facilitate the commission of crime, as murder, burglary, forgery or counterfeiting, however novel or ingenious, could not be patented. So with a dramatic composition which is grossly indecent, and calculated to corrupt the morals of the people. The exhibition of such a drama neither ‘promotes the progress of science or useful arts,’ but the contrary.”).

²⁶⁵ See *Mitchell Bros.*, 604 F.2d at 860.

Applying the well-known canon of construction, *expressio unius est exclusio alterius*,²⁶⁶ would mean that the enumeration of two types of works—useful arts and sciences—would imply the exclusion of other types of works. Thus Congress can only protect ideas and expression and it can only do so under the constraints of the provision’s requirements. The division between types of works is itself a constraint on congressional power. Under such an interpretation, a distinction between the two types of works is mandatory rather than permissive.

This distinction creates a wall of separation between the types of works. If one protects ideas after thorough review, the other must not if the review process is weaker. If one requires subject matter constraints on the “useful arts” phrase, and the lack of such constraints on the “sciences” phrase, the provision can be interpreted as requiring that one form of work be regulated with respect to permissible subject matter and the other be regulated independent of subject matter. To maintain a division between works that receive protection after thorough review of their subject matter and protections that attach to works without subject matter review requires that the weaker protection remain separate and independent from the boundaries of the stronger. To be sure, a copyright that protects ideas would allow an author to circumvent the thorough patent review process. The intrusion, however, would harm both intellectual property rights. Although the copyright holder would receive patent like protection without review of the work’s subject matters in most cases, a court may sometimes review the subject matter that a copyright is predicated on for novelty and non-obviousness, which is a small step away from censorship. Judicial review of the subject matter of literary works, for example, would retard rather than promote the progress of the arts. One can conceive of a situation in which it would be better to forgo the property right all together and avoid judicial review of the novelty of one’s literary work.

Assuming a dichotomy of works such that some works can be regulated based on subject matter and some works cannot, such an

²⁶⁶ The canon literally means that “the expression of one thing implies the exclusion of another.” See *Bush v. Holmes*, 919 So.2d 392, 407 (Fla. 2006).

interpretation would mean that regulating the protection of ideas would have to be done with greater care than when regulating expression. This is because an idea is the foundation of expression. Regulating the subject matter of ideas that can be protected will allow the government to ensure that monopolies will not be given for ideas that are necessary for autonomy and expression. The government must be free to limit the protection of ideas to those in which the long-term benefit to society of conferring a monopoly is worth the short-term restraints on their proliferation. Regulating the subject matter of patents ensures that ideas can be freely disseminated as expression under copyright. The distinction facilitates the protection of both types of works.

The distinction between the useful arts and sciences is thus more than a broad statement of the purpose of the Intellectual Property Clause. It is instead a textual anchor for what has judicially developed to become the modern idea-expression doctrine. The doctrine is an axiom of copyright law and it can be derived directly from the text of the Intellectual Property Clause.

V. A CONSTITUTIONAL DOCTRINE OF IDEA-EXPRESSION, ALTERNATE CONGRESSIONAL POWERS, AND THE CANON OF HORIZONTAL SUBORDINATION

If the Intellectual Property Clause of the Constitution mandates an idea-expression dichotomy, then the fundamental question in *Martignon* and *Moghadam* must be answered. Does the Copyright Clause constrain the scope of the Commerce Clause? The monopoly for ideas must be conferred cautiously,²⁶⁷ and the subject matter of the monopoly must be carefully regulated in order to facilitate the broad pool of ideas required to create expressive works.²⁶⁸ If such a fundamental doctrine can be short-

²⁶⁷ See *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 152 (1989) (noting that the protection of intellectual property rights requires striking a delicate balance between free exploitation and providing incentives to create); *Sony Corp. of Am. v. Universal City Studios, Inc.* 464 U.S. 417, 429 (1984) (noting a similar balance).

²⁶⁸ See *Fogerty v. Fantasy, Inc.*, 510 U.S. 517, 527 (1994) (“Because copyright law ultimately serves the purpose of enriching the general public through access to creative

circuited and circumvented through an exercise of alternate constitutional grants of power, the doctrine will lose force in the conventional copyright and patent context.²⁶⁹

This section will consider the horizontal constraints created by a constitutional idea-expression doctrine.²⁷⁰ In particular, this section will consider the extent to which the constitutional idea-expression doctrine constrains or qualifies the commerce power.

This section will propose a test to resolve the tension between the narrow Intellectual Property Clause and the broad Commerce Power. For the sake of brevity, I shall refer to it as the “Horizontal Subordination” test. Rather than a rigid rule requiring the narrower clause to qualify the more general one, or a rule that undermines narrower provisions by allowing what the broadest constitutional provision allows, the Canon of Horizontal Subordination ensures that the analysis is more flexible and will ensure that Congress retains its power to legislate even amidst a clash of constitutional grants of power.

A. *The Nature of the Problem: Three Possibilities*

Starting from the assumption that Article I, Section 8 implements a system of limited federal powers—enumerating powers that the federal government could wield, and by implication, denying powers not therein²⁷¹—this initial assumption

works, it is peculiarly important that the boundaries of copyright law be demarcated as clearly as possible.”); *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349–50 (“To this end, copyright assures authors the right to their original expression, but encourages others to build freely upon the ideas and information conveyed by a work.” (citing *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 556–57 (1985))).

²⁶⁹ Why abide by the rules governing traditional patents and copyrights when one can seek a property right under an alternative body of law with no such constraints? There may be some reasons to stick with patents or seek a copyright. For example, a patent may provide more protection for the underlying ideas than an alternative statute and a copyright may be less costly to obtain. However, when the difference in protection and cost between conventional intellectual property protections and an alternate body of law become negligible, the incentive to circumvent the idea-expression doctrine becomes far greater.

²⁷⁰ As used herein, “horizontal” means any constraints resulting from other Article I provisions.

²⁷¹ See *Gonzales v. Oregon*, 546 U.S. 243, 301 (2006) (Thomas, J., dissenting) (condoning the limited federal power assumption); *Gonzales v. Raich*, 545 U.S. 1, 57–58

means that each clause is an island. It can support only an exercise of power within its scope. If the Intellectual Property Clause allows the protection of works for limited times, then the implication is that it cannot protect works for an indefinite period of time.²⁷² The Ninth and Tenth Amendments require that whatever is not enumerated is reserved by either the states or the people of the United States.²⁷³ Although the Tenth Amendment, has proven an inert qualification of the Commerce Power,²⁷⁴ its existence implies a general structure of circumscribed grants of power. Absent the assumption that nothing other than what is granted in the Constitution belongs to the federal government, the Tenth Amendment would be far too dynamic a qualification of federal power to justify its very existence.²⁷⁵ The reservation of

(2005) (Thomas, J., dissenting) (“If Congress can regulate this under the Commerce Clause, then it can regulate virtually anything-and the Federal Government is no longer one of limited and enumerated powers.”); *New York v. United States*, 505 U.S. 144, 155, (1992) (“[T]he Constitution created a Federal Government of limited powers.” (quoting *Gregory v. Ashcroft*, 501 U.S. 452, 457 (1991))); *Marbury v. Madison*, 5 U.S. (1 Cranch) 137, 176 (1803) (“The powers of the legislature are defined and limited; and that those limits may not be mistaken, or forgotten, the constitution is written.”).

²⁷² Although it has been argued that the current term of copyright protection violates the Limited Times provision of the Constitution, the Supreme Court has disagreed. *See Eldred v. Ashcroft*, 537 U.S. 186, 204 (2003). The Supreme Court has been quite deferential when it comes to defining the scope of the intellectual property protections under the Constitutional provision. *See Sony Corp. of Am.*, 464 U.S. at 429 (“[I]t is Congress that has been assigned the task of defining the scope of the limited monopoly that should be granted to authors . . . in order to give the public appropriate access to their work product.”). It is hard to conceive of any term, as long as it is conceptually finite, that would violate the provision.

²⁷³ *See* U.S. CONST. amend. IX–X.

²⁷⁴ *See Garcia v. San Antonio Metro. Transit Auth.*, 469 U.S. 528, 546–47 (1985) (holding that the Tenth Amendment should not be interpreted as barring the federal government’s exercise of the Commerce Power when it impinges on functions traditionally relegated to the states). The *Garcia* Court overruled *National League of Cities v. Usery*, *see id.* at 47, which held exactly the opposite. *See* 426 U.S. 833, 852 (1976) (“This exercise of congressional authority does not comport with the federal system of government embodied in the Constitution. We hold that insofar as the challenged amendments operate to directly displace the States’ freedom to structure integral operations in areas of traditional governmental functions, they are not within the authority granted Congress by Art. I, § 8, cl. 3.”).

²⁷⁵ The Tenth Amendment can be viewed as no different than a mandatory canon of interpretation. That is, the power expressly given to the states are not an exhaustive list. In a more formal sense, the provision applies the *exclusio alterius* canon to federal powers and not to state powers. *See* Steven G. Calabresi & Saikrishna B. Prakash, *The*

powers to the states implies a fixed subset of government powers that are not at any given time granted to the federal government. If the federal government can only exercise powers it is expressly given then, there are other powers that the federal government does not have. It follows from the Amendments that what was not given to the federal government can be retained by the states or the people.

The fundamental question is whether this assumption is justified in all cases. There are three possible scenarios to consider. First, when a more specific grant of constitutional power is being used to justify the exercise of congressional power, and such a grant of power would be forbidden under a more general provision, the need for subordination should be at its minimum. The intermediate case is when two provisions of equal scope both reach the same exercise of congressional power. In such a case, the assumption should be that the provisions should be alternate. If one grant of power fails the other should be able to nevertheless support congressional action. Finally when a narrower constitutional provision addresses a particular exercise of congressional power, a broader power should only apply if doing so would not eviscerate the narrower provision.

These three categories are not discrete. It is difficult to compare the scope of some constitutional provisions, but in some cases a provision might be subject matter specific while another is a general grant of power. This indicates a difference in scope. For example, § 5 of the Fourteenth Amendment would be considered a general grant of congressional power because of its broad terms and interpreted scope, whereas the Intellectual Property Clause is far more circumscribed, addressing only the protection of intellectual property rights. The very nature of the grants of power differ from one another.

The Commerce Clause, like the § 5 power, is a general grant of power. Both provisions however are considered broad because

President's Power to Execute the Laws, 104 Yale L.J. 541, 561–62 (1994) (“The message of the Tenth Amendment is that *expressio unius est exclusio alterius* applies to lists of governmental powers. All powers not delegated to the federal government by the Constitution are reserved to the states or to the people. The amended text expressly precludes the existence of unenumerated, or inherent, powers of government.”).

they have been interpreted so expansively. The scope of such power, which appears on its face to be subject matter specific, depends on the interpretation it is given. The Commerce Power of one hundred years ago is not the commerce power today. This is precisely the problem with applying the *Trademark Cases* today. Since the Commerce Power would not support the exercise of congressional power in that case the court had no occasion to decide whether the provision would qualify a narrower constitutional provision. Similarly, comparing § 5's scope after the *Slaughterhouse Cases*²⁷⁶ with the Commerce Clause of today would reveal a stark contrast between the scope of the two provisions.

Thus two important factors determine, which of the three scenarios are at issue. First, the express terms of the clause. Is it on its face very subject matter specific, if so, how specific? Second, the interpretive scope of the provisions must be compared. Determining which category a specific case is in determines whether the assumption that each provision qualifies the other applied with full force.

The only time that balancing is necessary is when a broader constitutional provision is being used to address an issue within the scope of a narrower Constitutional provision. The assumption that each Article I provision qualifies the other, creating discrete islands of constitutional power is at its zenith. It is readily apparent that the Commerce Clause, reaching everything from trains to home-grown wheat, is far broader in its reach than the Intellectual Property clause. Falling in the third category, the exercise of congressional power under the commerce clause must be balanced against the purpose of the narrower Intellectual Property Clause.

B. Fashioning a Test to Balance the Commerce and Intellectual Property Clauses

The Commerce Clause is an Article I power just as the Intellectual Property Clause is. The grant of Article I powers are presented in a serial form, enumerating congressional powers one

²⁷⁶ 83 U.S. 36 (1872).

after the other.²⁷⁷ This would naturally imply that Article I powers are implicitly related and can modify or qualify one another. The truth of this proposition is what is essentially at issue in *Martignon* and *Moghadam*.

The power to regulate commerce is far broader than the power to regulate intellectual property rights. Congressional power to regulate commerce must be weighed against Congress' power to protect intellectual property rights and one must be subordinated to the other. There are two traditional ways to address this issue. Either one must determine which one of these rights is most important or one must simply choose the provision that is most specifically targeted at the subject matter being regulated as the supporting power. The latter method is the principle employed in *Moghadam*.²⁷⁸ The former is the method employed in *Martignon*.²⁷⁹

The consequences of choosing between these two constructions of the two Article I powers are significant. To hold the Commerce Clause to be constrained by narrower Article I provisions would imply that all narrower Article I powers similarly constraint the commerce clause, substantially restricting congressional power to regulate interstate commerce. On the other hand, if the two clauses are interpreted as separate and independent grants of power that do not qualify each other, then the sole arbiter of congressional power will be the broadest clause in Article I, the Commerce Clause.

Both interpretations can produce absurd results. Instead, a subordination test that considers both the doctrine that would qualify the alternative exercise of power and the nature of the

²⁷⁷ Article I, Section 8 begins with the phrase "The Congress shall have power to" and enumerates the various congressional powers, delimiting each with semi-colon. *See, e.g.*, U.S. CONST. art. I, § 8, cl. 2 ("To borrow Money on the credit of the United States;"); U.S. CONST. art. I, § 8, cl. 3 ("To regulate Commerce with foreign Nations, and among the several States, and with the Indian Tribes;"). Each clause after the first clause in Section 8 are dependent on the phrase, "Congress shall have the power to," indicating that each subsequent clause is part of a grouping of congressional powers. This "grouping" implies some special relationship between the various Article I Section 8 powers, making it more likely that they are meant to qualify one another in certain circumstances or to operate co-extensively.

²⁷⁸ *See supra* Section I, (a)(i).

²⁷⁹ *See Supra* Section I, (a)(ii).

constitutional power being subordinated would produce more sound results. This balancing test should consider how vital the doctrine being circumvented is to the constitutional provision in which it originates from and weigh the purpose it serves against the burden it will place on the horizontal constitutional power.

In the case of the constitutional idea-expression doctrine, the court will have to weigh the underlying purpose of the doctrine, to facilitate subject-matter independent regulation in copyright and subject-matter regulation in patents, against the purposes of passing copyright-like legislation under the Commerce Clause. The test would operate as a horizontal preemption test. If the circumvention of the horizontal provision would pose an intolerable burden on the exercise of the constitutional grant of power, then the burdening provision must be subordinated. Reciprocally, if the broader grant of power would pose an obstacle to the execution of the other constitutional provision then the broader provision must be subordinated.

The test would require that a horizontal provision be allowed to constrain its sister clause as long as doing so does not pose an undue burden to the exercise of the first provision. The Commerce Clause could be subordinated to the Intellectual Property Clause if the doctrine that would qualify the Commerce Clause is necessary to the purpose of the Intellectual Property Clause. For example, the circumvention of the originality requirement in copyright, a constitutional doctrine, would not be readily tolerated, while the circumvention of fixation may not compel the subordination of the commerce clause. The test requires courts to engage in a case-by-case analysis.

C. The Test

The Horizontal Subordination test requires the consideration of three elements. First the court must determine whether qualifying the broader second provision will frustrate the goals of the first. Second, the court must determine if the qualifying provision would pose an undue burden to the exercise of constitutional power under the provision being qualified. Third, the court must balance the importance of the interests furthered by the dominance of each

clause to determine which would be least restrictive to the overall scheme of constitutional distributions of power.

The test would allow the constitutional idea-expression doctrine to operate on statutes passed under alternate grants of congressional power, but would not be allowed to interfere with Congress' vital power to regulate interstate commerce. The Horizontal Subordination Canon coupled with a constitutional idea-expression dichotomy will ensure that important divisions between patent and copyright laws remain intact, and that the boundaries of the property right conferred by the federal scheme of intellectual property protection is more clearly defined, regardless of which congressional power is used to effectuate it.

1. Applying the Horizontal Subordination Test to a Constitutional Idea-Expression Doctrine

This section will begin with the assumption that the idea-expression doctrine is a constitutional requirement, textually derived from Article I Section 8, Clause 8 of the Constitution. With this assumption, this section will apply the three-part horizontal subordination test to the conflict between the Commerce Clause and the Intellectual Property Clause. This section will specifically address whether the commerce clause can be used to circumvent the requirements of a constitutional idea-expression doctrine.

- a) Will use of the commerce clause frustrate the goals of the Intellectual Property Clause, particularly the policies underlying the idea-expression doctrine?

As noted earlier, the Intellectual property clause has the primary purpose of ensuring an economic benefit to inventors and authors, for a limited time, in exchange for the public use of the ideas after the term has expired. Specifically, the idea-expression doctrine ensures that the property right that is conferred by the clause is adequately defined, and that the distinction between patents and copyrights remains a visible one. The idea-expression doctrine is not only directly applied, but also supports other corollary doctrines, some being constitutional and others not. In particular, the Fair Use defense, which has significant First

Amendment dimensions, would be significantly weaker without the Idea-Expression doctrine. Fixation, a quasi-constitutional requirement, which requires an idea to manifest itself as expression, would also be significantly weaker without a broader policy-division between idea and expression.

Commerce Clause legislation that lacks this requirement could be used to vest copyright-like protection without such a division, in turn making it difficult to ensure that the public derives the long term benefits of conferring economic incentives on authors and inventors for a limited time. This long-term benefit is the cornerstone of the Intellectual Property clauses' charge. Authors and inventors are granted limited property rights so that the public domain can benefit from new matter.

Granted, there is always tension when the requirements of one clause are being circumvented; the question is a bit leading.²⁸⁰ It is, however, clear that the economic incentive that the clause grants is not for its own sake. It must yield benefits that inure to the benefit of the public.²⁸¹ The extent that commerce legislation undermines the policy objectives of the intellectual property clause depends on what benefits the public will enjoy under the unfettered legislation. This aspect of the test is a fact specific inquiry. The principle factor is whether the commerce legislation maintains some public benefit in return for the economic incentive it confers on authors and inventors for their ideas and expression.²⁸²

²⁸⁰ To presuppose that one provision is being "circumvented" by the other is to assume one is being subordinated to the other. The presupposition ensures a particular answer.

²⁸¹ It would be improper for the government to confer personal benefits on clever inventors. It is assumed that if the sovereign's treasury is being used that the public derive some benefit. *Cf. Vieth v. Jubelirer*, 541 U.S. 267, 338 ("[A]n acceptable rational basis can be neither purely personal nor purely partisan."). Otherwise, it would be an arbitrary use of government power, particularly in a democratic context. This notion is rooted in the Rational Basis standard of review. At a minimum, government action must be reasonably related to a legitimate government purpose. *See Lawrence v. Texas*, 539 U.S. 558, 579 (2003) (O'Connor concurring) ("Under our rational basis standard of review, legislation is presumed to be valid and will be sustained if the classification drawn by the statute is rationally related to a legitimate state interest.") (internal quotation marks and citations omitted). Government action that does not inure to the benefit of the public cannot be legitimate. It is tenant of democratic government that the government must work for its polity.

²⁸² This is not unlike the Court's requirement that federal funds provided to states on the condition that the states implement federal standards must serve the general welfare. *See*

- b) Would imposing horizontal restraints on the Commerce Power pose an undue burden on Congress' power to regulate commerce?

This factor inquires whether the imposition of the horizontal constraint would make the regulation of interstate commerce impracticable. Congress is given broad powers to legislate interstate commerce. When that power is qualified by a narrower horizontal provision, there is a risk that the broader power will become inert when it addresses or even touches on subject matter mostly regulated by the Intellectual Property Clause. The extent that the idea-expression doctrine would impact Congress' ability to regulate interstate commerce would depend on whether the idea-expression doctrine would have a direct effect on the case at hand or whether the doctrine would apply through one of its corollaries. For example, granting a monopoly on a short phrase that copyright law would not confer a property right on would be a more direct application of the idea-expression doctrine than protecting something that would typically be deemed a fair use under the copyright laws.

The directness of the doctrine matters because the more directly it applies, the more of the commerce power it circumscribes. If commerce legislation directly protects ideas, and the idea-expression doctrine applies to the Commerce Power, then the horizontal provision would preclude regulation completely. The more direct the application the more vital the qualifying doctrine must be to the delicate balance that the Intellectual Property Clause is meant to implement.

South Dakota v. Dole, 483 U.S. 203, 207 (“The first of these limitations is derived from the language of the Constitution itself: the exercise of the spending power must be in pursuit of ‘the general welfare.’”). When certain congressional power is at issue, the central purpose is to benefit the public, in turn that benefit is implicitly guaranteed in the Constitutional provision. The Intellectual Property Clause is no different. It is implicit that the reward for works of authorship and inventions are in exchange for the growth of the public domain.

- c) What outcome would have the least restrictive effect on the federal distribution of powers as they currently exist?

This factor is a balancing test with special emphasis on maintaining the status quo. This factor will examine the effect of each clause being subordinated to the other and determine which would disturb the status quo the least. Specifically, in the Constitutional idea-expression and Commerce Clause context, would subordinating the Intellectual Property Clause to the Commerce Clause undermine the purpose of the Intellectual Property Clause? Would the subordinating the broad Commerce Clause to the narrower Intellectual Property Clause restrict Congress' power to regulate interstate commerce?

There are two reasons to side with the interpretation that is least restrictive of the subordinated clause. First, constitutional interpretation must be mindful of settled expectations, perhaps one of the most important components of *stare decisis*.²⁸³ Second, it is difficult to ascertain the effect of any interpretation with much precision.²⁸⁴ Beginning with the least imposing interpretation will allow a court to reverse itself should the decision prove to be sub-optimal or undesirable.²⁸⁵

²⁸³ The court often related the notion of settled expectations to the doctrine of *stare decisis*. See *James B. Beam Distilling Co. v. Georgia*, 501 U.S. 529, 548 (U.S. 1991) (“By announcing new rules prospectively or by applying them selectively, a court may dodge the *stare decisis* bullet by avoiding the disruption of settled expectations that otherwise prevents us from disturbing our settled precedents.”). The doctrine becomes a stronger force the longer a rule has been in place in order to protect any reliance interest that may have formed in the interim. See *IBP, Inc. v. Alvarez*, 546 U.S. 21, 32 (2005) (“Considerations of *stare decisis* are particularly forceful in the area of statutory construction, especially when a unanimous interpretation of a statute has been accepted as settled law for several decades.”).

²⁸⁴ This principle is self-evident from the existence of circuit splits. Often times, lower courts will not know for certain what the Supreme Court meant in a particular opinion and are forced to rule in the absence of clarification, giving rise to divergent interpretations of the same precedent.

²⁸⁵ Broader rules tend to give rise to stronger *stare decisis* effect. For example, overturning the central holding a decision articulating a bright-line rule would unsettle expectations to greater extent than overruling a more abstract ruling. To be sure, overruling the Court's decision in *Roe v. Wade*, 410 U.S. 113 (1973), would have a greater effect on settled expectations because it is more theoretically ambitious. A

At the margins, the tradeoff may be indeterminate. This is where the balancing test becomes the most critical. A court must balance the competing purposes of the two constitutional provisions and their doctrines to determine which must take precedence. Although the three-factor approach is not a highly determinate analytical rule, it does provide a useful framework for analysis. The starting point for analysis is often determining the purpose of the constitutional provision being interpreted. This is a task that does not lend itself to rigid rules, which is why the test must remain a balancing test, to maintain the necessary play in the joints necessary for constitutional interpretation.

VI. CONCLUSION

The idea expression dichotomy operates to define the line between public domain and private monopoly. The doctrine facilitates the implicit bargain in intellectual property rights for limited times, in that works are given short-term protections for the permanent benefit to the public of the ideas underlying the work. The doctrine is so fundamental to the scheme of protecting intellectual property rights that circumventing it through the exercise of an alternate constitutional power would undermine the Constitution's very charge to promote the progress of the useful arts and sciences.

If interpreted to stem from the distinction between the useful arts and sciences, the doctrine of idea-expression gains constitutional stature and can apply horizontally to constrain alternate exercises of power. The extent to which horizontal constitutional power can constrain one another remains a difficult determination. Rather than apply a rigid canon of construction, such as requiring a narrower constitutional provision to qualify the broader one, or allowing the broadest statute in the Constitution to be the ultimate ceiling on federal power, a test that balances the purpose of the qualifying provision against the burden placed on the qualified provision to determine which constitutional provision

minimalist opinion will necessarily unsettle expectations to a lesser degree simply because less has been decided.

2008] *A CONSTITUTIONAL IDEA-EXPRESSION DOCTRINE* 513

must yield, will produce more sound result. This Horizontal Subordination test can facilitate the careful application of the constitutional idea-expression doctrine to sister clauses and can even be adapted to apply vertically to Article II powers, such as the Treaty Power.

The tension between protecting intellectual property rights subject to carefully circumscribed limits and regulating works that travel through interstate commerce with fewer restrictions can be resolved by attempting to resolve the constitutional conflict by balancing each provision's underlying purpose. The constitutional mandate that congress promote the useful arts and sciences depends heavily on a delicate bargain being struck between author and the government providing the property incentive. This bargain requires a delicate balance of monopoly and public benefit. Circumventing the doctrines that have facilitated this delicate balance would permanently damage the incentive scheme set in place by the Constitution.