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I. INTRODUCTION

The Congress shall have the power . . .

(3) To regulate Commerce with foreign Nations, and among the several States, and with the Indian Tribes;

(8) To promote the Progress of Science and the useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries[.]

"The monopoly privileges that Congress may authorize through copyright grants are neither unlimited nor primarily designed to provide a special private benefit."\(^2\)

But trademarks are forever.\(^3\)

This article makes several assertions:

(1) The Intellectual Property Clause of the Constitution, even read with the Commerce Clause, prevents Congress from giving authors or inventors exclusive rights unbounded by premeasured time limitations;

(2) Because such limits exist, even incontestable trademarks must be subject to functionality challenges in order to prevent conflict with the Patent Clause;

(3) The Intellectual Property Clause requires a similar challenge to prevent conflict with the Copyright Clause;

(4) The states are also limited by either direct constitutional mandate or statutory preemption.

Based on the first two assertions, this article argues that the Fourth Circuit's decision in *Shakespeare Co. v. Silstar Corp.*\(^4\) is unconstitutional. This outcome also highlights the importance of the

1. U.S. CONST. art. I, § 8, cls. 3, 8. Clause 3 is the Commerce Clause. Clause 8 contains what are usually termed the Copyright and the Patent Clauses. For greater accuracy, see discussion infra Section IV.C.1. I shall refer to the two clauses as the Intellectual Property Clause. I use the singular form to parallel the singular usually used for the language containing the three commerce clauses: the Foreign Nation Commerce Clause, the Interstate Commerce Clause, and the Indian Tribes Commerce Clause. See, e.g., *Cotton Petroleum Corp. v. New Mexico*, 490 U.S. 163, 190 (1989).


3. Epigram by author.

The copyright laws are based on an entirely different concept than the trademark laws, and contemplate that the copyrighted material, like patented ideas, will eventually pass into the public domain by mere passage of time.


last two assertions. The ramifications of the third assertion are left to another paper.

The fourth assertion is both the most interesting and the most theoretical. The latter part of this Article suggests that states are directly limited by the Intellectual Property Clause, especially if Congress passes any legislation under that Clause. This outcome may be considered to rest on (1) statutory/constitutional preemption created by the Intellectual Property Clause in combination with any federal legislation under that Clause, or (2) narrow constitutional preemption by the Intellectual Property Clause acting alone, or (3) a dormant Intellectual Property Clause,\(^5\) or (4) the intersection of the Intellectual Property Clause and the Dormant Commerce Clause. However analyzed, Congress is constitutionally barred from removing this limitation.

Finally, this Article asserts that in an “evolving Constitution,” the best reading of “limited times” may be “limited in relation to the economic life of the res.”\(^6\)

II. THE TRIGGERING CASE: \textit{SHAKESPEARE V. SILSTAR}\(^7\)

Shakespeare and Silstar are competing manufacturers of fishing rods.\(^8\) Shakespeare sued Silstar for trademark infringement.\(^9\) Silstar defended and counterclaimed, requesting cancellation of Shakespeare’s mark.\(^10\)

Shakespeare had obtained federal registration and incontestable status for a mark that consisted of “a whitish-translucent, or clear, tip

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5. Thanks to Judge Kozinski, the only federal judge, so far, to use the term “dormant Copyright Clause” in an on-line opinion. Search of WESTLAW, Allfeds Library (April 27, 1994); see White v. Samsung Elec. Am., Inc., 989 F.2d 1512, 1518 (9th Cir.) ("Under the dormant Commerce Clause, state intellectual property laws can stand only so long as they don't 'prejudice the interests of other States.'" (quoting Goldstein v. California, 412 U.S. 546, 558 (1973)) (dissent from denial of rehearing en banc), cert. denied, 113 S. Ct. 2443 (1993).

6. While this is merely a side-issue in the current paper, I strongly suggest it warrants serious and immediate consideration.

7. \textit{Shakespeare} raises other issues, fascinating to a trademark specialist, which are beyond the scope of this paper: the relationship between the grounds for cancellation available to courts and the PTO, whether available weapons against incontestable marks are substantive or merely change the evidentiary weight of the registration, and whether the existence of collateral use empowers unlisted weapons when a counterclaimant requests judicial cancellation of incontestable marks.


10. \textit{Id.}
portion of the rod, combined with an opaque rod base.”11 This
trademarked appearance is not primarily a product of aesthetic choice;
it is the natural result of making a rod with a hollow graphite tube and
a solid fiberglass tip—a superior combination of material that creates
a strong, flexible, light-weight fishing rod. Leaving the tip clear or
transparent and the base opaque is the cheapest way of making a
superior rod because the manufacturer does not incur the expense of
adding coloring.12 The configuration also makes the rod’s superior
construction clearly visible to a consumer.13 Shakespeare’s “mark” is,
therefore, “functional” as defined in trademark law.14 Based on this
conclusion, the district court ordered the Patent and Trademark Office
(PTO) to cancel the mark’s registration. The Fourth Circuit re-
versed—unconstitutionally.15

III. BACKGROUND STATUTORY AND COMMON LAW

A trademark is a word, name, symbol, device, or any combination
thereof used in commerce by a person to identify the goods or services
of that person.16 Trademark law protects consumers’ mental associa-
tion between the source of a product and the product itself. This
allows consumers to easily locate goods of known quality and motivates
suppliers to offer high quality merchandise.17

11. Id. at 1388.
12. Id. at 1390-91.
13. Id. at 1391. But see Brief in Opposition to Petition for a Writ of Certiorari at 21, Silstar
Corp. v. Shakespeare Co., 9 F.3d 1091 (4th Cir. 1993) (No. 93-1568) (“Shakespeare takes
multiple steps in its conscious alteration of an already existing public domain method of
manufacture to produce the unique appearance of its ‘clear tip’ configuration. It adds a dual color
bath . . . .”).
15. Id. at 1398-99, rev’d, 9 F.3d 1091 (4th Cir. 1993), cert. denied, 114 S. Ct. 2134 (1994).
This description oversimplifies. The district court decided first that Silstar’s was a “fair use”;
second, that this conclusion lowered the evidentiary level of the registration from conclusive to
prima facie, thus allowing functionality to be considered; third, that the mark was functional;
fourth, that a court had the power to order cancellation of a functional mark under these
circumstances even if the mark was incontestable.
definitions of “trademarks” and “service marks.” The Lanham Act also defines “certification
marks” and “collective marks.” All are included in the statutory term ‘marks.’ For the purposes
of this Article, the technical definitions and distinctions are unimportant. Unless otherwise
specified, I shall follow the usage of attorneys who do not specialize in intellectual property law
and use “trademark” to mean any type of “mark” defined in the Lanham Act or an unregistered
However, only registered trademarks may become incontestable. See 15 U.S.C. § 1065 (1988).
17. See, e.g., Edward S. Rogers, The Lanham Act and the Social Function of Trademarks, 14
LAW & CONTEMP. PROBS. 173, 182 (1949). Economic analysis confirms the ties between legal
trademark protection, search costs, and incentives to offer quality goods. See William M. Landes
A. Mere Descriptiveness

Words, names, symbols, and devices presented to courts or the PTO as "marks" are commonly separated into categories originally created by Judge Friendly.19 Generic,20 descriptive, suggestive, and arbitrary or fanciful.21 These categories are unclearly marked sections of a continuum from clear indications of product nature to clear indications of product source.22

Marks that merely describe a product are not inherently distinctive and do not inherently identify a particular source. Therefore, under most circumstances, they cannot be protected. However, descriptive marks may acquire enough distinctiveness to be protected.23

No one has ever created a clear test to determine whether a mark is "merely descriptive" or "suggestive." The distinction is very important because "suggestive" marks, as opposed to "merely descriptive" marks, can be protected without a showing of acquired distinctiveness.24 One test looks at the role played by imagination: "A term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of the goods. A term is descriptive if it forthwith conveys an immediate idea of the ingredients,

18. Because this Article is limited to the constitutional issues, Sections I and II supply only the minimal information needed to understand those issues.
20. Generic terms are the common name of the type of product and are never protectible as marks. See 15 U.S.C. § 1064 (3) (1988). "A generic term is one that refers to the genus of which the particular product is a species." Park N' Fly, Inc. v. Dollar Park and Fly, Inc., 469 U.S. 189, 194 (1985). Words held generic include: shredded wheat (claimed as a mark by Kellogg Co.), Kellogg Co. v. National Biscuit Co., 305 U.S. 111 (1938); aspirin (formally a common-law mark owned by Bayer), Bayer Co. v. United Drug Co., 272 F. 505 (S.D.N.Y. 1921); and cellophane (formerly a trademark of E.I. Du Pont de Nemours & Co.), Du Pont Cellophane Co. v. Waxed Prods. Co., 85 F.2d 75 (2d Cir.), cert. denied, 299 U.S. 601 (1936), cert. denied, 304 U.S. 575 (1938). Marks which the reader may remember as having been at least on the verge of becoming generic include Xerox (photocopying) and Kleenex (paper tissue).
21. For example, EXXON or XEROX, which were coined by their holders.
The type and impression of these categories is a reasonable economic choice. See Landes & Posner, supra note 17, at 287-96.
23. Two Pesos, 112 S. Ct. at 2757; see also 15 U.S.C. § 1052 (1988 & Supp. V 1993) (Registration on the principle register may be denied if the element "when used on or in connection with the goods of the applicant is merely descriptive . . . of them," but such an element may be registered if it has "become distinctive of the applicant's goods in commerce.").
qualities or characteristics of the goods." 25 Another test considers whether or not competitors need the term to indicate the nature of their goods. 26 A third test focuses on the extent to which competitors already use the term. 27

Marks that courts have held "descriptive" include KING SIZE (clothing for larger men), 28 FINELINE (for mechanical pencils), 29 BUFFERIN (for buffered aspirin), 30 and CONTINUOUS PROGRESS (for educational materials). 31 Marks held "suggestive" include CITIBANK (for an urban bank), 32 COPPERTONE (for sun tan oil), 33 LOC-TOP (for bottle closure caps), 34 and MATERNALLY YOURS (for maternity clothing shop). 35

B. Functionality

"In general terms, a product feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of

27. See, e.g., In re Quick-Print Copy Shops, Inc., 203 U.S.P.Q. 624 (T.T.A.B.), aff'd, 616 F.2d 523 (C.C.P.A. 1979). The American Law Institute's drafts have elements of all three tests, see RESTATEMENT (THIRD) OF UNFAIR COMP. § 14 cmt. b (Tentative Draft No. 2, 1990) (not acknowledging that the tests may lead to conflicting outcomes, see, e.g., id. § 16 cmt. b, illus. 3 (container of liquid drain opener in the shape of a pipe trap is inherently distinctive even though this is the closest possibility of a physical description for a container, with the possible exception of a plunger-shaped bottle)). These tests, and these categories of marks, were created in an age when word marks predominated. Acceptance of packages and the configuration of the goods themselves as marks strains the system. The Supreme Court's decision that unregistered trade dress may be protected without a showing of secondary meaning exacerbates this problem. See Two Pesos, 112 S. Ct. 2753. I will leave the perplexities of when a non-word mark is "merely descriptive" to another article.
35. Maternally Yours, Inc. v. Your Maternity Shop, Inc., 234 F.2d 538 (2d Cir. 1956). Readers who find the court rulings regarding "descriptive" or "suggestive" difficult to coordinate are in good company. Consider the multiple opinions discussing whether SKINVISIBLE, used as a mark for transparent bandaging tape, is distinctive, or, as the court held, suggestive. Minnesota Mining & Mfg. v. Johnson & Johnson, 454 F.2d 1179 (C.C.P.A. 1972).
the article." 36 Functional features are not protectible as trademarks. 37

[T]he concept of functionality can be given a precise economic meaning. A nonfunctional feature, a feature that can be trademarked, is one with perfect (or nearly perfect) substitutes, so that a property right will create no deadweight loss . . . . But if the feature lacks good substitutes, either because the product is worth less without it (the circular tire) or because it makes the product cheaper to produce ([the cheapest] container shape), trademark protection will be denied. 38

No reference to "functionality" appears in the Lanham Act. The courts have refused to grant trademark protection to "functional" features. This judicial fiat sensibly prevents exclusive property in the "useful arts" without the need to meet the high criteria of the utility patent statutes and without the time limitations imposed on patent rights. 39  Congress has never spoken on this particular issue. The PTO, however, accepts the functionality doctrine and its policy rationale. 40 Although the Supreme Court has never directly consid-

36. Inwood Labs. v. Ives Labs., 456 U.S. 844, 850 n.10 (1982); see also Kellogg Co. v. National Biscuit Co., 305 U.S. 111, 122 (1938) (noting that the pillow-shape of a shredded wheat biscuit is functional because "the cost of the biscuit would be increased and its high quality lessened if some other form were substituted for the pillow-shape.").

This article does not discuss the disputed esoterica of aesthetic functionality. Compare Pagliero v. Wallace China Co., 198 F.2d 339 (9th Cir. 1952) (creating doctrine) with McCARTHY, supra, note 22, § 7.26[4][b], at 7-137 to 7-138 ("[T]he majority of courts have rejected the theory of aesthetic functionality with varying degrees of zeal."). Nor does this article discuss communicative functionality. But see Malla Pollack, Your Image Is My Image: When Advertising Dedicates Trademarks to the Public Domain—With an Example From the Trademark Counterfeiting Act of 1984, 14 CARDOZO L. REV. 1391, 1412-34 (1993) (suggesting doctrine). Neither aesthetic functionality nor communicative functionality present the constitutional problem addressed in this article.


38. Landes & Posner, supra note 17, at 265.

39. See, e.g., Keene Corp. v. Paralex Indus., 653 F.2d 822, 824 (3d Cir. 1981) ("The purpose of the rule precluding trademark significance is to prevent the grant of a perpetual monopoly to features which cannot be patented . . . . Products or features which have not qualified for patent protection but which are functional are in the public domain are fair game for imitation and copying."); see also In re Morton-Norwich Products, Inc., 671 F.2d 1332 (C.C.P.A. 1982); Vaughn Mfg. Co. v. Brikam Int'l Inc., 814 F.2d 346 (7th Cir. 1987); McCARTHY, supra note 22, § 7.26[1].

40. If something is de jure functional it cannot be registered . . . . The refusal made in such a situation is based on §§ 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052 and 1127, on the ground that the matter does not function as a mark. The refusal rests, however, upon the foundation of effective competition. If a design is so highly utilitarian in nature as to be the best or one of the few superior designs available,
ered the rule's legitimacy, the Court has assumed its legitimacy in several cases.\footnote{41}

C. Incontestably-Registered Trademarks

Trademarks that distinguish the goods of one business\footnote{42} can be registered on the principle register of the PTO.\footnote{43} If a trademark \((1)\) is registered on the principle register, \((2)\) is currently used in commerce, \((3)\) has been both registered and used in commerce for the immediately preceding five consecutive years, and \((4)\) is not generic,\footnote{44} a mere filing with the PTO transforms it into an incontestably-registered mark ("incontestable mark").\footnote{45} According to federal statute, the registration of an incontestable mark is "conclusive evidence" of the trademark's validity, of the validity of its registration, of the registrant's ownership of the mark, and of the registrant's

\footnote{41}{See Two Pesos, 112 S. Ct. at 2758; Inwood, 456 U.S. at 844; Kellogg, 305 U.S. at 122.}

\footnote{42}{The term "person" or any other word or term used to designate the applicant or other entitled to a benefit or privilege or rendered liable under the provisions of [the Lanham] Act includes a juristic person as well as a natural person. The term "juristic person" includes a firm, corporation, union, association, or other organization capable of suing and being sued in a court of law. 15 U.S.C. § 1127 (1988 & Supp. IV 1992).}


\footnote{44}{For definition, see supra note 20.}

\footnote{45}{15 U.S.C. § 1065 (1988) (for the goods or services for which it has been continuously used and registered for five years); see also Borg-Warner Corp. v. York-Shipley, Inc., 127 U.S.P.Q. 42 (N.D. Ill. 1960) (so interpreting § 1065), modified on other grounds, 293 F.2d 88 (7th Cir.), cert. denied, 368 U.S. 939 (1961). To be exact, only the "right to use the mark," not the mark itself, becomes incontestable. 15 U.S.C. § 1065. Additional qualifications for incontestability are:

\begin{enumerate}
  \item there has been no final decision adverse to registrant's claim of ownership of the mark for such goods and services, or to registrant's right to register the same or to keep the same on the register; and
  \item there is no proceeding involving said rights pending in the Patent and Trademark office or in a court and not finally disposed of.
\end{enumerate}

Id.}

An incontestable mark has no exclusion power to the extent that it "infringes a valid right acquired under the law of any State or Territory by use of a mark or trade name continuing from a date prior to the date of registration under [the Lanham] Act of such mark." \textit{Id.}
exclusive right to use the mark in commerce.\textsuperscript{46} Incontestability is a method of quieting title to the trademark.\textsuperscript{47}

Incontestable marks are not inviolate, but they are less open to challenge than other marks. The Lanham Act lists a limited number of challenges available against an incontestable mark:

(1) the registrant obtained the registration or incontestable right by fraud,\textsuperscript{48}

(2) the registrant abandoned the mark,\textsuperscript{49}

(3) the mark, under the aegis of the registrant, is being used for misrepresentation of the source of goods or services,\textsuperscript{50}

(4) the allegedly infringing mark is being used collaterally, i.e. descriptively, rather than as a mark,\textsuperscript{51}

\textsuperscript{46} 15 U.S.C. § 1115(b) (1988). This conclusive weight is limited to those goods or services covered by the registration and any renewals. \textit{Id}. 49

\textsuperscript{47} \textit{Park N' Fly}, 469 U.S. at 198 ("The incontestability provisions, as the proponents of the Lanham Act emphasized, provide a means for the registrant to quiet title in the ownership of his mark."). This has been challenged as inaccurate and as masking a lack of analysis. See Kenneth L. Port, \textit{The Illegitimacy of Trademark Incontestability}, 26 IND. L. REV. 519, 544 (1993) and sources cited in accompanying notes.


\textsuperscript{49} \textit{Id}. § 1115(b)(2).

\textsuperscript{50} \textit{Id}. § 1115(b)(3); see also \textit{id}. §§ 1064, 1065 (1988). Similar defenses exist against a specialized type of mark called a "certification mark." Certification marks are used by persons other than the registrants of the certification mark. A certification mark represents the registrant's "certification of the goods' or services'", regional or other origin, mode of manufacture, quality, accuracy, or other characteristic ... that the work or labor on the goods or services performed by members of a union or other organization." \textit{Id}. § 1127 (1988 & Supp. IV 1992).

An incontestable certification mark can be challenged on grounds that (1) it is being "used so as to represent falsely that the owner or a user thereof makes or sells the goods or performs the services on or in connection with which such mark is used," or (2) that

the registrant (A) does not control, or is not able legitimately to exercise control over, the use of such mark, or (B) engages in the production or marketing of any goods or services to which the certification mark is applied, or (C) permits the use of the certification mark for purposes other than to certify, or (D) discriminately refuses to certify or to continue to certify the goods or services of any person who maintains the standards or conditions which such mark certifies.


15 U.S.C. § 1115(b)(4) (1988). For example, a repair shop may advertise that it specializes in fixing Volkswagen cars, provided that it does not imply it is authorized to do so by Volkswagen. Volkswagenwerk Aktiengesellschaft v. Church, 411 F.2d 350, \textit{supplemental opinion}, 413 F.2d 1126 (9th Cir. 1969). A perfume manufacturer may use advertising comparing his scents and prices to those of a more expensive business, provided consumers are not confused. Smith v. Chanel, Inc., 402 F.2d 562 (9th Cir. 1968).
(5) the allegedly infringing mark has temporal priority within a limited geographic area,\textsuperscript{52}
(6) the registered mark is (or has been) used to violate federal antitrust law,\textsuperscript{53}
(7) equitable principles such as latches, estoppel, or acquiescence protect the alleged infringer,\textsuperscript{54}
(8) the mark is generic,\textsuperscript{55}
(9) the mark has been abandoned by the registrant,\textsuperscript{56} or
(10) the mark contains material intrinsically unacceptable under the Lanham Act.\textsuperscript{57}

Mere descriptiveness and functionality, two extremely potent weapons against other marks, are not listed in the statutory armory for use against incontestable marks. This Article argues that the absence of mere descriptiveness raises a constitutional problem under the Copyright Clause and that the absence of functionality raises a constitutional problem under the Patent Clause.

Mere descriptiveness and functionality differ in one important respect: the surety of their unavailability. Mere descriptiveness is addressed by the text of the Lanham Act;\textsuperscript{58} its exclusion from the list

\textsuperscript{52} 15 U.S.C. § 1115(b)(5), (6). The technical details are not relevant to this Article. The junior user is allowed to keep limited rights obtained by use (or use and registration) before the registrant's rights matured under the Lanham Act. \textit{Id.}
\textsuperscript{53} \textit{Id.} § 1115(b)(7).
\textsuperscript{54} \textit{Id.} § 1115(b)(8).
\textsuperscript{55} \textit{Id.} §§ 1064, 1065.
\textsuperscript{56} \textit{Id.}
\textsuperscript{57} For example, the mark:
(a) consists of or compromises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute[, or]
(b) [c]consists of or compromises the flag or coat of arms or other insignia of the United States or of any State or municipality, or of any foreign nation, or any simulation thereof[, or]
(c) [c]consists of or compromises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the of the United States during the life of his widow, if any, except by the written consent of the widow.

(\textit{e}) [c]consists of a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them, or (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive or deceptively misdescriptive of them . . . .

(\textit{f}) Except as expressly excluded in paragraphs (a), (b), (c), and (d) of this section, nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce.
of challenges available against an incontestable mark is, therefore, unmistakably a congressional choice.\textsuperscript{59} Functionality, however, is entirely a judicial creation.

The District Court opinion in \textit{Shakespeare Co. v. Silstar Corp.} was the first case to reach functionality's relationship to incontestable marks.\textsuperscript{60} On appeal, the Fourth Circuit reversed the District Court's cancellation of the mark because functionality is not listed in the Lanham Act as a ground upon which a court may order cancellation of an incontestable mark.\textsuperscript{61} Silstar petitioned in vain for certiorari on the constitutional issue\textsuperscript{62} of whether a trademark registered under the Lanham Act can provide a perpetual patent-like monopoly for a functional feature of a product in light of the constitutional limitation on such perpetual monopolies set forth in Article I, Section 8, Clause 8 of the United States Constitution, and in light of the entire history of trademark law to the contrary.\textsuperscript{63}

\textsuperscript{15} U.S.C. § 1052. The effect of this statutory language is that "words which are merely descriptive of the qualities, ingredients, or composition of an article cannot be appropriated as a trademark and are not entitled to protection unless they have acquired secondary meaning." Blisscraft of Hollywood v. United Plastics Co., 294 F.2d 694, 698 (2d Cir. 1961). "The basic element of secondary meaning is . . . the mental association by a substantial segment of consumers and potential consumers between the alleged mark and a single source of the product." Levi Strauss & Co. v. Blue Bell, Inc., 778 F.2d 1352, 1354 (9th Cir. 1985) (internal quotations and citation omitted).

\textsuperscript{59} See Park N' Fly, Inc. v. Dollar Park and Fly, Inc., 469 U.S. 189, 196-97 (1985) (discussing legislative history) ("The statutory provisions that . . . do not allow an incontestable mark to be challenged on [the] ground [of mere descriptiveness] cannot be attributed to inadvertence by Congress.").

\textsuperscript{60} 9 F.3d 1091, 1092, 1096-97 (4th Cir. 1993), cert. denied, 114 S. Ct. 2134 (1994). But see Schwinn Bicycle Co. v. Murray Ohio Mfg. Co., 339 F. Supp. 973 (M.D. Tenn. 1971), aff'd on other grounds, 470 F.2d 975 (6th Cir. 1972). Schwinn is cited in Anthony L. Fletcher, \textit{Incontestability and Constructive Notice: A Quarter Century of Adjudication}, 63 TRADEMARK REP. 71, 97 (1973) (describing Schwinn as using functionality to deny enforcement of an incontestable mark). Fletcher misreads Schwinn. The Schwinn court held against the plaintiff, the holder of an incontestable mark, on the ground that the alleged mark was functional. However, the relationship between incontestability and functionality was not addressed. The Schwinn court considered incontestability irrelevant because of the doctrine (followed by some, but not all, circuits) that incontestability cannot be used offensively. This offensive/defensive distinction was finally destroyed by Park N' Fly v. Dollar Park & Fly, Inc., 469 U.S. 189 (1985) (incontestability may be used offensively). For the history of the distinction, see Port, supra note 47, at 545-47.

\textsuperscript{61} See Shakespeare Co. v. Silstar Corp., 9 F.3d 1091, 1092 (4th Cir. 1993), cert. denied, 114 S. Ct. 2134 (1994). The Fourth Circuit also disagreed with other aspects of the district court opinion and remanded for reconsideration of several issues. \textit{Id.} at 1098-99. Judge Niepmeyer dissented; he saw the issue as the importance of functionality and alluded to, though did not stress, the constitutional time limit set for control of patentable subject matter. \textit{Id.} at 1099-1106.

\textsuperscript{62} The petition also requested review of "[w]hether 15 U.S.C. § 1119 provides authority for a federal court to cancel a trademark on the ground that it applies to a functional feature." Petition for a Writ of Certiorari, \textit{Shakespeare}, 9 F.3d 1091 (4th Cir. 1993) (No. 93-1568).

\textsuperscript{63} \textit{Id.}. 
The Supreme Court declined to answer Silstar's question. This Article answers the question: No.

This Article argues only that the Fourth Circuit's reading of the Lanham Act creates a constitutional problem. I leave for another article whether the reading is the correct statutory interpretation or the better policy choice.

IV. CONGRESS MAY NOT BY PASS THE "LIMITED TIMES" PROVISION IN THE INTELLECTUAL PROPERTY CLAUSE THROUGH THE COMMERCE CLAUSE

Anyone who suggests a constitutional limit on Congressional power needs to address whether the proposed limit is overcome by a different section of the Constitution. The Commerce Clause might easily allow Congress to pass statutes that could not be authorized by the Intellectual Property Clause.

A. Other Clauses as Limits on the Commerce Clause

The Commerce Clause, while expansive, does have outer limits even though its range has grown significantly over time. In 1879, the clause could not ground trademark legislation that did not expressly exclude marks used in commerce between citizens of the same state. By 1942, it covered regulation of grain intended, not for sale, but for consumption on the farm where it was produced. Yet "Congress may not . . . transcend specific limitations on its exercise of the commerce power that are imposed by other provisions of the Constitution."

Under certain circumstances, other Constitutional provisions may act as limits upon the Commerce Clause. These include the Bankruptcy Clause, and the Fifth, Sixth, Tenth, and Twenty-first Amendments. These various provisions have kept Congress from utilizing the Commerce Clause as a means to avoid the provisions' requirements.

64. Because the statute has a clear severability clause, the court could easily have held the statute unconstitutional only as applied to functional, incontestable marks. See 15 U.S.C. § 1051 (1988 & Supp. IV 1992) ("If any provision of this Act or the application of such provision to any person or circumstance is held invalid, the remainder of the Act shall not be affected thereby.").

65. See generally Richard A. Epstein, The Proper Scope of the Commerce Power, 73 VA. L. REV. 1387 (1987) (providing an overview of the history of the clause's expansion and arguing that the Commerce Clause had been over-expanded even before the New Deal, but agreeing that both reliance interests and lack of a good theory on when correcting past errors is justified militate against returning to a correct reading).

66. The Trade-Mark Cases, 100 U.S. 82, 96-97 (1879).
The words "[t]o establish an uniform Rule of Naturalization, and uniform Laws on the subject of Bankruptcies throughout the United States" bars a statute which "applies only to one debtor and [which] can be enforced only by the one bankruptcy court having jurisdiction over that debtor." 

Unlike the Commerce Clause, the Bankruptcy Clause contains an affirmative limitation or restriction upon Congress' power: Bankruptcy laws must be uniform throughout the United States. Such uniformity in the applicability of legislation is not required by the Commerce Clause. Thus, if Congress had the power to enact nonuniform bankruptcy laws pursuant to the Commerce Clause, a limitation on the power of Congress to enact bankruptcy laws would be eradicated from the Constitution. It is therefore necessary for us to determine the nature of the uniformity required by the Bankruptcy Clause.

Commerce Clause limitations based on the Tenth Amendment seemingly exist, but their extent has been clouded, not clarified, by recent Court decisions. In 1976, National League of Cities v. Usery "drew from the Tenth Amendment an 'affirmative limitation on the exercise of [congressional power under the Commerce Clause] akin to other commerce power affirmative limitations contained in the Constitution.'" In 1983, this constraint was loosened by EEOC v. Wyoming, and in 1985, Garcia v. San Antonio Metropolitan Transit

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72. "The powers not delegated to the United States by the Constitution, nor prohibited by it to the States, are reserved to the States respectively, or to the people." U.S. CONST. amend. X.
74. Compare EEOC v. Wyoming, 460 U.S. at 239 (ADEA as applied to game wardens does not meet National League of Cities' three part test for invalidity because the ADEA does not "directly impair the State's ability to structure integral operations in areas of traditional governmental functions.") (citation and internal quotations omitted) (op. for the court, Brennan, J.) with id. at 248 ("The only basis for questioning the federal statute at issue here is the pure judicial fiat found in National League of Cities. Neither the Tenth Amendment, nor any other provision of the Constitution, affords any support for that judicially constructed limitation on the scope of the federal power granted to Congress by the Commerce Clause.") (Stevens, J., concurring).
Authority overruled National League of Cities. The Garcia Court continued "to recognize that the States occupy a special and specific position in our constitutional system" and that "the scope of Congress' authority under the Commerce Clause must reflect that position." The Court trusted that "[t]he political process [generally] ensures that laws that unduly burden the States will not be promulgated" and declined to "identify or define what affirmative limits the constitutional structure might impose on federal action affecting the States under the Commerce Clause." In 1991, in Gregory v. Ashcroft, Justice O'Connor, writing for the Court, imposed a plain statement requirement on any congressional attempt to cover state judges under the Age Discrimination in Employment Act. The requirement partially rested on "avoid[ing] a potential constitutional problem" because, as compared to "Congress' powers [t]o regulate Commerce ... among the several States," the "authority of the people of the States to determine the qualifications of their government officials may be inviolate," trumping Congress's authority.

Clarification, or further mystification, on this issue may be imminent. On April 18, 1994, the Court granted certiorari to answer the question whether the "Commerce Clause empower[s] Congress to enact [18 U.S.C.] Section 922(q) [the Gun-Free School Zone Act of

75. 469 U.S. 528 (1985).
76. Id. at 557. But see id. at 580 (Rehnquist, J. dissenting) ("I am confident [that the principle of National League of Cities will] in time again command the support of a majority of this Court.").
77. Garcia, 469 U.S. at 556.
78. Id.
79. Id.; see also id. at 552 ("State sovereign interests ... are more properly protected by procedural safeguards inherent in the structure of the federal system than by judicially created limitations on federal power.").
80. 501 U.S. 452 (1991) (holding that state judges are not covered by the ADEA).
81. O'Connor dissented in Garcia. 469 U.S. at 580.
82. U.S. CONST. art. I, § 8, cl. 3.
1990], which makes it a federal offense to possess firearm[s] within 1,000 feet of [a] school."

The Fifth Amendment’s Due Process Clause rendered unconstitutional the presumption of knowledge embedded into the Marijuana Tax Act. The Sixth Amendment’s right to trial by jury rendered unconstitutional the death penalty created by the Federal Kidnapping Act. Justice O’Connor stated, though not for the Court, that the Twenty-First Amendment prevents federal legislation pursuant to the Commerce Clause to set minimum drinking ages.

In contrast to the above limitations on the Commerce Clause, the Court allowed circumnavigation of the Taxing Clause through the channel of the Commerce Clause in the Head Money Cases of 1884. An impost of fifty cents per immigrant passenger was held a valid exercise of the Commerce Clause despite the argument that this was a tax implicitly barred by the Constitution’s linkage of taxes to the general welfare.

85. United States v. Lopez, 62 U.S.L.W. 3645 (quotation is from U.S.L.W.), 2 F.3d 1342 (5th Cir. 1993) (‘‘Tenth Amendment bars Congress passing such legislation under its Commerce Clause authority; in the alternative, even if Congress had power to pass the statute, defendant’s conviction must be reversed for failure to allege and prove any connection between his possession of a gun in a school and interstate commerce’’). See United States v. Edwards, 13 F.3d 291 (9th Cir. 1993) (statute is within Congress’ Commerce Clause power), petition for cert. filed March 25, 1994 (No. 93-8487).


87. National League of Cities, 426 U.S. at 841, (construing United States v. Jackson, 390 U.S. 570 (1968)). The statute at issue erred by providing a possible death penalty only to defendants who chose to go to trial. Jackson, 390 U.S. at 571.

88. ‘‘[T]he regulation of the age of the purchasers of liquor, just as the regulation of the price at which liquor may be sold, falls squarely within the scope of those powers reserved to the States by the Twenty-First Amendment . . . . Accordingly, Congress simply lacks power under the Commerce Clause to displace state regulation of this kind.’’ South Dakota v. Dole, 483 U.S. 203, 218 (1987) (O’Connor, J., dissenting). The majority did not reach this issue because they validated the limit under the Spending Power. Id. at 206. But see Bacchus Imports, Ltd. v. Dias, 468 U.S. 263, 274-76 (1984) (Twenty-First Amendment does not allow state protectionism of the local liquor industry over a dormant commerce clause violation).

89. 112 U.S. 580 (1884).

90. U.S. CONST. art. I, § 8, cl. 1 (‘‘The Congress shall have power to lay and collect Taxes, Duties, Imposts, and Excises, to pay the Debts and provide for the common Defense and general Welfare of the United States’’). See DAVID P. CURRIE, THE CONSTITUTION IN THE SUPREME COURT: THE FIRST HUNDRED YEARS 1789-1888 at 431-32 (1985) (criticizing this use of the Commerce Clause). A better basis for the Court’s judgment would have been its dicta:
Seemingly, if a separate constitutional phrase (1) includes a limit by negative implication, and (2) this limit has not been interpreted out of the clause, Congress cannot by pass the limit through the Commerce Clause. As discussed immediately below, the "limited times" provision in the Intellectual Property Clause fills these requirements.91

B. The Meaning of "Limited Times" in the Intellectual Property Clause

The Congress shall have the power . . .

. . .

To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries].92

The Intellectual Property Clause, while relatively clear on its face, lacks a clear, contemporaneous pedigree or explication. However, nothing suggests the words "limited times" were intended in some counterintuitive sense for policy reasons.93 Nor does the current vision of the Clause's policy justification counsel interpreting it counterintuitively.94

According to James Madison's notes, David Brearley suggested the final wording of the clause to the Constitutional Convention on September 5, 1787, speaking for the Committee on Unfinished

__If it were necessary to prove that the imposition of this contribution on owners of ships is made for the general welfare of the United States, it would not be difficult to show that it is so, and particularly that it is among the means which Congress may deem necessary and proper for that purpose; and beyond this we are not permitted to inquire. Head Money Cases, 112 U.S. at 595. 91. But cf. Pierre N. Leval & Lewis Liman, Are Copyrights for Authors or Their Children?, 39 J. COPYRIGHT SOC. USA 1, 4 n.14 (1991) (concluding without analysis that "contemporary understanding of Congress' Commerce Clause power surely encompasses the power to pass such a statute" giving copyrights to non-authors). 92. U.S. CONST. art. I, § 8, cl. 8. 93. But see discussion infra notes 130-49 and accompanying text. Compare Maryland v. Craig, 497 U.S. 836, 845 (1990) ("The central concern of the Confrontation Clause is to ensure the reliability of the evidence against a criminal defendant by subjecting it to rigorous testing in the context of an adversary proceeding before the trier of fact") (holding constitutional a Maryland statute allowing an alleged child abuse victim to testify by one-way closed circuit television). But see id. at 870 ("The Court has convincingly proved that the Maryland procedure serves a valid interest, and gives the defendant virtually everything the Confrontation Clause guarantees (everything, that is, except confrontation). I am persuaded, therefore, that the Maryland procedure is virtually constitutional . . . . [I]t is not, however, actually constitutional . . . .") (Scalia, J., dissenting). 94. However, modern understanding of economics may counsel changing the way we calculate the time limit, see infra notes 134-39 and accompanying text.\__
Business. Brearley did so in response to Madison’s suggestion “[t]o secure to literary authors their copyrights for a limited time,” and also to two suggestions by Charles C. Pinckney: “[t]o grant patents for useful inventions,” and “[t]o secure to authors exclusive rights for a certain time.”

We have no record of any discussion about the clause. There was no debate on the floor of the Constitutional Convention, and minutes

95. See also Karl Fenning, The Origin of the Patent and Copyright Clause of the Constitution, 11 J. PAT. OFF. SOC’Y 438, 442 (1929) (On “Wednesday, September 5, 1787, . . . Mr. Brearley of the Committee of Eleven, made a further report as follows: ‘To promote the progress of Science and useful arts by securing for limited times to authors & inventors the exclusive right to their respective writings and discoveries.’ (A footnote in the journal here says that the word ‘the’ is inserted in the transcript between ‘and’ and ‘useful.’”).

96. ARTHUR T. PRESCOTT, DRAFTING THE FEDERAL CONSTITUTION 529 (1941) (a rearrangement of Madison’s notes giving consecutive development of provisions in the Constitution) (internal quotations omitted); see also Fenning, supra note 95, at 442 ("General Pinckney proposed, for the Committee [of detail], 'to grant patents for useful inventions; to secure to authors exclusive rights for certain ['limited' stricken out] time.'" (bracketed material in original)). Pinckney is credited with the first suggestion of both patent and copyright. 1 GEORGE T. CURTIS, CONSTITUTIONAL HISTORY OF THE UNITED STATES FROM THEIR DECLARATION OF INDEPENDENCE TO THE CLOSE OF THEIR CIVIL WAR 531 (1889) ("The subjects of patents for useful inventions and of copyrights of authors appear to have been brought forward by Mr. Charles Pinckney;" no authority given) [hereinafter CURTIS, CONSTITUTIONAL HISTORY]; 2 GEORGE T. CURTIS, HISTORY OF THE ORIGIN, FORMATION AND ADOPTION OF THE CONSTITUTION OF THE UNITED STATES; WITH NOTICES OF ITS PRINCIPAL FRAMERS 339 (1858) (same wording) [hereinafter CURTIS, HISTORY OF THE ORIGIN]. But see ROBERT P. MERGES, PATENT LAW & POLICY 7 (1992) (crediting Jefferson with authorship of the constitutional Patent Clause; no authority given); Fenning, supra note 95, at 440-41 (crediting Madison with first mention of copyright, but not patent). While Fenning provides the most detail on the movement of the proposal through the Constitutional Convention, he concludes that "[i]t seems impossible to fix definitely on whose brow the laurel wreath should be placed either for the general suggestion or for the specific phraseology of the patent and copyright clause [sic] of the Constitution." Id. at 445.

Madison’s notes also record several rejected alternatives on the same or related subjects:

MASSON: It should be provided that the government have power to encourage by premiums and provisions the advancement of useful knowledge and discoveries.

PINCKNEY: Power should be given the government to establish public institutions, rewards and immunities for the promotion of agriculture, commerce, trades and manufactures.

PINCKNEY: The government should have power to establish seminaries for the promotion of literature and the arts and sciences.

MASSON: Congress should be enabled to establish a university in the place of the general government, and should possess exclusive jurisdiction over the institution. It should be specified that all persons might be admitted to the university and to its honors and emoluments, without any distinction of religion whatever.

JAMES MADISON, CONSTITUTIONAL CHAFF: REJECTED SUGGESTIONS OF THE CONSTITUTIONAL CONVENTION OF 1787, WITH EXPLANATORY ARGUMENT 64 (Jane Butzner comp., 1941).
of the committee deliberations, if made, have not survived. 97 "The matter, on its merits, apparently aroused substantially no controversy either in the Convention or among the States adopting the Constitution." 98

Madison's apologia in the Federalist is silent on time limitations:

The utility of this power will scarcely be questioned. The copyright of authors has been solemnly adjudged in Great Britain to be a right at common law. The right to useful inventions seems with equal reason to belong to the inventors. The public good fully coincides in both cases with the claims of individuals. The States cannot separately make effectual provision for either of the cases, and most of them have anticipated the decision on this point by laws passed at the insistence of Congress. 99

The referenced "insistence" of the Continental Congress, however, was not silent on the matter of time periods. The Congress recommended that the several states pass copyright legislation creating an initial term of protection of "not less than fourteen years" followed by a renewal term of "not less than fourteen years." Thus, the Continental Congress recommended a lower limit, without mentioning the desirability of an upper time limit, but clearly assumed that a time limit would be named in each statute. 100 By the time of the Consti-

97. See Fenning, supra note 95, at 443; 2 Curtis, History of the Origin, supra note 96, at 339 ("The subjects of patents for useful inventions and of copyrights of authors . . . gave rise to no discussion in the Convention, but were considered in a grand committee, with other matters, and there is no account of the views which they took of this interesting branch of the powers of Congress."); see also Capitol Records v. Mercury Records Corp., 221 F.2d 657, 667 (2d Cir. 1955) ("So far as I know, there is nothing to show what took place in the Convention.") (Hand, J., dissenting); Melville Nimmer & David Nimmer, Copyright § 1.01[A] (1994) (committee discussion was secret) [hereinafter Nimmer].

98. Fenning, supra note 95, at 443 (no authority cited). The index to Jonathan Elliot's compilation of state debates on the Constitution includes no reference to the Intellectual Property, Copyright, or Patent Clause. 1 Jonathan Elliot, Debates in the Several State Conventions on the Adoption of the Federal Constitution (1836).


100. On the report of a committee, consisting of Mr. [Hugh] Williamson, Mr. [Ralph] Izard and Mr. [James] Madison, to whom where referred sundry papers and memorials on the subject of literary property . . . being persuaded that nothing is more properly a man's own than the fruit of his study, and that the protection and security of literary property would greatly tend to encourage genius, to promote useful discoveries and to the general extension of arts and commerce, . . . [the Congress] [r]esolved [t]hat it be recommended to the several states, to secure to the authors or publishers of any new books not hitherto printed, being citizens of the United States, and to their executors, administrators and assigns, the copyright of such books for a certain time, not less than fourteen years from the first publication; and to secure to the said authors, if they shall survive the term first mentioned, and to their executors, administrators and assigns, the
tutional Convention, most of the states had passed copyright legislation. All such statutes contained express term limits.\footnote{101}

Patents in the pre-Constitution United States also seem to have been granted only for set periods of time.\footnote{102} While the Continental Congress did not request the states to create patent legislation, South Carolina’s copyright statute also granted patent rights:

\begin{quote}
And be it further enacted by the authority aforesaid, That the inventors of useful machines shall have a like exclusive privilege of making or vending their machines for the like term of fourteen years, under the same privileges and restrictions hereby granted to, and imposed on, the authors of books.\footnote{103}
\end{quote}

In other states, patents were granted individually by special acts of the legislature. While the lengths of the grants varied, all seem to have been for set periods of time.\footnote{104}

\begin{footnotesize}
copyright of such books for another term of time not less than fourteen years, such copy or exclusive right of printing, publishing and vending the same, to be secured to the original authors, or publishers, their executors, administrators and assigns, by such laws and under restrictions as to the several states may seem proper.

\begin{itemize}
  \item 24 JOURNALS OF THE CONTINENTAL CONGRESS 326-27 (1922) (emphasis added; internal footnotes and indentations omitted).
  \item 101. By 1786, all the original states except Delaware had passed copyright statutes of some kind. All contained express term limits: North Carolina had a fourteen year term, New Hampshire had 20 year term, three states had a 21 year term (Massachusetts, Rhode Island, and Virginia), and seven states had a fourteen year term followed by a renewal term of an additional fourteen years (Connecticut, Maryland, New Jersey, Pennsylvania, South Carolina, Georgia, and New York). Copyright Office, Library of Congress, Copyright Office Bulletin No. 3, Copyright Enactments: Laws Passed in the United States Since 1783 RELATING TO COPYRIGHT 1-21 (1973) [hereinafter Copyright Enactments]; see also Karl Fenning, Copyright Before the Constitution, 17 J. PAT. OFF. SOC’Y 379, 381 (1935). In 1672, without mentioning a time limit, the Massachusetts Bay Colony granted John Usher, who had printed the colonies’ laws at his own expense, the right to collect a fee from anyone else who printed copies of this work; however, the next year the grant was limited to seven years. See BRUCE W. BUGBEE, GENESIS OF AMERICAN PATENT AND COPYRIGHT LAW 65-66 (1967).
  \item 102. In discussing the historical material, the term “patent” will be used to refer to a government grant of a right to exclude others from some use of a new invention. Historically, patents meant any grant by a sovereign which was open for inspection by the public and included other revenue-generating grants, such as Pepy’s commission as an officer in the Admiralty Office. See George Ramsey, The Historical Background of Patents, 18 J. PAT. OFF. SOC’Y 6, 6-7 (1936).
  \item 103. Copyright Enactments, supra note 101, at 13.
  \item 104. 1 CURTIS, CONSTITUTIONAL HISTORY, supra note 96, at 532; see also BUGBEE, supra note 101, at 84. Early patents issued by states included a 1779 New Jersey patent granting Henry Guest, for the term of five years, “the sole Right of making and selling the Blubber by him lately invented.” id. at 85 (quoting ACTS OF THE COUNCIL & GENERAL ASSEMBLY OF THE STATE OF NEW JERSEY 103) (Peter Wilson ed., Trenton, 1784)), and a 1783 Connecticut patent lasting 14 years to Benjamin Hanks for “a Clock, which winds itself up by the effect of Air, and which will continue to do so without any other Assistance till the Component parts thereof are destroyed by Friction . . . .” Id. at 88 (quoting V PUBLIC RECORDS OF THE STATE OF CONNECTICUT 237 (Charles J. Hoadley & Leonard W. Labaree eds., Hartford, 1894)). Patents were also
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Only two scholars have suggested a reason for the constitutional phrase "limited times"\(^{105}\) that is beyond the obvious intention of eventually moving writings and discoveries into the public domain. One such scholar, William Winslow Crosskey, points out that at the time of the Constitutional Convention, English law on common-law copyright in published works was unclear. Perhaps the majority view was that perpetual common-law rights originally existed, but had been eliminated by statute. However, the statute's coverage of the American colonies was undecided. The Framers therefore gave Congress the power to create rights for "limited times" to effectively destroy any argument for the continued validity of perpetual common-law copyright entitlements. Copyright was placed in the same clause as patent to emphasize the statutory nature of the intended right; English

handled by individual acts during the colonial period. See id. at 57; see, e.g., id. at 60 (in 1641, granting one "Samu: Winslow" for 10 years the sole right to make salt "by a meanes & way wch hitherto hath not bene discovered" (quoting I RECORDS OF THE GOVERNOR & COMPANY OF MASSACHUSETTS BAY IN NEW ENGLAND 331 (Nathaniel B. Shurtleff ed., Boston, 1853-54)). Some credit this as the first patent granted in North America. See, e.g., Ramsey, supra note 102, at 12. In 1641, Massachusetts Bay adopted a general policy to grant monopolies only for new inventions and only for limited periods: "No monopolies shall be granted or allowed amongst us, but of such new Inventions yet are profitable to ye Country, & yet for a short time." BUGBEE, supra note 101, at 61 (quoting The Body of Liberties—1641; A Coppie of the Liberties of the Massachusetts Colonie in New England, reprinted in 34-35 THE COLONIAL LAWS OF MASSACHUSETTS, REPRINTED FROM THE EDITION OF 1660, WITH THE SUPPLEMENTS TO 1672 (1889). Connecticut adopted a similar anti-monopoly statute in 1672. Id. at 69 ("It is ordered; That there shall be no Monopolies granted or allowed among us, but of such new Inventions as shall be judged profitable for the Country, and that for such time as the General Court shall judge meet." (quoting THE LAWS OF CONNECTICUT: AN EXACT REPRINT OF THE ORIGINAL EDITION OF 1673 at 52 (1865)). Both these provisions were obviously based on England's Statute of Monopolies, 21 Jam. I, c. 3 (1624) (Eng.), which attempted to limit the sovereign's power to grant monopolies. See generally BUGBEE, supra note 101, at 27-43 (overview of early history of English patent policy); Elizabeth R. Foster, The Procedure of the House of Commons Against Patents and Monopolies, 1621-1624, in CONFLICT IN STUART ENGLAND 57 (William A. Aiken & Basil D. Henning eds., 1960) (political history of Statute of Monopolies). While Bugbee points out that both these colonial anti-monopoly policies were soon violated by granting monopolies to encourage investment without requiring invention, see BUGBEE, supra note 101, at 61, 70, he reports no instances of perpetual, exclusive patent grants in the colonial United States. See id. at 57-83. However, one Massachusetts Bay "patent" for a way of warming rooms with less firewood was, after an initial three year period, renewed for the life of the inventor. Id. at 64. See also Oscar Cargill & Patrick A. Moran, Copyright Duration v. The Constitution, 17 WAYNE L. REV. 917 (1971) (arguing that the then pending bill to enlarge the copyright term to the life of the author plus fifty years is unconstitutional since "life plus fifty" is not a "limited" period of time).

law was settled that monopolies based on invention were creatures of the government. Crosskey considers the Intellectual Property Clause an especially clear instance of the Constitution's repeated enumeration of specific powers for the purpose of limiting those powers. The second scholar, John F. Whicher, contributes a more detailed look at the information available in the United States at the time of the Constitutional Convention and the state ratifying conventions. While he accepts Crosskey's assertion that the clause primarily intended to limit the duration of federally creatible rights, he asserts that this limit was not intended for the states.

106. See 1 CROSSKEY, supra note 105, at 477-86. Crosskey's reading of English law seems inconsistent with Madison's in the FEDERALIST. See infra text accompanying note 100 ("The copyright of authors has been solemnly adjudged in Great Britain to be a right at Common Law. The right to useful inventions seems with equal reasons to belong to the inventors."). But, as Crosskey points out, the FEDERALIST was written for persuasion, not accuracy. See 1 CROSSKEY, supra note 105, at 406-07. But see 2 CURTIS, CONSTITUTIONAL HISTORY, supra note 96, at 38 ('[T]he writers of the Federalist . . . made a commentary on the [Constitution] so comprehensive and accurate that in after-times their view has been considered to have foreshadowed the doctrines that have been generally acted upon."). But see generally James W. Ducayet, Publius and Federalism: On the Use and Abuse of The Federalist in Constitutional Interpretation, 68 N.Y.U. L. REV. 821 (1993) (discussing various reasons for using The Federalist when interpreting the Constitution and concluding most are unconvincing). Crosskey's argument is somewhat supported by the Supreme Court's holding that the Constitution's Copyright Clause forecloses the existence of perpetual common-law copyrights. The Court relied on both the word "secure" and the acknowledged absence of common-law rights in inventions. See Wheaton v. Peters, 33 U.S. (8 Peter) 591, 660-61 (1834). But see Ramsey, supra note 102, at 15-19 (arguing that the term "secure" in the Constitution implies a preexisting "inherent" right); accord Philip H. Nicklin, Remarks on Literary Property, 4 N.Y. REV. 273, 293-94 (1839) ("The words of the article . . . expressly recognise this species of property as pre-existing, inasmuch as the object they declare is 'to secure,' and not 'to create,' for authors and inventors, 'the exclusive,' and not 'an exclusive' enjoyment of their writings and discoveries."). See generally M.E. BRADFORM, ORIGINAL INTENTIONS 133 (1993) ("But to 'secure' liberties [quoting the U.S. CONST. pmbl.] is to protect known and preexistent, historic rights."). But see Millar v. Taylor, 4 Burr. 2303, 2334, 98 Eng. Rep. 201, 218 (K.B. 1769) ("Securing for a term' would not import that there was a common-law right beyond the term: and 'vesting for a term' does not import that there is no common-law right."). Prager disagrees with Crosskey's view of patent law. Admitting total absence of case law, but suggesting existence of undetailed administrative practice of routinely granting patents in inventions, Prager asserts that both common-law copyrights and common-law patents existed in 18th century England. See Frank D. Prager, A History of Intellectual Property from 1545 to 1787, 26 J. PAT. OFF. SOC'Y 711, 740-42 (1944).

107. See 1 CROSSKEY, supra note 105, at 486-87. But see Douglas G. Baird, Bankruptcy Procedures and State-Created Rights: The Lessons of Gibbons and Marathon, 1982 SUP. CT. REV. 25, 30 (arguing that specific clauses may be clarifications of, rather than limits upon general clauses). Crosskey also argues that the Framers needed to enumerate all powers even arguably included in British royal prerogatives in order to clearly assign them to either the executive or legislative branch. Crosskey sees this listing as a clarification of the legislature's power in relation to the executive's, rather than a clarification of the national government's powers in relation to the states. See 1 CROSSKEY, supra note 105, at 409-67.

108. Whicher, Part I, supra note 105. The historical material regarding limits on the states is discussed infra Section V.
My argument is not that Crosskey is necessarily correct in his reading of the Framers’ motives. I merely point to the fact that no scholar has supplied a good argument against the facial meaning of the phrase “limited times.”

The Supreme Court has never held that the Intellectual Property Clause requires authors and inventors be granted only time-limited rights. The Court has, however, recognized this in dicta:

The limited scope of the copyright holder’s statutory monopoly, like the limited copyright duration required by the Constitution, reflects a balance of competing claims upon the public interest. . . . The immediate effect of our copyright law is to secure a fair return for an “author’s” creative labor. But the ultimate aim is, by this incentive, to stimulate artistic creativity for the general public good.109

The Court has also repeatedly stressed the limited nature of the copyright monopoly. “We have often recognized the monopoly privileges that Congress has authorized . . . are limited in nature and must serve the public good.”110 While this quote refers to statutory limitations, it relies on Feist Publications, Inc. v. Rural Telephone Service, Inc.,111 which clarified the Constitutional nature of the statutory requirement of originality.112

Similarly, the Court’s patent jurisprudence consistently mentions that “[t]he [patent] clause is both a power and a limitation”;113 “the [Patent] Clause contains both a grant of power and certain limitations upon the exercise of that power. Congress may not create patent monopolies of unlimited duration . . . .”114

The Court’s dicta on time limitations reflects its insistence that the Intellectual Property Clause be interpreted in harmony with the stated purpose of the clause. “The primary objective of copyright is not to reward the labors of authors, but ‘[t]o promote the Progress of Science and useful Arts.’ To this end, copyright assures authors the right to their original expression, but encourages others to build freely

109. Twentieth Century Music Corp. v. Aiken, 422 U.S. 151, 156 (1975) (emphasis added).
112. “Originality is a constitutional requirement. The source of Congress’ power to enact copyright laws is article I, § 8, cl. 8, of the Constitution, which authorizes Congress to ‘secur[e] for limited Times to Authors . . . . the exclusive Right to their respective Writings.’” Id. at 346.
upon the ideas and information conveyed by a work."\textsuperscript{115} The ability to freely appropriate from another's work is "the essence of copyright and a constitutional requirement."\textsuperscript{116} "The monopoly privileges that Congress may authorize are neither unlimited nor primarily designed to provide a special private benefit."\textsuperscript{117}

Unlike the Supreme Court, the Ninth Circuit has decided a case concerning the constitutional phrase "limited times" in \textit{Marx v. United States}.\textsuperscript{118} This case involved a radio script registered under the 1909 Copyright Act.\textsuperscript{119} The 1909 Act expressly allowed the author to copyright works "not reproduced for sale" if the works were registered with the federal Copyright Office. The Act expressed the copyright term as twenty-eight years from "the date of first publication," which is defined by the Act as the date on which copies were "placed on sale, sold, or publicly distributed."\textsuperscript{120}

The \textit{Marx} radio script had never been sold or distributed publicly; it had been shared only with possible performers and related radio functionaries. The alleged infringer argued that the absence of a copyright term for works neither sold nor distributed rendered protection of the work unconstitutional.\textsuperscript{121} The court, invoking the maxim that "[l]egislative enactments are to be construed, if possible, in such [a] way as to render them constitutional,"\textsuperscript{122} set a time limit congruent with the rest of the statute: twenty-eight years from the date of deposit.\textsuperscript{123}

Could "limited times" apply only to patent or only to copyright? I think not. First, the Supreme Court dicta quoted above, while not determinative, is drawn from both patent and copyright cases. Second, while Crosskey's historical reconstruction leaves open the possibility that copyright limits were more important to the Framers than patent limits, a better explanation may be that the Framers merely thought a

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\item \textsuperscript{115} Feist, 499 U.S. at 349-50 (internal citations omitted); see also Thomas B. Richards, \textit{The Value of the Copyright Clause in Construction of Copyright Law}, 2 HASTINGS CONST. L.Q. 221, 246 (1975) (suggesting the interpretation of copyright statutes to effectuate constitutional purpose of promoting science and the useful arts). \textit{But see} Burchfiel, infra note 198 at 518-24 (statements of purpose in the Constitution do not create limitations).
\item \textsuperscript{116} Feist, 499 U.S. at 349 (internal quotations and citation omitted; discussing ability to freely appropriate factual material despite labor involved in collecting such material).
\item \textsuperscript{117} Sony Corp. v. Universal City Studios, Inc., 464 U.S. 417, 429 (1984).
\item \textsuperscript{118} 96 F.2d 204 (1938). \textit{Marx} seems to be the only case to deal with the issue. \textit{See} NIMMER, supra note 97, § 1.05[B].
\item \textsuperscript{119} 17 U.S.C. § 1 (1909) (repealed 1978).
\item \textsuperscript{120} \textit{Id.} §§ 12, 24, 26.
\item \textsuperscript{121} Marx, 96 F.2d at 206.
\item \textsuperscript{122} \textit{Id.}
\item \textsuperscript{123} \textit{Id.}
"perpetual rights" claim was more likely to be raised under copyright. On the opposite side of the argument, while both Madison and Pinckney's "original" suggestions of copyright included time limits, Pinckney's "original" suggestion of patent did not.124 The Convention's finished text, however, seems to place time limits on both.

Certainly, the Intellectual Property Clause has been read in different ways, but the confusion about the Clause's meaning relates only to the distribution of "Science" and "the Useful arts." The legislative history of the 1952 Patent Act describes the clause as two provisions merged into one. The purpose of the first provision is to promote the progress of science by securing for limited times to authors the exclusive rights to their writings, the word "science" in this connection having the meaning of knowledge in general . . . .

The other provision is that Congress has the power to promote the progress of the useful arts by securing for limited times to inventors the exclusive right to their discoveries.125

The House Report accompanying the 1909 Copyright Act, however, linked copyright to both "science and the useful arts."126 Furthermore, the Patent Act of 1793127 speaks of "art or science," as does the Patent Act of 1836.128

The phrase "limited times" seems firmly linked to both sub-clauses. In fact, the science/useful arts dispute is viable only because the Intellectual Property Clause has two choices as to both the category of knowledge promoted and the category of persons being assisted. The third double in the clause, "[w]ritings" and "[d]iscoveries," is clarified by the term "respective," which specifies the relationship of these alternatives to the immediately preceding word pair. The

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124. See supra text accompanying note 97.


126. H.R. REP. NO. 2222, 60th Cong., 2d Sess. 6-7 (1909); see also Feist, 499 U.S. at 349-50 ("The primary objective of copyright is . . . to promote the Progress of Science and useful Arts."); Kenneth W. Dam, Some Economic Considerations in the Intellectual Property Protection of Software, in UNIV. OF CHICAGO SCHOOL OF LAW WORKING PAPER ON LAW AND ECONOMICS (forthcoming 1995) (manuscript at 5-7, copy on file with the Seattle University Law Review).

127. 1 Stat. 318 § 3 (patent application must include description of invention so "as to enable any person skilled in the art or science to which it appertains . . . to make . . . [the invention].") (repealed 1836).

128. 5 Stat. 117, 119 § 6 (patent application must include description of invention so "as to enable any person skilled in the art or science to which it appertains . . . to make . . . [the invention]") (repealed 1861).
remainder of the wording in the clause simply lacks alternatives: "Congress shall have the power . . . [t]o promote [a & b] by securing for limited times to [c & d] the exclusive [r]ight to [c & d's] respective [e & f]." Unless the sentence sections lacking alternatives apply to both alternatives of each category, writing the sentence in parallel construction makes no stylistic sense.

The final question to consider is the meaning of "limited times." If the term is interpreted intuitively, Congress must protect intellectual property for a set term limit, for example, a period of seventeen years. Extending the term to an "unrealistically" long time, for example, 1000 years, might be held unconstitutional as "the equivalent of perpetual protection." Intuitive interpretations, however, may merely signal that the term has not yet been challenged; lack of challenge may merely signal lack of a party with sufficient motivation to raise that challenge. A classic example of this is Tushnet's discussion of interpretations of the thirty-five year age requirement for the President. An interested presidential candidate could claim that the limit does not mean physical age, but rather the maturity level of an eighteenth-century thirty-five year-old, or age including former reincarnations.

This logic can be applied to "limited times." The intuitive interpretation for the term is a "set number of years." However, the Intellectual Property Clause is a bargain between the public on one side and authors and inventors on the other: exclusive rights for a short term in return for perpetual free use by the public after that term. If the term is equal to or greater than the period during which the res has value (economic or otherwise), has the public received its quid pro quo? Arguably a seventeen-year patent term or copyright term of the author's life plus fifty years is much longer than the economic life of the res in rapidly changing fields such as computer programming.

The above argument shortens the allowable term. What about a reading lengthening the term to practical infinity? Effective January 1, 1978, Congress set the copyright term in reference to the life of the

130. The Court approached, but did not reach, this issue in Goldstein v. California, 412 U.S. 546, 560 (1973) (states are not bound by Intellectual Property Clause, therefore perpetual protection against record piracy is not unconstitutional for lack of time limit).
131. NIMMER, supra note 97, § 1.05[A][1] at 1-44.30 n.2.
One law review article claims that life-plus terms are unconstitutional. The issue, seemingly, has never been litigated. But human lives are, after all, relatively short.

Would it be allowable for Congress to set the patent term in relation to the economic life of each individual patent? Would this change if the economic life of a particular patent seemed much longer than several human lives, perhaps longer than the above mentioned 1000 years? A patent may retain value long after the particular invention claimed ceases to be valuable when used independently. Patent involves the right to exclude others from using, manufacturing, or selling, etc. the invention. Often basic inventions are valuable because they are necessary for incorporation into more advanced technology. Consider an invention like the wheel and axle defined in broad terms: a round, physical object able to be placed on a support running through its center, the support not blocking the wheel's movement. Dependent claims could cover, for example, (1) using the wheel so that it may intersect with other wheels, other moving parts, and other non-moving items, (2) wheels with smooth outer surfaces, and (3) wheels with tooth-edged outer surfaces. As a break-through invention, the wheel would be allowed broad, exclusive

133. This means that different works receive different periods of protection. The Intellectual Property Clause, however, unlike the Bankruptcy Clause, does not require "uniform laws." Copyright Act of 1976, § 302(a), 90 Stat. 2541, 2572 ("IN GENERAL.—Copyright in a work created on or after January 1, 1978, subsists from its creation and, except as provided by the following subsections, endures for a term consisting of the life of the author and fifty years after the author's death.") (codified at 17 U.S.C. § 302(a) (1988)).

134. See Oscar Cargill & Patrick A. Moran, Copyright Duration v. The Constitution, 17 WAYNE L. REV. 917, 927-29 (1971) (arguing that life plus fifty years is not a "limited time").


136. Cf. Columbia Motor Car Co. v. C.A. Duerr & Co., 184 F. 893 (2d Cir. 1911). After long litigation, the court in Duerr limited the reach of a patent claiming [t]he combination with a road locomotive, provided with suitable running gear including a propelling wheel and steering mechanism, of a liquid hydro-carbon gas engine of the compression type, comprising one or more power cylinders, a suitable liquid-fuel receptacle, a power shaft connected with and arranged to run faster than the propelling wheel, an intermediate clutch or disconnecting device, and a suitable carriage body adapted to the conveyance of persons or goods ... .

Id. at 896. This patent, filed for in 1879 and issued in 1895, id. at 894, was originally read as "covering every modern car driven in any way by petroleum vapor and as yet commercially successful." Id. (quoting court below, no citation supplied); see generally WILLIAM GREENLEAF, MONOPOLY ON WHEELS: HENRY FORD AND THE Selden Automobile Patent (1961) (popularly written history of the patent litigation).
power.\textsuperscript{137} A corporation which owned such a patent could survive indefinitely on the license fees from, for example, any motor with a gear or any object that moved with wheels on a track or flat surface. Could Congress then set the patent term as the period during which the invention increases in usefulness or economic worth? If so, then the holder of the patent on the wheel could claim that this period had not ended until an alternative technology existed and had started taking over a large share of the wheel market. While this is arguably constitutional, I doubt it would convince a court any more than Tushnet's reincarnated guru.\textsuperscript{138}

What about tying the life of a patent or copyright to the life of a trademark? For the subset of writings and discoveries that are used as trademarks, Congress could stipulate that the patent/copyright grant be a certain percentage of the life of the mark. This would present several problems. First, trademarks usually die only when they are abandoned.\textsuperscript{139} Even when going out of business, the holder of a mark may sell it to any other firm if the holder also sells certain other firm assets.\textsuperscript{140} The "limited time" would therefore last as long as the mark-holder wished. Second, if Congress set the "limited time" at some percentage of the mark's life, the period would not be calculable until after the mark died, thus rendering such a term practically impossible. Third, tying the life of a patent or copyright to the life of a trademark may be one of the few Congressional decisions that would not pass a judicial rationality test—unless by-passing a limit in the text of the Constitution is an acceptable governmental purpose. Finally, allowing a patent or copyright term for the full life of a mark does not advance the progress of science and the useful arts because it does not result in an enlargement of the public domain.

\textsuperscript{137} See, e.g., Continental Paper Bag Co. v. Eastern Paper Bag Co., 210 U.S. 405, 415 (1908) ("It is well settled that a greater degree of liberality and a wider range of equivalents are permitted where the patent is of a pioneer character than when the invention is simply an improvement. . . .") (citation and internal quotations omitted); Westinghouse v. Boyden Power Brake Co., 170 U.S. 537, 561 (1898) ("To what liberality of construction these claims are entitled depends to a certain extent upon the character of the invention, and whether it is what is termed in ordinary parlance a 'pioneer,'"); Texas Instruments, Inc. v. United States Int'l Trade Comm'n, 805 F.2d 1558, 1562 (Fed. Cir. 1986) (the "proposition is long established" that a "basic patent on a pioneering invention is entitled to be interpreted broadly.").

\textsuperscript{138} See supra note 133 and accompanying text.


\textsuperscript{140} Congress could end patent/copyright when the mark is sold—however, a lawyer could simply restructure the sale to be a sale of the business entity holding the mark.
One could make the plain language argument that the plural “times” allows multiple time periods—with “limited” constricting each separate “time” but not the number of such limited-length time periods. The original manuscript of the Constitution shows the clause was first written to allow “a limited time,” but was later changed to read “limited times.” The suggestion that the plural “times” allows infinite grants of consecutive “limited” periods is conceivable, but strained. The Framers could have rationally chosen to bar a grant of unlimited time periods, while allowing numerous successive grants of limited time periods, when such grants are warranted by various conditions. But the Framers generally avoided that level of detail, leaving it for future legislation. Furthermore, this reading would not save the incontestability provision which gives unlimited temporal protection in one grant.

Other readings are possible. For instance, the change to “limited times” may have been intended to allow renewal terms. The change could also have been stylistic polishing for parallelism (the right is being allowed to two different sets of recipients: authors and inventors). But the modern notion of parallelism suggests that “right” should have been “rights.” Perhaps the best reading is that the change was made to clarify that the limited time granted inventors does not have to be of the same length as the limited time allowed authors. However, all these suggestions are guesses unbacked by historical evidence.

Has the clause evolved into a new meaning? I do, emphatically, believe in an “evolving Constitution,” but such evolution does not undercut the importance of temporal limits. The Court continues to

141. Ramsey, supra note 102, at 14.
142. This is Ramsey’s interpretation, for which he cites no authority. See Ramsey, supra note 102, at 14.
143. Congress has granted rights of varying lengths, and there has been no argument that this is unconstitutional. In terms of required economic incentives and social costs, the distinction seems eminently reasonable. See, e.g., Paul Goldstein, Copyright, 38 J. COPYRIGHT SOC. USA 109, 114 (1991) ("[I]t is important to separate the price consequences of the copyright property from the price consequences of the patent property . . . . Patent protection may well confer market share and effectively result in monopoly pricing . . . . [But] one author’s expression will always be substitutable for another’s."). But see Prager, supra note 106, at 740 (longer terms for copyrights are "merely a result of differential bargaining powers . . . . in the fight for intellectual property protection. Inherently, there was and is no justification for copyright terms being any longer than patent terms . . . ."); no support offered.
144. Except for renewal terms, see Ramsey, supra note 102, at 14, these guesses are the author’s own suggestions.
view eventual dedication of works to the public domain as the core purpose of the clause. Perhaps under a rigorous economic analysis the current statutorily-set time limits are too long. To make this decision we might need to quantify non-quantifiable public domain interests possessed by readers and gadget-users, not merely by later writers and inventors. Certainly we would need to integrate numerical representations of the current market into the economists' theoretical models—something neither congressional committees nor courts seem to do.

The constitutional phrase "limited times" should be interpreted to mean that Congress' exclusive grants to authors and inventors must be temporally finite.


148. The generally unsatisfactory nature of the congressional hearings on the Copyright Revision Bill underlines the importance of these conclusions [not to extend protection by time or scope]. The hearings reveal little critical analysis of industry claims that protection is needed. They show little awareness of the possible harms of extending protection. Rather, the data amassed at the hearings is unsifted, often irrelevant, fact and opinion, and many critical facts about affected industries are missing. Breyer, supra note 146, at 351. Post-eighteenth century understandings of collective action problems, see generally JOHN HART ELY, DEMOCRACY AND DISTRUST (1980), and the growing centrality of advertising in our metaphors, see, e.g., Alex Kozinski, Trademarks Unplugged, 68 N.Y.U. L. REV. 960, 972-77 (1993); Pollack, supra note 36, at 1412-19, counsel less private control of writings and inventions.

149. See also L. Ray Patterson, Copyright Overextended: A Preliminary Inquiry into the Need for a Federal Statute of Unfair Competition, 17 U. DAYTON L. REV. 385, 396-97 (1992) (asserting, without analysis, that "[t]he terms 'authors,' 'writings,' and 'limited times' are
C. **Intellectual Property Clause Limits on the Commerce Clause**

Two limited classes of incontestable marks violate the Intellectual Property Clause by creating immortal rights. While courts have alluded to possible reinforcement of the Intellectual Property Clause with the Commerce Clause, no court has suggested that Congress may by pass the “limited times” provision.\(^{151}\) Similarly, although Congress has passed intellectual property statutes by relying on the Commerce Clause, none of these statutes attempts to by pass the “limited times” provision. Additionally, commentators have discussed the intersection of the Commerce Clause with the Intellectual Property

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\(^{150}\) Nimmer raises the possibility of First Amendment limits on the Intellectual Property Clause, both on its own and combined with the Commerce Clause. See NIMMER, supra note 97, § 1.10(A); see also Jane C. Ginsburg, No “Sweat”? Copyright and Other Protection of Works of Information After Feist v. Rural Telephone, 92 COLUM. L. REV. 338, 384-87 (1992) (First Amendment implications of a statute protecting Compiled Information). I leave this fascinating problem for a later date, partially due to its complexity, but mainly to the low probability of its relevance to any trademark covered by this Article (at least under current doctrinal limits on copyrightable subject matter and issues of First Amendment concern). Despite commentators’ theories about possible conflict between copyright and the First Amendment, the Court has not recognized a problem. See Harper & Row Publishers v. Nation, 471 U.S. 539 (1985).

\(^{151}\) The absence of certain clauses from the Constitution is important when construing the extent to which Congress’ power is limited by the Constitution. Cf. Swint v. Chambers County Commission, 115 S. Ct. 1203, 1210 n.4 (1995) (relying on Congress’ choice not to adopt a suggestion to illuminate meaning of statute as enacted). During the ratification debate, several persons called for an express provision barring congressional creation of any commercial monopoly. See Letter of Thursday, January 14, 1788, in 1 BERNARD SCHWARTZ, THE BILL OF RIGHTS: A DOCUMENTARY HISTORY 510, 512 (1971) (“By sect. 8 of article I, Congress are [sic] to have the unlimited right to regulate commerce, external and internal, and may therefore create monopolies which have been universally injurious to all the subjects of the countries that have adopted them, except the monopolists themselves.”); George Mason’s Objections to the Proposed Federal Constitution, in SCHWARTZ, supra, at 444, 446 (“By requiring only a majority to make all commercial and navigation laws, the five southern states . . . will be ruined: . . . [this] will enable the merchants of the northern and eastern states . . . to monopolize the purchase of commodities . . . . ”; “[u]nder their own construction of the general clause at the end of the enumerated powers, the Congress may grant monopolies in trade and commerce . . . .”). Several commentators have taken these suggestions, even though unadopted, added the alleged clear ability of Congress to issue patents under the Commerce Clause, and concluded that Congress has no power to issue patents to stimulate commerce. “[I]t necessarily follows that a separate patent clause was included at least in part to emphasize that Congress had no power to provide for the granting of patents primarily as a stimulant to commerce.” Mary Helen Sears & Edward S. Irons, The Constitutional Standard of Invention—The Touchstone for Patent Reform, 1973 UTAH L. REV. 653, 675-76. Sears and Irons conclude that the Fifth, Ninth, Tenth, and Fourteenth Amendments combine to create a current limit on congressional power to limit people’s choices of livelihood through either the Intellectual Property or Commerce Clauses. See id. at 677-78; see also infra note 236 (discussing SCM’s reliance on this argument in *Kewanee Oil*). I am totally skeptical of silence creating such strong limits on Congress.
Clause, but none has suggested a theory that allows Congress to bypass the "limited times" provision.

1. Equivalent Rights—A Thesis

If the Copyright Clause does not limit the Commerce Clause by negative implication, Congress may do as it wishes. However, the Court's quick destruction of nonuniform laws of bankruptcy in Railway Labor Executives Ass'n v. Gibbons\(^{152}\) suggests otherwise. In Railway Labor, the central question was how to separate rules of bankruptcy from closely related rules of commerce.\(^{153}\) Applying this to the question at hand, it follows that the constitutionality of trademark incontestability turns on how to separate one aspect of commerce (trademarks) from both patents and copyrights.\(^{154}\)

The linking of Copyright Clause protection to a minimal creative spark in *Feist Publications, Inc. v. Rural Telephone Service*\(^{155}\) fired a controversy over whether a misappropriation-type statute under the Commerce Clause could protect "sweat of the brow" works such as data bases.\(^{156}\) The expected constitutional question in a Data Base

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152. 455 U.S. 457 (1982). The absence of certain clauses from the Constitution is important when construing the extent to which Congress' power is limited by the Constitution as ratified. See id. at 468-69.

153. See id. at 465-66.

154. If such marks are unconstitutional, we do not have to reach the issues of the meaning of the Lanham Act or the intent of Congress because the statute contains a clear severability clause. See 15 U.S.C. § 1051 (1988) (note) ("If any provision of this Act or the application of such provision to any person or circumstance is held invalid, the remainder of the Act shall not be affected thereby.").


156. The leading article centering on the issue is Jane C. Ginsburg, No "Sweat"?: *Copyright and Other Protection of Works of Information After Feist v. Rural Telephone*, 92 COLUM. L. REV. 338 (1992). Other relevant articles include: David O. Carson, *Copyright Protection for Factual Compilations After Feist: A Practitioner’s Views*, 17 U. DAYTON L. REV. 969, 992-94 (1992) (assuming without discussion that, "Congress could enact noncopyright legislation under the Commerce Clause to prevent misappropriation of works that are not entitled to copyright," but arguing that no action should be taken until later decisions clarify affect of Feist); Michael B. Gerdes, Comment, *Getting Beyond Constitutionally Mandated Originality as a Prerequisite for Federal Copyright Protection*, 24 ARIZ. ST. L.J. 1461, 1468 n.42, 1471-73, 1474 (1992) (arguing that Railway Labor shows only that Commerce Clause is limited by "explicit or affirmative limitations" in other clauses—originality is not explicit in the Copyright Clause; that the Lanham Act and the Court's decisions on the spending and taxing power show Congress has the power to protect "sweat of the brow" items under its choice of the Commerce Clause or the Copyright Clause; and that Feist's invocation of a constitutional need for originality is dicta in relation to all works except compilations); Paul Goldstein, *Copyright*, 38 J. COPYRIGHT SOC. USA 109, 119 (reading Feist's reference to the Trade-Mark Cases, 100 U.S. 82 (1879), as the Court's suggestion for protection of data bases under the Commerce Clause); Dennis S. Karjala, *Copyright and Misappropriation*, 17 U. DAYTON L. REV. 885 (1992) (limits of copyright protection for works should look at social harm of piracy, i.e. misappropriation, and, therefore look to the creativity,
Protection Act litigation is, therefore, how to separate copyright from commerce. Similarly, the strength of the objections to intellectual property statutes recently passed by Congress in full or partial reliance on the Commerce Clause turns on how to separate patent and copyright from commerce.

First, I must clarify why the above paragraph, following other authors' terms, is seriously incorrect and thus leads to misanalysis. When discussing the limits placed on Congress by the Constitution, we are construing the Constitution—not related areas of common or statutory law.

The Intellectual Property Clause, containing the Copyright and Patent Clauses, mentions neither the word "patent" nor the word "copyright." It allows Congress to grant "exclusive rights" in "writings" and "discoveries" to their "authors" and "inventors" in order to "promote science and the useful arts." At the time the Constitution was written, England had legal rights, well known to the Framers, called patents and copyrights. The only logical conclusion from the Framers' choice not to use these words is that they did not want to tie the Clause to the technical meaning of "patent" and "copyright." The non-use of "patent" and "copyright" by the

skill, and effort involved in the work's fixation) (Feist should be read narrowly): Philip H. Miller, Note, Life After Feist: The First Amendment and the Copyright Status of Automated Databases, 60 FORDHAM L. REV. 507, 526, 536-38 & nn. 180-95 (1991) (suggesting, without real analysis of limits on the Commerce Clause, that Congress use it as authority to protect automated data bases); Patterson, supra note 149, at 407-10 (arguing that protection of low-authorship works under copyright is an historically-driven error and recommending a trade regulation statute under the Commerce Clause be substituted; reading Feist's subject as the Copyright Act, not the Copyright Clause); Leo J. Raskind, Assessing the Impact of Feist, 17 U. DAYTON L. REV. 331, 332 (1992) ("To the extent that Feist results in lesser copyright protection for compilations of data . . . . [it] is likely that there will be active consideration given to state and federal legislation establishing some version of misappropriation principles for the protection of data bases"); no discussion of constitutional limits of such legislation).

158. See infra Section IV.C.3.
160. This, of course, does not mean such related matters may not be considered.
161. Accord Fenning, supra note 95, at 445 (Constitution does not use the words: "possibly lest the power be limited to the particular forms . . . at that time known as copyrights and patents."); Tom Arnold, A Philosophy on the Protections Afforded by Patent, Trademark, Copyright and Unfair Competition Law: The Sources and Nature of Product Simulation Law, 54 TRADEMARK REP. 413, 418 (1964) (pre-Constitution, states often required that an invention be put to public use or a book be printed in sufficient supply at a fair price to maintain patent or copyright; Constitution probably left out words "patent" and "copyright" to prevent implication these were required); cf. Benjamin Kaplan, Performer's Right and Copyright: The Capitol Record Case, 69 HARV. L. REV. 409, 423 (1956) ("Yet even in 1787 lawyers were familiar with the importance
Framers means that similarity to statutory copyrights and patents is not the test for the constitutionality of Commerce Clause-based rights in intellectual property. Instead, suspect provisions must be compared to "exclusive rights" over "writings and discoveries" given to "authors and inventors" for "limited times" in order to "promote the progress of science and the useful arts." 162

For simplicity, I will call the prerogatives that the Constitution allows Congress to create (as opposed to the actual ones Congress has created through statute) "authors' exclusive rights," (AER's) and "inventors' exclusive rights," (IER's).

Something very like an AER or IER with one element missing is, most probably, not allowable, much as a nonuniform law having the other attributes of a bankruptcy law is not allowable. The more difficult question is whether Congress may protect something where one, some, or all of the elements are slightly below the minimum set by constitutional description. Determining likeness will involve a separation of the limits imposed by the Clause from the description of the res involved in the Clause. Do we look at exclusive rights in writings and discoveries to insure that each (a) promotes science and the useful arts, (b) is given to authors and inventors, and (c) is for limited times? Or, in the alternative, do we look at actions intended to promote science and the useful arts to make sure that they are (a) exclusive, (b) granted only for writings and discoveries, and (c) are granted only to authors or inventors? Is the identity of the relevant definitional term context dependent? 163

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of publication in copyright law, and the failure to use the term [publication] in the copyright clause may indicate that no distinction was intended for constitutional purposes between published and unpublished works."). In the case of patent, failure to use the word "patent" may be a choice not to bar other forms of government grants including monopolies. But see Flynn, supra note 159, at 414 n.81 ("Although unnecessary to the analysis of . . . this Article, it is submitted that from an historical point of view, . . . the Commerce Clause and the Patent Clause should be read together as establishing an implicit policy of precluding the federal government from granting private parties unregulated and exclusive monopolies over economic activity other than that authorized by the Patent Clause."). Flynn incorrectly ignores the Framers' choice not to pattern the Intellectual Property Clause after the existing British Statute of Monopolies. See supra note 104 (discussing British Statute of Monopolies).

162. But see Patterson, supra note 149, at 397 (asserting that the Copyright Clause and the Statute of Anne, the English Copyright Act, have the same basic content expressed in different language; and, also, that the word changes were made only to allow one constitutional clause to cover inventions and writings).

163. To clarify my interpretation of the Intellectual Property Clause and illustrate the power of the AER-IER/copyright-patent distinction, consider the post-Feist controversy on the constitutionality of a federal data base misappropriation act. I agree with Jane Ginsburg's conclusion that a statute under the Commerce Clause would be constitutional if "the protective law departs in significant ways from the copyright model," provided it also allowed the free-riding
Courts make a standard distinction between trademarks and AERs. Federal trademark law protects "distinctive words, [product shapes,] and symbols against copying, but only to the extent that the copying or imitation is likely to cause confusion as to the source or sponsorship of the goods or services, or constitutes a false representation."164 Objects protected as AERs "may be deserving of copyright . . . . Their entitlement to trademark recognition, however, depends not on their eye appeal but on their characteristic of identifying the manufacturer."165 The purpose behind the protection of a trademark is to prevent fraud, not to promote science and the useful arts. Trademark protection is clearly allowable, especially as trademark requires neither an author nor a res with a minimum spark of originality.166

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166. Accord McCarthy, supra note 22, § 6.04[2], at 6-26 ("[E]xpiration of the copyright does not bar a claim for trademark or trade dress. Whether or not a feature claimed as trademark or trade dress is also copyrightable is irrelevant.") (footnotes citing cases omitted); cf. In re Yardley, 493 F.2d 1389 (C.C.P.A. 1974) (design patent available on copyrighted res). This analysis replaced a simplistic view that trademark use of a formerly patented design was an illicit attempt to stretch the patent monopoly. For a history of the change, see Douglas R. Wolf, The Doctrine of Elections: Has the Need to Choose Been Lost?, 9 CARDOZO ARTS & ENT. L.J. 439, 441-58 (1991). The Copyright Office, oddly, refuses to issue copyright registration "in a patented design or in the drawings or photographs in a patent application . . . after the patent has been issued," even though "[t]he potential availability of protection under the design patent law will not affect . . . registrability." 37 C.F.R. § 202.10(a) (1993). Similarly, "[a] claim to copyright in a scientific or technical drawing [may be registered even if it is] part of a pending patent application." But copyright registration will be denied "[w]here the patent has been issued." Id.
Trademarks that are not functional have a similar relationship to IERs. Trademarks do not have the non-obviousness of "discoveries"; they are not originated by "inventors." Furthermore, the companies using the trademarks may not have created them; therefore, no rights are given to "inventors." Their purpose is to prevent fraud in the market place, not to advance science and the useful arts. While trademarks do grant exclusive rights, their immortality does not violate the Patent Clause.

Now consider the distinct case of an incontestable, functional trademark. As discussed above, the judicially created functionality doctrine bars protection of a useful element as a trademark because courts consider such protection an illegitimate attempt to by-pass the "limited time" and high creativity requirements of patent. Comparing a trademark which is functional to an IER, we have two different possibilities: (1) the mark is below the non-obviousness and novelty standards of patent creativity; or (2) the mark reaches the standard of patent creativity.

In the first case, the mark (a) hurts the progress of science and the useful arts by preventing sharing of a minor building block for other changes, (b) has an originator who is not quite an inventor, but the originator may not be related to the commercial entity using the mark, (c) protects a useful item, for example, one alike to but not quite creative enough to be an invention, (d) provides an exclusive right, and (e) exists for a potentially unlimited time. While debatable, this protection seems too close to the rights allowed by the Intellectual Property Clause to be constitutional.

An even stronger case can be made against an incontestable, functional mark that reaches the standard of patent creativity. This mark (a) hurts the progress of science and the useful arts by giving a permanent monopoly, (b) has an inventor (though the mark may not belong to him), (c) is a discovery, (d) grants exclusive rights, and (e) provides rights that are potentially immortal. This is clearly unconstitutional.

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§ 202.10(b). A trademark on a print or label will not bar copyright registration. Id. § 202.10(c); see also Parfums Givenchy, Inc. v. C & C Beauty Sales, Inc., 832 F. Supp. 1378, 1391 (C.D. Cal. 1993) (trademarked label may be copyrighted). No court has ruled on the validity of these regulations barring registration. See Wolf, supra, at 469 & n.196 (relying on letter from Copyright Office). The Copyright Office claims policy and case law reasons for the rule, not constitutional ones. See id. at 463-470.

167. See supra Section III.B., Functionality.

168. It also seems to be a bad policy choice. However, Congress may constitutionally make bad, but not irrational, policy choices.
Incontestability is unconstitutional to the extent it protects functional trademarks. Therefore, functionality must be an available defense to an incontestable mark; functionality must be sufficient cause to cancel the registration of an incontestable mark. 169 The PTO's policy of refusing to register functional features as trademarks does not negate this conclusion. 170 After all, the PTO can make mistakes. 171

The patent-based restriction on functional marks is parallel to the copyright-based restriction on merely descriptive marks. 172

A 'merely descriptive' mark . . . describes the qualities or characteristics of a good or service, . . . this type of mark may be registered only if the registrant shows that it has acquired secondary meaning, i.e., it "has become distinctive of the applicant's goods in commerce." 173

In infringement cases involving non-incontestable marks, the defendant wins if he shows that the mark is merely descriptive and has not acquired secondary meaning. 174 The Supreme Court, however, construes the Lanham Act to bar mere descriptiveness as a defense to infringement of an incontestable mark. 175 In cases involving incontestable marks, the subject of secondary meaning is never litigated even if the mark is merely descriptive. This largely reduces the test for trademark infringement of incontestable marks to similarity between


170. TMEP, supra note 40, § 1202.03.

171. If the PTO mistakenly registered the mark or mistakenly acknowledged the mark as incontestable because of the registrant's fraud, the fraud would be a distinct defense to alleged infringement of an incontestable mark. See 15 U.S.C. § 1115(b)(1) (1988). But not all PTO errors require fraud. For example, neither the opinion of the district court nor of the court of appeals in Shakespeare discusses possible fraud on the PTO. But see Petition for Writ of Certiorari at 5, Silstar Corp. v. Shakespeare, Inc., 114 S. Ct. 2134 (1994) (No. 93-1568) (implying some type of misconduct in Statement of the Case, though not arguing fraud in the petition) ("Failing to disclose to the Trademark and Patent Office that the clear tip was the natural appearance produced by its manufacturing process, Shakespeare was allowed to register as a trademark such clear tip portion of a fishing rod.").

172. This Article assumes that IER's should be conceptualized as akin to utility patents. Design patents protect non-useful design features which reach the patent level of creativity. 35 U.S.C. § 171 (1988). Such a design seems incapable of being merely descriptive in trademark terminology. If such a patented design did exist, it would share the constitutional problem of a merely descriptive, copyrightable trademark.

173. Park N' Fly, 469 U.S. at 194 (quoting U.S.C. §§ 1052(e), (f)).

174. See Mccarthy, supra note 22, § 15.01[2], at 15-5.

175. Park N' Fly, 469 U.S. at 205.
the junior and the senior users' marks. Fraud in the marketplace, however, is only possible if the mark is tied in the consumer's mind to both the junior and the senior user: "[S]imilarity, even identity, is not enough if [the senior user] ha[s] no interest in the words and the graphic that entitled him [or her] to restrict their use."176 Thus, if an incontestable mark is copyrightable subject matter177 and merely descriptive, the trademark holder has exclusive, temporally unlimited rights, even though the mark does not serve the purpose of preventing confusion and fraud in the marketplace. This is unconstitutional.

The possible rarity of such trademarks does not change the analysis. Names, single words, and slogans are not copyrightable,178 but the problem could presumably arise with merely descriptive picture-marks or product configurations.

This AER argument suggests a possible flaw in my IER argument. Why is a functional, incontestable trademark unacceptable without the additional flaw of mere descriptiveness? If the functional mark serves the non-patent purpose of preventing fraud in the marketplace, why isn't this enough to insulate it from the Patent Clause? The distinction would be easier to make if this were a statutory179 or policy argument—the monopoly dangers are much greater for functional features. However, the policy argument is embedded in the constitutional clause: "[t]o promote the Progress of Science and the useful Arts." Even though a functional trademark may


177. Presumably this will be something other than a word mark since single words, phrases, and slogans are not currently considered copyrightable. See, e.g., The Trade-mark Cases, 100 U.S. 82, 93-94 (1879) (commonly, trademarks consist of material lacking the originality required for either copyright or patent); Takeall v. PepsiCo, Inc., 29 U.S.P.Q.2d 1913, 1918 (4th Cir. 1993) ("[T]he disputed phrase [You got the right one, uh-huh] fails to evince the requisite degree of originality to entitle it to copyright protection and is a short expression of the sort that courts have uniformly held uncopyrightable."). cert. denied, 114 S. Ct. 2742 (1994); see generally MCCARTHY, supra note 22, § 6.05[1][b] (copyrightability of short word marks) (3rd ed. 1992). But see Tin Pan Apple Inc. v. Miller Brewing Co., 30 U.S.P.Q.2d 1791 (S.D.N.Y. 1994) (denying summary judgment) ("A jury could find that the Hugga-Hugga and Brr sounds, used as lyrics, are sufficiently creative to warrant copyright protection.").

178. 37 C.F.R. § 202.01(a); LIBRARY OF CONGRESS, COPYRIGHT OFFICE, COMpendium II: COMPENDIUM OF COPYRIGHT OFFICE PRACTICE § 202.2(i) (1984) [hereinafter CompendIum II]. As with most legal generalities, some exceptions exist. See generally, MCCARTHY, supra note 22, § 6.05[1][b] (copyrightability of short phrases).

179. The PTO defines de jure functional marks to not function as marks. It does so without regard to whether consumers recognize the functional feature as an indication of source. See TMEP, supra note 40, § 1202.03(a)(i)(C) ("A showing of acquired distinctiveness is irrelevant with regard to a design that is de jure functional," citing In re Deister Concentrator Co., 289 F.2d 496, 503 (C.C.P.A. 1961)).
prevent fraud in the market place, other fraud-prevention means must be sought because the price of this one is too high. Creating an immortal, exclusive right in an invention (or functional feature which is not creative enough to be an invention) retards the progress of the useful arts. Writings, however, like copyrighted res, seem to include only expressions, not ideas. The constitutional problem is acute enough to warrant a reading of the Lanham Act that avoids the problem.

This thesis also fails if trademarks do not grant exclusive rights. However, trademark does seem to provide exclusivity for the limited items it covers. Trademarks are not public goods like the "writings" and "discoveries" targeted by copyrights and patents; trademarks perform their function of cutting consumer search costs for desired products only if each mark is used by only one seller per market. Trademark protects elements that are visible to actors in the marketplace and does not apply to patentable hidden uses, such as processes, or product aspects invisible to a user. As to the items it covers, trademark grants an exclusive right, barring all uses "likely to cause confusion, or to cause mistake, or to deceive."

180. See Feist, 499 U.S. at 345; 17 U.S.C. § 102(b) (1988) ("In no case does copyright protection for an original work of authorship extend to any idea, 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.").


182. See, e.g., Patterson, supra note 149, at 398 (arguing that the exclusive right the Copyright Clause permits Congress to grant to author is "only the right to publish their writings [in print media]"; suggesting no definition of "exclusive rights" as applied to inventors); see also id. at 401-03 (arguing that the Copyright Clause gave Congress the power to grant only the limited rights covered by the Statute of Anne (the exclusive right to publish copies for a limited time period starting at first publication), but not the perpetual common law right of first publication).

183. Landes & Posner, supra note 17, at 269-70.

184. 15 U.S.C. § 1127 (1988 & Supp. IV 1992) (trademark defined as something "use[d] in commerce . . . to identify and distinguish his or her goods . . . from those manufactured or sold by others").


2. Court Statements

Despite some interesting dicta, no court has analyzed the power of the Commerce Clause to cover limitations in the Intellectual Property Clause. Neither has a court suggested that the Commerce Clause allows immortal rights equivalent to AERs or IERs.187

Judge Learned Hand, after holding a patent invalid, offered a general discourse on the merits of the patent system. He speculated that if a statute grants patents to investors, as opposed to inventors, and is outside the Patent Clause, "perhaps it could, like the trademark statute, be based on the interstate commerce clause."188 A later panel of the Second Circuit decided not to consider whether "Congress could grant monopolies for non-useful and non-original material if Congress based its authority to do so on the constitutional interstate commerce power" because "Congress ha[d] not so acted."189 After finding that federal copyright law preempted state law, the California Supreme Court asserted, "[i]t is clear . . . that Congress has the power to protect literary titles under either the Copyright or Commerce clauses of the United States Constitution and has simply elected not to do so."190

One circuit held that the Commerce Clause is sufficient authority for part of the Copyright Act. That case, however, is not helpful. Until July 1, 1986, the "manufacturing clause" of the Copyright Act barred importation of certain types of otherwise copyrightable English-language works unless the works were printed in the United States or

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187. Looking at the mirror issue, "[b]y virtue of the explicit constitutional grant [the Copyright Clause], Congress has the unquestioned authority to penalize directly the distribution of goods that infringe copyright, whether or not those goods affect interstate commerce." Dowling v. United States, 473 U.S. 207, 220 (1985) (holding in dicta that the National Stolen Property Act does not cover interstate transportation of phonorecords "stolen, converted or taken by fraud," 18 U.S.C. § 2314 (1988 & Supp. II 1990), only in the sense that they were made without the copyright holder's authorization).

188. Picard v. United Aircraft Corp., 128 F.2d 632, 643 n.22 (2d Cir.), cert. denied, 317 U.S. 651 (1942). Since patents are readily assignable, this limitation is hardly onerous. See 35 U.S.C. § 118 (1988) ("Whenever an inventor refuses to execute an application for patent, or cannot be found . . . , a person to whom the inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter . . . may make application for patent on behalf of and as agent for the inventor . . . ."). Cf. 17 U.S.C. § 201(b) (1988) ("In the case of a work made for hire, the employer . . . is considered the author for the purposes of this title . . ."). But c.f. Monore Price & Malla Pollack, The Author in Copyright, 10 CARDOZO ARTS & ENT. L. J. 703, 710 n.27 (1992) (raising issue of animal or computer authors). Furthermore, even when the inventor signs the application, he may have already assigned the rights. See, e.g., Diamond v. Chakrabarty, 447 U.S. 303, 305 (1980) (microbiologist filed a patent application for rights assigned to the General Electric Co.).

189. Chamberlin v. Uris Sales Corp., 150 F.2d 512, 513 n.2 (2d Cir. 1945).

190. Tomlin v. Walt Disney Prods., 96 Cal. Rptr. 118, 121 (1971).
A writers’ association sued for a declaratory judgment that the clause was unconstitutional because protection of the domestic printing industry is only tenuously related to the stated purposes of the Copyright Clause. The court did not reach the breadth of the Copyright Clause, but rather, held that the Commerce Clause gave Congress power to restrict imports in order to foster the growth of a domestic industry. This conclusion rests on one core purpose of the Commerce Clause; it does not attempt to use the Commerce Clause to by pass limits on AERs and IERs.

3. Congress’ Actions

The idea of using the Commerce Clause to expand Congressional power over intellectual property is not new. The Court alludes to this power as early as the *Trade-Mark Cases* in 1879. Congress eventually followed the Court’s suggestion by linking the Lanham Act, the federal trademark statute, to “all commerce which may lawfully be regulated by Congress.”

Perhaps in an excess of caution, Congress has rested several pieces of intellectual property legislation, at least in part, on the Commerce Clause. None of these, however, suggest Congress believes that

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192. Authors League of America, Inc. v. Oman, 790 F.2d 220, 224 (1986) (other constitutional arguments were also raised and rejected).

193. Id.

194. 100 U.S. 82, 93-94, 98-99 (1879) (holding that Congress cannot regulate trademarks under the Intellectual Property Clause since they are not “the fruits of intellectual labor,” and holding that Congress may be able to regulate trade-marks under the Commerce Clause but must limit statute to exclude marks used only in commerce between citizens of the same state).


Congress also relied on multiple constitutional authorities when eliminating the states’ sovereign immunity to infringement of various types of intellectual property. This seems fueled by Atascadero State Hospital v. Scanlan, 473 U.S. 234 (1985) (requiring super-plain-meaning in such pronouncements), rather than an attempt to by pass the Intellectual Property Clause. The Copyright Remedy Clarification Act, Pub. L. 101-553, 104 Stat. 2749 (1990) (which dealt with remedies for both classic copyright infringement and infringement of mask works), mentioned the
by legislating under the Commerce Clause, it can by pass the "limited [t]imes" provision of the Intellectual Property Clause. No court has yet ruled on the constitutionality of federal intellectual property legislation under the Commerce Clause.197 While several authors have argued the constitutionality or constitutional basis of Congressional action in this field under the Commerce Clause, no one has raised any argument undermining the Intellectual Property Clause time limit requirement.198


In addition, many intellectual property-related industries are routinely regulated under the Commerce Clause, for example, broadcast communications. See, e.g., Communications Act of 1934, § 1, Pub. L. 73-416, 48 Stat. 1064 (1934) (codified as amended Title 47 U.S.C.) ("For the purpose of regulating interstate and foreign commerce in communication by wire and radio . . . .").

197. Search of WESTLAW, Allfeds library (April 28, 1994 and April 3, 1995) ("ODR", "PLANT VARIETY" "PLANT PATENT" "SEMICONDUCTOR CHIP") /P (CONSTITUTION! UNCONSTITUTION!) retrieved 17 cases, none on point. The only case remotely on point was Yoder Bros. v. California-Florida Plant Corp., 537 F. 2d 1347, 1382 n.40 (5th Cir. 1976) (regarding patentability of recurring sports) ("We do not regard this argument as one attacking the constitutionality of the Plant Patent Act; rather it simply inquires how broadly the Act can be read consistent with the Constitution."). Search of WESTLAW, Allfeds library (Apr. 29, 1994 and April 3, 1995) ("DRUG PRICE COMPETITION" "PATENT TERM RESTORATION" 98-417) /P (CONSTITUTION! UNCONSTITUTION!) & DATE(AFTER 1983) retrieved no cases. Search of WESTLAW, Allfeds library (May 6, 1994 and April 3, 1995) ((animal veterinarian) /s (drug patent)) /p (constitution! unconstitutional!) & date(after 1987) retrieved none on point. No cases on Pub L. 100-670 address its constitutionality.


Regarding the Orphan Drug Act (hereinafter "ODA"), John J. Flynn, The Orphan Drug Act: An Unconstitutional Exercise of the Patent Power, 1992 UTAH L. REV. 389 (1992), attacks the ODA as an unconstitutional by pass of the Patent Clause. He claims that the ODA grants a "seven year exclusive marketing right for drugs to treat orphan diseases [which has] all the earmarks of the creation of a patent right" yet ignores several express limitations in the Patent Clause. The ODA allegedly (a) fails to advance the Progress of Science and the Useful Arts, (b) fails to limit rights to inventors, and (c) fails to limit rights to discoveries. Id. at 404-06. As originally passed, because it was limited to unpatentable drugs and granted benefits to drug companies. Flynn is clearly correct regarding points (b) and (c). The validity of point (a)
V. CONSTITUTIONAL LIMITS ON THE STATES? SUGGESTING CONSTITUTIONAL/STATUTORY PREEMPTION

If the federal government is constitutionally prevented from granting temporally unlimited intellectual property rights, can the states offer rights that Congress may not? This question presents two issues: (1) direct constitutional limits on the states, and (2) statutory preemption (indirect constitutional limits through the Supremacy Clause). I defer to the multitudinous articles already written on

depends on whether the Patent Clause should help advance only useful knowledge, or additionally reaches improvements in the availability of that knowledge's benefits to additional users. Either is arguable; the history of the clause is obviously unclear. One suggestion classified as an unadopted alternative to the Intellectual Property Clause is a governmental power "to establish . . . rewards and immunities for the promotion of agriculture, commerce, trades, and manufactures." JAMES MADISON, CONSTITUTIONAL CHAFF, supra note 96, at 64. This targets use of knowledge, but it was not adopted. Court dicta suggests that use of knowledge is relevant:

The authority of Congress [in enacting patent statutes] is exercised in the hope that the productive effort thereby fostered will have a positive effect on society through the introduction of new products and processes of manufacture into the economy, and the emanations by way of increased employment and better lives for our citizens. Diamond v. Chakrabarty, 447 U.S. 303, 307 (1979) (citing Kewanee Oil v. Bicron Corp., 416 U.S. 470, 480 (1974)).

The ODA, therefore, is close, but just misses fulfilling two (or three) requirements of the Patent Clause. This is certainly reason for suspicion. It does grant rights only for limited times—matching a fourth requirement. However, while the issue is close, I think the benefit created by the ODA is too remote from an IER to offend the Patent Clause; I would not classify it as exclusive. The "exclusivity" granted the drug company that adopts an orphan drug is limited in two ways: (1) it deals only with sales of the drug for use to treat a specific disease, and (2) it is conditioned on the company's fulfilling the public demand for the good. 21 U.S.C. § 360cc (1988).


Robert M. Patti, Section 202 of the Drug Price Competition and Patent Term Restoration Act—Has Congress Acted Constitutionally?, 69 J. PAT. & TRADEMARK OFF. SOC'Y 567, 567 (1987), denounces Section 202 as an unconstitutional diminution of patent rights. This section redefines patent infringement to allow generic drug companies to import and use otherwise infringing generic drugs for the sole purpose of obtaining FDA marketing approval so that they may compete with patent-holders as soon as the patents expire. This is, however, a mere partisan reading of statutory terms into the more sparse language of the Constitution.
statutory preemption.\textsuperscript{199} I suggest, instead, that state protection of intellectual property rights is otherwise constitutionally barred. Four slightly different theories support this conclusion. In roughly descending order of analytic rigor, they are: (1) statutory/constitutional preemption created by the Intellectual Property Clause in combination with any federal legislation under that Clause prevents state action in this realm, (2) constitutional preemption by the Intellectual Property Clause itself prevents state regulation, (3) a dormant Intellectual Property Clause prevents state intellectual property regulation, and (4) the intersection of the Intellectual Property Clause and the dormant Commerce Clause prevents such state regulation. For simplicity, (at least initially) I will refer to these theories en mass as the "dormant Intellectual Property Clause."

The Intellectual Property Clause does not mention the states. Nor does it declare congressional power to be exclusive or tied to nationally uniform laws.\textsuperscript{200} No constitutional clause expressly prohibits state legislation over intellectual property.\textsuperscript{201} Curtis asserts that the power to legislate on intellectual property was "surrendered by the states to the general government," but his only basis for this argument is the states' pre-Constitution legislation on the subject\textsuperscript{202}—hardly determinative. After all, "[t]he powers not delegated to the United States by the Constitution, nor prohibited by it to the States, are reserved to the States respectively, or to the people."\textsuperscript{203}

Furthermore, some authority exists for the proposition that the Intellectual Property Clause was intended, or originally considered, to be a non-exclusive grant to Congress. The Intellectual Property Clause gives Congress "power," not "the power," to promote science and the useful arts by granting exclusive rights—even though "the" had appeared in earlier drafts.\textsuperscript{204} Tucker's 1803 edition of Black-

\textsuperscript{199} See, e.g., Howard B. Abrams, Copyright, Misappropriation, and Preemption: Constitutional and Statutory Limits of State Law Protection, 1983 SUP. CT. REV. 509. However, if Congress intended to allow unlimited life to functional marks, this intent might undermine any argument that Congress' intentions would be thwarted by such state grants after Congress' actions were invalidated.

\textsuperscript{200} See U.S. CONST. art. I, § 8, cl. 17 ("The Congress shall have power . . . To exercise exclusive Legislation in all Cases whatsoever, over . . . the Seat of the Government of the United States . . . ") and U.S. CONST. art. I, § 8, cl. 4 ("To establish an uniform Rule of Naturalization, and uniform Laws on the subject of Bankruptcies throughout the United States.").

\textsuperscript{201} See U.S. CONST. art. I, § 10, cl. 1 ("No State shall enter into any Treaty . . . ").

\textsuperscript{202} 1 CURTIS, CONSTITUTIONAL HISTORY, supra note 96, at 532; see also 2 CURTIS, HISTORY OF THE ORIGIN, supra note 96, at 339.

\textsuperscript{203} U.S. CONST. amend. X.

\textsuperscript{204} The argument that the Intellectual Property Clause is a non-exclusive grant was made to the Supreme Court in Gibbons v. Ogden, 22 U.S. (9 Wheat.) 1, 85-87 (1824) (remarks of
stone's Commentaries, with comments about the new United States Constitution, listed intellectual property as a possibly concurrent power. At least two "Framers" apparently did not see state grants as prohibited by the Constitution. Furthermore, the Federalists argued to numerous state ratifying conventions that no implied powers existed in the proposed federal government. This is an important point if the binding "original intent" is that of the ratifiers of the Constitution.

Despite evidence to the contrary, Nicklin argues that the grant to the federal government is, indeed, exclusive. He rests his argument on the nature of the grant which, he asserts, meets Hamilton's test of being "necessarily exclusive ... from the nature of the grant." His exposition is, however, more confusing than persuasive. Nicklin's dated analysis ignores the possibility of powers that

attorney for respondent). The Court did not rule on the Intellectual Property Clause in Gibbons. See infra note 227. Justice Johnson declared the article irrelevant in the Commerce Clause. See Gibbons, 22 U.S. (9 Wheat.) at 226 ("It is not material, in my view of the subject, to inquire whether the article a or the should be prefixed to the word 'power.'").

205. See 1 BLACKSTONE'S COMMENTARIES: WITH NOTES OF REFERENCE TO THE CONSTITUTION AND LAWS OF THE FEDERAL GOVERNMENT OF THE UNITED STATES, app. Note D, View of the Constitution of the United States 265 (St. George Tucker ed., 1803) ("This is another branch of federal authority, in which I presume the states may possess some degree of concurrent right within their respective territories . . . .").

206. Mr. Jay and Chief Justice Lansing, as members of the New York Council of Revision, were involved with one of the series of state grants of the exclusive right to use steam-driven boats to navigate New York State waters that triggered Gibbons v. Ogden, 22 U.S. (9 Wheat.) 1 (1824). Both men objected to the grant—but on policy, not constitutional, grounds. See id. at 80 (remarks of attorney for respondent). However, this was before other states acted in retaliation, see id. at 17 (remarks of attorney for petitioner), and the grant in question was not premised on invention, see, e.g., id. at 58, 142 (remarks of attorney for respondent), though the U.S. Attorney considered this a subterfuge. See id. at 173-74. At the time the Supreme Court heard argument in Gibbons, no federal patent had been issued on a steam boat. See id. at 84 (remarks of attorney for respondent). Lansing had been at the Constitutional Convention. See PRESCOTT, supra note 96, at 20-22. While Jay did not attend the convention, see id., he was one of the authors of the FEDERALIST PAPERS. See FEDERALIST Nos. 2-5, 64 (E.H. Scott ed. 1894).

208. Nicklin, supra note 106, at 276-79.
209. THE FEDERALIST NO. 32, at 169 (Alexander Hamilton) (E.H. Scott ed., 1894) ("This exclusive delegation or rather this alienation of State sovereignty, would only exist in three cases; where the Constitution in express terms granted an exclusive authority to the Union; where it granted in one instance an authority to the Union and in another prohibited the States from exercising the like authority; and where it granted an authority to the Union, to which a similar authority in the States would be absolutely and totally contradictory and repugnant.").

210. The [Constitution says] that [C]ongress shall have power to secure the exclusive right of authors and inventors "for limited times." Now, if a state have [sic] a concurrent power with [C]ongress over the subject, it must be a power arising from the unceded portion of its sovereignty, and, consequently, a power to grant without limit of
time. But how could [C]ongress secure to the author or inventor, for a limited time, the enjoyment of that which a state might grant to another forever.

It was said, indeed, by one of the most able judges that ever sat in our state courts, that if an author or inventor, instead of resorting to the act of [C]ongress, should apply to the state legislature for an exclusive right to his production, there is nothing to prevent the state from granting such exclusive privilege, provided it be confined, in its exercise, to the particular jurisdiction." . . . [If] [this] opinion be correct, one, of two things, must follow—either that [C]ongress may secure to an author or inventor an exclusive right to his writing or discovery, and a state, following so far the example of [C]ongress, as to regard commentators, or even interpolators, as authors, within the statute, secure to another person the exclusive right to publish the same production, within its own jurisdiction; or that [C]ongress cannot secure such right to the former, after the state has secured it to the latter. In the first conclusion, this consequence seems to be involved, that [C]ongress may grant an exclusive right to one person, to the use or benefit of a certain thing, throughout the union, and that a state may grant to another an exclusive right to the use and benefit of the same thing, within its particular jurisdiction; in other words, that over the same subjects, and within the same jurisdiction, two co-ordinate powers may grant exclusive privileges to different persons! The other branch of the dilemma, supposes the individual state to derogate, by an assumption of power, from the express terms of its grant to the general government, and actually to exercise an exclusive power to secure privileges, in direct contradiction to the terms of the power ceded to [C]ongress. Nor does it . . . obviate this repugnancy, to say, that "when these separate powers come into direct conflict, the grant of the state must yield to the supreme law of the land"—because the repugnance is, from the nature of the subject . . . directly deducible from the propositions themselves, and not from any casual effects or consequences arising from the accidental collision of concurrent jurisdictions.

The power in question is moreover exclusive, from the nature of the grant; because if each state [has] a concurrent power with [C]ongress, its exercise would defeat the two-fold object, for which the federal [C]onstitution intended to provide. That object . . . was to secure to the public the benefit and transmission of inventions, as well as to secure to genius a reward for its productions and discoveries. But if the individual states have a concurrent power with [C]ongress, neither branch of this double object can be secured by the federal legislature. For, if to secure the first, [C]ongress prescribe twenty-eight years as the limit of exclusive rights, and render them common at the expiration of that period, each state might fix a different period, or secure a right of property to authors and inventors without any limitation of time. Nor could the second branch of the object be secured by [C]ongress, if the states could exercise a concurrent power, because each state might, on that supposition, reduce the term of exclusive enjoyment to a minimum, or declare the fruits of genius and learning to be common property.

Nicklin, supra note 106, at 277-79.

Nicklin’s quote from “one of the most able judges” refers to Chief Justice Kent’s opinion in Livingston v. Van Ingen, 9 Johns. 507, 580-81 (N.Y. Ch. 1811) (Kent, C.J.), aff’d sub nom., Gibbons v. Ogden, 17 Johns. 488 (N.Y. 1820), rev’d, 22 U.S. (9 Wheat.) 1 (1824) (holding that New York’s grant of exclusive rights to use steam navigation on New York’s waterways violates the active Commerce Clause and declining to reach the Intellectual Property Clause). Chief Judge Kent’s mention of perpetual patent rights was dicta. New York had only granted a twenty-year term. Id. at 572. Furthermore, the New York grant was not made to appellants “as inventors of the steam-boat.” Id. at 583.

Nicklin’s argument deserves the limited skepticism granted attorneys speaking for clients. His main thesis is that the Constitution, as well as good policy, requires Congress to grant copyright protection to the works of foreign authors who do not reside inside the United States.
are neither totally exclusive nor totally concurrent—a possibility that we now take for granted in dormant Commerce Clause jurisprudence. Furthermore, it assumes that all AERs and IERs are "copyrights" or "patents."

The Supreme Court's pronouncements also ignore the possibility that some, but not all, state actions may violate the Constitution's grant of power to the federal government. The Court, in Kewanee Oil v. Bicron Corp., declared that the Intellectual Property Clause does not limit the states:

In the 1972 Term, in Goldstein v. California, we held that the cl. 8 grant of power to Congress was not exclusive and that, at least in the case of writings, the States were not prohibited from encouraging and protecting the efforts of those within their borders by appropriate legislation . . .

Just as the States may exercise regulatory power over writings so may the States regulate with respect to discoveries . . . . The only limitation on the States is that in regulating the area of patents and copyrights they do not conflict with the operation of laws in this area passed by Congress . . . .

Kewanee accepts, rather than rethinks, the statement in Goldstein. This is unfortunate, as Goldstein is a good example of bad law made by a hard case. To be even more precise, the case exemplifies the two-sided focus of the adversary system allowing black-hat/white-hat rhetoric to distract the Court from public domain values.

See Nicklin, supra note 106, at 297.

211. A "dormant" Commerce Clause barring some state action was seemingly first mentioned (in dicta, the statute was upheld) in 1829. See Julian N. Eule, Laying the Dormant Commerce Clause to Rest, 91 YALE L.J. 425, 425 n.1 (1982) (quoting Wilson v. Black Bird Creek Marsh Co., 27 U.S. (2 Pet.) 245, 252 (1829) (Chief Justice Marshall giving the opinion of the Court) ("We do not think that the act empowering the Black Bird Creek Marsh Company to place a dam across the creek, can . . . be considered as repugnant to the power to regulate commerce in this dormant state . . . ."). Eule argues that Congress no longer needs help from the courts to balance national and state commercial interests. Rather, he suggests that the dormant Commerce Clause should be used for representation-reinforcement to by pass the incorrect exclusion of corporations from the Privileges and Immunities Clause). Eule, supra, at 428.

212. 416 U.S. 470 (1974) (holding that patent law does not preempt state trade secret law).


214. Id. at 478-79 (citations omitted).

215. See also International News Svc. v. Associated Press, 248 U.S. 215 (1918) (copying facts from publicly posted broadsheets is illegal misappropriation); see also Feist Pubs., Inc. v. Rural Tel. Svc. Co., 499 U.S. 340, 349 (1991) ("It may seem unfair that much of the fruit of the compiler's labor may be used by others without compensation . . . [But] this is . . . the essence of copyright . . . . The primary objective of copyright is not to reward the labors of authors, but to promote the Progress of Science and useful Arts.") (internal citations and quotation marks
Goldstein involved a California statute criminalizing "record piracy," a pejorative label highlighting the moralistic stance of the Court. Defendants had bought records and tapes offered for public sale and had made multiple rerecordings that they then offered for sale in competition with the originals. At the time of the copying, the federal copyright statute did not bar such behavior. However, while the case was pending, the 1909 Copyright Act was amended to bar similar, later activity. Seemingly, both Congress and California considered such behavior harmful. California characterized its statute as a "valid exercise of the police power" targeting "larceny."

The California statute under which defendants were convicted gave the first recorder perpetual rights against this type of copying. If the states were covered by the Intellectual Property Clause, the statute that defendants violated was unconstitutional because it lacked a time limit. If the constitutional grant of power over Intellectual Property to the federal government was exclusive, the statute that defendants violated was unconstitutional because the state lacked power to enact legislation on the subject.

The Court found the language of the Constitution definitive on the first constitutional argument. Because Article I, § 8 is addressed to Congress, it does not bind the states. The Court also held that the grant to the federal government is non-exclusive. It failed to

omitted); International News Serv., 248 U.S. at 263 ("The rule for which plaintiff contends would effect an important extension of property rights and a corresponding curtailment of the free use of knowledge and of ideas.") (Brandeis, J., dissenting); Pollack, supra note 36, at 1392-97 (arguing that same problem leads to over expansion of trademark protection). Unsurprisingly, International News Service was cited repeatedly in the Goldstein briefs. See, e.g., Brief of Respondent at v., Goldstein v. California, 412 U.S. 546 (1973) (No. 71-1192) (listing International News Service as cited on four pages); RIAA Brief at v. (listing cites to International News Service on six pages and in one footnote).

216. 412 U.S. at 546 & n.1 (quoting CAL. PENAL CODE § 653h).
217. Id. at 548.
218. Id. at 551-52.
219. Respondent's Brief at 7, Goldstein, 412 U.S. 546 (No. 71-1192); see also id. ("The beneficiaries of this [larceny] . . . will not be the public or any of the composers, performers, musicians or technicians whose skill has made the recordings possible, but only a parasitic group of record pirates who create nothing, who add nothing to the store of human culture and knowledge, and who live off the artistry, work and invested capital of others."); see also Brief of the People of the State of California Amicus Curiae in Support of Respondent at 4, Goldstein, 412 U.S. 546 (No. 91-1192) ("[I]t is estimated by reliable trade sources that the annual volume of such piracy is now in excess of $100 million. It has been estimated that legitimate pre-recorded tape sales have an annual value of approximately $300 million.") (citation omitted).
220. Goldstein, 412 U.S. at 560. The Court also threw in a make weight argument—such a perpetual copyright granted by a state would not be as dangerous as one granted by the federal government. Id. at 560-61.
221. Id. at 559.
discuss the possibility of anything like a dormant Copyright Clause, but instead skipped directly to the standard statutory preemption, the Supremacy Clause. While "it is difficult to see how the concurrent exercise of the power to grant copyrights by Congress and the States will necessarily and inevitably lead to difficulty,"222 the Court erred in believing that "[n]o reason exists why Congress must take affirmative action either to authorize protection of all categories of writings or to free them of all restraint."223 The usefulness of a dormant Intellectual Property Clause would be to invalidate state statutes which individually interfere with constitutional values.

The Court had little help on this issue from the briefs224 or oral argument.225 Few of the written submissions discussed any constitu-

222. Id.
223. Id. at 560.
224. The confusion dated from the original appeal:

3) California Penal Code Section 653(h) conflicts directly with Article I, Section 8, Clause 8 of the United States Constitution and the implementing Federal Statutes because it establishes a State Copyright:

4) California Penal Code Section 653(h) conflicts directly with Article I, Section 8, Clause 8 of the United States Constitution and the implementing Federal Statutes because it prohibits copying of public domain matter for unlimited times.

Grounds for Appeal and Designation of Record certified by Judge Auerbach of the Municipal Court, reprinted in Appendix in the Supreme Court of the United States at 29, Goldstein, 412 U.S. 546 (No. 71-1192). Similarly, the question presented for review to the Supreme Court was "May the State of California, through its criminal laws, grant copyright protection for unlimited times to sound recordings in the Public Domain, in direct conflict with Article I, § 8, Clause 8 of the United States Constitution and the implementing Federal Copyright laws and policy." Petition for a Writ of Certiorari to the Appellate Department of the Superior Court of the County of Los Angeles, State of California, Goldstein, 412 U.S. 546 (No. 71-1192). The petitioners argued only preemption: the effect of the Copyright Act with the Supremacy Clause. Brief of Petitioners, Goldstein, 412 U.S. 546 (No. 71-1192). In reply, petitioners also argued (1) that the California penal code unconstitutionally protected items already in the public domain, citing Graham v. John Deere Co., 383 U.S. 1 (1966) (patent case holding that 'nonobviousness' is a constitutional requirement for patentability), see Reply Brief of Petitioners at 6 n.5; and (2) unconstitutionally created perpetual rights, see id. at 9-11 (not clear if this argument reaches Intellectual Property Clause in absence of any federal statutes).

225. The Court asked:

Do you think State action of this sort is unconstitutional by virtue of [the] supremacy clause or that it would be unconstitutional by virtue of the patent grant to Congress in the Constitution, even if Congress had never implemented its authority under that grant?

to which Petitioner replied:

I think it would be unconstitutional under both clauses, your Honor.

I think that Article I, Section 8, Clause 8, is a grant of authority and a grant of power to the Congress.

When read in connection with Madison's Federalist, I think he makes it as clear as possible, and I believe going back to the Banks case, Banks v. Manchester, [128 U.S. 244 (1888) (reporter of state court cannot obtain statutory copyright in decisions written by judges and does not have common law copyright in those decisions)] way back in 1888,
tional issue except standard statutory preemption.\footnote{226} The few arguments mentioning possible direct Intellectual Property Clause limitations on the states were conclusory,\footnote{227} which is hardly surpris-

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I believe it was, this Court held that this power to make copyright rested only by the Constitution within Congress.

But, I think we needn't find that in this case, because I think in this case we have a clear legislative intent as expressed for a number of years, from 1909 through 1972, that you either find your rights under the Copyright Law or you don't find your rights at all.

Oral Argument at 13-14, City, 412 U.S. 546 (No. 71-1192) (Dec. 13, 1972) (GPO microfiche). Respondent's argument to the Court was the absence of preemption.

"[Question by Court:] Isn't that the basis of your argument, that there is no Federal Preemption of this particular segment? [Respondent:] Correct, Your Honor. There is no Federal preemption." Id. at 33.


All amici curiae, except Custom Recording Tape Co., et al., supported California. See briefs listed earlier in this footnote; Brief of Recording Indus. Association of America, Inc., Amicus Curiae (hereinafter RIAA Brief); Brief Amici Curiae For American Federation of Musicians and American Federation of Telephone and Radio Artists (hereinafter AFM Brief). Merit filings with some material on possible Intellectual Property Clause limitations directly on the states were RIAA Brief; AFM Brief; Reply Brief of Petitioners; and [Respondent's] Post-Argument Memorandum.

227. RIAA asserted that Supreme Court case law recognized "the continuing validity of state protection in the field of common law copyright," RIAA Brief at 33, and that "[the copyright clause of the Constitution does not its own force preempt state law." Id. at 34 n.89 (citing Arnold, supra note 163, at 420-21; Comment, 43 N.Y.U. L. REV. 178, 183 (1968). The Comment refers briefly to materials discussed elsewhere in this article. Arnold's article cannot be taken seriously on this point. Discussing Gibbons v. Ogden, he puts the words of the attorneys for the respondent into the mouth of Chief Justice Marshall. Marshall's only comment on the Intellectual Property Clause was: "As this [discussion of the Commerce and Supremacy Clauses] decides the cause, it is unnecessary to enter in an examination of that part of the Constitution which empowers Congress to promote the progress of science and useful arts." Gibbons v. Ogden, 22 U.S. (9 Wheat.) 1, 221 (1824); accord John W. Whicher, The Ghost of Donaldson v. Beckett: An Inquiry Into the Constitutional Distribution of Powers Over the Law of Literary Property in the United States—Part II, 9 BULL. COPYRIGHT SOC'Y U.S.A. 194, 197 (1962). Nor can we be sure to what extent the New York state grant (which was not based on invention) survived the Supreme Court's pronouncement. See Brief Amicus Curiae of the Licensing Executives Society at 52 & n.36, Kewanee Oil Co. v. Bicron Corp., 416 U.S. 470 (1974) (No. 73-187). The New York Chancellor in a later case issued an injunction barring a federally licensed steam boat from traveling between Troy, N.Y. and New York City, N.Y. but refused to grant one barring trips inside New York with stops in other states. Only the refusal of the interstate injunction was
appealed. North River Steam Boat Co. v. Livingston, 3 Cow. 711, 739 (N.Y. 1825). The appellate court affirmed the denial, id. at 756, but clearly indicated that, if appealed, it would have reversed the limited injunction which had been granted. Id. at 750 ("[T]he commerce subject to the control of congress, is the coasting trade . . . [I]ncluding all rivers approachable from the coasts . . . [T]he [defendant's enjoined vessel] . . . had a perfect right to the navigation of the Hudson."). But see id. at 754-55 (state retains exclusive right to regulate solely internal commerce which includes ferries and canals). RIAA also declared, citing but not discussing two secondary authorities, that "the historical background of the copyright clause makes it clear that the 'limited times' phrase was intended only as a restraint on federal power and does not limit the states with respect to common law copyright in unpublished works." RIAA Brief at 34, Goldstein, 412 U.S. 546 (No. 71-1192). RIAA did not bother to analyze the possible importance of a change to state statutory protection of writings. But, as Kaplan notes, "[it] seems unlikely that the validity of the state regulation in relation to the copyright clause would be made to turn on whether it emanated from the state's legislature or its courts. Cf. Shelly v. Kraemer, 334 U.S. 1 (1948); Powell v. Alabama, 287 U.S. 45 (1932)." Kaplan, supra note 161, at 412 n.41.

RIAA's first authority is Howard I. Kalodner & Verne W. Vance, Jr., The Relation Between Federal and State Protection of Literary and Artistic Property, 72 HARV. L. REV. 1079 (1959) (cited in RIAA Brief at 34 nn.90, 91). Kalodner begins with Learned Hands' dissent in Capitol Records, Inc. v. Mercury Records Corp., 221 F.2d 657, 664-68 (2d Cir. 1955) (Hand, J., dissenting). Kalodner & Vance, supra, at 1080. The case turned on whether divestive publication of an artist's performance on a commercially distributed record had destroyed state protection of the performance. Unlike the majority in Capitol Records, Hand considered "publication" to be an issue of federal law. He considered this necessary because the performance was a "writing," Congress could only grant protection to "writings" for "limited times," and the Federal Copyright Act ended state protection at divestive "publication." Kalodner interprets Hand as claiming that the Copyright Clause's "limited times" language directly binds the states. Kalodner, supra, at 1082-83; see also Kaplan, supra note 161, at 412-13 (Learned Hand's dissent rested on direct connection of Copyright Clause with states and on a policy of nationally uniform intellectual property law); Paul Goldstein, Federal System Ordering of the Copyright Interest, 69 COLUM. L. REV. 49, 51 (1959) ("Judge Hand viewed the copyright clause of the constitution, particularly its restriction of congressional protection to 'limited times,' as a mandate with which both state and federal regulation must comply."). Kalodner's argument against a direct tie between the Intellectual Property Clause and the states is neither new, overwhelming, nor relevant to dormancy:

It is submitted that the limited-times policy is not applicable to the states. A contrary view would probably mean that state grants of perpetual protection of unpublished works are invalid, a conclusion which opposes many years of practice and general assumption. The words of the clause do not refer to the states, and traditionally courts have refused to apply constitutional limitations to governmental units not specifically included within the scope of the limitation. This is particularly true in regard to the states, which are not governments of enumerated powers but of residual power subject to enumerated restraints.

... If the clause is read as an expression [of] . . . policies [on writings, authors, and time limits], it is not easy to understand why one should limit the states while the others do not. It seems more persuasive to argue either that all apply to the states or that none does. The arguments against applying the limited-times policy to the states indicate that none of the policies should apply.

Kalogdner, supra, at 1085, 1086. But see Whicher, Part I, supra note 105, at 150 & n.168 (arguing that a time limit counted from publication, an event which may not happen, is just as much a time limit as the statute of limitations for fraud which runs from when a reasonably diligent plaintiff would have discovered the fraud, an event which may never happen). Kaplan, see AFM Brief at 8 n.2, Goldstein v. California, 412 U.S. 546 (1973) (No. 71-1191), supplies no further
ing considering the murky history of the Clause. Even such luminaries as Story have found that the tie between the states and the Intellectual Property Clause is unclear. The Court addressed Hamilton’s famous list of three ways in which the Constitution bars state actions. However, the Court ignored the fact that Hamilton’s comments predated creation of dormant Commerce Clause doctrine and ignored the possibility that some, but not all, state actions in an area might be barred directly by the Constitution.

In Kewanee, the Court uncritically involved the reasoning in Goldstein. Kewanee involved trade secrets. After a long trial, the district court granted an injunction permanently barring defendants from using certain processes and information obtained from the plaintiff’s former employees. On appeal, the judgment was reversed because the district court had granted perpetual protection for patentable subject matter. Though the Sixth Circuit had not mentioned the issue, the Supreme Court in Kewanee explicitly denied that the Intellectual Property Clause directly barred state action.

analysis. He admits Learned Hand’s position has “some force” but he is “against the current of interpretation of other powers conferred on Congress by the Constitution.” Kaplan concludes that because Congress can always preempt the states by legislation, “it is doubtful” that the “history or intrinsic purpose” of the Intellectual Property Clause directly limits the states. Kaplan, supra note 161, at 420-21. The problem with perpetual protection of unpublished works is easily met by (1) construing limited times to refer to an economic return limit, see supra notes 133-38 and accompanying text, and (2) making any more than minimally economically productive use of a work a divestive publication, thus following Hand’s intelligent lead. See Capitol Records, 221 F.2d at 667 (commercial distribution of a record is divestive publication of the artists’ performances) (Hand, J., dissenting); see also Kaplan, supra note 161, at 425-26 (listing oddities of then-current “divestive publication” doctrine).

RIAA’s second authority is Whicher, Part I, supra note 105. Whicher is also relied upon by respondents. See Post-Argument Memorandum [of Respondent] at 11, Goldstein, 412 U.S. 546 (No. 71-1192). Whicher’s interesting historical theory is discussed in the text. See infra notes 248-49 and accompanying text.

228. See supra notes 93-104 and accompanying text.

229. See 2 JOSEPH STORY, COMMENTARIES ON THE CONSTITUTION OF THE UNITED STATES § 1154, at 84 (5th ed. 1891) (stating that it is a “matter for grave inquiry” whether states have concurrent power over intellectual property if they do not contravene federal statutes); cf., Mazer v. Stein, 347 U.S. 201, 220-21 (1954) (Douglas, J. dissenting) (noting that central term “writings” in Intellectual Property Clause is unclear) (“The constitutional materials are quite meager [and] much research is needed.”).

230. Goldstein, 412 U.S. at 552; see also supra note 210.

231. See supra note 211, and accompanying text.

232. Justice Johnson approached this possibility in Gibbons v. Ogden, 22 U.S. (9 Wheat.) 1, 228 (1824) (“Power to regulate foreign commerce, is given in the same words, and in the same breath, as it were, with that over the commerce of the States and with the Indian tribes. But the power to regulate foreign commerce is necessarily exclusive.”).


As in Goldstein, neither oral argument nor the briefs pointed the Court toward a dormant Intellectual Property Clause.

235. Only once did oral argument touch constitutional, as opposed to statutory, preemption:

[General Griswold, counsel for petitioner:]
In the last term, in Goldstein v. California, this Court refused to find such an effect in the constitutional provision, which is identical with respect to copyrights and patents, and refused to find it as a matter not covered by the patent law as enacted by the—by the copyright law as enacted by Congress.

And we submit that the same conclusion should be reached here with respect to the impact of the patent laws on the state law of trade secrets.

Question [from the Court]: General Griswold, there were some of us who dissented in Goldstein last term. Do you think our position is inconsistent with yours here?

Mr. Griswold: No, I do not think so, Mr. Justice.


236. Several additional constitutional arguments were made, but no one suggested a dormant Intellectual Property or Commerce Clause analysis. Trade secrets were argued as outside the Intellectual Property Clause because unlike IER's they (1) protect privacy interests, see Brief for Amicus Curiae Manufacturing Chemists Ass'n at 23, Kewanee Oil, 416 U.S. 470 (No. 73-187), (2) grant non-exclusive rights, see id., (3) are not offered specifically to inventors, see Brief Amicus Curiae of the Licensing Executives Society at 51, and (4) are intended to promote ethics, rather than progress. Id. at 50. One amicus curiae argued that the Intellectual Property Clause allowed Congress "to 'secure,' i.e., expand, inventors' common law rights—for a limited time—against both later inventors and copiers," but not to "limit [pre-existing] common law rights of inventors" to practice their inventions in secrecy; protecting such common law rights was a power retained by the states. Brief of the Bar Ass'n of the District of Columbia as Amicus Curiae at 9, 10 [hereinafter "DC Brief"]. But see supra note 106 and accompanying text (meaning of 'secure'). SCM Corp. raised several interesting arguments. First, "the intent of the Constitutional Framers as to trade secrets was non-existent" because "no common law right in trade secrets or inventions [was] generally recognized prior to the adoption of the Constitution." Brief Amicus Curiae of SCM Corp. at 30, 31 [hereinafter "SCM Brief"]. But see D.C. Brief, supra, asserting common law rights existed pre-Constitution. Second, "[g]rants ... of exclusionary rights in science and useful arts which have the net effect of retarding or even stifling progress are, regardless of purpose, in the teeth of the Constitutional mandate for promotion of progress in these fields." SCM Brief at 32. However, this statement is merely a preamble to a statutory preemption argument. See id. Third, trade secret law is "repugnant[... to the property right of every citizen, arising under the Fifth and Fourteenth Amendments, to utilize fully his own talents and skills in pursuit of a lawful trade or calling." Id. at 45 (largely relying on Edward S. Irons and Mary Helen Sears, The Constitutional Standard of Invention—The Touchstone for Patent Reform, attached as appendix to SCM Brief at 4a-50a, later version printed in 1973 UTAH L. REV. 653).

Respondents declined to take a position on non-statutory preemption. See Brief for Respondents at 8. Many briefs merely relied on the Court's logic in Goldstein, arguing that "discoveries" must be treated identically to "writings" under U.S. CONST. art. I, § 8, cl. 8. See Brief for the Petitioner at 25 n.7; Brief Amicus Curiae for the Budd Co. at 4; Brief of Amicus Curiae for Burroughs Corp.; Brief Amicus Curiae for R. J. Reynolds Industries, Inc. at 6; Brief for the New York Patent Law Association as Amicus Curiae at 13-15; Brief Amicus Curiae for Rohr Industries, Inc. Thirteen merits briefs did not mention non-statutory preemption. See Brief Amicus Curiae of the American Bar Association; Brief for the Association for the Advancement of Invention & Innovation as Amicus Curiae; Brief on the Merits for the American Patent Law Association, Amicus Curiae; Brief of the Chamber of Commerce of the U.S.A. as Amicus Curiae in Support of Petitioner; Brief of the Electronic Industries Association as Amicus Curiae in Support of Petitioner; Brief for Amicus Curiae National Patent Council, Inc. for Itself and Representing
John F. Whicher, however, has presented an interesting, historically-based theory that the "limited times" provision was addressed solely to the federal government.\textsuperscript{237} Whicher points to the English controversy over the continued existence of perpetual common law copyrights after the Statute of Anne,\textsuperscript{238} which is the same material relied upon by Crosskey.\textsuperscript{239} To drastically oversimplify, before the Statute of Anne, individual printers had exclusive, perpetual rights to reprint specific works—however, such rights were ineffective because the printer needed to prove actual damages. The Statute of Anne gave authors a limited term of copyright during which they could obtain confiscation and destruction of the infringing copies and damages based on the number of infringing copies in the defendant's possession. The words of the statute were unclear as to whether it created better remedies for a limited term or constricted the term of the underlying right. In 1769, \textit{Millar v. Taylor}\textsuperscript{240} held that the common law right was perpetual. In 1774, \textit{Donaldson v. Beckett}\textsuperscript{241} held that the common law right was terminated by the statutory, limited grant. Whicher contends that, when the Constitution was written and ratified, American lawyers were unaware of Donaldson.\textsuperscript{242} Thus, the Framers intended the "limited times" in the Intellectual Property Clause to bar the federal government from providing excessive remedies for the perpetual period of the common law monopoly. To this point, Whicher's analysis would seem to be a more detailed support of Crosskey's analysis.\textsuperscript{243} The two historians strongly

\textsuperscript{237} Whicher, \textit{Part I, supra} note 105. Whicher's article was cited to the Court in \textit{Goldstein}. RIAA Brief at 34 & nn.90, 91, \textit{Goldstein}, 412 U.S. 546 (No. 71-1191).

\textsuperscript{238} Statute of Anne, 8 Anne C. 19 (1709) (Eng.).

\textsuperscript{239} 1 CROSSKEY, supra note 105, at 480-86.

\textsuperscript{240} 4 Burr. 2303, 98 Eng. Rep. 201 (K.B. 1769).


\textsuperscript{242} See Whicher, \textit{Part I, supra} note 105, at 133. Whicher primarily bases this on their limited access to updated legal books:

The fact is worth stressing that it was the fourth edition of Blackstone's treatise \textit{[Commentaries on the Laws of England]}, originally published after the case of \textit{Millar v. Taylor} had been decided but before that decision had been overruled by \textit{Donaldson v. Beckett}, which was thus soon broadcast in pre-Revolutionary America.

\textit{Id.} In addition, Madison's defense of the Clause in the Federalist echoes the natural rights language of Blackstone's fourth edition. \textit{Id.}

\textsuperscript{243} See \textit{supra} notes 105-07 and accompanying text.
disagree, however, over whether the colonists were hostile to perpetual common law rights when limited to individual colonies.244

Whicher arguably shows: (1) the Framers believed in the existence of perpetual, common law copyright; (2) the Framers construed common law rights as waived in any jurisdiction where the author did not arrange publication of his work; (3) the Framers wanted to limit nationally effective copyrights; and (4) the Framers could reasonably have intended short-term national protection to co-exist with perpetual, but merely local, rights. Whicher, however, overreaches his evidence by asserting it proves the Framers were approving the continuation of the perpetual common law right in individual states.

What Whicher fails to show is that the Framers, even if they did choose concurrent federal/state power,245 chose to make the state power temporally unlimited.246 He totally ignores the Framers' choice not to use natural rights language in the Clause.247 Whicher strongly relies upon the undisputed existence of concurrent federal and state protection of unpublished manuscripts from the first federal copyright statute in 1790 until the adoption of the 1909 Copyright Act.248 This is not determinative, however. As Whicher himself points out, "limited times" measured from publication (a future act which may never occur), would make sense to attorneys accustomed to a statute of limitations for fraud measured from discovery (a future act which may never occur).249 Whicher contends that Madison's

244. See Whicher, Part I, supra note 105, at 139-41 & n.125 (citing historical evidence that he argues shows local, perpetual common law rights were accepted). But see Sears & Irons, supra note 151, at 667-69 (discussing historical evidence allegedly showing a strong colonial aversion to monopolies).

245. See Whicher, Part I, supra note 105, at 146-51.

246. Nor is this shown by the possibly lesser danger presented by perpetual, but merely local, rights. But see Goldstein, 412 U.S. at 560-61 ("[I]t is not clear that the dangers to which this limitation was addressed apply with equal force to both the Federal Government and the States. . . . [T]he exclusive right granted by a State is confined to its borders.").

247. See H.R. REP. NO. 1494, 52d Cong., 1st Sess. 2 (1892) (accompanying 1894 Patent Act) ("The object to be attained and the reason for the constitutional grant of power are embedded in the grant itself . . . . There is nothing said [in the Constitution] about any desire or purpose to secure to the author or inventor his 'natural right to his property.'").

248. See Whicher, Part I, supra note 105, at 146-51; see also Lewis S. Kurlantzick, The Constitutionality of State Law Protection of Sound Recordings, 5 CONN. L. REV. 204, 220 n.59 (1972). The state of California relied on this history to show that the states have concurrent intellectual property powers. See Post-Argument Memorandum [of Respondents] at 11-13, Goldstein, 412 U.S. 546 (No. 71-1192). But see Kurlantzick, supra, at 221 (state power to protect unpublished works protects author's right to decide not to publish and, thus, may not be relevant to existence of concurrent state power to protect published writings which involves author's economic interests).

249. See Whicher, Part I, supra note 105, at 150.
statement "[t]he public good fully coincides in both cases [authors’ and inventors’ rights] with the claims of individuals," does not undermine his interpretation. The sentence certainly makes more sense if all discoveries and writings are eventually dedicated to the public. Congruently, the Patent Act of 1793 conditioned grants of a federal patent upon relinquishment of any pre-Constitution, state-granted patent.

No strong, contemporary evidence of the Framers’ intent has been discovered, and modern legal theories do conflict. The Court’s best choice in interpretation may be to simply follow the language of the Intellectual Property Clause. The Clause is addressed to Congress; it binds only Congress. The Clause does not mention national uniformity; it does not mandate national uniformity. No parallel clause bars state action; the Clause, itself, does not bar state action.

However, this analysis ignores the possibility of a dormant Intellectual Property Clause. After all, the Commerce Clause is addressed to Congress, does not mention uniformity, and lacks a parallel anti-state-action clause. Amusingly, Judge Kozinski ties the existence of a “dormant Copyright Clause” to Goldstein: “Under the dormant Commerce Clause, state intellectual property laws can stand only so long as they don’t ‘prejudice the interests of other States.’” If, as Supreme Court dicta consistently declares,

251. Madison’s early view on the value of long-term intellectual property rights is unclear; his later belief that they are undesirable is not disputed. See Whicher, Part I, supra note 105, at 133-36.
252. 1 Stat. 318 § 7 (repealed July 4, 1836).
253. With the exception, see supra notes 130-49 and accompanying text, that “time limits” might be better set in terms of the economic life of the res, a theory that may render much existing law unconstitutional.
254. But see Kurlantzick, supra note 248, at 222-23 (arguing that because of the policy expressed in the Intellectual Property Clause, “the limited times provision applies to any state or federal action designed to protect subject matter covered by the copyright clause”) (“Given the constitutional concern with excess protection, state power in this area should be subject to similar limitations [on length of protection], since excessive state protection imposes the same unjustifiable costs as would excessive federal protection.”).
255. But see Albert A. Abel, The Commerce Clause in the Constitutional Convention and in Contemporary Comment, 25 MINN. L. REV. 432, 481-94 (1941) (arguing that the interstate commerce clause was intended to limit state action).
256. Some “commercial” taxation is prohibited by U.S. CONST. art. I, § 10, cls. 2, 3.
258. See supra Section IV.C.2; accord Nicklin, supra note 106, at 281 (“The ultimate object of the power, was the advancement of science and the useful arts; the means by which [C]ongress were to effect that end, was by securing to authors a right of property in their works for limited
eventual dedication to the public is the central concern of the Intellectual Property Clause, Learned Hand is correct in asserting that state law allowing perpetual protection of any "writing" or "discovery" is unconstitutional because it "prejudice[s] the interests of the other States" and of the states united.\textsuperscript{259}

In economic terms, the market harm from fifty states separately granting identical perpetual protection to a res is presumably the same as the harm from federal granting of perpetual protection in all states. Organizing concerted action in fifty states, furthermore, would probably involve higher transaction costs than instigating action in Congress. If national marketing of intellectual property is more efficient than local marketing, perpetual protection by one state disallows use of the most efficient system.

The analytically pure approach is to point out that Hamilton left out a possibility in Federalist No. 32.\textsuperscript{260} Some broad power delegated non-exclusively to the federal government might require for its effectiveness that states be barred from some small group of actions, but not all actions, in that area. I originally called this broad power a "dormant Intellectual Property Clause" because it involves the type of analysis involved in dormant Commerce Clause jurisprudence: a case-by-case analysis, as opposed to a blanket rejection of state action in a broad area.

As a textual matter, the Intellectual Property Clause is a more sensible place for such case-by-case analysis than is the Commerce Clause. Although the Commerce Clause does not state why or how Congress should regulate commerce, the Intellectual Property Clause

\textsuperscript{259} See Capitol Records, Inc. v. Mercury Records Corp., 221 F.2d 657, 664 (2nd Cir. 1955) (Hand, J., dissenting); see also supra note 227 (discussing Learned Hand's jurisprudence). Learned Hand also saw a policy of uniformity underlying the Intellectual Property Clause: Uniformity was one of the principal interests to be gained by devolving upon the Nation the regulation of this subject. During the existence of the Articles of Confederation several of the states had passed copyright laws . . . . [B]ut, in the 43rd number of the Federalist, Madison made this short comment on the Clause, 'The States cannot separately make effectual provision for either of these cases[.]' . . . If, for example, . . . the defendant is forbidden to make and sell these records in New York, that will not prevent it from making and selling them in any other state which may regard the plaintiff's [record] sales as 'publication'; and it will be practically impossible to prevent their importation into New York. That is exactly the kind of evil at which the clause is directed.

\textsuperscript{260} See supra note 209 (quoting Hamilton on exclusive delegation). One could alternatively say he has been misinterpreted.
gives both a purpose—to promote the progress of science and the useful arts—and a method, by supplying, for limited times, exclusive rights to authors and inventors. This allows courts to easily decide whether a state has violated the clause in the absence of statutory preemption. "Limited times" is the clearest of the textual fences in the clause. Therefore, whatever state intellectual property regulations may be allowable, granting perpetual AERs or IERs should be held unconstitutional regardless of Congressional action or inaction.

Alternatively, one could label the dormant Intellectual Property Clause a fourth type of statutory preemption—a preemption turning on the mere existence of any federal statute, rather than one turning on the type, content, or extent of a federal statute. This is possibly the most analytically satisfying explanation and may be termed constitutional/statutory preemption.

Congress does not have to grant any AERs or IERs. If Congress chooses not to set up a federal intellectual property system, the states may be allowed to grant perpetual rights. However, if Congress chooses to set up any type of AERs or IERs, the Constitution requires the rights be for only "limited times." Once any federal system is in place, its goal is effectively undercut by the existence of perpetual state-created rights. A slightly more nuanced approach might look separately to the existence of some federal action on "writings" and some federal action on "discoveries." Constitutional/statutory preemption differs from standard statutory preemption because the details of the federal statutory regime are irrelevant. For instance, the courts should not consider whether Congress has chosen to protect only different types of "writings" and "discoveries" than those targeted by the state laws.

Such broad preemption should be triggered by any federal statute for two reasons. First, if Congress granted rights in any area it would either be barring otherwise possible state grants of later perpetual rights or destroying already granted perpetual rights. Therefore, Congressional action would automatically create a disincentive for progress in that branch of science or the useful arts covered by federal statute.

261. The standard three types of statutory preemption are by express federal statutory command, actual conflict between the dictates of federal and state statute, and congressional enactment which "so thoroughly occupies a legislative field as to make reasonable the inference that Congress left no room for the [s]tates to supplement" federal statute. Cipollone v. Liggett Gp., Inc., 112 S. Ct. 2608, 2617 (1992) (citation and internal quotation marks omitted).

262. The need for legislation has almost always been met. Both the patent statute, Patent Act of 1790, 1 stat. 109, and the first copyright statute, Copyright Act of 1790, 1 stat. 124, were passed by the first Congress.
Second, any state law granting longer, more valuable protection in one type of writing or discovery would tend to make rights in that subject matter more valuable than federal time-limited rights in other types of writings or discoveries. States, therefore, not Congress, would be the leading influence on intellectual property investment choices.

Chief Justice Marshall once articulated a similar constitutional/statutory preemption theory. In Sturgis v. Crowinshield,263 Marshall stated in dicta that state bankruptcy statutes were preempted, not by the existence of the constitutional grant to Congress, but by its exercise:

If, in the opinion of Congress, uniform laws concerning bankruptcies ought not to be established, it does not follow that partial laws may not exist, or that State legislation on the subject must cease. It is not the mere existence of the power, but its exercise, which is incompatible with the exercise of the same power by the States. It is not the right to establish these uniform laws, but their actual establishment, which is inconsistent with the partial acts of the States.264

The Court may have already acted on constitutional/statutory preemption in the Intellectual Property area without expressly recognizing this as the basis for its action.265 If the Intellectual Property Clause is merely a grant of Congressional power to protect "writings" and "discoveries," the power to legislate on non-writings and non-discoveries (items below the constitutionally-set threshold for AERs and IERs) must be reserved to the states. Why then did the Court emphatically bar state protection of such lesser items?266

263. 17 U.S. (4 Wheat.) 122 (1819).
265. See, e.g., Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225 (1964) (state may not bar copying of lamp which lacks copyright or design patent protection); Compco Corp. v. Day-Brite Lighting, Inc., 376 U.S. 234 (1964) (same); Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141 (1989) (state may not bar the use of plug molding to prevent cheap copying of boat hull unprotected by patent (or copyright)). Cases are worded at different levels of generality, see Bonito Boats, 489 U.S. at 154 ("The pre-emptive sweep of our decisions in Sears and Compco has been the subject of heated scholarly and judicial debate."), but the differences are unimportant to my thesis.
266. My thanks to Michael B. Gerdes for clearly framing this issue, even though I disagree with his conclusion. See Michael B. Gerdes, Getting Beyond Constitutionally Mandated Originality as a Prerequisite for Federal Copyright Protection, 24 ARIZ. ST. L.J. 1461, 1465-68, (1992) (arguing that, because power over non-original works is reserved to the states, under the authority of South Dakota v. Dole, 483 U.S. 203 (1987), and Missouri v. Holland, 252 U.S. 416 (1920), Congress' power under the Commerce Clause is not limited by the originality requirements of the Copyright Clause).
In *Bonito Boats Inc. v. Thunder Craft Boats, Inc.*, 267 for example, the Court overturned a state statute barring imitators from copying the exact shape of boat hulls by the relatively inexpensive copying method called "plug molding."

The Florida [anti-plug molding] statute is aimed directly at the promotion of intellectual creation by substantially restricting the public's ability to exploit ideas that the patent system mandates shall be free for all to use. . . . The Florida law substantially restricts the public's ability to exploit an unpatented design in general circulation, raising the specter of state-created monopolies in a host of useful shapes and processes for which patent protection has been denied or is otherwise unobtainable. 268

The Court saw no tension between this statement and two others also made in *Bonito Boats:* (1) "that the Patent and Copyright Property Clauses do not, by their own force or by negative implication, deprive the States of the power to adopt rules for the promotion of intellectual creation within their own jurisdictions," 269 and (2) that Florida had "enter[ed] a field of regulation which the patent laws have reserved to Congress" by "a scheme of federal regulation . . . so pervasive as to make reasonable the inference that Congress left no room for the States to supplement it." 270

The Constitution, not Congressional choice, however, makes obvious items unprotectable by IERs271 and non-original items unprotectable by AERs. 272 This is not a Congressional choice. Congress cannot in any reasonable way have preempted a field over which it has no control—unless the preemption is a constitutional/statutory one. 273

268. Id. at 167.
269. Id. at 165.
270. Id. at 167 (internal quotations and citation omitted) (quoting Rice v. Santa Fe Elevator Corp., 331 U.S. 218, 230 (1947)).
At least one author has gone further and suggested that the Intellectual Property Clause gives Congress the power to protect intellectual property, but not the power to place designated intellectual property in the public domain over state objections. Therefore, to preempt state laws granting protection, Congress must rely on the Commerce Clause. See Edward Samuels, Comment, Goldstein v. California: Breaking Up Federal Copyright Preemption, 74 COLUM. L. REV. 960, 966 (1974).
One other explanation of such preemption exists. The Court has yet to bar a state from protecting something below the level of originality. While most of Bonito Boats talks about patents, the Court does point out that Congress had decided not to protect industrial designs through copyright. The Court's theory may be that Congress, by leaving items out of the Copyright Act, decided not to protect industrial designs above originality but below nonobviousness. Perhaps when the Court reaches the effect of preemption on a state law protecting non-original works, such as data bases, it will allow the state law to stand. However, lower courts and scholars have consistently agreed that such a state misappropriation law would be preempted by the Copyright Act. From an economic rationale, any other outcome is ludicrous.

Furthermore, while the Court has not held that the states cannot give copyright-like rights to writings below the constitutional minimum, its dicta on statutory preemption implies that it would: "Today we have held in Sears, Roebuck & Co. v. Stiffel Co., . . . that when an article is unprotected by a patent or a copyright, state law may not forbid others to copy that article."

The Court cannot logically hold both that the Constitution denies Congress the power to grant AERs to items below the authorship threshold of originality and that the Constitution gives Congress the

274. See Bonito Boats, 489 U.S. at 167-68.
275. The classic trilogy of cases (Sears, Compco, and Bonito Boats), deals with industrial designs not entitled to design patents. None of these cases states that the items, which lacked design patents or copyrights and which were below the standard for design patent protection, were also below the standard of originality for copyright protection. This is hardly surprising as these cases all predate Feist.
276. See Nimmer, supra note 97, § 1.1[B][2], at 1-37 through 1-38. But see Robert A. Gorman, Fact or Fancy? The Implications for Copyright, in 'FACT AND DATA PROTECTION AFTER FEIST 47, 88-92 (Jon A. Baumgaten, ed. 1991) (discussing one case that held state law action for misappropriation of facts was not preempted by the Copyright Act and arguing that it incorrectly construed the Copyright Act).
277. Unlike the federal patent statutes which preempt the field, see supra note 270, and the 1990 Copyright Act, the current 1976 Copyright Act has an express preemption clause generally barring state laws granting "legal or equitable rights . . . within the general scope of copyright" as specified by the Act for any "works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified [by this Act]." 17 U.S.C. § 301 (1988 & Supp. V 1993).
Even if the Court considered the articles above the "originality" standard for "writings," it would not have needed to discuss the possible copyrightability of the lamps because copyright protection at that time required notice on the article, 17 U.S.C. § 10 (repealed 1978). Because the plaintiffs had claimed design patent, not copyright, they would have had no reason to publish with copyright notice. The Court did not announce the constitutional minimum of "originality" for "writings" until 1991. See Feist Publications, Inc. v. Rural Tel. Serv., Inc., 499 U.S. 340 (1991).
power to control state legislation in the exact same area.\textsuperscript{279} Of course, lack of such a limitation would debilitate the AERs Congress may grant—but that merely supports my theory of constitutional/statutory preemption. If challenged with this argument, the Court could hide behind the Necessary and Proper Clause. I would consider this to be improper, as would Justice Marshall. His expansive\textsuperscript{280} reading of the Necessary and Proper Clause in \textit{McCulloch v. Maryland}\textsuperscript{281} instructed us to read the instrument as a whole\textsuperscript{282} and repeatedly pointed to the absence of language denying Congress the power to create a national bank.\textsuperscript{283}

The heavy hand of precedent may, however, counsel arguing for a different basis for the congressional limit.\textsuperscript{284} Instead of asking the Court to change its interpretation of the Intellectual Property Clause, we could ask the Court to hitch that Clause to the acknowledged dormant Commerce Clause\textsuperscript{285}—as Goldstein murkily suggested.\textsuperscript{286}

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\item \textsuperscript{279} Michael W. McConnell has suggested one interesting alternative with which I respectfully disagree. Congress, by the interaction of the Commerce and Intellectual Property Clauses, may have more power to preempt than to legislate. \textit{Cf.} Abrams, supra note 199.


\item \textsuperscript{280} Perhaps over-expansive, See Lawson & Granger, supra note 198, at 288-89 (stating that while Marshall’s argument about the meaning of “necessary” has force, he did not address the meaning of “proper,” perhaps because it was not relied on by the opposing attorneys).

\item \textsuperscript{281} 17 U.S. (4 Wheat.) 316 (1819).

\item \textsuperscript{282} \textit{Id.} at 406 (“a fair construction of the whole instrument”).

\item \textsuperscript{283} \textit{Id.} at 407, 421, 423 (“[T]heir having omitted to use any restrictive term”; “all means . . . which are not prohibited”; “should [C]ongress . . . adopt measures which are prohibited by the constitution . . . it would become the painful duty of this tribunal . . . to say, that such an act was not the law of the land. But where the law is not prohibited . . .”).

\item \textsuperscript{284} For those Court-watchers who expect the Court to decline any expansion of the dormant Commerce Clause, cf. C & A Carbone, Inc. v. Town of Clarkstown, 114 S. Ct. 1677, 1695 (Souter, J., dissenting); see discussion of Carbone, infra notes 304-07 and accompanying text, overruling Goldstein might seem more practical. \textit{Keuanee} is not a problem; the outcome in that case is easily supportable even if states are covered by the Intellectual Property Clause. Trade secrets are not IERs, because they are not exclusive; they do not grant rights against the entire world. See ROGER M. MILGRIM, MILGRIM ON TRADE SECRETS § 1.05[5] (1993) (typically state law only protects trade secrets from improper means of discovery).

\item \textsuperscript{285} Numerous scholars have made similar suggestions about the active Commerce Clause. \textit{See}, e.g., Ginsburg, “No Sweat,” supra note 150, at 365-67 (“Whatever the accuracy of [the assumption that records were of purely local importance in 1973 when Goldstein was decided], it seems most implausible today, particularly in the domain of electronic databases.”); Kurlantzick, supra note 248, at 236-46 (discussing Commerce Clause limits on state bans on record piracy).

\item \textsuperscript{286} Chief Justice Berger used a preemption test from dormant Commerce Clause cases. \textit{See} Goldstein v. California, 412 U.S. 546, 556-60 & n.15 (1973). Abrams deplores this strategy as a misguided attempt to use the dissimilar Commerce Clause as an excuse to ignore the historical jurisprudence on the Copyright Clause. \textit{See} Abrams, supra note 199, at 527-30. \textit{But see} Dan L.

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In 1973, the Court’s assertion that records were "of purely local importance" failed the giggle test. In 1994, how can the law sensibly ignore the power of computer nets, fiber optic networks, and broadcast media to move "writings" and "discoveries" between jurisdictions? Law cannot overlook the importance of "writings" and "discoveries" in interstate and international trade.

Therefore, perpetual state protection of a functional mark may also be analyzed as a violation of the dormant Commerce Clause. This argument does not require total national uniformity in trademark law, but it does make illegitimate any state grant of perpetual trademark protection to the limited class of marks discussed in this article.

Burk, Protection of Trade Secrets in Outer Space Activity: A Study in Federal Preemption, 23 SETON HALL L. REV. 560, 613-14 (1993) (Abrams argument shows only that the preemptive power of the Patent Clause would be as narrow as the Clause's scope). Burger's Goldstein analysis could have been successful if Burger had been more realistic.

287. Goldstein, 412 U.S. at 558.

288. See, e.g., AFM Brief at 20-26, Goldstein, 412 U.S. 546 (No. 71-1192) (amassing statistics to support the notion that "[t]he nationwide and deleterious scope of unauthorized tapping of musical sound recordings fully justifies the exercise of California's police power to penalize such actions."); RIAA Brief at 22-23 & n.53 (stating that ten of the states have anti-piracy statutes).

289. Cf. Chris Conley, California Couple Found Guilty for Role in Computer Pornography Service, THE COMMERCIAL APPEAL (Memphis, Tenn.) July 29, 1994 at 1A. A California couple was tried in federal court in Memphis on obscenity charges based on the use of a computer bulletin board controlled from their California home. An appeal is expected to question the application of Memphis community standards to a California distributor in obscenity finding.

290. Publishing and printing (SIC, standard industrial classification, 27) were responsible for 1,250 million dollars of exports in 1985 and 3,808 million dollars of exports in 1992; imports were 1,200 million dollars in 1985; 2,046 million dollars in 1992. GNP in SIC 27 was 23,326 million dollars in 1977 and 68,236 million dollars in 1989. United States’ trade in advanced technology products generated 83.5 billion dollars in exports in 1989; 105.1 billion in 1992; such technology was responsible for a positive United States balance of trade of 27.1 billion dollars in 1989; 33.3 billion dollars in 1992. See U.S. BUREAU OF THE CENSUS, U.S. DEPT’ OF COMMERCE, STATISTICAL ABSTRACT OF THE U.S. 1993 at 819, 741, 744 (11th ed. 1993). Note that the classic declaration of federal primacy in commerce held that state-issued patents for steam boats violated the Commerce Clause. Gibbons v. Ogden, 22 U.S. (9 Wheat.) 1 (1824) (active Commerce Clause); see generally, JAMES THOMAS FLEXNER, STEAMBOATS COME TRUE: AMERICAN INVENTORS IN ACTION (1944) (popularly written account of the rival inventors of steam navigation).

291. A similar argument shows that states are also barred from perpetual protection of merely descriptive marks that are also "writings."

292. An Intellectual Property-Commerce Clause link was suggested as early as 1824, before the advent of the dormant Commerce Clause:

I have not touched upon the right of the states to grant patents for inventions or improvements, generally, because it does not necessarily arise in this case. It is enough for all the purposes of this decision, if they cannot exercise it so as to restrain a free intercourse among the States.

Consider a mark that is ineligible for federal incontestable protection because it is merely functional. Hypothesize that New York State grants the mark in-state immortality and validates the mark's ownership by firm Y.293 Federal law, under orders from the Intellectual Property Clause, allows firm X to use the device in national commerce. But Firm X cannot send its goods so-dressed into New York. This clearly burdens interstate commerce.294

I will analyze the possibilities on the assumption that the protecting state will only bar importation into the protecting state and sale inside the protecting state.295 Congress has the option of protecting, or not protecting,296 writings and discoveries, but, any federally granted right must be mortal and must be limited to items meeting the constitutional standards for "writings" and "discoveries."

Possibility one: Both the protecting state and Congress grant protection to the res. The state grants rights in perpetuity, Congress grants protection for "limited times." Thus, if the res is originally protectible, under federal law it is dedicated to the public domain when the protection ends. If the res does not meet the constitutional minimum standards of protectability, it enters the public domain

293. This does not quite fit the usual local-protectionism profile of dormant Commerce Clause cases, as firm Y may not be based or incorporated in the protecting state. This is not a problem for two reasons. First, the term "local" may have many definitions. Consider the Florida statute held unconstitutionally protectionist even though it "could also apply to locally organized bank holding companies, if they maintained their principal operations outside the State . . . [because] discrimination based on the extent of local operations is itself enough to establish the kind of local protectionism . . ." barred by the dormant Commerce Clause. Lewis v. BT Investment Managers, Inc., 447 U.S. 27, 42 n.9 (1980). Choosing local trademark registration may be sufficient to be "local" for dormant Commerce Clause purposes. Second, and more importantly, the functional trademark problem is better addressed under what Donald H. Regan calls a "national interest," rather than a "movement of goods" dormant Commerce Clause analysis. See discussion, infra notes 305-11 and accompanying text.

294. A variation on this problem is presented by plaintiffs seeking extra-state injunctions against the use of trademarks which violate state antidilution laws. See, e.g., Mead Data Central, Inc. v. Toyota Motor Sales, U.S.A., 702 F. Supp. 1031 (S.D.N.Y. 1988), rev'd on other grounds, 875 F.2d 1026 (2d Cir. 1989). David Welkowitz argues that multi-state injunctions for state torts, including dilution, are improper because "[t]here appears to be a constitutionally mandated (though perhaps only impliedly so) structure that prohibits certain extensions of state power. It is not a balancing of the interests of several states; it is a limit that per se exists to restrict power in the federal system of interstate relations." David S. Welkowitz, Preemption, Extraterritoriality, and the Problem of State Antidilution Laws, 67 TUL. L. REV. 1 (1992). Welkowitz discusses several lines of Court cases including those under the dormant Commerce Clause. Id. at 30-40.

295. I make this assumption to target the right, not the remedy. Cf. Welkowitz, supra note 294 (analyzing problems with extrastate remedies). If the state also issues an extra-territorial injunction, the added remedy cannot sanitize the importation ban.

296. But see Nicklin, supra note 106, at 294-97 (stating that Congress is constitutionally required to protect authors and inventors, including foreign authors and inventors not residing in the United States).
immediately. But whenever it enters the public domain, free-riding by the public is a constitutional mandate.297 In this hypothetical situation, the over-protecting state protects the res longer than does federal statute. The protecting state's law permanently prevents all donees from using the dedicated res inside the protecting state, thus undercutting the federal scheme.

Possibility two: Congress does not grant protection, but all states grant perpetual protection to the same res. If the grants are incompatible with each other, we seem to have a classic dormant Commerce Clause violation.298 If the grants are compatible, we have the states functioning as a group to offer a protection barred from the federal government. I know of no case presenting such an unlikely scenario, but speaking as a functionalist, I suggest the states would be acting as if they were the federal government and thus should be barred from enacting in-concert legislation that Congress is constitutionally barred from enacting.299

Possibility three: Congress does not grant protection. Some states grant protection, but the res is inside the public domain in at least one state. Any protecting state is barring importation of items from non-protecting states. Because the protecting state is also barring its own residents from selling such items, the statute is not expressly protectionist. Thus, the action only falls afool of the dormant Commerce Clause if "the burden imposed on such commerce is clearly excessive in relation to local benefits."300

The only local benefit is that the trademark-holder may retain use of the goodwill associated with his established mark. This is a benefit both to the holder of the mark and the local consumers who are saved

297. See Feist, 499 U.S. at 349; see also Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 164 (1988) ("Sears and Compco protect more than the right of the public to contemplate the abstract beauty of an otherwise unprotected intellectual creation—they assure its efficient reduction to practice and sale in the market place.").

298. See, e.g., Bibb v. Navajo Freight Lines, 359 U.S. 520 (1959) (Illinois statute barring "conventional or straight mud flap, which is legal in at least 45 States" and required in Arkansas, violates dormant Commerce Clause); see also Kassel v. Consolidated Freightways Corp., 450 U.S. 662 (1980) (state law barring trailer trucks of a length commonly used for long-hauls through multiple states violates dormant Commerce Clause).

299. This limitation on state action should apply in areas primarily under Congressional control and in which Congress is constitutionally limited. I am not arguing that in "traditional state areas" states are barred from enacting similar laws (consider the U.C.C.) nor that in predominantly federal areas the states are barred from unanimously passing legislation that would be constitutional if passed by Congress (standard state trademark statutes).

search costs. But the supply of possible marks is quite large\textsuperscript{301} and therefore, the burden of requiring the mark-holder to choose a non-functional mark is small.\textsuperscript{302} In addition, the only local interest which counts is the importance of the protection created under state law which was not available under the existing federal statutes.\textsuperscript{303} Furthermore, the state is burdening its consumers with possible monopoly pricing by the trademark holder, thus making the state’s interest even smaller.

Against this minor, legitimate interest, we must balance the constitutional choice that functional items should be protected only for limited times. While this interest would be stronger had the Intellectual Property Clause expressly limited the states, it is still strong. If the state’s intent is to allow a “local” supplier (more precisely, the holder of a locally registered mark) a competitive advantage by preventing out-of-state (and competing in-state) suppliers from using a functional feature, the goal is illegitimate.

How does this suggestion fit into the maze of current dormant Commerce Clause jurisprudence? Obviously the answer varies with one’s view on the sense (or nonsense) behind dormant Commerce Clause cases. I will briefly address only the Court’s last garbage case, \textit{C & A Carbone, Inc. v. Town of Clarkstown},\textsuperscript{304} and the only law review article cited in Carbone, Donald H. Regan’s 1986 attempt to organize the case law.\textsuperscript{305}

301. At least the supply of possible arbitrary marks is quite large. \textit{See, e.g.}, Landes & Posner, supra note 17, at 274, 290 (stating that “the distinctive yet pronounceable combinations of letters to form words that will serve as a suitable trademark are as a practical matter infinite,” and stating that the supply of “unusual symbols and shapes or combinations of well-known symbols, shapes, and colors” is “virtually unlimited”). \textit{But see} Stephen L. Carter, \textit{The Trouble With Trademark}, 99 \textit{YALE L.J.} 759, 768-75 (1990) (trademark law is based on an unrealistic assumption that all marks are fungible). While I agree with Carter that marks, even arbitrary ones, are not as fungible as Landes and Posner assume, I do not think we are facing a sufficient shortage to justify allowing perpetual, functional marks. However, I have no hard data to support my assumption.

302. I look at this burden \textit{ex ante} and not \textit{ex poste}, in line with court cases that so look at the choice of a confusing mark. \textit{See generally} McCarthy, supra note 22, §§ 19.02, at 23.21[3] (stating that a junior user has obligation to check possibility of conflict before choosing mark).

303. \textit{See} Edgar v. MITE Corp., 457 U.S. 624, 644-45 (1982) (holding that an Illinois anti-takeover law violates the dormant Commerce Clause) (“We are also unconvinced that the Illinois Act substantially enhances the shareholders’ position. . . . [T]he disclosures required by the Illinois Act which go beyond those mandated by the [federal] Williams Act and the regulations pursuant to it may not substantially enhance the shareholders’ ability to make informed decisions.”).


305. Donald H. Regan, \textit{The Supreme Court and State Protectionism: Making Sense of the Dormant Commerce Clause}, 84 MICH. L. REV. 1091 (1986), cited in Carbone, 114 S. Ct. 1677, 1695 (1994) (Souter, J., dissenting). I currently take no position on whether, as Regan argues, the
Carbone held that a local law requiring all recyclable garbage picked up inside the town to be sorted at one municipally organized, but temporarily privately owned facility, constituted a per se violation of the dormant Commerce Clause. Justice O'Connor's concurrence in Carbone calls for standard Pike Church balancing, the type of analysis used above on state over-protection of a functional mark.\textsuperscript{306} According to the Carbone majority, however, the case against state protection is even stronger. Under their rule, an “ordinance may discriminate against interstate commerce” by “depriv[ing] out-of-state businesses of access to a local market,”\textsuperscript{307} and thus be invalid without balancing.

This possible expansion of the dormant Commerce Clause seems both ill-conceived and inapplicable to the instant hypotheticals. It is ill-conceived because I, like the dissent, am uncomfortable with calling illegitimate any “protectionist” policy much, or all, of whose burdens fall on in-state actors.\textsuperscript{308} It is inapplicable because I doubt that such a local trademark holder would meet the other criteria relied on by the dissent to legitimize the local ordinance under review—being “essen-

\textsuperscript{306} Carbone, 114 S. Ct. at 1687 (O'Connor, J., concurring in the judgment).

\textsuperscript{307} See id. at 1681.

\textsuperscript{308} Id. at 1696, 1700, 1701, 1702 (“Subjecting out-of-town investors and facilities to the same constraints as local ones is not economic protectionism. . . . An examination of the record confirms skepticism that enforcement of the ordinance portends a Commerce Clause violation, for it shows that the burden falls entirely on Clarkstown residents. . . . [T]he only business lost as a result of this ordinance is business lost in Clarkstown, as customers . . . drift away in response to higher fees. . . . The Commerce Clause was not passed to save the citizens of Clarkstown from themselves.”) (Souter, J., dissenting); see also id., 114 S. Ct. at 1688-89 (“Local Law 9, however, lacks an important feature common to the regulations at issue in these cases—namely, discrimination on the basis of geographic origin. . . . Rather the garbage sorting monopoly is achieved at the expense of all competitors be they local or nonlocal.”) (O'Connor, J., concurring in the judgment). But see Dean Milk Co. v. City of Madison, 340 U.S. 349, 354 n.4 (1951) (“It is immaterial that Wisconsin milk from outside the Madison area is subjected to the same prescription as that moving in interstate commerce.”); accord Regan, supra note 305, at 1230 ("A government cannot validate discrimination against a protected class (in the Dean Milk case non-Wisconsin firms) simply by subjecting some members of the non-protected class to the same burden. (A state may not conserve gas by closing gas stations to all blacks and to whites with odd numbered license plates.").
tially an agent of the [local] government” engaged in an activity required of local government.

However, Carbone is part of a different branch of dormant Commerce Clause jurisprudence, a movement-of-goods case.\(^{309}\) I would place my hypothetical in the smaller set of “national interest” cases. The dormant Commerce Clause protects a limited class of national interests:

[T]hose interests, and only those, that, like the interest in preventing state protectionism, [the central concern in movement-of-goods cases], are fundamentally related to the existence and political viability of federal union. The interest in an effective transportation network, the interest in protecting interstate commerce from special disadvantage that flows just from its being organized across state lines, and perhaps the interest in a uniform national monetary policy, are such interests.\(^{310}\)

[Regan] certainly wants to hold open the possibility that there are some other [national interests], though there may not be. [He] do[es] not think there are any other national interests . . . that are recognized [as yet] in the cases, but there is nothing to prevent us from recognizing hitherto unnoticed national interests in response to new sorts of state legislation.\(^{311}\)

In Regan’s terms, preventing the creation of temporally unlimited AERs and IERs is such a national interest. The main basis for this suggestion is the wording of the Intellectual Property Clause. This sounds slightly suspicious; I am basing a state limit on the wording of the Intellectual Property Clause after I expressly contended that the Clause is not addressed to the states. However, this is the same oddity involved in all dormant Commerce Clause cases.\(^{312}\)

\(^{309}\) Using Regan’s terminology. See Regan, supra note 305. Regan preliminarily defines “[m]ovement-of-goods cases a[s] all dormant commerce clause cases except: (1) cases involving state regulation of the instrumentalities of interstate transportation, such as railroads or trucking; (2) cases involving state taxation of interstate commerce; and (3) cases involving the state as market participant . . . .” Id. at 1098-99 (footnotes omitted). Regan’s thesis is that in movement-of-goods cases the Court should be, and is, only interested in striking down state laws motivated by the desire to advantage local interests in relation to their out-of-state competitors. Id. at 1206. I take no position on this thesis, but I find Regan’s classification of the cases very helpful.

\(^{310}\) Regan, supra note 305, at 1192.

\(^{311}\) Id. at 1189.

\(^{312}\) But see Prudential Ins. Co. v. Benjamin, 328 U.S. 408, 434-35 (1946) (“This broad authority [over commerce] Congress may exercise alone, subject to those limitations [created by the Constitution on Congress’ powers], or in conjunction with coordinated action by the states, in which case limitations imposed for the preservation of their powers become inoperative and only those designed to forbid action altogether by any power or combination of powers in our
In summary, however one labels the concept, (I prefer constitutional/statutory preemption), my argument reduces to the theory that a limited field-preemption is built into the skeletal outline of national information policy contained in the Intellectual Property Clause—with the possible caveat that Congress must first pass some AER and/or IER legislation. The federal government may not create temporally unlimited AERs or IERs. If the states are allowed to do so, they can make state protection more valuable than federal protection. But the existence of the Intellectual Property Clause shows a constitutional choice of federal primacy in intellectual property—even if only after Congress has taken some action in the area. Therefore, the states are barred from creating such unlimited rights.

My final point is that even under the more permissive dormant Commerce Clause analysis, Congress is constitutionally barred from allowing states to grant temporally unlimited AERs or IERs. Congress' ability to override the Dormant Commerce Clause rests on Congress' power to regulate the involved area. But Congress may not create perpetual AERs and IERs. Therefore, if the states act as Congress' agents, the states may not violate the limitation either; Congress cannot delegate power it does not have.

VI. CONCLUSION

The Constitution bars a congressional grant of perpetual, exclusive rights in both (1) functional trademarks and (2) merely descriptive trademarks that are simultaneously "writings." The Intellectual governmental system remain effective." (citations omitted). I read Prudential as allowing the state and federal government to combine powers to do any acts separately impossible only because of the system of federalism—not to allow combination to override other constitutional limits. See id. at 439 n.52 ("It would be a shocking thing, if state and federal governments acting together were prevented from achieving the end desired by both, simply because of the division of power between them.") (citation omitted).

313. Or at least prevent Congress from effectively controlling incentives.

314. Accord Kurlantzick, supra note 248, at 225 ("[I]t is very difficult to imagine that Congress can authorize the states to extend temporally unlimited protection when the copyright clause expressly prohibits Congress from doing it.").

315. See William Cohen, Congressional Power to Validate Unconstitutional State Laws: A Forgotten Solution to an Old Enigma, 35 STAN. L. REV. 387, 388 (1983) ("[C]ongress should be able to approve unconstitutional policy choices in state laws when Congress is not constitutionally prohibited from directly adopting the same policy itself."); accord Prudential Ins. Co. v. Benjamin, 328 U.S. 408, 435 n.47 (1946) ("There can be no doubt that the combined exercise of state and federal authority is limited, to some but largely undefined extent, by other constitutional prohibitions or the combined effects of more than one."); see also id. at 434 (holding that Congress may pass legislation allowing state action which otherwise would violate the dormant Commerce Clause) ("The power of Congress over commerce exercised entirely without reference to coordinated action of the states is not restricted, except as the Constitution expressly provides["].")
Property Clause must be applied to the states at least to the same extent (under one of several alternative theories). Therefore, neither the federal government nor the states may create such protection.

VII. Coda

The possibility that “limited times” should be interpreted in terms of the economic life of the res is merely a side issue in this paper. However, this “side issue” is constitutionally and practically of overwhelming importance. I strongly urge my economically-oriented colleagues to investigate it further.