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COPYRIGHT AND THE CONSTITUTION IN THE AGE OF INTELLECTUAL PROPERTY

The Twenty-Second Annual Donald Brace Memorial Lecture, given to the Copyright Society of America at Columbia Law School, April 22, 1992. Reprinted substantially as given, with the addition of footnotes for clarity.

*David Lange**

As I've thought about the things I might say on this occasion, I've found my memory returning again and again to Mel Nimmer, and especially to the occasion when I first met him. It was in Chicago, in the winter of 1973, at one of those otherwise dreary professional conferences that flee from the mind almost as soon as they are over. I've long since forgotten the subject, but I have never forgotten the occasion. And I want to begin my remarks by telling you this story.

I was then still a young man, and new to the academy; copyright and intellectual property had been given to me to teach as much because there was no one else who wanted to do it as because I myself had asked for it, though in fact I had asked for it and was glad of the opportunity. In practice, in the decade preceding, I had represented what today we would call entertainment clients (though at the time we thought of them as media clients), and I had encountered intellectual property doctrines along the way, as one does in such a practice. But teaching copyright was something at which I was still very much the novice when I first met Mel Nimmer that winter in Chicago.

I know some of you will remember him yourselves: his kindness, his warmth, his generosity, his wit—and of course, his enormous, encyclopedic knowledge of this field of copyright, which by then he had already come to dominate with his “great work.”¹ I was somewhat in awe of him, I suppose; and yet within moments of our introduction I felt not merely that I had known him for a very long while but that, somehow, he had always been my mentor. And he

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¹ *Donahue v. Ziv Television Programs, Inc.*, 54 Cal. Rptr. 130, 142 (Cal. Dist. Ct. App. 1966) (referring to MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* (1992)).

did become a mentor: in the years that followed, even after what I know he sometimes thought of as my apostasy, Mel always was open to my inquiries and my arguments alike, which he treated with the same patient, gentle collegial courtesy whether or not he agreed with me. He was a full-spirited man, and it gives me pleasure to remember him, on any occasion.

But on the occasion of this lecture, I remember him particularly for something striking he said in that first conversation in Chicago. I was teaching intellectual property from a casebook I found difficult: the copyright seemed clear enough in its main outlines, but the other doctrines seemed to me to be—well, not so much confusing in themselves, nor merely inconsistent with copyright, but rather profoundly inconsistent with some essential underpinning in the field of copyright which intuition led me to suspect ought to be essential in these other fields as well. And this inconsistency seemed especially troublesome in the particular sense that all of the protections copyright seemed to offer could be swept away merely by shifting doctrinal grounds—by moving, say, from the rule in copyright that an artist's style is not protected (which means that other artists are free to work in that style if they choose to do so) to a rule in an adjacent field of law, like unfair competition, in which look-alikes and sound-alikes actually may be forbidden to work.

I asked Mel what he thought about this. I said, "How do you handle the problem of these other disciplines when you teach copyright?" And what he said was this: "Well, I don't, necessarily. Understand, that what I am is a copyright lawyer. And a copyright lawyer doesn't necessarily traffic in the rest of intellectual property."

Now we all need to understand, as I came eventually to do myself: what Mel said that day was not to be taken literally, without qualification. Recall that his own professional career had begun with the publication of an article in *Law & Contemporary Problems* in which he had painstakingly, and brilliantly, outlined a new intellectual property right he called "the right of publicity"—an article which was a tour de force, both in analysis and imagination, as well as one of the purest examples of American

legal realism ever penned.² And recall as well that it was Mel Nimmer who wrote, on another occasion, of “distilling new wine in old bottles.”³ Mel Nimmer, in short, knew as much as any person alive about the utility in shifting doctrinal grounds.

And yet there was a certain innocence in this remark—an innocence in time and place—that stays with me to this day. Those of you who are as old as I am now, or older, will know that in a very real sense what Mel said was simply true. This was almost twenty years ago, after all, and Mel himself was reflecting on a career which had started some years earlier, when the formal constraints among intellectual property disciplines were considerably more secure than they are today. We might have thought about shifting from one doctrine to another; but in fact it was not as easy to do as it was to contemplate. Legal formalism might have been in sharp decline, but judges tended still to suppose somehow that “the law wished to have a formal existence.”⁴ Cases tended, accordingly, to stay within accustomed doctrinal boundaries.

Times have changed. Nancy Sinatra lost her “sound alike” claim in that long ago time;⁵ Bette Midler won hers just this month.⁶ In the distance between these two suits lies movement in our field which is not merely striking, but compelling.

Part of what we are compelled to recognize in this movement is clearly beneficial. As intellectual property doctrines have become more flexible, so has our productivity increased in the valuable products this system recognizes and nurtures. As intellectual property doctrines have become increasingly “harmonized” the world around, so has our ability to generate exports become more viable as well. A substantial part of this country’s exports this year will be in the form of intellectual property—and much of those exports will be in the form of interests that would have been

² Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203 (1954).

³ 2 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 8.21(B) (1992).

⁴ Cf. Stanley Fish, *The Law Wishes to Have a Formal Existence*, in THE FATE OF LAW 159 (Austin Sarat & Thomas R. Kearns eds., 1991).

⁵ *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711 (9th Cir. 1970), *cert. denied*, 402 U.S. 906 (1971) (holding that use of song associated with celebrity and imitation of celebrity’s singing voice in advertisement did not constitute unfair competition under California law).

⁶ *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988) (upholding tort cause of action for imitation of celebrity’s singing voice in advertisement), *cert. denied, sub nom. Midler v. Young & Rubicam, Inc.*, 112 S. Ct. 1513 (1992).

problematic, at best, twenty years ago.

But the moral claims in an expanded field of intellectual property remain harder to assess. Let's take the case of publicity rights again, for example. How do we decide where the moral balance lies in the case of publicity? I have no doubt—well, let's say I have very little doubt—that a living individual, like the great Bobby Hurley, should be able to control commercial uses that might be made of his name, personality or likeness. If Dolly Madison were still alive I'm sure I would feel the same way about her. But do I care that her name appears today on packages of cupcakes? Do I care that Sigmund Freud's likeness may appear next week on a new cigar? In truth, I don't, and neither do you, in all likelihood. Dolly Madison is dead, and so is Freud, and so are all who were near and dear to them.

But then, these aren't really the hard moral cases, are they? After all, the hard cases are the ones in which the immediate heirs (or successors or assigns) of dead poets (or whatever) claim a continuing monetary interest in their predecessor's personam. I know how these cases come out, as I know you do too: commercial appropriations (involving, say, the use of Groucho Marx's likeness on a new cigar) are vulnerable to the publicity claims; more aspiring artistic appropriations (such as a novelistic or movie treatment of Agatha Christie) are also vulnerable, but far less so. Analytically this may seem right; but intuitively the decisions still leave much of the issue in doubt. Why should we favor the heirs of dead celebrities where mere money is concerned? Why not encourage them just to start singing, "heigh ho! heigh ho!" and trot on off to work like the rest of us? And meanwhile, what about Dame Agatha's children and grandchildren? Have we no pity?

Meanwhile, difficult as I think these essentially communal moral questions are, they pale at the side of the real issue, which is: how do we justify even the marginal intrusions into the public domain which the publicity doctrines continue to allow, no matter how carefully we may try to control them? And here, let me make it clear, the exercise is not to resolve a common moral question, but rather the far more difficult challenge of justifying an encroach-

ment upon our personal ability to engage in creative play.⁷

Probably I shouldn't have been so cavalier in my disregard for Sigmund Freud, because now I actually come to the point in my remarks where I need him. My thesis at this point is simple, but important: I believe that we are born with an innate urge to engage in creative play—an urge which is not merely constructed from our discourses with each other, nor merely an artifact of a particular society at a particular point in time, but is, instead, essential in all of humankind. Antiformalists, some post-modernists, deconstructionists and other post-structuralists, New Historicists, and others of their ilk—who believe that we are born *tabula rasa*, only to invent ourselves from the essence of our own language and history—will vigorously disagree, to say the least; but I am adamant in my conviction. And I think I can claim the support of Doctor Freud, if I have not succeeded in so alienating him as to drive his shade from the field. Certainly in his writings, at least, he suggested that the urge to express ourselves through creative play is innate; and while he imagined that the origins of that urge could be further dissected, still he did not appear to doubt, in any of his work, ever, that we are, for whatever reasons, creatures born to play. Creativity in adult life, he added, is merely an extension of this innate playful urge.⁸

If this is so—and certainly I do subscribe to it—then it is fair to argue, as I have done elsewhere, that we are born, in a very real sense, to play in the fields of the Word.⁹

Which brings us once again to the real difficulty with the right of publicity—and with all of the other parvenu intellectual property doctrines that have conspired to absorb our beloved copyright within the past few decades. What they confront us with is an obligation not unknown in the law, but one still relatively rare: namely, to justify our intrusions into activities—in this case, the activities of creative self-expression—which are as natural to us,

⁷ Cf. *White v. Samsung Elec. Am., Inc.*, 989 F.2d 1512 (9th Cir. 1993) (Kozinski, J., dissenting), *cert. denied*, 113 S. Ct. 2443 (1993).

⁸ See, e.g., 9 SIGMUND FREUD, *Creative Writers and Day-Dreaming*, in THE STANDARD EDITION OF THE COMPLETE PSYCHOLOGICAL WORKS OF SIGMUND FREUD 143 (James Strachey et al. eds. and trans., 1953).

⁹ See David Lange, *At Play in the Fields of the Word: Copyright and the Construction of Authorship in the Post-Literate Millennium*, LAW & CONTEMP. PROBS., Spring 1992, at 139.

and as essential, and as unavoidable, as breathing.

Something of this insight may have been in my mind when I asked Mel Nimmer the question I did all those years ago. But, if so, it was no more than a dim sense of a reality yet to dawn. Certainly, I did not truly understand how profound this challenge was, and is, until, by chance, I encountered it face to face some years later. For me this encounter was nothing short of an epiphany. Let me tell you how it came about.

It was early in 1979. I had agreed to participate in an ABA program at the Beverly Wilshire, sponsored by the Forum Committee on the Entertainment and Sports Industries. My job was to talk about the right of publicity, which, as you may recall, was just then a matter on appeal in two cases pending in the California Supreme Court, in which the questions had to do with the susceptibility of the public lives of dead celebrities to subsequent appropriation in fiction.¹⁰

I flew to California expecting to speak to lawyers who, like myself, probably would find these doctrinal developments intriguing, if not necessarily appealing. But what I found when I arrived was that a number of Hollywood screenwriters were in the audience, and as their questions followed I realized that whatever interest this subject might hold for them intellectually was wholly outweighed by the threat they felt to their very ability to continue working. And I need to emphasize that when I say "working" what I mean is, "go on creating." For what was at stake for these writers, or so they feared, was not merely their livelihoods, but their very lives. How could they create, they asked, if the raw materials they had been accustomed to using were to be taken from them? And on what basis could such an appropriation be justified? It was in these questions, and others like them, that I sensed a deeper question I now found most telling: "Do you lawyers not recognize the public domain?"

Well, I had supposed that we did. But now I had to ask: what does it mean to recognize the public domain?

¹⁰ *Guglielmi v. Spelling-Goldberg Prod.*, 603 P.2d 454 (Cal. 1979) (holding right of publicity not descendible under California law); *Lugosi v. Universal Pictures*, 603 P.2d 425 (Cal. 1979) (holding right of publicity to be personal and exercisable only during celebrity's lifetime under California law).

I asked that question seriously, of myself and others, in the aftermath of that talk in Beverly Hills, and I came eventually to the point at which I thought it was possible to suggest some tentative answers.¹¹ Certainly we do not have to reject intellectual property outright in order to have a decent regard for the public domain. But we do have to recognize something about intellectual property which makes it unlike other species of property, namely, that it almost always exists in an intangible *res*:

The hypothetical nature of intellectual property means that boundaries inevitably prove troublesome to fix. Rarely can we be sure that our perception of a particular interest is more than an approximation of someone else's perception of the same interest. And unlike real estate or personalty, intellectual property is subject to unlimited recreation in the mind of each observer. This causes trouble enough in the task of establishing recognizable boundaries. But the real difficulty arises from the fact that more than one person sensibly may assert a proprietary interest in what looks like the same property. Learned Hand's useful dictum [about Keats' "Ode on a Grecian Urn"] anticipates this phenomenon in the law of copyright and offers a neat solution. But not all of these conflicts are so easily resolved. Hand's dictum is a rule of copyright but not of patents. And even in copyright, the theory of derivative works makes no adequate allowance for the copier whose recreation of an earlier work is also a substantial improvement.¹²

To me, at least, these insights suggest something of the balance we ought to try to strike:

¹¹ See David Lange, *Recognizing the Public Domain*, LAW & CONTEMP. PROBS., Autumn 1981, at 147.

¹² *Id.* at 150 (footnotes omitted).

What I would suppose . . . is not that intellectual property is undeserving of protection, but rather that such protection as it gets ought to reflect its unique susceptibility to conceptual imprecision and to infinite replication. These attributes seem to me to require the recognition of two fundamental principles. One is that intellectual property theory must always accept something akin to a "no man's land" at the boundaries; doubtful cases of infringement ought always to be resolved in favor of the defendant. The other is that no exclusive interest should ever have affirmative recognition unless its conceptual opposite is also recognized. Each right ought to be marked off clearly against the public domain.¹³

Recognizing the public domain is something I think we have tried to do in copyright—not always gracefully or successfully, and not always ingenuously, either, for that matter—but still, we've made an effort. Indeed, copyright presupposes such an effort by the very nature of the bargain struck between the author and society under the Constitution: the author gets the limited monopoly of copyright for a limited time, but only in exchange for an eventual dedication of the work to the public domain. This is the implicit constitutional transaction, and it is echoed within the doctrinal law in a number of explicit ways which we need not spend additional time recalling here.

Our time can be better spent, instead, in enumerating the ways in which *other* intellectual property doctrines confront the public domain, and in seeing how they accommodate themselves to the challenge. We can't hope to exhaust the field on this occasion but let's do consider three doctrines, specifically: unfair competition, trademarks (including the Lanham Act's § 43(a)),¹⁴ and dilution—understanding, of course, that we can only hope to sketch the dimensions of the problem impressionistically.

When we think of unfair competition in this context, we have to think not so much of that branch of unfair competition dealing with

¹³ *Id.* (footnotes omitted).

¹⁴ 15 U.S.C. § 1125(a) (1988).

fraud, deception or “palming off,” as we do of the newer, more protean branch of unfair competition that some call “misappropriation.” You understand the problem here. If I design an industrial lamp, or a floor lamp, or a boat, you may have every reason in the world to want to copy my design: if you think it has commercial appeal, and think also that you can make it better or more inexpensively—or even if you simply think you can market it more effectively. That’s competition in the marketplace at large. But sometimes the common law, left to its own devices, calls your appropriation “unfair competition”—and then I may enjoin you from copying my design on grounds that you and I both will have trouble explaining to any sensible, fair-minded ten-year-old with no prior axe to grind. Why do I get to keep the design, and you don’t? Is it that I was first? Surely not; even in an age of rampant narcissism, that explanation is a non-starter. Is it that I invested time, money and effort in developing the design? I’ve read Locke’s Second Treatise, as you have, and I understand that argument up to a point; but let’s remember that what Locke actually said was that it was sensible to recognize “property” in such circumstances only when what remained for others was “sufficient” and “as good.” That isn’t an easy case to make when what the market wants is a product fashioned exactly like mine.¹⁵

And so far, I’ve only mentioned competition in industrial settings. That may be enough where lamps and boats are concerned. But it clearly isn’t enough among artisans, whose commerce and creative lives are fully intertwined. Among jewelers, for example, or potters or glassmakers or metalsmiths or rag doll makers or woodworkers, making the product is also a species of creative play—and this is no less true when what is being made is not original. You don’t have to take my word for that. Just take a close look the next time you head for the beach and see for yourself: the child who imitates the next child’s sand castle is enjoying herself every bit as much as if she had gotten there first. Sometimes, in fact, the art is in the appropriation. Shakespeare called it “The Winter’s Tale.” Art

¹⁵ For an elegant Lockean analysis, see Wendy Gordon, *A Property Right in Self-Expression: Equality and Individualism in the Natural Law of Intellectual Property*, 102 YALE L.J. 1533 (1993).

historians call it “making a find.”¹⁶ And so do we when we’re not being intellectual property lawyers.

We’re not done here: I’ve said nothing about defenses, and nothing in particular about a singular source of defenses—namely the American Constitution—that is of particular interest in this context. And we’ll come to that presently.

Before we do, though, let’s shift doctrinal grounds again—this time from unfair competition to the adjacent field of trademarks. Now here the theories are rarely anything so straightforwardly crude as simple “misappropriation.” No, here the driving theories ordinarily are confusion or mistake or deception in the marketplace. If my wife and I call our ice cream “Ben & Jerry’s,” someone might buy it thinking it’s the *real* Ben & Jerry’s, when really it’s just Dave and Terri’s—but then, you understand how this works. What we lawyers want to do is to protect the consumer from the consequences of misleading practices, and we also want to protect the prior user (or registrant in the case of the Lanham Act) whose effort and investment are at risk when the consumer is misled. So far, so good. These are not necessarily unworthy goals.

But it’s a funny business, trademarks: if we were Ben and Jerri (with an “i”), my wife and I might think ourselves ill-used at being told that we couldn’t sell ice cream under our own names. And as a matter of fact, we wouldn’t be told that unless Ben and Jerry I had established something called secondary meaning in their names—which I suppose they have. Sometimes there really isn’t room for a second use of a distinctive mark. But sometimes—just sometimes—proprieters of trademarks are tempted to claim a little secondary meaning where, if the truth be told, there’s probably just enough of it that if you had that much secondary meaning and a token you could catch a ride, one-way, on the Staten Island Ferry. I’ve seen cases like that. If you’re a trademark lawyer, so have you.

And that’s troublesome, but that’s not all. Some judges can’t distinguish between appropriation and confusion: in the First Circuit, for example—and for that matter, elsewhere—we have a rule that says deliberate copying of a trademark raises a presump-

¹⁶ Richard Shiff, *Making a Find: An Argument for Creativity Not Originality*, STRUCTURALIST REV., Spring 1984, at 59.

tion of confusion¹⁷—which now means that trademark law works very much as though it were, once again, anchored in whatever-it-is that makes us frown on “misappropriation.” Talk about doctrinal shifting: *plus ça change!*

And now, finally, let’s add dilution into the mix. As a theory, this was the brainchild of Harvard Law School’s Frank Schechter, who suggested it in an important article called “The Rational Basis of Trademark Protection” some sixty-five years ago.¹⁸ Here’s the thought behind dilution: if a “highly distinctive” trademark is used by someone other than its proprietor, even in circumstances in which there is no confusion or likelihood of confusion or mistake or deception, the trademark may still suffer from a threat to its continued distinctiveness; and if it does, that second use ought to be enjoined. There’s actually more to the theory, but this is enough for our purposes now: what we need to see here, again, is how easy it is to dispense with “confusion,” in favor of protection against “misappropriation.” Some commentators have said that judges haven’t liked dilution for just that reason; but it’s quite clear that the action is gaining ground. There is even some recent case authority to the effect that dilution may exist at the common law, rather than—as had been supposed—in statutes enacted by the states.¹⁹

We’ve looked, now, at unfair competition, trademark law, and dilution; and before that, we looked briefly at the right of publicity. So what is it, then, that we see in these additional intellectual property doctrines that make them importantly different from copyright in their response to the challenge of the public domain—which is to say, the challenge to justify encroachments into the free exercise of creative self-expression?

¹⁷ See *Chart House, Inc. v. Bornstein*, 636 F.2d 9 (1st Cir. 1980) (holding owner of registered service marks entitled to preliminary injunction against defendant’s use of coinciding name); *Purolator, Inc. v. EFRA Distrib., Inc.*, 687 F.2d 554 (1st Cir. 1982) (holding that evidence, including similarities between the products themselves and between their packaging and styling, supported finding of likelihood of confusion between competing products).

¹⁸ Frank Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813 (1927).

¹⁹ See *Storck USA, L.P. v. Levy*, 18 U.S.P.Q.2d (BNA) 1965 (N.D. Ill. 1991) (holding that Illinois anti-dilution statute did not supersede common-law dilution claims).

I'm going to oversimplify my answer to that question, but only because time and space are short. The longer account would be more damning still.

What we see in the fields of intellectual property beyond copyright (and patents, which are circumscribed at least as satisfactorily as copyright) is a deep and growing appetite for appropriation *simpliciter* as the main touch-spring of the device. Copying and appropriation are concepts which ensnare us twice over: first, because they are relatively easy to prove; and second, because, once proven, we assume too much, too easily, about why they are wrong.

I might be more troubled than I am by the direction intellectual property has been taking during the past twenty years or so, were it not for a counter-revolution that has been quietly asserting itself in just that same space of time. And now I'm referring, of course, to the increasing role the Constitution has been playing in the field, which is the subject I want to turn to finally in these comments.

We Americans are more committed to our Constitution, I think it's fair to say, than are most of the other political states in the world at this moment in time; and what that means, among many other things, is that we are committed to a kind of formalism that otherwise we have all but abandoned. I know you will have reservations about this statement, to say the least: consider the evolution of the rights revolution, for example, and of course it appears as though nothing could be further from the truth. But bear with me, please. I think the point I'm making is nonetheless real, and I believe it has some importance for us as intellectual property lawyers.

When I say we are committed to formalism, through our commitment to the Constitution, what I mean is simply this: that our system of law has not yet delivered us into the hands of the post-structuralists; in the words of my colleague, Stanley Fish, "the law still wishes to have a formal existence"—and I mean to observe, merely, that the agency we have designated to give us that existence is to be found more fully in the Constitution than in any other source our law affords.

This is important in copyright law because it anchors us in the very practices that allow us to say that copyright is responsive to the interests of both commerce and creative self-expression alike.

How many legislative compromises were driven, during the long passage from the 1909 Act to the 1976 Act, by fundamental constitutional concerns no one could say with assurance now, but there were many. And they were accepted in the main, I think it is fair to say, with the same combination of resignation and grace that led the good people of Kentucky to accept Christian Laettner's final basket²⁰—sometimes you don't have to like it; you just have to understand that that's the way it is—it's play within the rules. That's formalism in practice.

We've been accustomed to playing within the rules in copyright for a very long time—so long, in fact, that it's sometimes possible to forget that there are rules, so fully situated are we in the play. It came as something of a surprise, then, a year ago, to encounter a case like *Feist v. Rural Telephone*,²¹ in which Justice O'Connor unmistakably grounded her opinion not merely in long-standing flaws in the doctrinal ground, but also in the deeper requirements of the Constitution itself. But the surprise is not so much in the outcome as it is in our ability to "sense the Constitution" in the process of decision itself.

I have suggested on another occasion that I think that *Feist* may signal the Court's intention "to begin the serious business of bringing to intellectual property the constitutional coherence it deserves."²² To be sure, the opinion alone, though substantially more discursive in constitutional terms than the issues would have required, still does not contain anything explicit suggesting a radical departure from established precedents; it is rather the *decision itself*, and the *process by which it was reached*, that command attention! We can count on the toes of Long John Silver the number of occasions on which the Court has invalidated an aging reign of precedents by reaching out to constitutional doctrines within the Copyright Clause. In this sense, *Feist* was, and is, an event, and I think it portends events to follow.

²⁰ Duke Univ. v. Univ. of Kentucky, final score Duke 104-103, E. Regional Finals, NCAA Div. I Men's Basketball Tournament, Mar. 28, 1992.

²¹ *Feist Publications v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991) (holding that information contained in white pages of telephone directory did not meet constitutional or statutory requirements for copyright protection).

²² David Lange, *Sensing the Constitution in Feist*, 17 U. DAYTON L. REV. 367 (1992).

It is possible, of course, to read *Feist* as though it merely reinscribes the formal distinctions between copyright and commerce originally contemplated by the *Trade-Mark Cases*,²³ which Justice O'Connor prominently cites. If so, then, as Paul Goldstein suggested to you on this occasion a year ago, we may eventually observe the transfer of a portion of what has belonged to copyright, in the protection of databases, to some other field of law under the Commerce power.²⁴ This is a plausible reading of the case; but it isn't the reading I would give it.

Instead, I would suggest that the Copyright Clause itself may stand at the threshold of a new era of interpretation in which the formalist distinctions of the past will give way to new, and more harmonious, resolutions of the issues we actually confront in intellectual property today—resolutions better suited, in other words, to the new intellectual property millennium—yet resolutions derived finally, once again under the formal auspices of a new Intellectual Property Clause, a clause newly read as *primus inter pares* among other clauses within the Constitution.

I think so for two reasons, and with these reasons, when I have finished sketching them, I will conclude these remarks, with thanks for your patience and your kindness in hearing me out.

I think so first simply because there is need now, as never before, for harmonization among the intellectual property doctrines under a paramount Intellectual Property Clause. Now that copyright has been joined by "the barbarians at the gate," either we will harmonize or we will perish. I give you a case that makes my point more succinctly than I could otherwise hope to do: Recently, in New York, a judge of the U. S. Federal District Court for the Eastern District issued a preliminary injunction forbidding the continued sale of prints and posters that were "quite similar in [style and] general appearances" to the plaintiff's earlier works.²⁵ To a copyright lawyer, this might at once seem to be a copyright case. Today, however, it can also be decided, apparently within the limits of precedent, as though it were a trade dress infringement case

²³ *Trade-Mark Cases*, 100 U.S. 82 (1879).

²⁴ See Paul Goldstein, *Copyright*, LAW & CONTEMP. PROBS., Spring 1992, at 79, 88-89.

²⁵ *Romm Art Creations, Ltd. v. Simcha Int'l, Inc.*, 786 F. Supp. 1126, 1138 (E.D.N.Y. 1992) (granting preliminary injunction prohibiting defendant's distribution of posters resembling plaintiff's fine art posters).

under section 43(a) of the Lanham Act. In an era without real rules, decisions like this easily pass as sound doctrinal law.

And I think, meanwhile, that there is precedent for formal revisionism within the Constitution and its own history of interpretation. I said a few pages ago, as I was speaking of unfair competition, that I would return to the matter of defenses presently, and I want to do that now, in this context. What's striking about the defenses to what would otherwise be runaway doctrines in unfair competition, trademark law, and dilution alike, is that, as if sensing the need, the Constitution has taken the lead in generating these defenses. Beginning with the decisions in *Sears*²⁶ and *Compco*²⁷—and surviving the decisions in *Goldstein*²⁸ and *Kewanee*²⁹—the Court has signaled its intentions to employ the Constitution to curtail the worst inclinations in a rapidly expanding field. *Bonito Boats*³⁰ continues to send that signal. And really, in terms of constitutional law itself, as a process of interpretation, nothing could be more natural, or more in accordance with long-standing precedent: the Court has always reached for whatever tools came to hand. To use the Supremacy Clause, in the context of intellectual property, is to achieve approximately the converse of what was achieved through incorporation of the Bill of Rights into the Fourteenth Amendment.

But the real precedent here is in the First Amendment, and twice over at that: first, because that amendment has also played a recurring role in curtailing intellectual property doctrines; and second, because the First Amendment gives us a striking example of how a long-dormant provision within the Constitution can spring suddenly into life when need arises. Today the First Amendment is all but omnipresent in our lives; we live as though we had always lived within a system of freedom of expression; and indeed, I would say, in a sense, we always did—but not because of the First Amendment: we must remember that the First Amendment did not begin to be construed until 1919, at the close of the Great War, when repeated prosecutions of dissidents forced us to think in more

²⁶ *Sears, Roebuck, & Co. v. Stiffel Co.*, 376 U.S. 225 (1964).

²⁷ *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964).

²⁸ *Goldstein v. California*, 412 U.S. 546 (1973).

²⁹ *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470 (1974).

³⁰ *Bonito Boats v. Thunder Craft Boats*, 489 U.S. 141 (1989).

formal terms about what it was to be free.³¹ We found it useful then to envision an expanded First Amendment precisely because our circumstances justified a formal resolution of that dilemma. But the First Amendment, even after its expansion, merely confirmed what had gone before. We lived within a system of freedom of expression, ultimately, because it is in our character as Americans to “think as [we please] and to speak as [we] think.”³²

Just so, I would say, it is in our character as Americans—but also even more deeply and essentially as humans—to wish to be free to play in the fields of the Word. Copyright has offered us that promise. In an age of intellectual property, however, copyright alone can no longer guarantee that promise. An expanded role for an Intellectual Property Clause offers some hope that we can restore harmony to a system of rights in which commerce and creative self-expression will continue to coexist peacefully and productively.

As was true in 1919 with the First Amendment, so now it may be with the Intellectual Property Clause: exigent necessity justifies us in envisioning new, more formal, uses for a dormant provision of the Constitution. I don’t know what Mel Nimmer would think of this suggestion. I suppose it would depend on his own assessment of the need. But I expect he would understand the thought behind my suggestions, and I imagine he would approve of the process. For after all, it was he who taught us all to respect the practice of distilling “new wine in old bottles.”

³¹ See *Schenck v. United States*, 249 U.S. 47 (1919); *Debs v. United States*, 249 U.S. 211 (1919); *Abrams v. United States*, 250 U.S. 616 (1919).

³² *Whitney v. California*, 274 U.S. 357, 375 (1927) (Brandeis, J., concurring), *overruled by* *Brandenburg v. Ohio*, 395 U.S. 444 (1969).