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MEANS/ENDS ANALYSIS IN COPYRIGHT LAW: *ELDRED V. ASHCROFT* IN ONE ACT

Dan T. Coenen and Paul J. Heald***

Scene: The quiet hallway of a law school. A troubled young professor of Intellectual Property law stands in front of a senior colleague's office and studies a pencil sketch of Bushrod Washington taped to the door. After a brief hesitation, he knocks and enters.

IP: Have you got a minute? I've got an Intellectual Property Clause question, and I really need the opinion of an expert in Constitutional Law.

CL: Sit down! It wouldn't be about *Eldred v. Ashcroft*,¹ would it? I noticed that the Supreme Court had granted cert the other day on the issue of retroactive extension of the copyright term.

IP: That's right. The Court is going to decide whether Congress can prevent old works from falling into the public domain by extending the monopoly previously given to copyright holders. It's ridiculous! When Gershwin wrote his *Concerto in F* in 1925, he knew that the law would grant him rights until 1983 at the most. Now, under the Sonny Bono Copyright Term Extension Act (CTEA), the concerto won't enter the public domain until 2025—that is, if Congress doesn't extend the publisher's copyright even further.

CL: I don't see anything in the Constitution that says Congress can't pass ridiculous laws.

IP: No, but you will find the Intellectual Property Clause in Article I, Section 8. If you recall, the Court has held that a specialized grant of power—like the bankruptcy power—may restrain Congress from regulating the subject matter of that power under other grants like the Commerce Clause.²

CL: So?

IP: So, I think Congress either can grant these retroactive extensions under the Intellectual Property Clause, or it can't grant them at all.

CL: Well, let's take a look at this Intellectual Property Clause of yours. Here in Article I it says: "Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."³ So, why can't Congress extend copyright protection in existing works? One hundred years of protection for Gershwin's concerto is a long while, but it's still a "limited" time, isn't it?

IP: That's actually not so clear, in part because any actuary will tell you that the present value of a hundred-year income stream is about the same as an infinite one.⁴ But, for now at least, I want to put to one side the "limited Times" language.⁵ The language I find most important is in the opening clause. How on earth can it possibly "promote Science and useful Arts" to grant an author's heirs a bonus term of protection decades after a work has already been created? The Court has always talked about the Intellectual Property Clause in terms of the economic incentives it authorizes Congress to create.⁶ How can Congress incentivize a work that already exists?

CL: *Incentivize?* What kind of IP jargon is that?

IP: Give me a break! Just yesterday I heard you carrying on about the *dormant* Commerce Clause, whatever that is. Anyway, how *can* Congress incentivize works that already exist?

CL: Maybe Congress figures that some authors are more likely to produce works if they know their heirs might get more rights down the road.

IP: So you think Congress envisioned potential authors—already promised a term that lasts for life plus fifty years beyond—would choose to create more works because of the possibility that some future Congress will extend the rights of their great-great-grandchildren? Let's give Congress more credit than that!

CL: Well it sounds to me like you've got this incentivizing business all figured out. Why do you need help from me?

IP: Here's my problem. I've been following this case very closely, and I'm confused by some of the arguments that I've been hearing. Both sides seem obsessed with legislative history and Congress's motives for passing the legislation. It seems to me that the Constitution either forbids a certain type of statute or it doesn't. Congress's intent, as opposed to the Framers' intent, seems irrelevant as to whether a law is unconstitutional. Can a good motive save a bad law? Or vice-versa?

CL: In fact, the Supreme Court has said that a bad motive can invalidate an otherwise good law under many constitutional provisions, including the Establishment Clause,⁷ the Free Exercise Clause,⁸ the Equal Protection Clause,⁹ and—yes—even the dormant Commerce Clause.¹⁰ Of course those cases don't so much involve limitations on Congress's Article I lawmaking powers as they involve the protection of individual rights. Additionally, despite tons of cases that say motive matters, there is plenty of rhetoric in Supreme Court opinions suggesting that legislative motive should not—or at least normally should not—count in constitutional decision-making.¹¹ In a nutshell, the Court's treatment of motive in constitutional cases is pretty messy.¹² What does the legislative history show about Congress's motives in passing this CTEA?

IP: Well, you won't be surprised to learn that copyright term extension was pushed by Disney, the American Society of Composers, Authors, and Publishers (ASCAP), the American Motion Picture Association and other owners of income streams on the verge of drying up. But Congress was wise enough not to let on that the extension was just a giveaway to wealthy campaign contributors. The official committee reports say that the retroactive extension will harmonize U.S. law with the E.U. copyright term and help preserve old films.¹³

CL: Does it?

IP: Does it what?

CL: Harmonize U.S. law with European law and help preserve old films?

IP: What does it matter? Harmony is great, but Congress can't pass unconstitutional laws to make the Europeans happy! Do you teach *Reid v. Covert*?¹⁴ After WWII, Congress honored a treaty obligation with England by passing a law that took away the right to a jury trial from some of our overseas citizens. The Court held that Congress can't throw out the Constitution just to make foreign governments happy.

CL: We'll talk about *Reid* in a minute. What about preserving old films?

IP: Let me start with a hypothetical. Imagine a law that rewarded the first person to restore an old silent film that was deteriorating. Let's say you could earn a ten-year exclusive right to show a film if you really saved it from the dustbin. That statute would be constitutional because a law that provides genuine incentives to preserve fading art should not be a problem under the Intellectual Property Clause.

CL: I assume the CTEA doesn't do that?

IP: Of course not. There's no requirement that anyone restore anything. The effect of the law is to make consumers pay billions to all sorts of copyright owners—not just owners of films. Also there's no requirement that the money be spent on anything, far less preserving old films.

CL: How do you *really* feel about the law?

IP: The same way the Framers of the Constitution would have felt—completely outraged! Don't you constitutional law people care about original intent anymore?

CL: Sure we do, but there is nothing wrong with framing an original-intent argument in the sort of rhetoric the Court often uses nowadays when it talks about constitutional restraints.

IP: What do you mean?

CL: The important thing to see is that the Court frequently discusses constitutional restrictions on government power in terms of a means-ends analysis.¹⁵

IP: Well, what would a means-ends analysis say about the CTEA and preserving old movies?

CL: First, it suggests that you're missing something important by just asking about wrongful motives. After all, even you concede that helping to preserve old films is a purpose that Congress can rightfully pursue; the problem is *the way* in which Congress is pursuing this goal. Who knows? Maybe granting retroactive extensions will encourage preservation of a few old films, though it's hard for me to see how. Even if it does, giving lengthy copyright extensions to Gershwin's grandchildren, book publishers, and long-dead painters won't preserve old films at all. In other words, there is a big-time problem with the means Congress has chosen to pursue its film-preservation purpose. To use modern constitutional lingo, the law is massively overinclusive. And even Chief Justice John Marshall said that in order to pass constitutional muster, the law must be "really calculated" to achieve the goal Congress has identified.¹⁶ Anyway, as someone who has read a lot of constitutional law opinions, that's how I see it.

IP: Don't all those means-ends opinions have to do with constitutional protections of individual rights, like the Equal Protection Clause and the First Amendment?

CL: Not really. My quote from Chief Justice Marshall concerned the grant of power to Congress under the Necessary and Proper Clause of Article I, Section 8. The Rehnquist Court has said—and genuinely meant—that congressional means for pursuing a permissible goal must have a "proportionality" to that goal when Congress invokes its powers under the Fourteenth and Fifteenth Amendments.¹⁷ Besides, even assuming a means-ends analysis is especially well-suited for rights cases, I'll be surprised if you don't tell me in a little while that the Constitution's treatment of copyrights is closely tied to the First Amendment.¹⁸ Beyond that, at least with regard to the goal of preserving old films, perceiving a means-end connection in this case may require such an "exercise of strained

imagination”¹⁹ that the law violates even the basic due process prohibition on legislative “arbitrariness.”²⁰

IP: Hmmm. What about the congressional goal of harmonizing U.S. and E.U. copyright laws?

CL: What about that goal? Does the retroactive grant of copyright extensions actually produce uniformity?

IP: No way. International IP experts agree that the CTEA doesn’t harmonize U.S. and E.U. law. In fact, they think that it may exacerbate conflicts between the two systems.²¹

CL: Those facts are very helpful to you because the Court sometimes finds legislative means improper as a result of problems other than over- and under-inclusiveness. In particular, the Court sometimes finds “fit” problems because the means are too tenuously connected to the declared legislative objective or because those means have counterproductive effects.²² On the other hand, I have to warn you that the Court is normally hesitant to second-guess a legislature’s choice of means for pursuing a permissible end, at least absent a smash-in-the-face means problem like we just talked about with regard to old-movie preservation. This hesitance may be heightened when we are talking about laws enacted by Congress, as opposed to, for example, a local city council.²³ And this hesitance is heightened even more when we are talking about judicial review of congressional judgments about foreign relations.²⁴ As I’m sure even you can understand, the courts don’t want to get into that business at all.

IP: But I still don’t see why Congress can grant gratuitous copyright extensions to improve our foreign relations.

CL: Excellent! Now you’ve brought us back to where we began—by raising the issue of permissible legislative purposes.

IP: What do you mean?

CL: Remember, you suggested that the preservation of old movies was a purpose Congress could pursue consistent with the Intellectual Property Clause. But now you’re questioning whether

Congress can—regardless of how well its means and ends fit together—extend copyright protections to advance the goals of creating international uniformity of laws, improving relations with foreign nations, achieving international equity, cutting down on administrative costs and the like.

IP: Exactly. I repeat: How can Congress grant freebie copyright extensions to improve our foreign relations or promote “equity” when the Intellectual Property Clause permits the granting of exclusive rights only “[t]o promote the Progress of Science and useful Arts”?²⁵

CL: Hold on just a minute! The Constitution, after all, doesn’t contain only the Intellectual Property Clause. Article I, Section 8, for example, gives Congress authority to regulate foreign commerce.²⁶ The cases say that Congress can pass laws to implement treaties under the Necessary and Proper Clause, even if its other powers would not independently authorize those enactments.²⁷ The Supreme Court even seems to believe that Congress has a non-textual “foreign affairs” power, at least if it acts in concert with the President.²⁸

IP: Well, maybe Congress can invoke its foreign-commerce, treaty, and foreign-affairs powers in lots of ways. However, the Constitution says Congress can grant exclusive rights to authors and inventors *only* “[t]o promote the Progress of Science and useful Arts.”²⁹

CL: Hold on another minute, and let me look at the Constitution again. Well, I do see the “To promote” language, but I don’t see the word “only” in front of it or anywhere else in the Intellectual Property Clause.

IP: Isn’t the notion of “onlyness” implied? Why else would the Framers put the introductory “To promote” clause in there?

CL: Maybe if I had a little more time, I could come up with some explanation. For now, however, I have to admit that the introductory language of the Intellectual Property Clause is striking.

IP: Why is that?

CL: Because I can't think of any other clause in the Constitution that is structured in this sort of way.³⁰

IP: What do you mean?

CL: Well, the Clause begins by saying that Congress has the power to do something—namely, “[t]o promote”; then it goes on to say that Congress can exercise that power in a particular way—namely, “by securing [exclusive rights] for limited Times to Authors.”³¹ Maybe the Framers—contrary to all your protests about whether congressional purposes should matter in constitutional decision-making—wanted to place a special focus on congressional motivation in copyright-power cases. Maybe the Framers foresaw that judicial examinations of purpose would prove controversial as a general matter and wanted to clarify that a careful focus on purpose was appropriate in this context, even if it might not be in other areas of constitutional law.

IP: So, it's possible that the Court will brush off as beside the point all this talk about harmonizing U.S. and E.U. law because such a purpose doesn't concern promoting science and the useful arts.

CL: It looks to me like the Court could take that approach if it wanted to.

IP: Cool.

CL: In effect you're making two separate points. First, when Congress grants copyright protection it can't rely on any source of authority other than the Intellectual Property Clause. Usually Article I grants of power are not deemed exclusive in this way. For example, if Congress passes a tax that is not permissible under the taxing power because the Court views it as a regulation,³² the Court will still uphold the law under the commerce power so long as it deals with a commercial activity that significantly affects commerce among the states.³³ But in the copyright context your notion of exclusivity may well make good sense. For example, it may help promote commerce among the states to grant authors unlimited copyright terms. But it would make mincemeat of the “limited Times”

language of the Intellectual Property Clause to let Congress grant unlimited copyright terms under the Commerce Clause.

IP: I totally agree. If Congress is going to grant exclusive rights to authors and inventors, it has to act under the Intellectual Property Clause. That's the whole point of the bankruptcy clause case I mentioned right at the start.³⁴ What else am I saying?

CL: The second thing I hear you saying is that the text of the Intellectual Property Clause authorizes the grant of copyrights only "[t]o promote the Progress of Science and useful Arts"—and that harmonizing international copyright law doesn't do that.³⁵ By the way, why doesn't it? I would think that having international copyright law in disarray would tend to discourage creative activity.

IP: Even assuming that's true for prospective works (which I would question), it surely isn't true for works that already exist. It's simply not possible to promote or discourage the creation of works that are already created—as I'm sure even someone who doesn't like the word "incentivize" can appreciate.

CL: Good point. And precisely because it's a good point, it opens the door for the Court to use means-ends analysis to bonk the CTEA. That's true even if the Court somehow says that international relations concerns might justify non-incentivizing copyright laws in rare emergency-type circumstances. After all, there's surely no "compelling" foreign-relations reason to hand out these sweeping retroactive term extensions to Disney, the Gershwin estate, and every other copyright holder.³⁶

IP: All this talk about ends and means is interesting, but I worry that it vastly over-complicates things and directs attention away from what should be the point of focus in Intellectual Property Clause cases.

CL: What do you mean?

IP: I prefer a simple, straightforward, objective test.

CL: And what test is that?

IP: The quid pro quo test: Congress can only give someone copyright or patent protection in exchange for a new creation. If Congress doesn't grant the exclusive right as part of such an exchange, it has acted unconstitutionally—period.³⁷

CL: Perhaps your test is not as simple as you think.

IP: What do you mean?

CL: You said earlier, for example, that Congress could give copyright protection to someone who preserved an old film. But an "old film" is not a "new creation." So I have trouble seeing how your supposedly simple test gets you where you want to go.

IP: History indicates that "new" means "previously unavailable to the public," not "absolutely novel."³⁸ Patents for new inventions in seventeenth-century England, for example, included any innovation "new to the realm,"³⁹ like a glass-blowing process used in Italy but unknown in England. Until 1976, copyright law measured the duration of rights from the moment of publication rather than creation.⁴⁰ A new creation is one the public gets access to for the first time.⁴¹

CL: If someone *preserves* an old film, that act doesn't give public access to that film "for the *first* time." So I'm still not sure your "simple" test quite works.

IP: Alright, I suppose I will have to argue more broadly that in certain circumstances "maintaining access" could constructively satisfy the requirement of providing "new access" to a work. Under the Visual Artists Rights Act (VARA), for example, the destruction of some public artworks without the author's permission is prohibited by way of a legal protection written into the copyright statutes.⁴² Assuming the Intellectual Property Clause provides the source of power to enact this law, I don't see any constitutional problem because creation of a new work of art is a pre-requisite to receiving augmented protection. I might add that Congress did not apply VARA retroactively.⁴³

CL: Here's another question about your simple quid pro quo test. What if Congress gave all copyright holders a monetary grant as a sort of reward for their past industry and creative contributions?

IP: I see no problem with that—at least so long as the grant qualifies as spending for “the general welfare”⁴⁴ and doesn't amount to a violation of due process, the equal protection principle, or some other constitutional prohibition because it's “special” legislation.⁴⁵ Your hypothetical presents a spending-power issue, not a copyright-power issue.

CL: Hey! I thought I was the constitutional law scholar around here!

IP: Why on earth should it matter in the *Eldred* case whether Congress can grant monetary subsidies to existing copyright holders?⁴⁶

CL: Because that's exactly what—as a practical matter—Congress has done. The only difference is that the CTEA gives away the congressional subsidy in the form of a monopoly right rather than in the form of cash. And why should that fact make any constitutional difference? After all, many constitutional cases say that substance is more important than form.⁴⁷

IP: Of course. However, what you're missing is that there are two *real*—and very big—differences between cash gifts and copyright term extensions.

CL: What are they?

IP: First, the Intellectual Property Clause simply doesn't apply to cash subsidies and similar outright handouts. By its terms, the Clause constrains Congress only when it grants an “exclusive Right” to authors and inventors.⁴⁸ Writing a check is not the same thing as granting someone a monopoly right. Our whole legal culture—with good reason—has always looked askance at monopolies that limit the freedom and industry of others.

CL: Fair enough. What's the other real difference?

IP: The second difference has to do with political-process considerations.⁴⁹ The point is that outright subsidies are almost always controversial and therefore subject to significant political scrutiny. It's very hard to pull the wool over the public's eyes when Congress is handing out buckets of dollar bills. The CTEA, on the other hand, was passed quickly without opposition. It effected a transfer payment worth billions from consumers to copyright holders without anyone noticing. Imagine if Congress instead had decided to tax consumers and write a \$1 billion check to Disney and another one to ASCAP!

CL: You've got a point there. In fact, I recently read a law review article that developed this very point in discussing—you guessed it—the dormant Commerce Clause.⁵⁰ You'll also be interested to know that the Supreme Court has recently emphasized these same sorts of concerns about transparency and accountability in the context of assessing the scope of Congress's Article I powers.⁵¹

IP: So there! My quid pro quo test makes good sense, and—unlike all that means-ends stuff—it's simple to apply.

CL: Is it? It seems to me that, whatever test one comes up with, there will be cases on its edges that create difficulties with application. What if, for example, Congress conditioned retroactive term extensions for works *A*, *B*, and *C* on the prospective creation of work *D*? Would that transfer involve a quid pro quo? Or what if Congress simply allowed the transfer of the newly earned term for work *A* to work *B*? Besides, you can't just make up some new test. Where does your quid pro quo approach come from?

IP: It comes from the history of the Intellectual Property Clause and the deliberate policy choices its text reflects.⁵²

CL: What do you mean?

IP: The Framers knew their English history and were well aware of the abusive granting of exclusive rights perpetrated on the public by Queen Elizabeth I and King James I. Favored courtiers were granted "odious" monopolies in common products like ale, salt, and window glass.⁵³ The public suffered all the ills associated with monopolies—high prices and reduced availability—while receiving

no offsetting benefits at all.⁵⁴ Eventually, the common law courts held crown-sponsored monopolies illegal, and Parliament passed anti-monopoly legislation shortly thereafter.⁵⁵

CL: What about monopolies for new inventions?

IP: That was the main exception recognized both by the King's Bench in *Darcy v. Allin*⁵⁶ and by Parliament in the Statute of Monopolies.⁵⁷ If the Crown had purchased something new for the public, then a monopoly was permitted. The Framers were familiar with this history, and they were worried history might repeat itself in their new nation. They drafted the Intellectual Property Clause as they did because of this concern. In fact, Americans were more aware than anyone of the perils of monopolies because the Statute of Monopolies was enforced only in England itself and not in the colonies. Don't ever forget that one of the causes of the American Revolution was the monopoly on the sale of tea in the colonies granted to the East India Company!

CL: I won't, but I still don't understand how all this means the Court should adopt your quid pro quo test.

IP: Haven't you been listening? The quid pro quo test fits both the history and the language of the Intellectual Property Clause like a glove. Copyright protection can be given only "[t]o promote . . . Progress"—and that means the creation of new things.⁵⁸ In other words, copyright protection can be given only as part of a genuine exchange or trade for the creation of something that did not exist before. At bottom, the clause shows a fear of Congress behaving as irresponsibly as the Crown. While I'm on my high horse, I might add that's exactly what happened when Congress passed the CTEA. A favored courtier of the Clinton administration, the entertainment industry, successfully approached Congress for a no-strings-attached hand-out in the form of extended monopolies on Mickey Mouse and thousands of other valuable books, songs, and pieces of art. We, like English consumers long ago, will foot the bill for these gifts to a favored few.⁵⁹ Just ask your wife how many dollars she had to spend yesterday for that expensive edition of Gershwin's *Concerto in F* because she couldn't print it for free off the Internet.

CL: Can't you get to the same place by talking about a lack of meaningful connection between permissible ends and chosen means instead talking about a quid pro quo?

IP: Maybe, but looking solely for the presence of a quid pro quo—and nothing more—has several protective features. First, it makes it impossible for the government to use legislative history—or, worse yet, evidence of good motive cooked up after the fact by lawyers—as a smokescreen for congressional giveaways. Second, even if Congress is well meaning, the quid pro quo test reduces the risk that Congress will mistakenly grant exclusive rights contrary to the public good. Under the quid pro quo test, Congress has to buy the public something. That's what we want; that's what's in the public interest; and that—and that alone—is what the Intellectual Property Clause was meant to foster. Third, the quid pro quo test removes the need for courts to address extremely messy questions about subjective motivation and the effectiveness of legislation. Finally, as I said before, focusing attention on the form of the transfer will heighten political accountability.

CL: Well, let me ask you this question. You keep relying on the new-invention exception to the Statute of Monopolies. Maybe that makes sense when we are talking about patents, but *Eldred* concerns copyright law, doesn't it?⁶⁰

IP: You're not going to suggest that the quid pro quo test should apply to patents, but not copyrights, are you? No plausible reading of the constitutional text—which treats patents and copyrights together—would support that result. Plus, there are strong historical reasons for looking with particular skepticism at copyright protections awarded in the absence of a true exchange.

CL: How so?

IP: Until the Statute of Anne was enacted in 1710, Parliament granted the Stationer's Company the exclusive right to print books.⁶¹ Further, it could only print those books the Crown and the Church of England permitted it to print.⁶² As a result, the Stationer's Company became an engine for the suppression of political and religious speech.⁶³ This vehicle of censorship was broken by the Statute

of Anne when authors were granted the exclusive right to their works for a short fourteen-year term.⁶⁴ A large public domain was thereby stimulated, and the marketplace of ideas flourished—largely because of the state's *trading* of the copyright for the creation of new works. When Congress locks up expression for increasingly long periods of time by extending copyright protection for works already created, history mandates that a very strict judicial approach should be triggered.

CL: Your history seems sound, but I still think the constitutional test you're trying to extract from it may not promote the goals that history reveals to be important.⁶⁵ In particular, you view the quid pro quo test as a bastion of protection for the public. But whenever the Court creates a highly specific and objective formal test, the lawmakers (aided by lobbyists) find ways to circumvent it.⁶⁶

IP: I see where you're coming from. It's not hard to imagine a statute put in the form of a purchase that would be detrimental to scientific progress. For example, computer programmers think that protecting new software for the life of its author plus seventy years is absurd.⁶⁷ Anything longer than about two years is just a gift to Bill Gates. It would be nice if the Court examined whether the term length for software is counterproductively long. (In addition, I'm troubled by your previous hypotheticals about transferable copyrights and works *A*, *B*, *C* and *D*.)⁶⁸ Still, this business about means/ends analysis is tough for me to swallow. I just don't trust the Court to ferret out bad motives or bad means/end fits.

CL: Then why not keep your quid pro quo test, but then supplement it with an additional, complementary constitutional requirement?

IP: Could the Court do that? Could the Court require both a quid pro quo *and* some sound means/end relationship in copyright legislation?

CL: I don't see why not, since the Court does this sort of thing all the time. Under the Establishment Clause, for example, the Court strikes down laws that have the purpose of promoting religion.⁶⁹ Even when the Court can't discover such a purpose, however,

it will strike down a law when the promotion of religion is its primary effect.⁷⁰ You might say that the effect test is sort of a backstop to guard against lawmakers who are sufficiently sophisticated to mask their wrongful purpose. An even better example comes from—you guessed it—the dormant Commerce Clause cases. If the challenged law overtly discriminates against interstate commerce, it's unconstitutional (or at least “virtually” so).⁷¹ But the Court doesn't stop there. Even if the law is neutral on its face, the Court engages in a means-ends analysis to see if it “smells” too much like a hidden protectionist measure.⁷² If it does, the Court will throw the law out even if it's not discriminatory on its face or in its avowed purpose. The point is that the sort of dual-protection rule we are considering for the Intellectual Property Clause is common fare in constitutional law.⁷³ I see no reason why the Court couldn't require both a *quid pro quo* and some demonstration that a law works well enough not to constitute a cleverly disguised giveaway.

IP: Now your means-ends analysis is starting to sound a lot better!!!

CL: In fact, I suspect—despite all your hand-wringing about legislative ends and means—that you and I don't view the Intellectual Property Clause very differently at all.

IP: What do you mean?

CL: You have convinced me, at least for now, that the Intellectual Property Clause is special. In particular, I'm inclined to agree with your notion that—at least absent extraordinary circumstances—any award of copyright protection is unconstitutional unless it does “promote” the creation of new work in keeping with the terms of the Intellectual Property Clause itself. By the way, this conclusion brings us back to *Reid v. Covert*.⁷⁴ If the Intellectual Property Clause in fact operates as a constraint on, as well as a grant of, congressional power, then Congress should not be able to win the *Eldred* case simply by relying on its authority to make treaties or regulate foreign affairs. I might add that the shared purposes of the Intellectual Property Clause and the Free Speech and Press Clauses⁷⁵ make *Eldred* an appealing case for application of the *Reid* principle, since both *Reid* and *Eldred* concern protection of individual rights.⁷⁶

IP: Good!

CL: I tend to agree with the logic behind your *quid pro quo* principle, and I don't think that I have a problem applying it as a freestanding (though not as the sole) constitutional test. In other words, if it's obvious that Congress hasn't gotten something in exchange for the grant of copyright protection, I would say that Congress hasn't done anything "[t]o promote" the sort of new work with which the Intellectual Property Clause is concerned. Such grants might be called "*per se*" violations of the anti-monopoly principle inherent in the clause.⁷⁷ Alternatively, we could say that such a grant is unlawful "*on its face*"⁷⁸ because by definition it lacks the requisite purpose of "*incentivizing*" the creation of new work.

IP: Now you're talking!

CL: That reveals something else very important that we agree on.

IP: It does?

CL: It reveals that at bottom we're both concerned with congressional motive. We agree, based primarily on the specialized text of the Intellectual Property Clause, that the only purpose for which Congress can grant copyrights is to incentivize—that is, to stimulate the creation of new works.

IP: Excellent.

CL: Yet, I think I would even go further than you. In particular, I suspect there are some cases in which Congress would supply some *quid pro quo*—but only a very lame one. The question then becomes whether Congress has genuinely acted to "*promote*" new works. It's important for you to see that using means/ends analysis in this sort of case doesn't necessarily involve a fuzzy inquiry into the fine points of legislative history or a probing of the actual subjective mental states of 535 or some other number of elected federal officials. These sorts of cases are driven by a concern about purpose, but the assessment of purpose is based on objective factors—just like under your *quid pro quo* test. As the Supreme Court has explained time and again, an objective means/ends analysis—inspired

by concerns about wrongful purpose—makes sense because “if upon examination it becomes clear that there is no substantial relationship between the statutes and their purported objectives, this may well indicate that these objectives were not the statute’s objectives in the first place.”⁷⁹

IP: Basically you would fine tune my quid pro quo test to cover cases that involve phony-baloney, largely formal acts of incentivization.

CL: That’s a fair way to put the point.

IP: But would you go beyond the quid pro quo test in a case like *Eldred*?

CL: In *Eldred*, there’s no need to do more than that, but in other cases I would be open to striking down copyright laws that are marked by poor means-end fits, especially when they only technically meet the quid pro quo requirement. If the purpose of the Intellectual Property Clause is to outlaw freebie monopoly grants, why should we find some sort of “peppercorn” trade-off to be enough?

IP: Wow, if my actuary friends are right about the negligible value of distant future income streams, you may be casting doubt on the CTEA’s *prospective* twenty-year extension of the copyright term! Anyway, you seem clearly convinced of at least one thing.

CL: What’s that?

IP: That the opening language of the Intellectual Property Clause means something. Surely the D.C. Circuit was wrong to hold that “[t]o promote the Progress of Science and useful Arts” has no effect on the scope of the congressional power whatsoever.⁸⁰

CL: For now at least, I will *strongly* agree with you on that point. *Marbury* itself teaches that we should try hard not to read any constitutional clause as “mere surplusage” that is “entirely without meaning.”⁸¹

IP: We also seem to agree that a key question is whether the Court should extract from that language an objective quid pro quo test, some means-ends test, or some combination of the two.

CL: I agree with that too. In any event, we'll find out whether we're right pretty soon—unless the Court is able to sidestep all these Intellectual Property Clause issues by invalidating the CTEA on First Amendment grounds.

IP: Well that's a conversation for another day! Let me buy you a beer, and you can tell me what Bushrod Washington would think about the merits of the legislative purpose component of modern dormant Commerce Clause analysis.

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1. See *Eldred v. Ashcroft*, No. 01-618 (U.S. oral argument Oct. 9, 2002).

2. See *Ry. Labor Executives' Ass'n v. Gibbons*, 455 U.S. 457, 465, 469 (1982) (finding that allowing Congress to "enact nonuniform bankruptcy laws pursuant to the Commerce Clause . . . would eradicate from the Constitution a limitation on the power of Congress" to "establish . . . uniform Laws on the subject of Bankruptcies throughout the United States'") (citing U.S. CONST. art. I, § 8, cl. 8).

3. U.S. CONST. art. I, § 8, cl. 8.

4. See Paul J. Heald & Suzanna Sherry, *Implied Limits on the Legislative Power: The Intellectual Property Clause as an Absolute Constraint on Congress*, 2000 ILL. L. REV. 1119, 1173-74.

5. There is a significant argument, however, that retroactive extensions do run afoul of the "limited Times" constraint. If Congress can give a twenty-year extension in 1976 and then again in 1998, there is no principled reason it cannot give still further extensions in 2018, in 2038, and thereafter. Authorizing such a string of extensions would render the "limited Times" language an empty shell. The need to restrict retroactive extensions is confirmed by the fact that "[t]he monopoly is a property right; and like any property right, *its boundaries should be clear*." *Festo v. Shoketsu Kinzoku Kogyo Kabushiki*, 122 S. Ct. 1831, 1837 (2002) (emphasis added). As the unanimous Court recently explained in expounding the Intellectual Property Clause in the patent-law context: "This clarity is essential to promote progress, because it enables efficient investment in innovation. A patent holder should know what he owns, *and the public should know what he does not*." *Id.* (emphasis added). If Congress can freely grant retroactive extensions, however, potential creators and purveyors of expressive work cannot even remotely know where private rights end and public rights begin with regard to copyright. (To put the point another way, a monopoly granted for a fixed number of years becomes one that is not fixed at all if Congress can extend it willy nilly based on the drift of prevailing political winds.) Notably, the certainty and predictability values highlighted in *Festo* are at a particularly high ebb in the copyright context because of the modern statute's broad prohibition on publishing even highly novel and socially valuable—but "derivative"—works rooted only loosely in protected material. In short, the uncertainty created by allowing retroactive extensions of copyright would be wholly at war with the core principle that "the public. . .

should be encouraged to pursue innovations, creations, and new ideas beyond the inventor's exclusive rights." *Id.*

6. See Heald & Sherry, *supra* note 4, at 1164-65.

7. See, e.g., *Edwards v. Aguillard*, 482 U.S. 578, 590-91 (1987).

8. See, e.g., *Church of Lukumi Babalu Aye, Inc. v. Hialeah*, 508 U.S. 520, 533-34 (1993).

9. See, e.g., *Washington v. Davis*, 426 U.S. 229, 241 (1976).

10. See, e.g., *Minnesota v. Clover Leaf Creamery Co.*, 449 U.S. 456, 471 & n.15 (1981).

11. See generally Dan T. Coenen, *The Rehnquist Court, Structural Due Process and Semi-Substantive Constitutional Review*, 75 S. CAL. L. REV. ____ (forthcoming Dec. 2002) (examining the history of motive-based review by the Rehnquist Court).

12. As one constitutional law expert has put the point: "The Supreme Court has never developed an even remotely coherent account . . . of when legislative motive, and congressional motive in particular, is relevant and when it is not." LAURENCE H. TRIBE, *AMERICAN CONSTITUTIONAL LAW* § 5-3, at 803 n.12 (3d ed. 2000).

13. See S. REP. NO. 104-315, at 3, 13 (1996).

14. 354 U.S. 1 (1957).

15. See, e.g., Gerald Gunther, *The Supreme Court, 1971 Term—Foreword: In Search of Evolving Doctrine on a Changing Court: A Model For a Newer Equal Protection*, 86 HARV. L. REV. 1, 43 (1972).

16. *M'Culloch v. Maryland*, 17 U.S. (4 Wheat.) 316, 423 (1819).

17. See, e.g., *City of Boerne v. Flores*, 521 U.S. 507, 520 (1997) (setting forth requirements of "congruence and proportionality").

18. See Heald & Sherry, *supra* note 4, at 1144.

19. *Logan v. Zimmerman Brush Co.*, 455 U.S. 422, 442 (1982) (Blackmun, J., concurring) (applying rational-relation review); *id.* at 444 (Powell, J., concurring) (similarly finding constitutional violation when legislative means "is arbitrary and irrational when measured against [its] purpose").

20. See *Duke Power Co. v. Carolina Envtl. Study Group, Inc.*, 438 U.S. 59, 83 (1978).

21. See Dennis S. Karjala, *Judicial Review of Copyright Term Extension Legislation*, 36 LOY. L.A. L. REV. 199, 227-28 (2002).

22. See generally Dan T. Coenen, *Constitutional Means Problems (Part I): Problems of Inefficacy and Perverse Results* (unpublished manuscript, on file with authors) (examining the Court's tenuousness and counterproductivity reasoning).

23. See *City of Erie v. Pap's A. M.*, 529 U.S. 277, 311 n.1 (2000) (Souter, J., concurring) (noting that the "nature of the legislating institution" might affect judicial analysis of "means-end fit" and that the Court might "defer less to a city council than we would to Congress").

24. See, e.g., *Mathews v. Diaz*, 426 U.S. 67, 81 (1976) (suggesting that government decisions that "implicate our relations with foreign powers . . . are frequently of a character more appropriate to either the Legislature or the Executive than to the Judiciary" and that "[a]ny rule of constitutional law that would inhibit the flexibility of the political branches to . . . respond to changing world conditions should be adopted only with the greatest caution").

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25. U.S. CONST. art. I, § 8, cl. 8.
 26. See U.S. CONST. art. I, § 8, cl. 3 ("Congress shall have Power to . . . regulate Commerce with Foreign Nations.").
 27. See, e.g., *Missouri v. Holland*, 252 U.S. 416 (1920).
 28. See, e.g., *Perez v. Brownell*, 356 U.S. 44, 57 (1958) (recognizing that such a legislative power is needed "to reduce to a minimum the frictions that are unavoidable in a world of sovereigns sensitive in matters touching their dignity and interests"), *overruled by* *Afroyim v. Rusk*, 387 U.S. 253, 268 (1967) (ultimate holding overruled, but reasoning remains consistent).
 29. U.S. CONST. art. I, § 8, cl. 8.
 30. Although the Second Amendment includes an introductory clause, it does not include the sort of introductory clause that appears in the Constitution's creation of the IP power. In particular, the introductory language of the Second Amendment suggests the Framers' purpose for creating some sort of right to bear arms. The introductory language of the Intellectual Property Clause, in contrast, speaks to the power of the national legislative branch—that is, what purpose Congress can pursue when it grants patents and copyrights. In short, the Second Amendment is not built upon the sort of "[t]o . . . by" architecture that organizes the Intellectual Property Clause. Compare U.S. CONST. art. I, § 8, cl. 8 (Intellectual Property Clause introductory language) with U.S. CONST. amend. II (Second Amendment introductory language). For more on the unique structure of the Intellectual Property Clause, see Malla Pollack, *Dealing With Old Father William, or Moving From Constitutional Text to Constitutional Doctrine: Progress Clause Review of the Copyright Term Extension Act*, 36 Loy. L.A. L. Rev. 337 (2002).
 31. U.S. CONST. art. I, § 8, cl. 8.
 32. See, e.g., *Child Labor Tax Case*, 259 U.S. 20 (1922).
 33. See, e.g., *Wickard v. Filburn*, 317 U.S. 111 (1942); see also *U.S. v. Lopez*, 514 U.S. 549 (1995) (distinguishing commercial and noncommercial activities with regard to aggregation principle); see generally *EEOC v. Wyoming*, 460 U.S. 226, 243-44 n.18 (1983) (noting that the "constitutionality of action taken by Congress does not depend on recitals of the power which it undertakes to exercise").
 34. See *Ry. Labor Executives Ass'n v. Gibbons*, 455 U.S. 457 (1982).
 35. U.S. CONST. art. I, § 8, cl. 8.
 36. See *infra* notes 72-73.
 37. See *Heald & Sherry*, *supra* note 4, at 1162-63, 1169-72.
 38. See *id.* at 1144.
 39. See *id.*
 40. See *id.*
 41. See *id.* at 1143-44.
 42. See 17 U.S.C. § 106(A) (2000).
 43. See Visual Artists Rights Act of 1990, Pub. L. No. 101-650, tit. 6, 104 Stat. 5128.
 44. See U.S. CONST. art. I, § 8, cl. 1.
 45. See Michael Kent Curtis, *Historical Linguistics, Inkblots, and Life After Death: The Privileges or Immunities of Citizens of the United States*, 78 N.C. L. REV. 1071, 1077 (2000).

46. See *Eldred v. Reno*, 239 F.3d 372, 374-75 (D.C. Cir. 2001) (upholding Sonny Bono Copyright Term Extension Act of 1998), *cert. granted sub nom. Eldred v. Ashcroft*, 122 S. Ct. 1062 (Feb. 19, 2002) (mem).

47. See, e.g., *Complete Auto Transit, Inc. v. Brady*, 430 U.S. 274, 279 (1977).

48. See Heald & Sherry, *supra* note 4, at 1120, 1165-66.

49. See *id.* at 1174-76.

50. See Dan. T. Coenen, *Business Subsidies and the Dormant Commerce Clause*, 107 YALE L.J. 965 (1998).

51. See, e.g., *id.* at 998-99.

52. See Heald & Sherry, *supra* note 4, at 1128-40.

53. See *id.* at 1143.

54. See *id.*

55. See *id.* at 1169.

56. 74 Eng. Rep. 1131 (K.B. 1907).

57. 21 Jam., ch. 3, § 5 (1623) (Eng.).

58. But see Malla Pollack, *What is Congress Supposed to Promote? Defining "Progress" in Article I, Section 8, Clause 8 of the United States Constitution or Introducing The Progress Clause*, 80 Neb. L. Rev. (forthcoming 2002).

59. See Heald & Sherry, *supra* note 4, at 1143-44.

60. See *Eldred v. Reno*, 239 F.3d 372, 374-75 (D.C. Cir. 2001) (upholding Sonny Bono Copyright Term Extension Act of 1998), *cert. granted sub nom. Eldred v. Ashcroft*, 122 S. Ct. 1062 (Feb. 19, 2002) (mem).

61. See Heald & Sherry, *supra* note 4, at 1144-45.

62. See PAUL GOLDSTEIN, COPYRIGHT §§ 1.13.1.1; Heald & Sherry, *supra* note 4, at 1144-45.

63. See PAUL GOLDSTEIN, COPYRIGHT §§ 1.13.1.1; see also Heald & Sherry, *supra* note 4, at 1145.

64. See *id.*

65. By the way, the First Amendment might well interact with the Intellectual Property Clause to produce specialized means-ends scrutiny. After all, means-ends analysis is common fare when free expression values are threatened by statute. See, e.g., *Reno v. ACLU*, 521 U.S. 844 (1997). Nor is it unusual for the Court to distill constitutional tests or approaches from the joint operation of multiple constitutional provisions. See, e.g., *M.L.B. v. S.L.J.*, 519 U.S. 102, 110 (1996) (noting the Court's earliest right-of-access-to-court ruling "drew support from the Due Process and Equal Protection Clauses"); *Employment Div., Dep't of Human Res. v. Smith*, 494 U.S. 872, 881 (1990) (describing rules of heightened scrutiny employed in earlier challenges to generally applicable laws as involving "not the Free Exercise Clause alone, but the Free Exercise Clause in conjunction with other constitutional protections, such as freedom of speech"); see Akhil Reed Amar, *Intratextualism* 112 HARV. L. REV. 747 (1999). In particular, there is no clear reason why the "incentivization" values that underlie the Intellectual Property Clause should be ignored by courts as they consider what interests are—and are not—sufficiently weighty to justify the sweeping infringement on speech and press rights effectuated by the CTEA.

66. See, e.g., *Oklahoma Tax Comm'n v. Jefferson Lines, Inc.*, 514 U.S. 175, 189 (1995) (reaffirming prior prohibition on unapportioned "gross

receipts tax" imposed on seller's gross proceeds from sale of interstate transportation services, while upholding economically equivalent "sales tax" imposed on buyers of such services).

67. See Lawrence D. Graham & Richard O. Zerbe, *Economically Efficient Treatment of Computer Software*, 22 RUTGERS COMPUTER & TECH. L.J. 61, 142 (1996) (suggesting two-year term of protection is optimal).

68. See *supra* text accompanying notes 51-52.

69. See, e.g., *Edwards v. Aguillard*, 482 U.S. 578, 590 (1987).

70. See *Lemon v. Kurtzman*, 403 U.S. 602, 612-13 (1971) (setting forth improper-purpose-or-effect test).

71. See *City of Philadelphia v. New Jersey*, 437 U.S. 617, 624 (1978).

72. See, e.g., *Hunt v. Wash. Apple Adver. Comm'n*, 432 U.S. 333 (1977).

73. See also *Penn Central Transportation Co. v. City of New York*, 438 U.S. 104, 123-24 (1978) (authorizing contextual judicial examination of regulation's effects to determine if it gives rise to a Fifth Amendment taking, even if no "per se" taking is present).

74. 354 U.S. 1 (1957).

75. See *supra* notes 7-15 and accompanying text.

76. See *Eldred v. Reno*, 239 F.3d 372, 374-75 (D.C. Cir. 2001) (upholding Sonny Bono Copyright Term Extension Act of 1998), *cert. granted sub nom. Eldred v. Ashcroft*, 122 S. Ct. 1062 (Feb. 19, 2002) (mem); *Reid v. Covert*, 354 U.S. 1, 6-7 (1957).

77. See, e.g., LAURENCE H. TRIBE, *AMERICAN CONSTITUTIONAL LAW* § 9-5, at 602 (2d ed. 1988) (describing approach to regulatory takings articulated in *Loretto v. Teleprompter Manhattan CATV Corp.*, 458 U.S. 419, 442 (1982), as abandoning an "ad hoc approach in favor of a per se rule" in a well-identified set of cases that concern constitutional interests that are particularly acute).

78. See, e.g., *Church of Lukumi Babalu Aye, Inc. v. City of Hialeah*, 508 U.S. 520, 533-34 (1993) (citing as a "minimum requirement" of the Free Exercise Clause's neutrality requirement that "a law not discriminate on its face," but rejecting contention that "our inquiry must end with the text of the laws at issue").

79. *Orr v. Orr*, 440 U.S. 268, 280 n.10 (1979); *accord, e.g., City of Richmond v. J.A. Croson Co.*, 488 U.S. 469, 506 (1989) (noting that "gross overinclusiveness of Richmond's racial preference strongly impugns the city's claim of remedial motivation"). The Court, however, often does look beyond objective factors to legislative history in determining whether a lawmaking body has acted with an impermissible purpose. See Coenen, *supra* note 11, at 80 n.376. Likewise, the Court sometimes strikes down statutes because the legislative record reveals that the lawmaker failed to study adequately the required connection between legislative means and legislative ends, and in particular whether less restrictive alternatives existed for achieving the government's permissible purposes. See *id.* at 34-49. A careful study of the legislative process that led to passage of the CTEA might well reveal its vulnerability to challenge under either of these approaches. See Karjala, *Judicial Review of Copyright Term Extension Legislation*, *supra* note 21, at 222-31 (detailing shortcomings of legislative processes that produced retroactive extension of copyright terms). Moreover, the dramatic free-expression implications of the Act may well render it particularly susceptible to such a "due process of

lawmaking” invalidation. *See* Coenen, *supra* note 11, at 60-67 (noting the Court’s gravitation to this approach in various First Amendment cases, including *Sable Communications, Inc. v. FCC*, 492 U.S. 115 (1989); *Turner Broadcasting System, Inc. v. FCC*, 520 U.S. 180 (1997); *Reno v. ACLU*, 521 U.S. 844 (1997); and *Bartnicki v. Vopper*, 121 S. Ct. 1753 (2001)).

80. *See Eldred v. Reno*, 239 F.3d 372, 378 (2001).

81. *Marbury v. Madison*, 5 U.S. (1 Cranch) 137, 174 (1803).