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## Martignon and Kiss Catalog: Can Live Performances Be Protected?

Brian Danitz

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### Cover Page Footnote

The author would like to express his gratitude to Professors Hugh C. Hansen, Alan J. Hartnick, and Stanley Rothenberg for their invaluable advice and tutelage

## COMMENT

### *Martignon* and *KISS Catalog*: Can Live Performances Be Protected?

Brian Danitz\*

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## INTRODUCTION

Two recent court actions have threatened to topple Congress' protection of live musical performances by finding the federal anti-bootlegging statutes<sup>1</sup> unconstitutional.<sup>2</sup> These opinions, issued three months apart from district courts in New York and California, the heart of America's entertainment industry, affect more than the collecting habits of a few avaricious fans.<sup>3</sup> If these decisions are upheld and widely followed, not only will bootlegging laws be outside the scope of Congress' lawmaking authority, but the United States also will be incapable of enforcing a uniform policy that would comply with article 14 of the TRIPs agreement—an accord sponsored and signed into law by the President harmonizing American intellectual property law with the laws of 110 other signatory nations.<sup>4</sup> This is an expensive proposition both in terms of trade sanctions that may be brought to bear<sup>5</sup> and in terms of American leadership in the world of

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<sup>1</sup> 18 U.S.C. § 2319A (2000); 17 U.S.C. § 1101 (2000).

<sup>2</sup> *United States v. Martignon*, 346 F. Supp. 2d 413, 425 (S.D.N.Y. 2004), *appeal docketed*, No. 04-5649 (2d Cir. Oct. 26, 2004) (finding the criminal anti-bootlegging statute, 18 U.S.C. § 2319A, to be unconstitutional under the Copyright Clause and thereby dismissing indictment of defendant for bootlegging); *KISS Catalog v. Passport Int'l Prods., Inc.*, 350 F. Supp. 2d 823, 833 (C.D. Cal. 2004), *appeal docketed*, No. 04-57077, (9th Cir. Dec. 9, 2004) (finding that the section of the civil anti-bootlegging statute that prohibited the unauthorized distribution of the unauthorized recording of live performances, 17 U.S.C. § 1101(a)(3), was unconstitutional under the Copyright Clause).

<sup>3</sup> See *Martignon*, 346 F. Supp. 2d at 425; *KISS Catalog*, 350 F. Supp. 2d at 833.

<sup>4</sup> See Agreement of Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 108 Stat. 4809, 1869 U.N.T.S. 299, 326 [hereinafter TRIPs Agreement]; *pertinent sections available at* [http://www.wto.org/english/docs\\_e/legal\\_e/27-TRIPs\\_01\\_e.htm](http://www.wto.org/english/docs_e/legal_e/27-TRIPs_01_e.htm) (last visited Mar. 1, 2005). "In respect of a fixation of their performance on a phonogram, performers shall have the possibility of preventing . . . [*inter alia*,] the fixation of their unfixed performance and the reproduction of such fixation." *Id.*, art. 14, ¶ 1. A comprehensive summary of the TRIPs Agreement is available at [http://www.wto.org/english/docs\\_e/legal\\_e/legal\\_e.htm#TRIPs](http://www.wto.org/english/docs_e/legal_e/legal_e.htm#TRIPs) (last visited Mar. 17, 2005).

<sup>5</sup> See TRIPs Agreement, *supra* note 4, arts. 42–46, 59–61 (establishing remedies of, *inter alia*, injunctions, compensatory damages and other equitable relief); see also Int'l Intell. Prop. Alliance, *Copyright Enforcement Under the TRIPs Agreement* (Oct. 19, 2004), at [http://www.iipa.com/rbi/2004\\_Oct19\\_TRIPs.pdf](http://www.iipa.com/rbi/2004_Oct19_TRIPs.pdf) (listing the various enforcement provisions of the TRIPs Agreement).

intellectual property law.<sup>6</sup> The rationale behind these decisions would also effectively stymie Congressional efforts to regulate in the area of “neighboring rights,” an increasingly vital segment of intellectual property law in our networked, speed-of-light world.<sup>7</sup>

Title 18, § 2319A of the U.S. Code and 17 U.S.C. § 1101 vest an exclusive right to record or transmit a live performance in the performer(s).<sup>8</sup> The central holdings in *Martignon*<sup>9</sup> and *KISS Catalog*<sup>10</sup> are that these rights are “copyright-like” and subject, therefore, to the limitations of the Copyright Clause.<sup>11</sup>

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<sup>6</sup> See Emery Simon, *GATT and NAFTA Provisions on Intellectual Property*, 4 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 267, 270 (1993) (discussing the options of the international community in responding to violations of intellectual property agreements, including using trade as “leverage”).

<sup>7</sup> See J. THOMAS MCCARTHY, MCCARTHY’S DESK ENCYCLOPEDIA OF INTELLECTUAL PROPERTY 287–88 (2d ed. 1995) (“A term used to express the concept of rights not equal to copyright but which relate to or are a ‘neighbor’ of copyright. . . . ‘Neighboring rights’ confer a more limited level of protection than copyright.”).

<sup>8</sup> Compare 17 U.S.C. § 1101 (2000) with 18 U.S.C. § 2319A (2000). The provisions are identical but for the requirement in § 1101 that the act be done “knowingly and for purposes of commercial advantage or private financial gain.” The remedies are identical as well in that infringement “shall be subject to the remedies provided in sections 502 through 505, to the same extent as an infringer of copyright.” The United States fulfilled its obligation under TRIPs by enacting § 2319A (codifying § 513 of the Uruguay Round Agreement Act, 108 Stat. 4809, 4975 (1994)), providing for criminal penalty. Section 2319A reads in pertinent part:

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

- (1) fixes the sounds or sounds and images of a live musical performance in a copy or phonorecord, or reproduces copies or phonorecords of such a performance from an unauthorized fixation;
- (2) transmits or otherwise communicates to the public the sounds or sounds and images of a live musical performance; or
- (3) distributes or offers to distribute, sells or offers to sell, rents or offers to rent, or traffics in any copy or phonorecord fixed as described in paragraph (1), regardless of whether the fixations occurred in the United States;

shall be imprisoned for not more than 5 years or fined in the amount set forth in this title, or both, or if the offense is a second or subsequent offense, shall be imprisoned for not more than 10 years or fined in the amount set forth in this title, or both.

<sup>9</sup> 346 F. Supp. 2d 413 (S.D.N.Y. 2004).

<sup>10</sup> 350 F. Supp. 2d 823 (C.D. Cal. 2004).

<sup>11</sup> See *United States v. Martignon*, 346 F. Supp. 2d 413, 425 (S.D.N.Y. 2004) (citing *Marbury v. Madison*, 5 U.S. 137, 176–77 (1803) (“Congress may not enact copyright-like

These decisions marked a dramatic shift from the decision of the Eleventh Circuit five years earlier, where that court held in *United States v. Moghadam*<sup>12</sup> that the Commerce Clause<sup>13</sup> could provide an alternative authority for the enactment of anti-bootlegging legislation.<sup>14</sup> In contrast, the *Martignon* and *KISS Catalog* courts assume that the Commerce Clause or the Necessary and Proper Clause could have provided Congress with the requisite authority, but this only would be material “if the Copyright Clause did not restrict Congress’ legislation in this field.”<sup>15</sup>

This new direction in the jurisprudence, if affirmed, would undermine Congress’ ability to regulate the information economy, in a manner reminiscent of the *Lochner* era.<sup>16</sup> By binding Congress to the four corners of the Intellectual Property Clause,<sup>17</sup>

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legislation, such as the anti-bootlegging statute, under the commerce clause (or any other clause), when the legislation conflicts with the limitation[s] imposed by the Copyright Clause.”); *KISS Catalog v. Passport Int’l Prods., Inc.*, 350 F. Supp. 2d 823, 833 (C.D. Cal. 2004) (“Since the Court cannot include a limited term of its own accord, the Court holds that the current version of the statute creates perpetual copyright-like protection in violation of the ‘for limited Times’ restriction of the Copyright Clause.”). For more on jurisprudential limitations on court creation of limited copyright terms, see *Eldred v. Ashcroft*, 537 U.S. 186 (2003).

<sup>12</sup> *United States v. Moghadam*, 175 F.3d 1269 (11th Cir. 1999), *reh’g en banc denied*, 193 F.3d 525 (11th Cir. 1999), *cert. denied*, 529 U.S. 1036 (2000).

<sup>13</sup> U.S. CONST. art. I, § 8, cl. 3 (granting Congress authority “[t]o regulate Commerce with foreign Nations, and among the several States”).

<sup>14</sup> See *Moghadam*, 175 F.3d at 1274–82 (citing U.S. CONST. art. I, § 8, cl. 18 (granting Congress authority “[t]o make all Laws which shall be necessary and proper for carrying into Execution the foregoing Powers”).

<sup>15</sup> *Martignon*, 346 F. Supp. 2d at 425 n.14.

<sup>16</sup> Between 1897 and 1937, the Supreme Court aggressively restricted state and federal economic regulation in order to protect freedom of contract and property which was considered fundamental to individual autonomy. “Lochnerism” is considered synonymous with judicial overreaching. See generally LAURENCE H. TRIBE, *AMERICAN CONSTITUTIONAL LAW* §§ 8-3 to 8-4 (1988) (“[L]aws aimed at redistributing resources would by their very nature fall outside the legislative function. Governmental actions which sought to benefit some persons at the expense of others were perceived as dangerous and exceptional. If such activities were not based on notions of corrective justice between parties, they were merely disguised forms of robbery.”); see also *Lochner v. New York*, 198 U.S. 45 (1905) (requiring more than the possible existence of some small amount of “unhealthiness” to warrant legislative interference with a liberty right).

<sup>17</sup> See U.S. CONST. art. I, § 8, cl. 8. The grant of authority to Congress “[t]o 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” allows Congress to enact both the patent and copyright systems. “Intellectual Property Clause”

this interpretation of the Constitution would create a new public right that would displace the traditional First Amendment balancing of interests with a bright-line and blanket rule within the Constitution's body.<sup>18</sup> Congress would be unable to protect artistic or scientific expression that does not meet the requirements of a restrictive interpretation of the textual provisions of the Intellectual Property Clause. This would strip Congress of its ability to respond to accelerating changes in information technology<sup>19</sup> that are currently challenging the Framers' twenty-seven word provision.<sup>20</sup>

This Comment argues that in deference to Congress' vested authority, before one Article I, Section 8 power is found to impliedly limit another, a functional and structural<sup>21</sup> analysis is necessary to determine whether an actual conflict exists. The *Martignon* and *KISS Catalog* opinions do not include a finding that the anti-bootlegging statutes actually undermine, or interfere with, the Copyright Clause.<sup>22</sup> Rather, both opinions apply *Railway*

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refers to clause 8 taken as a whole. "Copyright Clause" refers only to the copyright aspect of the provision.

<sup>18</sup> See Thomas B. Nachbar, *Intellectual Property and Constitutional Norms*, 104 COLUM. L. REV. 272, 319–24 (2004).

[I]f the constitutional interests captured by the First Amendment's Free Speech Clause are a limit on Congress's ability to grant exclusive rights, those interests operate through the First Amendment itself—they neither require nor suggest reading the Intellectual Property Clause's limits externally. . . . If granting exclusive rights does raise speech-related concerns, there is no possibility that Congress can avoid them by using the commerce power; the First Amendment itself applies to all legislation, regardless of the power under which Congress legislates. . . . The very existence of the First Amendment belies any argument that the Intellectual Property Clause's limits represent independently enforceable, speech-related constitutional norms.

*Id.*; see also Paul J. Heald & Suzanna Sherry, *Implied Limits on the Legislative Power: The Intellectual Property Clause as an Absolute Constraint on Congress*, 2000 U. ILL. L. REV. 1119, 1138 (2000).

<sup>19</sup> See Heald & Sherry, *supra* note 18, at 1138; see also U.S. CONST. art. I, § 8, cl. 18.

<sup>20</sup> See *id.*; see also U.S. CONST. art. I, § 8, cl. 18.

<sup>21</sup> See generally WALTER F. MURPHY ET AL., AMERICAN CONSTITUTIONAL INTERPRETATION ch. 4, § VI (3d ed. 2003).

<sup>22</sup> The *Martignon* court found 18 U.S.C. § 2319A to be "fundamentally inconsistent with Copyright Clause limitations." See *United States v. Martignon*, 346 F. Supp. 2d 413, 428 (S.D.N.Y. 2004). The *KISS Catalog* court found that 17 U.S.C. § 1101(a)(3) "violates 'the for limited Times' requirement of the Copyright Clause." See *KISS Catalog v. Passport Int'l Prods., Inc.*, 350 F. Supp. 2d 823, 837 (C.D. Cal. 2004). Neither opinion



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*Labor Executives' Ass'n v. Gibbons*,<sup>23</sup> in which the Supreme Court held that the uniformity requirement of the Bankruptcy Clause impliedly limits Congress' discretion to enact bankruptcy laws under the Commerce Clause, as a categorical and bright-line rule.<sup>24</sup> The analogy to *Gibbons*, in a context where the textual and structural elements that compelled its result are absent, effects a radical transformation of the Copyright Clause; the constitutional phrase "Writings" is reduced to the scope of the Copyright Act's "fixation requirement" and both "Writings" and "for limited Times" are endowed with the same preclusive effect as the uniformity requirement of the Bankruptcy Clause. The result is similar to building a wall in the middle of a front porch instead of a gate at the property-line; by erecting the "fixation requirement" as a barrier against copyright-like protection, the court would artificially restrict the Copyright Clause to the current confines of the Copyright Act.

Recognizing that the Copyright Clause is broader than the Copyright Act, this Comment suggests that Congress' discretion to enact copyright-like protections is restricted only where the "essential" purpose of the Copyright Clause is threatened.<sup>25</sup> Copyright-like statutes that, in the balance, "promote the Progress of Science and the useful Arts" are constitutional under either the Commerce Clause or the Copyright Clause itself.<sup>26</sup> This approach preserves the Constitutional scheme and, at the same time,

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elaborates on how this inconsistency or violation undermines the Copyright Clause. *See infra* Part III.

<sup>23</sup> 455 U.S. 457 (1982).

<sup>24</sup> The United States in its brief has also taken a categorical position. Both the district courts and the government would constitutionalize the Copyright Act's "fixation requirement" as a bright-line rule. The *Martignon* court would limit the scope of copyright's *protections* to fixed works: thus Congress would have *no authority* to regulate unfixed works *via* the Commerce Clause. The government would limit the scope of copyright's *restrictions* to fixed works: thus Congress would have *plenary authority* to regulate unfixed works *via* the Commerce Clause. Both of these categorical approaches effect an artificial bifurcation of the constitutional copyright power: a result that is legislatively inefficient and harmful to the Constitutional scheme. *See supra* notes 311–15 and accompanying text.

<sup>25</sup> *See Feist Publ'ns v. Rural Tel. Serv.*, 499 U.S. 340, 350 (1991).

<sup>26</sup> U.S. CONST. art. I, § 8, cl. 8.

preserves Congress' broad discretion to protect intellectual property.<sup>27</sup>

Part I of this Comment presents the background leading up to the *Martignon* and *KISS Catalog* decisions, emphasizing the anti-bootlegging statutes' goals of protecting the domestic recording industry and implementing the Agreement on Trade-Related Aspects of Intellectual Property (TRIPs). This part also presents the controversy sparked by the enactment of the anti-bootlegging legislation, as well as the arguments for and against constitutionality. The 1999 decision in *United States v. Moghadam*<sup>28</sup> is also summarized in this part in some detail, because the recent decisions fundamentally depart from the *Moghadam* court's reasoning.

Part II summarizes the opinions in *United States v. Martignon* and *KISS Catalog v. Passport International Productions, Inc.*, which share the common rationale that copyright-like statutes may not be enacted under the Commerce Clause, contrary to the holding in *Moghadam*.

Part III analyzes this rationale and argues that this categorical approach has yielded a skewed result that should not be upheld at the appellate level. Analogizing to the Court's functional analysis in separation of powers issues, this Comment advocates for a functional approach to questions of the compatibility between copyright-like statutes and the Copyright Clause—an approach more in keeping with the deference due to Congress in matters of economic policy.

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<sup>27</sup> See Brief for the United States of America at 16, *United States v. Martignon*, *appeal docketed*, No. 04-5649 (2d Cir. 2005) [hereinafter *Martignon* Brief for the U.S.]; Brief of Amici Curiae UMG Recordings, Inc., EMI Music North America d/b/a Capitol Records, Inc., Univision Music LLC, d/b/a Univision Music Group, National Academy of Recording Arts & Sciences, American Federation of Musicians of the United States and Canada, American Federation of Television and Radio Artists, Recording Artists Coalition and National Music Publishers Association, Inc. In Support of Reversal, at 13, *United States v. Martignon*, *appeal docketed*, No. 04-5649 (2d Cir. 2005) [hereinafter *UMG Amicus* Brief]; Brief of Amicus Curiae of the Association of American Publishers; American Business Media; CoStar Group, Inc.; The National Association of Realtors; Reed Elsevier Inc.; and The Software & Information Industry Association Supporting Reversal, at 21, *United States v. Martignon*, *appeal docketed*, No. 04-5649 (2d Cir. 2005) [hereinafter *Ass'n of Am. Publishers Amicus* Brief].

<sup>28</sup> See *United States v. Moghadam*, 175 F.3d 1269 (11th Cir. 1999).

This analysis reveals that the mere lack of “fixation” does not create an inherent conflict with the Copyright Clause and that the anti-bootlegging statutes are a form of protection which Congress has extended in the past within the Copyright Act itself.<sup>29</sup> This Comment labels this narrow class of protections “proto-copyright” because the protections therein are a precursor to full copyright protection, encompassing original works that are poised to be fixed in a tangible medium of expression. This Comment posits that this form of circumscribed protection is constitutional under the Commerce Clause and possibly under the Copyright Clause as well.

In conclusion, this Comment rejects the *Martignon/KISS Catalog* rationale as overbroad; if appellate courts affirm this approach in a departure from *Mohagdam*, the United States will be unable to meet its obligations under TRIPS,<sup>30</sup> the President will be hindered in future trade negotiations, and legislative attempts at a uniform intellectual property standard for the nation will be confounded.<sup>31</sup>

#### I. THE ANTI-BOOTLEGGING STATUTES AND THE CONSTITUTION: CONTEXT AND CONTROVERSY

The anti-bootlegging statutes were enacted in 1994 on a fast-track basis,<sup>32</sup> bundled within the omnibus Uruguay Rounds

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<sup>29</sup> See 17 U.S.C. § 101 (2000) (“A work consisting of sounds, images, or both, that are being transmitted, is ‘fixed’ for purposes of this title if a fixation of the work is being made simultaneously with its transmission.”); see also H.R. REP. NO. 94-1476, at 52–53 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5745 (discussing the various measures Congress considered or enacted regarding the Copyright Act).

<sup>30</sup> See TRIPs Agreement, *supra* note 4, art. 14, ¶ 1 (providing in relevant part that TRIPs “[i]n respect of a fixation of their performance on a phonogram, performers shall have the possibility of preventing . . . the fixation of their unfixed performance and the reproduction of such fixation.”)

<sup>31</sup> See *infra* Part I.B.

<sup>32</sup> See David Nimmer, *The End of Copyright*, 48 VAND. L. REV. 1385, 1407–08 (1995) (“Procedurally, [the Uruguay Round Agreement Act’s] most salient feature is that it was implemented on a fast-track basis . . . [B]oth the House and the Senate managed to issue lengthy reports on the Act. Those reports contain virtually nothing about copyright . . .”).

Agreement Act.<sup>33</sup> As a consequence, 17 U.S.C. § 1101 and 18 U.S.C. § 2319A received little attention, and Congress passed the legislation without debate and with essentially no legislative history.<sup>34</sup> In considering the nature and purpose of the statutes, the courts are left, as a result, with only the text of the statutes themselves and the context of their adoption into federal law.

*A. Scope and Nature of the Anti-Bootlegging Statutes*

Courts define bootlegging as “the sale of wholly unauthorized recordings of performances by musical artists which frequently are produced by individuals who smuggle tape recorders into live performances or who record live performances broadcast over the radio or television.”<sup>35</sup> The anti-bootlegging statutes protect live musical performances by providing legal recourse against anyone who records or transmits a performance without the permission of the performer(s).<sup>36</sup> The statutes also protect against the reproduction and distribution of such unauthorized recordings.<sup>37</sup> The civil statute, 17 U.S.C. § 1101, provides the same remedies as copyright infringement, including injunction, impoundment, destruction, damages, and, at the discretion of the court, costs and attorneys fees.<sup>38</sup> The criminal statute, 18 U.S.C. § 2319A, penalizes commercial bootlegging activity with fines based on

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<sup>33</sup> See Uruguay Round Agreements Act of 1994, Pub. L. No. 103-465, 108 Stat. 4809 (codified in Titles 7, 15, 17–19, 21, 26, 29 and 35 of the United States Code).

<sup>34</sup> See S. REP. NO. 103-412, at 225 (1994). There is no House Report for the legislation.

<sup>35</sup> See Brief of Amicus Curiae Recording Industry Association of America at 2, *United States v. Moghadam*, 175 F.3d 1269 (11th Cir. 1999) (No. 98-2180) [hereinafter RIAA Amicus Brief] (citing *RSO Records, Inc. v. Peri*, 596 F. Supp. 849, 852 n.2 (S.D.N.Y. 1984)); see also Stephan Braun, *Hot Acts, Hidden Microphones; Recordable CDs Give Concert Pirates a Bootleg Up. Industry Wants Laws Fine-Tuned*, L.A. TIMES, Oct. 16, 1999, at A1 (“Music bootlegging—the unsanctioned taping and distribution of rare, unreleased recordings and concert material—is a hobby gone haywire, part black market, part crusade. It is an outlaw trade of hustlers who cater to the voracious appetites of music buffs who can never get enough, fans who scheme and pay whatever it takes to obtain souvenirs of the performances of their idols.”).

<sup>36</sup> See 18 U.S.C. § 2319A (2000); 17 U.S.C. § 1101 (2000); *supra* note 8 (providing relevant statutory text and analysis).

<sup>37</sup> See *id.*

<sup>38</sup> See 17 U.S.C. § 1101(a) (2000) (establishing liability under 17 U.S.C. §§ 502–05 (2000)).

victim impact statements and/or up to five or ten years imprisonment for first or second offenses respectively.<sup>39</sup> The statute also mandates forfeiture and destruction of the recordings and, at the discretion of the court, of the recording equipment.<sup>40</sup>

### B. Policies of the Anti-Bootlegging Statutes

The anti-bootlegging statutes are the product of a two-pronged legislative initiative thirty years in the making.<sup>41</sup> The statutes protect the domestic music industry from the depredations of bootleggers and, concurrently, align American standards of protection with international trading partners.<sup>42</sup>

#### 1. Domestic Protection

The anti-bootlegging statutes are an outgrowth of Congress' ongoing efforts to protect the interests of the American recording industry.<sup>43</sup> Copyright protection was first extended to phonorecords<sup>44</sup> in the Sound Recording Amendment of 1971.<sup>45</sup> That amendment was enacted in response to the "widespread unauthorized reproduction of phonograph records and tapes" amounting to approximately 25% of the value of annual record and tape sales.<sup>46</sup> The Copyright Act of 1976 incorporated these

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<sup>39</sup> See 18 U.S.C. § 2319A(a) (2000).

<sup>40</sup> See 18 U.S.C. § 2319A(b) (2000).

<sup>41</sup> See *infra* notes 43–61 and accompanying text.

<sup>42</sup> See *infra* notes 72–99 and accompanying text.

<sup>43</sup> See H.R. REP. NO. 92-487, at 2 (1971), *reprinted in* 1971 U.S.C.C.A.N. 1566, 1567.

<sup>44</sup> See 17 U.S.C. § 101 (2000).

"Phonorecords" are material objects in which sounds, other than those accompanying a motion picture or other audiovisual work, are fixed by any method now known or later developed, and from which the sounds can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. The term "phonorecords" includes the material object in which the sounds are first fixed.

*Id.*

<sup>45</sup> Sound Recording Amendment Act of 1971, Pub. L. No. 92-140, 85 Stat. 391 (1971).

<sup>46</sup> H.R. REP. NO. 92-487, at 2 (1971), *reprinted in* 1971 U.S.C.C.A.N. 1566, 1567. The report estimated annual piracy amounted to 100 million 1971 dollars where the gross value of 1971 legitimate record sales was \$400 million. Other reasons set forth for this legislation were denial of artists' royalties and loss of federal and state tax revenues.

protections<sup>47</sup> and Congress subsequently expanded protection of sound recordings in the Piracy and Counterfeiting Amendments Act of 1982,<sup>48</sup> the Record Rental Amendment of 1984,<sup>49</sup> and the Digital Performance Right in Sound Recordings Act of 1995.<sup>50</sup>

While these statutes protected record companies and artists from “piracy” of existing recordings,<sup>51</sup> they did not protect live performances from bootlegging activity.<sup>52</sup> Prior to 1985, some Circuits had applied<sup>53</sup> the National Stolen Property Act,<sup>54</sup> which imposed criminal penalties for interstate transportation of stolen property, to interstate trafficking in “bootleg records.”<sup>55</sup> However, the Supreme Court, in *Dowling v. United States*,<sup>56</sup> held that that statute did not apply to bootleg recordings because such items “were not ‘stolen, converted or taken by fraud’ except in the sense that they were manufactured and distributed without the consent of the copyright owners” of the underlying musical works.<sup>57</sup> Performers and producers were left with only a patchwork of state

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<sup>47</sup> Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541; see 17 U.S.C. §§ 101–14 (2000 & Supp. 2002).

<sup>48</sup> Pub. L. No. 97-180 (codified as amended at 18 U.S.C. §§ 2318–19 (2000)) (imposing criminal and civil liability for trafficking in counterfeit phonorecord labels).

<sup>49</sup> 17 U.S.C. § 109(b)(1)(A) (2000) (prohibiting rental of phonorecords to the public for commercial gain).

<sup>50</sup> Digital Performance Right in Sound Recordings Act of 1995, Pub. L. No. 104-39, 109 Stat. 336 (1995) (granting performance rights in digital transmissions of sound recordings).

<sup>51</sup> See *supra* notes 45–50; see also Recording Indus. Ass’n of Am., *Issues: Anti-Piracy*, at <http://www.riaa.com/issues/piracy> (last visited Mar. 15, 2005) (defining four categories of music piracy).

<sup>52</sup> See MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 1.08[C][2] (2004).

<sup>53</sup> *E.g.*, *United States v. Dowling*, 739 F.2d 1445, 1448 (9th Cir. 1984) [hereinafter *Dowling I*], *rev’d*, 473 U.S. 207 (1985) [hereinafter *Dowling II*].

<sup>54</sup> 18 U.S.C. § 2314 (2000) replaced 18 U.S.C. § 413, which was the National Stolen Property Act. The history of the statute indicates that it is no longer being called this name (“Section consolidates §§ 413, 415, 417, 418, 418a, and 419 of title 18, U.S.C., 1940 ed. . . . Section 413 of title 18, U.S.C., 1940 ed., providing the short title ‘National Stolen Property Act,’ was omitted as not appropriate in a revision.”).

<sup>55</sup> *Dowling I*, 739 F.2d 1445.

<sup>56</sup> *Dowling II*, 473 U.S. at 213.

<sup>57</sup> *Id.* at 208; see also *id.* at 228–29 (“[T]he rationale employed [by lower courts] to apply the [mail fraud and interstate transportation of stolen goods] statute to petitioner’s [copyright-related] conduct would support its extension to significant bodies of law that Congress gave no indication it intended to touch.”).

statutory and common law causes of action.<sup>58</sup> These remedies were rarely utilized as they could not address the interstate and, increasingly, international scope of bootlegging activity.<sup>59</sup> Thus, no uniform protection of live performances was possible until the anti-bootlegging statutes were enacted.<sup>60</sup> Title 18, § 2319A of the U.S. Code and 17 U.S.C. § 1101 filled a gaping hole in the federal scheme to protect the domestic recording industry.<sup>61</sup>

## 2. International Harmonization

The domestic protection of the American recording industry paralleled the United States' increasing prominence as a net exporter of intellectual property.<sup>62</sup> International trade had always exerted an influence on United States intellectual property policy.<sup>63</sup>

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<sup>58</sup> See generally NIMMER & NIMMER, *supra* note 52, § 2.02 (discussing the states' role in protecting copyrighted works not fixed in a tangible medium via common law because federal preemption of the Copyright Act does not apply to such works).

<sup>59</sup> See RIAA AMICUS BRIEF, *supra* note 35, at 12 ("Rare is the performer with a public following only within a single state who is nevertheless popular enough to be a target of bootleggers. Bootleggers ordinarily target nationally and internationally known performers and for self-evident economic reasons are unlikely to restrict their unlawful distributions to a single state.")

<sup>60</sup> See *id.* at 6 ("Given the immense profitability of bootlegging due to recent technological advancements and corresponding incentives for bootleggers, the growing worldwide scope of bootlegging, and the insufficiency of previous efforts to deal with the problem, Congressional enactment of Section 2319A was the right remedy at the right time. Without the deterrence of Section 2319A, bootleggers could continue their depredations without fear of a tough, nationwide response coordinated by the federal government.")

<sup>61</sup> *Id.*

<sup>62</sup> See *Intellectual Property Crimes*, at [http://www.fbi.gov/hq/cid/fc/fifu/about/about\\_ipc.htm](http://www.fbi.gov/hq/cid/fc/fifu/about/about_ipc.htm) (last visited Mar. 15, 2005) ("Currently, the U.S. leads the world in the creation and export of IP and IP-related products. The International Anti-Counterfeiting Coalition recently reported that the combined U.S. copyright industries and derivative businesses account for more than \$433 billion, or 5.68%, of the U.S. Gross National Product, which is more than any other single manufacturing sector. The Bureau of Labor Statistics reports that between 1977 and 1996 the growth in the IP segment of the economy was nearly twice that of the U.S. economy as a whole.")

<sup>63</sup> See, e.g., International Copyright Act of 1891, 26 Stat. 1106, § 13; Louisiana Purchase Exposition Act of 1904, 33 Stat. 4, § 7; Ad Interim Act of 1905, 33 Stat. 1000, § 4952; *Buenos Aires Convention of 1914*, [http://ipmall.info/hosted\\_resources/lipa/copyrights/The%20Buenos%20Aires%20Convention.pdf](http://ipmall.info/hosted_resources/lipa/copyrights/The%20Buenos%20Aires%20Convention.pdf) (last visited Mar. 15, 2005); *The Universal Copyright Convention of 1952*, available at [http://ipmall.info/hosted\\_resources/lipa/copyrights/Protocol%203%20Annexed%20to%20the%20Univer](http://ipmall.info/hosted_resources/lipa/copyrights/Protocol%203%20Annexed%20to%20the%20Univer)

However, it was not until the 1980s that the United States implemented an aggressive policy of harmonization<sup>64</sup> with international standards of protection.<sup>65</sup> Facing an appalling trade deficit and rampant piracy of American products abroad, the United States reversed one hundred years of reticence and adhered to the Berne Convention for the Protection of Literary and Artistic Works<sup>66</sup> on March 1, 1989.<sup>67</sup> Although the Berne Convention itself granted protection to unfixed works,<sup>68</sup> it did not require member nations to extend such protection,<sup>69</sup> and the United States joined the Convention without providing protection to unfixed works.<sup>70</sup>

The policy of harmonization reached a high water mark in 1994 with the implementation of the Agreement on Trade-Related Aspects of Intellectual Property (TRIPS),<sup>71</sup> within the Uruguay

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1%20Copyright%20Convention.pdf (last visited Mar. 15, 2005). *See generally* WILLIAM F. PATRY, *COPYRIGHT LAW AND PRACTICE* (2000), <http://digital-law-online.info/patry/> (last visited Mar. 15, 2005).

<sup>64</sup> *See generally* ROGER E. SCHECHTER & JOHN R. THOMAS, *INTELLECTUAL PROPERTY: THE LAW OF COPYRIGHTS, PATENTS AND TRADEMARKS* § 2.3 (2003).

<sup>65</sup> *See, e.g.*, Convention Relating to the Distribution of Programme-Carrying Signals Transmitted by Satellite, May 21, 1974 (ratified Dec. 7, 1984), 13 I.L.M. 1444, *available at* [http://www.wipo.int/treaties/en/ip/brussels/pdf/trtdocs\\_wo025.pdf](http://www.wipo.int/treaties/en/ip/brussels/pdf/trtdocs_wo025.pdf); General System of Preferences Renewal Act, Pub. L. No. 98-573, 98 Stat. 2948, 3018 (1984); International Trade and Investment Act, Pub. L. No. 98-573, 98 Stat. 2948, 3000 (1984); Berne Convention Implementation Act, Pub. L. No. 100-568, 102 Stat. 2853 (1988); Visual Artists Rights Act, Pub. L. No. 101-650, 104 Stat. 5089, 5128 (1990); 17 U.S.C. § 102(a)(8) (2000) (Berne adherence legislation) (amending 17 U.S.C. §102 (2000) to include architectural works within the scope of copyrightable subject matter); North American Free Trade Agreement (NAFTA) Implementation Act, Pub. L. No. 103-182, § 334, 107 Stat. 2057 (1993) (creating 17 U.S.C. § 104A (2000) which provides for certain copyright protection in motion pictures), 107 Stat. 2057 (1993). *See generally* PATRY, *supra* note 63.

<sup>66</sup> *See* Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, revised July 24, 1971, 828 U.N.T.S. 221 [hereinafter Berne Convention], *available at* [http://www.wipo.int/treaties/en/ip/berne/trtdocs\\_wo001.html](http://www.wipo.int/treaties/en/ip/berne/trtdocs_wo001.html).

<sup>67</sup> *See* Berne Convention Implementation Act, Pub. L. No. 100-568, 102 Stat. 2853 (1988) (codified as amended in scattered sections of 18 U.S.C.) [hereinafter Berne Convention Implementation Act].

<sup>68</sup> *See* Berne Convention, *supra* note 66, art. 2, ¶ 1.

<sup>69</sup> *See id.* art. 2, ¶ 2.

<sup>70</sup> *See* Berne Convention Implementation Act, *supra* note 67.

<sup>71</sup> *See supra* note 4.



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Round of the General Agreement of Tariffs and Trade (GATT).<sup>72</sup> TRIPs incorporated many of the pre-existing international intellectual property agreements, including the Berne Convention,<sup>73</sup> the Paris Convention,<sup>74</sup> the Washington Treaty on Intellectual Property in Respect of Integrated Circuits,<sup>75</sup> and the Rome Convention for performances and neighboring rights.<sup>76</sup> TRIPs gave effect to the Rome Convention<sup>77</sup> by requiring protection of performers from the unauthorized recording or broadcasting of their live performances.<sup>78</sup> In compliance with this obligation,<sup>79</sup> Congress enacted the civil<sup>80</sup> and criminal<sup>81</sup> anti-

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<sup>72</sup> See *Understanding the WTO: Basics—The GATT Years: From Havana to Marrakesh*, at [http://www.wto.org/english/thewto\\_e/whatis\\_e/tif\\_e/fact4\\_e.htm](http://www.wto.org/english/thewto_e/whatis_e/tif_e/fact4_e.htm) (last visited Mar. 15, 2005); *Understanding the WTO: Basics—The Uruguay Round*, at [http://www.wto.org/english/thewto\\_e/whatis\\_e/tif\\_e/fact5\\_e.htm](http://www.wto.org/english/thewto_e/whatis_e/tif_e/fact5_e.htm) (last visited Mar. 15, 2005); Uruguay Round Agreement Act of 1994, Pub. L. 103-465, 108 Stat. 4809.

The Uruguay Round Agreements are the broadest, most comprehensive trade agreements in history and were negotiated by 125 countries. They are vital to our national interest and to economic growth, job creation, and an improved standard of living for all Americans. These agreements, by lowering tariff and other barriers to international trade and investment, will lead to increased levels of world and U.S. output, trade, real income, savings, investment, and consumption . . . . When fully implemented, these agreements are expected to increase U.S. GNP by \$100–\$200 billion per year. They are also expected to create hundreds of thousands of new, permanent well-paying American jobs (over and above the normal growth in employment in the economy).

H.R. REP. NO. 103-826(I), at 16 (1994), *reprinted in* 1994 U.S.C.C.A.N. 3773.

<sup>73</sup> See Berne Convention, *supra* note 66.

<sup>74</sup> See Paris Convention for the Protection of Industrial Property, Mar. 20, 1883, revised July 14, 1967, 828 U.N.T.S. 305 [hereinafter Paris Convention], *available at* [http://www.wipo.int/treaties/en/ip/paris/trtdocs\\_wo020.html](http://www.wipo.int/treaties/en/ip/paris/trtdocs_wo020.html).

<sup>75</sup> See Treaty on Intellectual Property in Respect of Integrated Circuits, May 26, 1989, 28 I.L.M. 1477, *available at* [http://www.wipo.int/treaties/en/ip/washington/pdf/trtdocs\\_wo011.pdf](http://www.wipo.int/treaties/en/ip/washington/pdf/trtdocs_wo011.pdf) (last visited Mar. 15, 2005).

<sup>76</sup> See WIPO Performances and Phonograms Treaty, art. 6, Dec. 20, 1996, S. Treaty Doc. No. 105-17, 36 I.L.M. 76, *available at* [http://www.wipo.int/treaties/en/ip/wppt-trtdocs\\_wo034.html#P109\\_12974](http://www.wipo.int/treaties/en/ip/wppt-trtdocs_wo034.html#P109_12974).

<sup>77</sup> See *id.* art. 10.

<sup>78</sup> See TRIPs Agreement, *supra* note 4, art. 14, ¶ 1 (“In respect of a fixation of their performance on a phonogram, performers shall have the possibility of preventing the following acts when undertaken without their authorization: the fixation of their unfixed performance and the reproduction of such fixation. Performers shall also have the possibility of preventing the following acts when undertaken without their authorization: the broadcasting by wireless means and the communication to the public of their live performance.”).

<sup>79</sup> See S. REP. NO. 103-412, at 2–3 (1994).

bootlegging statutes protecting performers against the unauthorized recording, transmission to the public, and the sale or distribution of, or traffic in, unauthorized recordings of their live musical performances.<sup>82</sup>

The Uruguay Round Agreements Act, signed into law by President Clinton on December 8, 1994, was the product of eight years of negotiations amongst 123 nations.<sup>83</sup> The United States strongly advocated for TRIPs, and this placed the United States in the center stage of “the highest expression to date of binding intellectual property law in the international arena.”<sup>84</sup> Unlike the prior great conventions, TRIPs included enforcement requirements and noncompliance with agreed provisions could trigger trade sanctions tied to the larger GATT agreement.<sup>85</sup> Thus the anti-bootlegging statutes have ongoing significance to the nation’s global trade policies.<sup>86</sup>

### C. Constitutional Basis for the Anti-Bootlegging Statutes

The anti-bootlegging statutes immediately raised questions of Constitutional dimension that the scarce legislative history could not answer.<sup>87</sup> Many commentators viewed federal protection of live performances as an erosion of the traditional boundary

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<sup>80</sup> 17 U.S.C. § 1101 (2000).

<sup>81</sup> 18 U.S.C. § 2319A (2000).

<sup>82</sup> See *supra* note 8.

<sup>83</sup> The Uruguay Round of GATT began in September 1982 and was signed by the participating ministers on April 15, 1994 in Marrakesh, Morocco. This officially ended GATT and began WTO. See *Understanding the WTO: Basics—The Uruguay Round*, at [http://www.wto.org/english/thewto\\_e/whatis\\_e/tif\\_e/fact5\\_e.htm](http://www.wto.org/english/thewto_e/whatis_e/tif_e/fact5_e.htm) (last visited Mar. 15, 2005).

<sup>84</sup> See Nimmer, *supra* note 32, at 1391–92.

<sup>85</sup> See TRIPs Agreement, *supra* note 4, arts. 42–46, 59–61; Int’l Intell. Prop. Alliance, *Copyright Enforcement Under the TRIPs Agreement* (Oct. 19, 2004), at [http://www.iipa.com/rbi/2004\\_Oct19\\_TRIPS.pdf](http://www.iipa.com/rbi/2004_Oct19_TRIPS.pdf); Emery Simon, *GATT and NAFTA Provisions on Intellectual Property*, 4 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 267, 270 (1993).

<sup>86</sup> See *supra* note 72.

<sup>87</sup> See Nimmer, *supra* note 32, at 1408–09 (“One seeks in vain for evidence that anyone in Washington even considered the constitutional basis for these vitally important [anti-bootlegging] amendments to the copyright law.”).

between copyright and the public domain.<sup>88</sup> David Nimmer hailed “the end of copyright,” suggesting that copyright, empowered by the Commerce Clause, now served the “new master” of international trade.<sup>89</sup> These commentators view the anti-bootlegging statutes as a juggernaut threatening centuries of carefully crafted Constitutional limits.<sup>90</sup> The developing split among the Circuits<sup>91</sup> attests to the complex balancing of state, federal, legislative, and judicial interests enmeshed in the question of the implied and express limits on Congressional authority to reshape the contours of copyright. This Comment suggests that the anti-bootlegging statutes do not run afoul of these limits which have already been clearly and fully set down by the Supreme Court.<sup>92</sup>

The Intellectual Property Clause, Article I, Section 8, Clause 8 of the U.S. Constitution, grants Congress the authority “[t]o 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.” Two centuries of Supreme Court decisions<sup>93</sup> and consistent Congressional practice<sup>94</sup> had

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<sup>88</sup> See, e.g., Peter A. Jaszi, *Goodbye to All That—A Reluctant (and Perhaps Premature) Adieu to a Constitutionally-Grounded Discourse of Public Interest in Copyright Law*, 29 VAND. J. TRANSNAT’L L. 595, 602–05 (1996) (“Most students of copyright would concur, at some level, that the limited times language expresses more than an incidental or technical constraint on federal grants of intellectual property protection, at least where copyrightable subject matter is concerned.”).

<sup>89</sup> See Nimmer, *supra* note 32, at 1412 (“Copyright, it seems, now has a new master . . . [C]opyright now serves as an adjunct of trade . . .”).

<sup>90</sup> See *id.* at 1416.

<sup>91</sup> See *supra* notes 10–12.

<sup>92</sup> See *Feist Publ’ns v. Rural Tel. Serv.*, 499 U.S. 340, 346 (1991); see also *Bonito Boats v. Thundercraft Boats*, 489 U.S. 141 (1988).

<sup>93</sup> See *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884); *Goldstein v. California*, 412 U.S. 546, 561 (1973) (interpreting “Writings” as “any physical rendering of the fruits of creative intellectual or aesthetic labor”) (citing *The Trade-Mark Cases*, 100 U.S. 82, 94 (1879)); cf. *CBS v. DeCosta*, 377 F.2d 315 (1st Cir. 1967), *cert. denied*, 389 U.S. 1007 (1967) (“[W]hile more precise limitations on “writings” might be convenient in connection with a statutory scheme of registration and notice, we see no reason why Congress’ power is so limited.”).

<sup>94</sup> See 17 U.S.C. § 102(a) (2000) (“Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression. . .”). Although the fixation requirement was first made explicit in the Copyright Act of 1976, prior law required publication with notice or registration with the

seemingly embedded a “fixation requirement” into the meaning of “Writings.”<sup>95</sup> Since live performances are inherently “unfixed” the anti-bootlegging statutes seemed to contravene that requirement.<sup>96</sup>

The Clause also states, in plain terms, that exclusive rights may be granted to authors only “for limited Times,”<sup>97</sup> a limitation also consistently enforced within the Copyright Act.<sup>98</sup> “A federal copyright statute that purported to grant copyright protection in perpetuity would clearly be unconstitutional.”<sup>99</sup> If the anti-bootlegging statutes failed to meet these copyright requirements, the question remained whether the Commerce Clause could provide an alternative authority for their enactment as “copyright-like” statutes.<sup>100</sup>

Article I, Section 8, Clause 3 of the Constitution grants Congress authority to regulate activities that substantially affect interstate commerce,<sup>101</sup> even if those activities themselves are entirely intrastate in nature.<sup>102</sup> The anti-bootlegging statutes, enacted to protect “the \$12 billion recording industry,”<sup>103</sup> and pursuant to international trade agreements, satisfied the Commerce Clause threshold requirements.<sup>104</sup> However, commentators disagreed as to the effect of the Intellectual Property Clause’s words of limitation upon other Article 1, Section 8 powers.<sup>105</sup>

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Copyright Office, necessitating a fixed form. *See* Douglas Lichtman, *Copyright as a Rule of Evidence*, 52 DUKE L.J. 683, 721 (2003).

<sup>95</sup> *See* NIMMER & NIMMER, *supra* note 52, § 1.08[C][2].

<sup>96</sup> *See id.*

<sup>97</sup> *See* U.S. CONST. art. I, § 8, cl. 8.

<sup>98</sup> *See* NIMMER & NIMMER, *supra* note 52, § 1.05[A][1].

<sup>99</sup> *Id.*

<sup>100</sup> *See* U.S. CONST. art. I, § 8, cl. 3 (Congress has the legislative authority “[t]o regulate Commerce with foreign Nations, and among the several States.”).

<sup>101</sup> *See* *United States v. Lopez*, 514 U.S. 549, 559 (1995).

<sup>102</sup> *See, e.g., Wickard v. Filburn*, 317 U.S. 111, 124 (1942).

<sup>103</sup> *See* RIAA Amicus Brief, *supra* note 36, at 3 (stating that “[t]he recording industry is a major sector of the U.S. economy, with 1997 sales exceeding \$12 billion”).

<sup>104</sup> *See* *United States v. Moghadam*, 175 F.3d 1269, 1276 (11th Cir. 1999).

<sup>105</sup> *See* Nimmer, *supra* note 32, at 1409 (“[N]o respectable interpretation of the word ‘Writings’ embraces an untaped performance of someone singing at Carnegie Hall.”); *see also* Susan M. Deas, *Jazzing up the Copyright Act? Resolving the Uncertainties of the United States Anti-Bootlegging Law*, 20 HASTINGS COMM. & ENT. L.J. 567, 570 (1998) (“The most obvious constitutional departure . . . is how [the anti-bootlegging statutes]

Some espoused a broad “structuralist” approach to constitutional interpretation that proscribed the use of the Commerce Clause to make “end runs” around the express limitations of the Copyright Clause.<sup>106</sup> Others viewed the Intellectual Property Clause as an independent grant of Congressional authority.<sup>107</sup>

### 1. Traditional View of the Intellectual Property Clause

Traditionally, the Copyright Clause has been viewed as an entirely positive grant of power to Congress.<sup>108</sup> The copyright power permits Congress to vest authors with the right to exclude others from unauthorized reproduction, distribution, performance, display, and adaptation of their work.<sup>109</sup> This grant traditionally

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extend[] protection to unfixed material under the authority of a congressional enactment.”).

<sup>106</sup> See Paul J. Heald & Suzanna Sherry, *Implied Limits on the Legislative Power: The Intellectual Property Clause as an Absolute Constraint on Congress*, 2000 U. ILL. L. REV. 1119, 1177 (arguing that the history and structure of the Intellectual Property Clause militates against Congressional authority to enact certain legislation); Jaszi, *supra* note 88, at 602–05; Robert Patrick Merges & Glenn Harlan Reynolds, *The Proper Scope of the Copyright and Patent Power*, 37 HARV. J. ON LEGIS. 45, 63–64 (2000) (“To allow Congress to do things under its general commerce power that it is forbidden to do under its specifically applicable copyright and patent power would in essence read the Copyright and Patent Clause out of the Constitution.”); William Patry, *The Enumerated Powers Doctrine and Intellectual Property: An Imminent Constitutional Collision*, 67 GEO. WASH. L. REV. 359, 394–97 (1999); Andrew M. Hetherington, Comment, *Constitutional Purpose and Inter-Clause Conflict: The Constraints Imposed on Congress by the Copyright Clause*, 9 MICH. TELECOMM. & TECH. L. REV. 457, 503–06 (2003) (arguing that an impermissible conflict is created whenever Congress acts under any constitutional provision in a manner that frustrates an explicit constitutional purpose set out in a different provision); Joseph C. Merschman, Comment, *Anchoring Copyright Laws in the Copyright Clause: Halting the Commerce Clause End Run Around Limits on Congress’s Copyright Power*, 34 CONN. L. REV. 661, 677 (2002).

<sup>107</sup> See Nachbar, *supra* note 18 (positing that an accurate evaluation of the Intellectual Property Clause’s place in the Constitution requires a new approach that recognizes that not all of the limits of Article I powers are of equal constitutional weight and that considers the constitutional significance of the restrictions in question); see also Shira Perlmutter, *Participation in the International Copyright System as a Means to Promote the Progress of Science and Useful Arts*, 36 LOY. L.A. L. REV. 323, 324 n.5 (2002) (“The text of the preambular phrase in the Copyright Clause does not limit the desired ‘progress of science’ to ‘incentives for creation.’ Thus, even assuming the phrase operates as a substantive constraint on congressional power, it does not prevent Congress from considering the entire range of possible means by which progress may be promoted.”).

<sup>108</sup> Hetherington, *supra* note 106, at 484–85.

<sup>109</sup> See 17 U.S.C. § 106 (2000 & Supp. 2002).

has been construed as an incentives scheme.<sup>110</sup> Without exclusive rights, free-riders would sell works at unreasonably low prices that do not reflect the time and effort invested in their production.<sup>111</sup> This would drive authors from the market.<sup>112</sup> Congress' copyright power avoids this loss of intellectual potential by authorizing Congress "to promote the progress of science and the useful arts" by granting a limited monopoly.<sup>113</sup> Therefore, copyright is an economic policy affecting private business interests and does not implicate larger constitutional concerns that would affect Congress' ability to act under another Section 8 power.<sup>114</sup> Proponents of Congress' authority to enlarge the scope of these incentives beyond the limits of the Copyright Clause point to cases where Congress has enacted legislation under one Constitutional power to achieve an end proscribed under another.<sup>115</sup>

In *Heart of Atlanta Motel, Inc. v. United States*,<sup>116</sup> the Supreme Court held that the Commerce Clause justified the public accommodations provisions of the Civil Rights Act of 1964,<sup>117</sup> even though similar provisions proscribing private discrimination within the Civil Rights Act of 1875<sup>118</sup> had been declared beyond the scope of Congress' authority under § 5<sup>119</sup> of the Fourteenth Amendment.<sup>120</sup> This illustrates the general proposition that Congress' various grants of authority, in this case the 14<sup>th</sup>

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<sup>110</sup> See generally SCHECHTER & THOMAS, *supra* note 64, § 1.3.1.

<sup>111</sup> See Stewart E. Sterk, *Rhetoric and Reality in Copyright Law*, 94 MICH. L. REV. 1197, 1204 (1996).

<sup>112</sup> *Id.* (At a price derived from a copyright-free world "the author would realize no financial return on his investment in creating the work. In this world, only authors unconcerned with financial return would produce creative works.") (citing William M. Landes & Richard A. Posner, *An Economic Analysis of Copyright Law*, 18 J. LEGAL STUD. 325, 328 (1989)).

<sup>113</sup> *Id.*; see also U.S. CONST. art. I, § 8, cl. 8.

<sup>114</sup> See Nachbar, *supra* note 18, at 291.

<sup>115</sup> *Id.*

<sup>116</sup> *Heart of Atlanta Motel, Inc. v. United States*, 379 U.S. 241, 250 (1964).

<sup>117</sup> Pub. L. No. 88-352, 78 Stat. 241 (1964).

<sup>118</sup> 43 Cong. Ch. 114, 18 Stat. 335 (1875).

<sup>119</sup> See U.S. CONST. amend. XIV (providing that "[t]he Congress shall have power to enforce, by appropriate legislation, the provisions of [the Fourteenth Amendment]").

<sup>120</sup> See *The Civil Rights Cases*, 109 U.S. 3, 26 (1883) (holding that "the act[s] of [C]ongress of March 1, 1875, entitled 'An act to protect all citizens in their civil and legal rights,' are unconstitutional and void . . .").

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Amendment and the Commerce Clause, may operate independently and in the alternative to one another.<sup>121</sup>

In *The Trademark Cases*, the Supreme Court held that the Copyright Clause could not sustain the 1876 Trademark Act because a trademark “is simply founded on priority of appropriation” and not on originality in authorship.<sup>122</sup> Although that Court found that the Act was not justified by the Commerce Clause either, under the modern concept of the Commerce Clause,<sup>123</sup> the Act would have been upheld. The constitutionality of modern federal trademark laws<sup>124</sup> therefore attests to Congress’ ability to enact intellectual property laws that are beyond the scope of Article I, Section 8, Clause 8 by using its Article I, Section 8, Clause 3 authority.<sup>125</sup>

The principle that, generally, Congress’ enumerated powers are nonexclusive is also supported by *Authors League of America, Inc. v. Oman*,<sup>126</sup> in which the Second Circuit held that a statute withholding copyright protection for imported publications<sup>127</sup> and

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<sup>121</sup> See, e.g., *Nevada Dep’t of Human Res. v. Hibbs*, 538 U.S. 721 (2003).

<sup>122</sup> *The Trade-Mark Cases*, 100 U.S. 82, 94 (1879).

<sup>123</sup> The 1870 Act did not have a jurisdictional component that would limit its scope to interstate commerce. The modern view of the Commerce Clause permits intrastate regulation of matters that “substantially affect” interstate commerce, such as trademarks. See, e.g., *Wickard v. Filburn*, 317 U.S. 111, 123–24 (1942).

<sup>124</sup> Trademark Act of 1946 (Lanham Act), 60 Stat. 427 (1946) (codified as amended in scattered sections of 15, 17, and 28 U.S.C.).

<sup>125</sup> In *The Trade-Mark Cases* and *Heart of Atlanta*, the Court did not explicitly address the question of whether Congress may enact legislation under the Commerce Clause that is precluded from enactment under Constitutional provision. See, e.g., Maya Pollack, *Unconstitutional Incontestability? The Intersection of the Intellectual Property and Commerce Clauses of the Constitution: Beyond a Critique of Shakespeare Co. v. Silstar Corp.*, 18 SEATTLE U. L. REV. 259, 297–98 (1995) (noting that the Court did allude to Congressional power to enact legislation outside of the Intellectual Property Clause).

<sup>126</sup> *Authors League of Am., Inc. v. Oman*, 790 F.2d 220 (2d Cir. 1986) (Oakes, J., concurring).

<sup>127</sup> See 17 U.S.C. § 601(a) (2000). The “manufacturing clause” protected domestic printers by restricting the ability of foreign printers to receive copyright protection for books shipped to the United States:

[T]he importation into or public distribution in the United States of copies of a work consisting preponderantly of nondramatic literary material that is in the English language and is protected under this title is prohibited unless the portions consisting of such material have been manufactured in the United States or Canada.

codified within the Copyright Act, could not be sustained under the Copyright Clause because the statute did not “promote the Progress of . . . useful Arts.”<sup>128</sup> Instead, the *Authors League* court found that the statute was a legitimate exercise of its Commerce Clause power to regulate commerce with foreign nations.<sup>129</sup>

Under this traditional view, the express and implied limitations of the Intellectual Property Clause—namely the requirements that the work be a “Writing,” that protection be extended only for “limited Times,” and that the progress of Science and the useful Arts be promoted—apply only when Congress is legislating under that power, and should not hinder Congress’ ability to enact copyright-like legislation under the Commerce Clause.<sup>130</sup>

## 2. Structuralist Views of the Intellectual Property Clause

A pattern of recent holdings has signaled to many observers that the Rehnquist Court has rejected the view that each of Congress’ enumerated powers is “hermetically sealed . . . such that Congress may ignore the restrictions on its power contained in one clause merely by legislating under another clause.”<sup>131</sup> Instead, the Court seems to have adopted a structural approach to defining the scope of Congress’ enumerated powers.<sup>132</sup>

In *United States v. Lopez*, the Court put an end to fifty years of judicial deference to Congress’ own conception of its Commerce Clause authority.<sup>133</sup> Striking down the Gun Free School Zones Act

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<sup>128</sup> *Authors League*, 790 F.2d at 223–24.

<sup>129</sup> *Id.* (“In our view, denial of copyright protection to certain foreign-manufactured works is clearly justified as an exercise of the legislature’s power to regulate commerce with foreign nations.”). However, the Second Circuit did not determine that the challenged statute had actually violated an express limit of the Copyright Clause. *Id.*

<sup>130</sup> See *United States v. Moghadam*, 175 F.3d 1269, 1277 (11th Cir. 1999) (“[E]ach of the powers of Congress is alternative to all of the other powers, and what cannot be done under one of them may very well be doable under another.”); see also *Heart of Atlanta Motel, Inc. v. United States*, 379 U.S. 241 (1964).

<sup>131</sup> Patry, *supra* note 106, at 371 (1999); see also *supra* note 106.

<sup>132</sup> See generally MURPHY ET AL., *supra* note 21, ch. IV, § VI.

<sup>133</sup> *United States v. Lopez*, 514 U.S. 549, 567–68 (1995) (“[S]ome of our prior cases have taken long steps down that road, giving great deference to congressional action . . . . The broad language in these opinions has suggested the possibility of additional expansion, but we decline here to proceed any further. To do so would require us to conclude that the Constitution’s enumeration of powers does not presuppose something



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of 1990, the Court held “that [the commerce] power is subject to outer limits” and that Congress could not use its authority to regulate commerce in a way that “would effectually obliterate the distinction between what is national and what is local . . . .”<sup>134</sup> In *United States v. Morrison*, the Court reiterated this limiting view of the Commerce Clause, holding that Congress had exceeded its commerce power in granting a private right of action to redress gender-motivated violence.<sup>135</sup> In these and other decisions such as *Printz v. United States*,<sup>136</sup> *City of Boerne v. Flores*,<sup>137</sup> and *Clinton v. New York*,<sup>138</sup> the Court has shown a readiness to invalidate legislation that exceeds the defined and limited powers of the federal government.<sup>139</sup>

In *Railway Labor Executives’ Ass’n v. Gibbons*,<sup>140</sup> the Court struck down a Commerce Clause statute that conflicted with the Bankruptcy Clause, another Article I, Section 8 power of Congress.<sup>141</sup> The Rock Island Transition and Employee Assistance Act (RITA) provided former employees of the bankrupt Chicago, Rock Island, and Pacific Railroad Company with unemployment benefits valued at seventy-five million dollars.<sup>142</sup> These funds were to be distributed from the company’s bankruptcy estate with priority over the claims of unsecured creditors.<sup>143</sup> The Court found the statute directly conflicted with the uniformity requirement of

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not enumerated, . . . and that there never will be a distinction between what is truly national and what is truly local . . . . This we are unwilling to do.”)

<sup>134</sup> *Id.* at 557.

<sup>135</sup> *United States v. Morrison*, 529 U.S. 598, 601–02 (2000) (holding the Violence Against Women Act of 1994 (“VAWA”) unconstitutional for lack of Congressional authority either under the Commerce Clause or the enactment provision of the Fourteenth Amendment). This holding, as well as the holding in *Lopez*, 514 U.S. 549, is compelled by the implied limits of federalism, while others have enforced the structural implications of the separation of powers. *See generally* MURPHY ET AL., *supra* note 21, at 548–56.

<sup>136</sup> 521 U.S. 898 (1997) (striking down provisions of the Brady Handgun Bill).

<sup>137</sup> 521 U.S. 507 (1997) (striking down the Religious Freedom Restoration Act).

<sup>138</sup> 524 U.S. 417 (1998) (striking down the Line Item Veto Act).

<sup>139</sup> *See supra* notes 133–38; *Marbury v. Madison*, 5 U.S. (1 Cranch) 137, 176 (1803) (“The powers of the legislature are defined, and limited . . . .”).

<sup>140</sup> 455 U.S. 457 (1982).

<sup>141</sup> *See* U.S. CONST. art. I, § 8, cl. 4.

<sup>142</sup> *Gibbons*, 455 U.S. at 462.

<sup>143</sup> *Id.* at 463.

the Bankruptcy Clause.<sup>144</sup> Justice Rehnquist expressed the view of the Court that a specific limitation on one of Congress' enumerated powers<sup>145</sup> may, under some circumstances, restrict Congress' ability to legislate under an alternative power:<sup>146</sup>

Unlike the Commerce Clause, the Bankruptcy Clause itself contains an affirmative limitation or restriction upon Congress' power: bankruptcy laws must be uniform throughout the United States . . . . Thus, if we were to hold that Congress had the power to enact nonuniform bankruptcy laws pursuant to the Commerce Clause, we would eradicate from the Constitution a limitation on the power of Congress to enact bankruptcy laws.<sup>147</sup>

Like the Bankruptcy Clause, the Intellectual Property Clause incorporates specific terms of limitation.<sup>148</sup> Therefore, if *Gibbons* applies as a general rule by preventing Congress from avoiding other Article I, Section 8 limitations by invoking other, broader clauses, then Congress is proscribed from enacting copyright-like laws under the Commerce Clause.<sup>149</sup>

a) William Patry's "Negative Right"

William Patry posits that "[u]nder the Court's structural approach, Article I, Section 8, Clause 8 contains both positive and negative rights: a positive right to grant authors a limited monopoly in their original material, and a negative right in the public to copy unoriginal material."<sup>150</sup> Professor Patry and other

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<sup>144</sup> *Id.* at 468–69.

<sup>145</sup> See U.S. CONST. art. I, § 8 (containing 17 clauses enumerating Congress legislative powers).

<sup>146</sup> *Gibbons*, 455 U.S. at 468–69.

<sup>147</sup> *Id.*

<sup>148</sup> See Pollack, *supra* note 125, at 320 (“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.”).

<sup>149</sup> See *supra* notes 148–55.

<sup>150</sup> Patry, *supra* note 106, at 362.

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commentators maintain that *Bonito Boats v. Thundercraft Boats*<sup>151</sup> and *Feist Publications v. Rural Telephone Service*,<sup>152</sup> two unanimous decisions authored by Justice O'Connor, have imported the Court's structural approach into the heart of the Intellectual Property Clause.<sup>153</sup> Taken together, these decisions establish a constitutional floor to Clause 8, holding that the means by which the progress of science and the useful arts is promoted is by making the "building blocks" of creativity, facts and ideas, available to the public.<sup>154</sup> Public access to uncopyrightable and unpatentable subject matter, as well as access to copyrightable and patentable subject matter after the period of protection expires, is therefore the benefit of the bargain contemplated in the Constitution: limited monopoly rights in original works in exchange for public access to the ideas and facts they embody.<sup>155</sup> The scope of this "negative right," and whether it acts as an absolute bar to legislation of copyright-like statutes under the Commerce Clause, is the subject of vigorous debate and the nub of the issue in controversy in *Moghadam*,<sup>156</sup> *Martignon*,<sup>157</sup> and *KISS Catalog*.<sup>158</sup>

b) Thomas Nachbar's "Constitutional Norms"

Thomas Nachbar's structural approach to the enumerated powers of Congress suggests that the Intellectual Property Clause should operate independently of other clauses.<sup>159</sup> Professor

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<sup>151</sup> 489 U.S. 141 (1988) ("[T]he 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, nor may it 'authorize the issuance of patents whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already available.'") (citing *Graham v. John Deere Co.*, 383 U.S. 1, 6 (1966)).

<sup>152</sup> 499 U.S. 340 (1991). In *Feist*, the Court, reaching the constitutional issue *sua sponte*, stated plainly that originality is "a constitutional requirement" and the essence of copyright. *Id.* at 346.

<sup>153</sup> See Patry, *supra* note 106, at 367.

<sup>154</sup> See *Feist*, 499 U.S. at 350 ("[T]he raw facts may be copied at will. This result is neither unfair nor unfortunate. It is the means by which copyright advances the progress of science and art.").

<sup>155</sup> *Id.*

<sup>156</sup> 175 F.3d 1269 (11th Cir. 1999).

<sup>157</sup> 346 F. Supp. 2d 413 (S.D.N.Y. 2004).

<sup>158</sup> 350 F. Supp. 2d 823 (C.D. Cal. 2004).

<sup>159</sup> See generally Nachbar, *supra* note 18.

Nachbar suggests that “whether a specific restriction on a specific Article I power must be read externally depends on whether it reflects an enforceable constitutional norm.”<sup>160</sup> A “constitutional norm” inheres in the fabric of the Constitution.<sup>161</sup> Certain norms, when present, tend to narrow the scope of Congress’ enumerated powers and broaden the effect of its limitation upon other enumerated powers.<sup>162</sup> These “narrowing norms” include federalism, the separation of powers, and the individual liberty that is the foundation of many substantive constitutional rights.<sup>163</sup> Professor Nachbar’s analysis finds that in the case of the Intellectual Property Clause, such narrowing norms operate weakly, if at all.<sup>164</sup> Instead, the countervailing constitutional norm of favoring legislation by the representative branch of government in matters of economic policy is controlling.<sup>165</sup> Professor Nachbar finds that the values underlying Article I, Section 8, Clause 8 are served best through judicial deference to Congress<sup>166</sup>—the approach that the Supreme Court has consistently taken to federal copyright legislation.<sup>167</sup>

Professor Nachbar’s method recognizes that “a variety of values are served by the Section 8 limitations,”<sup>168</sup> and offers a means to navigate between the poles flagged by *Gibbons*<sup>169</sup> and

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<sup>160</sup> *Id.* at 317.

<sup>161</sup> *Id.* (a constitutional norm means a rule “required by and even inherent” in the Constitution).

<sup>162</sup> *Id.* at 318.

<sup>163</sup> *Id.*

<sup>164</sup> *Id.* at 361–62.

<sup>165</sup> *Id.* at 318 (“When the regulation is economic in character—as is intellectual property legislation—the preference for representative government means that constitutional ambiguities affecting Congress’s power are read in Congress’s favor.”).

<sup>166</sup> *Id.* at 291 (“There is simply no way to characterize the limits in the Intellectual Property Clause as so fundamental to the constitutional order as to warrant their inference as a matter of structure . . . . The Intellectual Property Clause’s limits reflect a policy choice about the reach of a relatively insignificant form of economic regulation allocating quasi-property rights between private entities.”).

<sup>167</sup> The Supreme Court has never struck down a statute enacted pursuant to the Copyright Act except for the first federal Trademark Act which was later revisited in the Lanham Act and promulgated under the Commerce Clause. *See supra* notes 122–25 and accompanying text.

<sup>168</sup> Nachbar, *supra* note 18, at 317. Not all Section 8 limits are alike. *Compare Gibbons*, 455 U.S. at 462, with *Heart of Atlanta*, 379 U.S. at 250.

<sup>169</sup> *See supra* notes 140–46 and accompanying text.

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*Heart of Atlanta Motel*.<sup>170</sup> According to this analysis, the Intellectual Property Clause exerts no control over other enumerated powers and Congress' Commerce Clause authority to enact copyright-like laws is unencumbered.<sup>171</sup>

*D. United States v. Moghadam*

Five years before *United States v. Martignon*, the constitutionality of the anti-bootlegging statute was considered and upheld by the Eleventh Circuit in *United States v. Moghadam*.<sup>172</sup>

1. Facts and Procedural History

Ali Moghadam arrived in Orlando, Florida, expecting to visit Disney World and to make some business deals.<sup>173</sup> Unbeknownst to him, the invitation was the climax of a year-long undercover operation by the United States Customs Service, dubbed "Operation Goldmine."<sup>174</sup> The sting yielded eleven arrests and approximately 800,000 compact discs containing bootleg recordings of performances by the Grateful Dead, Dave Matthews Band, Bruce Springsteen, Phish, Smashing Pumpkins, Tori Amos, and the Beastie Boys, amongst others.<sup>175</sup>

Ali Moghadam was convicted of violating 18 U.S.C. 2319A by "knowingly distributing, selling, and trafficking in" unauthorized compact discs of live concerts.<sup>176</sup> On appeal he argued that the statute was unconstitutional because it could not be legitimately enacted under any of Congress' enumerated Article I, § 8 powers.<sup>177</sup> The court rejected Moghadam's constitutional

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<sup>170</sup> See *supra* notes 116–21 and accompanying text.

<sup>171</sup> See Nachbar, *supra* note 18, at 297 ("There is nothing about the arrangement of powers and limitations in the Intellectual Property Clause to suggest that its limitations, even its express limitations, reach beyond the Clause itself. The limitation is on a power, which in turn is bounded by the grant.").

<sup>172</sup> *United States v. Moghadam*, 175 F.3d 1269 (11th Cir. 1999).

<sup>173</sup> See Paul Farhi, *CD Bootleggers Face the Music: Supply of Illegal Recordings Shrinks after Customs Crackdown*, WASH. POST, July 14, 1997, at A1.

<sup>174</sup> *Id.*

<sup>175</sup> *Id.*

<sup>176</sup> *United States v. Moghadam*, 175 F.3d 1269, 1271 (11th Cir. 1999).

<sup>177</sup> *Id.*

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challenge and affirmed his conviction.<sup>178</sup> Moghadam's applications for rehearings and for a writ of certiorari were denied.<sup>179</sup>

## 2. Summary of the *Moghadam* Opinion

The Eleventh Circuit first considered the nature of the anti-bootlegging statutes,<sup>180</sup> and it found that they were best described as "quasi-copyright" or *sui generis* statutes "that in some ways resemble the protections of copyright law but in other ways are distinct from them."<sup>181</sup> The court noted that the civil statute was codified in Title 17 and utilized the remedy for copyright infringement, yet seemed to lack the Copyright Act's requirements of limited duration and fixation.<sup>182</sup> The court also noted that the statutes were less extensive than copyright, conferring only the right to prevent the making of unauthorized sound recordings or transmissions.<sup>183</sup>

The court next considered whether the "quasi-copyright" statute was consistent with the Copyright Clause.<sup>184</sup> After briefly reviewing the historically expanding meaning of the term "Writings," the court declined to decide whether "Writings" could be broadened to encompass live performances.<sup>185</sup> Instead, the court assumed *arguendo* that the lack of fixation precluded the use of the Copyright Clause as a source of congressional authority and

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<sup>178</sup> *Id.*

<sup>179</sup> *Moghadam*, 175 F.3d 1269, *reh'g en banc denied*, 193 F.3d 525 (11th Cir. 1999), *cert. denied*, 529 U.S. 1036 (2000).

<sup>180</sup> *Id.* at 1273.

<sup>181</sup> *Id.* at 1272.

<sup>182</sup> *Id.* at 1273.

<sup>183</sup> *Id.* In contrast the copyright clause provides for six exclusive rights. Although not all of these may apply in any particular work, typically three or more do apply. *See* 17 U.S.C. § 106 (2000 & Supp. 2002).

<sup>184</sup> *Id.* The only question raised on appeal was whether the lack of a fixation requirement rendered the statute unconstitutional, and thus, the court declined to consider whether the absence of a limited duration would render the statute unconstitutional.

<sup>185</sup> *Id.* at 1273–74 (citing *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884); *Goldstein v. California*, 412 U.S. 546, 561 (1973) ("[W]ritings . . . may be interpreted to include any physical rendering of the fruits of creative intellectual or aesthetic labor.") (citations omitted)).

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proceeded to uphold the statute based on an alternative source of authority: the Commerce Clause.<sup>186</sup>

The court pointed out that Congress' failure to cite the Commerce Clause as grounds for § 2319A did not dispose of the question of Constitutional authority.<sup>187</sup> Then, applying the test developed in *United States v. Lopez*, the court asked "whether a rational basis existed for concluding that a regulated activity sufficiently affected interstate commerce."<sup>188</sup> Considering the commercial subject of the statute,<sup>189</sup> its context as implementation of an international trade accord administered by the World Trade Organization, and the "deleterious economic effect" bootlegging has on the recording industry, the court found that § 2319A "clearly prohibits conduct that has a substantial effect on both commerce between the several states and commerce with foreign nations."<sup>190</sup>

Having found that the anti-bootlegging statute meets the *Lopez* test, the court next addressed the more difficult question of whether Congress could use its Commerce Clause power "to avoid

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<sup>186</sup> *Id.* at 1280 n.12 ("We assume *arguendo*, without deciding, that the Commerce Clause could not be used to avoid a limitation in the Copyright Clause if the particular use of the Commerce Clause (e.g., the anti-bootlegging statute) were fundamentally inconsistent with the particular limitation in the Copyright Clause (e.g., the fixation requirement).").

<sup>187</sup> *Id.* at 1275 n.10 ("[T]he constitutionality of action taken by Congress does not depend on recitals of the power which it undertakes to exercise,' *Woods v.loyd W. Miller Co.*, 333 U.S. 138, 144 (1948), and '[i]n exercising the power of judicial review,' we look only at 'the actual powers of the national government,' *Timmer v. Michigan Dep't of Commerce*, 104 F.3d 833, 839 (6th Cir. 1997).") (citations altered).

<sup>188</sup> *United States v. Lopez*, 514 U.S. 549, 558–59 (1995). In *Lopez*, the Court held that the Commerce Clause empowers Congress to legislate regarding three things: (i) the use of channels of interstate commerce; (ii) instrumentalities and persons or things in interstate commerce; and (iii) intrastate activities that substantially affect interstate commerce. The *Moghadam* court focused on this third category.

<sup>189</sup> In the absence of legislative findings of an interstate commercial nexus and in the absence of a jurisdictional limit, the *Moghadam* court would have to "determine independently whether the statute regulates 'activities that arise out of or are connected with a commercial transaction, which viewed in the aggregate, substantially affect[ ] interstate commerce.'" *Moghadam*, 175 F.3d at 1276 (citing *United States v. Olin Corp.*, 107 F.3d 1506, 1509 (11th Cir. 1997) (citation omitted)).

<sup>190</sup> *Id.*

the limitations that might prevent it from passing the same legislation under the Copyright Clause.”<sup>191</sup>

After a review of the relevant case law, the *Moghadam* court held that the various grants of legislative authority act independently and in the alternative to the other powers.<sup>192</sup> In support of Ali Moghadam’s position that the Copyright Clause limits Congress’ Commerce Clause authority, the court considered *Railway Labor Executives’ Ass’n v. Gibbons*.<sup>193</sup> The *Moghadam* court found that the Court’s decision to restrict the use of the commerce power in *Gibbons* was the result of a direct conflict between the statute and the uniformity requirement of the Bankruptcy Clause.<sup>194</sup> The court found that no such direct conflict was present in the case in controversy.<sup>195</sup>

Using a “circumscribed analysis,” the court resolved the tension between the *Heart of Atlanta Motel* jurisprudence and *Gibbons* by finding that the Copyright Clause itself is a positive grant which “does not imply any negative pregnant that suggests that the term ‘Writings’ operates as a ceiling on Congress’ ability to legislate pursuant to other grants.”<sup>196</sup> The court further found that the anti-bootlegging statute furthered the purpose of, and was “in no way inconsistent with,” the Copyright Clause.<sup>197</sup> Therefore, *Gibbons* could not control and the statute was a legitimate use of Congress’ commerce power under the Commerce Clause.<sup>198</sup>

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<sup>191</sup> *Id.* at 1277.

<sup>192</sup> *Id.* (“[E]ach of the powers of Congress is alternative to all of the other powers, and what cannot be done under one of them may very well be doable under another.”) (discussing *Heart of Atlanta, Inc. v. United States*, 370 U.S. 241 (1964)).

<sup>193</sup> 455 U.S. 457 (1982); *see supra* notes 140–47 and accompanying text.

<sup>194</sup> *Moghadam*, 175 F.3d at 1279.

<sup>195</sup> *Id.* at 1279–80.

<sup>196</sup> *See id.* at 1279–80 (qualifying that “[t]he Commerce Clause cannot be used by Congress to eradicate a limitation placed upon Congressional power in another grant of power” but nonetheless stating “that in some circumstances the Commerce Clause can be used by Congress to accomplish something that the Copyright Clause might not allow”).

<sup>197</sup> *Id.* at 1280.

<sup>198</sup> *Id.*



## II. THE *MARTIGNON* AND *KISS CATALOG* DECISIONS

Five years after the Eleventh Circuit decision in *Moghadam*, United States District Courts in the Second and Ninth Circuits revisited the question of the constitutionality of the anti-bootlegging statutes.<sup>199</sup> Despite gestures to distinguish the cases, these opinions are directly contrary to the holding of the *Moghadam* court.<sup>200</sup> These decisions apply the rationale of *Gibbons* as a bright-line rule.

### A. United States v. Martignon

#### 1. Facts and Procedural History

In September 2003, Jean Martignon was arrested by federal and state law enforcement agents for selling bootleg recordings on the web, in catalogs, and in a shop through his business “Midnight Records.”<sup>201</sup> On October 27, 2003, Martignon was indicted by a federal grand jury for violating 18 U.S.C. § 2319A.<sup>202</sup> The indictment included no details as to “the artists that Martignon allegedly bootlegged, the scope of the bootlegging, or the distribution of bootlegged works.”<sup>203</sup> On January 15, 2004, the defendant moved for dismissal on the grounds that the anti-bootlegging statute was unconstitutional.<sup>204</sup> In the Opinion and Order dated September 24, 2004, the motion was granted.<sup>205</sup> The Attorney General filed a Notice of Appeal in the Second Circuit on October 22, 2004 and Oral Arguments were heard on July 12, 2005.<sup>206</sup>

#### 2. *United States v. Martignon* Summary

The *Martignon* opinion moves briskly to the determination that, although the anti-bootlegging statute does substantially affect

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<sup>199</sup> See *infra* Parts II.A–B.

<sup>200</sup> See *infra* Parts II.A–B.

<sup>201</sup> See *United States v. Martignon*, 346 F. Supp. 2d 413, 417 (S.D.N.Y. 2004).

<sup>202</sup> *Id.*

<sup>203</sup> *Id.*

<sup>204</sup> *Id.*

<sup>205</sup> *Id.* at 429.

<sup>206</sup> See *supra* note 11.

interstate and international commerce, it may only be enacted under the Copyright Clause because it is “copyright-like” in nature.<sup>207</sup> As such, the statute failed both the fixation requirement and the limited times requirement of the Copyright Clause and is therefore unconstitutional.<sup>208</sup>

As an alternate ground for its holding, the *Martignon* court found that “even if Congress may legislate copyright-like statutes under other Section 8 powers, the express limit of durations must be adhered to because copyright-like protection must have boundaries in order to counter-balance the grant of monopoly power to the artist.”<sup>209</sup> Therefore, the court held that the absence of a durational limitation rendered the statute “fundamentally inconsistent” with Copyright Clause.<sup>210</sup>

The court first inquired into the nature of the anti-bootlegging statute and found that it was primarily copyright-like.<sup>211</sup> The court pointed out that the anti-bootlegging statute was enacted in order to comply with TRIPs, which “dealt completely with intellectual property,”<sup>212</sup> and that the Senate Report on the Uruguay Round Agreement Act described the statutes under the general subheading “Copyright Provisions.”<sup>213</sup>

The court was also swayed by the fact that the civil anti-bootlegging statute was codified within the Copyright Act itself<sup>214</sup> and that the criminal anti-bootlegging statute was positioned next to the criminal infringement statute.<sup>215</sup> In addition, it observed that the statute refers to the definition of terms provided within the Copyright Act and utilizes the phrase “for purposes of commercial

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<sup>207</sup> See *Martignon*, 346 F. Supp. 2d at 428–29.

<sup>208</sup> See *id.* at 429 (“The anti-bootlegging statute’s failure to impose a durational limitation on its regulation is ‘fundamentally inconsistent’ with the Copyright Clause’s requirement that copyright-like regulations only persist for ‘Limited Times.’”).

<sup>209</sup> See *id.* at 428–29.

<sup>210</sup> *Id.*

<sup>211</sup> See *Martignon*, 346 F. Supp. 2d at 422 (“Based on the anti-bootlegging statute’s language, history, and placement, it is clearly a copyright-like regulation.”).

<sup>212</sup> *Id.* at 420.

<sup>213</sup> *Id.* at 421 (citing the SENATE REPORT ON THE URUGUAY ROUND AGREEMENT ACT, S. REP. NO. 103-412, at 225 (1994)); see also *supra* note 72 and accompanying text.

<sup>214</sup> See 17 U.S.C. § 1101 (2000); see also *supra* note 8 and accompanying text.

<sup>215</sup> See 18 U.S.C. § 2319A (2000); see also *supra* note 8 and accompanying text.

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advantage or private financial gain,” which appears in the criminal infringement statute.<sup>216</sup>

The court finally concluded that the statute is primarily copyright-like, based on “a plain reading of the statute [which] makes evident that its purpose is synonymous with that of the Copyright Clause” and that “it was enacted primarily to cloak artists with copyright-like protection.”<sup>217</sup>

The *Martignon* opinion holds what *Moghadam* assumed *arguendo*: the anti-bootlegging statute cannot satisfy the “Writings” requirement of the Copyright Clause because a live performance is not fixed.<sup>218</sup> The court applied the structural model of the relationship between the enumerated powers as articulated by the Supreme Court in *Gibbons*,<sup>219</sup> and by William Patry<sup>220</sup> with mechanical precision: (1) The statute is primarily copyright-like;<sup>221</sup> (2) the Copyright Clause contains the limitations of duration<sup>222</sup> and fixation;<sup>223</sup> (3) the statute is inconsistent with both of these limits;<sup>224</sup> (4) therefore, Congress may not use the Commerce Clause to bypass the Copyright Clause;<sup>225</sup> and (5) the statute is unconstitutional under the Copyright Clause.<sup>226</sup>

The *Martignon* court’s insistence on classifying the statute based on its purpose is now clear. If the clause may be classified as “copyright-like” then it is categorically confined to Congress’

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<sup>216</sup> *Martignon*, 346 F. Supp. 2d at 421 (citing 18 U.S.C. § 2319A(e)(1) (2000)) (“[T]he terms ‘copy’, ‘fixed’, ‘musical work’, ‘phonorecord’, ‘reproduce’, ‘sound recordings’, and ‘transmit’ mean those terms within the meaning of title 17.”).

<sup>217</sup> *Id.* at 420–22 (emphasis added).

<sup>218</sup> *Id.* at 423–24.

<sup>219</sup> *Ry. Labor Executives’ Ass’n v. Gibbons*, 455 U.S. 457 (1982); see U.S. CONST. art. I, § 8 (conferring all of Congress’ enumerated powers).

<sup>220</sup> See *Martignon*, 346 F. Supp. 2d at 425 n.16. See generally Patry, *supra* note 106.

<sup>221</sup> See *supra* notes 212–17 and accompanying text.

<sup>222</sup> See U.S. CONST. art. I, § 8, cl. 8; see also 17 U.S.C. § 302(a) (2000) (establishing a basic copyright term of life of the author plus 70 years).

<sup>223</sup> See U.S. CONST. art. I, § 8, cl. 8; see also *Bleistein v. Donaldson Lithographic*, 188 U.S. 239 (1903).

<sup>224</sup> See *Martignon*, 346 F. Supp. 2d at 422–24 (Part II.C: “Sustainability of the Anti-Bootlegging Statute Under the Copyright Clause”).

<sup>225</sup> See *id.* at 424–29 (Part II.D: “When Copyright Clause Power Conflicts With Commerce Clause Power”).

<sup>226</sup> *Id.*

copyright authority, and as such, the anti-bootlegging statute may not be sustained under alternative authority.<sup>227</sup>

The *Martignon* holding echoes the holding in *Gibbons*:

[W]hen Congress enacts copyright or copyright-like legislation, for the purpose stated in the Copyright Clause, it is constrained by the Copyright Clause's boundaries. Finding otherwise, as cautioned by *Ry. Labor Execs.' Ass'n*, would grant Congress the ability "to repeal the [fixation and durational] requirement[s]" of Art. I, § 8 cl. 8 of the constitution.<sup>228</sup>

Thus, the *Martignon* court applied *Gibbons* as a model and reached the same result. Express limits on one of Congress' enumerated powers impliedly limit Congressional discretion to legislate under another.

#### B. *KISS Catalog v. Passport International Productions, Inc.*

Only three months after the Southern District of New York entered its Opinion and Order in *Martignon*, the Central District of California entered its Opinion and Order<sup>229</sup> in *KISS Catalog*,<sup>230</sup> reaching a similar result based on the same rationale.

##### 1. Facts

On July 10, 1976, KISS<sup>231</sup> performed at New Jersey's Roosevelt Stadium as part of its "Spirit of '76" tour.<sup>232</sup> The

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<sup>227</sup> See *id.* at 426 n.17 ("Congress is not bound by the Copyright Clause's limitations when it legislates in an unrelated field and enacts legislation for a purpose other than the one embodied in the Copyright Clause. However, when Congress enacts copyright or copyright-like legislation, for the purpose stated in the Copyright Clause, it is constrained by the Copyright Clause's boundaries.").

<sup>228</sup> *Id.* at 426 (citing *Gibbons*, 455 U.S. at 468–69).

<sup>229</sup> The *Martignon* Order was entered on Sept. 24, 2004 and *KISS Catalog* on Dec. 21, 2004.

<sup>230</sup> *Kiss Catalog v. Passport Int'l Prods., Inc.*, 350 F. Supp. 2d 823 (C.D. Cal. 2004).

<sup>231</sup> KISS is a New York City-based band that became famous in the mid-1970s and is attributed with inventing much of the musical genre "heavy metal." The band is known for its elaborate stage shows, loud music, and extravagant costumes. See *KISS*, at [http://en.wikipedia.org/wiki/KISS\\_%28band%29](http://en.wikipedia.org/wiki/KISS_%28band%29) (last visited Apr. 11, 2005). See generally GENE SIMMONS, *KISS AND MAKE-UP* (2001).

<sup>232</sup> See *KISS Catalog*, 350 F. Supp. 2d at 825.

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concert promoter, Metropolitan Talent, Inc., (Metropolitan) arranged for three camera video coverage of the concert for simultaneous projection behind the performers.<sup>233</sup> The video-feed was also recorded onto videotape.<sup>234</sup> Thirty years later, in June 2003, Metropolitan's agent licensed "the long-forgotten Roosevelt Concert footage" to the defendant, Passport International Productions, Inc. (Passport).<sup>235</sup> Passport began to sell the video, in DVD format, in October 2003 as *KISS: The Lost Concert*.<sup>236</sup>

In November 2003, the plaintiffs, Kiss Catalog and founding band members/songwriters Gene Klein (a.k.a. Gene Simmons) and Paul Stanley, filed a variety of trademark and state law claims.<sup>237</sup> The court issued a preliminary injunction against continued sales that was reversed by the Ninth Circuit.<sup>238</sup> In August 2004, the plaintiffs added a claim of distributing bootleg recordings in violation of 17 U.S.C. § 1101(a)(3), which creates a cause of action against distributors of bootleg recordings.<sup>239</sup> In October 2004, the plaintiffs added a copyright infringement claim based on a statement by Metropolitan's CEO which averred that the footage was a work-for-hire and KISS was the rightful copyright owner.<sup>240</sup>

Based on the copyright infringement claim, the court issued a preliminary injunction against sales on November 8, 2004.<sup>241</sup> On December 21, 2004, the court granted the defendant's motion to dismiss the anti-bootlegging claim, finding that 17 U.S.C. § 1101(a)(3) was unconstitutional because it violated the "limited Times" requirement of the Copyright Clause.<sup>242</sup>

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<sup>233</sup> *Id.*

<sup>234</sup> *Id.*

<sup>235</sup> *Id.*

<sup>236</sup> *Id.* As of April 11, 2005, this DVD was still available, among other places, at <http://www.mvc.co.uk/common/product.jhtml?pid=30049846>.

<sup>237</sup> See *KISS Catalog*, 350 F. Supp. 2d at 825. KISS Catalog is the holder of KISS trademarks. *Id.*

<sup>238</sup> *KISS Catalog v. Passport Int'l Prods., Inc.*, 108 Fed. Appx. 525 (9th Cir. 2004).

<sup>239</sup> See *KISS Catalog*, 350 F. Supp. 2d at 825.

<sup>240</sup> *Id.*

<sup>241</sup> *Id.*

<sup>242</sup> *Id.* at 833 ("Since the Court cannot include a limited term of its own accord, the Court holds that the current version of the statute creates perpetual copyright-like protection in violation of the 'for limited Times' restriction of the Copyright Clause.").

## 2. Summary of the *KISS Catalog* Opinion

The court first noted that although the civil anti-bootlegging statute had been in existence for a decade, the issue was a matter of first impression for the courts.<sup>243</sup>

The court held that § 1101(a)(3) unconstitutionally extends perpetual protection against the distribution of bootleg phonograms or copies of a performance.<sup>244</sup> In the case at bar, the protection was invoked for an act of distribution that took place twenty-eight years after the original recording had been made.<sup>245</sup> The court found that the plain language of the statute<sup>246</sup> did not establish a durational limit, but applied to any distribution of unauthorized recordings, regardless of when it was originally fixed.<sup>247</sup> The court also held that, although § 1101 was codified within title 17, the Copyright Act's own limits on duration did not apply.<sup>248</sup> Congress had specifically incorporated the remedies found in 17 U.S.C. §§ 502–05; therefore it was “reasonable to conclude that Congress included as much existing copyright law [within § 1101] as it intended.”<sup>249</sup>

Citing the *Martignon* analysis of 18 U.S.C. § 2319A, the court found the anti-bootlegging statutes to be copyright-like,<sup>250</sup> and therefore, in violation of the “limited Times” requirement of the

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<sup>243</sup> *Id.* at 828.

<sup>244</sup> Having found that the civil anti-bootlegging statute is a copyright-like statute the court next considered whether it was constitutional under the Copyright Clause. *Id.* at 831–32. Referencing the *Moghadam* court's discussion of the scope of the fixation requirement, the *KISS* court, like the *Moghadam* court five years earlier, stopped short of deciding the issue. *Id.* (citing *United States v. Moghadam*, 175 F.3d 1274, 1274 (11th Cir. 1999)). The court found fixation to be a close question because in a § 1101(a)(3) claim the bootlegged recording may, itself, satisfy the requirement. *Id.* at 832.

<sup>245</sup> *See id.* at 825 (KISS performed the concert on July 10, 1976, while the defendants began selling the video in October 2003).

<sup>246</sup> 17 U.S.C. § 1101(c) (2000) (“This section shall apply to any act or acts that occur on or after the date of the enactment of the Uruguay Round Agreements Act.”). The “Lost Concert” recording took place in 1976, eighteen years before the anti-bootlegging statutes were enacted. *KISS Catalog*, 350 F. Supp. 2d at 825.

<sup>247</sup> *KISS Catalog*, 350 F. Supp. 2d at 832.

<sup>248</sup> *Id.* (citing 17 U.S.C. § 302 (2000)).

<sup>249</sup> *Id.* at 833.

<sup>250</sup> *Id.* at 830.

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Copyright Clause.<sup>251</sup> As in *Moghadam* and *Martignon* before it, the court then considered whether the Commerce Clause could provide alternative authority for the statute by placing *Gibbons* in the balance with *The Trade Mark Cases*, *Heart of Atlanta Motel*, and *Authors League*.<sup>252</sup> Like the *Martignon* court, the *KISS Catalog* court found *Gibbons* to be on point.<sup>253</sup> The *Gibbons* Court had examined a clause, “like the Copyright Clause, that both provides a positive grant of power and contains an express limit.”<sup>254</sup> In the instant case, allowing Congress to invoke the Commerce Clause in a situation where the Copyright Clause would otherwise be violated would “eradicate from the Constitution a limitation on the power of Congress.”<sup>255</sup>

### III. *KISS CATALOG* AND *MARTIGNON* ANALYSIS

This section analyzes the district courts’ formalist rationale and suggests that questions of implied limits on Congress’ legislative authority require a functional analysis. Both courts applied the template laid-out in *Gibbons* categorically, i.e. without alteration or adjustment. This results not only in the wrong conclusion in *KISS Catalog* and *Martignon* but in a sweeping precedent that would be highly debilitating to Congress’ ability to regulate the information economy.

Part A distinguishes *Gibbons* and finds that the courts failed to consider significant differences between the statutes and constitutional clauses involved. Part B distinguishes William Patry’s “negative rights” hypothesis from the matter before the district courts. Part C suggests that imposing implied limits upon Congress’ legislative authority requires a functional, not a categorical approach and advocates for an inquiry that asks whether the anti-bootlegging statutes are incongruous with the Commerce Clause or interfere with the Copyright Clause. Parts D

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<sup>251</sup> *Id.*

<sup>252</sup> *Id.* at 834.

<sup>253</sup> *Id.* at 836.

<sup>254</sup> *Id.* at 836–37.

<sup>255</sup> *Id.* at 836 (citing *Ry. Labor Executives’ Ass’n v. Gibbons*, 455 U.S. 457, 469 (1982)).

and E inquire whether the anti-bootlegging statutes actually conflict with the “Writings” and “limited Times” requirements of the Copyright Clause.

A. *The Quasi-Copyright Nature of the Statutes: Distinguishing Gibbons*

Unlike the Eleventh Circuit,<sup>256</sup> the Southern District of New York and Central District of California find convincing congruence between the uniformity requirement in the Bankruptcy Clause and the limitations of the Copyright Clause. The *Martignon* opinion is modeled closely on *Railway Executives’ Ass’n v. Gibbons*,<sup>257</sup> and both district court opinions rely on the case.<sup>258</sup> However, the district courts did not consider a number of distinguishing points between *Gibbons* and the present case: the absence of a state sovereignty interest, the absence of a distinct textual implication of external effect, and the circumscribed scope of the statute’s protection. The district courts simply applied *Gibbons* as a blanket rule, an overly broad approach that unnecessarily hinders Congress’ ability to legislate within the grant of its enumerated powers.

1. Differences between the Statutes

The Rock Island Railroad Transition and Employee Assistance Act (RITA) at issue in *Gibbons* was found by the Court to be an actual bankruptcy law, not a bankruptcy-like law: the Act applied to an ongoing proceeding in bankruptcy court, reordered the priority of creditors’ claims, and required the bankruptcy court to implement the final arrangements.<sup>259</sup> RITA’s legislative history

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<sup>256</sup> See *supra* Part I.D.

<sup>257</sup> See *supra* Part I.D.

<sup>258</sup> See *United States v. Martignon*, 346 F. Supp. 2d 413, 420 (S.D.N.Y. 2004) (stating that it is “essential to determine how to classify a statute in order to ensure that it does not run afoul of any express limitations imposed on Congress when regulating in the respective arena”) (citing *Gibbons*, 455 U.S. at 467); *KISS Catalog*, 350 F. Supp. 2d at 823 (“Like the *Martignon* court, this Court finds [*Gibbons*] to be the most instructive case on this issue.”).

<sup>259</sup> *Gibbons*, 455 U.S. at 467–68.



also revealed that “Congress wanted to make liquidation of a railroad costly for the estate.”<sup>260</sup>

In contrast to RITA, 18 U.S.C. § 2319A is, at most, a quasi-copyright statute.<sup>261</sup> The statute affords substantially less protection than copyright protection, vesting only the exclusive right to record or broadcast a live performance in the performers.<sup>262</sup> Any other form of copying, including the subsequent performance of the *identical work* by an unauthorized performer, or copying of the *actual notes* performed, is not addressed by the statute.<sup>263</sup>

The *Martignon* court does not consider the statute’s minimal scope.<sup>264</sup> Instead, the court cites evidence of Congress’ intent as proof that the statute is *primarily* copyright-like.<sup>265</sup> This evidence is ambiguous at best. The *Martignon* court’s emphasis on TRIPs’ “IP” (Intellectual Property) aspect<sup>266</sup> only contrasts with the *Moghadam* court’s focus on its “TR” (Trade-Related) aspect.<sup>267</sup> The confluence of international trade and intellectual property

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<sup>260</sup> *Id.*

<sup>261</sup> *See, e.g.,* United States v. Moghadam, 175 F.3d 1269, 1272 (11th Cir. 1999) (“The rights created by the anti-bootlegging provisions . . . are actually hybrid rights that in some ways resemble the protections of copyright law but in other ways are distinct from them.”).

<sup>262</sup> Compare *supra* notes 178–79 and accompanying text with notes 209–14 and accompanying text. In contrast, copyright prevents any substantial copying and grants multiple rights to exclude in 17 U.S.C. § 106 (2000 & Supp. 2002).

<sup>263</sup> Of course, in the case of a performance of contemporary music, the underlying musical composition will often be protected by copyright, in which case, transcription of the composition and subsequent performance, although permitted by the anti-bootlegging statutes, would violate the Copyright Act’s reproduction and public performance rights. *See* 17 U.S.C. § 106. However, performances of musical compositions that have fallen into the public domain, such as of Mozart, or improvisational or other works that have not been fixed in a tangible medium of expression, may be transcribed, performed, and distributed unhindered by the anti-bootlegging statutes, which only protect against simultaneously produced recordings and transmissions. *See supra* note 8.

<sup>264</sup> *Martignon*, 346 F. Supp. 2d at 422.

<sup>265</sup> *Id.*

<sup>266</sup> *Id.* at 420 (stating TRIPs “dealt completely with intellectual property”).

<sup>267</sup> *Moghadam*, 175 F.3d at 1276 (“The specific context in which § 2319A was enacted involved a treaty with foreign nations, called for by the World Trade Organization, whose purpose was to ensure uniform recognition and treatment of intellectual property in international commerce. *The context reveals that the focus of Congress was on interstate and international commerce.*”) (emphasis added).

interests only underscores the difficulty of characterizing the statute as primarily embodying the values of either the Commerce or the Copyright Clauses. The fact that the Committee on the Judiciary divided the TRIPs chapter of the Senate Report into the three-part division of copyright, patent, and trademark is also less than helpful.<sup>268</sup> The protection of live musical performances from bootleggers is undoubtedly more similar to a copyright than a trademark or a patent. While it would have been more accurate to provide a fourth subheading “*Sui Generis* Provisions,” the bare five-sentence description of both statutes in the report attests to the cursory consideration given to its drafting.<sup>269</sup>

Both courts’ arguments for a copyright-like status based on statutory placement is undermined by *Authors League of America, Inc. v. Oman*,<sup>270</sup> in which the Second Circuit held that the Manufacturing Clause,<sup>271</sup> codified in Section 601 of the Copyright Act, was justified not by the Copyright Clause, but by the Commerce Clause.<sup>272</sup> Had Congress intended live performance to become a protected subject matter under the Copyright Act it would have amended § 102(a) as it has done repeatedly in the past.<sup>273</sup> Instead, Congress created a new Chapter 11 to accommodate the civil statute. Similarly, Congress could have amended 18 U.S.C. § 2319, the umbrella criminal infringement statute for all copyrightable subject matter, to include criminal infringement of live performances. Instead, Congress opted to

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<sup>268</sup> See *id.*; see also *supra* note 34. The anti-bootlegging statutes implement Article 14 of TRIPs which comes under the subheading of “Copyright and Related Rights.” See *supra* note 8.

<sup>269</sup> NIMMER & NIMMER, *supra* note 52, § 8E.05[A] (“In the context of Chapter 11 [of Title 17], the question arises how Congress viewed its enactment authority. There is no answer. Chapter 11 itself offers no clue as to how it might pass constitutional muster. The legislative history, Statement of Administrative Action, and floor statements are similarly bereft of support.”).

<sup>270</sup> See *Authors League of Am., Inc. v. Oman*, 790 F.2d 220 (2d Cir. 1986); see also *supra* notes 130–32 and accompanying text.

<sup>271</sup> 17 U.S.C. § 601 (2000).

<sup>272</sup> See *Authors League*, 790 F.2d at 224 (finding that the Manufacturing Clause was “clearly justified as an exercise of the legislature’s power to regulate commerce with foreign nations”); see also U.S. CONST. art. 1, § 8, cl. 3.

<sup>273</sup> See 17 U.S.C. § 102(a)(8) (2000). Architectural works were added as copyrightable subject matter in 1990. Judicial Improvements Act of 1990, Pub. L. No. 101-650, § 703, 104 Stat. 5089 (1990).

enact a separate statute, distinct from a claim of copyright infringement.<sup>274</sup> Finally, while it is true that the phrase “for purposes of commercial advantage or private financial gain” appears in both the criminal infringement and anti-bootlegging statutes, the phrase also appears in a criminal statute regarding “fraud and related activity in connection with computers,” a title 18 statute that was enacted under Congress’ Commerce Clause powers.<sup>275</sup> In *Moghadam*, the court cites the phrase as evidence that the statute was, indeed, of and concerning commerce.<sup>276</sup>

The *Martignon* court recites this ambiguous evidence of Congressional intent after agreeing with the *Moghadam* court that “Congress’ belief as to the power under which it enacts a statute is not dispositive.”<sup>277</sup> At most, the court’s rationale illustrates that the statute is, as the *Moghadam* court had found it, a somewhat copyright-like statute.

## 2. Differences between the Clauses

Chief Justice Rehnquist observes that the text of the Bankruptcy Clause was drafted specifically contemplating statutes of the very kind faced by the Court in that case.<sup>278</sup> The word “uniform” loses much of its meaning if inapplicable to alternative sources of legislation.<sup>279</sup> The same cannot be said for the text of the Copyright Clause. There is no indication that the terms “Writings” and “limited Times” were intended to or must apply to any matter beyond the implementation of the grant itself.<sup>280</sup>

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<sup>274</sup> See 18 U.S.C. § 2319A (2000).

<sup>275</sup> See 18 U.S.C. § 1030(b)(2)(B)(i) (2000).

<sup>276</sup> See *United States v. Moghadam*, 175 F.3d 1269, 1272 (11th Cir. 1999) (“If bootlegging is done for financial gain, it necessarily is intertwined with commerce.”).

<sup>277</sup> *United States v. Martignon*, 346 F. Supp. 2d 413, 419–20 (S.D.N.Y. 2004); see also Laurence H. Tribe, *AMERICAN CONSTITUTIONAL LAW* 307 n.6 (2d ed. 1988) (“The question of the constitutionality of action taken by Congress does not depend on recitals of the power which it undertakes to exercise.”) (citing *Woods v. Cloyd W. Miller Co.*, 333 U.S. 138, 144 (1948)).

<sup>278</sup> *Ry. Labor Executives’ Ass’n v. Gibbons*, 455 U.S. 457, 471 (1982).

<sup>279</sup> See *id.* (“Although the debate in the Constitutional Convention regarding the Bankruptcy Clause was meager, we think it lends some support to our conclusion that the uniformity requirement of the Clause prohibits Congress from enacting bankruptcy laws that [in this case] specifically apply to the affairs of only one named debtor.”).

<sup>280</sup> See *supra* note 92 and accompanying text.

The *Gibbons* court emphasized that the Bankruptcy Clause was hotly debated during the Constitutional Convention because it involved a question of State sovereignty.<sup>281</sup> The uniformity requirement was, in part, a response to some States' practice of enacting private bills which rendered uniformity impossible.<sup>282</sup> Congressional meddling in particular bankruptcy proceedings is no less prone to legislative abuse and may be equally prejudicial to the interests of certain States.<sup>283</sup>

In contrast, the Copyright Clause was passed by committee with little debate, reflecting a weak linkage to State sovereignty issues.<sup>284</sup> During the centuries following the Constitutional Convention, federal copyright law progressively preempted most of common-law copyright with little protest from the States.<sup>285</sup> The absence of a strong State sovereignty component<sup>286</sup> undermines the view that the commerce power is restricted in this matter. State sovereignty concerns are further assuaged by § 1101(d), which preserves all State protection of live performances

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<sup>281</sup> *Gibbons*, 455 U.S. at 472.

<sup>282</sup> *Id.*

<sup>283</sup> *See id.*

<sup>284</sup> *See* Nachbar, *supra* note 18, at 338 (“There was very little discussion of the Intellectual Property Clause among the Framers; there is no record of any debate over it at the Federal Convention.”); Karl Fenning, *The Origin of the Patent and Copyright Clause of the Constitution*, 17 GEO. L.J. 109, 114 (1929) (“The matter, on its merits, apparently aroused substantially no controversy either in the Convention or among the States adopting the Constitution.”).

<sup>285</sup> The Copyright Act of 1790 protected maps, charts and books for a maximum of two fourteen-year terms. *See* Act of May 31, 1790, ch. 15, 1 Stat. 124. The 1909 Act doubled the term of protection and encompassed “all the writings of an author” from the moment of publication, while common law copyright continued to protect all unpublished works. *See* Act of March 4, 1909, ch. 320, § 4, 35 Stat. 1076 (repealed 1976). The Copyright Act of 1976 extended the term to life of the author plus fifty years and protected, from the moment of creation, all original works of an author fixed in tangible medium of expression under seven broad categories of subject matter. *See* Pub. L. No. 105-298, 112 Stat. 2827 (codified as amended at 17 U.S.C. §§ 302(a) (1998)).

<sup>286</sup> *See* Thomas B. Nachbar, *Judicial Review and the Quest to Keep Copyright Pure*, 2 J. TELECOMM. & HIGH TECH. L. 33, 59 (2003) (stating that the “exercise of the copyright power does not in any way impinge on the authority of the States.”). *But see* NIMMER & NIMMER, *supra* note 52, § 8E.01[B] (“The federalization of control over unfixed productions departs from several centuries of American jurisprudence, given that regulation of activities lacking fixation has traditionally been the realm of state law protection. In th[is] sense, . . . chapter [11] represents a . . . departure from Constitutional moorings . . .”).

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from preemption.<sup>287</sup> The few Commerce Clause statutes that have been struck down by the Court since the *Lochner* era have each touched upon areas of traditional State control, such as education<sup>288</sup> and health and safety.<sup>289</sup> In such cases, the Court has applied a heightened form of rational basis review in order to safeguard the States from federal overreaching. Since federalism is not strongly implicated in copyright issues, this form of close scrutiny should not apply.<sup>290</sup> Also, copyright is a field rife with economic policy, well-suited to the processes of representative government and ill-suited to the processes of the courtroom.<sup>291</sup> Therefore, deference is due to Congressional decision-making and the courts should apply a “minimal rational basis” of review.<sup>292</sup>

In sum, the absence of a strong state sovereignty interest, the absence of a textual implication of external effect, and the circumscribed scope of the statutes’ effect sufficiently distinguish *Gibbons* from the present case so as to warrant a reasoned analysis not a categorical application of its result.

#### *B. Distinguishing William Patry’s Structural Analysis*

The *Martignon* court also misapplies William Patry’s structural analysis, which contemplates only the originality requirement.<sup>293</sup> Interpreting *Bonito Boats*, *Feist*, and *Gibbons*, William Patry predicted that if Congress tried to protect databases of unoriginal facts, the Court would strike it down as an end run around the

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<sup>287</sup> 17 U.S.C. § 1101(d) (2000).

<sup>288</sup> See *United States v. Lopez*, 514 U.S. 549 (1995); see *supra* notes 133–34 and accompanying text.

<sup>289</sup> See *Morrison v. Olson*, 487 U.S. 654 (1988); see *supra* note 135 and accompanying text.

<sup>290</sup> See *Nachbar*, *supra* note 286, at 59 (“While vigilant judicial review in the federalism context is a response to the possibility that Congress has taken power from the States, thereby altering the balance of power so carefully established by the Constitution, the exercise of the copyright power presents no similarly fundamental danger to the constitutional order because exercise of the copyright power does not in any way impinge on the authority of the States.”).

<sup>291</sup> *Id.* at 34.

<sup>292</sup> *Id.* at 68–70 (“[T]he Court applies the lower conceivable basis standard when it is satisfied that the sovereign in question does indeed have plenary power in the area being regulated.”).

<sup>293</sup> *United States v. Martignon*, 346 F. Supp. 2d 413, 425 n.16 (S.D.N.Y. 2004).

Copyright Clause.<sup>294</sup> The *Martignon* court's extension of this reasoning to the "fixation requirement" is unsound.<sup>295</sup> Patry concluded that in *Feist*, the Court demarcated the boundary between the Copyright Clause and other enumerated powers, and that this boundary-line is the originality requirement: the locus of the "negative right"/"positive right" divide.<sup>296</sup>

This structural analysis, focusing on the originality requirement, supports the validity of the federal anti-bootlegging statute. Live musical performances are original works. Every performance is a new experience for audience and performer. The protection extended by the anti-bootlegging statutes does not remove the building blocks of creativity from the public domain. To the contrary, each performance disseminates the ideas and facts embodied in the work and the statute places no restraint on the re-use of those building blocks. Indeed, the statute places no restraint on the verbatim copying of the live performance.<sup>297</sup> The statute simply grants the performers the sole right to record or transmit the performance.<sup>298</sup> This circumscribed protection furthers the goal of the Copyright Clause by encouraging the production of new ideas and discoveries which are, in turn, given over to the public without encumbrance. The protection of live musical performances by the enactment of anti-bootlegging statutes, therefore, is supported by William Patry's structural analysis.<sup>299</sup>

### *C. Implied Limits Require a Functional Rather than a Categorical Approach*

After placing the statute in the "copyright" box, both the *Martignon* and the *KISS Catalog* courts simply conclude that the

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<sup>294</sup> See Patry, *supra* note 106, at 398.

<sup>295</sup> See *Martignon*, 346 F. Supp. 2d 413.

<sup>296</sup> See Patry, *supra* note 106, at 384 ("In *Feist*, the Court made clear that originality is the dividing line of Congress's enumerated power.").

<sup>297</sup> See 17 U.S.C. § 1101(a) (2000); 18 U.S.C. § 2319A(a) (2000).

<sup>298</sup> See 17 U.S.C. § 1101(a) (2000); 18 U.S.C. § 2319A(a) (2000).

<sup>299</sup> If the absence of a fixed form triggers any concern at all it is regarding the scope of the dissemination. Unless it is broadcast, live performance is accessible to only a limited number of persons. However, that concern is ameliorated by the rather circumscribed scope of the protection. The performance may be mimicked and otherwise copied after the performance without violating the statute. See *infra* note 323.

Commerce Clause may not authorize the statute. This is a categorical approach to a matter of public policy in which deference to Congress is appropriate. In analogous circumstances, the Court has tended to utilize a functional and structural approach that weighs the actual effect of potential conflicts between Constitutional grants of authority.

In considering the non-delegation doctrine, the Rehnquist Court has taken a functional/structural approach—asking whether the delegation at issue is incongruous and whether it actually interferes with the functioning of the neighboring power. For example, in *Morrison v Olson*<sup>300</sup> the Supreme Court upheld the limited role of the executive in appointing and removing the Independent Counsel based on a pragmatic analysis that diverged from formalist precedent.<sup>301</sup> In *Morrison*, Chief Justice Rehnquist, speaking for the Court, found that Congress' delegation of the power to appoint the Independent Counsel to the courts was not incongruent with functions normally performed by courts and therefore did not run afoul of Constitutional limits on inter-branch appointments.<sup>302</sup> Regarding the imposition of a “good cause” provision for removal by the executive, the Court stated that the real question is whether the President's ability to perform his duty is impeded.<sup>303</sup> Finding that the “good cause” provision did not “unduly trammel[] on executive authority”<sup>304</sup> and did not “pose a dange[r] of Congressional usurpation” of executive power,<sup>305</sup> the Court upheld the delegation.<sup>306</sup>

The enumerated powers issue posed by 18 U.S.C. § 2319A and 17 U.S.C. § 1101 parallels the inter-branch delegation cases, and, as in the delegation cases, the inquiry should be a pragmatic one. Is the statute incongruous with the commerce power? Does the

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<sup>300</sup> 487 U.S. 654 (1988).

<sup>301</sup> *Id.* at 689–90.

<sup>302</sup> *Id.* at 677.

<sup>303</sup> *Id.* at 691 (“But the real question is whether the removal restrictions are of such a nature that they impede the President's ability to perform his constitutional duty, and the functions of the officials in question must be analyzed in that light.”).

<sup>304</sup> *Id.*

<sup>305</sup> *Id.* at 694 (citing *Commodity Futures Trading Comm'n v. Schor*, 478 U.S. 714, 727 (1983)).

<sup>306</sup> *Id.* at 691–92.

statute actually interfere with the copyright power? This is essentially the approach taken, albeit with spare analysis, by the *Moghadam* court.

If the finding that the anti-bootlegging statute is “copyright-like” is accepted, then the question parallels one of delegation between constitutional powers. In *Morrison*, the transfer of authority took place between the Articles of the Constitution.<sup>307</sup> In *Martignon*, the transfer of authority occurs between Clauses within Article 1, Section 8 of the Constitution.<sup>308</sup> The portion of a quasi-copyright statute that is “copyright-like” must not pose a danger of undermining the place of the Copyright Clause in the Constitutional scheme and “may not . . . set at naught” the benefits contemplated by the Clause.<sup>309</sup> This is a matter of hybrid authority. Power sharing between Article I, Section 8 clauses should receive more solicitude upon judicial review than power sharing between branches of government that involves inter-Article delegations of authority because there is no equivalent to the Necessary and Proper clause on the inter-branch level.<sup>310</sup> Also, the Court makes clear in *Bonito Boats* that Congress is vested with great discretion to shape the contours of the rights generated by the Intellectual Property Clause.<sup>311</sup> The balance is Congress’ to strike.<sup>312</sup> This is amply illustrated in the afterward to *Bonito Boats* in which Congress responded to the Court’s decision by extending

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<sup>307</sup> The Independent Counsel is an executive officer; executive officers are typically appointed and removed by the President pursuant to his Article I powers. *Id.* at 657–60. Congress, authorized by its Article II powers, delegated the authority to appoint the Independent Counsel to the Special Division of the D.C. Circuit Court, an Article III court. *See* Ethics in Government Act of 1978, 28 U.S.C. §§ 49, 591 (1978). The Act also restricted removal by the President by requiring a showing of “good cause.” *See id.*

<sup>308</sup> 346 F. Supp. 2d 413, 424–25 (S.D.N.Y. 2004).

<sup>309</sup> *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 480 (1974) (quoting *Sola Elec. Co. v. Jefferson Elec. Co.*, 317 U.S. 173, 176 (1942)).

<sup>310</sup> *See* U.S. CONST. art. I, § 8, cl. 18 (“To make all Laws which shall be necessary and proper for carrying into Execution the foregoing Powers, and all other Powers vested by this Constitution in the Government of the United States, or in any Department or Officer thereof.”).

<sup>311</sup> *See generally* *Bonito Boats, Inc. v. Thundercraft, Inc.*, 489 U.S. 141, 168 (1989).

<sup>312</sup> *See* *Eldred v. Ashcroft*, 537 U.S. 186, 216 (2003) (“*Bonito Boats* reiterated the Court’s unclouded understanding: ‘It is for Congress to determine if the present system’ effectuates the goals of the Copyright and Patent Clause.”) (citing *Bonito Boats*, 489 U.S. at 168).



*sui generis* copyright-like protection to vessel hull designs within Title V of the Digital Millennium Copyright Act<sup>313</sup> and codified in a new chapter 13 of the Copyright Act itself.

In sum, the district courts' rationale is flawed because it applies the *result* of the Court's analysis in *Gibbons* and the *result* of William Patry's analysis as a bright-line and blanket rule. Invalidation of a duly enacted federal law based on an implied limit on Congress' powers should be premised on a finding of actual interference with the copyright power or with a larger "constitutional norm." In the instant case, the structural concerns addressed in *Feist* and *Gibbons* are not present and, as we shall discuss in greater detail below, there is no actual conflict between the anti-bootlegging statutes and the Copyright Clause. Therefore, the Circuit Courts should reverse the district courts and find that the statute is a legitimate use of Congress' commerce power.

*D. No Fixation. No Problem.*

The government<sup>314</sup> and amicus briefs<sup>315</sup> to the Second Circuit rely on the assumption that unfixed works are inherently inconsistent with the Copyright Clause "Writings" requirement. These briefs argue that unfixed works, such as live performances, are simply beyond the subject matter of copyright and therefore no conflict arises with Commerce Clause authority.<sup>316</sup> This is the mirror image of the *Martignon* opinion. Both the district court and the government would constitutionalize "fixation" as a bright-line rule. Judge Baer would limit the scope of copyright's *protections* to fixed works, leaving Congress with no authority to regulate unfixed works under the Commerce Clause. In contrast, the government would limit the scope of copyright's *restrictions* to fixed works, giving Congress plenary authority to regulate unfixed works under the Commerce Clause.<sup>317</sup> Both approaches would effect an artificial bifurcation of the federal copyright power, a

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<sup>313</sup> See Digital Millennium Copyright Act, Pub. L. No. 105-304, 112 Stat. 2860 (1998).

<sup>314</sup> See *Martignon* Brief for the U.S., *supra* note 27, at 16.

<sup>315</sup> UMG Amicus Brief, *supra* note 27, at 13; Ass'n of Am. Publishers Amicus Brief, *supra* note 27, at 21.

<sup>316</sup> See, e.g., *Martignon* Brief for the U.S., *supra* note 27, at 16.

<sup>317</sup> See *id.*

result that is legislatively inefficient and harmful to the Constitutional scheme. Also, “fixation” is an increasingly murky and metaphysical concept as information is manipulated at near real-time through processes no more fixed than a quantum probability or a phosphorescent glow. As a result, it can provide only an arbitrary basis for delimiting where the copyright power begins and ends. Ironically, the insistence on permanence may itself place the foundations of copyright on shifting sands.

A sounder basis of decision would inquire whether the regulation undermines the constitutional floor erected in *Feist Publications v. Rural Telephone Service*.<sup>318</sup> Technological innovation is unlikely to erode the principles of originality or the fact/expression and idea/expression dichotomy, as it has begun to erode the concept of the fixation. The “Progress of Science and the useful Arts” is promoted when new forms of expression, including those that challenge the traditional meaning of “Writings,” are brought within copyright’s protective mantle.<sup>319</sup> Therefore, determining the scope of protection by asking whether a statute functionally conflicts with the Copyright Clause would preserve meaningful distinctions between Clauses 3 and 8, and, at the same time, provide Congress with the flexibility it requires.

#### 1. Live Performances May Be “Writing[s]”

A live musical performance may, in fact, be a “Writing;” therefore it is unfortunate that the *Martignon* prosecutors conceded that they are not.<sup>320</sup> In *Moghadam*, the Eleventh Circuit noted that it is unclear whether “Writings” may be expanded to include live performances which “are merely capable of fixation” and decided the case on other grounds.<sup>321</sup> The *KISS Catalog* court also decided the case on grounds other than the “Writings” requirement, finding it a “closer question” than the “limited Times” requirement.<sup>322</sup> While common law copyright has recognized copyright

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<sup>318</sup> 499 U.S. 340 (1991).

<sup>319</sup> See U.S. CONST. art. I, § 8, cl. 3.

<sup>320</sup> See *United States v. Martignon*, 346 F. Supp. 2d 413, 423–24 (S.D.N.Y. 2004).

<sup>321</sup> See *United States v. Moghadam*, 175 F.3d 1269, 1274 (11th Cir. 1999).

<sup>322</sup> *KISS Catalog v. Passport Int’l Prods., Inc.*, 350 F. Supp. 2d 823, 832 (C.D. Cal. 2004).

infringement of unfixed expressions<sup>323</sup> and California has codified its protection of unfixed works,<sup>324</sup> the federal copyright system has always implicitly or explicitly required that the work be fixed in a “tangible medium of expression.”<sup>325</sup> However, despite protestations by venerable commentators that construing “Writings” to include performances is ludicrous,<sup>326</sup> the Court has not limited Congress’ discretion in this matter and requires no more from a “Writing” than an original expression that is made by an “Author.”<sup>327</sup>

The Framers lived in a world dominated by the quill and the printing press. Even these prescient drafters could not have envisioned camcorders, DATs, eyeglass-cams, mini-mics, and a battery of other miniaturized and affordable means of surreptitious reproduction, in simulacra, of a live work. Neither would the progenitors of American copyright protection have conceived of a network of peer-to-peer and file transfer protocols in which clones

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<sup>323</sup> See, e.g., *Estate of Hemingway v. Random House, Inc.*, 23 N.Y.2d 341, 349 (1968) (“Assuming, without deciding, that in a proper case a common-law copyright in certain limited kinds of spoken dialogue might be recognized, it would, at the very least, be required that the speaker indicate that he intended to mark off the utterance in question from the ordinary stream of speech, that he meant to adopt it as a unique statement and that he wished to exercise control over its publication.”); see also *Falwell v. Penthouse Int’l*, 521 F. Supp. 1204 (W.D. Va. 1981) (finding oral interview does not come within narrow circumstances that can sustain a common law copyright cause of action).

<sup>324</sup> CAL. CIVIL CODE § 980(a)(1) (1982).

The author of any original work of authorship that is not fixed in any tangible medium of expression has an exclusive ownership in the representation or expression thereof as against all persons except one who originally and independently creates the same or similar work. A work shall be considered not fixed when it is not embodied in a tangible medium of expression or when its embodiment in a tangible medium of expression is not sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration, either directly or with the aid of a machine or device.

*Id.*

<sup>325</sup> See H.R. REP. NO. 94-1476 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5666 (“Two essential elements—original work and tangible object—must merge through fixation in order to produce subject matter copyrightable under the statute.”).

<sup>326</sup> See NIMMER & NIMMER, *supra* note 52, § 1.08[C][2] (“If the word ‘writings’ is to be given any meaning whatsoever, it must, at the very least, denote some material form, capable of identification and having a more or less permanent endurance.”) (internal quotations omitted).

<sup>327</sup> See *Feist Publ’ns v. Rural Tel. Serv.*, 499 U.S. 340, 346 (1991).

of such recorded works are exported globally in a matter of minutes.

It is entirely plausible that the living document of the U.S. Constitution does not exclude protection of certain live works within the broad grant of discretion the Copyright Clause vests in Congress. In this scenario, the Copyright Act's fixation requirement functions as an evidentiary and administrative measure applicable to the bulk of protected subject matter, and *sui generis* protection of original but unfixed works, while outside the Copyright Act itself, is within the scope of the copyright power.<sup>328</sup>

As noted by the *Moghadam* court, Congress' protection of live broadcasts through the legal fiction<sup>329</sup> of simultaneous recording illustrates that the fixation requirement is a flexible standard; therefore, 18 U.S.C. § 2319A is more in the nature of "an incremental change than a constitutional breakthrough."<sup>330</sup> Recognizing that the Copyright Clause is broader than the Copyright Act, the courts should not force Congress to legislate by legal fiction, but should recognize that the Constitution's interest in the progress of the useful arts is promoted when live performances are protected.

## 2. Protecting Live Performances Does Not Conflict with the Copyright Clause

Even if the term "Writings" is construed as excluding live musical performances, there is no inherent conflict between the protection of fixed works under the Copyright Clause and *sui generis* protection of live performances under the Commerce Clause. Such protections provide incentives to performing artists to produce live works that disseminate the ideas and facts

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<sup>328</sup> See *CBS v. DeCosta*, 377 F.2d 315, 320 (1st Cir. 1967), *cert. denied*, 389 U.S. 1007 (1967) ("[W]hile more precise limitations on 'writings' might be convenient in connection with a statutory scheme of registration and notice, we see no reason why Congress' power is so limited.").

<sup>329</sup> See 17 U.S.C. § 101 (2000) ("A work consisting of sounds, images, or both, that are being transmitted, is 'fixed' for purposes of this title if a fixation of the work is being made simultaneously with its transmission."); see also H.R. REP. NO. 94-1476 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5666.

<sup>330</sup> *United States v. Moghadam*, 175 F.3d 1269, 1281 (11th Cir. 1999).

embodied within to their audience. While fixation enlarges the scope of dissemination, in both time and space, it does not change the “essential” benefit gained by the public. Therefore the anti-bootlegging statutes are consistent with the goals of copyright as delineated in *Feist* and do not undermine the Congressional scheme enacted to give effect to the Copyright Clause.

### 3. “Proto-Copyright” Protection

Protection of original works that are poised to be fixed is a distinct species of quasi-copyright that this Comment shall label “proto-copyright.”<sup>331</sup> Proto-copyright statutes protect live, streaming, transmitted, and RAM-cached works that are the unfixed precursors to wholly copyrightable expressions.<sup>332</sup> Proto-copyright protection promotes the progress of science and the useful arts by encouraging performances that in turn may be fixed in a copyrightable form to be determined by the author(s). Where a proto-copyright protection guards, as it does in the instant case, only against reproduction of a work by means of a recording, and only for the duration of a performance, such protection is consistent with the Copyright Clause because it does not create an ongoing monopoly interest in a particular work.<sup>333</sup> Quasi-copyright is a broader genus of protection encompassing both proto-copyright and copyright-like protection of works that *would not be* protectable under the Copyright Clause itself if fixed in a tangible medium of expression. Protection of unoriginal databases is one such proposed quasi-copyright statute and is distinct from the proto-copyright statute at issue in the instant case.<sup>334</sup> Thus, the

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<sup>331</sup> See AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (4th ed. 2000) (defining proto as “1. First in time, earliest . . . 2. First formed; primitive . . .”), available at <http://www.bartleby.com/61/62/P0616200.html> (last visited Apr. 10, 2005).

<sup>332</sup> The legal fiction protecting live transmissions that are simultaneously recorded is another example of proto-copyright protection. See *supra* note 336.

<sup>333</sup> See *infra* notes 336–63 and accompanying text.

<sup>334</sup> See Alan J. Hartnick, *Do Proposed Database Laws Protect Information Rather than Investment?*, 14(2) N.Y. ST. B.A. ENT., ARTS & SPORTS L.J. 61 (2003) (“If there is a new law, to avoid controversy, it will need to be narrowly drafted.”); see also Patry, *supra* note 106. *Contra* Nachbar, *supra* note 18, at 274.

anti-bootlegging statutes are not unconstitutional simply because they are not yet “fixed in a tangible medium of expression.”<sup>335</sup>

*E. The Statutes Do Not Conflict with the “limited Times” Requirement*

The *Martignon* decision’s alternative ground—that even if Congress may enact copyright-like statutes under the Commerce Clause, the anti-bootlegging statute is ‘fundamentally inconsistent’ with the Copyright Clause because it lacks a durational limit—rests on the false premise that “limited Times” for purposes of copyright and patent protection is equivalent. Drawing upon precedents from patent law, the court ignores the Court’s lesson in *Eldred v. Ashcroft*<sup>336</sup> that “limited Times” operates differently in copyright than patent law because 1) copyright is not a true monopoly and 2) public disclosure is a goal but not a requirement of copyright. The result of this confusion is an expansive and overly rigid version of the “limited Times” requirement as applied to copyright generally and to a proto-copyright statute, such as the anti-bootlegging statutes, particularly.<sup>337</sup> Because “limited Times” acts as an antidote to monopoly, where such concerns are absent the requirement should by not be applied. However, the anti-bootlegging statutes at issue do not violate even the expansive version of the “limited Times” requirement espoused by the district courts because live performances are of intrinsically finite duration.

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<sup>335</sup> 17 U.S.C. § 101 (2000 & Supp. 2002).

<sup>336</sup> See *Eldred v. Ashcroft*, 537 U.S. 186 (2003).

<sup>337</sup> Although the Court has, in certain cases, analogized to patent law, recognizing “the historic kinship between patent law and copyright law,” it has also emphasized that “[t]he two areas of the law, naturally, are not identical twins, and we exercise the caution which we have expressed in the past in applying doctrine formulated in one area to the other.” *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 439 n.19. In *Eldred*, the Court squarely states that durational limits is one area where fruitful analogies between patent and copyright may not be drawn. See *Eldred*, 537 U.S. at 217.

### 1. The “limited Times” Requirement Applies Differently to Patents and Copyrights

The *Martignon* court provides only a brief explanation for its conclusion that the lack of a durational limitation is fundamentally inconsistent with the Copyright Clause. Citing *P.C. Films Corp. v. Turner Entertainment Co.*,<sup>338</sup> the court stated that “[t]he ‘Limited Times’ requirement offsets [an author’s] monopoly and ensures that the public will benefit, albeit at a later date, when the work reaches the public domain.”<sup>339</sup>

This rationale is based on false premises stemming from a confusion of patent and copyright. This confusion is borne out by the passage in *P.C. Films* referenced by the court: “The public has invested in such free use by the grant of a monopoly to the patentee for a limited time. Hence any attempted reservation or continuation . . . of the patent monopoly, after the patent expires . . . runs counter to the policy and purpose of the patent laws.”<sup>340</sup> For this passage, *P.C. Films* references the Court’s decisions in *Scott Paper Co. v. Marcalus Manufacturing Co.*<sup>341</sup> and *Brulotte v. Thys Company*,<sup>342</sup> both of which decided questions of patent law.<sup>343</sup>

In *Eldred v. Ashcroft*, the Court stated that the copyright and patent systems effectuate the Intellectual Property Clause in distinct ways and courts should be wary of applying the analysis of patents cases to copyright cases, especially when analyzing questions of duration.<sup>344</sup> The reason for this caution is two-fold: 1) copyright is not a true monopoly and 2) disclosure is not required by copyright, but is the *quid pro quo* of patent protection.

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<sup>338</sup> *P.C. Films Corp. v. Turner Entm’t Co.*, 954 F. Supp. 711 (S.D.N.Y. 1997) (deciding the effect of a copyright renewal upon a perpetual license under the 1909 Act).

<sup>339</sup> *United States v. Martignon*, 346 F. Supp. 2d 413, 429 (S.D.N.Y. 2004) (citing *P.C. Films Corp.*, 954 F. Supp. at 715 (citations omitted)).

<sup>340</sup> *P.C. Films Corp.*, 954 F. Supp. at 715.

<sup>341</sup> *Scott Paper Co. v. Marcalus Mfg. Co.*, 326 U.S. 249 (1945).

<sup>342</sup> *Brulotte v. Thys Co.*, 379 U.S. 29 (1964), *reh’g denied*, 79 U.S. 985 (1965).

<sup>343</sup> *P.C. Films*, 954 F. Supp. at 715.

<sup>344</sup> See *Eldred v. Ashcroft*, 537 U.S. 186, 216 (2003) (“[P]atents and copyrights do not entail the same exchange, and . . . our references to a *quid pro quo* typically appear in the patent context.”).

a) Copyright Is Not a True Monopoly

As noted by Justice Ginsberg, speaking for the Court, in *Eldred*:

Distinguishing the two kinds of intellectual property, copyright gives the holder no monopoly on any knowledge. A reader of an author's writing may make full use of any fact or idea she acquires from her reading. . . . The grant of a patent, on the other hand, does prevent full use by others of the inventor's knowledge.<sup>345</sup>

Copyright only grants protection to a particular expression.<sup>346</sup> This protection also falls short of being a true monopoly because, unlike patent, copyright does not require novelty:<sup>347</sup> in copyright, an independently created work that is identical to a pre-existing work, does not infringe that pre-existing identical work.<sup>348</sup> Therefore, while the "limited Times" requirement offsets the patent monopoly, it does not function in the same way in the copyright context.

b) Disclosure is Not Required by Copyright, but Is the *Quid Pro Quo* of Patent Protection

Since the enactment of the Copyright Act of 1976, publication is no longer a prerequisite of copyright protection.<sup>349</sup> This underscores a basic distinction between copyright and patent. While a patent acts very much like a contract, with consideration on both sides of the bargain, copyright acts more as an incentives scheme that does not require disclosure as *quid pro quo*. Justice Ginsberg highlights this distinction in *Eldred*:

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<sup>345</sup> See *id.* at 217.

<sup>346</sup> See generally SCHECHTER & THOMAS, *supra* note 64, § 16.1.

<sup>347</sup> *Id.*

<sup>348</sup> See *Sheldon v. Metro-Goldwyn Pictures*, 81 F.2d 49, 54 (2d Cir. 1936) ("Borrowed the work must not indeed be . . . ; but if by some magic a man who had never known it were to compose anew Keats's Ode on a Grecian Urn, he would be an 'author,' and, if he copyrighted it, others might not copy that poem, though they might of course copy Keats's [since Keats's work is now in the public domain].")

<sup>349</sup> See H.R. REP. NO. 94-1476, § 301, at 129 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5745.



[I]mmediate disclosure is not the objective of, but is *exacted from*, the patentee. It is the price paid for the exclusivity secured . . . . For the author seeking copyright protection, in contrast, disclosure is the desired objective, not something exacted from the author in exchange for the copyright.<sup>350</sup>

The Court's statement that "limited Times" requires a different analysis in patent than in copyright applies with even more force in the case of proto-copyright statutes, such as 17 U.S.C. § 1101 and 18 U.S.C. § 2319A, which provide for only minimal copyright-like protections.<sup>351</sup>

c) "limited Times" is Required Only as an Antidote to Monopoly

In *Feist* and *Bonito Boats*, the Court raised the concern that, in promoting the progress of science and the arts, Congress should not lock-up the "building blocks" of creativity, as this would undermine that goal.<sup>352</sup> With patents, the law permits knowledge to be monopolized for a limited time on the condition that it is fully disclosed in executable detail to the public.<sup>353</sup> This "*quid pro quo*" acts as a sort of "idea pump" permitting 20 years of monopoly profits to come in, in return for subsequent free access by the public forever.

In copyright, the scheme less resembles a contract with full consideration on either side than it does an incentives scheme. This is because ideas cannot be protected under copyright and to the extent that an expression *is* an idea, it may be utilized under the

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<sup>350</sup> *Eldred*, 537 U.S. at 216.

<sup>351</sup> The anti-bootlegging statutes protect only against unauthorized recordings and transmissions, and only during the course of a live musical event. In contrast, copyright protects the copyright holder from any form of copying for the entire term of protection, as well as against subsequent performances, and adaptations. *See supra* note 8. Similarly, there is no equivalent to the Copyright Act's broad distribution right in the anti-bootlegging statute. *See infra* notes 362–63 and accompanying text.

<sup>352</sup> *See Bonito Boats, Inc. v. Thundercraft, Inc.*, 489 U.S. 141, 151 (1989); *see also Feist Publ'ns v. Rural Tel. Serv.*, 499 U.S. 340, 349–50 (1991).

<sup>353</sup> *Eldred*, 537 U.S. at 224.

“fair use” exception.<sup>354</sup> Thus, the moment a copyrightable subject is published the idea(s) and facts embedded within the expression flow freely to the public.<sup>355</sup> As articulated in *Feist*, this is the primary benefit and the “essence of copyright.”<sup>356</sup> This benefit is achieved through the *ex-ante* economic encouragement of the author to produce and publish the work.<sup>357</sup> This primary benefit, of entry of fact and idea into the public domain, accrues immediately upon publication.

A secondary public benefit of copyright, not addressed in *Feist*, is economic and affects the scope of the dissemination. When a copyright term expires and a work enters the public domain, the author’s partial monopoly premium ends and less expensive copies may be published by competitors. However, in a mass market, the profit-maximizing prices for copyrighted works during the term of protection will often not significantly exceed those of public domain works. As a result, the democratic implications of copyright are not distressing. Therefore, the Intellectual Property Clause “limited Times” requirement is less “essential” with respect to copyrights than to patents, in which it operates as a *quid pro quo*. The role of the “limited Times” requirement is further attenuated in the case of a proto-copyright protection, such as the anti-bootlegging statutes, in which monopoly plays virtually no part.<sup>358</sup>

## 2. The Anti-Bootlegging Statutes Meet the “limited Times” Requirement

The anti-bootlegging statutes are consistent with the Copyright Clause requirement that protections be granted only for “limited Times”<sup>359</sup> because a live performance is inherently limited in duration. The statutes vest performers with a right to exclude

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<sup>354</sup> See *Feist*, 499 U.S. at 350; 17 U.S.C. § 107 (2000).

<sup>355</sup> See *Feist*, 499 U.S. at 350.

<sup>356</sup> *Id.* at 349 (citing *Harper & Row Publ’rs, Inc. v. Nation Enters.*, 471 U.S. 539, 589 (1985)).

<sup>357</sup> See *Harper & Row*, 471 U.S. at 558.

<sup>358</sup> See *supra* note 351.

<sup>359</sup> See U.S. CONST. art. I, § 8, cl. 8; see also 17 U.S.C. § 302(a) (2000) (establishing a basic term of life of the author plus 70 years).

others from recording or transmitting their performance for the duration of the performance.<sup>360</sup> When the lights fade-out and the curtains fall, the show is over. As it is the performance itself that is the subject matter of protection, not the bootleg recording, it is difficult to see how the statute fails the “limited Times” requirement.<sup>361</sup>

Unlike the copyright distribution right,<sup>362</sup> 17 U.S.C. § 1101(a)(3) and 18 U.S.C. § 2319A(a)(3) (“Section (a)(3)”) restricts the distribution of a work that no longer exists. Therefore, that section does not grant an exclusive right of distribution of a work at all. The bootleg recording is the fruit of the initial illegal act of making the unauthorized recording and therefore subject to injunction. Since no perpetual right of distribution is secured for the performer of the live and inherently finite work, the statutes do not violate the “limited Times” requirement of the Copyright Clause.

This distinction is clarified by an example. In the hypothetical case where a simultaneous recording has been made by both the bootlegger and the performing artist, then there *would be* actual interference with the artist’s distribution of her work. In this case, Section (a)(3) would act as a form of quasi-distribution right that would parallel the author’s right to distribute her sound recording of the event, insofar as Section (a)(3) would eliminate competition with the distribution of the authorized sound recording. However, because the authorized sound recording is within the Copyright Act, it would be subject to the durational limits of 17 U.S.C. § 302.<sup>363</sup> When that copyright expired and the authorized sound recording entered the public domain, the Section (a)(3) right would lose its effect as a quasi-distribution right, since it would no longer protect the author’s distribution interest. The distribution of the unauthorized recording would, once again, be merely the fruit of an illegal act and subject to injunction for that reason.

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<sup>360</sup> See *supra* note 8.

<sup>361</sup> See 18 U.S.C. § 2319A (2000); 17 U.S.C. § 1101 (2000).

<sup>362</sup> See 17 U.S.C. § 106(3) (2000 & Supp. 2002) (providing the copyright owner the right to control the transfer of physical copies of the work).

<sup>363</sup> See 17 U.S.C. § 302 (2000).

The anti-bootlegging statutes also protect a general interest in choosing which of a series of performances, if any, to record and market. This protection has no equivalent under the Copyright Act which only protects transfers of actual copies or phonograms. The protection more closely resembles a protection of the right of privacy as it is construed in the “right of publicity” tort. Although such interests are present to some degree in all of copyright, they are pervasive in a live performance, which has not yet been fixed. The decision whether to make a recording is a threshold decision that marks the transition between personal and public, ephemeral and permanent. That threshold is delineated by the limits of the Copyright Act itself. Protection of performers from a forced entry of their work into a form that will persist in time and be widely disseminated is consistent with fundamental notions of autonomy, privacy and the right not to speak. Control over how the recording is to be made similarly implicates these concerns as evinced by Congress’ decision to make sound recordings a copyrightable subject matter that is distinct from the underlying musical work. A sound recording, made without authority or control by the artist is, therefore, a misrepresentative misappropriation that is distinct from the distribution of actual copies contemplated by § 106(3).

That the live work may not persist except for the bootleg recording raises concerns regarding a conflict with the promotion of the progress of science and the useful arts. Statutory authority to destroy the only record of a live work<sup>364</sup> is also statutory authority to remove, in perpetuity, the “building blocks” contained in the performance. This, however, is the very balance that Congress is charged by the Constitution with making. Here, Congress has granted performers the right to say which, if any, performances are to persist in time as a record of their own performance. This grant encourages live performance and dissemination of the ideas and facts contained within them. Performing artists, such as the Grateful Dead, Dave Matthews Band, and Phish, who choose to freely license the right to record their performances to all attending, are free to do so. Other artists, who prefer to determine which of their performances to fix in a

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<sup>364</sup> See 18 U.S.C. § 2319A(3)(b) (2000); 17 U.S.C. § 1101(a) (2000).

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tangible medium of expression, and thereby enter the copyright system, are protected in making that choice.

CONCLUSION: THE ANTI-BOOTLEGGING STATUTES ARE  
CONSTITUTIONAL<sup>365</sup>

The *Martignon* and *KISS Catalog* decisions mandate that any statute protecting live performances must comply with an expansive version of copyright's "limited Times" and "Writings"

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<sup>365</sup> The statutes do not directly interfere with the Copyright Clause. However, they are in tension with the Copyright Act in certain circumstances.

In the case where there is a copyright in the underlying musical composition, if the court determines that the bootleg sound recording is a "fair use" under § 107 of the Copyright Act, then the statute would seem to conflict with the Copyright Act. *See* 17 U.S.C. § 107 (2004). The anti-bootlegging statute would require forfeiture, destruction of the phonorecords, and damages or imprisonment of the bootlegger, while the Copyright Act, pursuant to the goals of the Copyright Clause, would permit free use.

Similarly, in the case where there is no copyright in the underlying work (for instance, in the case of an improvisation or performances of works in the public domain, such as Mozart), the bootlegger may claim a legitimate copyright in the bootleg sound recording itself and the statute would again seem to conflict with the Copyright Act.

These tensions are not constitutionally fatal. Copyright holders are subject to certain limits which are, in turn, subject to First Amendment balancing upon review. For example, federal regulation of indecency and obscenity limit a copyright holder's ability to make use of her exclusive right to distribute, display or perform a copyrighted work. *See, e.g.,* FCC v. Pacifica Found., 438 U.S. 726 (1978), *reh'g denied*, 439 U.S. 883 (1978); Miller v. California, 413 U.S. 15 (1973). Similarly, a copyright holder may be held liable or penalized for publishing unlawfully obtained information, information that endangers individual safety, or information that endangers national security. *See, e.g.,* Cohen v. Cowles Media Co., 501 U.S. 663 (1991) (unlawfully obtained information); Rice v. Paladin Enterprises, Inc., 128 F.3d 233 (4th Cir. 1997) (individual safety); United States v. Progressive, Inc., 467 F. Supp. 990 (W.D. Wis. 1979) (national security). *But see* New York Times Co. v. United States, 403 U.S. 713 (1971) (permitting publication of unlawfully obtained information). Each of these restrictions is in tension with the copyright interest in dissemination of facts and ideas to the public. However, enforcement of such statutes is subject to ad hoc First Amendment balancing of private and public interests, not to any test arising out of the Copyright Clause itself.

Although there is no fatal conflict between the Copyright Clause and the anti-bootlegging statutes, a statutory amendment specifying that 17 U.S.C. § 1101 and 18 U.S.C. § 2319A only apply to works originally recorded or transmitted after the statutes' enactment in 1994 would increase clarity and decrease potential unfairness. Also, an amendment admitting the "fair use" exception would be preferable to ad hoc First Amendment review of the statute as applied. Such an amendment might read:

This act shall apply only to recordings and transmissions, as set forth in subsections (a)(1) and (a)(2) respectively, taking place on or after the date of the enactment of the Uruguay Round Agreements Act and to subsequent copies of the same. The limitation to exclusive rights set forth in 17 U.S.C. § 107 shall apply to this section, although any consideration of fair use shall consider the intention expressed herein to protect the interests of performers.

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requirements. The district courts' categorical application of *Gibbons* unnecessarily hampers Congress' ability to shape policy and to respond to the demands of domestic and international trade. A functional analysis, such as has been applied by the Supreme Court in questions of separation of powers, reveals that the anti-bootlegging statute does not undermine the copyright power and is not incongruous with the commerce power. Therefore the statute should be found to be constitutional as drafted and authorized under either, Article I, Section 8, Clause 3, or Clause 8 itself.