

# ESSAY

## FREEDOM OF SPEECH AND INTELLECTUAL PROPERTY: SOME THOUGHTS AFTER *ELDRED, 44 LIQUORMART, AND BARTNICKI*

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## I. INTRODUCTION

The Supreme Court has decided five First Amendment cases involving the rather rare activity of flag desecration.<sup>1</sup> During the same time, it has decided only four First Amendment cases involving intellectual property.<sup>2</sup>

This is unfortunate, because most intellectual property rules—copyright law, trademark law, right of publicity law, and trade secret law—are speech restrictions: They keep people from publishing, producing, and performing the speech that they want to publish, produce, and perform. The laws may be well motivated and often beneficial, but they are speech restrictions nonetheless, as many courts have acknowledged.<sup>3</sup> And they are practically significant and doctrinally complex speech

1. *United States v. Eichman*, 496 U.S. 310 (1990); *Texas v. Johnson*, 491 U.S. 397 (1989); *Spence v. Washington*, 418 U.S. 405 (1974); *Smith v. Goguen*, 415 U.S. 566 (1974); *Street v. New York*, 394 U.S. 576 (1969). *Smith* was decided on vagueness grounds, but under the more demanding version of the void-for-vagueness doctrine that applies in free speech cases. 415 U.S. at 581–82. *Halter v. Nebraska*, 205 U.S. 34 (1907), the first Supreme Court case that dealt with flag misuse laws, did not focus on free speech, and was in any event decided before the First Amendment was read as applying to state laws.

2. *Eldred v. Ashcroft*, 123 S. Ct. 769 (2003) (copyright); *S.F. Arts & Athletics, Inc. v. United States Olympic Comm.*, 483 U.S. 522 (1987) (quasi-trademark right in the word “Olympics” used for commercial purposes); *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539 (1985) (copyright); *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977) (right of publicity).

3. *See, e.g.*, cases cited *supra* note 2 (discussing the First Amendment in the context of various intellectual property restrictions); *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26 (1st Cir. 1987) (holding that applying a state trademark dilution law to an advertisement parody would violate the First Amendment); *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797 (Cal. 2001) (holding that the First Amendment constrains the right of publicity in certain ways); *Joe Dickerson & Assocs. v. Dittmar*, 34 P.3d 995 (Colo. 2001) (same).

restrictions, which deserve more attention than the Supreme Court has so far given them.

I think the core of these restrictions is indeed constitutional, except perhaps as to the right of publicity. Still, it is important to identify the precise constitutional boundaries of these restrictions and the precise justifications for their validity.

First, it is important for resolving specific questions about these particular restrictions: Are artists free to use famous people's faces in their paintings, much like moviemakers are free to use famous people as characters?<sup>4</sup> May people produce and sell prints, T-shirts, or playing cards that make fun of celebrities or of trademarks?<sup>5</sup> May the law punish the publication of facts, such as the URLs of sites that contain infringing material, on the grounds that publishing those facts constitutes "contributory [copyright] infringement"?<sup>6</sup> May newspaper or Web site publishers be sued for disclosing trade secrets that were illegally leaked by third parties?<sup>7</sup>

Second, it is important for judging new intellectual property speech restrictions that people suggest by analogy to the old ones. May Congress, for instance, bar people from republishing material that they extract from databases of facts?<sup>8</sup> May the government create information privacy rules that prohibit the unauthorized revelation of personal data relating to other people, on the theory that all people own the information about themselves?<sup>9</sup>

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4. *Compare Comedy III*, 21 P.3d at 811 (holding that an artist may be barred from selling prints depicting a famous person's picture), *with* *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915 (6th Cir. 2003) (holding that such prints are constitutionally protected). The cases involved prints, not paintings, but the constitutional issue seems to be the same for both.

5. *See* *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959 (10th Cir. 1996) (parody trading cards); *Anheuser-Busch, Inc. v. Balducci Publ'ns*, 28 F.3d 769 (8th Cir. 1994) (ad parody); *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26 (1st Cir. 1987) (sexually explicit parody of a clothing catalog); *see also* *Politicards*, at <http://www.politicards.com/> (last visited July 12, 2003) (political parody playing cards).

6. *See* *Arista Records, Inc. v. MP3Board, Inc.*, No. 00 CIV. 4660, 2002 WL 1997918, at \*3-\*4 (S.D.N.Y. Aug. 29, 2002); *Intellectual Reserve, Inc. v. Utah Lighthouse Ministry, Inc.*, 75 F. Supp. 2d 1290, 1293-95 (D. Utah 1999); *see also* *Universal City Studios, Inc. v. Corley*, 273 F.3d 429, 455-58 (2d Cir. 2001) (enjoining publication of links to page that contained material which violated the Digital Millennium Copyright Act).

7. *See, e.g.,* *Ford Motor Co. v. Lane*, 67 F. Supp. 2d 745 (E.D. Mich. 1999); *DVD Copy Control Ass'n v. Bunner*, 75 P.3d 1 (Cal. 2003); *State ex rel. Sports Mgmt. News, Inc. v. Nachtigal*, 921 P.2d 1304 (Or. 1996).

8. *See* Yochai Benkler, *Free as the Air to Common Use: First Amendment Constraints on Enclosure of the Public Domain*, 74 N.Y.U. L. REV. 354, 440-46 (1999).

9. *See* Eugene Volokh, *Freedom of Speech and Information Privacy: The Troubling Implications of a Right to Stop People from Speaking About You*, 52 STAN. L. REV. 1049, 1063-80 (2000).

Third, because intellectual property speech restrictions have fared relatively well before the Supreme Court, some have tried to recast other restrictions in intellectual property terms. Thus, some have proposed flag burning bans justified on the theory that the government owns an intellectual property right in the flag.<sup>10</sup> Others have urged restrictions on dissemination of public records, arguing that the government owns an intellectual property right in those records.<sup>11</sup> Others may promote restrictions on the use of American Indian symbolism, perhaps arguing that a tribe owns intellectual property rights in its cultural symbols,<sup>12</sup> or that the heirs of a long-dead Indian leader own the rights in his name.<sup>13</sup> To evaluate these proposals, we need to understand the constitutional rules governing the doctrines to which these proposals try to draw analogies.

And, fourth, if judges accept certain justifications for intellectual property speech restrictions, these justifications may also be used to defend other restrictions that have nothing to do with intellectual property. Say that the right of publicity is upheld on the theory that misusing someone's name or likeness interferes with his dignity and sense of self-worth.<sup>14</sup> This would strengthen the argument that protecting people's dignity is generally justification enough for restricting speech—and that argument could then strengthen the case for punishing cruel personal attacks like the one in *Hustler Magazine v. Falwell*,<sup>15</sup> or

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10. See, for example, H.R. 3883, 104th Cong. (1996) (introduced by Rep. Robert G. Torricelli), which declared the United States flag to be copyrighted and would have imposed "criminal penalties for the destruction of a copyrighted flag." See also *Texas v. Johnson*, 491 U.S. 397, 429–30 (1989) (Rehnquist, C.J., dissenting) (suggesting that the government could ban flag desecration because it had a "limited [intellectual] property right" in the flag).

11. See, e.g., *FEC v. Int'l Funding Inst., Inc.*, 969 F.2d 1110, 1119–20 (D.C. Cir. 1992) (Buckley, J., concurring); *id.* at 1121 (Randolph, J., concurring in the judgment).

12. Cf. Andrew Osborn, *Maoris Win Lego Battle*, *GUARDIAN* (London), Oct. 31, 2001, at 16 ("The Danish toy maker Lego said yesterday that it would not loot indigenous cultures for exotic new product names after Maori tribes in New Zealand challenged its right to use Polynesian names in a new game called Bionicle.").

13. Cf. *Hornell Brewing Co. v. Rosebud Sioux Tribal Court*, 133 F.3d 1087, 1093–94 (8th Cir. 1998) (involving the descendants of the Sioux leader Crazy Horse, then 115 years dead, trying to use right of publicity law to stop the marketing of Crazy Horse Malt Liquor; the malt liquor company won on procedural grounds); *Hornell Brewing Co. v. Minn. Dep't of Pub. Safety, Liquor Control Div.*, 553 N.W.2d 713, 718 (Minn. Ct. App. 1996) (involving a Minnesota statute that banned the use of American Indian leaders' names on alcohol products, and that was justified by a desire to prevent "unauthorized . . . appropriation of individuals' names").

14. See 1 J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 2:2, at 2-2 (2d ed. 2000) (reasoning that "[t]he appropriation type of right of privacy"—which is closely connected to the right of publicity—"recognizes legal injury when such unpermitted use causes mental injury by loss of dignity and self-esteem").

15. 485 U.S. 46 (1988) (discussing a parody portraying Jerry Falwell's first sexual

for punishing other insults.<sup>16</sup> Likewise, if copyright law is justified on the grounds that the government may restrict some speech in order to foster other speech, that might be deployed to justify broader campaign finance restrictions and other restraints.<sup>17</sup>

In this Essay, I would like to make a few observations about some of the First Amendment issues raised by intellectual property law, especially in light of some recent doctrinal developments: the Court's decision about copyright in *Eldred v. Ashcroft*,<sup>18</sup> the Court's evolving commercial speech jurisprudence in cases such as *44 Liquormart, Inc. v. Rhode Island*,<sup>19</sup> which is relevant to trademark dilution law; and the Court's decision in *Bartnicki v. Vopper*,<sup>20</sup> which indirectly bears on trade secret law. (A separate Article in the next issue of this journal discusses the right of publicity and the First Amendment in light of the California Supreme Court's recent decision in *Comedy III*

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experience as a drunken rendezvous with his mother).

16. See, e.g., Richard Delgado & Jean Stefancic, *Ten Arguments Against Hate-Speech Regulation: How Valid?*, 23 N. KY. L. REV. 475, 484 (1996).

Powerful actors like government agencies, the writers' lobby, industries, and so on have always been successful at coining free speech "exceptions" to suit their interest—copyright, false advertising, words of threat, defamation, libel, plagiarism, words of monopoly, and many others. But the strength of the interest behind these exceptions seems no less than that of a black undergraduate subjected to vicious abuse while walking late at night on campus.

*Id.*; see also Richard Delgado & David H. Yun, *Pressure Valves and Bloodied Chickens: An Analysis of Paternalistic Objections to Hate Speech Regulation*, 82 CAL. L. REV. 871, 892 (1994) ("Perhaps . . . in twenty or fifty years we will look upon hate speech rules with the same equanimity with which we now view defamation, forgery, obscenity, copyright, and dozens of other exceptions to the free speech principle, and wonder why in the late twentieth century we resisted them so strongly."); Martin E. Lee, *Free Speech in Mortal Joust with Hate Speech*, NAT'L CATH. REP., Oct. 4, 1996, at 17 (reviewing *THE PRICE WE PAY: THE CASE AGAINST RACIST SPEECH, HATE PROPAGANDA AND PORNOGRAPHY* (Laura Lederer & Richard Delgado eds., 1995)).

Noting routine exceptions to free speech absolutism (copyright, trademark and such) that hew to business interests, the essays cite studies that document the heavy toll inflicted by the multibillion dollar porn industry, as it profits from a kind of hate speech that degrades women and children.

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This book provides a sober rejoinder to cliché-ridden thinking by highlighting the profound power imbalance and social inequities that dim the luster of the First Amendment.

*Id.*

17. See Rebecca Tushnet, *Copyright as a Model for Free Speech Law: What Copyright Has in Common with Anti-Pornography Laws, Campaign Finance Reform, and Telecommunications Regulation*, 42 B.C. L. REV. 1, 60–63 (2000) (drawing such an analogy).

18. 123 S. Ct. 769 (2003).

19. 517 U.S. 484 (1996).

20. 532 U.S. 514 (2001).

*Productions, Inc. v. Gary Saderup, Inc.*)<sup>21</sup> I won't try to broadly cover all aspects of the tension between the First Amendment and intellectual property law, since so much of this has already been discussed by many other commentators.<sup>22</sup> Rather, I hope to focus on some areas that deserve some more attention than they have been getting.

## II. INTELLECTUAL PROPERTY RULES GENERALLY

### A. *Copyright, Trademark, and the Right of Publicity Are Not Content-Neutral "Time, Place, or Manner Restrictions"*

Intellectual property rules, some have argued, are merely content-neutral time, place, or manner restrictions, subject to the *United States v. O'Brien*<sup>23</sup>/*Ward v. Rock Against Racism*<sup>24</sup> intermediate standard of review.<sup>25</sup> Even some commentators who support meaningful First Amendment review in this area contend that the restrictions are content-neutral;<sup>26</sup> and even the *Eldred v. Ashcroft* petitioners' briefs took the same view, at least for the sake of argument.<sup>27</sup> This, I think, is not quite right.

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21. See Eugene Volokh, *Freedom of Speech and the Right of Publicity*, 40 HOUS. L. REV. (forthcoming 2003).

22. See, e.g., Benkler, *supra* note 8; Neil Weinstock Netanel, *Locating Copyright Within the First Amendment Skein*, 54 STAN. L. REV. 1 (2001); Jed Rubenfeld, *The Freedom of Imagination: Copyright's Constitutionality*, 112 YALE L.J. (2002); Alfred C. Yen, Eldred, *The First Amendment, and Aggressive Copyright Claims*, 40 HOUS. L. REV. 673 (2003); Diane Leenheer Zimmerman, *Fitting Publicity Rights into Intellectual Property and Free Speech Theory: Sam, You Made the Pants Too Long!*, 10 DEPAUL-LCA J. ART & ENT. L. 283 (2000).

23. 391 U.S. 367 (1968).

24. 491 U.S. 781 (1989).

25. See, e.g., *Dr. Seuss Enters. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1403 n.11 (9th Cir. 1997) ("The prohibition of the Lanham Act is content neutral, and therefore does not arouse the fears that trigger the application of constitutional 'prior restraint' principles." (quoting *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979))).

26. See, e.g., Yochai Benkler, *Constitutional Bounds of Database Protection: The Role of Judicial Review in the Creation and Definition of Private Rights in Information*, 15 BERKELEY TECH. L.J. 535, 588 (2000); Erwin Chemerinsky, *Balancing Copyright Protections and Freedom of Speech: Why the Copyright Extension Act Is Unconstitutional*, 36 LOY. L.A. L. REV. 83, 93 (2002); Stephen Fraser, *The Conflict Between the First Amendment and Copyright Law and Its Impact on the Internet*, 16 CARDOZO ARTS & ENT. L.J. 1, 10 (1998); Netanel, *supra* note 22, at 47-54; Paul Tager Lehr, Note, *The Fair Use Doctrine Before and After "Pretty Woman's" Unworkable Framework: The Adjustable Tool for Censoring Distasteful Parody*, 46 FLA. L. REV. 443, 461 (1994).

27. See Petitioners' Brief at 37, *Eldred v. Ashcroft*, 123 S. Ct. 769 (2003) (No. 01-618) ("To be sure, copyright law is content-neutral speech regulation, for its sole purpose is to provide an economic incentive for authors to produce 'original' work, without regard to the content of the material protected, the viewpoint of the author, or the subject matter of the speech.").

### 1. Content-Based Speech Restrictions

a. Defining Restricted Speech Based on Content. First, while intellectual property speech restrictions are generally *viewpoint*-neutral, they define the behavior they prohibit based on its content.<sup>28</sup> Bans on using profanity on jackets<sup>29</sup> and bans on using people's names or likenesses on commercially distributed jackets are equally content-based. Bans on false and defamatory statements about people<sup>30</sup> and bans on false and confusing commercial statements about products are equally content-based. (Trademark confusion law is generally constitutional, but the question here is whether the law is content-based, not whether it fits within an exception to protection.) Copyright law might be a bit tougher, but even there a publisher is free to publish a wide range of speech, unless the *content* of the speech is substantially similar to the content of already-produced speech (and some other elements are satisfied).<sup>31</sup> Likewise

28. See, e.g., *Burson v. Freeman*, 504 U.S. 191, 198 (1992) (plurality opinion) (holding that content-based restrictions, even viewpoint-neutral ones, must be subjected to strict scrutiny); *Boos v. Barry*, 485 U.S. 312, 321 (1988) (same); *Ark. Writers' Project, Inc. v. Ragland*, 481 U.S. 221, 230 (1987) (same); *Consol. Edison Co. of N.Y., Inc. v. Pub. Serv. Comm'n*, 447 U.S. 530, 537–38, 540 (1980) (same); *Carey v. Brown*, 447 U.S. 455, 462 n.6 (1980) (same).

29. See *Cohen v. California*, 403 U.S. 15, 26 (1971) (striking down a ban on public profanity, and treating it as content-based).

30. See *R.A.V. v. City of St. Paul*, 505 U.S. 377, 383–84 (1992) (describing libel law as content-based).

31. Netanel, *supra* note 22, at 51 & n.202, argues that the Court should treat such restrictions—or at least copyright law—as content-neutral, citing *Hill v. Colorado*, 530 U.S. 703, 719–25 (2000), *Bartnicki v. Vopper*, 532 U.S. 514, 526 (2001), *Regan v. Time, Inc.*, 468 U.S. 641 (1984), and *San Francisco Arts & Athletics, Inc. v. United States Olympic Committee*, 483 U.S. 522 (1987). While I think the Netanel article is generally excellent, I think it's mistaken on the content-neutrality issue. *Hill* does say the following, in the course of holding that a restriction on “oral protest, education, or counseling” is content-neutral:

It is common in the law to examine the content of a communication to determine the speaker's purpose. Whether a particular statement constitutes a threat, blackmail, an agreement to fix prices, a copyright violation, a public offering of securities, or an offer to sell goods often depends on the precise content of the statement. We have never held, or suggested, that it is improper to look at the content of an oral or written statement in order to determine whether a rule of law applies to a course of conduct.

530 U.S. at 721. This, though, can't be read as treating copyright law as content-neutral, because the laws referred to in other examples are clearly content-based. See, e.g., *Virginia v. Black*, 123 S. Ct. 1536, 1547–48 (2003) (treating bans on threats as content-based, though often still constitutional because they fit within an exception to protection akin to those for incitement, fighting words, and such); *R.A.V. v. City of St. Paul*, 505 U.S. 377, 387–88 (1992) (same); *City of Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410, 429 (1993) (treating restrictions on commercial speech, which would presumably include speech such as public offerings of securities or offers to sell goods, as content-based). As

with the prohibition on third-party dissemination of unlawfully leaked trade secrets.<sup>32</sup>

The strongest argument for treating some of these laws as content-neutral (setting aside the content-based defenses that subsection (b) of Part II.A.1 mentions) comes from the *City of*

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the dissent in *Hill* pointed out, these laws are constitutional not because they are content-neutral, but because “[s]peech of a certain content is constitutionally proscribable.” 530 U.S. at 746 (Scalia, J., dissenting). (To its credit, the Netanel article does say that *Hill* rests on somewhat “shak[y] reasoning.” Netanel, *supra* note 22, at 51 n.202.)

*Bartnicki* is even more opaque. It begins by describing 18 U.S.C. § 2511(1)(c), which bans people from disclosing intercepted cell phone communications when they know or have reason to know that the communications were illegally intercepted, as “a content-neutral law of general applicability.” 532 U.S. at 526. Two paragraphs later, however, it says that, “[o]n the other hand, the naked prohibition against disclosures”—part of that very same § 2511(1)(c)—“is fairly characterized as a regulation of pure speech” and “not a regulation of conduct,” *id.* at 526–27; and then, in footnote 11, it favorably quotes a lower court dissenting opinion that says, “What . . . is being punished . . . here is not conduct dependent upon the nature or origin of the tapes; it is speech dependent upon the nature of the contents,” *id.* at 527 n.11 (alterations in original). Moreover, the Court then goes on to apply what seems to be a fairly strict form of scrutiny, rather than the *United States v. O’Brien/Ward v. Rock Against Racism* scrutiny applicable to content-neutral restrictions (though perhaps this is because, as the next subsection of this Essay suggests, the scrutiny for content-based restrictions is pretty much the same as the scrutiny for content-neutral restrictions that, like the law in *Bartnicki*, don’t leave open ample alternative channels for expressing one’s message). It’s not clear, therefore, just what *Bartnicki* was saying about content neutrality.

Perhaps part of the problem is that both *Hill* and *Bartnicki* were written by Justice Stevens, the one Supreme Court Justice who has most criticized the Court’s emphasis on whether a law is content-based or content-neutral. *See, e.g., R.A.V.*, 505 U.S. at 426–28 (Stevens, J., concurring in the judgment); *Widmar v. Vincent*, 454 U.S. 263, 277–80 (1981) (Stevens, J., concurring in the judgment); *Consol. Edison Co. of N.Y., Inc. v. Pub. Serv. Comm’n*, 447 U.S. 530, 544–45 (1980) (Stevens, J., concurring in the judgment). Naturally, this doesn’t affect the precedential value of the Court’s holdings in these cases, but it does help explain why the Court’s discussion of the content discrimination question is so vague as to not really provide much of a holding at all on that subject.

*Time, Inc. v. Regan* strikes me as generally inapposite here (except insofar as it held the law content-based because of the exceptions that it contained, see text accompanying notes 45–48 *infra*; Netanel, *supra* note 22, at 51 n.205). The Court did treat limitations on the color and size of reproductions of currency as content-neutral, but this says little about the status of laws that turn on which words a particular work uses. *San Francisco Arts & Athletics* was, I think, mistaken in applying *O’Brien* scrutiny to the restriction on commercial use of the word “Olympic”; but in any event this judgment is explicable—and reconcilable with *Cohen v. California*, 403 U.S. 15 (1971), which held that restrictions on use of particular words are presumptively unconstitutional, because they may interfere with the communication of ideas—only because the case involved commercial speech, where the normal constraints on content-based speech restrictions are relaxed. Refer to note 69 and Part IV *infra*.

32. Refer to Part IV.A *infra* (discussing the problem of third-party publishers in trade secret law). *Compare* *State ex rel. Sports Mgmt. News, Inc. v. Nachtigal*, 921 P.2d 1304, 1308 (Or. 1996) (holding that this prohibition is content-based), *with* *DVD Copy Control Ass’n v. Bunner*, 75 P.3d 1, 11 (Cal. 2003) (holding that this prohibition is content-neutral).

*Renton v. Playtime Theatres, Inc.* line of cases.<sup>33</sup> Those decisions have indeed viewed certain facially content-based laws as content-neutral, on the theory that the laws were aimed at the “secondary effects” of speech—such as the crime or decreased property values caused by adult bookstores and theaters—rather than at the primary effects, such as the potential that the speech will offend or persuade and the harms that flow from this potential.<sup>34</sup>

The *Renton* test has been heavily, and I think aptly, criticized.<sup>35</sup> Part of the problem is that there is no clear rule explaining which effects of speech qualify as “primary” and which qualify as “secondary.”<sup>36</sup> Whenever a law considers the content of speech in determining whether the speech should be punished, the law must be doing so because speech with certain kinds of content has certain effects: It may attract the people who are inclined to patronize prostitutes, offend would-be neighbors, deceive readers, reveal third parties’ secrets, or lead consumers not to buy a copyright owner’s work. Whether these effects are primary or secondary is, absent a precedent that’s pretty squarely on point, a subjective and likely indeterminate inquiry.

It seems to me that if your book is substantially similar to my earlier book, then the tendency of your book to diminish the market for my book—caused by people’s lack of interest in reading the same content a second time—is a primary effect of your book’s content being similar to mine; and if this is so, then

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33. See *City of Los Angeles v. Alameda Books, Inc.*, 535 U.S. 425 (2002) (plurality opinion); *City of Erie v. Pap’s A.M.*, 529 U.S. 277 (2000); *City of Renton v. Playtime Theatres, Inc.*, 475 U.S. 41 (1986).

34. See, e.g., *Reno v. ACLU*, 521 U.S. 844, 868 (1997) (holding that the harm that allegedly flows from children’s exposure to sexually themed speech is not a secondary effect that justifies content-based restrictions on speech); *R.A.V.*, 505 U.S. at 394 (holding that “listeners’ reactions to speech are not the type of ‘secondary effects’ we referred to in *Renton*” (internal quotations omitted)); *Forsyth County v. Nationalist Movement*, 505 U.S. 123, 134 (1992) (holding that the risk that listeners will react violently to certain kinds of speech “is not a content-neutral basis for regulation”); *Boos v. Barry*, 485 U.S. 312, 321 (1988) (plurality opinion) (same as to the risk that listeners may be offended); *id.* at 334 (Brennan, J., concurring in part and concurring in the judgment) (same).

35. See *Boos*, 485 U.S. at 334–38 (Brennan, J., concurring in part and concurring in the judgment).

36. See, e.g., Robert Post, *Recuperating First Amendment Doctrine*, 47 STAN. L. REV. 1249, 1267 (1995).

[T]he Court has so far failed to articulate any substantive First Amendment theory to guide its distinction between primary and secondary effects. The Court has produced only particular judgments, more or less convincing on their own facts. This failure of First Amendment principle not only fundamentally impairs the usefulness of secondary effects doctrine, it also poses serious dangers for freedom of speech.

*Id.*

the law is content-based even given *Renton*. But because of the vagueness of the *Renton* doctrine, a court might indeed hold that this effect is a secondary effect, which would make the law content-neutral. It's impossible to tell for sure.

This vagueness, and the potential that the *Renton* doctrine can therefore be misused to justify a wide range of content-based restrictions,<sup>37</sup> makes it fortunate that the Court has used *Renton* to uphold laws only in the limited area of zoning of adult businesses.<sup>38</sup> And while I think the *Renton* doctrine is questionable even there, I hope courts do not extend it more broadly.

b. Defining Exceptions Based on Content. But in any event, whether or not intellectual property laws are content-based simply on the grounds given above, the exceptions to those laws—the fair use exception to copyright law,<sup>39</sup> the similar exception to trademark dilution law,<sup>40</sup> the news/fiction/entertainment exception to right of publicity law,<sup>41</sup> and the substantial public concern exception to trade secret law<sup>42</sup>—would make the laws content-based.

The Court has repeatedly held that a law's content-based exceptions make the law itself content-based, even when the main thrust of the law is unrelated to content. Thus, a ban on picketing becomes content-based if it excludes labor picketing.<sup>43</sup> Likewise, a ban on billboards is made content-based by its exclusion of certain commercial and noncommercial billboards.<sup>44</sup>

Most closely on point, though, is *Regan v. Time, Inc.*,<sup>45</sup> which held that a ban on photographic reproductions of currency was content-based because it contained an exception "for philatelic,

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37. See *Renton*, 475 U.S. at 55–58 (Brennan, J., dissenting).

38. See cases cited *supra* note 33. The Court has discussed whether the secondary effects test is applicable in other cases as well—see, for example, cases cited *supra* note 34—but in each such case, the Court held that the law's justification turned on the primary effect of speech, not its secondary effect.

39. 17 U.S.C. § 107 (2000).

40. 15 U.S.C. § 1125(c)(4)(A).

41. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47.

42. See *id.* § 40 cmt. c ("A privilege [to disclose] is likely to be recognized, for example, in connection with the disclosure of information that is relevant to public health or safety, or to the commission of a crime or tort, or to other matters of substantial public concern.")

43. See *Carey v. Brown*, 447 U.S. 455, 460–62 (1980); *Police Dep't of Chi. v. Mosley*, 408 U.S. 92, 98–99 (1972).

44. *Metromedia, Inc. v. City of San Diego*, 453 U.S. 490, 512–17 (1981) (plurality opinion).

45. 468 U.S. 641 (1984).

numismatic, educational, historical, or newsworthy purposes.”<sup>46</sup> “A determination concerning the newsworthiness or educational value of a photograph cannot help but be based on the content of the photograph and the message it delivers. . . . The permissibility of the photograph is therefore often ‘dependent solely on the nature of the message being conveyed.’”<sup>47</sup> I see no way in which the fair use “purpose and character” test, or the analogous tests in the exceptions to other intellectual property laws, can be meaningfully distinguished.<sup>48</sup>

Nor does it matter that intellectual property laws don’t seem to be animated by a desire to suppress certain viewpoints. The law in *Regan* was viewpoint-neutral, too; and the Court has repeatedly stressed that exacting scrutiny is required not just of *viewpoint*-based restrictions, but of content-based ones as well.<sup>49</sup> Likewise, the *Metromedia, Inc. v. City of San Diego* plurality held that a billboard ban excluding, among other things, “commemorative historical plaques,” “signs depicting time, temperature, and news,” and “[t]emporary political campaign signs,” was also content-based.<sup>50</sup> And *City of Cincinnati v. Discovery Network, Inc.* held that a ban on commercial advertising was content-based because it distinguished commercial speech from other speech:

The city contends that its regulation of newsracks qualifies as such a [content-neutral time, place, or manner] restriction because the interests in safety and esthetics that it serves are entirely unrelated to the content of respondents’ publications. Thus, the argument goes, the *justification* for the regulation is content neutral.

The argument is unpersuasive because the very basis for the regulation is the difference in content between ordinary newspapers and commercial speech. True, there is

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46. *Id.* at 647.

47. *Id.* at 648 (quoting *Carey*, 447 U.S. at 461 (a leading case enunciating the rules for content-based speech restrictions)).

48. See Tushnet, *supra* note 17, at 25 (making this point as well); see also *Regan*, 468 U.S. at 698 n.1 (Stevens, J., concurring in the judgment in part and dissenting in part) (likewise analogizing the exception in the currency reproduction statute to the fair use exception, though using that to argue against the majority’s conclusion that the “newsworthy purposes” exception made the law content-based).

49. Refer to note 28 *supra*.

50. 453 U.S. 490, 494–95, 515–16 (1981) (plurality opinion) (alteration in original). The plurality stressed that there was discrimination even within the category of “noncommercial messages”—“Because some noncommercial messages may be conveyed on billboards . . . San Diego must similarly allow billboards conveying other noncommercial messages . . .,” *id.* at 515—so I quote in the text the main exclusions of noncommercial messages.

no evidence that the city has acted with animus toward the ideas contained within respondents' publications, but just last Term we expressly rejected the argument that "discriminatory . . . treatment is suspect under the First Amendment only when the legislature intends to suppress certain ideas." Regardless of the *mens rea* of the city, it has enacted a sweeping ban on the use of newsracks that distribute "commercial handbills," but not "newspapers." Under the city's newsrack policy, whether any particular newsrack falls within the ban is determined by the content of the publication resting inside that newsrack. Thus, by any commonsense understanding of the term, the ban in this case is "content based."

Nor are we persuaded that our statements that the test for whether a regulation is content based turns on the "justification" for the regulation compel a different conclusion. We agree with the city that its desire to limit the total number of newsracks is "justified" by its interests in safety and esthetics. The city has not, however, limited the number of newsracks; it has limited (to zero) the number of newsracks *distributing commercial publications*. As we have explained, there is no justification for that particular regulation other than the city's naked assertion that commercial speech has "low value." It is the absence of a neutral justification for its selective ban on newsracks that prevents the city from defending its newsrack policy as content neutral.<sup>51</sup>

So different treatment for commercial speech, justified by an "assertion that commercial speech has 'low value,'" makes a law content-based. Therefore, different treatment for news, parody, and commentary, justified by an assertion that it's especially high in value, likewise makes copyright law content-based.<sup>52</sup>

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51. 507 U.S. 410, 429–30 (1993) (citations omitted) (alteration in original).

52. Netanel, *supra* note 22, at 49 n.197, argues that the fair use doctrine shouldn't be seen as making copyright law content-based, because "First Amendment law itself accords greater protection to certain types of speech, and the hierarchy suggested in Section 107 more or less tracks that found in First Amendment jurisprudence." This, though, seems to contradict the holding in *Regan*. (The article cites Justice Stevens's opinion in *Regan*, which dissented on this issue, as support for its proposition.) It contradicts the holding in *Discovery Network* that even classifications that echo the Court's judgments of what's higher value speech are content-based. 507 U.S. at 428–31. And it also seems to me to be mistaken in its assertion about the existing First Amendment hierarchy: First Amendment law does *not* generally prefer news reporting to fiction, or parody to satire. *See, e.g.*, *Miller v. California*, 413 U.S. 15, 22–23, 26 (1973) (holding that serious literary or artistic value provides as much immunity from obscenity law as does serious political value); *Winters v. New York*, 333 U.S. 507, 510 (1948) (holding that entertainment is just as protected as political advocacy).

More broadly, the Supreme Court has routinely applied something much like strict scrutiny to laws that don't seem animated by any legislative desire to suppress disfavored viewpoints or subject matters. *Regan* and *Metromedia* are two examples, but the same is true of *Hustler Magazine v. Falwell*,<sup>53</sup> *NAACP v. Claiborne Hardware Co.*,<sup>54</sup> *United Mine Workers v. Pennington*,<sup>55</sup> and *Eastern Railroad Presidents Conference v. Noerr Motor Freight, Inc.*<sup>56</sup> Each of the latter four cases involved a legal rule that, unlike the intellectual property laws mentioned here, didn't even single out speech for special punishment: the tort of intentional infliction of emotional distress (*Hustler*), the tort of interference with business relations (*Claiborne*), and antitrust law (*Pennington* and *Noerr*). But in each case the legal rule was applied based on the content of speech—it was the content of the speech that inflicted emotional distress, that interfered with business relations, or that aimed to create anticompetitive effects by petitioning the government to enact anticompetitive rules. And each case held that applying the legal rule to speech based on this content was unconstitutional. None of these cases specifically called the rules content-based in their application; but they certainly applied a much more demanding form of scrutiny than the *O'Brien/Ward v. Rock Against Racism* intermediate scrutiny.

c. Leaving Room for Viewpoint- and Subject-Matter-Based Application. Now it may be that this sort of extreme skepticism of laws that discriminate based on content—even when the discrimination may seem like a worthy preference for “newsworth[y] or educational” uses—is excessive; maybe the Court ought to retreat from *Regan* and *Discovery Network*. But I think there is indeed good reason for the Court to be skeptical even of such seemingly benign content classifications.

Applying these classifications requires judges and juries to make further content-based decisions of their own: whether speech is “newsworth[y],”<sup>57</sup> whether it’s “outrageous,”<sup>58</sup> whether it “tarnish[es]” a trademark by “us[ing it] in an unwholesome context,”<sup>59</sup> whether it uses a trademark or a name in a way that

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53. 485 U.S. 46 (1988).

54. 458 U.S. 886 (1982).

55. 381 U.S. 657 (1965).

56. 365 U.S. 127 (1961).

57. *Regan v. Time, Inc.*, 468 U.S. 641, 648 (1984).

58. *Hustler*, 485 U.S. at 55.

59. *Jordache Enters., Inc. v. Hogg Wyld, Ltd.*, 828 F.2d 1482, 1490 (10th Cir. 1987).

has “artistic relevance” to its message,<sup>60</sup> whether it copies more than it really needs to copy,<sup>61</sup> whether it is parody that mocks the original rather than satire that mocks society,<sup>62</sup> and so on. These decisions often leave factfinders with considerable discretion in judging speech based on what it says, and it’s easy for the factfinders to exercise that discretion in ways that are viewpoint-based or subject-matter-based.<sup>63</sup>

It’s impossible to tell for sure whether such discrimination has taken place, for instance in cases such as: *Walt Disney Productions v. The Air Pirates*, which rejected a fair use defense for counterculture comics that placed beloved childhood icons in sex- and drug-related contexts;<sup>64</sup> *MCA, Inc. v. Wilson*, which rejected a fair use defense for sexually themed lyrics;<sup>65</sup> *Parks v. LaFace Records*, which held that a song full of rap braggadocio may violate trademark law and the right of publicity because it used Rosa Parks’s name as its title;<sup>66</sup> or *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, which held that a pornographic movie (which the court called “sexually depraved”) violated the trademark in the Dallas Cowboys Cheerleaders uniform, though it seems unlikely that viewers would really think the Cowboys were endorsing the film.<sup>67</sup> Nonetheless, it’s clear that the tests invite judges and juries to evaluate the content of the speech, and that the vagueness of the rules may cause even well-intentioned factfinders to be subconsciously swayed by the viewpoint and subject matter of the speech.

Perhaps if intellectual property rules were clearer, and thus prevented viewpoint and subject matter discrimination in their application, courts could properly ignore the content discrimination that the rules require, and treat the rules as content-neutral because of their viewpoint neutrality and subject matter neutrality. Given, however, that the rules are facially content-based and leave judges and juries with broad latitude to evaluate the content of the speech, it seems to me that they should be treated like normal content-based speech restrictions are treated.

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60. *Parks v. Laface Records*, 329 F.3d 437, 451, 452–58 (6th Cir. 2003).

61. *See Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 586–89 (1994).

62. *See id.* at 580–81; *Dr. Seuss Enters. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1400 (9th Cir. 1997).

63. *See Jessica Litman, Reforming Information Law in Copyright's Image*, 22 U. DAYTON L. REV. 587, 611–13 (1997) (raising this concern as to fair use).

64. 581 F.2d 751, 754, 758 (9th Cir. 1978).

65. 677 F.2d 180, 182, 185 (2d Cir. 1981).

66. 329 F.3d 437, 459 (6th Cir. 2003).

67. 604 F.2d 200, 205 (2d Cir. 1979).

2. *Lack of Ample Alternative Channels.* But even if courts conclude that intellectual property rules should be treated as content-neutral, those rules still can't be defended under the more forgiving intermediate scrutiny applicable to content-neutral time, place, or manner restrictions.

The time/place/manner restriction doctrine gives a First Amendment break to content-neutral speech restrictions only if they are narrowly tailored (under a fairly relaxed standard) to a substantial government interest, *and leave open ample alternative channels* for the speaker to convey the speech that he wants to convey. It is only because the restrictions leave open ample alternative channels that they are seen as relatively minor burdens on speech, and are thus easier for the government to defend.<sup>68</sup>

Intellectual property laws do not satisfy the ample alternative channels requirement, because they broadly ban the expression of certain words, rather than just channeling the expression away from certain times, places, or modes of expression.<sup>69</sup> (At the very least, the laws bar you from charging money for your expression, which the Supreme Court has recognized is tantamount for First Amendment purposes to barring the expression itself.)<sup>70</sup> If your words infringe my copyright, trademark, right of publicity, or trade secret, you are given no alternative channel to communicate them.

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68. See, e.g., *City of Ladue v. Gilleo*, 512 U.S. 43, 55–56 (1994); *Schad v. Borough of Mt. Ephraim*, 452 U.S. 61, 75–76 (1981); Alan Brownstein, *How Rights Are Infringed: The Role of Undue Burden Analysis in Constitutional Doctrine*, 45 HASTINGS L.J. 867, 952 (1994).

69. The doctrine's stress on *content-neutral* time, place, and manner exceptions shows that "manner" refers not to the content, but to the content-independent aspects of the speech, such as noise or medium. E.g., *Metromedia, Inc. v. City of San Diego*, 453 U.S. 490, 516–17 (1981) (plurality opinion) ("It is apparent as well that the ordinance distinguishes in several ways between permissible and impermissible signs at a particular location by reference to their content. Whether or not these distinctions are themselves constitutional, they take the regulation out of the domain of time, place, and manner restrictions. A law that bars people from using certain words is thus not a content-neutral manner restriction."); *Papish v. Board of Curators*, 410 U.S. 667, 670 (1973) (describing the expulsion of a student who used a vulgarity in a newspaper cartoon as being based on "the disapproved content of the newspaper rather than the time, place, or manner of its distribution"). The only case I've seen that suggests that content-based restrictions may be justified as "manner" restrictions is *San Francisco Arts & Athletics, Inc. v. United States Olympic Committee*, 483 U.S. 522, 536 (1987), which says that by restricting the use of the word "Olympic," a federal law "restricts only the manner in which the SFAA may convey its message." But this was in the middle of a discussion that stressed that the law applied overwhelmingly to *commercial advertising*, which is considerably less protected against content-based restrictions than is other speech. Refer to Part IV *infra*.

70. *Simon & Schuster, Inc. v. Members of the N.Y. State Crime Victims Bd.*, 502 U.S. 105, 115–16 (1991).

Nor is it enough that you may remain free to communicate your idea using other words. As the Court concluded in *City of Ladue v. Gilleo*, alternative channels are inadequate even when they let the speaker use exactly the same words, if the change of medium materially changes the message. *Ladue* held that a ban on posting signs on one's home failed to leave open ample alternative channels, because the alternative—posting a sign elsewhere—wouldn't communicate the same message: "Displaying a sign from one's own residence," the Court held, "often carries a message quite distinct from placing the same sign someplace else, or conveying the same text or picture by other means."<sup>71</sup>

A law that forces you to convey your idea using *different* text will even more surely make you use words that "carr[y] a message quite distinct from" what you wanted to communicate: In the Court's words, "We cannot indulge the facile assumption that one can forbid particular words without also running a substantial risk of suppressing ideas in the process."<sup>72</sup> Intellectual property laws thus go beyond the scope of content-neutral time, place, and manner restrictions, because they don't leave speakers adequate alternative channels to "convey[] the same text."<sup>73</sup> They are therefore justifiable only if they fit within one of the First Amendment exceptions or if they pass strict scrutiny.

3. *The Proper Approach.* So whether intellectual property speech restrictions are treated as content-based laws, or as content-neutral ones that fail to leave open ample alternative channels, the result is the same. The restrictions are presumptively unconstitutional, unless they fit within an exception to protection—or a zone of diminished protection, as with commercial advertising—or satisfy strict scrutiny.<sup>74</sup>

And this makes sense: Unlike restrictions on soundtracks or on the timing of demonstrations, and unlike the law of real property, intellectual property speech restrictions bar people from saying what they want to say, any time and in any place.<sup>75</sup> They may still be justifiable, but it should take a quite considerable justification to do so.

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71. *Ladue*, 512 U.S. at 56.

72. *Cohen v. California*, 403 U.S. 15, 26 (1971).

73. *Hill v. Colorado*, 530 U.S. 703, 786 (2000) (Kennedy, J., dissenting).

74. *United States v. Grace*, 461 U.S. 171, 177 (1983).

75. See Mark Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 DUKE L.J. 147, 184 (1998).

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FREEDOM OF SPEECH AND I/P

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## III. COPYRIGHT AND THE COPYRIGHT EXCEPTION

A. *Introduction: The Copyright Exception*

Copyright law does have a considerable justification: the text and the original meaning of the Copyright Clause, which expresses the Framers' view that copyright law is needed to stimulate the creation of new works. Whether or not one agrees with this economic theory or believes that this theory suffices to justify speech restrictions, the Framers apparently believed this, and embodied this belief in the Constitution.

The Supreme Court in *Eldred v. Ashcroft* and *Harper & Row, Publishers, Inc. v. Nation Enterprises*<sup>76</sup> relied on the Copyright Clause to uphold the constitutionality of copyright law; and though this conclusion could in some measure be assailed,<sup>77</sup> I mostly won't try to challenge it here. These cases essentially create what we might call a copyright exception to the First Amendment, an exception that validates copyright law just like the obscenity and libel exceptions validate obscenity and libel laws. *Eldred* is thus important partly because it reinforced both the judgment that copyright law is a speech restriction, and the conclusion that there's a copyright exception that justifies copyright law.

The Court didn't make the boundaries of this exception explicit, but the Court's argument strongly suggests two such boundaries:

(1) *The copyright exception immunizes only laws that protect creative expression rather than facts or ideas.* We see this from *Eldred's* stress that copyright law doesn't block people from copying "idea[s], theor[ies], and fact[s]," and that "[p]rotection of [creative expression] does not raise the free speech concerns present when the government compels or burdens the communication of particular facts or ideas."<sup>78</sup> And we see it likewise from *Harper & Row*: The Court there says that "copyright's idea/expression dichotomy 'strike[s] a definitional balance between the First Amendment and the Copyright Act by permitting free communication of facts while still protecting an

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76. 471 U.S. 539 (1985).

77. For instance, one can argue that the Copyright Clause doesn't sufficiently justify modern copyright law's restriction on the communication of derivative works, given that early copyright law generally seemed to be mostly limited to literal or near-literal reproductions.

78. *Eldred v. Ashcroft*, 123 S. Ct. 769, 789 (2003).

author's expression."<sup>79</sup> *Harper & Row* stresses that "[n]o author may copyright his ideas or the facts he narrates," and that under copyright law people "possess[] an unfettered right to use any factual information revealed in [the original]," though they may not copy creative expression.<sup>80</sup> It says that "[w]e do not suggest this right not to speak would sanction abuse of the copyright owner's monopoly as an instrument to suppress facts."<sup>81</sup> And it concludes that, "[i]n view of the First Amendment protections already embodied in the Copyright Act's distinction between copyrightable expression and uncopyrightable facts and ideas," copyright law is constitutional.<sup>82</sup>

(2) *The copyright exception immunizes only those laws that provide enough protection for at least certain kinds of uses of expression.* This is visible in *Eldred's* defending copyright law both by pointing out that "[t]he fair use defense affords considerable latitude for scholarship and comment, and even for parody," because the defense "allows the public to use not only facts and ideas contained in a copyrighted work, but also expression itself in certain circumstances,"<sup>83</sup> and in *Harper & Row's* describing "the latitude for scholarship and comment traditionally afforded by fair use" as a "First Amendment protection[]."<sup>84</sup>

Thus, speech that copies expression, and that isn't within the zone of constitutionally protected fair use, may constitutionally be constrained by copyright law. Speech that copies ideas or facts, or that is a fair use, is constitutionally protected.

*B. The Copyright Exception, Contributory Copyright Infringement, and First Amendment Protection for Facts*

Because *Eldred* and *Harper & Row* defend copyright law by stressing that it doesn't restrict communication of facts, laws that do restrict the communication of facts aren't supported by the copyright exception. If database protection laws,<sup>85</sup>

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79. *Harper & Row*, 471 U.S. at 556 (quoting *Harper & Row, Publishers, Inc. v. Nation Enters.*, 723 F.2d 195, 203 (1983)) (alteration in original).

80. *Id.* at 556, 557–58 (quotation marks omitted).

81. *Id.* at 559.

82. *Id.* at 560.

83. *Eldred*, 123 S. Ct. at 789 (quotation marks and citations omitted).

84. *Harper & Row*, 471 U.S. at 560.

85. See Benkler, *supra* note 8, at 440–46 (criticizing such proposals); Malla Pollack, *The Right To Know?: Delimiting Database Protection at the Juncture of the Commerce Clause, the Intellectual Property Clause, and the First Amendment*, 17 CARDOZO ARTS & ENT. L.J. 47 (1999) (same).

misappropriation rules that secure rights in “hot news,”<sup>86</sup> and rules that aim to give people a property right in personal information about themselves<sup>87</sup> are justified, they must be justified on some grounds other than an analogy to copyright.

The same applies to the few circumstances where copyright law itself restricts the publication of facts. Consider these scenarios:

- A newspaper publishes a story about a store that sells some infringing material. The story mentions the store’s name and address.
- A newspaper publishes a story about a Web site that distributes infringing material. The story mentions the site’s URL.<sup>88</sup>
- A Web site—an online newspaper, a Web log, or some other sort of Web page—does the same, perhaps providing a clickable link to the infringing site.<sup>89</sup>
- A computer security expert publishes an article, in print or on a Web page, that discusses flaws in a copy protection scheme. The article demonstrates this by showing the source code that would bypass the protection.
- A print or Web publication provides the URL at which the security expert’s article is located, or provides a clickable link to it.<sup>90</sup>

In the first three cases, the speaker’s publication of facts—whether a street address or a Web site address—may be contributory copyright infringement: The publication materially

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86. *Cf.* *Int’l News Serv. v. Associated Press*, 248 U.S. 215 (1918) (adopting such a rule); *NBA v. Motorola, Inc.*, 105 F.3d 841 (2d Cir. 1997) (discussing the misappropriation tort but not reaching the First Amendment question); *see also* Richard A. Posner, *Misappropriation: A Dirge*, 40 HOUS. L. REV. 621 (2003) (discussing and criticizing the misappropriation tort).

87. *See* Volokh, *Freedom of Speech*, *supra* note 9, at 1063–73.

88. *See* Stacey L. Dogan, *Infringement Once Removed: The Perils of Hyperlinking to Infringing Content*, 87 IOWA L. REV. 829, 904–05 (2002) (discussing this example).

89. *Cf.* *Arista Records, Inc. v. MP3Board, Inc.*, No. 00 CIV. 4660, 2002 WL 1997918, at \*7–\*8 (S.D.N.Y. Aug. 29, 2002) (holding that a Web site could be ordered to take down such links, if it should have known that the links pointed to infringing material); *Intellectual Reserve, Inc. v. Utah Lighthouse Ministry, Inc.*, 75 F. Supp. 2d 1290, 1293–95 (D. Utah 1999) (ordering a Web site to take down links to an infringing site based on a contributory infringement theory). In *Intellectual Reserve*, the court may have been particularly angered because it had earlier ordered the defendant to take down infringing material from its site, and the defendant then replaced the material with links to an infringing site. But the court’s reasoning wasn’t limited to this situation and applies to links generally.

90. *Universal City Studios, Inc. v. Corley*, 273 F.3d 429, 455–58 (2d Cir. 2001) (holding that links to pages containing circumvention source code may be enjoined).

contributes to third parties' copyright infringement (by making it easier for consumers to find places where they can buy or download infringing material), and the speaker may well know or have reason to know of that infringement.<sup>91</sup> In the last two, the speaker's publication of facts may contribute to a violation of the Digital Millennium Copyright Act (DMCA), because it may help people "traffic in . . . technology . . . that . . . has only limited commercially significant purpose or use other than to circumvent [copy] protection."<sup>92</sup>

I think the speech in these examples should be constitutionally protected, at least in many instances, but one can argue that it should be punishable: Perhaps speech that makes it easier for people to break the law should in some situations be restricted; or perhaps at least direct linking should be restrictable, on the theory that the First Amendment doesn't protect clickable links the same way that it protects unclickable text.<sup>93</sup> These arguments, though, should be made on their own merits, applying whatever doctrine applies to cover crime-facilitating (or tort-facilitating) speech<sup>94</sup> or to clickable links. The arguments should not rely on the copyright exception, which may justify most of copyright law but cannot justify restriction on the communication of facts.<sup>95</sup>

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91. See *Fonovisa, Inc. v. Cherry Auction, Inc.*, 76 F.3d 259, 265 (9th Cir. 1996); *Arista*, 2002 WL 1997918, at \*7-\*8; *Intellectual Reserve*, 75 F. Supp. 2d at 1294-95. Dogan, *supra* note 88, at 894-95, 904-05, argues that the linker shouldn't be seen as materially contributing to the infringement "[b]ecause effective relief against the direct infringer is available." Even the Dogan article, though, would take a different view if the direct infringer couldn't be sued, perhaps because the infringer is located offshore in a "copyright haven." *Id.* at 895. In any event, the Dogan article suggests how the law ought to evolve, rather than describing what the law is right now. Under the current rules, I think someone providing a link would indeed be seen as materially contributing to the infringement, because he made easier another's tortious activity.

92. 17 U.S.C. § 1201(b)(1)(B) (2000); *Corley*, 273 F.3d at 455-58 (upholding an injunction against distributing such code on one's page, and against linking to pages containing such code).

93. See *Corley*, 273 F.3d at 456 (concluding that "a hyperlink has both a speech and a nonspeech component," the latter flowing from its "functional capacity to bring the content of the linked web page to the user's computer screen").

94. Crime-facilitating speech is an interesting and largely unexplored field, which covers speech that facilitates copyright infringement, murder, making bombs, growing drugs, and a variety of other forms of misconduct; and this doctrine, whatever it may end up being, will likely have its own limitations (perhaps such as requirements that the speech be *intended* to facilitate misconduct, or other requirements that go beyond what copyright law provides). See Eugene Volokh, *Crime-Facilitating Speech* (forthcoming); cf. Dogan, *supra* note 88, at 905 n.317 (suggesting that when "the sole and deliberate function of [a person]'s links is to facilitate slavish [infringing] copying by others, . . . her links arguably constitute the type of valueless speech that falls outside the scope of First Amendment protection").

95. *But see Arista*, 2002 WL 1997918, at \*12 (dismissing defendants' First Amendment argument by concluding that "the fair use doctrine encompasses all claims of

*C. The Copyright Exception and Fair Use*

Likewise, just as copying facts falls outside the copyright exception, so does making fair uses. This in turn has three consequences.

First, as I'll mention shortly, the constitutional protection of fair uses may require certain procedural safeguards when factfinders determine whether something is a fair use.

Second, the DMCA has been interpreted as barring people from circumventing copyright protection even when they're doing so to create fair uses—for instance, parodies or reviews.<sup>96</sup> If copyright law is constitutional because it allows fair uses, then one can argue that the DMCA can't be justified under the copyright exception.<sup>97</sup>

The DMCA's anticircumvention provisions generally prohibit conduct, albeit conduct aimed at facilitating speech, rather than speech. The argument that the DMCA must allow fair uses has to assert that the First Amendment includes the right to engage in certain conduct that's necessary to get certain information (for instance, to decrypt encrypted material)—an argument that's closely related to the claims of a right to engage in news *gathering* free of various constraints on conduct and not just a right to engage in news *reporting* free of various constraints on speech. The Court has said little about this sort of claim,<sup>98</sup> but if the First Amendment does bar various interference with information gathering, then this may apply to the DMCA as well.

Third, the fair use limitation on the copyright exception should affect cases where the copyright exception is used as an analogy. For instance, if the prohibition on newspapers disseminating trade secrets that were leaked to them is justified by analogy to the copyright exception,<sup>99</sup> courts should note the limitations on the copyright exception—the right to republish facts, and the right to engage in fair use. Both of these

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first amendment in the copyright field," and citing cases that refer to *Harper & Row* and the copyright exception (quotation marks omitted); *Intellectual Reserve*, 75 F. Supp. 2d at 1295 (likewise).

96. *Corley*, 273 F.3d at 443–44.

97. *See, e.g., id.* at 458–59 (describing the defendants' arguments to this effect); Pamela Samuelson, *Intellectual Property and the Digital Economy: Why the Anti-Circumvention Regulations Need To Be Revised*, 14 BERKELEY TECH. L.J. 519, 537–43 (1999) (making such arguments).

98. *Cf. Branzburg v. Hayes*, 408 U.S. 665, 681–82 (1972) (suggesting that news gathering is entitled to some independent protection, but not giving details).

99. *Cf. DVD Copy Control Ass'n v. Bunner*, 113 Cal. Rptr. 2d 338, 349–50 (Ct. App. 2001) ("DVDCCA also relies heavily [in its trade secret lawsuit] on cases that upheld injunctions in copyright infringement cases."), *rev'd*, 75 P.3d 1 (Cal. 2003).

limitations show the *dissimilarity* between trade secret law and copyright law: Trade secret law is chiefly aimed at preventing the reproduction of facts and ideas, not of creative expression; and it doesn't appear to have a "fair use" exception that broadly lets people quote others' trade secrets when commenting on them, when criticizing the owner's behavior with regard to the trade secret, and so on.<sup>100</sup>

Note, though, one important uncertainty in applying the fair use limitation on the copyright exception: The Court has suggested that some fair uses may be constitutionally protected, but it didn't say this as to all fair uses—it spoke only of the latitude that fair use leaves "for scholarship and comment, and even for parody." It thus isn't clear whether the constitutionally mandated fair use zone would include nontransformative uses, such as literal copying that is unlikely to harm the work's value,<sup>101</sup> or only the transformative ones that the Court mentioned.

#### *D. The Copyright Exception and Procedural Rules*

The Court's First Amendment cases don't just set forth substantive rules, such as the exceptions to First Amendment protection. They also set forth procedural rules that help ensure that speech restrictions don't inadvertently suppress protected speech as well as the unprotected. Libel and obscenity, for instance, fall within exceptions to First Amendment protection; but libel and obscenity law must still comply with these "[F]irst [A]mendment due process" rules.<sup>102</sup> Likewise, speech that infringes a copyright falls within the copyright exception—but copyright law must comply with these procedural rules, too.

Coauthors of mine and I have elsewhere made this argument as to independent appellate review and as to the prior restraint doctrine.<sup>103</sup> Here, I want to briefly touch on a few other First Amendment procedural rules.

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100. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 40 cmt. c (1995) does suggest that there may be a privilege to disclose information "that is relevant to public health or safety, or to the commission of a crime or tort, or to other matters of substantial public concern," but it's not clear that this would cover routine commentary or criticism, such as a newspaper excerpting a leaked secret business plan in order to criticize a company's plans to close a plant or to market an allegedly socially harmful product.

101. See *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 447–52 (1984).

102. The phrase is from Henry P. Monaghan, *First Amendment "Due Process,"* 83 HARV. L. REV. 518, 519 (1970).

103. See Lemley & Volokh, *supra* note 75; Eugene Volokh & Brett McDonnell, *Freedom of Speech and Independent Judgment Review in Copyright Cases*, 107 YALE L.J. 2431 (1998).

1. *Burden of Proof.* Fair use is an affirmative defense;<sup>104</sup> the defendant bears the burden of proof, and in close cases this may make a difference.<sup>105</sup>

But the standard First Amendment due process rule is that the burden of proof as to constitutionally relevant matters—for instance, whether allegedly libelous speech is true or false—must be placed on those who would punish speakers, not on the speakers themselves. Placing the burden of proof on speakers, the Court has held, suffers from

[t]he vice . . . that, where particular speech falls close to the line separating the lawful and the unlawful, the possibility of mistaken factfinding—inherent in all litigation—will create the danger that the legitimate utterance will be penalized. The man who knows that he must bring forth proof and persuade another of the lawfulness of his conduct necessarily must steer far wider of the unlawful zone than if the State must bear these burdens. This is especially to be feared when the complexity of the proofs and the generality of the standards applied provide but shifting sands on which the litigant must maintain his position.<sup>106</sup>

The Court has taken this view as to a range of cases, both criminal and civil, covering alleged advocacy of fraudulent charitable fundraising, libel on matters of public concern, obscenity, and unlawful violence.<sup>107</sup> In public concern libel cases,

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104. *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 561 (1985).

105. *See Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1260 n.3 (11th Cir. 2001) (taking the view that as a matter of first principles fair use should not be seen as an affirmative defense, though conceding that the Supreme Court had held the contrary); Netanel, *supra* note 22, at 83–84 (concluding that the placement of the burden of proof on the fair use question is important, and arguing that the burden should be at least partly shifted to plaintiffs).

106. *Speiser v. Randall*, 357 U.S. 513, 526 (1958) (citation omitted).

107. *See, e.g., Illinois ex rel. Madigan v. Telemarketing Assocs.*, 123 S. Ct. 1829, 1840–41 (2003) (alleged fraudulent charitable fundraising); *Phila. Newspapers, Inc. v. Hepps*, 475 U.S. 767, 775–77 (1986) (alleged libel on matters of public concern); *Freedman v. Maryland*, 380 U.S. 51, 58 (1965) (obscenity); *Speiser*, 357 U.S. at 526 (alleged advocacy of unlawful violence); *cf. Ashcroft v. Free Speech Coalition*, 535 U.S. 234, 255 (2002) (saying that “[t]he Government raises serious constitutional difficulties by seeking to impose on the defendant the burden of proving his speech [does not fit within the child pornography exception],” but concluding that it wasn’t necessary to resolve this question in that case). The only case I’ve found that seems to hold otherwise is *FW/PBS, Inc. v. City of Dallas*, 493 U.S. 215, 229 (1990) (plurality opinion), which involved an ordinance licensing adult businesses. *FW/PBS* held that the *Freedman v. Maryland* burden of proof rule didn’t apply, chiefly because the tendency to steer wide of the unlawful zone would be unusually small: “Because the license is the key to the applicant’s obtaining and maintaining a business, there is every incentive for the applicant to pursue a license denial through court.” *Id.* at 229–30. Most copyright cases will be more similar to *Freedman*, *Hepps*, and *Speiser* than to *FW/PBS*—the allegedly infringing material will rarely be the defendant’s main line of business, so the deterrent effect mentioned by

for instance, the Court has held that states may not make truth an affirmative defense; rather, plaintiffs must bear the burden of proving falsehood.<sup>108</sup>

The same should apply in copyright cases. Unfair uses of expression are constitutionally unprotected, just like obscenity, knowingly false statements of fact, and incitement to imminent unlawful conduct are unprotected—but fair uses (at least when done for scholarship, commentary, or parody) are constitutionally protected. Thus, as the Court held for libel cases, “where the scales are in . . . an uncertain balance, . . . the Constitution requires [courts] to tip them in favor of protecting” constitutionally protected uses;<sup>109</sup> the burden of proving that defendants’ speech is unprotected, because it isn’t a fair use, must be on the plaintiff. And this is especially true because the factual evidence as to the effect on market is so often highly speculative, and the balancing of the fair use factors is so conceptually hard to do. Such vagueness makes it more likely that the evidence will indeed be in equipoise, so the burden of proof may indeed affect the result.

Nor does it matter that copyright law is itself aimed at encouraging the production of speech. Libel law, too, has been defended on the grounds that it encourages people to participate in public debate, by protecting those who enter public life from scurrilous attacks; one can also argue that it fosters the marketplace of ideas by giving readers more confidence in the accuracy of what they read.<sup>110</sup> Nonetheless, the burden of proof rules properly apply there: First Amendment procedural rules, like the First Amendment itself, aim primarily at protecting speech from government suppression, not from private deterrence.<sup>111</sup> The same is true of copyright.

Moreover, even if courts determine burden of proof rules by aggregating the free speech benefits of protecting potentially transformative fair uses and the free speech benefits of maintaining the incentive to create, the burden should still be placed on the plaintiff copyright owner, and not on the defendant

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*Speiser* will be quite strong.

108. *Hepps*, 475 U.S. at 775–77.

109. *Id.* at 776.

110. *See, e.g.*, *Gertz v. Robert Welch, Inc.*, 418 U.S. 323, 392, 400 (1974) (White, J., dissenting) (arguing that libel “may frustrate th[e] search [for truth]” and contribute to “assaults on individuality and personal dignity”); *id.* at 400 (“It is not at all inconceivable that virtually unrestrained defamatory remarks about private citizens will discourage them from speaking out and concerning themselves with social problems. This would turn the First Amendment on its head.”).

111. *See* Lemley & Volokh, *supra* note 75, at 185–86.

speaker. Many would-be commentators, critics, and parodists may be considerably deterred by the risk that they'll be erroneously held legally liable if the fair use case is close. Very few potential creators would be considerably deterred by the risk that some people will be erroneously allowed to engage in commentary, criticism, and parody when the fair use question is close. Placing the burden of proving fair use on the defendant is thus likely to deter considerably more speech than would placing the burden of proving unfair use on the plaintiff.<sup>112</sup>

This would also apply equally to other intellectual property cases, at least ones that don't involve commercial advertising. In particular, if courts conclude that the right of publicity doesn't apply to transformative uses<sup>113</sup> (which I think is the least that the First Amendment requires), then they cannot simply make transformative use into an affirmative defense.<sup>114</sup> Rather, the plaintiff would have to bear the burden of proving that the speaker's use was nontransformative.<sup>115</sup>

Nor is this analysis foreclosed by the Supreme Court's holding fair use to be an affirmative defense. This holding was a matter of statutory construction; the Court didn't indicate that it at all considered the First Amendment due process argument.<sup>116</sup> As the Supreme Court has held, "cases cannot be read as foreclosing an argument that they never dealt with."<sup>117</sup> And in fact the Court has sometimes struck down or limited laws on constitutional grounds, even when it had upheld the laws in

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112. First Amendment due process may also require that some aspects of a copyright claim be proven by clear and convincing evidence, as is the rule for actual malice in public figure libel cases. *Gertz*, 418 U.S. at 342. See also *Bose Corp. v. Consumers Union*, 466 U.S. 485, 511 (1984) (applying the same rule to product disparagement cases). Lower courts have likewise required that actual malice be proven by clear and convincing evidence in public figure, false light, and invasion of privacy cases involving public figures, see, for example, *Douglass v. Hustler Magazine, Inc.*, 769 F.2d 1128, 1140 (7th Cir. 1985), and California courts have said the same as to findings of obscenity in obscenity injunctions, see, for example, *People ex rel. Cooper v. Mitchell Bros. Santa Ana Theater*, 180 Cal. Rptr. 728, 730 (Ct. App. 1982).

113. See Volokh, *Freedom of Speech and the Right of Publicity*, *supra* note 21.

114. But see *Winter v. DC Comics*, 69 P.3d 473, 477-78 (Cal. 2003) (describing transformative use as an affirmative defense (citing *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 809 (Cal. 2001))).

115. See Volokh, *Freedom of Speech and the Right of Publicity*, *supra* note 21.

116. See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 590 (1994); *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 561 (1985); Netanel, *supra* note 22, at 22 n.85 (citing sources involved in this decision).

117. *Waters v. Churchill*, 511 U.S. 661, 678 (1994) (plurality opinion) (citing *United States v. L.A. Tucker Truck Lines, Inc.*, 344 U.S. 33, 38 (1952)); see also *Miller v. Cal. Pac. Med. Ctr.*, 991 F.2d 536, 541 (9th Cir. 1993) ("It is a venerable principle that a court isn't bound by a prior decision that failed to consider an argument or issue the later court finds persuasive.").

earlier cases where those particular constitutional claims hadn't been asserted.<sup>118</sup>

2. *Strict Liability.* The Court has also consistently held—in cases involving libel, obscenity, and child pornography—that reasonable mistake of fact must be allowed as a defense in free speech cases involving speech on matters of public concern. Strict liability as to factual errors is forbidden, even when only compensatory damages are at stake.<sup>119</sup> Copyright law, on the other hand, allows strict liability: If your newspaper or Web site publishes my submission, and it turns out that I had copied someone else's work, you may be held strictly liable for compensatory damages, and even for up to \$30,000 in statutory damages.<sup>120</sup> (The lower boundary of statutory damages is decreased to \$200 for innocent infringements, but the upper boundary stays at \$30,000 in these cases.)<sup>121</sup> And this is true even though you may have had no reasonable way to make sure that my work was original.<sup>122</sup>

Here, copyright law might be distinguishable from other restrictions, oddly enough because mistakes of fact in copyright cases—which chiefly arise when a publisher mistakenly believes that a submitted work is original, when in reality the author copied it from someone else—are so hard to avoid. The theory behind the prohibition on strict liability is that strict liability for

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118. Compare *White v. Mass. Council of Constr. Employers, Inc.*, 460 U.S. 204, 214 (1983) (holding that preference in city-funded construction contracts for city residents passed muster under the Commerce Clause), with *United Bldg. & Constr. Trades Council v. Mayor of Camden*, 465 U.S. 208, 221–22 (1984) (holding the following year that such preferences violated the Privileges and Immunities Clause), and *Gannett Co. v. DePasquale*, 443 U.S. 368 (1979) (holding that the exclusion of the public from a criminal trial, with the criminal defendant's consent, didn't violate the Public Trial Clause), with *Richmond Newspapers, Inc. v. Virginia*, 448 U.S. 555 (1980) (holding the following year that such exclusion violated the First Amendment).

119. See *New York v. Ferber*, 458 U.S. 747, 765 (1982) (barring strict liability in child pornography cases); *Gertz v. Robert Welch, Inc.*, 418 U.S. 323, 392 (1974) (same in libel cases); *Manual Enters., Inc. v. Day*, 370 U.S. 478, 492–93 (1962) (same in civil obscenity cases); *Smith v. California*, 361 U.S. 147, 152–53 (1959) (same in criminal obscenity cases). The one exception may be libel cases involving statements on matters of purely private concern, see *Dun & Bradstreet, Inc. v. Greenmoss Builders, Inc.*, 472 U.S. 749, 761 (1985), but few copyright cases would involve works on matters of purely private concern.

120. 17 U.S.C. § 504 (2000).

121. *Id.*

122. *Cf. De Acosta v. Brown*, 146 F.2d 408, 412–13 (2d Cir. 1944) (Hand, J., dissenting) (arguing that holding a magazine publisher strictly liable for infringement by a contributing author “is likely to prove an appreciable and very undesirable burden upon the freedom of the press”); Eugene Volokh, *Cheap Speech and What It Will Do*, 104 YALE L.J. 1805, 1844 n.130 (1995) (briefly touching on this question); Edward M. Di Cato, Comment, *Operator Liability Associated with Maintaining a Computer Bulletin Board*, 4 SOFTWARE L.J. 147, 155–56 (1990) (discussing this question).

mistakes of fact would deter those kinds of speech that seem to be particularly likely to be punished. Strict liability for mistakes of fact in libel cases may lead newspapers to play it safe by not publishing criticisms of people, even ones that ultimately prove correct.<sup>123</sup> Strict liability for distributing obscene books even when one hasn't read them may lead bookstores to play it safe by not carrying any books that have covers hinting of risqué content.<sup>124</sup>

But because there are relatively few cues to whether one work indeed copies from another, no class of work will seem especially likely to be infringing, and publishers therefore won't be deterred from publishing any class of works. Strict liability for distributing material that, unbeknownst to the publisher, is copied from another work thus won't deter publishers from publishing any class of work.

Publishers may, of course, be deterred by specific claims of infringement, such as "The article that's posted on your Web site illegally copies expression from my book; take it down or I'll sue." But such claims are usually accompanied by the text of the claimant's own work; the publisher will then be able to see for himself whether the published article is indeed a copy, and thus will not much worry about being mistaken as to the facts of the claim. The fear of mistake of fact will happen chiefly in the relatively rare situations where there's a plausible claim of independent creation, of the original work having fallen into the public domain, or of an undocumented license to use the claimant's work—the situations where there really is a contested issue of fact.

Of course, the speaker or publisher might still be deterred if he (1) knows that the work copies another work, (2) believes that the copying is a fair use, or copies only facts or ideas and not expression, but (3) is concerned that a judge or jury might find otherwise.<sup>125</sup> These concerns may often make publishers skittish about publishing particular works.

But in such a case the speaker would be worried that he might make a mistake of *application of law to fact* (also sometimes referred to as a mistake of law),<sup>126</sup> not a mistake of

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123. See *New York Times v. Sullivan*, 376 U.S. 254, 279 (1964) (noting that strict liability tends to lead speakers to "make only statements which steer far wider of the unlawful zone," and thus "dampens the vigor and limits the variety of public debate" (quotation marks omitted)); see also *Gertz*, 418 U.S. at 347–48 (holding that strict liability is impermissible even when the plaintiff is a private figure).

124. See *Smith*, 361 U.S. at 152.

125. Cf. *New York Times*, 376 U.S. at 279 (describing similar "self-censorship" caused by broad libel laws).

126. See, e.g., *Cheek v. United States*, 498 U.S. 192, 199 (1991) (giving *Hamling v.*

fact<sup>127</sup>—and the Court has held that speech restrictions need not provide a defense for reasonable mistakes of application of law to fact.<sup>128</sup> So while immunity from strict liability may decrease (for better or worse) the deterrent effect of these copyright rules on speakers who reasonably believe that their works are fair uses or that they fall below the substantial similarity threshold, the current First Amendment procedural rules don't supply such immunity.

3. *Presumed and Punitive Damages.* Just as First Amendment law generally forbids all damages liability when a speaker makes a reasonable mistake of fact, it also precludes presumed and punitive damages—at least in public concern libel cases—even when the speaker makes an unreasonable but honest mistake. Such damages can be awarded only when the speaker is reckless or worse; if mere negligence is proven, only provable compensatory damages can be awarded.<sup>129</sup>

If this doctrine applied to copyright cases, it would likely bar statutory damages, a form of presumed or punitive damages,<sup>130</sup> unless the defendant acted willfully. This, though, would again only be true if the defendant claims he made an honest mistake *as to the facts*.<sup>131</sup> If the defendant honestly (though perhaps unreasonably) believed that his licensor had the power to license the work to him, then he'd have a First Amendment argument in favor of having to pay only actual damages. The same may be true if the defendant honestly (though perhaps unreasonably) believed that his use of the work wouldn't materially affect the copyright owner's market, and would thus be a fair use.

But in the more common cases where the defendant claims

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*United States*, 418 U.S. 87, 119–24 (1974), as an example of a case that involves a “mistake of law,” though *Hamling* involved an alleged mistake of application of law to fact).

127. The exception would be if the speaker is mistaken about the likely effect of the use on the market, the one part of the substantial similarity and fair use tests that often turns on a contested issue of fact.

128. *Hamling*, 418 U.S. at 119–24.

129. *Gertz v. Robert Welch, Inc.*, 418 U.S. 323, 349–50 (1974).

130. See 17 U.S.C. § 504 (2000). Statutory damages are conventionally seen more as presumed damages than punitive, but some cases suggest that they also have a punitive component. See, e.g., *Cass County Music Co. v. C.H.L.R., Inc.*, 88 F.3d 635, 643 (8th Cir. 1996) (“[I]t is plain that another role has emerged for statutory damages in copyright infringement cases: that of a punitive sanction on infringers,” akin to “the award of punitive damages.”); *Evans Newton Inc. v. Chi. Sys. Software*, 793 F.2d 889, 897 (7th Cir. 1986) (“Under copyright law, punitive damages could come from an award of statutory damages for willful infringement.”); *Video Cafe, Inc. v. De Tal*, 961 F. Supp. 23, 26 (D.P.R. 1997) (“The Court would also note that statutory damages awards under § 504(c) serve both compensatory and punitive purposes.”).

131. Refer to Part III.D.2 *supra*.

an honest mistake in applying the law to uncontested facts—for instance, claims that he thought his work wasn't substantially similar to the plaintiff's, or that his use was fair—then the limits on presumed and punitive damages wouldn't apply. Under *Hamling v. United States*, an honest mistake in applying law to facts is no defense even to criminal liability; a fortiori, it would be no defense to presumed and punitive damages.

*E. Eldred and Harper & Row: Two Possible Errors*

The copyright exception, then, is the core of the *Eldred/Harper & Row* holding, and I think it's basically sound—and, in any event, unlikely to be changed soon. The text and the original meaning, coupled with the economic incentive argument,<sup>132</sup> do indeed justify the copyright exception. But the Court has also given two other justifications that are unnecessary, unsound, and potentially dangerous, because they may justify other speech restrictions that are considerably broader than copyright law. They should be rejected, and they are tangential enough that the Court may in fact be willing to revisit them.

1. *The Value (or Lack of Value) of Copied Speech.* One such unsound justification comes in this paragraph from *Eldred*:

The [Copyright Term Extension Act] . . . does not oblige anyone to reproduce another's speech against the carrier's will. Instead, it protects authors' original expression from unrestricted exploitation. Protection of that order does not raise the free speech concerns present when the government compels or burdens the communication of particular facts or ideas. The First Amendment securely protects the freedom to make—or decline to make—one's own speech; *it bears less heavily when speakers assert the right to make other people's speeches.* To the extent such assertions raise First Amendment concerns, copyright's built-in free speech safeguards are generally adequate to address them.<sup>133</sup>

If the italicized text simply asserts the Court's conclusion, which is that the copyright exception lets the government restrict speech that borrows too much of others' work, then it's fine. But if the text is seen as part of the argument for the conclusion—if

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132. Refer to Part III.A *supra*.

133. *Eldred v. Ashcroft*, 123 S. Ct. 769, 789 (2003) (emphasis added); see also *In re Aimster Copyright Litig.*, 334 F.3d 643, 656 (2003) (using this argument as a partial justification for rejecting a First Amendment defense to a copyright injunction).

it's seen as arguing that the copyright exception is legitimate because copied speech is substantially less valuable than other speech—then the text seems mistaken.

Your repeating my speech, after all, is informative to the listeners, just as if I delivered it myself. If you're literally copying my work, this doesn't add to the number of works that are created; but the value of speech to consumers isn't just in its existing somewhere in a bookstore—the value lies in consumers actually hearing or reading it.

When you republish work that the author doesn't want republished (consider attempts by critics of the Church of Scientology to publish secret Scientology documents,<sup>134</sup> or the Philadelphia Church of God's attempt to republish *Mystery of the Ages*, a book that the author's legatees are trying to withhold from reproduction),<sup>135</sup> you're delivering information to readers. When you publish a work for less money than the authorized edition costs, so that people buy it even though they wouldn't have bought the more expensive version, you're delivering information to more readers. When you publish a work and distribute it to people who haven't seen it before, perhaps because your advertising is especially effective, or because you're using different distribution channels (as Eldred himself was), you're delivering information to more readers.

In all these cases, the republished work is materially more valuable to readers than the original that they can't get, that costs too much, or that they don't know about (even though the republication might still be properly restrained, on the grounds that it decreases the incentive to create new works). Certainly the republished work is at least as valuable to listeners as are the many relatively brief and often unoriginal forms of speech that the First Amendment clearly protects.

Moreover, your repeating my speech can also be valuable to you as self-expression. Speakers often express themselves using words or symbols that communicate their own feelings or ideas more effectively than what they themselves could have created. Johnson, for instance, didn't invent flag burning,<sup>136</sup> and the Tinkers didn't invent black armbands.<sup>137</sup> Cohen may have taken the "Fuck the Draft" line from someone else, or perhaps may

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134. Religious Tech. Ctr. v. Lerma, 40 U.S.P.Q.2d (BNA) 1569 (E.D. Va. 1996).

135. Worldwide Church of God v. Phila. Church of God, 227 F.3d 1110 (9th Cir. 2000).

136. See Texas v. Johnson, 491 U.S. 397 (1989).

137. See Tinker v. Des Moines Indep. Cmty. Sch. Dist., 393 U.S. 503 (1969).

have even bought a ready-made jacket with that text.<sup>138</sup> Union members regularly hand out leaflets written by others.<sup>139</sup> Whenever someone waves a flag, distributes Bibles, or sings a song (whether a protest song or a love song) that others wrote, he is expressing himself using “other people’s speech[,]” at least in the sense of speech written (and sometimes even owned) by other people. And yet this speech doesn’t become less constitutionally valuable just because it is unoriginal.

All this is true even of literal copying, but the value of speech that uses other people’s speech is clearer still in the preparation of derivative works. The movie *Rear Window* seems to be at least as valuable as the short story on which it was based,<sup>140</sup> or as the unquestionably constitutionally protected speech on Cohen’s jacket. Likewise for a biography containing excerpts of J.D. Salinger’s letters,<sup>141</sup> or even a magazine article that excerpts particular portions of Gerald Ford’s memoirs.<sup>142</sup> So copyright law is constitutional *despite* the constitutional value of repetition of others’ speech, and not because such repetition is of no value or low value.

2. *Copied Speech as Compelled Speech.* The second unsound justification appears in *Harper & Row’s* statement that:

Moreover, freedom of thought and expression “includes both the right to speak freely and the right to refrain from speaking at all.” *Wooley v. Maynard*, [430 U.S. 705, 714 (1977)]. We do not suggest this right not to speak would sanction abuse of the copyright owner’s monopoly as an instrument to suppress facts. But in the words of New York’s Chief Judge Fuld:

“The essential thrust of the First Amendment is to prohibit improper restraints on the *voluntary* public expression of ideas; it shields the man who wants to speak or publish when others wish him to be quiet. There is necessarily, and within suitably defined areas, a concomitant freedom *not* to speak publicly, one which serves the same ultimate end as freedom of speech in its affirmative aspect.”

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138. See *Cohen v. California*, 403 U.S. 15 (1971).

139. See *Old Dominion Branch No. 496 v. Austin*, 418 U.S. 264, 267–68 (1974) (describing an antistrikebreaker leaflet that quotes a passage from a second piece of trade union literature attributed to Jack London).

140. See *Stewart v. Abend*, 495 U.S. 207 (1990).

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

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

*Estate of Hemingway v. Random House, Inc.*, [244 N.E.2d 250, 255] (1968).

Courts and commentators have recognized that copyright, and the right of first publication in particular, serve this countervailing First Amendment value.<sup>143</sup>

This logic is flawed; it wasn't necessary to the result in *Harper & Row*, and it ought to be rejected.

To begin with, consider the implications of this principle. If indeed quoting several hundred words from Ford's unpublished memoirs violates Ford's "freedom not to speak publicly," then quoting even a few words would, too: The compelled speech doctrine bars compulsion of even a little bit of speech—*Wooley* itself held that a driver couldn't be required to display the four-word license plate slogan "Live Free or Die."<sup>144</sup> Presumably Congress would thus be empowered (or perhaps required, if there really is a First Amendment principle involved here) to constrict fair use to the point that it would be illegal to quote even four words from, say, a leaked corporate executive's memo or a politician's private letter.

Moreover, if quoting from a written work violates "the right to refrain from speaking at all," then presumably quoting from an oral statement would violate this right as well. (*Estate of Hemingway* in fact involved quotes from oral statements.)<sup>145</sup> Copyright law's fixation requirement limits protection to written or recorded work, but First Amendment law protects oral speech as well as written. Therefore, when reporters quote people's statements without their permission, they would be either violating the First Amendment or at least harming a "First Amendment value." Congress would thus be allowed to bar all quoting of people's oral remarks without their consent, since such a ban would protect the "freedom not to speak publicly" as much as would a ban on long quotations from people's unpublished writings. This can't be right—but that just shows that the Court's reasoning, from which we started, can't be right, either.

Looking closely at the reasoning illustrates the problem. First, the claim that publishing someone's remarks forces him to speak is only a metaphor. Ford wasn't forced to speak; he spoke entirely voluntarily, though he may not have intended his words to be quoted before publication.

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143. *Id.* at 559–60.

144. *Wooley v. Maynard*, 430 U.S. 705, 707, 713 (1977).

145. 244 N.E.2d 250, 252–53 (N.Y. 1968).

This is a fundamental distinction: Speech compulsion involves compulsion, the application of coercive force or legal command—in *Wooley*, the Maynards had been criminally prosecuted for covering up the slogan on their license plate. The First Amendment prohibits this compulsion, because such coercion forcibly interferes with people’s “right of self-determination in matters that touch individual opinion and personal attitude,” to quote *Barnette’s* characterization of the Jehovah’s Witnesses’ objection.<sup>146</sup> Being quoted without one’s permission may be upsetting or embarrassing, or may interfere with one’s ability to make money from one’s words, but it doesn’t interfere with the self-determination of opinion and attitude that *Barnette* described.

The Court has drawn this very distinction in the one other constitutional area that deals with speech compulsion—the right not to be compelled to testify against oneself. If government officials coerce me to speak, that may lead to a Fifth Amendment violation. But if I voluntarily say something to someone, and that person repeats it at trial, that is not considered compelled self-incrimination because I was never compelled to make the statement.<sup>147</sup> Naturally, the First Amendment and Fifth Amendment rights to be free from speech compulsions are far from identical, and analogies between them are necessarily imperfect. But on this particular point, the reasoning of the Fifth Amendment cases applies well to First Amendment cases.

Second, even if we treat unauthorized quoting as a form of speech compulsion, the First Amendment bars only speech compulsion by the government. Unauthorized quoting by nongovernmental actors is at most speech compulsion by nongovernmental actors, and thus not a violation of the First Amendment.

Presumably, the *Harper & Row* Court wasn’t trying to overrule the state action doctrine. I take it the reference to freedom from compelled speech as a “First Amendment value” suggests only that the government could restrict speech to prevent what one might call “nongovernmental speech compulsion,” not that such nongovernmental speech compulsion was itself a constitutional violation.

But this can’t be right, either: Nongovernmental actors generally have the First Amendment right to say things that are aimed at suppressing or compelling speech by others (so long as they stay away from threats of violence). Speakers urge others to

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146. *W. Va. State Bd. of Educ. v. Barnette*, 319 U.S. 624, 631 (1943).

147. *See Couch v. United States*, 409 U.S. 322, 328 (1973).

boycott newspapers until the newspapers fire columnists who say offensive things; this is nongovernmental speech suppression.<sup>148</sup> Speakers urge these boycotts because they want the newspapers to publicly apologize; this is nongovernmental speech compulsion. In fact, these are much more literally suppression and compulsion than what happened in *Harper & Row*—they actually, rather than metaphorically, seek to use economic pressure to compel people to say things they don't want to say, and actually seek to "restrain the voluntary public expression of ideas." Nonetheless, the First Amendment protects these forms of speech, even though they are intended to and likely to suppress or compel other speech.

Likewise, speakers often try to silence political opponents by calling them names such as "racist," "Communist," "sexist," "un-American," "homophobe," "Uncle Tom," "Klansman," or "Nazi," even when the pejoratives are unearned.<sup>149</sup> Those who express

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148. See, e.g., Jerry Berger, *Kennedy Decries Reagan Civil Rights Policies*, UNITED PRESS INT'L, Jan. 18, 1988, available at LEXIS, News Library, UPI File (describing public pressure that caused CBS to fire Jimmy "The Greek" Snyder after he made racist remarks); Jill Stewart, *Free This Man; Can Black Conservatives Speak Their Minds in America? Ask KABC Talk-Show Host Larry Elder, the Target of a Black Nationalist Group in L.A.*, NEW TIMES (L.A.), July 3, 1997 (Features section) (describing boycott of sponsors of black conservative talk show host Larry Elder's radio show, aimed at getting the radio station to take him off the air); James Warren, *Andy Rooney Suspended, But Denies Racist Comment*, CHI. TRIB., Feb. 9, 1990, § 1, at 3 (describing public pressure that caused CBS to suspend *60 Minutes* commentator Andy Rooney for allegedly making a racist comment).

149. See, e.g., John L. Mitchell, *Larry Knows Best*, L.A. TIMES, May 31, 1998 (Magazine), at 12, 15 ("Out of the black community came anonymous fliers accusing [conservative black talk show host Larry] Elder of hate speech, describing him as a 'White Man's Poster Boy' and a 'boot-licking Uncle Tom.'"); Rick Pearson & Graeme Zielinski, *Senator Apologizes for Epithet: Moseley-Braun Uses Slur in Calling Columnist Racist*, CHI. TRIB., Sept. 8, 1998, § 1, at 1 (quoting Sen. Carol Moseley-Braun's response to columnist George Will's criticism of her):

"I think because he could not say 'nigger,' he said the word 'corrupt,'" Moseley-Braun said, although the word "corrupt" did not appear in the conservative commentator's column.

"George Will can just take his hood and go back to wherever he came from," she added, apparently alluding to hoods worn by members of the Ku Klux Klan.

*Id.*; *Olbermann: The News No Longer With Keith*, THE HOTLINE, Dec. 3, 1998 (People section) (quoting MSNBC anchor Keith Olbermann as saying, while criticizing Ken Starr's investigation of Bill Clinton, "[i]t finally dawned on me that the person Ken Starr has reminded me of, facially, all this time was Heinrich Himmler, including the glasses").

In a few situations these terms might be legally actionable false statements of facts, since they may imply that the person has certain specific views or has engaged in certain specific acts, though even that isn't certain; but generally, they're seen as statements of opinion, and thus constitutionally protected. See *Stevens v. Tillman*, 855 F.2d 394, 402 (7th Cir. 1988) ("In daily life 'racist' is hurled about so indiscriminately that it is no more than a verbal slap in the face . . . . It is not actionable unless it implies the existence of undisclosed, defamatory facts . . . .").

certain views are sometimes called traitors to their race,<sup>150</sup> or attacked with scurrilous parodies.<sup>151</sup> Such attacks and pejoratives are often intended to and likely to deter others from speaking, or to compel others to retract their earlier statements. People often stay silent to avoid this sort of vituperation from critics. But the vituperation, though it's a form of nongovernmental speech suppression, is itself constitutionally protected speech: The government may not ban it, even to protect those who might otherwise be silenced by the attacks.

Congress is thus not allowed to suppress the speech of some in order to avoid nongovernmental deterrents or nongovernmental compulsion of the speech of others. The Copyright Clause and its policy of securing to people the exclusive rights in their works may justify copyright law. But the compelled speech doctrine adds nothing to this justification.

The mischief of this "copying as compelled speech" doctrine is well illustrated by its use in four of the decisions that have quoted the "concomitant freedom not to speak publicly" language: court of appeals opinions in *Boehner v. McDermott*,<sup>152</sup> *Bartnicki v. Vopper*,<sup>153</sup> and *Peavy v. WFAA-TV, Inc.*,<sup>154</sup> and a dissenting opinion in *Bartnicki* when the case was before the Supreme Court.<sup>155</sup> These cases all involved a ban on publishing illegally intercepted cellular telephone conversations, a ban which applied even when the publisher wasn't involved in the illegal interception. Those judges who wanted to uphold the ban cited the *Harper & Row* "compelled speech" argument as justification.

But whatever one thinks of the ban itself—a splintered Supreme Court decision in *Bartnicki v. Vopper* held it unconstitutional, at least in certain situations<sup>156</sup>—accepting the "compelled speech" reasoning would have led courts to uphold much more than this particular ban. *Estate of Hemingway*, after all, involved oral conversations that were reported by a listener, not ones that were illegally intercepted:<sup>157</sup> The theory was that,

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150. See, e.g., Amy Wallace, *He's Either Mr. Right or Mr. Wrong*, L.A. TIMES, Mar. 31, 1996 (Magazine), at 12, 28 ("State Sen. Diane Watson of Los Angeles accused [Ward Connerly, leader of the California anti-race-preference campaign] of selling out his own people. 'He probably feels this makes him more white than black, and that's what he really wanted to be,' she said, adding, 'He married a white woman.'").

151. *Hustler Magazine v. Falwell*, 485 U.S. 46, 48 (1988).

152. 191 F.3d 463, 469 (D.C. Cir. 1999).

153. 200 F.3d 109, 136 (3d Cir. 1999) (Pollak, J., dissenting).

154. 221 F.3d 158, 192 (5th Cir. 2000).

155. 532 U.S. 514, 553 (2001) (Rehnquist, C.J., dissenting).

156. *Id.* at 516.

157. *Estate of Hemingway v. Random House, Inc.*, 244 N.E.2d 250, 252–53 (N.Y. 1968).

were it not for Hemingway's consent, a writer's publishing Hemingway's oral statements would have constituted "compelled speech" and common law copyright could therefore prevent such publication.<sup>158</sup> Likewise, if Vopper's publication of Bartnicki's unlawfully intercepted statements could be suppressed on the grounds that it "compelled" Bartnicki's speech, the same would have applied if Bartnicki's statements had not been unlawfully intercepted, but had been remembered by Bartnicki's conversation partners and then retold to Vopper. In either case, Bartnicki's statements would have been made public without his consent, the gravamen of the "speech compulsion" that *Estate of Hemingway* and *Harper & Row* condemn.

Fortunately, the Supreme Court in *Bartnicki* didn't accept the "freedom not to speak publicly" argument. I hope that lower courts likewise view this argument skeptically, and that the Supreme Court eventually disavows it.

#### IV. TRADEMARK DILUTION CLAIMS AND THE EVOLVING COMMERCIAL SPEECH DOCTRINE

Trademark dilution laws cover (to quote the federal statute) all "use in commerce of a mark or trade name, if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark,"<sup>159</sup> even if the use isn't likely to mislead consumers. Is such a restriction on nonmisleading commercial speech constitutional?

It's hard to answer this, because the commercial speech doctrine is in such flux. The Court concluded in the mid-1970s that commercial advertising was constitutionally protected;<sup>160</sup> seemingly pulled back on that protection in the 1980s;<sup>161</sup> but has been providing more and more protection since the early 1990s.<sup>162</sup> In particular, the Court's 1996 decision in *44 Liquormart, Inc. v.*

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158. *Id.* at 255.

159. 15 U.S.C. § 1125(c)(1) (2000); *see also, e.g.*, 765 ILL. COMP. STAT. ANN. 1036/5, 1036/65 (Michie Supp. 2003) (implementing a similar state rule).

160. *Virginia State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748 (1976) (holding unconstitutional a Virginia statute forbidding pharmacists from advertising drug prices).

161. *Bd. of Trustees v. Fox*, 492 U.S. 469 (1989); *S.F. Arts & Athletics, Inc. v. United States Olympic Comm.*, 483 U.S. 522 (1987); *Posadas de P.R. Assocs. v. Tourism Co. of P.R.*, 478 U.S. 328 (1986); *Central Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n*, 447 U.S. 557 (1980).

162. *Thompson v. W. States Med. Ctr.*, 535 U.S. 357 (2002); *Lorillard Tobacco Co. v. Reilly*, 533 U.S. 525 (2001); *Greater New Orleans Broad. Ass'n v. United States*, 527 U.S. 173 (1999); *44 Liquormart, Inc. v. Rhode Island*, 517 U.S. 484 (1996); *Rubin v. Coors Brewing Co.*, 514 U.S. 476 (1995); *Edenfield v. Fane*, 507 U.S. 761 (1993); *City of Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410 (1993).

*Rhode Island*<sup>163</sup> overruled one leading commercial speech case from the 1980s (*Posadas de P.R. Assocs. v. Tourism Co. of P.R.*),<sup>164</sup> and a plurality in that case would have essentially overruled (at least in large part) *Central Hudson Gas & Electric Co. v. Public Service Commission*,<sup>165</sup> the case that supposedly sets forth the official test for commercial speech restrictions.<sup>166</sup> Moreover, even if *Central Hudson* still provides the official test, that test is notoriously indeterminate. The doctrine thus won't give us much of an answer, so it might be more helpful to return to first principles.

Trademark dilution laws protect trademark owners from a certain kind of nondeceptive competition—and, in theory, also indirectly benefit consumers, as trademark owners get more of an incentive to invest in their trademarked goods. But protecting some businesses from competition, the Court has concluded, generally isn't reason enough to suppress other businesses' factually accurate advertising; that's what *Virginia Board of Pharmacy*, the font of modern commercial speech doctrine, necessarily concludes.<sup>167</sup> Likewise, restrictions on accurate advertising can't be justified simply on the theory that the benefits to some businesses will indirectly benefit their consumers.<sup>168</sup>

The significant distinction between trademark dilution laws and the advertising ban in *Virginia Board of Pharmacy* is not that one is an intellectual property law and the other is not. Rather, it's that *Virginia Board of Pharmacy* restricted the communication of factual information: the price of pharmaceuticals. Trademark dilution law allows advertisers to communicate facts, even including facts about other companies' products—15 U.S.C. § 1125(c)(4)(A) exempts comparative advertising. Advertisers may not, however, use certain trademarks as part of the nonfactual (image-building, attention-grabbing, or simply amusing) component of the promotion.

If dilution law restricted noncommercial speech, it wouldn't matter that it only restricts certain words, but leaves speakers free to express facts and ideas. As *Cohen v. California* held,

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163. 517 U.S. 484 (1996).

164. 478 U.S. 328 (1986).

165. 447 U.S. 557 (1980).

166. The fifth vote in *44 Liquormart*, Justice Scalia, seemed open to the argument that *Central Hudson* should be overruled in the future. See 517 U.S. at 517–18 (Scalia, J., concurring in part and concurring in the judgment).

167. *Virginia State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 769–70 (1976).

168. *Id.* at 767–69.

“forbid[ding] particular words” also “run[s] a substantial risk of suppressing ideas in the process”;<sup>169</sup> moreover, the First Amendment protects the “emotive function” of speech as well as the “cognitive content,” because the emotive function “may often be the more important element of the overall message.”<sup>170</sup> (Copyright law does allow the restriction of creative expression, on the theory that people remain free to communicate facts and ideas, but the copyright exception is justified by a particular rationale that’s not applicable here.)<sup>171</sup> This is why authors and moviemakers have the right to use trademarked terms in their works, from the movie *The Coca-Cola Kid* to characters talking about Xeroxing (the way real people talk) rather than photocopying (the way trademark lawyers might want us to talk).<sup>172</sup>

But the Supreme Court has had few occasions to decide whether the *Cohen* principle applies to commercial speech. Nearly all commercial speech cases have dealt with laws that restricted commercial speakers from advertising facts or ideas, such as the availability or propriety of a product or service,<sup>173</sup> its

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169. 403 U.S. 15, 26 (1971).

170. *Id.*

171. Refer to Part II.A *supra*.

172. See, e.g., *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1512 n.6 (9th Cir. 2002) (Kozinski, J., dissenting from denial of rehearing en banc) (mentioning *The Coca-Cola Kid* and many similar examples); Tim Carvell, *Lockheed Raises a Stink Over “Skunkworks,”* FORTUNE, Mar. 6, 2000, at 80 (“Xerox often sends out letters and takes out ads imploring people not to refer to photocopies as ‘xeroxes.’”).

173. See, e.g., *Thompson v. W. States Med. Ctr.*, 535 U.S. 357 (2002) (compounded pharmaceuticals); *Lorillard Tobacco Co. v. Reilly*, 533 U.S. 525 (2001) (tobacco); *Greater New Orleans Broad. Ass’n v. United States*, 527 U.S. 173 (1999) (private casino gambling); *Fla. Bar v. Went for It, Inc.*, 515 U.S. 618 (1995) (legal services); *United States v. Edge Broad. Co.*, 509 U.S. 418 (1993) (lotteries); *Edenfield v. Fane*, 507 U.S. 761 (1993) (accounting services); *City of Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410 (1993) (all products sold through advertising publications distributed through newsracks); *Bd. of Trs. v. Fox*, 492 U.S. 469 (1989) (all products sold by private commercial enterprises in public university dorm rooms); *Shapero v. Ky. Bar Ass’n*, 486 U.S. 466 (1988) (legal services); *Posadas de P.R. Assocs. v. Tourism Co. of P.R.*, 478 U.S. 328 (1986) (casino gambling); *Zauderer v. Office of Disciplinary Counsel*, 471 U.S. 626 (1985) (legal services); *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60 (1983) (contraceptives); *Vill. of Hoffman Estates v. Flipside, Hoffman Estates, Inc.*, 455 U.S. 489 (1982) (drug paraphernalia); *Metromedia, Inc. v. City of San Diego*, 453 U.S. 490 (1981) (all products or services advertised by “off-premise” outdoor displays); *Central Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n*, 447 U.S. 557 (1980) (electrical utility products); *Ohralik v. Ohio State Bar Ass’n*, 436 U.S. 447 (1978) (legal services); *Bates v. State Bar*, 433 U.S. 350 (1977) (legal services); *Carey v. Population Servs. Int’l*, 431 U.S. 678 (1977) (contraceptives); *Linmark Assocs. v. Township of Willingboro*, 431 U.S. 85 (1977) (housing).

price,<sup>174</sup> its features,<sup>175</sup> or the qualifications of the people providing it,<sup>176</sup> and not just the particular words or symbols used to express those facts or ideas. There are only two exceptions.

First, *Zauderer v. Office of Disciplinary Counsel* struck down a ban on the use of illustrations in lawyers' advertisements on the grounds that an illustration "serves important communicative functions: it attracts the attention of the audience to the advertiser's message, and it may also serve to impart information directly."<sup>177</sup> The government tried to justify the ban by arguing that illustrated ads were potentially misleading, and undignified for professionals; but the Court concluded that there was nothing inherently misleading or undignified about illustrations, and that the law couldn't bar all illustrations because some may be misleading or undignified.

The *Zauderer* Court did not, however, make a *Cohen*-like argument that all expressive choices by the commercial speaker are equally protected. In fact, when *Zauderer* went on to uphold a requirement that lawyer ads contain certain disclaimers, it distinguished commercial speech from noncommercial speech and stressed that commercial speech is protected chiefly for its *informational* content:

But the interests at stake in this case are not of the same order as those discussed in *Wooley*, *Tornillo*, and *Barnette* [earlier speech compulsion cases that involved noncommercial speech]. Ohio has not attempted to "prescribe what shall be orthodox in politics, nationalism, religion, or other matters of opinion or force citizens to confess by word or act their faith therein" [quoting *Barnette*]. The State has attempted only to prescribe what shall be orthodox in commercial advertising, and its prescription has taken the form of a requirement that appellant include in his advertising purely factual and uncontroversial information about the terms under which

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174. See, e.g., 44 *Liquormart, Inc. v. Rhode Island*, 517 U.S. 484 (1996) (alcohol); *Virginia State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748 (1976) (pharmaceuticals).

175. See, e.g., *Rubin v. Coors Brewing Co.*, 514 U.S. 476 (1995) (alcohol content of beer).

176. See, e.g., *Ibanez v. Fla. Dep't of Bus. & Prof'l Regulation*, 512 U.S. 136 (1994) (accountant's qualifications); *Peel v. Attorney Registration & Disciplinary Comm'n*, 496 U.S. 91 (1990) (lawyer's qualifications); *Zauderer v. Office of Disciplinary Counsel*, 471 U.S. 626 (1985) (same); *In re R. M. J.*, 455 U.S. 191 (1982) (same); *Friedman v. Rogers*, 440 U.S. 1, 11 (1979) (trade names of optometrist businesses, which "may serve to identify an optometrical practice and also to convey information about the type, price, and quality of services offered for sale in that practice").

177. 471 U.S. at 647.

his services will be available. Because the extension of First Amendment protection to commercial speech is justified principally by the value to consumers of the information such speech provides, appellant's constitutionally protected interest in *not* providing any particular factual information in his advertising is minimal.<sup>178</sup>

And this stress on the value of information as a justification for commercial speech protection arises time and again in commercial speech cases. *Virginia Pharmacy*, for instance, rested largely on society's "strong interest in the free flow of commercial information"<sup>179</sup> and the 44 *Liquormart* plurality stressed the harm of "state attempts to deprive consumers of accurate information about their chosen products."<sup>180</sup>

This, I think, helps explain the second case in which the Court has confronted a restriction on commercial advertising that didn't materially block the communication of facts or ideas—*San Francisco Arts & Athletics, Inc. v. United States Olympic Committee*, which upheld a law barring people from using the word "Olympic" in advertisements unless they first got permission from the USOC.<sup>181</sup> The federal government, the *SFAA* Court concluded, has a constitutionally sufficient interest in "ensur[ing] that the USOC receives the benefit of its own efforts so that the USOC will have an incentive to continue to produce a 'quality product'"; and the government may serve this interest by banning even nonconfusing uses, because even nonconfusing uses "may harm [the trademark owner] by lessening the distinctiveness and thus the commercial value of the marks."<sup>182</sup>

In the process, the Court engaged in some quite un-*Cohen*-like reasoning: "By prohibiting the use of one word for particular purposes," the Court said, "neither Congress nor the USOC has prohibited the SFAA from conveying its message. . . . Section 110 restricts only the manner in which the SFAA may convey its message."<sup>183</sup> The argument that this content-based law is just a "manner" restriction wouldn't generally apply to noncommercial speech,<sup>184</sup> as *Cohen* itself suggests; for noncommercial speech, the principle is that the speaker is entitled to choose the particular words he wants. Something must have been different here, in the

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178. *Id.* at 651 (citation omitted).

179. 425 U.S. at 764.

180. 44 *Liquormart, Inc. v. Rhode Island*, 517 U.S. 484, 503 (1995).

181. 483 U.S. 522 (1987).

182. *Id.* at 537, 539.

183. *Id.* at 536.

184. Refer to note 69 *supra*.

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Court's view.

Part of that difference flowed from the challenged law's being an intellectual property speech restriction:

This Court has recognized that words are not always fungible, and that the suppression of particular words "run[s] a substantial risk of suppressing ideas in the process." *Cohen v. California*, [403 U.S. 15, 26] (1971). The SFAA argues that this principle prohibits Congress from granting the USOC exclusive control of uses of the word "Olympic," a word that the SFAA views as generic. Yet this recognition always has been balanced against the principle that when a word acquires value "as the result of organization and the expenditure of labor, skill, and money" by an entity, that entity constitutionally may obtain a limited property right in the word.<sup>185</sup>

But part, I think, also flowed from the law's being almost entirely focused on commercial speech:

[O]n its face, [the law] applies primarily to commercial speech, to which the application of the overbreadth doctrine is highly questionable. There is no basis in the record to believe that the Act will be interpreted or applied to infringe significantly on noncommercial speech rights. The application of the Act to the SFAA is well within constitutional bounds, and the extent to which the Act may be read to apply to noncommercial speech is limited.<sup>186</sup>

This passage, together with the Court's stress that "[n]or is it clear that § 110 restricts purely expressive uses of the word 'Olympic,'"<sup>187</sup> suggests that the Court would have had misgivings about denying political and artistic speakers the use of the word "Olympic": It was the law's focus on commercial speech that made the law permissible. And this, I think, is tied to the Court's tradition of recognizing that commercial speech is protected largely for its informational content.

*SFAA*, of course, is the chief case supporting the constitutionality of trademark dilution law. Though general dilution law is distinguishable from the specific law that *SFAA* upheld—*SFAA* also partly relied on the special public importance of the U.S. Olympic Committee<sup>188</sup>—I doubt that this is distinction enough: Other trademark holders also contribute to the economy,

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185. 483 U.S. at 532 (footnote omitted) (alteration in original).

186. *Id.* at 536 n.15.

187. *Id.* at 536.

188. *Id.* at 537 ("The USOC's goal under the Olympic Charter . . . is to futher the Olympic movement . . .").

employ people, and invest efforts in their trademarks. But as I said above, commercial speech doctrine has shifted considerably since the late 1980s. The Court has reversed *Posadas* and might reverse *Central Hudson*, so it might be willing to reconsider *SFAA*, too.

The real question, then, isn't just whether trademark dilution law is permissible under *SFAA* and the *Central Hudson* framework. Rather, it's whether the Court, as it scrutinizes restrictions of nonmisleading commercial speech more and more closely—perhaps approaching equal treatment for noncommercial speech and nonmisleading commercial speech—should and will do the same for restrictions that focus not on the facts or ideas that the commercial speech expresses, but on the particular way that those facts or ideas are expressed.

My view is that the Justices should indeed apply the *Cohen* principle to commercial advertising. First, as Judge Alex Kozinski and Stuart Banner have pointed out, commercial advertisements are important parts of our cultural, social, political, and economic debates.<sup>189</sup> The government may have broader latitude to police misleading statements in commercial ads, in order to prevent fraud in the eventual transactions in which consumers buy products or services based on those ads, but this rationale cannot apply to nonmisleading statements.

Second, restrictions on nonmisleading commercial speech, like restrictions on noncommercial speech, may improperly try to change the public's behavior by constraining what the public is likely to think. Trademark dilution law itself illustrates this problem well: The metaphorical "dilution" that the law aims to prevent is a change in the associations that a product name creates in consumers' minds. Godiva Chocolates wants people to think luxury and delectability when they hear the term "Godiva," and a hypothetical Godiva Horse Tack product will undermine that image. But while I certainly understand why Godiva might not want consumers to change their thinking about the term "Godiva," it seems to me that the First Amendment shouldn't let the legal system suppress speech to preserve consumers' current attitudes.

Still, whether or not my stance on this question—should broad protection for commercial speech extend not just to the facts and ideas that an advertiser wants to express, but also to the words that an advertiser chooses to express those facts and ideas?—is correct, it is the answer to this question that should

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189. See Alex Kozinski & Stuart Banner, *The Anti-History and Pre-History of Commercial Speech*, 71 TEX. L. REV. 747 (1993); Alex Kozinski & Stuart Banner, *Who's Afraid of Commercial Speech?*, 76 VA. L. REV. 627 (1990).

drive the trademark dilution debate. If the answer is “no,” then *SFAA* should remain the law as to commercial advertising, and trademark dilution law should therefore be upheld precisely because it doesn’t “prohibit[] the [would-be speaker] from conveying its message.”<sup>190</sup> If, however, the answer is “yes,” then trademark dilution law and *SFAA* become hard to defend, and the Court ought to strike down the former and reverse the latter.

## V. TRADE SECRET

### A. *The Problem of Third-Party Publication*

Finally, let me briefly touch on trade secret law. There’s no First Amendment problem with imposing liability on a person who discloses a trade secret in violation of a confidentiality agreement; *Cohen v. Cowles Media Co.* held (correctly, I think) that contracts not to speak are enforceable.<sup>191</sup> Mark Lemley and I have argued that even permanent injunctions would be permissible in such cases, though preliminary injunctions may pose prior restraint problems.<sup>192</sup> The same should apply if the person discloses a trade secret in violation of an implied confidentiality agreement stemming from his confidential relationship with the trade secret owner.<sup>193</sup>

But what if a newspaper is sued for publishing a trade secret that was leaked to it, in violation of the leaker’s duty of confidentiality, but with no prompting on the newspaper’s part? (In the remainder of this section, I’ll call this “third-party publication,” with the implicit qualifier that the publisher didn’t originally conspire with the leaker.) Under *Restatement (Third) of Unfair Competition* § 40, the newspaper may well be held liable:

One is subject to liability for the appropriation of another’s trade secret if:

....

(b) the actor . . . discloses the other’s trade secret without the other’s consent and, at the time of . . . disclosure, [and]

....

190. 483 U.S. at 523.

191. 501 U.S. 663 (1991) (upholding the validity of a confidentiality agreement between a newspaper and an informant).

192. Lemley & Volokh, *supra* note 75, at 230.

193. *Cf.* Volokh, *Freedom of Speech and Information Privacy*, *supra* note 9, at 1057–62.

(3) the actor knows or has reason to know that the information is a trade secret that the actor acquired from or through a person . . . whose disclosure of the trade secret constituted a breach of a duty of confidence owed to the other . . . .<sup>194</sup>

If the reporter knows or has reason to know that the information is a leaked trade secret—and many reporters will be fully aware of this, or may at least learn of this before the information is published—then the newspaper might be punished for publishing the material.

And this can apply to a whole range of important information. Trade secrets aren't just customer lists or formulas for soft drinks (though even those might have political, social, and medical significance in some situations). A trade secret is defined as "any information that can be used in the operation of a business or other enterprise and that is sufficiently valuable and secret to afford an actual or potential economic advantage over others."<sup>195</sup> This may cover confidential business plans, marketing strategies, and other descriptions of how a business, charity, church, educational institution, or even government agency operates or intends to operate.<sup>196</sup>

Thus, if a newspaper publishes leaked information about a company's plans to release a new product (which some might say is dangerous), to open a new plant (which some might argue may harm the environment), or to close a plant (which may affect the employees' jobs), it potentially faces liability—perhaps including punitive damages—and an injunction. Such lawsuits are rare, but they happen, and trade secret law seems to authorize them.<sup>197</sup>

I think the First Amendment should generally preclude such

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194. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 40 (1993).

195. *Id.* § 39.

196. *See, e.g.*, OHIO REV. CODE ANN. § 1333.61(D) (Anderson 2003) (defining trade secrets as including "any scientific or technical information, design, process, procedure, formula, . . . or improvement, or any business information or plans, [or] financial information" that "derives independent economic value, actual or potential, from not being generally known to . . . persons who can obtain economic value from its disclosure or use" and that "is the subject of efforts . . . to maintain its secrecy").

197. *See, e.g.*, *Ford Motor Co. v. Lane*, 67 F. Supp. 2d 745 (E.D. Mich. 1999) (holding that the First Amendment barred an injunction against a Web site's publishing material about a car manufacturer's secret product plans, but suggesting that a damages award may be permissible); *DVD Copy Control Ass'n v. Bunner*, 75 P.3d 1 (Cal. 2003) (holding that the First Amendment doesn't protect a Web site's publishing speech containing source code derived from a secret computer language); *State ex rel. Sports Mgmt. News, Inc. v. Nachtigal*, 921 P.2d 1304 (Or. 1996) (holding that an injunction against a newsletter's publishing of information about a shoe manufacturer's secret product plans was authorized by statute, but was prohibited by the Oregon Constitution's Free Speech Clause).

lawsuits. While organizations may understandably want to keep certain information secret, the public may often benefit from its revelation. Restricting the publication of this information interferes with the media's and the public's ability to monitor organizations' conduct, and to use legal, political, or public opinion channels to persuade the organizations to change their behavior. Leaks of confidential information are a staple of modern investigative journalism and have helped break many important stories. Such coverage ought not be outlawed.

People should indeed be required to abide by their own promises, which is why enforcement against leakers should be constitutionally permissible (though legislatures and judges may choose to protect certain kinds of whistle-blowing by statute or common law). Such contractual enforcement helps preserve the potentially beneficial effects of confidentiality, and it fits our traditional conclusion that people are entitled to voluntarily waive their constitutional rights and to get the benefits that such waivers may provide them.<sup>198</sup> But where the speaker has made no promises, the speech ought not be restricted—whether it is a trade secret, other information that isn't a trade secret but is covered by the leaker's nondisclosure agreement or a duty of confidentiality, or most forms of government secrets.

This functional argument for protection is supported by the formal rules of First Amendment law. Trade secret law, as applied to third parties, is subject to strict scrutiny. Even if the law is seen as content-neutral, it can't be defended as a time, place, and manner restriction, because it doesn't leave open ample alternative channels: The newspaper is completely prohibited from publishing the trade secret.<sup>199</sup> Sometimes, the newspaper may be able to get the same information through other means, but often it will not—any other employees who might be asked to confirm the information would themselves be bound not to disclose the trade secret, and the managers who are entitled to disclose it will often refuse.<sup>200</sup>

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198. See *Cohen v. Cowles Media Co.*, 501 U.S. 663 (1991).

199. Refer to Part I.A.2 *supra*. But see *Bunner*, 75 P.3d at 10–13 (holding that strict scrutiny doesn't apply but without discussing the "ample alternative channels" question).

200. Even if the publisher does independently verify the secret information, the use of the tortiously leaked secret during the publisher's follow-up investigation may itself violate trade secret law. The *Restatement* prohibits "use" as well as "disclosure," and comment c provides that, "[a]s a general matter, any exploitation of the trade secret that is likely to result in injury to the trade secret owner or enrichment to the defendant is a 'use' under this Section," and also that "[t]he owner of a trade secret may be injured by unauthorized disclosure of a trade secret as well as by unauthorized use." RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 40 cmt. c (1993). It thus follows that using the illegally leaked information in the process of getting it independently confirmed may well

And the law should fail strict scrutiny. Trade secret law generally does provide an extra incentive for people to invest time, money, and effort into some projects; and the ban on third-party dissemination helps decrease the incentive for employees and others to breach their duty of confidentiality. But while these are important concerns, they shouldn't be compelling enough to justify suppression of speech.

The closest the Court has come to allowing these sorts of restrictions is in child pornography law, which bans the dissemination of child porn in order to diminish the incentive to create child porn. But the Court's reasoning there rested on (1) the immense harm involved in the creation of child pornography, and (2) the availability of alternative channels of communication, such as the use of adult models who look young.<sup>201</sup> Neither of these justifications applies to bans on third-party publication of trade secrets.

#### B. *Bartnicki v. Vopper*

Whether or not the above analysis is correct, though, the Court's latest aside on the subject, in *Bartnicki v. Vopper*,<sup>202</sup> is a mistake. *Bartnicki* considered the constitutionality of a statute that barred the publication of illegally intercepted cellular telephone calls—a law that's analogous to the ban on the publication of illegally leaked trade secrets, since both laws aim to prevent criminal or tortious confidentiality-destroying behavior (interception or leaking) by drying up the demand for the fruits of such behavior.<sup>203</sup> Both the statute in *Bartnicki* and the ban on third-party publication of leaked trade secrets are also analogous to possible bans on the publication of illegally leaked government secrets<sup>204</sup> or on the publication of non-trade-secret information that was leaked in violation of confidentiality agreements or fiduciary duties.

The Court unfortunately didn't fully resolve these questions.

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constitute forbidden "use" of the illegally leaked secret.

201. *New York v. Ferber*, 458 U.S. 747, 758, 763 (1982).

202. 532 U.S. 514 (2001).

203. Revealing trade secrets, like revealing the contents of telephone conversations, jeopardizes individual privacy and not just business assets: Confidential and potentially embarrassing business plans are often contained in documents written by particular people, and the publication of such information—which often identifies and embarrasses the employees responsible for the plans—can thus violate these people's expectations of confidentiality.

204. See Rodney A. Smolla, *Information as Contraband: The First Amendment and Liability for Trafficking in Speech*, 96 NW. U. L. REV. 1099, 1166–67 (2002) (discussing this issue).

First, the *Bartnicki* decision itself was splintered: Though a six-Justice majority held that the law was unconstitutional at least as to statements on matters of public concern—“privacy concerns give way when balanced against the interest in publishing matters of public importance”<sup>205</sup>—two of the six Justices said, in a concurrence, that their judgment rested on the conclusion that the speech in this case was of “unusual public concern, namely, a threat of potential physical harm to others.”<sup>206</sup> Second, the plurality’s argument was based in part on the empirical conclusion that the ban on illegal interception would usually deter such interception, and that the ban on dissemination would provide little additional deterrent.<sup>207</sup> It’s not clear whether this conclusion is accurate even for the statute involved in this very case,<sup>208</sup> but in any event, it limits the case’s precedential value.

But in the process of reaching its decision, the plurality also made the following assertion: “We need not decide whether that interest [in preserving privacy] is strong enough to justify the application of § 2511(c) to disclosures of trade secrets or domestic gossip or other information of purely private concern.”<sup>209</sup> This suggests that trade secrets are either per se “information of purely private concern” or at least constitutionally on par with “domestic gossip or other information of purely private concern,” rather than with the “negotiations over the proper level of compensation for teachers” that the Court described as being the general topic of *Bartnicki*’s conversation.<sup>210</sup>

It seems to me the Court erred in characterizing trade secrets this way. As I mentioned above, trade secrets can often be matters of significant public concern to a company’s employees, customers, neighbors, or regulators. It would be a shame if the Court’s casual, offhanded dictum led lower courts to quickly uphold the ban on third-party publication of trade secrets based on an unsupported assertion about their inherent “private concern” status.

But beyond this, the Court’s assertion further illustrates the dangers of casting First Amendment tests in terms of whether the speech is on a matter of “public concern.” Every time the Court has decided that certain speech is not on a matter of public concern, it has erred.

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205. 532 U.S. at 534.

206. *Id.* at 535 (Breyer, J., concurring).

207. *Id.* at 531–32.

208. *See id.* at 550–52 & n.9 (Rehnquist, C.J., dissenting).

209. *Id.* at 533.

210. *Id.* at 533, 535.

In *Connick v. Myers*, the Court held that the First Amendment generally doesn't protect government employees from being fired for speech unless the speech is on matters of public concern.<sup>211</sup> In theory, this may seem like a plausible conclusion, but the Court then proceeded to hold that speech among employees in the district attorney's office about "the confidence and trust that [employees] possess in various supervisors, the level of office morale, and the need for a grievance committee" was "not of public concern."<sup>212</sup> This hardly fits the normal understanding of "public concern"—we wouldn't be surprised or offended, for instance, if we saw a newspaper article discussing morale at the district attorney's office.<sup>213</sup>

Government employers may well need to have considerable flexibility to fire employees for speech that the government as sovereign cannot punish through criminal or civil liability. But even if *Connick* was correct to uphold the government's action, this simply shows that "public concern" isn't the proper test there.

Likewise, in *Dun & Bradstreet, Inc. v. Greenmoss Builders*, the Court held that punitive damages should be allowed in libel cases even without a showing of "actual malice" when the libel wasn't on a matter of a public concern; and again, this seems like a plausible conclusion. But the Court went on to hold that a report about a company's bankruptcy wasn't a matter of "public concern," something that would surprise the company's employees, creditors, and customers, as well as local journalists who might well cover the bankruptcy of even a small company in their small town.<sup>214</sup>

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211. 461 U.S. 138, 154 (1983).

212. *Id.* at 147–48.

213. Lower courts have likewise found that speech wasn't of public concern even when it alleged race discrimination by a public employer, criticized the way a public university department is run, and criticized the FBI's layoff decisions—not results that fit well with conventional understandings of what's a matter of legitimate public concern. See *Murray v. Gardner*, 741 F.2d 434 (D.C. Cir. 1984); *Lipsey v. Chi. Cook County Criminal Justice Comm'n*, 638 F. Supp. 837 (N.D. Ill. 1986); *Landrum v. E. Ky. Univ.*, 578 F. Supp. 241 (E.D. Ky. 1984); Volokh, *Freedom of Speech and Information Privacy*, *supra* note 9, at 1097.

214. *Dun & Bradstreet, Inc., v. Greenmoss Builders Inc.*, 472 U.S. 749, 789 (1985) (Brennan, J., dissenting) (arguing that "an announcement of the bankruptcy of a local company is information of potentially great concern to residents of the community where the company is located"). *Greenmoss Builders* was located in Waitsfield, Vermont, a town that in 2000 had under 2000 residents. See Superior Court Complaint, *in* Joint Appendix, *Dun & Bradstreet, Inc. v. Greenmoss Builders, Inc.*, No. 83-18 (U.S. 1983); Central Vermont Regional Planning Commission, *Waitsfield Town: Census 2000 Data Report, Sec. 1: General Population Data*, at <http://www.badc.com/towns/census00/waitsfield00.pdf> (last visited July 26, 2003).

Again, perhaps the ultimate result (allowing punitive damages liability) was correct, because the report was sent only to a small group of credit report subscribers. But that relates to whether the speech is being made public, not whether it's on a matter of public concern.

The one lower court case that applies *Bartnicki* to trade secrets, *DVD Copy Control Ass'n v. Bunner*,<sup>215</sup> similarly erred in deciding what constitutes speech on matters of public concern. Bunner had published on his Web site a computer program that decrypts encrypted DVDs; the California Supreme Court assumed, given the case's procedural posture, that the program was derived from algorithms that were plaintiffs' trade secrets, and that had been improperly leaked to Bunner.

The court then went on to hold that, though publishing computer source code is protected by the First Amendment—because such code “is an expressive means for the exchange of information and ideas about computer programming”<sup>216</sup> (computer professionals can and do read such code to understand how an algorithm works)—Bunner's publication could be enjoined. Bunner, the court reasoned, “did not post [the source code] to comment on any public issue or to participate in any public debate,” and “only computer encryption enthusiasts are likely to have an interest in the *expressive* content—rather than the uses—of DVD CCA's trade secrets.”<sup>217</sup> Therefore, in the court's view:

[d]isclosure of this highly technical information adds nothing to the public debate over the use of encryption software or the DVD industry's efforts to limit unauthorized copying of movies on DVD's. . . . The expressive content of these trade secrets therefore does not substantially relate to a legitimate matter of public concern.<sup>218</sup>

But as the court itself acknowledged, “computer encryption enthusiasts”—engineers, academics, and others—*are* likely to be interested in this sort of encryption technology; and the First Amendment shields ideas that relate to science as well as politics.<sup>219</sup> The content of the trade secrets *does* relate to a legitimate matter of scientific concern; it may well be of interest

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215. 75 P.3d 1 (Cal. 2003).

216. *Id.* at 10 (quotation marks omitted).

217. *Id.* at 16.

218. *Id.*

219. *Id.* at 10 (stating that the First Amendment protects ideas related to “science,” including “technical scientific information . . . and scientific research” (quoting *Junger v. Daley*, 209 F.3d 481, 484 (9th Cir. 2000), and *Universal City Studios, Inc. v. Corley*, 273 F.3d 429, 447 (2d Cir. 2001))).

only to a small section of the public, but that's equally true of many important facts.

The source code may also be relevant, contrary to the court's assertions,<sup>220</sup> to debate about encryption policy and intellectual property policy: For instance, when deciding what legal rules should protect intellectual property, policymakers and citizens might well want to know whether particular technical protections are easy to evade or hard to evade, and the source code of such an evasion mechanism is important evidence on that score. But in any event, the code is clearly of legitimate concern to computer scientists and engineers, as well as to people who are thinking about encryption policy.

What's more, if the court's argument is accepted, then courts would be allowed to treat a wide range of scientific information published in scientific journals as being merely of private concern and thus less constitutionally protected. After all, even if some source code—or for that matter a textual discussion that was based on the secret source code—was published as part of a scholarly article on encryption, it would still be of interest “only [to] computer encryption enthusiasts.”<sup>221</sup> The subject matter of the speech would still be the same, and would thus be equally unrelated “to a legitimate matter of public concern.” Courts would thus be able to enjoin such supposedly unimportant speech, either if the speech stems (directly or indirectly) from trade secrets illegally leaked by others, or perhaps also when the allegedly low-value speech implicates some other government interests.

Perhaps the sentence “[Bunner] did not post [the source code] to comment on any public issue or to participate in any public debate”<sup>222</sup> might be interpreted as making the test turn on the speaker's motive—though the legitimate public concern inquiry sounds like it should focus on relevance to listeners (the public), and not on the speaker's intentions. But even so, the computer scientist's motive would still be seen as unworthy under the California Supreme Court's opinion, which suggests that speech that's interesting “only [to] computer encryption enthusiasts” shouldn't be treated as involving “public issue[s]” or “public debate[s].”<sup>223</sup> And this result, I think, would be quite harmful: Discussion of scientific issues often is of no less public

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220. See *id.* at 16 (asserting that “[d]isclosure of this highly technical information adds nothing to the public debate over the use of encryption software or the DVD industry's efforts to limit unauthorized copying of movies on DVD's”).

221. *Id.*

222. *Id.*

223. *Id.*

concern than much discussion of politics, both for its own sake and because scientific and political issues are often ultimately interrelated.<sup>224</sup>

Put together, then, *Connick*, *Dun & Bradstreet*, and *Bartnicki* illustrate that the Court has not been very good at deciding what is a matter of “public concern” and what isn’t; and *Bunner* suggests that this will continue to be so as lower courts apply a “public concern”/“private concern” distinction to trade secret cases. And this, I think, is no accident. What is or is not a matter of legitimate public concern is a highly subjective judgment. Most such matters of taste are left to individual speakers and listeners to determine; courts generally don’t decide what’s “mere entertainment” and what’s ideological commentary,<sup>225</sup> or what’s vulgarity and what’s lyric.<sup>226</sup>

Likewise, it shouldn’t be for courts to decide what is a matter of “public concern” and what isn’t. When judges do make such decisions, the decisions may tend to simply reflect their judgments about who should win or lose in this case, rather than more principled judgments about the actual value of the speech to the public.<sup>227</sup>

And if I’m right on this, then this may have broader implications for trade secret law as well. One possible rule for disseminator liability in trade secret cases—like the rule that the *Bartnicki* majority and concurrence seem to be suggesting for cellular interception cases—may turn on whether the speech is

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224. One might argue that *Bunner*’s speech should indeed be enjoined or at least punished because it facilitates illegal conduct—the unauthorized copying of DVDs—and may have been intended to do that. This, though, is quite a different rationale than the one the Court used: It would apply only to speech that facilitates such misbehavior, whether or not it’s based on improperly leaked secrets, rather than to all technical scientific speech that’s based on leaked secrets, whether or not it facilitates crimes or torts. See generally Volokh, *Crime-Facilitating Speech*, *supra* note 94. If courts believe it’s proper to restrict harm-facilitating speech, they should focus on defining that category, rather than on inquiring—in my view unsoundly—into whether the speech is of “public concern.”

225. See *Winters v. New York*, 333 U.S. 507, 510 (1948).

226. See *Cohen v. California*, 403 U.S. 15, 25 (1971).

227. Cf. *Rosenbloom v. Metromedia, Inc.*, 403 U.S. 29, 79 (1971) (Marshall, J., dissenting).

[A]ssuming that . . . courts are not simply to take a poll to determine whether a substantial portion of the population is interested or concerned in a subject, courts will be required to somehow pass on the legitimacy of interest in a particular event or subject [and thus on] what information is relevant to self-government. The danger such a doctrine portends for freedom of the press seems apparent.

*Id.* (citation omitted); Cynthia L. Estlund, *Speech on Matters of Public Concern: The Perils of an Emerging First Amendment Category*, 59 GEO. WASH. L. REV. 1, 30 (1990); Robert C. Post, *The Constitutional Concept of Public Discourse: Outrageous Opinion, Democratic Deliberation, and Hustler Magazine v. Falwell*, 103 HARV. L. REV. 601, 670–79 (1990).

on matters of public concern, or, if the concurrence prevails, of “unusual public concern.” For instance, a newspaper would be free to publish information about a secret business plan that might cost the jobs of thousands of workers, or that might cause what some think to be serious environmental harm, but not information about matters that are supposedly less important. But if my criticism of the courts’ ability to draw the public concern line is sound, then this line would be inapt in trade secret cases as well. All third-party dissemination of trade secrets would therefore have to be constitutionally protected, regardless of whether the secret is on a matter of public concern, or all such dissemination would have to be constitutionally unprotected, or at least the defenders of some intermediate line would have to offer some definition beyond simply “public concern.”

## VI. CONCLUSION

Copyright law, trademark law, and trade secret law, I have argued in this article, are generally constitutional. Though they are speech restrictions, they are in most cases constitutionally permissible speech restrictions—not because they are intellectual property rules, but for various other reasons that are reflected in First Amendment doctrine (such as the copyright exception, the commercial speech doctrine, and the principle that people may waive their free speech rights).

The First Amendment, though, continues to impose important limits even on these restrictions, and I’ve pointed to some such specific limits. My hope is that these observations can in some measure help advance our understanding of how First Amendment doctrine can affect intellectual property rules, and of how intellectual property rules can affect First Amendment doctrine.