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PANEL III: *United States v. Martignon* —
Case in Controversy

Moderator: Hugh C. Hansen*
Panelists: William Patry[†]
David Patton[‡]
Robert W. Clarida[§]
Marjorie Heins^{||}
Jane Ginsburg[#]

MR. DANITZ: Good afternoon. I am Brian Danitz. I am the symposium editor of Volume 16 of *Intellectual Property, Media, & Entertainment Law Journal* at Fordham.

On behalf of the Journal, welcome. Thank you for coming today. You are all invited back to next year's symposium.

I would like to take this opportunity to thank a few people: Dean Treanor; Dean Diller; my faculty advisers: Professor Hugh Hansen, Professor Katyal, Professor Patterson; the folks in the Office for Public Programming and CLE, especially Darin Neely and Helen Herman.

I would especially like to thank our esteemed panelists for their scholarship and advocacy in the area of intellectual property law, and for sharing the fruits of their intellectual labor with us today.

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Now it is my distinct honor to introduce Professor Hugh Hansen, who will be moderating the copyright discussion, which promises to be a really exciting one. Professor Hansen teaches courses in copyright law, trademark law, European Community intellectual property law, advanced copyright law, and U.S. constitutional law at Fordham. He is the founder and director of the Annual International Intellectual Property Law and Policy Conference at Fordham School of Law, now in its fourteenth year. He has had speaking tours in Japan and Australia and averages about 10 presentations a year here and abroad. He has edited seven volumes on international intellectual property law, and one on U.S. IP law and policy. The 2006 edition of his book *New York Intellectual Property Handbook* will be published shortly by Matthew Bender/Lexis Nexis.

Professor Hansen.

PROFESSOR HANSEN: Thank you very much, Brian. Congratulations to you for putting together this symposium. I know that you have put in a lot of hard work over many months. We have had, I understand, two terrific panels already, and this looks like it is going to be another one.

The biographies are in the materials. To save time for discussion at Fordham we normally just give the name of the speaker and his or her affiliation and refer people to the biographies.

We have five speakers. Brian has devised a format where Bill Patry, of Thelen, Reid & Priest, will give an address and the other speakers will then give their comments or critiques. After that, we will have a general discussion with the audience and panelists.

The one exception to this format is that, if anyone wishes to have a point clarified, that question may be asked right after that speaker's presentation. Anything further should be left for the final discussion.

This symposium will be published in a future edition of the Fordham IPLJ. The very able staff of the Journal will add footnotes to the oral presentations given here today.

Without further ado, Bill Patry.

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MR. PATRY: Thank you, Hugh.

I am here because I was the one who drafted the bootleg statute¹ that is the topic discussion today. I wrote the statute when I was a congressional staffer in the House of Representatives, in the Intellectual Property Subcommittee. In that role, I wrote a fair number of statutes. I was used to being criticized by groups who didn't get everything they wanted. I will say, I never expected any statute I wrote to be held unconstitutional, and certainly not by second-year law students.²

I appreciate, of course, the venue in which I am speaking. I was a full-time faculty member at Cardozo for five years. I am sure it was a tremendous thrill, but it is one, from a societal standpoint, that I would hope is not repeated.

Being on the defensive, I decided that I would wear my camouflage. I thought I was going to be outnumbered, and indeed I may be. I hope to take away some of the flak by one particular *mea culpa*, but it may not be enough for some of you. So I decided I would go anonymous, or at least be able to deflect some of it.

What I would like to do is give you some background about how it is that this particular statute was passed, what we were thinking of. Some may think we weren't thinking at all, and I want to give you at least assurance that people in Washington, when I was there, before the "Great Cultural Revolution" in 1994, did spend time earnestly attempting to think things through. It doesn't mean we always came up with the best policy. I would say that this particular statute has a substantial policy flaw in it. But it was a statute that underwent a fair amount of high-level consideration.

In 1994, Congress was given the task by the administration of implementing legislation that arose out of the Uruguay Round Agreements.³ This particular round of WTO agreements was noteworthy because it incorporated for the first time protections for

¹ 17 U.S.C. § 1101 (2000); 18 U.S.C. § 2319A (2000) (17 U.S.C. § 1101 is a civil statute; 18 U.S.C. § 2319A is its criminal counterpart).

² See *United States v. Martignon*, 346 F. Supp. 2d 413, 416 n.1 (S.D.N.Y. 2004).

³ See Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, Legal Instruments—Results of the Uruguay Round, 33 I.L.M. 1125, 1197 (1994) [hereinafter TRIPS].

intellectual property and services, so that if one were found to violate the obligations that the treaty imposed, then a recalcitrant country could be taken to a WTO panel and have cross-sector retaliation imposed.⁴ That was a serious issue. Indeed, the United States, I believe, was the first to be taken to the dock on our Section 110(5) expansion that came about as a result of term extension.⁵ So it was a serious issue, and you wanted to make sure you got it right.

It was a big deal to have intellectual property in a trade agreement where there are some teeth to it. Prior to then, countries that didn't have penalties—like people who speed and don't get caught (I would include myself in that)—would do things without fear of retribution. If there is no penalty, if there is no stick, and you try to get away with as much as you can. I will come back to that in a minute.

GATT was a different sort of beast. It was an obligation that the executive branch engaged in. It wasn't a congressional initiative. That means that Congress' job was to implement legislation, not to formulate policy.

That being said, it was not the case—as Judge Pooler said at the oral argument in the Second Circuit in the *Martignon* case, “Why didn't Congress just do what it was told?”⁶ I found that to be incredibly chutzpahdik and, frankly, rather ignorant of how the system works. Told by whom? Congress may do things wrong, but it is not like some treaty tells Congress, “You have to do this.” That is just not the way it works.

What Congress did was to attempt to fulfill the treaty obligations in a good-faith manner and to figure out how it wanted to effectuate the protection that was required. After all, the treaty merely said, “You have to do X and Y.” It didn't tell any country how it had to do X and Y. There was a fair amount of discretion in how X and Y were done.⁷

⁴ See *id.* at 1215.

⁵ See 17 U.S.C. § 110(5) (2000); 17 U.S.C. § 302(a) (2000); see also *Eldred v. Ashcroft*, 537 U.S. 186, 191 (2003).

⁶ *United States v. Martignon*, No. 04-5649-cr (2d Cir. argued July 12, 2005).

⁷ See *TRIPS*, *supra* note 3, at 1198.

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There were some procedural issues also. First of all, it was fast-track legislation, meaning that once the bill was introduced, that was it; there was no amending.⁸ It was a straight up or down vote on a 3,000-page bill.⁹ There was no way that bill was not going to pass. There was no way anybody was going to vote against the bill based upon on some intellectual property provision. As important as we may think intellectual property is, I can tell you, in a 3,000-page trade bill, it doesn't mean diddly-squat. It just was not a big deal.

It was a big deal to us, though, because that was our job. So we sat down with the administration and other people and figured out what should go in. It was particularly important to do it, because, as I mentioned, once it goes in, that's it; it's law.¹⁰ So you had to get it right before the bill went in—not like ordinary bills, where you can hold hearings, you can change it, you can listen to people, you can play with it; the Senate is going to do something. That wasn't the case here. You either got it right or you didn't. Many people would say we didn't get it right, and to some extent, I would agree. But we did think about it.

Another thing about being a trade bill and a fast-track bill is that, as an obligation for a treaty, we didn't engage in the ordinary incentives-balancing that some people think Congress does—on the one hand, this, and on the one hand, that; does it promote the progress of science by this or that. Forget it. That is just not the task. The task is: you have this treaty obligation. You have to do it. What is the best way to do it? There may be, and should be, policy issues in there, but the ordinary process of balancing incentives was taken away by the obligation to give the protection. So any debate about whether it was good policy to give protection for this was not on our table at all. It was something we had to do, and we did it.

The specific obligation was to give to performers the right against an unauthorized fixation of their work and subsequent

⁸ See 19 U.S.C. § 2903 (2000); *Michel v. Anderson*, 14 F.3d 623, 632 (D.C. Cir. 1994).

⁹ See Uruguay Round Agreements Act, Pub. L. No. 103-465, 108 Stat. 4809 (1994) [hereinafter URAA].

¹⁰ See 19 U.S.C. § 2903 (2000).

distributions of an unauthorized fixation.¹¹ The term that was set out in the treaty itself was “at least fifty years.”¹² It didn’t say “only fifty years.” If it had said you couldn’t give more than fifty years that is what we would have done. We would have done, as Judge Pooler so much wanted us to do, what we were told. But we weren’t told “just fifty years.” We were told “at least fifty years.”¹³ If a statute says, “You shall protect blue cars,” okay, we will protect blue cars. If we want to protect green cars, we will protect those, too. We are not violating a treaty obligation by doing more than the treaty requires. So if we gave more than fifty years, we weren’t violating the treaty in the least.

An initial question that we faced, which one should face in any exercise of this nature, is: do you have to pass any implementing legislation? It is very common for countries to want to sign treaties that don’t obligate them to do anything, but require the other side to do lots of things. That is a great treaty for one side: “hey, you guys have an obligation you didn’t have before; we don’t have any, because our law already does it.” The United States is quite fond of treaty obligations like that.¹⁴

So our first task was to honestly look through and see whether we could do one of those rope-a-dopes. Could we say, “Guess what? We woke up in the morning and we’ve already got the protection that this treaty obligates us to have”? There was some evidence of that. There were state laws that gave protection of this nature.¹⁵

One problem with that was that it wasn’t uniform. Another problem was that, in 1988, when the United States joined the Berne Convention—we joined on March 1, 1989, but the legislation was passed in 1988¹⁶—there was a requirement in

¹¹ See 17 U.S.C. § 1101 (2000); 18 U.S.C. § 2319A (2000).

¹² TRIPS, *supra* note 3, at 1202.

¹³ *Id.*

¹⁴ See, e.g., Extradition Treaty with Great Britain and Northern Ireland, U.S.-U.K., Mar. 31, 2003, S. TREATY DOC. NO. 108-23 (2003).

¹⁵ See, e.g., FLA. STAT. § 540.11(2)(a)(3) (2002).

¹⁶ See Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853 [hereinafter BCIA].

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Article 6^{bis} to provide moral rights.¹⁷ That was quite a big issue. There were many hearings held on that, many debates.¹⁸ Then one morning the United States woke up and said, “Wow, we have had moral rights all along. We actually have them in state laws¹⁹ and maybe in Section 43(a) of the Lanham Act,²⁰ so we don’t have to do anything.²¹ We now can join the Berne Convention,²² and this enormous issue that was so problematic is just gone, because the states do it.” As I said before, the treaty didn’t obligate you to do it in a particular way; it merely obligated you to have protection.²³

That was felt by some to be intellectually dishonest, if not factually inaccurate.²⁴ There was some criticism in Europe after Berne—sort of a “morning after” thing—“Gee, it’s great that you’re in, but you’re not what I thought you were.” So we thought that was probably a weak basis upon which to fulfill this obligation. We wanted to do better, frankly, than we had done in 1988.

Another reason is that the U.S. Customs Service came to us and said, “We don’t think it’s a very strong basis for us to stop imports based solely on state law. We are a federal agency. There may be state anti-bootlegging laws, but we’re uncertain whether we have the authority to stop the importation into the United States of a bootleg that merely violates state law. It would be helpful to us if you had a federal statute.” We thought that was a decent enough concern.

¹⁷ See Berne Convention for the Protection of Literary and Artistic Works, Paris Act, art. 6bis, July 24, 1971, S. TREATY DOC. NO. 99-27, 828 U.N.T.S. 221 [hereinafter Berne Convention].

¹⁸ See H.R. REP. NO. 101-514, pt. 3, at 7 (1990), as reprinted in 1990 U.S.C.C.A.N. 6915, 6917.

¹⁹ See, e.g., CAL. CIV. CODE § 987 (West 2006); N.Y. ARTS & CULT. AFF. LAW § 14.03 (McKinney 2006).

²⁰ 15 U.S.C. § 1125 (2000).

²¹ See H.R. REP. NO. 101-514, pt. 3, at 7–8 (1990), as reprinted in 1990 U.S.C.C.A.N. 6915, 6917-18; S. REP. NO. 100-352, pt. 3, at 9–10 (1988), as reprinted in 1988 U.S.C.C.A.N. 3706, 3714–15.

²² See Berne Convention, *supra* note 17, art. 6bis.

²³ See TRIPS, *supra* note 3, at 1198.

²⁴ See, e.g., Robert J. Sherman, Note, *The Visual Rights Act of 1990: American Artists Burned Again*, 17 CARDOZO L. REV. 373, 405 (1995).

A final concern was that if our trade negotiators, USTR,²⁵ wanted to go around to other countries that were a source of bootlegs, it would be helpful for them to have on the books a strong federal statute, so they could avoid, in some ways, the Berne problem, that they could point to it and say, “Look, we have this federal statute here, and we would like you to enact something like that.”

All three of those things made sense, to have a federal statute where there wasn’t one before. There was no question that there was no existing federal statute that covered it. So we decided that we would have a federal statute.

Now, where would that statute be placed? What would it be based on? That was the next issue that we had to decide. This, surprisingly to me, has turned out to be a key component, at least in the court opinions. I have to say, I am disappointed by the unfamiliarity with how laws are actually made that is reflected in some of those opinions. I am not talking about policy. That is a different issue. Frankly, I have difficulties defending the statute on some of the policy grounds. And I am very happy to talk about law rather than policy, for that reason.

But let’s talk about placement. Contrary to what most people think, where a law is placed—a federal law—has little, if any, consequence at all. A law can just be. Once both bodies pass it and the President signs it, that is really it. That is what the law is. So if Congress decided that they wanted to ban the implanting of global positioning chips on children under the age of 4—I don’t know if it is a good idea or not; I have 4-year-old twins, so I am thinking of it—if they wanted to do that, they could put that in Title 17, Title 15, any title they want, or not in a title at all. It is no more or less a law whether it is in a title or not.

I used to think—and Jane can correct me if this is true—that, in fact, the Lanham Act is not codified. I think West put it in Title 15,²⁶ but I don’t think Congress did. I may be wrong on that, but I think that is right.

²⁵ United States Trade Representative.

²⁶ See 15 U.S.C. §§ 1051–1141(n) (2000).

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United States Code, U.S.C.—or U.S.C.A. for West—is not a codification of all laws. The United States Code represents some laws that happen to be put into a certain bin, but the Code is not all laws. There are lots of laws that aren't in USC. Indeed, it is very rare for effective dates in statutes, including copyright statutes, to be codified. Effective dates are pretty important parts of a statute. They are usually not codified. The copyright acts that I have been involved with don't have effective dates that are codified.

So where an act is placed or whether it is codified really doesn't have any consequence, legally. Sometimes it is merely administrative. I will tell you a little bit about that right now.

When we decided to have a federal statute, where would we put it? We could have put it nowhere. That probably would have been a good idea. Originally, we wanted to put it in what is called by West (but not by Congress) Title 15, the trademark part.²⁷

We wanted to put it in Title 15. We drafted it in Title 15 originally, because we viewed it as an exercise of commerce-clause power,²⁸ and it made sense to put it in the Trademark Act.²⁹

We took it out of Title 15 only at the very, very end of the process. We took it out for a personal reason that had nothing to do with the legal reasons. The reason was this. In the subcommittee, when I worked there, I handled the copyright issues. There was another lawyer who handled trademark and patents. She also did prisons, which is convenient for the criminal part of these statutes. That lawyer had gone to the trademark groups, when they were trying to figure out what was going to be in the bill, and she said, "There are very few amendments to the Trademark Act in this. Here are the ones that there are. What do you think of them?" Fair enough to do, since once the bill is introduced, you can't change it. So if you are going to talk to people and get their input, you have to do it early. And she did. She said, "There are only one, two and three that are in there." They said, "We don't care about those. That's fine." So they went back to bed.

²⁷ 15 U.S.C. § 1501 (2000) (effective July 5, 1947).

²⁸ See U.S. CONST. art. I, § 8, cl. 3.

²⁹ 15 U.S.C. §§ 1051–1141(n).

As it turned out, we didn't view the bootleg provision as a copyright provision, nor did she. Since she had gone and told people this, we—"we" being chief counsel and I—went ahead and put it in Title 15. We thought, "That makes sense. Why not? It is not copyright; it is Commerce Clause. We'll put it in there."

So a draft of the bill was sent around. The trademark people saw this and accused her of breaking her word. They said, "Look, you're amending the Trademark Act. You're putting this bootleg provision in there. You told us it would only be one, two and three." She went ballistic at us. On a personal basis, it was a lot easier for us to say to her, "Okay, okay, okay, we made a mistake. We didn't mean to do it."

So we took it out at the very end and put it in Title 17.³⁰ We didn't change the bill at all. That is why I say the placement of the bill was really quite irrelevant. The fact that it is in Title 17 has merely to do with the fact that it was much easier for us to placate Jeralyn by putting it in there, rather than having to listen to her and argue about it. She was pretty tough. She had prisons, after all; we didn't—"all right, fine; you want it in Title 17? We'll put it in Title 17." And we did.

Now, getting on to the constitutional part of it, we did actually think quite seriously about this. My view—and I understand Prof. Ginsburg may have a slightly different one—is that for a work to be considered a writing within the meaning of the Constitution, it has to be fixed.³¹ It doesn't extend to unfixed works.³² That turns out to be a rather critical thing. I thought that the Eleventh Circuit agreed,³³ and I thought, in his own hapless manner, Judge Baer thought that, too, although it is sort of hard to figure out what he did think, since I find his opinions inconsistent.³⁴

Nevertheless, we started from that assumption, that "writings" is limited to fixed works.³⁵ Since, by definition, we were only

³⁰ See 17 U.S.C. § 1101 (2000).

³¹ See 17 U.S.C. § 102(a) (2000).

³² See *id.*

³³ See *United States v. Moghadam*, 175 F.3d 1269 (11th Cir. 1999).

³⁴ See *United States v. Martignon*, 346 F. Supp. 2d 413, 421 n.8 (S.D.N.Y. 2004).

³⁵ See 17 U.S.C. § 102(a).

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protecting unfixed performances, my belief was, and remains, that we were not legislating under the Copyright Clause at all.

We talked to the administration. We talked to the Copyright Office. We talked to a number of constitutional copyright scholars. It wasn't something where we sat back and said, "What do you think?" "No, I don't think so. I think 'writings' is only fixed work. Let's do it." It wasn't that way. It was deliberate. We did talk to people. We did think about the issue. We did some reading about it. At that point, I had been practicing copyright law for thirteen years full-time. It wasn't something we did off-the-cuff. It was something that we thought was substantively correct. If we had thought it was permissible to legislate under the Copyright Act,³⁶ we would have. I was a copyright lawyer. It was much more natural for me to do that. I had never done anything outside of copyright, so it was my first instinct to do it.

Having decided that the Copyright Clause was limited to fixed works and that the performances in question were unfixed,³⁷ we knew that we were not legislating under the Copyright Act—knew in the sense that that was our intention. I understand that there might be some difference of opinion about that. But when the Eleventh Circuit said that Congress thought they were legislating under the Copyright Clause,³⁸ I don't get that. We clearly were not. You can say we were wrong because you disagree with how we interpreted the Constitution, but to say that we thought we were legislating under the Copyright Clause is nonsensical.

I will give you a textual reason for that. I don't expect you to say, "Oh, well, he says that, and he was there. What good does that do me?" I am not even talking about legislative history, which you may or may not look at, and even if you did look at, you wouldn't find very much on this.

³⁶ General Revision of Copyright Law, Pub. L. No. 94-553, § 101, 90 Stat. 2541 (1976) (codified as amended in scattered sections of 17 U.S.C. §§ 101–1332).

³⁷ See 17 U.S.C. § 102(a) (2000).

³⁸ See *United States v. Moghadam*, 175 F.3d 1269, 1275 (11th Cir. 1999).

But the statute itself, in § 1101(a), says that a violator of the right shall be subject to the remedies provided in §§ 502–505 *to the same extent as an infringer of copyright*.³⁹

Now, what does that mean to ordinary people who have a moderate ability to read a statute in good faith? It means that you are not a copyright infringer. If you were a copyright infringer, we wouldn't have said anything. We certainly wouldn't have said "to the same extent as if you were a copyright infringer." That says that we thought that this was not a copyright provision, and the fact that it was in Title 17,⁴⁰ for the reasons I just gave you, is silly. It just doesn't make sense. This is sort of plain stuff. The idea that it could be "copyright-like" I don't quite get either. You are pregnant or you are not pregnant. Either it is a Copyright Clause or it is not a Copyright Clause. It can't be "copyright-like."

We will get into the dormant Copyright Clause issue, and I will certainly leave that to Professor Ginsburg, who is a much greater authority on it than I am. I would say, though, in terms of policy—here is my *mea culpa* on this—because we didn't think we were operating under the Copyright Clause, we believed that we were free to do what we wanted, including the term of protection. Being free was sort of exhilarating—"wow, it's nice to be out from under the Constitution for once. How long do we have to chafe under that terrible document. Now we're free to do whatever we please."

We thought, how long is this protection going to be? Anything seemed arbitrary. We thought, why be arbitrary? Just do it. How many times do you have the opportunity to just do it, and have no limits at all, have an act without any limitations? That is what we did.

In hindsight, I think that was a huge mistake. I do think that we had the power to do it. I do think it was a terrible policy judgment. There is no reason to go beyond the fifty years that were set forth in the treaty—not because the treaty told us to do it. It didn't tell us to do it. On that, obviously, I have a very combative view towards what Judge Pooler said at argument in the

³⁹ See 17 U.S.C. § 1101(a) (2000).

⁴⁰ 17 U.S.C. (2000).

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Second Circuit.⁴¹ But fifty years was really quite adequate. It really did not need to be more than that. After the term extension in 1998,⁴² which was four years later, I like to think that I have learned something, and one of the things that I think I have learned is that a long term of protection has very bad societal impacts.⁴³ For this one, the public didn't gain anything by it being so long, and, actually, I think, was rather harmed by it. For that, I certainly apologize and confess error.

On the Commerce Clause issue—this is where it really gets down to it—a few things I will dispatch quickly, because I know other people want to talk and certainly have great things to say.

Judge Baer argued that the mere placement of it in Title 17 showed that we were concerned with the interests of artists, not commerce.⁴⁴ I didn't think there was a huge difference between artists and commerce, and certainly when you are talking about tours, they are engaged in interstate commerce. That is just a bizarre little argument, for me.

Another one that some people take seriously—I hope no one here takes that one seriously—is that live performances can be original and that, because they are original within the colloquial creative sense § 1100 is a copyright provision.⁴⁵ I think that is tied to the issue of fixation, although if you have the view that the Writings Clause in the Constitution⁴⁶ encompasses things that could be fixed but aren't, then I would say that we are wrong on the constitutional part of that. I don't think we are, but I accept that some people believe that the word “writings” doesn't mean

⁴¹ See *United States v. Martignon*, No. 04-5649-cr (2d Cir. argued July 12, 2005) (during oral arguments Judge Pooler inquired as to why Congress did not simply do what it was told to do).

⁴² Sonny Bono Copyright Term Extension Act of 1998, Pub. L. No. 105-298, 112 Stat. 2827 (1998) (codified as amended at 17 U.S.C. §§ 301–304 (2000) and other scattered sections of 17 U.S.C.) [hereinafter Bono Act].

⁴³ See, e.g., *Eldred v. Ashcroft*, 537 U.S. 186, 266 (2003) (Breyer, J., dissenting) (noting that the Bono Act will pose serious harm to society).

⁴⁴ See *United States v. Martignon*, 346 F. Supp. 2d 413, 421–22 (S.D.N.Y. 2004).

⁴⁵ See, e.g., Brian Danitz, Comment, *Martignon and Kiss Catalog: Can Live Performances Be Protected?*, 15 *FORDHAM INTELL. PROP. MEDIA & ENT. L.J.* 1143, 1186 (2005).

⁴⁶ See U.S. CONST. art. I, § 8, cl. 8.

just fixed, and it means things that could be fixed.⁴⁷ Since a live performance could be original, if you are of the other view, you could tie those two things together, and the statute would indeed have the infirmities some people think it does.

So fixation is really, I think, the key issue. For me, there is a distinction between the subject matter that is being protected—the live performance—and the violation of it. The violation of it, of course, in Mr. Martignon’s case, was not the fixation, but the distribution.⁴⁸ He only engaged in distribution. I can see how it is easy to look at it and say, “Wait a minute. What he or anybody else was doing was distributing a fixed copy of a live performance, which, once fixed, people would believe is original work of authorship.” I think that is the argument.

My response to that is, okay, that is true, but the subject matter that we were concerned with was the live, unfixed performance; the fixation of it is the copy, it is not the work, in copyright parlance—which I am reluctant to fall into the trap of—because people will say, “See? You’re talking about it like it’s a copyright statute. You really think it is.” But it is a distinction between the material object and the particular immaterial subject matter that we are dealing with there.

I also think that there is an authorization issue. I think, to be fixed, it has to be fixed with the authority, understanding that other countries don’t do that, that Berne doesn’t require it.⁴⁹ If you believe that fixations can be unauthorized, I think you would have to preempt state laws, because states can protect unfixed oral works right now.⁵⁰

Enough background. I will turn it over to others, who will have, probably, more interesting things to say. But I wanted to at least provide the background for why Congress seemingly did something that seems too “fercockta.”

PROFESSOR HANSEN: Thank you.

⁴⁷ See Danitz, *supra* note 45, at 1190–91.

⁴⁸ See *Martignon*, 346 F. Supp. 2d at 417.

⁴⁹ See Berne Convention, *supra* note 17.

⁵⁰ See, e.g., CAL. CIV. CODE § 980(a)(1) (West 1982).

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I think we should hear from the counsel for the defendant in this case, who probably has a different view—I am just guessing—David Patton, out of the Federal Defender Office in the Southern District of New York.

[See article below in lieu of presentation transcript.]⁵¹

PROF. HANSEN: Thank you very much.

I think now we will have Bob Clarida, from Cowan, Liebowitz, and Latman.

MR. CLARIDA: Thank you.

I have been involved with this case—not, certainly, as long as David, and not involved with the statute anywhere near as long as Bill has—but I was very interested in this the first time I read the decision and was contacted shortly thereafter by the RIAA, the Recording Industry Association [of America], which was interested in putting in an amicus brief in support of the government,⁵² in support of the constitutionality of this statute, when the case went up on appeal to the Second Circuit.⁵³ I drafted a brief for the RIAA in connection with this case.⁵⁴

I understand that a representative of the RIAA was going to be on the panel today and couldn't make it. I am not his stand-in. I am not here today to speak for the RIAA or for my firm. I am just giving you my own observations, which are generally in agreement with the positions set forth in the RIAA brief, which is in your material.

I will give you a quick synopsis of the argument that we made, and then I will go into some of the points in a little more detail.

As to the writings question, we did not get into that. I don't think that is a question that is up on appeal. The court's finding as to writings—that these live performances are not writings⁵⁵—was

⁵¹ David Patton, *The Correct-Like Decision in United States v. Martignon*, 16 *FORDHAM INTELL. PROP. MEDIA & ENT. L.J.* 1287 (2006).

⁵² Brief of *Amici Curiae* UMG Recordings, Inc., et al. in Support of Reversal, *United States v. Martignon*, No. 04-5649-cr (2d Cir. Mar. 15, 2005) [hereinafter RIAA Brief].

⁵³ *Martignon*, 346 F. Supp. 2d 413, *appeal docketed*, No. 04-5649-cr (2d Cir. Oct. 26, 2004).

⁵⁴ RIAA Brief, *supra* note 52.

⁵⁵ *Martignon*, 346 F. Supp. 2d at 423.

something that I thought was so devastating to the conclusion that the court ultimately tried to reach that certainly it was not something that we were going to take issue with. If you take the position that live musical performances are not writings, then I don't see what possible relevance the Copyright Clause has on any of this, because, as I will get into briefly, the powers of Congress under Article I are cumulative.⁵⁶ Certainly, the fact that you can operate under one clause and protect a particular subject matter has nothing to do with the other kinds of protection you might be able to provide to other subject matter under other clauses of the Constitution. So by saying that the works at issue, the performances at issue, are not writings, I think, should have been the end of the day, and the court should have said, "They are not writings. The Copyright Clause doesn't govern."

There is also the issue of whether the performers at issue are authors in a constitutional sense. Certainly, some may be authors. Bob Dylan gets up and performs his own music. He is both an author of the underlying music and, if the performance is fixed with his authorization, he is an author of the sound recording as well. But it is not the case, and certainly not the case with otherwise unfixed performances, that the performers can be deemed authors in the constitutional sense or statutory sense.⁵⁷

Also, I think the purposes of the bootleg statute are quite different. It is not to give authors an incentive to create writings. If we start from the premise that the performances at issue are not writings, then we are not giving anyone an incentive to create those writings. As Bill described the genesis of the statute, it clearly arose out of a trade bill.⁵⁸ International trade concerns were first and foremost in Congress' mind and the Clinton Administration's mind in putting this together.⁵⁹ It was not something that was seen as necessary to promote the progress of science and the useful arts, as the Constitution says in Article I, § 8.⁶⁰

⁵⁶ See RIAA Brief, *supra* note 52, at 12.

⁵⁷ RIAA Brief, *supra* note 52, at 14–16.

⁵⁸ See *supra* note 3 and accompanying text.

⁵⁹ See Brian Danitz, *Martignon and Kiss Catalog: Can Live Performances Be Protected?*, 15 FORDHAM INTELL. PROP. MEDIA & ENT. L. J. 1143, 1153–58 (2005).

⁶⁰ U.S. CONST. art. I, § 8, cl. 8.

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Also the statute was filling a very important gap that had been pointed out in federal law. Bootlegging convictions had previously been sought and obtained under the National Stolen Property Act, the NSPA, before about 1985.⁶¹ There was a case in 1985 called *Dowling v. U.S.*,⁶² in which that was held impermissible. The National Stolen Property Act could not be used to stop the sale of bootleg recordings.⁶³

So there had been a federal statute that prohibited this.⁶⁴ That statute was no longer applicable under that precedent.⁶⁵ This federal protection,⁶⁶ basically, was filling the gap that had existed since that time. There had been state law protection in various states,⁶⁷ but there wasn't a federal law. Clearly, this is a federal problem. It is an interstate and international problem. One of the things about the statute that doesn't get much attention is the fact that it pertains to trafficking in fixations of performances, even if the fixation occurred outside the United States.⁶⁸ There is clearly an international dimension, as well as an interstate dimension.

So for all those reasons, we thought that there was no application of the Copyright Clause, nor did we see that there was a conflict with the Copyright Clause and the Commerce Clause here. Basically, the *Railway Labor Executives v. Gibbons*⁶⁹ analysis was not very persuasive, I think, because the statute at issue in *Gibbons* was a bankruptcy statute.⁷⁰ There is no question about it. The statute at issue here⁷¹—certainly, at least arguably—is not a copyright statute. It is copyright-like. That is as close as the court will come to saying it is a copyright statute. It is copyright-like.

⁶¹ 18 U.S.C. §§ 2314–2315 (2000).

⁶² 473 U.S. 207 (1985).

⁶³ *Id.* at 229.

⁶⁴ 18 U.S.C. § 2314 (2000).

⁶⁵ *Dowling*, 473 U.S. 207 (1985).

⁶⁶ 17 U.S.C. § 1101.

⁶⁷ *See, e.g.*, FLA. STAT. § 540.11(2)(a)(3) (2002).

⁶⁸ 17 U.S.C. § 1101(a)(3).

⁶⁹ 455 U.S. 457 (1982).

⁷⁰ 45 U.S.C.A. § 1005 (2000).

⁷¹ 18 U.S.C. § 2319A (2000).

The word “purview” comes up three times in this opinion. You can read a lot of opinions and not see the word “purview.” It comes up three times here. The court, in one instance, says the statute is within the purview of the Copyright Clause,⁷² and twice it says the statute is not within the purview of the Copyright Clause.⁷³ So that says to me that the relationship between the statute and the Copyright Clause was extremely unclear to the court. Yet it was that sort of perceived kinship between the statute and the Copyright Clause that I think was the basis for the court’s reasoning. It saw this sort of emanation from the Copyright Clause—“well, this has something generally to do with the arts; therefore, it has to come within the ambit of the Copyright Clause, and it has to play by the rules and the limitations of the Copyright Clause.”

To give a little bit more detail on a couple of those points, I think it is quite clear under the statute as written, and as Bill has described it, that they were not trying to protect authors here; they were trying to protect performers. The language in the statute itself says, “Whoever, without the consent of the performer or performers involved.”⁷⁴ This is not an author-protection statute; it is a performer-protection statute. The creations that they are making are not works of authorship under the statute, under 102(a), that lists various types of copyrighted works.⁷⁵

Now, *Moghadam*⁷⁶ points out, and I think correctly, that the drafting of § 102(a) does not include live musical performances.⁷⁷ It is not one of the types of copyrighted works listed in § 102(a).⁷⁸ *Moghadam* says that Congress could have done that differently, that they could have included live musical performances under § 102(a).⁷⁹ Perhaps they could have. We have the writings question, whether you consider it a writing or not. But they could

⁷² See *United States v. Martignon*, 346 F. Supp. 2d 413, 427 (S.D.N.Y. 2004).

⁷³ See *id.* at 424.

⁷⁴ 18 U.S.C. § 2319A (2000).

⁷⁵ 17 U.S.C. § 102(a) (2000).

⁷⁶ *United States v. Moghadam*, 175 F.3d 1269 (11th Cir. 1999).

⁷⁷ See *id.* at 1274.

⁷⁸ 17 U.S.C. § 102(a) (2000).

⁷⁹ See *Moghadam*, 175 F.3d at 1273.

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have, perhaps, included live musical performances, and they didn't do that.

The performer in a case like this may, in fact, be creating a writing, or may not. But what they are certainly doing with respect to the underlying work is exercising a right in the work. They are not creating a new work by performing it. Performance is one of the exclusive rights granted in § 106 of the Copyright Act.⁸⁰ When a person performs a work, he is not thereby creating a new work any more than a museum is creating a new work when it hangs a painting on the wall. It is giving a public display of that work. That is exercising a right in the work. It is not creating a new work.

If you then step back from that painting and you take a photograph of that painting hanging on that wall, you have created a new work which incorporates the painting, and you have a new work of authorship. But merely by hanging the painting on the wall, you don't create a new work. You are not an author by virtue of doing that.

The argument that we made was that a performer, in performing a work, is not an author by virtue of doing so.⁸¹

There is also a policy question about the underlying policy of this statute vis-à-vis the Copyright Act. There is not a *quid pro quo* here. There was a lot of discussion at the time of the *Eldred*⁸² case that went up to the Supreme Court about the importance of a *quid pro quo*.⁸³ There is certainly case-law support for this, the idea that in order to get copyright protection, an author has to dedicate a work to the public and, in exchange, receive a period of exclusive rights in that work.⁸⁴ So there is this exchange that takes place between the author and the public. You are donating something to the public.

What is going on here is that someone is fixing and trafficking in a performance that was never intended to be made public. This

⁸⁰ 17 U.S.C. § 106 (2000).

⁸¹ See *Moghadam*, 175 F.3d at 1274.

⁸² *Eldred v. Ashcroft*, 537 U.S. 186 (2003).

⁸³ See *id.* at 216.

⁸⁴ See, e.g., *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989).

is not something that the artist is dedicating to the public. The public is deprived of nothing here, except the right to eavesdrop on a performance that they didn't buy a ticket for. That is the only thing the public is being deprived of. It is simply not a matter—in *Bonito Boats*,⁸⁵ for example, there is this language: Does it constrict the spectrum of useful public knowledge, or does it restrict the public's ability to exploit a work in general circulation?⁸⁶ There is no work in general circulation here. There is no useful public knowledge that is being withheld. What is being withheld is what happens within an auditorium for people who pay to be in that auditorium.

It is possible for a performer in a situation like this, by not authorizing a fixation of his or her performance, to opt out of copyright altogether, to say, "What I'm doing is not about copyright. What I'm doing is giving a performance, and if you want to come to my performance, buy a ticket." That is what the performer is doing. The performer is opting out of this federal statutory scheme that exists for copyright, in the same way that an inventor can, perhaps, opt out of the patent system by simply keeping the information as a trade secret.⁸⁷ You don't have to enter into this exchange. You can keep it secret. You can keep it within your four walls and charge people to come in and see it. Or you can make a recording of it and sell it, and then you have the bargain with the public, the quid pro quo.

But the bootleg statute doesn't require that.⁸⁸ Also, the bootleg statute doesn't require originality in the performance. It requires that the performance be live.⁸⁹ It doesn't require that it be original. If you are talking about the differences between what a performer does and what an author does, originality is the sine qua non of authorship in the copyright sense—in the constitutional sense, as *Feist*⁹⁰ tells us—but it has nothing to do with a performance. If I get up and do a performance that is very much like Marcel

⁸⁵ 489 U.S. 141 (1989).

⁸⁶ *Id.* at 159.

⁸⁷ HARRY D. NIMS, *THE LAW OF UNFAIR COMPETITION AND TRADE-MARKS* 406 (1929).

⁸⁸ 18 U.S.C. § 2319A (2000).

⁸⁹ 18 U.S.C. § 2319A (2000).

⁹⁰ *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991).

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Marceau, it is not my performance. It is not an original performance. It may be substantially similar to Marcel Marceau's. Now, maybe it wouldn't be covered here because it is not a live musical performance, but if he were singing, I guess it would be. (He was a mime, but if he were to have done a live musical performance.)

If I got up and did my best Bob Dylan imitation, there would be nothing original about that. Yet it could still be protected under this statute.

As far as the placement in the statute and things like that, which both Bill and David alluded to, I will just go through a few points that the court made. The court said there is no reference to the Commerce Clause anywhere in the statute or the legislative history.⁹¹ But, of course, there is no recital of any particular constitutional source needed. The no-recital rule is well-established.⁹² Congress can even recite the wrong clause, and it is still okay.⁹³

The placement in Title 17,⁹⁴ I think, should be a non-issue. The criminal statute that we are talking about, of course, is not even in Title 17. It is 18 U.S.C. § 2319(a). But even if it were—say, § 1101, which is the civil analogue, is placed in the copyright statute—that has nothing to do with it. It can still be supported by the Commerce Clause. The *Authors League* case, I think, is probably the best illustration of that; *Authors League v. Oman*, a case in which the Manufacturing Clause, former § 601 of the Copyright Act, which is now abrogated, was held permissible under the Commerce Clause.⁹⁵

I will just read you quickly a quote from *Authors League*.⁹⁶ This was a section within Title 17, 17 U.S.C. § 601, prohibiting the

⁹¹ Eldred v. Ashcroft, 537 U.S. 186 (2003).

⁹² “The constitutionality of action taken by Congress does not depend on recitals of the power which it undertakes to exercise.” Equal Employment Opportunity Comm’n v. Wyoming, 460 U.S. 226, 244, n.18 (1983) (quoting *Woods v. Cloyd W. Miller Co.*, 333 U.S. 138, 144 (1948)).

⁹³ Cf. *Woods v. Cloyd W. Miller Co.*, 333 U.S. 138, 144 (1948).

⁹⁴ 17 U.S.C. § 1101 (2000).

⁹⁵ 790 F.2d 220, 224 (2d Cir. 1986).

⁹⁶ *Id.*

importation of works manufactured abroad. “The Copyright Clause is not the only constitutional source of congressional power that could justify § 601. 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.”⁹⁷

So it is not the case that if something is in Title 17, it is thereby a copyright provision.

Also the court said this criminal statute imports definitions from the Copyright Act, definitions of what is fixed and so on and so forth, distribution.⁹⁸ But the Copyright Act itself incorporates definitions from other statutes, for example, the FCC Act, Title 47, which is under the Commerce Clause.⁹⁹ If you look in the Copyright Act, there are definitions about what a terrestrial broadcaster is and all sorts of things having to do with broadcast that are imported wholesale from the FCC provisions, which are based in the Commerce Clause.¹⁰⁰

So that doesn’t mean those provisions are not copyright provisions, simply because they incorporate definitions from elsewhere.

Finally, just to touch briefly on the treaty power, which the court did not deal with at all—and it was really surprising to me, because I thought that the exhortation to a court was always to try, if possible, to find some constitutional basis for a statute, and not throw out a statute gratuitously. I think there is an independent treaty power basis here, because the treaty power of the Necessary and Proper Clause provides Congress with the power to do things pursuant to ratification of an international agreement that it has no Article I power whatsoever to do.¹⁰¹

The case, specifically, that we cited in our brief is *Missouri v. Holland*,¹⁰² which Justice Holmes decided in 1920. It involved an

⁹⁷ *Id.* at 224.

⁹⁸ *Id.*

⁹⁹ See U.S. CONST. art. I, § 8, cl. 3.

¹⁰⁰ See Copyright Act, 17 U.S.C.A. § 101 (1999).

¹⁰¹ See U.S. CONST. art. I, § 8, cl. 18.

¹⁰² *Missouri v. Holland*, 252 U.S. 416 (1920).

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act to prohibit the hunting of migratory birds.¹⁰³ The statute had been struck down as unconstitutional twice.¹⁰⁴ Then, finally, the executive branch executed a treaty with the United Kingdom, which included Canada, saying that we have to do this as part of a treaty obligation, and the statute was upheld.¹⁰⁵ It had previously been struck down as unconstitutional because the court said there was no Article I basis for this statute.¹⁰⁶ When the statute was passed to implement this treaty, it withstood constitutional scrutiny. The court said, “It is obvious that there may be matters of the sharpest exigency for the national well-being that an act of Congress could not deal with, but that a treaty, followed by such an act, could. It is not lightly to be assumed that in matters requiring national action, a power which must belong to and somewhere reside in every civilized government is not to be found.”¹⁰⁷

There is a limitation on that. Certainly, we couldn’t have a treaty with China where we said, for anybody who criticizes China, we are going to not enforce their copyright, because they are criticizing China. We couldn’t do that. There is a case called *Reid v. Covert*¹⁰⁸ in 1957, which says that where there is a violation of the affirmative provisions of the Bill of Rights, even the treaty power won’t reach.¹⁰⁹ But that is only where Congress is depriving people of their constitutional rights. It is clear, in *Reid v. Covert*, you can’t deprive people of their constitutional rights.¹¹⁰ But here, there is no constitutional right to make and distribute bootlegs of live musical performances. So by taking that away from people, I don’t think we rise to the level of violating the limits of the treaty power, as articulated in *Reid v. Covert*.¹¹¹

So under the district court decision here, I think it is categorically impossible for the United States to meet its

¹⁰³ *See id.*

¹⁰⁴ *Id.* at 431.

¹⁰⁵ *See id.*

¹⁰⁶ *See id.*

¹⁰⁷ 250 U.S. at 433.

¹⁰⁸ *Reid v. Covert*, 354 U.S. 1 (1957)

¹⁰⁹ *See id.*

¹¹⁰ *See id.*

¹¹¹ *See id.*

obligations under TRIPS.¹¹² Even fixing the duration would not be an issue, would not actually solve the problem, because, as Judge Baer said, fixation itself—by trying to protect unfixed works, we have no possible basis under which we could provide that protection, short of a constitutional amendment.¹¹³

For those reasons, we argued, and I still sincerely believe, that the district court decision was wrong.

PROFESSOR HANSEN: Thank you, Bob.

We now have Marjorie Heins, from the Brennan Center for Justice, Free Expression Policy Project.

MS. HEINS: I am going to go a little beyond the *Martignon* case in order to give some history and background on the First Amendment and free expression issues that are implicated. But I will come back to it at the end.

I am, like David Patton, a relative latecomer to copyright law, although I did, long ago, have the honor of clerking for Judge Ben Kaplan. It was on a state supreme court, so we didn't get many copyright cases. But I did, because I was working for him, take a look at his little masterwork, *An Unhurried View of Copyright*, and I have to admit, not having any background in the subject, I found it, although very witty, somewhat rough sledding.

My first real exposure to copyright was about ten years ago, when I was a First Amendment lawyer at the ACLU. We First Amendment lawyers pretty much viewed copyright as something happening on a separate planet. I think copyright lawyers felt the same thing about the First Amendment. The courts generally reinforced that. When First Amendment issues were raised in copyright cases, courts generally said fair-use and other free-expression safeguards within the copyright statute itself or within copyright common law take care of free-expression concerns, to the extent there is a clash or a tension there between copyright control and users' rights to copy, exchange, or borrow parts of

¹¹² See TRIPS, *supra* note 3.

¹¹³ See *United States v. Martignon*, 346 F. Supp. 2d 413, 423-24 (S.D.N.Y. 2004).

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existing works, for such purposes as education, criticism, news reporting, or parody.¹¹⁴

Well, it is 1994, and a case comes up to the Supreme Court involving a rather raunchy rap music group called 2 Live Crew.¹¹⁵ They did a parody version of the Roy Orbison song, “Oh! Pretty Woman.” I said to my pals at the ACLU, “You know, there seem to be some free-expression issues here. Let’s do an *amicus* brief.” The ACLU sort of scratched its head and said, “Right.” So I had the pleasure of reading a lot of the copyright cases and doing an *amicus* brief¹¹⁶ in *Campbell v. Acuff-Rose*.

I became fascinated enough by fair use that I am still investigating the subject. In fact, the Brennan Center’s just-published report, *Will Fair Use Survive? Free Expression in the Age of Copyright Control*, is basically the report of an investigation that the Center has done over the past year-and-a-half, trying to get a sense of how well fair use is or is not working for artists, writers, and others who contribute to culture and democratic discourse.¹¹⁷

The relevance of the Constitution, and in particular the First Amendment, to copyright issues came to a head in *Eldred v. Ashcroft*¹¹⁸ in 2003, in which the Supreme Court upheld the twenty-year extension of copyright, the Sonny Bono Copyright Term Extension Act.¹¹⁹ But although the statute was upheld, the Court did say that the First Amendment was not entirely irrelevant to copyright law.¹²⁰ The D.C. Circuit had thrown out the challenge to that law, saying that copyright laws are categorically immune from First Amendment challenge.¹²¹ The Supreme Court rejected

¹¹⁴ See, e.g., *Authors League v. Oman*, 790 F.2d 220, 223 (2d Cir. 1986).

¹¹⁵ *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994).

¹¹⁶ Brief for American Civil Liberties Union as Amici Curiae Supporting Petitioners, *Campbell v. Acuff-Rose*, 510 U.S. 569 (1994) (No. 92-1292), 1993 U.S. S. Ct. Brief LEXIS 471.

¹¹⁷ MARJORIE HEINS & TRICIA BECKLES, BRENNAN CENTER FOR JUSTICE, *WILL FAIR USE SURVIVE? FREE EXPRESSION IN THE AGE OF COPYRIGHT CONTROL* (2005), available at <http://www.fepproject.org/policyreports/WillFairUseSurvive.pdf>.

¹¹⁸ 537 U.S. 186 (2003).

¹¹⁹ *Id.* (citing 17 U.S.C. § 304 (2000)).

¹²⁰ *Id.* at 219.

¹²¹ *Eldred v. Reno*, 239 F.3d 372, 376 (D.C. Cir. 2001).

that.¹²² They said that a blanket immunity was too broad and that, in fact, although there are traditional safeguards in copyright law for free expression, such as fair use, and the idea/expression dichotomy, where these traditional contours of copyright law are disrupted by Congress, then it would have to look at the First Amendment implications of the copyright legislation. (The Court didn't make a big point of another noted free-expression safeguard within copyright law, the "limited times" provision, which was meant to ensure that things get into the public domain, because, of course, that was the very problem that was confronting the Court with this term extension.)

Even before the Supreme Court acknowledged the need for First Amendment review of at least some copyright legislation in *Eldred*, a couple of courts had imposed First Amendment scrutiny on a copyright—or at least a copyright-like—statute, the Digital Millennium Copyright Act, or "DMCA."¹²³ The DMCA imposes restrictions both on circumventing digital rights management and protection schemes for digital media, and even on distributing circumvention tools.¹²⁴ In a couple of cases, including *Universal City Studios v. Corley*¹²⁵ in the Second Circuit, which involved the circumvention of a content-scrambling system for DVDs, the court looked at the First Amendment arguments, including the argument that the ban on circumvention unconstitutionally restricts fair use.¹²⁶ For example, it interferes with the ability of scholars to take one frame from a film for purposes of a classroom presentation—a classic example of fair-use. The court applied intermediate First Amendment scrutiny and upheld the Digital Millennium Copyright Act, saying that the right to fair use does not include the right to access and copy material by the easiest or

¹²² *Id.* (citing *San Francisco Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522 (1991)).

¹²³ Digital Millennium Copyright Act, Pub. L. No. 105-304, 112 Stat. 2860 (1998) (codified at 17 U.S.C. § 512 (2000)).

¹²⁴ *Id.*

¹²⁵ 273 F.3d 429 (2d Cir. 2001).

¹²⁶ *Id.* at 436.

most technologically effective method.¹²⁷ But the court did apply First Amendment scrutiny.¹²⁸

So, clearly, there are constitutional limitations on the scope of copyright legislation. I will give you an example from a case that is still pending, which takes off where *Eldred* left off. The case is *Kahle v. Gonzales*¹²⁹ (originally *Kahle v. Ashcroft*,¹³⁰ but of course the attorney general keeps changing, so the titles keep changing). *Kahle* is a challenge to what the plaintiffs call the change over time from an opt-in to an opt-out system of copyright, or from a conditional to an unconditional system, which was accomplished through the elimination of copyright formalities, such as the notice requirement, the registration requirement, the renewal-after-a-certain-period-of-time requirement, the notion being that if you weren't interested in having copyright protection, your work would go immediately into the public domain, and this was a public good.¹³¹ If you were interested in having copyright protection, for example, but after the initial copyright term the work was no longer of commercial value—or maybe the author had died and the heirs weren't interested—they would not renew, and so the work would then go into the public domain.¹³²

So, over a period starting with the 1976 Copyright Act,¹³³ Congress moved from an opt-in to an opt-out system. The 1976 Act abolished the registration requirement, the requirement that the work be deposited in the Library of Congress, and the renewal requirement for works created after the effective date of the Act. Then, the 1988 Berne Convention Implementation Act¹³⁴ eliminated the notice requirement prospectively. Finally, the Renewal Act of 1992¹³⁵ provided, for the first time, an automatic renewal—the copyright owner did not have to do anything; the copyright was automatically renewed for works published between

¹²⁷ *Id.* at 459.

¹²⁸ *Id.* at 449.

¹²⁹ *Kahle v. Ashcroft*, 2004 WL 2663157 (N.D. Cal. 2004).

¹³⁰ *Kahle v. Ashcroft*, No. 04-1127, 2004 WL 2663157 (N.D. Cal. 2004).

¹³¹ *See id.* at *3.

¹³² *See id.*

¹³³ 17 U.S.C. § 101 *et seq.* (2000).

¹³⁴ *See BCIA, supra* note 16, Pub. L. No. 100-568, 102 Stat. 2853 (1988).

¹³⁵ Copyright Amendments Act of 1992, Pub. L. No. 102-307, 106 Stat. 264 (1992).

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1964 and 1977. By the time that statute had been passed, the formalities had been pretty much eliminated, with the result that the facts that the plaintiffs in *Kahle* alleged in the complaint were pretty compelling.¹³⁶

They alleged that, starting in the early days of the copyright system, only 5 percent of published works were registered.¹³⁷ So you had a very free and open public domain. Through most of U.S. history, the renewal rate was only 8–15 percent.¹³⁸

Here, the plaintiffs ran into a little trouble. I think they understood that to challenge the entire change over time from a conditional opt-in system to an unconditional opt-out system, where everything is immediately copyrighted as soon as you scribble it, would probably be a little more than the courts could handle. So they started narrowing the focus of the case, to the works published between 1964 and 1977, when, for the first time, there was an automatic renewal, whether or not the holder of the copyright wanted it.¹³⁹

Even there, even with that narrowing to that thirteen-year period, they allege in the complaint, judging from past history of copyright renewals, that if it hadn't been for this law, approximately 85 percent of those works would have entered the public domain and been available for general distribution, republication, and so forth.¹⁴⁰

That might have been an overstatement. As the legislative history of the Renewal Act suggested, the Copyright Office was concerned about copyrights that fell into the public domain inadvertently. They weren't renewed because of negligence, ignorance, or inadvertence of the owners or the heirs.¹⁴¹

So 85 percent may be a little high, but, still, it is probably a fair inference—and, of course, the case has not been tried, because the

¹³⁶ *Kahle v. Ashcroft*, 2004 WL 2663157 at *4.

¹³⁷ *Id.* at *3.

¹³⁸ Brief of the Brennan Center for Justice et al. as Amici Curiae Supporting Plaintiff-Appellee and Reversal at 8, *Kahle v. Ashcroft*, No. 04-17434 (9th Cir. Jan. 28, 2005) [hereinafter Brennan Center Brief].

¹³⁹ *Kahle*, 2004 WL 2663157, at *5.

¹⁴⁰ Brennan Center Brief, *supra* note 138, at 8.

¹⁴¹ *Kahle*, 2004 WL 2663157, at *14.

district court dismissed it, and it is now up on appeal¹⁴²—it is a fair inference that there would be a lot more works in the public domain from that period of 1964 to 1977, if not for the elimination of the renewal requirement.

In addition, the *Kahle* plaintiffs pointed to the problem of orphan works, which the Copyright Office has now recognized as well.¹⁴³ Because there is no registration requirement and there is no renewal requirement, it is very hard, in many, many cases, to find out who the copyright owner is and to track them down. A lot of work which could be freely copied—and this is documented in the report “Will Fair Use Survive?” as well—it is especially a problem among filmmakers. You have to get permission for everything. If you can’t find the owner, your film may end up on the cutting room floor.

The *Kahle* complaint had three claims under the Copyright Clause—that this change to an unconditional system violated various restrictions within the Copyright Clause of the Constitution.¹⁴⁴ They also had a First Amendment claim, based on the “change in the traditional—contours language” of *Eldred*.¹⁴⁵ All four claims were dismissed by the district court. The court did not analyze the First Amendment claim in great depth, I think it is fair to say. In one or two paragraphs, the court basically said, “These are just procedural changes. They are not substantive, and they certainly don’t amount to change-in-the-traditional-contours of copyright.”¹⁴⁶

I got involved in *Kahle* by writing an *amicus* brief to the Ninth Circuit on the plaintiffs’ appeal of the district court’s dismissal.¹⁴⁷ The brief was filed on behalf of the Brennan Center, the ACLU of Northern California; Public Knowledge; the Center for the Public Domain; and the First Amendment Project, a group in Oakland.¹⁴⁸

¹⁴² *Kahle v. Ashcroft*, No. 04-17434 (9th Cir. 2004).

¹⁴³ *Kahle*, 2004 WL 2663157 at *5.

¹⁴⁴ *Kahle v. Ashcroft*, No. 04-1127, 2004 WL 2663157 (N.D. Cal. 2004).

¹⁴⁵ *Kahle v. Ashcroft*, 2004 WL 2663157 at *16.

¹⁴⁶ *Id.* at *17.

¹⁴⁷ Brennan Center Brief, *supra* note 138.

¹⁴⁸ *See id.*

We basically confined ourselves to the First Amendment arguments in *Kahle*.

First, we acknowledged the government's interests, especially the interest in complying with the Berne Convention and the interest in rescuing people who, because of inadvertence and neglect, did not renew.¹⁴⁹ But we argued that even if you use a First Amendment intermediate scrutiny standard, there still has to be some effort at narrow tailoring by Congress. By switching to an entirely unconditional system and basically freezing out of the public domain thousands and thousands of works that would otherwise be available, Congress had not chosen a very narrowly tailored response to the problem that it perceived.¹⁵⁰

We also thought, why isn't this a First Amendment overbreadth case as well? The statute is substantially overbroad. It is attacking a problem that Congress perceived, but there are a lot of narrower ways of accomplishing the same goal.

So having come up with this substantial overbreadth First Amendment argument in *Kahle*, I was pleased to see that in the *Martignon*¹⁵¹ case, there were two friend-of-the-court briefs supporting the defendant and emphasizing the free expression problems with the anti-bootlegging statute. One was from the Internet Archive and three library associations.¹⁵² The other one was from thirty-one IP and constitutional law professors.¹⁵³

The constitutional law professors' brief argued that the anti-bootlegging statute is substantially overbroad and vague.¹⁵⁴ They pointed to the First Amendment interest in making an unauthorized copy of a public performance.¹⁵⁵ Having a record of such a performance has independent value to both the speaker and those

¹⁴⁹ See *id.* at 19.

¹⁵⁰ See *id.* at 17-18.

¹⁵¹ United States v. Martignon, No. 04-5649-CR (2d Cir. argued July 12, 2005).

¹⁵² Brief of Internet Archive et al. as Amici Curiae Supporting Defendant-Appellee and Affirmance, U.S. v. Martignon, No. 04-5649-cr (2d Cir. May 11, 2005) [hereinafter Brief of Internet Archive].

¹⁵³ Brief of Thirty-One Intellectual Property and Constitutional Law Professors as Amici Curiae Supporting Defendant-Appellee and Affirmance, U.S. v. Martignon, No. 04-5649-cr (2d Cir. May 12, 2005).

¹⁵⁴ See *id.* at 23-29.

¹⁵⁵ See *id.* at 28.

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who would otherwise not hear it. It is this First Amendment value that gives rise to First Amendment interests of both speakers and listeners.

The brief from the Internet Archive and the library associations gave specific examples of these free-expression cultural interests, which are, I think, at the bottom of both the First Amendment and the Copyright Clause. What are the interests in allowing bootlegging to go on? This is from the brief of the Internet Archive and the libraries:

“Few experiences compare to hearing live music. Whether Rachmaninoff played on a Steinway or the Grateful Dead in the midst of a twenty-two-minute improvised jam, every live performance is a unique cultural artifact. Until recently, the inspiration provided by these moments of creativity reached only a limited audience and then was lost forever. The promise of digital technology is that preservation on an unprecedented scale can happen, and digital storage can preserve all of these fleeting moments.”¹⁵⁶

They give further examples: The American Folklife Center illustrates the importance of recording ephemeral performances to the preservation and growth of our culture. The Folklife Center, housed in the Library of Congress, features rare materials from the WPA California Folk Music Project, ranging from Great Depression recordings of blues and gospel songs from folk music festivals around the country. The center recently celebrated its acquisition of the Alan Lomax collection, an unparalleled ethnographic documentation of the legendary folklorist during his field trips to record artists such as Leadbelly, Woodie Guthrie, Jellyroll Morton, and Muddy Waters.¹⁵⁷

“What is at stake for preservationists was recently dramatized in a ten-CD box set released in 1997, *The New York Philharmonic: the Historic Broadcasts, 1923–87*, which sold for \$185.00, consisting solely of live amateur recordings by devoted collectors. The New York Philharmonic did not establish its own archive until 1960. These amateur recordings are all that remain of the live

¹⁵⁶ Brief of Internet Archive, *supra* note 152, at 12–13.

¹⁵⁷ *Id.* at 14.

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performances of some of the century's greatest conductors, including Toscanini, Stravinsky, and Bernstein. These priceless live recordings capture an electricity 'that more pristine studio recordings lack.'"¹⁵⁸ That is a quote from a *New York Times* article. "The Library of Congress recently discovered a 1957 Carnegie Hall concert featuring one of the only recordings ever made of Thelonious Monk performing with John Coltrane, originally recorded by the Voice of America and never aired in the U.S."¹⁵⁹

Finally, one last example from the Internet Archive brief: "When musicologist Paul Jackson contemplated a book detailing the weekly Metropolitan Opera performances broadcast from 1931–50, he discovered that recordings of only 20 percent of the broadcasts still existed, many of which were bootlegs preserved by fans."¹⁶⁰

This, I hope, will give you a sense of the cultural and artistic freedom interests on the defendant's side of the *Martignon* case.

Thank you.

PROFESSOR HANSEN: Thank you.

The final speaker is Jane Ginsburg, from Columbia Law School.

PROFESSOR GINSBURG: The legislation at issue in *Martignon*¹⁶¹ is what other countries of the world call a "neighboring rights" statute.¹⁶² Bob Clarida is correct that our § 1101 is a performer's-rights statute. It is not an author's-right statute; most countries, other than the U.S., distinguish authors (creators of works) from performers (interpreters of works). The

¹⁵⁸ Allan Kozinn, *Critic's Notebook: Bootlegging as a Public Service: No This Isn't a Joke*, N.Y. TIMES, Oct. 8, 1997, at E2.

¹⁵⁹ Brief of Internet Archive, *supra* note 152, at 19.

¹⁶⁰ *Id.*

¹⁶¹ U.S. v. *Martignon*, 364 F. Supp. 2d 413 (S.D.N.Y. 2004).

¹⁶² See, e.g., *Collective management of copyright and related rights: What is protection of related rights?*, http://www.wipo.int/about-ip/en/about_collective_mngt.html#P31_2900 ("'[R]elated rights', also known as 'neighboring rights' . . . are the rights that belong to the performers, the producers of phonograms and broadcasting organizations in relation to their performances, phonograms and broadcasts respectively.')

United States, however, has since the 1976 Act,¹⁶³ if not since the 1972 amendment bringing sound recordings within the scope of federal copyright,¹⁶⁴ put performers whose works are fixed in sound recordings in the same basket as authors. The Copyright law defines a sound recording as the fixation of the sounds of the performance.¹⁶⁵ That means the performer is a co-author of a work of authorship that is fixed.

Although the 1976 Act turns on fixation, the distinction between (1) a recorded performance of a work, (2) the simultaneous fixation of a performance as it is being transmitted—a point that I will return to—and (3) a performance that is not recorded—at least not with authorization—at the time that it is being performed, may not make a lot of sense if we are trying to ascertain the nature of a performer’s authorship. The nature of the creative activity—the interpretative performance of a musical or other work—seems to me to be the same, regardless of whether or not some kind of tangible rendition also results from it. If the originality of the interpretation of the work is what makes a performer a statutory “author”¹⁶⁶ (once the performance has been “fixed”), it is not clear to me why performers would not also be “authors” of unfixed works. What should count for authorship is the level of creativity, not the mechanical task of generating a tangible record of the creation. Congress should, then, have power under the Copyright Clause, to secure exclusive rights for limited times to these authors. That is, assuming that fixation or tangibility is not a constitutional prerequisite, a question to which I will later turn.

The statute *Martignon* challenges implements the United States’ obligation under Article 14 of the TRIPS agreement to protect the rights of performers against the unauthorized fixation,

¹⁶³ General Revision of Copyright Law, Pub. L. No. 94-553, § 101, 90 Stat. 2541 (1976) (codified as amended in scattered sections of 17 U.S.C. §§ 101–1332 (2000)).

¹⁶⁴ Sound recordings first eligible for copyright in 1972. See *Copyright Registration for Sound Recordings*, U.S. COPYRIGHT OFFICE CIRCULAR 56 (Dec. 2004), available at <http://www.copyright.gov/circs/circ56.html>.

¹⁶⁵ See 17 U.S.C. § 101 (2000).

¹⁶⁶ See HR Rep. No. 94-553 (1976) (discussing elements of originality of a sound recording).

distribution, and transmission of their live performances.¹⁶⁷ A similar obligation exists in Article 6 of the WIPO Performances and Phonograms Treaty, which the U.S. has also ratified.¹⁶⁸

What is the source of Congress' authority to enact legislation that would achieve the protections we are obliged to provide? One source would be the Copyright Clause.¹⁶⁹ Another source would be the Commerce Clause.¹⁷⁰ A third source referred to might be the treaty power, since the question arises in an international context.¹⁷¹

The questions I will address are: first, does Congress have power under the Copyright Clause to protect unfixed performances? Second, if Congress does not, does it have the necessary authority under the Commerce Clause and/or treaty power? If it does, do the limitations on Congress' power that are contained in the Copyright Clause—limited times, and—perhaps—tangible rendition—carry over to other sources of congressional power? This is what Bill referred to as the dormant Copyright Clause issue. David also referred to it in his discussion of the *Moghadam*¹⁷² case, with respect to the question whether legislation under some other source of authority would be fundamentally inconsistent with other limitations on Congress' power.

With respect to whether Congress has power under the Copyright Clause to protect unfixed performances, one would first inquire whether these performances are the “writings” of an “author”? For the reasons given above, the argument can be made that a performer is an author: if a performer's interpretation makes her a co-author of a sound recording, I think the same interpretation would make her an author even absent the fixation.

But that argument addresses only the “Authors” element of the Copyright Clause. We must also consider the “Writings” component. Does the Constitution, in giving Congress power to

¹⁶⁷ TRIPS, *supra* note 3.

¹⁶⁸ World Intellectual Property Organization Performances and Phonograms Treaty, Apr. 12, 1997, S. Treaty Doc. No. 105-17 (1997) [hereinafter WPPT].

¹⁶⁹ U.S. CONST. art. I, § 8, cl. 8.

¹⁷⁰ U.S. CONST. art. I, § 8, cl. 3.

¹⁷¹ U.S. CONST. art. II, §2.

¹⁷² 175 F.3d 1269 (11th Cir. 1999). *See also* Patton, *supra* note 51.

protect the “Writings” of “Authors”—require that the work have previously assumed tangible form? Even if “Writings” presupposes tangibility, does that tangible form have to have been achieved with the author’s permission?

David referred to the *Burrow-Giles*¹⁷³ case, which describes the writings of authors as all works “through which the ideas in the mind of the author are given visible expression.”¹⁷⁴ Does that imply that Congress has power to protect only works that are given *visible* expression, and that invisible—i.e. auditory—expressions therefore are excluded? Such an interpretation inappropriately reads a negative inference into a statement that the Court, in context, had pronounced to make clear that the Constitution gives Congress very *broad* authority. At issue in *Burrow-Giles* was whether or not Congress had power to include photographs within the subject matter of copyright. Defendant had claimed that their mechanical qualities placed photographs beyond the zone of “writings” of “authors.” The court embraced “visual expression”—of which photographs were obviously an example—in the course of rejecting that argument. Tangibility was not an issue in *Burrow-Giles*. But one might infer from the Court’s ecumenical concept of creativity that, had the question of tangibility been posed, the Court would not have denied Congress’ power to protect unfixed creations on the ground that they lacked authorship.

To my knowledge, no decision before *Martignon* held that a “Writing” in the constitutional sense must be tangible. Rather, it has just been assumed that a writing must be tangible.¹⁷⁵

¹⁷³ *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884). See also Patton, *supra* note 51.

¹⁷⁴ *Id.*

¹⁷⁵ See, e.g., *Martignon*, at n.11 (“The Moghadam Court ‘assume[s] arguendo, without deciding, that [the fact that live musical performances are not in a fixed, tangible and durable form] would preclude the use of the Copyright Clause as a source of Congressional power for the anti-bootlegging statute.’” (quoting *U.S. v. Moghadam*, 175 F.3d 1269, 1274 (11th Cir. 1999))). Compare U.S. CONST. art. I, § 8, cl. 8 (protecting “Authors . . . exclusive right to their . . . Writings”) with 17 U.S.C. § 102(a) (2000) (protecting “original works of authorship fixed in any tangible medium of expression”).

If, however, the Constitution did require that a work have been fixed before it could be deemed a “Writing,” then one feature of the current Copyright Act would be problematic. The 1976 Copyright Act’s definition of fixation includes works that are being transmitted and simultaneously fixed with the transmission.¹⁷⁶ The legislative history gives the example of a sports broadcast.¹⁷⁷ A football game is being broadcast live. The filming of the football game meets the creativity criterion of an original work of authorship because of the director’s creative choice of camera angles and such, but the broadcast is live, so the audiovisual work is not fixed. Congress, perceiving that live broadcasts could be vulnerable to unauthorized exploitations, modified the fixation concept to allow for fixation simultaneous with transmission (the broadcaster is recording the filming of the game at the same time as it is broadcasting it). Because of its simultaneous fixation, the live broadcast thus comes within the scope of the federal power.¹⁷⁸ This is a bit of sleight of hand, because anyone recording that transmission off the television is recording the live feed before the fixed version comes into being, so Congress is in fact extending copyright to cover works before they are made tangible. But if the Constitution conditions the federal copyright power on a work’s preexisting tangibility, then the simultaneous fixation rule, by covering works in pre-tangible form, would be vulnerable.

I am not sure, however, that the Constitution in fact requires tangibility. The Framers may have assumed the tangible character of a copyrighted work, but a lot of things were assumed, given the state of technology and commercial practices in 1787.¹⁷⁹ That

¹⁷⁶ 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.”).

¹⁷⁷ H.R. REP. NO. 94-1476, 52 (1976), as reprinted in 1976 U.S.C.C.A.N 5659, 5665.

¹⁷⁸ 17 U.S.C. § 102 (2000).

¹⁷⁹ Commentators have asserted that “writings” must imply permanence, lest the term be meaningless, see, e.g., 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 1.08[C][2], at 1-66.30 (Matthew Bender 2005) (1963), but we should be wary of attributing to the Framers an intent to set the subject matter of copyright into the mold of the technology and commercial practices they would have found familiar. The *Moghadam* court’s quotation of Learned Hand on this point is worth reiterating here: “Rejecting the notion that the Constitution ‘embalms inflexibly the habits of 1789,’ Judge

does not mean that what was assumed was also required. It is important to distinguish what is constitutionally permissible from what is constitutionally mandated. One might draw a parallel with the argument made in *Kahle v. Ashcroft* that the progressive diminution in statutory formalities starting with the 1976 Act renders the current copyright law subject to first amendment challenge.¹⁸⁰ Yes, we have had formalities from the start. Does that mean that they were constitutionally mandated, as opposed to constitutionally permissible? The Northern District of California declined to assign a constitutional dimension to formalities. By the same token, one might recognize that tangibility has been with us from the beginning, but that doesn't mean that it is mandated.

Can the concept of a "Writing" include incipient fixations, such as simultaneous fixations with transmissions? Can it include other works which are in the process of becoming fixed? Can the United States constitutionally adopt a solution such as that applied in the U.K. 1988 Copyright Act,¹⁸¹ which requires fixation, but includes within the concept of fixation a work that is being fixed without authorization?¹⁸² The work must be rendered tangible, but the rendering may occur without the author's permission. Once the work is rendered tangible, whether or not with authorization, it comes within the scope of the U.K. Copyright Act (and the unauthorized fixation violates the reproduction right).¹⁸³ Section 1101 in effect adopts the U.K. approach, at least with respect to the creation of copies. Thus, even if the Constitution required fixation, § 1101 would still be constitutionally permissible, so long as the Constitution did not also require that the fixation occur with permission. This approach does not, however, save all of § 1101, because that text not only gives the performer the right to fix the

Learned Hand wrote that the Copyright Clause's 'grants of power to Congress comprise not only what was then known, but what the ingenuity of men should devise thereafter. Of course, the new subject matter must have some relation to the grant, but we interpret by the general practice of civilized people in similar fields, for it is not a strait-jacket but a charter for a living people.' *Reiss v. National Quotation Bureau*, 276 F. 717, 719 (S.D.N.Y.1921)." *Moghadam*, 175 F.3d at 1274 n.8.

¹⁸⁰ *Kahle v. Ashcroft*, 2004 U.S. Dist. LEXIS 24090, 72 U.S.P.Q.2d (BNA) 1888 (N.D. Cal. 2004).

¹⁸¹ Copyrights, Designs and Patents Act of 1988, ch. 48, § 164 (U.K.).

¹⁸² *See id.*

¹⁸³ *Id.*

work, but also to transmit the work as unfixed.¹⁸⁴ The constitutional text may pose an additional impediment: the clause permits Congress to secure exclusive rights to authors “to *their* . . . Writings . . .” (emphasis supplied). The Constitution thus designates the creative person as the subject of copyright.¹⁸⁵ If “Writings” means that the work must at least be in the process of assuming physical form, does it also imply that the creator must personally be fixing the work or authorizing its fixation? If so, then the Constitution would foreclose the U.K. approach. If, on the other hand, prior fixation were not a constitutional prerequisite, then recourse to the U.K. approach would not be necessary.

For purposes of this discussion, however, let us assume that “Writings” does mean preexisting, or at least simultaneous, tangibility. In that case, the performances that are covered by § 1101 might indeed fall outside the scope of the Copyright Act. In that event, does Congress lack power to grant performers’ fixation and transmission rights? I think it is fairly clear, as has been indicated by most of the speakers, that this legislation concerns interstate and international commerce; Congress thus would have power under the Commerce Clause. But we then confront the question whether the limitations that are contained within the Copyright Clause constrain Congress’ power under other sources of authority.

*Martignon*¹⁸⁶ is not the first copyright case to raise the problem of inter-clausal conflict. The issue came to the fore after *Feist*,¹⁸⁷ when the Supreme Court stated that sweat-of-the-brow compilations lack originality, and thus are not writings of authors. They therefore do not come within Congress’ power to protect under the Copyright Clause.¹⁸⁸ (The Court’s frequent iteration of the constitutional character of originality was, arguably, dicta, because the Court also held that the statute did not purport to cover

¹⁸⁴ 17 U.S.C. § 1101 (2000).

¹⁸⁵ *But see* 17 U.S.C. § 201(b) (works made for hire).

¹⁸⁶ *United States v. Martignon*, 346 F. Supp. 2d 413 (S.D.N.Y. 2004).

¹⁸⁷ *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991).

¹⁸⁸ U.S. CONST. art. I, § 8, cl. 8.

unoriginal compilations; Congress' power to protect such collections thus was not in fact at issue.)¹⁸⁹

Feist left open the question whether, notwithstanding the lack of Copyright Clause authority, these valuable collections of information could be protected under the Commerce Clause.¹⁹⁰ That spawned a fair amount of academic writing, inspired by *Railway Labor v. Gibbons*¹⁹¹ (a case Bob Clarida earlier discussed),¹⁹² speculating whether the originality limitation in the Copyright Act would carry over to the Commerce Clause.¹⁹³ The two constraints at issue in *Martignon* are fixation (“Writings”) and duration (“limited Times”).¹⁹⁴ If the live performance is not a writing, does that foreclose Congress from affording protection under another source of constitutional authority? Even if Congress can protect non-writings, does the limited-times constraint prohibit Congress from making that protection perpetual?

There are two reasons the “Writings” term should not preclude federal legislation. One concerns subject matter, the other the scope of rights protected. The first relates to the Supreme Court’s 19th-century decision in the *Trademark Cases*.¹⁹⁵ One of the first federal trademarks acts had declared itself to be legislation under the Patent and Copyright Clause.¹⁹⁶ The Supreme Court held that a trademark is neither a writing nor an invention; Congress therefore lacked power under that source of authority to enact a trademarks act. But the Court also indicated that the Commerce Clause could supply the requisite authority.¹⁹⁷ Congress subsequently legislated under the aegis of the Commerce Clause. I doubt anyone today would seriously dispute Congress’ power to

¹⁸⁹ *Feist*, 499 U.S. at 352–56.

¹⁹⁰ U.S. CONST. art. I, § 8, cl. 3.

¹⁹¹ 455 U.S. 457 (1982).

¹⁹² See *supra* note 69 and accompanying text (Robert Clarida presentation).

¹⁹³ See, e.g., Thomas Nachbar, *Intellectual Property and Constitutional Norms*, 104 COLUM. L. REV. 272 (2004); Paul Heald & Suzanna Sherry, *Implied Constraints on Congressional Power: Construing the Intellectual Property Clause*, 2000 U. ILL. L. REV. 1119 (2000); Jane C. Ginsburg, *No Sweat? Copyright and Other Protection for Works of Information after Feist v. Rural Telephone*, 92 COLUM. L. REV. 338 (1992).

¹⁹⁴ See U.S. CONST. art. I, § 8, cl. 8.

¹⁹⁵ 100 U.S. 82 (1879).

¹⁹⁶ Trademark Legislation of Congress Act, U.S. Rev. Stat., ch. 2, tit. 60, §§ 4937–4947.

¹⁹⁷ U.S. CONST. art. I, § 8, cl. 3.

enact trademark laws. As a result, the exclusion of the disputed subject matter from the constitutional ambit of copyright does not, standing alone, mean that the subject matter is inapt for protection on some other constitutional basis.

The inquiry should instead focus on the policies underlying the exclusion from copyright of the disputed subject matter. Do the limitations in the Copyright Clause embody fundamental policies that should limit Congress' ability to act under some other clause? In other words, can Congress evade a substantive limitation of its power that is imposed under the Copyright Clause simply by saying—if I can use Bill's prop—"I now take off the Copyright Clause hat and put on the Commerce Clause hat, and I am free of all constraints that came with the former fashion item?"

The two limitations warrant different analyses. I have difficulty perceiving a fundamental public policy in the "Writing" limitation, if indeed it is a limitation at all. The usual reason for having a tangibility or fixation requirement is proof. It is easier for the author to establish her creativity if the work has previously been fixed. That is a matter of judicial economy and litigation convenience; it is not at all apparent that those interests rise to the level of fundamental policy.¹⁹⁸ By contrast, limited-times is a fundamental policy and should not be so easily evaded. The Constitution forbids the vesting of perpetual property rights in Writings and Discoveries. The key here is the nature of the protection that Congress is affording. Perpetuity per se does not necessarily offend the Constitution; rather, it is necessary to examine the rights that Congress is making perpetual. In the case of § 1101, Congress is providing copyright-like protection—the

¹⁹⁸ One might contend that prior fixation promotes free speech because a member of the public who encounters a work in unfixated form need not fear assertion of another's proprietary rights should she incorporate the overheard musical work into her own composition. Cf. Jessica Litman, *The Public Domain*, 39 EMORY L.J. 965 (1990) (facts and ideas are excluded from the scope of copyright protection because it would be unrealistic to hold the public accountable for elements it so commonly absorbs). The contention proves too much, however, because it would make fixation a prerequisite not only to initial protection, but to infringement. The statute does not require that the alleged infringer have encountered the work in tangible form; once the work has been fixed, it is protected in all its guises, including via a live performance. Indeed, the fixed version need not even be publicly accessible.

rights to make and distribute copies, and to transmit are all exclusive rights (i.e., property rights) afforded copyrighted works under § 106 of the Copyright Act.¹⁹⁹ Section 1101 thus looks like a simple change of haberdashery; the head (the exclusive rights) being the covered remains the same. The claim that Copyright Clause limitations should carry over to Commerce Clause enactments thus is persuasive.

One might object that trademark protection is potentially perpetual, yet the Supreme Court has implicitly blessed resort to the Commerce Clause in that instance. But while trademark registrations are infinitely renewable, the nature and scope of trademark protection are quite different from copyright protection. Trademark protection is not a right in gross. It is not a general right to prevent the copying of the distinctive sign or design. It is a right vested in the trademark owner to preserve truth in the marketplace by prohibiting those uses of the mark that are likely to confuse the consumer,²⁰⁰ or that constitute false representations of the origin or qualities of the goods or services in question.²⁰¹ The trademark owner serves as a proxy for the broader public interest.²⁰² Viewed in that light, a federal trademark registration's indefinite renewability should not be problematic. Where, by contrast, the nature of the right is, to use the *Moghadam*²⁰³ court's terminology, a copyright-like right, mere resort to the Commerce Clause, or, for that matter to the treaty power,²⁰⁴ should not suffice.²⁰⁵

¹⁹⁹ 17 U.S.C. § 106 (2000).

²⁰⁰ See Lanham Act, § 32.

²⁰¹ *Id.* § 43(a).

²⁰² The Federal Anti Dilution Act, Lanham Act § 43(c), does provide protection for famous marks even in the absence of consumer confusion, and thus more closely resembles an exclusive right than does traditional trademarks protection. For an argument why § 43(c) nonetheless is not constitutionally vulnerable, see Brian Jacobs, Note, *Trademark Dilution on the Constitutional Edge*, 104 COLUMBIA L. REV. 161 (2004). In addition, courts have interpreted § 43(c) restrictively. See Clarisa Long, *Dilution*, 106 COLUM. L. REV. 1029 (2006).

²⁰³ *United States v. Moghadam*, 175 F.3d 1269 (11th Cir. 1999).

²⁰⁴ U.S. CONST. art. II, § 2.

²⁰⁵ *But see* *Kiss Catalog v Passport Int'l. Prods.*, 2005 U.S. Dist. LEXIS 37671 (C.D. Cal. 2005) (upholding § 1101 against constitutional challenge on the ground that if the statute's subject matter falls outside copyright clause, then none of the clause's limitations apply).

Consider another example: let's suppose an international anti-hate speech treaty has been promulgated (this is certainly conceivable, since many other countries seem to have a much lower tolerance for hate speech than we do). Suppose the U.S. ratified such a treaty, and that Congress, invoking its power to enact legislation necessary and proper to implement agreements concluded under the treaty power,²⁰⁶ passed a variety of restrictions on the expression of hate speech. That legislation should pose a serious First Amendment problem,²⁰⁷ notwithstanding that the treaty power is an additional source of congressional authority. The treaty power would not exempt Congress from the injunction that it shall "make no law" abridging freedom of speech. One has to look at the question of whether there is a fundamental conflict in basic policy.

So my bottom line is not so different from Bill's.²⁰⁸ I think that Congress has power to enact a performers' rights statute, but the term must be limited. TRIPS requires a minimum of fifty years of protection from fixation.²⁰⁹ Similarly, the minimum term of protection set out in the WIPO Performances and Phonograms Treaty is fifty years.²¹⁰ We could provide a longer term, for example, ninety-five years from the performance, but fifty seems ample.

The term of protection also makes me think about the historical benefits or cultural benefits of bootleg recordings. I am delighted to learn from Marjorie Heins that I have a First Amendment interest in obtaining a copy of a performance that I wouldn't otherwise hear, and therefore that I needn't worry about affording an expensive subscription to the Metropolitan Opera.²¹¹ But I assume that that is not really what the First Amendment argument seeks to prove.

²⁰⁶ See U.S. CONST. art. II, § 2, cl. 2.

²⁰⁷ See U.S. CONST. amend. I.

²⁰⁸ See *supra* notes 1–50 and accompanying text (William Patry presentation).

²⁰⁹ TRIPS, *supra* note 3, at Part II, § 1, art. 12.

²¹⁰ WIPO Performances and Phonograms Treaty, ch. IV, art. 17, Dec. 20, 1996, S. TREATY DOC. NO. 105-17 (1997); 36 I.L.M. 76 (1997).

²¹¹ See *supra* notes 114–160 and accompanying text (Marjorie Heins presentation).

Many of the examples Marjorie gave concerned performances that were recorded with permission. The unauthorized recordings were by and large, very old. Perhaps, if Congress redrafts § 1101 to impose a time limit on the performer's right, it might consider some kind of exception for historic recordings. But any exception would still have to meet our treaty obligations. For example, limiting the violation to the distribution or other communication of the performance, for a period of fifty years following the performance might sound attractive, for it would thus be possible for anyone to create and retain historical copies, for example for an archive. Whether or not the performer created the archive, there would be a recording of performance that could be made public fifty years later. But this scheme is not consistent with TRIPs art. 14, because the act of fixation would not be actionable without further communication of the fixed performance. TRIPs and the WPPT require that "performers shall have the possibility of preventing . . . the [unauthorized] fixation of their unfixed performance and the reproduction of such fixation."²¹² This right is independent of the communication right. According to the WPPT, any exceptions to the performer's fixation right must be consistent with the "three step test," which limits exceptions to "certain special cases, which do not conflict with the normal exploitation of the work, and do not reasonably prejudice the legitimate interests of the rights holder."²¹³ The suggested revision of § 1101 is in tension with the first step, as the exception to the fixation right would not be confined to certain special cases, but would be across the board of performances. Moreover, such an exception would also fall afoul of the second and third steps: even if the members of the public who fix the performances do not further distribute or communicate them, they will nonetheless have captured for themselves the economic and enjoyment value of an authorized fixation.

Equally importantly, defining the *performer's* fixation right to allow anyone present to fix a performance on the theory that fifty years later the fixation might have historical value is a bad idea independently of its inconsistency with our treaty obligations. The

²¹² See also WIPO Performers and Phonograms Treaty, art. 6(ii).

²¹³ *Id.* at art. 16(2).

archival exceptions contained in the copyright act are narrowly drawn; they do not allow or encourage members of the public to appoint themselves “archivists” and thus enjoy certain copying privileges.²¹⁴ Most significantly, in addition to the economic values the fixation right protects, there are moral and artistic considerations of which we should not lose sight. Not every performer may wish to have every performance preserved for posterity.²¹⁵ The ephemeral quality of a live performance may promote a spontaneity and experimentation that could be discouraged if the artist knew or feared that anyone could create a record of the performance.

If, however, Congress does not have power to protect unfixed performances, because they (1) are not writings and because (2) the writings condition limited Congress’ power under other constitutional founts of authority, then Congress cannot cure the problems with § 1101 by specifying a limited term for the performers’ rights. No matter how short the term under § 1101, Congress would not have power, period. That outcome is neither desirable nor, for that matter, correct.

PROFESSOR HANSEN: I know Bill Patry wants to respond to things. I know other panelists want to respond to each other. But our audience has been sitting very patiently, so I would like to start out with questions or comments from the audience. Then we will be sure to give everyone on the panel a chance to make whatever comments they want.

Could you state your name and affiliation?

QUESTION: My name is Richard Field, no affiliation.

I guess this is one of Jane’s points. Technology changes lots of things. It is hard, in a lot of areas, to know what the original intent of the framers was because of technology changes. But I would think that in this area, of all areas, it is not hard. Sure, they didn’t

²¹⁴ See, e.g., 17 U.S.C. § 108(a) (setting out characteristics of and requirements for libraries and archives to engage in certain acts of reproduction and distribution); 17 U.S.C. § 112 (licensed transmitting organizations’ ephemeral recordings for archival purposes).

²¹⁵ Interview with Barbara Haws, Archivist/Historian, New York Philharmonic (on file with author).

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have TV, but at the time of the Constitution being written and for hundreds of years before, people got up and made speeches constantly. They were orators. Everybody was an orator. Did they approve of somebody then making the same speech the next day or did they disapprove of it? That goes to both the First Amendment, freedom of speech, and to copyright.

You would think that over the centuries there was some view on that, and it is really no different from the view now, so that that, in some way, is enshrined—it may have been common wisdom at the time, but it is enshrined in what ends up being written in terms of both the First Amendment and copyright in the Constitution.

Is there nothing, over all the centuries, about that simple issue?

MR. PATTON: There are cases on this. It comes up in theater a lot. Playwrights didn't want to set things down for fear of it getting out. There are nineteenth-century cases in which an audience member would either memorize or write down lines and then go perform it somewhere else. There were common-law copyright solutions to that.²¹⁶

PROFESSOR GINSBURG: The issue wouldn't have come up, because, up until 1976, the dividing line was publication.²¹⁷ So whether the work was tangible and not published or not tangible and not published was all the domain of state law. That is a reason that the issue simply wouldn't have been presented before the federal courts.

PROFESSOR HANSEN: Someone else?

QUESTION: My name is Travis Uhlenhopp. I am a third-year student from Pepperdine.

I want to start by thanking Mr. Patry for providing the basis of the National Entertainment Moot Court Competition that we hosted. His statute was one of the main issues. That is why I am here today.

MR. PATRY: I love to amuse.

²¹⁶ See, e.g., *Thomkins v. Halleac*, 133 Mass. 32 (1882); *Keene v. Kimball*, 82 Mass. 545 (1860).

²¹⁷ See The Copyright Act of 1909 § 10, reprinted in 8 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT app. 6 (Matthew Bender 2005) (1963).

QUESTIONER: I think Ms. Ginsburg brought this up, but how do you respond to the disjunctive nature of the statute as it affects—apparently, the smoke has cleared, and it has been under the Commerce Clause that it was enacted. How is it that simply fixing or recording something itself, without distribution, without selling it, affects interstate commerce?

That was one of the main arguments against the Commerce Clause.

MR. PATRY: How does renting a motel room in Alabama affect interstate commerce? You think it either reaches those things or it doesn't, and the Supreme Court thought it did.²¹⁸ We were concerned with tours that go across the country. You certainly could find somebody who exists in a bar in—well, I won't name a place, because someone will be offended—some area, where that is the only bar they have ever sung in and they are lucky to sing there. You would say, if someone in the audience fixes that, how is that going to affect interstate commerce? I don't think that is how it works. I think it works on a much more gross level. Certainly, this sort of protection covers activity which, on the whole—and perhaps almost entirely on the whole—isn't interstate commerce.

Maybe performers would like to be treated like baseball stars and have an antitrust exemption. But I think that is an anomaly, too.

QUESTIONER: So was it intentional to make just fixing it illegal, as well?

MR. PATRY: The one thing I did try to do was to make sure it wasn't illegal to buy them, because I like to go down to the Village and buy them. So I did take care of myself.

The issue did come up once before, in 1984, when the first of the real *sui generis* provisions came into the statute, which is the Semiconductor Chip Act.²¹⁹ There was a concern not about commerce, but a concern about them being writings. Perhaps they were just merely mechanical things, and perhaps they weren't

²¹⁸ W. Coast Hotel v. Parrish, 300 U.S. 379 (1937).

²¹⁹ Semiconductor Chip Protection Act of 1984, 17 U.S.C. §§ 901–912 (2000).

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original. Perhaps they were part of a process. So Congress did sort of a belt-and-suspenders thing there. If you look at the infringement part of that statute, you will see that it is only an infringement of the statute if you distribute your thing in commerce.²²⁰

So Congress has, in the past, evidenced some discomfort on the issue. Whether we should have expressed discomfort this time I don't know, but I don't think so.

One quick point I want to make is the issue of whether the Supreme Court or anyone else has ever dealt with the issue of tangibility. What we relied upon, which I think is still correct, is the statement in the Supreme Court's *Goldstein*, opinion, that writings may be interpreted to include any physical—*physical*—rendering of the fruits of creative intellectual or artistic labor.²²¹ I take Jane's point about *Burrow-Giles*.²²² I think that is absolutely right. But I interpret "physical" there to mean "physical." You have to have a tangible thing.

PROFESSOR GINSBURG: But those were pirate disks, not bootleg disks.

MR. PATRY: Sure, but they were talking about what a writing is.

PROFESSOR GINSBURG: I know, but, again, the issue . . .

PROFESSOR HANSEN: It was dicta. There was tangibility in that case, so it is dicta.

MR. PATRY: You say "tomayto," I say "tomawto."

PROFESSOR HANSEN: Basically, what Chief Justice Berger said in other things hasn't held up well today, so I am not sure how much that is going to be . . .

MR. PATRY: If he's so smart, why isn't he alive, I guess.

PROFESSOR HANSEN: On the Commerce Clause question, I think the issue is basically, does the Court think Congress has a

²²⁰ 17 U.S.C. § 910(a) (2000) ("[A]ny person who violates any of the exclusive rights of the owner of a mask work under this chapter, by conduct in or affecting commerce, shall be liable as an infringer of such rights.").

²²¹ *Goldstein v. Cal.*, 412 U.S. 546 (1993).

²²² *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884).

role to do this or not? It has different views about this. You had Chief Justice Marshall, *McCulloch v. Maryland*,²²³ who had a broad view of the role of Congress, adopt an approach to the necessary and proper clause that was very broad. Then you had the Supreme Court in the 1890s to about 1928, 1930, drop any use of the necessary and proper clause and take a relatively narrow view of the scope of congressional power under the Commerce Clause—leaving it is up to the states to address many problems.

The real issue has been the respective legislative roles of Congress and the states, with the Court in some periods looking out to protect state autonomy and others actually encouraging Congress to address many social and economic issues. Recently, there have been a few 5–4 decisions where the majority reserved some minor areas for state control but not radically the broad view of congressional power that has predominated in the twentieth century. I don't think anyone thinks that this bootleg legislation is an intrusion upon state autonomy. So I don't think that traditional policy issue is in play here.

The one case everyone points to where you don't have a state autonomy issue and where the Court found a congressional statute unconstitutional for lack of power is the *Railway Labor* case, which involved the constitutional provision giving Congress bankruptcy power.²²⁴ The congressional statute involved was, in effect, a private law to help a union and its employees and overturned a bankruptcy decision dissolving the railroad. The district court enjoined the application of the Act because it amounted to an unlawful taking, the Seventh Circuit affirmed and Justice Stevens, in refusing to grant a stay, agreed that it would probably be considered an unlawful taking by the full Court. Congress sought to avoid the takings issue by amending the law to make clear that the railroad could pursue damages against the government. The trial court again enjoined the implication of the Act and the Seventh Circuit affirmed on the basis that the Act constituted an uncompensated taking. The Supreme Court avoided a problematic takings issue, that could have broad implications in

²²³ 17 U.S. 316 (1819).

²²⁴ *Railway Labor Executives' Ass'n v. Gibbons*, 448 U.S. 1301 (1980); *Railway Labor Executives' Ass'n v. Gibbons*, 455 U.S. 457 (1982).

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recognizing damages for congressional enactments. Instead, it took the easy way out by using the Bankruptcy Clause which would have no effect on Congress other than to stop private laws overturning bankruptcy decisions.

Moreover, there is another difference between *Railway Labor* and this case. In the former, Congress retained its full power to deal with bankruptcies. It was only prohibited from private relief for one party. Under Judge Baer's decision, Congress would be deprived of all power to deal with bootlegging, leaving the states alone to deal with it. And the states are not equipped to deal with it effectively, and no one argues that they are.

In short, I think *Railway Labor*, despite some broad language from Justice Rehnquist, is in reality *sui generis* and won't have much effect in binding the court in the future on Commerce Clause power.

Therefore, I think Jane on the tangibility issue is absolutely right. If you take *Burrow-Giles*, they said, "The framers didn't think about photographers. Therefore, they didn't include it."²²⁵ You just apply that. The framers didn't think that you could be bootlegging. There wasn't the technology or anything else. Certainly they would have been allowing that now. If you can have a photographer considered to be an author, it is much less of a stretch to say that a writing doesn't have to be tangible. Especially, since the framers could have chosen "creators" and instead chose "authors." On its face, this excluded painters, sculptors and other creators. So there was a textual and historical argument to exclude photographers."²²⁶

So I think the Court will not find "writings" an obstacle to the lack of tangibility of performances that are bootlegged.

But I have one question on your constitutional attack on the length of protection of the bootlegging statute. How does your client have standing under Article III to raise it?²²⁷ Even if you have a constitutional wrong, you still need to show causation—that he has been harmed by that provision. But he was prosecuted only

²²⁵ *Burrow-Giles*, 111 U.S. 53.

²²⁶ *Id.*

²²⁷ U.S. CONST. art. III.

a few years after the passage of the Act. Thus, the unconstitutional length of life plus seventy, or even life plus fifty, would not have caused his harm, i.e., prosecution. So the constitutional wrong of too long a term hasn't caused any harm to him. So he would not have standing to raise the too long a term argument, although he could raise the tangibility issue.

So where does he get standing to raise this?

MR. PATTON: It was a facial challenge. There is nothing in the record to suggest whether this stuff is older than fifty years or not.

PROFESSOR HANSEN: So you can just get past Article III standing by a facial challenge?

QUESTION: Does Article III standing apply to a criminal defense matter?

PROFESSOR HANSEN: Actually, in criminal defense, they even have tougher standing laws. You have a third-party standing rule. I violate, purposely, going into your house without a warrant, on the Fourth Amendment. You have five other people in there. You are the only one who can raise that standing issue. The other four people cannot raise the unconstitutional search issue because they had no privacy interest in that house. In criminal cases, ironically, the standing rules are stricter.

QUESTION: Is that Article III?

PROFESSOR HANSEN: No, it's not an Article III requirement. The people in the house had Article III standing, because there was a constitutional wrong—the illegal search, it caused them harm—the prosecution. But the Supreme Court has consistently said that “On a policy basis, for prudential reasons, we are not going to let so-called third parties raise the constitutional challenges.”

Anyone else on a different issue?

PROFESSOR GINSBURG: May I just provide an additional answer to your question? TRIPS Article 14 requires member states

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to protect against the fixation of their unfixed performances and the reproduction of such fixation.²²⁸

QUESTION: I know you have addressed this tangibility issue in quite detail, so I will just ask—

PROFESSOR HANSEN: Name and affiliation.

QUESTIONER: Mark Jaffe, third-year student, *Fordham Intellectual Property Law Journal*, and research assistant for Professor Hansen.

I won't ask you to go over it again. But I am curious as to why those whose interest it is to support this congressional legislation or defending it have been so quick to dismiss the argument that it is proper; why the tangibility issue has been assumed and not argued.

MR. PATRY: I don't think it is true that it has been assumed. We thought about it a lot. After deep thought and research, we came to the conclusion that fixation is a constitutional requirement. We didn't assume anything.

I understand that there are people who disagree, but it is not accurate to say that we assumed anything. We did take seriously how we could do it.

I don't defend the term, which I think is indefensible. But I think that is a separate issue. I understand that that has a big impact.

But for your question, we did think a lot about that, and we did talk to a lot of people about it as well. If you go back through some of the legislative history of the 1976 act,²²⁹ you will find statements by Register of Copyrights Abraham Kaminstein that writings require fixation, in exactly those terms.²³⁰ Maybe you could say that was assumed because he just said it and he didn't cite to anything. Well, what are you going to cite to? I will cite to the Supreme Court's *Goldstein* opinion.²³¹ You can cite to a common-sense interpretation of what "writings" means. Maybe

²²⁸ TRIPS, *supra* note 3, at Part II, § 1, art. 14.

²²⁹ See, e.g., H.R. REP. NO. 94-1476, 52 (1976), as reprinted in 1976 U.S.C.C.A.N 5659.

²³⁰ Testified before the House Judiciary May 1975-76 CIS H 4213.

²³¹ *Goldstein v. California*, 412 U.S. 546 (1973).

that is my common sense. Certainly, I think in the *Burrow-Giles* case there is a question about whether writings in common sense means just literary works.²³² I don't purport to put forth that my interpretation of something is the only one.

I do purport to say, however, that it was an issue we took seriously and I believe we came to the right conclusion.

PROFESSOR GINSBURG: What do you think about simultaneous fixation?

MR. PATRY: I think it is fine, with this caveat. I don't see a requirement of preexisting fixation. I see a requirement of fixation. So if you are simultaneously taping something while it is being transmitted, I think you have a protectable work.

The only issue I have with that is—and this would occur at a jazz club or a club where someone is improvising, where it is not being simultaneously transmitted.

PROFESSOR GINSBURG: It's being simultaneously fixed, but not transmitted.

MR. PATRY: Yes, right. That's the one where I would say, no, there is no violation of the Copyright Act there. I am confessing to being, maybe, incredibly inconsistent. I try to be honest, even being inconsistent.

PROFESSOR HANSEN: You would be copying a live work.

MR. PATRY: Right, you would be copying, I think, a live work.

PROFESSOR HANSEN: Congress' broadcasting is a legal fiction, which, if you are serious about writings being tangible, should be struck down. But that's all it is, a legal fiction. There was a problem, so created the legal fiction that the live work is actually fixed when it is not.

MR. PATRY: No, no, I wouldn't agree. I think the question would be one of liability for somebody, not for an exercise in Congress' power to do it. If Congress says, "You can protect your live broadcast of a football game, so long as you simultaneously tape it," I don't see what's wrong with that. I don't think you need

²³² *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884).

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to have taped it beforehand. If I am writing a chapter in a book and I write down the first chapter, that chapter is protected. I don't have to write down the whole thing.

PROFESSOR HANSEN: But the infringer is not copying a fixed work.

MR. PATRY: Right, which is why the jazz club, for me, is the easier answer. Maybe I am begging the one that you are asking me, which is, doesn't that logic apply to simultaneous transmission?

PROFESSOR HANSEN: Whatever it is, we have to move on. Brian?

QUESTION: Brian Danitz, Fordham University.

PROFESSOR HANSEN: Brian is the man who put this all together. Congratulations, again.

[Applause]

QUESTIONER: You won't be clapping after this question. In terms of the limited-times on distribution, live performances are inherently limited. I can't get my mind around this. The recording, the copy, is done by somebody else. It is a separate work. That is copyrightable. You are protecting the live performance. The distribution right is not the same as the copyright distribution right. Why is there a limit on enjoining that person from distributing that other work? It doesn't seem to trigger the limited-times provision, to me. It's a separate thing. The live performance is the thing being protected.

MR. PATRY: What we gave people—and on pain of people going to jail, so it's serious, not just theoretical—was a right to say, “If you took my live musical performance and put it in that form or if you are the person who is distributing it,” like Mr. Martignon,²³³ “you can't do that.”

I wouldn't think that what they did by fixing it is creating a separate work. I don't think it's a work at all. If I am a composer, like Irving Berlin was, who couldn't read music and I play my

²³³ 346 F. Supp. 2d 443 (S.D.N.Y. 2004).

piece and somebody else writes it down for me, they are not the author of it; I am the author of it.

So I don't think that what Mr. Martignon did was to create another work at all. I think that what he did was to violate a statute.

The more serious issue, for me, is the one that Jane raises, which is that, under one reading of this, Congress can't do it under either provision. That I find a more troubling prospect. You could say, "You know, what they did back in 1994 was a bad idea, and the guy who did it apologized for it. So please fix it." They wouldn't care, but if Congress did care and they did say, "Oh, okay, you made a mistake, and we're going to fix it and do fifty years," under that reading of it, they couldn't. That is a real issue, because that does, then, place you in violation of your treaty obligation.

MR. PATTON: May I just say, though, depending on your view of simultaneous transmission and simultaneous recording, it could be fixed, I think, either by interpreting the Copyright Act itself to give a simultaneous recording copyright protection or by amending the Copyright Act to, just as you have simultaneous transmission, have a simultaneous recording.

MR. PATRY: But I thought the problem was not how the statute was written, but the constitutional authority to do something.

MR. PATTON: It is, but here, as it stands now, there is no requirement that the performer record his own performance. If Congress were to require that the performer recorded the performance, and once he did so any simultaneous recording gave the performer traditional copyright protection, I think that could comply with the treaty.

MR. PATRY: But then you are redefining it as the Copyright Act. I know Fred von Lohmann has the idea that that is what you should do, and it would encourage people to record things.²³⁴ But

²³⁴ See, e.g., Fred von Lohmann, *Fred von Lohmann said . . .*, THE PATRY COPYRIGHT BLOG, May 18, 2005, <http://williampatry.blogspot.com/2005/05/constitutionality-of-bootleg-statute.html> (responding to William Patry's essay *The Constitutionality of the Bootleg Statute*).

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that is a different act; that is a different thing than what we are talking about.

MR. PATTON: It is, but I think it's a way to fix the treaty, if the court were to say . . .

MR. PATRY: But that's not the treaty. The treaty doesn't say you have to do it. The treaty is intended to cover what we covered, in a constitutional way or not. That's a separate problem, of course, that maybe we agreed—I don't think we did, but I think your view, followed out, is that the administration agreed to something Congress couldn't constitutionally do.

MR. PATTON: Absolutely.

MR. PATRY: Then that's the position.

PROFESSOR HANSEN: We have to move on from this, too.

I have one question. I think it's tactically crazy to bring a criminal case. Why wasn't this a civil case? You put all the force of law against this little shop owner? You just put all sorts of equity on his side that is unnecessary.

MR. PATRY: He's just lucky Judge Martin wasn't on the bench.

PROFESSOR HANSEN: This is what happens when you overreach, maybe. It just comes back to bite you. But if this was a civil case, I doubt that anyone would have been as concerned.

MR. PATRY: *KISS Catalog* is a civil case.²³⁵

PROFESSOR HANSEN: What?

MR. PATRY: *KISS Catalog*, the other case in California, is a civil case.²³⁶

MR. PATTON: And it came out exactly the same way.

MR. PATRY: There are two criminal and one civil, and they all came out wrong.

PROFESSOR HANSEN: I stand corrected. It came out wrong, and it might have been a copycat opinion based upon Judge Baer's

²³⁵ *Kiss Catalog, Ltd. v. Passport Intern. Prods., Inc.*, 135 Fed. Appx. 116 (9th Cir. 2005).

²³⁶ *Id.*

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case. So the criminal first case might have had some influence on the second. What are your predictions about what is going to happen in the Second Circuit, and beyond? Anyone?

MR. PATRY: I went to the argument. I was not encouraged. I was not encouraged by the grasp of the issues at all. If they uphold it, they will only uphold it out of a sort of *noblesse oblige* attitude towards what they view as Congress' fumbling, and the Court is going to interpret it in a way that saves Congress from itself. I found it to be a deeply disturbing argument. You probably thought it was a good argument.

MR. PATTON: I was happy you were deeply disturbed.

I find it difficult to predict. I honestly believe we have the better of the legal positions, certainly with the limited-times issue, and I think also on the writings issue. But I also think it's quite difficult to convince a court to strike down a statute.

I think most people's initial impression of this—I was talking to Marjorie about this earlier—is, “This is somebody ripping off a performer.” People have this initial sense that this is theft of some sort. I think we have to overcome that initial impression with the judges first.

I do think that you are probably right that the criminal context maybe balances out the equities a bit on that issue.

I think we are in the right. What they will do I have no idea.

PROFESSOR HANSEN: Anyone else with predictions?

Why is it taking so long?

MR. PATTON: They want to be careful about striking it down.

PROFESSOR GINSBURG: I don't think it has been that long. The Second Circuit takes—

PROFESSOR HANSEN: How many months?

MR. PATTON: Four months.

PROFESSOR HANSEN: With the Second Circuit, when I was clerking there, there was a rule, sixty days. You have to start writing explanations to the chief judge, why you haven't done it, this and this. No one likes to write those explanations.

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Usually it means there is a dissent or usually you're worried about something, if you are taking this long. The administrative rules want an opinion issued before this.

We'll see. We'll see what that means.

MS. HEINS: Don't the law clerks turn over in the summer?

PROFESSOR HANSEN: That's even more of a reason why it would come out this summer, because the law clerks turn over.

MS. HEINS: Not if it's in July. The new clerk has to start with it in September.

PROFESSOR GINSBURG: I am wondering about how you would fix the statute. This obviously needs fixing. I think most of us agree that the limited-times problem is a real problem. But trying to figure out how you would write a statute to deal with the subject-matter problem—if the unfixed performance isn't a writing, how do you either make it a writing or bring it within the Commerce Clause in a way that is not obnoxious to the Copyright Clause? (Although I don't think it is obnoxious to the Copyright Clause.)

The suggestion that maybe you could have a simultaneous fixation for the performance is interesting, but I think, ultimately, may be a little troublesome when you work through how it would work. For copyright, simultaneous fixation means that now the broadcast is a work—now and forever. But if what you are protecting is a performance and not a work, then that means that every time the performer performs, the performer has to create an archive. One archive, I think we all agree, is a good thing. But if we write a statute in a way that requires the performer, every time she performs, no matter where, at least in the United States, to create some kind of a backup recording—maybe that is not unduly onerous. I don't know. But that is, in effect, the consequence of a simultaneous fixation requirement, because each and every single performance is, itself, an individualized item.

Bob is correct. The performance is not a work of authorship in the sense that once you write the song, it doesn't matter how many times you perform the song or if you sing the song differently every time, the protected work is the song. But if the protected subject matter is the singing of the song, then every time you sing,

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you have a new subject matter. So, if Congress chose to fix the statute by providing for simultaneous fixation, that would mean that every time you sing, you have to make your own recording, at least simultaneous recording, of the performance if you want to protect that same performance from being recorded and transmitted by somebody else, if that is how you choose to fix the statute.

MR. PATTON: And I just don't think that's too much to ask for federal protection.

PROFESSOR HANSEN: A question?

QUESTION: Leslie Kushner [phonetic].

Recording a performance is inherently different than recording a broadcast. Every recording of a broadcast is identical. Every recording of a performance is not. There is something artistic in every recording of a performance, depending on where you put the close-ups, what angle you take. So it seems to me that you would have to do more than just archive each performance in order to claim that another recording is a bootleg, because it's not identical.

PROFESSOR GINSBURG: I think that is confusing the copyrighted work and the performance. It is true that making a recording itself contains elements of authorship—where you put the microphones and so forth. So the output that results from the performance as fixed is a work of authorship. But what we are talking about is the performance, regardless of how fixed. That is what makes this a slightly elusive quantity.

QUESTIONER: But what you are saying is, if it's archived, then that performance cannot be recorded by anybody else, because that would be a bootleg. But that would be an inherently different work.

PROFESSOR GINSBURG: It would be a different recording, but it would capture the performance.

MR. CLARIDA: Right. It wouldn't be an infringement of the sound recording because the definition of what is protected in a sound recording requires a mechanical copy of that sound recording, and not an independent fixation of other sounds, which is, I think, what you are getting at. So it wouldn't be a pirate copy of the authorized fixation, but it would still be . . .

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QUESTIONER: But it wouldn't be permitted because it's the same performance.

PROFESSOR GINSBURG: That's correct. That's right, because what the performer is trying to do is to prevent other people from either making concrete (from fixing) or from transmitting her rendition as she is singing it. It is the difference between a bootleg and a pirated copy. If she has made a recording, copying that recording is record piracy. That is making a copy of the copy. But somebody else making a copy of her performance—whether or not their recording of it has artistic elements doesn't matter. What she is trying to do is protect her performance.

Does anybody remember the movie *Diva*?²³⁷ The plot turned on an opera singer who didn't ever want to be recorded.

The interests that a statute like this protects are not only the commercial interests, but for some artists, they may well be integrity interests, so-called moral rights—that the artist doesn't ever want to be recorded or wants only to be recorded under conditions that she has supervised, agreed to, and all of that.

Somebody said, is this an incentive to anything? Yes, it is. One can say that a statute like this is an incentive and is consistent with the policies underlying the Copyright Act, to the extent that one discerns author policies underlying the Copyright Act, in that it does give the performer some control over what creative thing is done with her performance. Ideally, the Copyright Act should establish a legal environment conducive to creativity (and performance); a law which gives authors and performers some control over the exploitation of their work may be more likely to stimulate artistic activity than a law which makes it open season on works of authorship and performance.

MS. HEINS: But there is another policy side to it, which is that she has chosen to give a public performance.

MR. CLARIDA: Maybe not. It doesn't have to be a public performance.

MS. HEINS: Right, and I think the balance might be struck very differently if somebody were not giving a public performance

²³⁷ DIVA (Les Films Galaxie 1981).

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to which they were selling tickets which anybody could buy. It seems, at that point, you are in public, and there is a public interest in being able to record it. You have not retained any privacy interest.

PROFESSOR GINSBURG: I don't think there is a right to make a public record of every event which people pay to attend.

MS. HEINS: If you are in public, there is at least an argument that you are relinquishing some right of privacy. If you have a rehearsal, which is a limited invitation only, I think it's quite a different story.

PROFESSOR GINSBURG: So all those Lincoln Centers and all those sporting arenas and all those other people who say, "You can't bring cameras in here. You can't record the live performance or the live sports event" . . .

MR. PATTON: But that is state law.

MR. CLARIDA: It should be preempted, then.

PROFESSOR GINSBURG: But the argument Marjorie is making is a First Amendment-type argument. It wouldn't matter whether the basis of the prohibition is state law or federal law. You are positing a public interest, a sort of right to have a publicly available historical record of any performance that takes place in a public place, even if access to the performance is limited to those who pay and so forth.

MS. HEINS: I think I would make a little less ambitious claim than that. I would say, in the context of balancing the artist's interest in not having a public performance recorded against the public's and history's interest in having a record of it, there are some arguments on the other side.

PROFESSOR HANSEN: The Court has sort of rejected those public-interest, First Amendment arguments. Certainly, in the *Random House-Ford* autobiography case it did.²³⁸ The Court said, "No, the First Amendment does not provide additional public interest defense to fair use."²³⁹ In any case, Justice O'Connor said that the First Amendment is on the author's side, because he may

²³⁸ *Harper & Row Publishers v. Nation Enters.*, 471 U.S. 539 (1985).

²³⁹ *Id.*

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not have wanted to speak at that time. Thus, the First Amendment supports the role of copyright rather than serves to undercut copyright protection.²⁴⁰

MS. HEINS: When they take it on the road, I think there is a different balance. Even with an unpublished work, there is still some fair use left for unpublished works. Congress made that explicit after the *Salinger* case.²⁴¹ It is not a bad analysis. With an unpublished work, the author may or may not have made a conscious decision not to reveal this to the world. But there are some interests on the other side.

PROFESSOR HANSEN: If you equate a First Amendment right with whatever might be in the public interest, you make the First Amendment much broader than the Court has ever gone. Nor do I think that the Court is currently inclined to go that way. I think that's probably why these arguments have lost dramatically in every court they have been raised in, including the D.C. case.²⁴²

MS. HEINS: Not every fair-use claim to take quotations from an unpublished work has lost.

PROFESSOR HANSEN: No, no, not every . . .

PROFESSOR GINSBURG: You are positing the entire work, the entire performance. That's a harder sell.

MS. HEINS: I am simply saying that there is no absolute author privacy interest here.

PROFESSOR HANSEN: All right, I think we have actually ventilated this issue quite a bit, let's go to the audience.

I saw a hand over here. Name and affiliation, please.

QUESTION: I am Tina Ravitz. I am the former chief counsel at *Newsweek*, where we didn't have bootleg issues, so forgive the naïveté of this question.

If we assume that a live performance can be theatrical, where you would have the author of the play or the musical, the person

²⁴⁰ See, e.g., *Authors League v. Oman*, 790 F.2d, 220, 223 (2d Cir. 1986).

²⁴¹ *Salinger v. Random House*, 811 F.2d 90 (2d Cir. 1987).

²⁴² *Eldred v. Reno*, 239 F.3d 372, 376 (D.C. Cir. 2001).

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who wrote the lyrics, the person who was the composer, and you have thirty performers, who has standing under the statute?

MR. PATRY: It doesn't cover that type of work. It's only a live musical performance. That's a dramatic work.

QUESTIONER: Only a musical performance, okay. Thank you.

PROFESSOR GINSBURG: If it were a live improvisation of a theatrical work—*Second City*²⁴³—and there were not some preexisting scenario or something that would more or less constitute the work that is being performed, then you do have a problem. It doesn't mean you don't have a claim, but you don't have a claim under federal copyright law. Your claim would be under what is left of state common-law copyright, just like those old cases that were referred to about the people who went into theaters, memorized the plays, and then had them produced down the block. That was all common-law copyright.

So the absence of federal protection doesn't mean that the work is absolutely fair game. It's just that a different source of law would apply.

QUESTION: My name is Chuck Leininger. I am also a third-year at Pepperdine.

Mr. Patry, as the author of the statute, how would like to maybe fix the statute or do things differently to avoid this whole mess?

MR. PATRY: "Author" has never sounded so like such a negative term.

The only way I would fix it is by limiting it to fifty years. I would probably also have—because I have become more of a public-interest guy—some exemptions that take care of what Judge Leval would call transformative uses. I would need to think those out more, but I think you do need things that would take into account people who use portions of bootlegs in the creation of other works—sort of like a fair-use type of thing.

Those are the two things that I would do.

²⁴³ A Chicago-based improvisational comedy group.

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PROFESSOR HANSEN: Anyone else?

[No response]

Any final comments?

MS. HEINS: I could just pick up on that, because I didn't get to it during my talk. The law professors' brief said one of the reasons that the statute is overbroad is that there is no provision for fair use. Evidently, the government responded, "Well, that's not necessarily so. There could be fair use read into it," at which point the law professors turned around and said, "Well, that just underlines our point that it's vague, because we don't know whether there is a fair-use defense for this."

MR. PATRY: Right. I would say that there isn't, unless one wants to read it in as a Commerce Clause good government provision. But since I don't think there is any overbreadth problems, it doesn't bother me from a legal standpoint, although it does bother me from a policy standpoint. That's why I say, from a policy standpoint, if one were to fix it, I would certainly do that.

PROFESSOR GINSBURG: You could make a textual argument, based on the language you cited earlier, that somebody who violates the statute shall be subject to the remedies provided in §§ 502–505,²⁴⁴ to the same extent as any infringer of copyright. One could argue that what makes you an infringer of copyright is that you have made an unauthorized reproduction and so forth that is not excused by §§ 107 and so forth.²⁴⁵

MR. PATRY: Right.

PROFESSOR GINSBURG: So you could sort of funnel all of the Copyright Act in there.

MR. CLARIDA: The criminal provision wouldn't have that advantage, though, because it says you go to jail or you pay a fine. It doesn't have the "to the same extent as an infringer."

MR. PATRY: Most people who will be charged under the criminal provision are not making what most people would

²⁴⁴ 17 U.S.C. §§ 502–505 (2000).

²⁴⁵ 17 U.S.C. § 107 (2000).

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consider to be a fair use, along the transformative lines I am talking about.

PROFESSOR HANSEN: Okay. Our speakers have been excellent, and the audience participation has been interested, insightful and caused the issues to be examined on even a higher level. Thank you all very much.