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## Intellectual Property and the Presumption of Innocence

Irina D. Manta

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INTELLECTUAL PROPERTY AND THE PRESUMPTION  
OF INNOCENCE

IRINA D. MANTA\*

ABSTRACT

*Our current methods of imposing criminal convictions on defendants for copyright and trademark infringement are constitutionally defective. Previous works have argued that due process under the Sixth Amendment requires prosecutors to prove every element of a crime beyond a reasonable doubt, including the jurisdictional element. Applying this theory to criminal trademark counterfeiting results in the conclusion that prosecutors should have to demonstrate that an infringing mark needs to have traveled in or affected*

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\* Associate Professor of Law and Director of the Center for Intellectual Property Law, Maurice A. Deane School of Law at Hofstra University; Yale Law School, J.D.; Yale College, B.A. I would like to thank David Abrams, Richard Albert, Jonas Anderson, Shyam Balganes, Jack Balkin, Mark Bartholomew, Ann Bartow, Will Baude, Chris Beauchamp, Barton Beebe, Josh Blackman, Chris Buccafusco, Michael Burstein, Greg Dolin, Joseph Fishman, Susy Frankel, Jeanne Fromer, Brian Frye, Daniel Gervais, Cynthia Godsoe, Philip Hamburger, Kevin Hickey, Timothy Holbrook, Camilla Hrdy, Margot Kaminski, Sapna Kumar, Joseph Landau, Brian Lee, Amanda Levendowski, Jake Linford, Michael Mattioli, Andrea Matwyshyn, Mark McKenna, George Mocsary, Christina Mulligan, Janewa OseiTutu, Sabeel Rahman, Cassandra Robertson, Zvi Rosen, Elizabeth Rowe, Andres Sawicki, Christopher Seaman, Sean Seymore, Jeremy Sheff, Jacob Sherkow, Michael Simkovic, Katherine Strandburg, Eva Subotnik, Olivier Sylvain, Robert Wagner, and my research assistants Allyson Beach, Neha Chopra, Erik Harmon, Reema Mahbubani, Jason Mencher, and James O'Connor. I am also grateful to the participants of the Yale Law School Information Society Project Ideas Lunch Workshop, Vanderbilt University Law School Inaugural Intellectual Property Scholars Roundtable, New York Area Junior Faculty Colloquium at Fordham University, University of Houston Law Center IPIL Colloquium, Fourth Annual Tri-State Region IP Workshop at the New York University School of Law, Junior Scholars Workshop at Columbia Law School, University of Baltimore School of Law Faculty Workshop, Junior Intellectual Property Scholars Workshop at the Florida State University College of Law, and 2013 Intellectual Property Scholars Conference at Cardozo Law School. Finally, my appreciation goes to the Maurice A. Deane School of Law at Hofstra University and its staff for support during my research.

*interstate commerce, which currently is not mandated. Parallel to this construction of the Commerce Clause, criminal prosecutors would also have to prove that Congress has the power to reach individual copyright infringers under the Intellectual Property Clause. This presents little difficulty under the traditional understanding of the clause as prosecutors would need to show only that convicting a defendant serves to secure the rights of authors. Some contemporary scholars have argued, however, that the text of the Intellectual Property Clause must be understood to mean that Congress can only enact copyright legislation if it serves to promote progress. If this notion is correct and is combined with this Article's theory of the Sixth Amendment's requirements, prosecutors would have to prove that individual convictions will serve to promote progress before courts can impose sentences in given cases. Although this requirement could raise costs and potentially reduce the number of cases brought, prosecutors may have little choice but to introduce expert testimony to demonstrate an effect on progress, similar to the use of expert evidence in antitrust litigation and related contexts.*

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## INTRODUCTION

There is a world of difference between committing a murder and manufacturing knockoff handbags. One would therefore not expect that the case of Montana woman Jordan Linn Graham—who allegedly intentionally pushed her husband off a cliff during an argument just days after their wedding—bears much relation to that of a counterfeiter of materials protected by intellectual property (IP) laws.<sup>1</sup> In spite of the moral and social differences between the two crimes, they are united by common features of constitutional criminal procedure. The ability of prosecutors to have either Graham or a counterfeiter convicted in federal court depends on the existence of a nexus to the constitutional text that establishes Congress’s power to legislate. Even though manslaughter is usually a creature of state rather than federal law, prosecutors had no trouble with this aspect of the Graham case because the incident occurred in a national park.<sup>2</sup> Meanwhile, although copyright law and most of current trademark law are properly governed by federal statutes in the civil context, this Article shows that federal criminal prosecutions for IP offenses today are potentially more questionable from a constitutional perspective than the prosecution of Graham’s lethal marital dispute.

Thus far, most of the debate surrounding the use of criminal sanctions to combat intellectual property infringement has focused on the wisdom of introducing or strengthening them.<sup>3</sup> This Article

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1. See Amanda Watts, *Newlywed Wife Accused of Pushing Husband off Montana Cliff*, CNN (Sept. 11, 2013, 6:33 AM), <http://www.cnn.com/2013/09/10/us/montana-husband-death/index.html> [http://perma.cc/B3T6-WFT9]. Graham later pleaded guilty to second-degree murder. See Michael Martinez & Kyung Lah, *Montana Newlywed Jordan Linn Graham Pleads Guilty in Husband’s Murder*, CNN (Dec. 12, 2013, 10:12 PM), <http://www.cnn.com/2013/12/12/justice/montana-newlywed-death-trial> [http://perma.cc/F9A2-VEKE].

2. See Graham Winch, *Attorney: Newlywed’s Fall Was “Accident,”* HLN (Sept. 13, 2013, 3:51 PM), [http://www.hlnv.com/article/2013/09/13/montana-bride-jordan-graham-cody-johnson-newlywed-death?hpt=hp\\_t2](http://www.hlnv.com/article/2013/09/13/montana-bride-jordan-graham-cody-johnson-newlywed-death?hpt=hp_t2) [http://perma.cc/U7TJ-DEGY]; see also Brian C. Kalt, *The Perfect Crime*, 93 GEO. L.J. 675, 678 (2005) (showing how criminal law may prove to be unable to govern a strip of land near Yellowstone National Park because the defendant’s constitutional right “to a jury trial and an impartial jury of inhabitants of the state and district where the crime was committed” cannot be satisfied in that area).

3. See, e.g., Irina D. Manta, *The High Cost of Low Sanctions*, 66 FLA. L. REV. 157, 160 (2014) [hereinafter Manta, *High Cost*]; Irina D. Manta, *The Puzzle of Criminal Sanctions for*

asks a more foundational question: Are federal criminal sanctions for IP offenses constitutional on their face and as applied? As a related matter, does the answer to that question differ in the case of criminal sanctions for copyright infringement, for which Congress draws its authority from the IP Clause of the Constitution,<sup>4</sup> as opposed to those for trademark infringement, which Congress regulates under the auspices of the Commerce Clause? The analysis of these questions demonstrates that criminal prosecutions for intellectual property violations do not honor the constitutional obligation to maintain the presumption of innocence for defendants, and shows what courts need to do to fix this error.<sup>5</sup>

The Constitution explicitly discusses the authority of Congress to use criminal punishments in only four places. First, it empowers Congress “[t]o provide for the Punishment of counterfeiting the Securities and current Coin of the United States.”<sup>6</sup> Second, Congress shall be able “[t]o define and punish Piracies and Felonies committed on the high Seas, and Offences against the law of nations.”<sup>7</sup> Third, Congress may “exercise exclusive legislation” over federal property, which arguably includes the area of criminal law.<sup>8</sup> Fourth, the Constitution specifies that “Congress shall have Power to declare the Punishment of Treason.”<sup>9</sup> Federal criminal law, however, covers a multitude of offenses not even remotely connected to these

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*Intellectual Property Infringement*, 24 HARV. J.L. & TECH. 469, 473 (2011) [hereinafter Manta, *Puzzle of Criminal Sanctions*].

4. The IP Clause, also known as the Copyright Clause, exists “[t]o promote the Progress of Science and Useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.” U.S. CONST. art. I, § 8, cl. 8.

5. See *infra* Part II.B-D.

6. U.S. CONST. art. I, § 8, cl. 6.

7. *Id.* cl. 10. During the debates at the North Carolina constitutional ratifying convention, the future Supreme Court Justice James Iredell stated: “They have power to define and punish piracies and felonies committed on the high seas, and offences against the law of nations. They have no power to define any other crime whatever.” Statement of James Iredell (July 29, 1788), in 4 THE DEBATES IN THE SEVERAL STATE CONVENTIONS ON THE ADOPTION OF THE FEDERAL CONSTITUTION, AS RECOMMENDED BY THE GENERAL CONVENTION AT PHILADELPHIA, IN 1787, at 219 (photo. reprint 1941) (Jonathan Elliot ed., 2d ed. 1891) [hereinafter ELLIOT’S DEBATES]; see also Eugene Kontorovich, *Discretion, Delegation, and Defining in the Constitution’s Law of Nations Clause*, 106 NW. U. L. REV. 1675, 1702 n.131 (2012) (providing sources that echo or discuss this sentiment).

8. U.S. CONST. art. I, § 8, cl. 17.

9. *Id.* art. III, § 3, cl. 3.

four areas.<sup>10</sup> Similarly, the criminal punishment of intellectual property infringement has not been and cannot be justified as part of these four delegations of power.

Rather, the many criminal laws enacted despite their lack of a relationship to these four areas have generally been justified as constitutional due to their role in enforcing other enumerated powers, or as necessary and proper in the pursuit of congressional regulation under the Commerce Clause.<sup>11</sup> The traditional story would place copyright-related criminal sanctions into the former category and trademark-related criminal sanctions into the latter and would justify their existence accordingly. This Article argues, however, that matters are not so simple and that several uncomfortable questions arise as one digs more deeply into the constitutionality of these sanctions.

Complications stem mainly from the prosecutor's burden to prove the facts of each offense beyond a reasonable doubt. The case of Jordan Linn Graham illustrates that one such set of facts is the relationship between each particular defendant and the constitutional mandate that allows federal courts to punish that defendant. In the Graham case, a federal prosecutor not only had to show that the defendant killed her husband, but also that she did so *in a national park*. The federal power to prosecute her hinged on that fact—if she killed him elsewhere, no federal court could convict her. Criminal prosecutions for trademark and copyright offenses are no different: there needs to be a “jurisdictional hook” for a federal court to convict each defendant.<sup>12</sup> This Article shows that for trademark counterfeiting, prosecutors should have to prove beyond a reasonable doubt

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10. The current estimate is that there are between 4000 and 5000 federal criminal statutes, but nobody knows the exact number because no comprehensive list exists. There may also be over 300,000 different statutory or regulatory offenses that contain the possibility of criminal penalties. See Edwin Meese, III, *Overcriminalization in Practice: Trends and Recent Controversies*, 8 SETON HALL CIRCUIT REV. 505, 509-10 (2012). When recently asked to provide a list of the approximately 4500 criminal provisions in effect, the Congressional Research Service refused to do so, citing lack of manpower and resources to complete the task. See Todd Ruger, *Way Too Many Criminal Laws, Lawyers Tell Congress*, BLOG LEGALTIMES (June 14, 2013, 1:18 PM), <http://legaltimes.typepad.com/blt/2013/06/way-too-many-criminal-laws-lawyers-tell-congress.html> [<http://perma.cc/U8K8-7FZX>].

11. For a discussion of Congress's power in this area as related to the concerns of the Anti-Federalists, see, for example, Michael J. Zydney Mannheimer, *Cruel and Unusual Federal Punishments*, 98 IOWA L. REV. 69, 101-02 (2012).

12. 1 WAYNE R. LAFAVE ET AL., CRIMINAL PROCEDURE § 1.2(c), at 34-35 (3d ed. 2007).

that a defendant sold or transported a counterfeit good in interstate commerce or that the good affected interstate commerce. This Article also demonstrates that in the context of criminal copyright infringement cases, prosecutors should have to show that convicting a defendant will serve to secure the exclusive rights of a copyright owner. Doing so is straightforward under the traditional view of the IP Clause. Yet, this is not necessarily the case if one accepts a more limiting reading, which would only allow Congress to enact IP laws that promote progress, as a number of scholars have advocated in recent years. If one adopts the narrower view, then under my theory of criminal due process, prosecutors would also have to demonstrate that the securing of rights is taking place in each case in a way that advances the progress of science and the useful arts beyond a reasonable doubt. These changes would reshape the landscape of criminal trademark and copyright prosecutions to varying degrees if courts adopted them.

In Part I, the Article examines how the Framers viewed the Constitution's relationship to criminal sanctions and how early court cases decided those issues. The Article then discusses the history of federal criminal sanctions since the Founding and how the Supreme Court has handled some key constitutional challenges to such sanctions. Part II evaluates the merits of possible constitutional challenges to federal criminal sanctions for intellectual property violations.

### I. FEDERAL CRIMINAL LAW FROM THE FOUNDING TO THE MODERN ERA

This Part shows the Framers' views of criminal law and highlights some key congressional and judicial developments regarding federal criminal law between the Founding and today. Rather than trying to cover all the related statutes and cases in that period, this Part focuses on those events and arguments that provide the most important pieces of information necessary to evaluate the constitutionality of federal criminal sanctions for intellectual property.<sup>13</sup>

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13. For this analysis, see *supra* Part II.



A. *The Framers' Views of Federal Criminal Law*

Although punishing crimes is an important function of government, and thirty-four of the fifty-five delegates at the Constitutional Convention were either lawyers or had studied law, criminal law was not a major topic of discussion.<sup>14</sup> When the Constitution was enacted, it was understood that the federal government was not to have a general police power like that of the state governments.<sup>15</sup> We have some information about the Framers' general views on appropriate levels of punishment, but we know much less about their opinions on the proper division between federal and state authority over crimes.<sup>16</sup> The *Federalist Papers* reveal only scant consideration of issues involving federal criminal law on the part of the Framers.<sup>17</sup> A search of the *Federalist Papers* reveals just seven instances in which the word "crime" or "crimes" appears and sixteen instances in which the word "criminal" is used.<sup>18</sup> Most of these appearances occur in *Federalist No. 83*, written in part to respond to states' concerns that the Constitution would not explicitly provide for a trial by jury in civil cases.<sup>19</sup> In *Federalist No. 83*, Alexander Hamilton argued against the theory that just because the Constitution would explicitly provide for trial by jury only in criminal cases, the silence on this matter for civil cases "is an implied prohibition of trial by jury in regard to the latter. The rules of legal interpretation are rules of *commonsense*."<sup>20</sup> Hamilton basically argued against an overly

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14. JOHN D. BESSLER, *CRUEL & UNUSUAL: THE AMERICAN DEATH PENALTY AND THE FOUNDERS' EIGHTH AMENDMENT* 115 (2012).

15. LAFAVE ET AL., *supra* note 12, § 1.2(c); *see* ELLIOT'S DEBATES, *supra* note 7.

16. RONALD J. PESTRITTO, *FOUNDING THE CRIMINAL LAW: PUNISHMENT AND POLITICAL THOUGHT IN THE ORIGINS OF AMERICA* 119-38 (2000).

17. The *Federalist Papers* consist of the eighty-five essays that Alexander Hamilton, James Madison, and John Jay wrote in 1787 and 1788 to elaborate on the Constitution and encourage its ratification in the state of New York. Gregory E. Maggs, *A Concise Guide to the Federalist Papers as a Source of the Original Meaning of the United States Constitution*, 87 B.U. L. REV. 801, 802 (2007).

18. THE FEDERALIST NO. 83, at 420 (Alexander Hamilton) (Ian Shapiro ed., Yale Univ. Press 2009).

19. *Id.*

20. *Id.* Of course, the Bill of Rights did ultimately provide a right to jury trial in both civil and criminal cases. U.S. CONST. amends. VI, VII; *see also* Cassandra Burke Robertson, *Judging Jury Verdicts*, 83 TUL. L. REV. 157, 190 (2008) (discussing judges' discretion to reexamine factual findings in the criminal and civil contexts based on the history and text of the Seventh

expansive understanding of the principle of statutory interpretation of *expressio unius est exclusio alterius*.<sup>21</sup> At the same time, although he stated that juries would not be prohibited in civil cases, one cannot conclusively ascertain from his statement that they should be mandated like in criminal cases either. Hamilton may have thought that the enumeration of four areas of congressional authority over criminal legislation need not mean that such legislation outside these areas would be out of the question if it was necessary and proper.<sup>22</sup> Hamilton concluded *Federalist No. 83* by dismissing the idea “that there is no security for liberty in a Constitution which expressly establishes the trial by jury in criminal cases, because it does not do it in civil also.”<sup>23</sup>

The other *Federalist Papers* provide few clues about the Framers’ thoughts on the subject of criminal punishment. At one point, James Madison emphasized in a more general context that the powers of the federal government were limited to a few defined ones that would mainly focus on war, peace, negotiation, foreign commerce, and taxation.<sup>24</sup> The state governments would deal with the vast remainder of subjects “which, in the ordinary course of affairs, concern the lives, liberties, and properties of the people, and the internal order, improvement, and prosperity of the State.”<sup>25</sup> In a separate essay, Madison also explained the necessity of having the federal government punish monetary counterfeiting: “The punishment of counterfeiting the public securities, as well as the current coin, is submitted of course to that authority which is to secure the value of both.”<sup>26</sup> The text lists counterfeiting as a separate offense because the Constitution adopted a more limited definition of treason rather than the common law understanding, which had included counterfeiting.<sup>27</sup> Monetary counterfeiting had to be listed

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Amendment).

21. “[T]he mention of one thing implies the exclusion of the other.” *Hardy v. N.Y.C. Health & Hosps. Corp.*, 164 F.3d 789, 794 (2d Cir. 1999).

22. Some of the Framers feared the potential of the Necessary and Proper Clause to override states’ rights. *See, e.g.*, 1 ANNALS OF CONG. 455-56 (Joseph Gales ed., 1834) (discussing that concern during the proceedings of June 8, 1789).

23. THE FEDERALIST NO. 83, *supra* note 18, at 429.

24. THE FEDERALIST NO. 45, *supra* note 18, at 237 (James Madison).

25. *Id.*

26. THE FEDERALIST NO. 42, *supra* note 18, at 217 (James Madison).

27. BESSLER, *supra* note 14, at 115.

on its own in the Constitution if the federal government was to have the power to punish it.

*B. Federal Criminal Law Between the Founding and the New Deal*

Shortly after the Constitution was ratified, Congress passed what came to be called the Crime Act of 1790.<sup>28</sup> The law sought to punish a number of different offenses. The first set consisted of the types of crimes specifically enumerated in the Constitution: treason, piracy and other crimes on the high seas or that violated the law of nations, and crimes taking place in areas of sole federal jurisdiction.<sup>29</sup> The law also addressed many other offenses, however, such as bribery of federal judges, interference with the judicial process, freeing federal prisoners, and theft or falsification of court records.<sup>30</sup> Even before the Crime Act of 1790, Congress had enacted criminal penalties for actions such as unloading ships in the dark or without a license, or being a census taker who fails to report his findings; hence, several scholars have argued that “the First Congress did not view the list of topics of federal criminal law as implicitly negating authority to create other offenses when that was necessary and proper to the exercise of some other explicit federal power.”<sup>31</sup>

An important moment in this context occurred when the Supreme Court decided the seminal case of *McCulloch v. Maryland*, which dealt with the question of whether the federal government could charter a bank.<sup>32</sup> The case established that Congress has not only express but also implied powers, and that it may—via the Necessary and Proper Clause—pursue objectives that are rationally related to enumerated powers and not prohibited by the Constitution.<sup>33</sup> These powers include the ability to punish crimes.<sup>34</sup>

Most federal criminal sanctions created before the Civil War were “self-defensive criminal jurisdiction,” criminal prohibitions

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28. Act of Apr. 30, 1790, ch. 9, 1 Stat. 112.

29. *Id.* §§ 1, 3, 8, 1 Stat. at 112-13.

30. *Id.* §§ 15, 21-23, 1 Stat. at 116-17.

31. *E.g.*, David P. Currie, *The Constitution in Congress: Substantive Issues in the First Congress, 1789-1791*, 61 U. CHI. L. REV. 775, 833 (1994).

32. 17 U.S. (4 Wheat.) 316, 322 (1819).

33. *See id.* at 316.

34. *See id.* at 417.

protecting the operation of the federal government.<sup>35</sup> The main exception to this trend was criminal sanctions related to commercial interstate carriers.<sup>36</sup> After the Civil War, Congress began interpreting its authority over criminal law more expansively and passing laws that often punished behaviors already criminalized under state law.<sup>37</sup> In an important signal to Congress about the limits of its power, the Supreme Court struck down Congress's attempt to criminalize discrimination by individuals, reasoning that the 1875 Civil Rights Act did not extend to the regulation of private citizens.<sup>38</sup>

Around the same period, the Supreme Court evaluated a criminal sanction related to intellectual property for the first time. In the *Trade-Mark Cases*, the Court decided whether criminal sanctions for trademark counterfeiting passed constitutional muster.<sup>39</sup> First, the Court ruled that Congress could not legislate trademarks via the IP Clause because trademarks qualified neither as writings nor discoveries, demanding in their creation "no fancy or imagination, no genius, no laborious thought."<sup>40</sup> Next, the Supreme Court turned its attention to whether Congress could regulate trademarks as part of its power over interstate commerce. The Court concluded that although Congress clearly had the authority to regulate commerce with foreign nations, between citizens of different states, and between U.S. citizens and foreign ones, "there still remains a very large amount of commerce, perhaps the largest, which, being trade or traffic between citizens of the same State, is beyond the control of Congress."<sup>41</sup> The Court explained that when Congress passed its original trademark legislation on registration and civil remedies in 1870, it failed to require that the commerce regulated fall into one of the above-mentioned permissible categories.<sup>42</sup> Thus, the criminal offenses passed in 1876, and predicated on the 1870 law, were unconstitutional just like the initial legislation.<sup>43</sup>

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35. LAFAYE ET AL., *supra* note 12.

36. *Id.*

37. *See id.*

38. *The Civil Rights Cases*, 109 U.S. 3, 11, 25 (1883).

39. 100 U.S. 82, 82 (1879).

40. *Id.* at 94.

41. *Id.* at 96.

42. *Id.* at 99.

43. *Id.* Congress later passed trademark legislation that was based on and conformed to the Commerce Clause requirements. *See, e.g.*, Xuan-Thao Nguyen & Jeffrey A. Maine, *The*

The Supreme Court was more generous toward congressional authority in upholding provisions that criminalized the use of postal channels in the service of fraud, lotteries, or obscenity,<sup>44</sup> the transportation of lottery tickets across state lines,<sup>45</sup> or the transportation in interstate commerce of women engaged in prostitution or related illicit activities.<sup>46</sup> The late nineteenth and early twentieth centuries saw an expansion in a variety of federal regulatory crimes as citizens' mobility increased, and it became more difficult for individual states to contain criminals on their own.<sup>47</sup> An example of this development was the Supreme Court's decision to uphold criminal sanctions against auto theft conspiracies that operated across state lines, preventing thieves from stealing cars in one place and driving them to other states where they could no longer be apprehended.<sup>48</sup>

By the 1930s, Congress confidently criminalized a wide variety of activities, including the transportation of a kidnapping victim across state lines, interstate flight to avoid being prosecuted for specific violent felonies, certain firearm-related offenses, interstate transportation of stolen property, robbery of a national bank, and extortion via the use of the phone, telegraph, or radio.<sup>49</sup> Expansion of the federal criminal law was thus well on its way before the beginning of the New Deal.

### *C. Federal Criminal Law After the New Deal*

The Supreme Court began taking a more lenient approach toward federal economic regulation in the 1930s. In *Wickard v. Filburn*, the Court famously upheld under the Commerce Clause a regulation that limited a farmer's ability to grow wheat for his own consumption because the aggregate impact of farmers doing so would have a sufficient effect on the interstate market (by reducing the overall

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*History of Intellectual Property Taxation: Promoting Innovation and Other Intellectual Property Goals?*, 64 SMU L. REV. 795, 821 n.133 (2011).

44. *In re Rapier*, 143 U.S. 110, 134-35 (1892).

45. *Champion v. Ames*, 188 U.S. 321, 354 (1903).

46. *Hoke v. United States*, 227 U.S. 308, 323 (1913).

47. Kathleen F. Brickey, *Criminal Mischief: The Federalization of American Criminal Law*, 46 HASTINGS L.J. 1135, 1141-44 (1995).

48. *See Brooks v. United States*, 267 U.S. 432, 438-39 (1925).

49. *See Brickey, supra* note 47, at 1143-44.

demand for wheat).<sup>50</sup> At that time, however, Congress preferred to enact federal criminal legislation that required proof in every prosecution of a “nexus” between the criminal act and interstate commerce (a nexus also known as a jurisdictional hook) rather than legislation justified by the aggregate impact of local crime on interstate commerce.<sup>51</sup> The Supreme Court later emphasized the importance of this hook in *United States v. Bass* by requiring it in the case of statutory ambiguity as a protection of federalism principles and a limit on Congress’s ability to improperly expand into the states’ province of law making.<sup>52</sup>

The Court, however, gave a fairly high degree of latitude to Congress when interpreting the connection to commerce, ruling in *Perez v. United States* that Congress could criminalize improper intrastate credit transactions without showing an effect on interstate commerce in every case.<sup>53</sup> Rather, looking to previous civil cases involving racial discrimination by hotels and restaurants, the Court held that Congress can legislate based on class activities and “[w]here the *class of activities* is regulated and that class is within the reach of federal power, the courts have no power ‘to excise, as trivial, individual instances’ of the class.”<sup>54</sup> This holding turned out to be incredibly important to later Supreme Court doctrine and opened the door to a wide variety of criminal laws against classes that allegedly had an impact on commerce, rather than individuals who had an impact.<sup>55</sup> As far as can be ascertained, however, nobody tried to mount a due process challenge based on the Sixth Amendment against this idea in *Perez* or its progeny.

Overall, the Supreme Court did not put up too many obstacles in the area of criminal legislation until *United States v. Lopez*, in which it held that an individual’s possession of a firearm near a school did not substantially affect commerce and therefore could not be criminalized under the Commerce Clause.<sup>56</sup> The government

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50. 317 U.S. 111, 118 (1942).

51. LAFAVE ET AL., *supra* note 12.

52. 404 U.S. 336, 339 (1971).

53. 402 U.S. 146, 156-57 (1971).

54. *Id.* at 154 (quoting *Maryland v. Wirtz*, 392 U.S. 183, 193 (1968)).

55. *See, e.g.*, Thane Rehn, Note, *RICO and the Commerce Clause: A Reconsideration of the Scope of Federal Criminal Law*, 108 COLUM. L. REV. 1991, 1996, 2020-35 (2008).

56. 514 U.S. 549, 567 (1995); *see also* *United States v. Morrison*, 529 U.S. 598, 601-02

tried to show a relationship between violent crime and interstate commerce, but the Court remained unconvinced, noting in part the lack of congressional findings on the matter.<sup>57</sup> In some ways it appeared that *Lopez* represented a break with the Court's reluctance to interfere with congressional decisions in the area of criminal law. But as discussed in the next Section, three recent cases show that the Court continues to grant a high degree of latitude in this area.

*D. The Most Recent Pronouncements of the Supreme Court on the Constitutionality of Federal Criminal Sanctions*

One of the most important recent tests of Congress's power appeared in *Gonzales v. Raich*, which considered whether individuals (or caregivers) who were growing medical marijuana in a manner permitted by the California Compassionate Care Act could be convicted under the Federal Controlled Substances Act for the possession and growth of this marijuana.<sup>58</sup> The Supreme Court, aligning the case with *Wickard* rather than with *Lopez* or *United States v. Morrison*, ruled that this criminalization was constitutional.<sup>59</sup> The majority concluded that the growth of marijuana involved economic activity like that in *Wickard* rather than non-economic activities like those in *Lopez*.<sup>60</sup> Looking to the reasoning in *Perez*, the Court held that "[w]hen Congress decides that the total incidence of a practice poses a threat to a national market, it may regulate the entire class."<sup>61</sup> The Court explained that it need not decide whether the aggregate of all medical marijuana users affect interstate commerce but only whether there is a rational basis to conclude that

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(2000) (holding that civil damages for gender-based violence was unconstitutional under the Commerce Clause, expressly endorsing the reasoning in *Lopez*).

57. *Lopez*, 514 U.S. at 563-64. For a discussion of the effect of *Lopez* on jurisdictional hooks in other types of statutes, see Christopher DiPompeo, Comment, *Federal Hate Crime Laws and United States v. Lopez: On a Collision Course to Clarify Jurisdictional-Element Analysis*, 157 U. PA. L. REV. 617 (2008).

58. 545 U.S. 1 (2005).

59. *Id.* at 9.

60. *Id.* at 18 ("The similarities between this case and *Wickard* are striking."). Justice O'Connor wrote in a dissent joined in part by two other Justices, however, that the case at bar was "materially indistinguishable from *Lopez* and *Morrison* when the same considerations are taken into account." *Id.* at 45 (O'Connor, J., dissenting).

61. *Id.* at 17 (majority opinion) (internal quotation marks omitted).



they do.<sup>62</sup> The Court reasoned that because Congress was legislating as part of a permissible comprehensive regulatory scheme, individual components should not be excised from that scheme.<sup>63</sup> Of particular interest to this Article, the statute under examination in *Raich* seemed to implicitly embody the view that the conduct it criminalized affected interstate commerce and never required prosecutors to show that the activity actually did.

Both Justice O'Connor and Justice Thomas filed vehement dissents in the case.<sup>64</sup> Justice O'Connor deplored the removal of any real limits on congressional power under the Commerce Clause and criticized Congress's failure to show that the intrastate cultivation and possession of marijuana for medical use actually had a substantial effect on interstate commerce.<sup>65</sup> She also stated:

If the Court is right, then *Lopez* stands for nothing more than a drafting guide: Congress should have described the relevant crime as “transfer or possession of a firearm anywhere in the nation”—thus including commercial and noncommercial activity, and clearly encompassing some activity with assuredly substantial effect on interstate commerce.”<sup>66</sup>

Justice Thomas wrote that Congress does not have the power to criminalize local growth and possession of marijuana under either the Commerce Clause or the Necessary and Proper Clause, and that this regulation would have been unimaginable in the early days of the Republic.<sup>67</sup> Justice Thomas charged: “The majority’s rewriting of the Commerce Clause seems to be rooted in the belief that, unless the Commerce Clause covers the entire web of human activity, Congress will be left powerless to regulate the national economy effectively.”<sup>68</sup> He did not believe that medical marijuana users in

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62. *Id.* at 22.

63. *Id.*

64. *Raich*, 545 U.S. at 42 (O'Connor, J., dissenting); *id.* at 57 (Thomas, J., dissenting).

65. *Id.* at 46-49 (O'Connor, J., dissenting).

66. *Id.* at 46. As a historical matter, that is ultimately what took place. Congress redrafted the Gun Free School Zones Act to include such a hook and several United States Courts of Appeals upheld the revised statute. *See, e.g.*, *United States v. Dorsey*, 418 F.3d 1038, 1045-46 (9th Cir. 2005); *United States v. Danks*, 221 F.3d 1037 (8th Cir. 1999).

67. *Raich*, 545 U.S. at 58-59 (Thomas, J., dissenting).

68. *Id.* at 70.



California and other states were placing substantial amounts of the drug into interstate commerce; thus, Congress should not be able to regulate their activities under the substantial effects test.<sup>69</sup> It is important to emphasize here that one's views of whether the decision in *Wickard* was correct need not determine one's opinion of the *Raich* outcome. The *Wickard* case concerned purely civil issues that do not involve the kinds of due process protections that the Constitution promises to criminal defendants.<sup>70</sup>

Another important case that raised similar issues as *Raich* followed in 2010. *United States v. Comstock* sought to resolve whether a federal statute permitting a district court to civilly commit a sexually dangerous prisoner beyond the end of his prison term was constitutional.<sup>71</sup> The Court found the practice constitutional for five reasons: (1) Congress has broad powers under the Necessary and Proper Clause;<sup>72</sup> (2) Congress has a long involvement in providing mental health care for federal prisoners;<sup>73</sup> (3) Congress acted reasonably in extending its ability to use civil commitment over individuals in federal custody even if the commitment detained them past their prison terms;<sup>74</sup> (4) the relevant statute properly took account of state interests;<sup>75</sup> and (5) the links between the statute and Congress's enumerated Article I powers were not too attenuated.<sup>76</sup>

Justice Thomas, dissenting, argued that no enumerated power gave Congress the authority to enact this type of civil-commitment regime.<sup>77</sup> He specifically faulted the majority for finding constitutionality on the basis that the statute is tied to existing laws that Congress had enacted rather than being tied to those powers actually listed in the Constitution.<sup>78</sup> Justice Thomas explained that the statute "requires no evidence that [a] sexually dangerous condition

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69. *Id.* at 73-74.

70. For a more extended discussion of the important differences between civil and criminal cases in this respect, see text accompanying *infra* Part II.E.

71. 560 U.S. 126, 129 (2010); see H. Jefferson Powell, *The Regrettable Clause: United States v. Comstock and the Powers of Congress*, 48 SAN DIEGO L. REV. 713, 714 (2011).

72. *Comstock*, 560 U.S. at 133.

73. *Id.* at 137.

74. *Id.* at 142.

75. *Id.* at 143.

76. *Id.* at 146.

77. *Id.* at 163 (Thomas, J., dissenting).

78. *Id.* at 167-68.

will manifest itself in a way that interferes with a federal law that executes an enumerated power or in a geographic location over which Congress has plenary authority.”<sup>79</sup> He did not believe that the enumerated powers that enable Congress to arrest or convict a defendant justify subsequent civil detention.<sup>80</sup> Rather, Justice Thomas thought that the federal government could only civilly detain a mentally ill person over whom it had federal criminal jurisdiction.<sup>81</sup> And as far as federalism issues are concerned, according to Justice Thomas, a law that falls outside the enumerated powers by definition intrudes on states’ rights.<sup>82</sup>

The third recent case that tested congressional power over criminal law is *United States v. Kebodeaux*, which addressed whether a registration requirement under the Sex Offender Registration and Notification Act (SORNA) was constitutional.<sup>83</sup> The Court upheld Congress’s decision to subject to SORNA’s requirements an individual already required to register under the Wetterling Act, a statute considered valid under the Military Regulation and Necessary and Proper Clauses.<sup>84</sup> In the Court’s view, Congress gathered enough evidence on the special recidivism issues concerning sex offenders to conclude that the statute had a reasonable basis, which was sufficient to pass constitutional muster.<sup>85</sup> Thus, SORNA’s changes were constitutionally appropriate as applied to the defendant.<sup>86</sup> Interestingly, although Justice Roberts concurred in the judgment, he warned against the risk that the majority opinion would be interpreted as granting a federal police power.<sup>87</sup> Despite having joined the majority opinion in *Comstock*, he stated that “[t]he fact of a prior federal conviction, by itself, does not give Congress a freestanding, independent, and perpetual interest in protecting the public from

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79. *Id.* at 171-72.

80. *Id.* at 171.

81. *Id.* at 176.

82. *Id.* at 179 n.16.

83. 133 S. Ct. 2496, 2500 (2013). For an examination of the relationship between the case and the issue of jurisdictional hooks, see Casey B. Nathan, *Searching for “Jurisdictional Hook”*: *United States v. Kebodeaux and the Constitutional Limits of the Sex Offender Registration and Notification Act*, 33 B.C. J.L. & SOC. JUST. 53 (2013).

84. *Kebodeaux*, 133 S. Ct. at 2504.

85. *Id.* at 2503.

86. *Id.* at 2505.

87. *Id.* at 2507 (Roberts, C.J., concurring).

the convict's purely intrastate conduct."<sup>88</sup> Meanwhile, Justice Alito concurred in the judgment because he viewed the decision as a proper extension of military jurisdiction given that the defendant had been convicted in a military court.<sup>89</sup>

Justices Scalia and Thomas dissented. In addition to joining most of Justice Thomas's dissent, Justice Scalia explained that he was not convinced "that the Wetterling Act's registration requirement was itself a valid exercise of any federal power, or that SORNA is designed to carry the Wetterling Act into execution. The former proposition is dubious, the latter obviously untrue."<sup>90</sup> Justice Thomas would have held SORNA unconstitutional as applied to the defendant because the law related neither to an enumerated power under Article 1, Section 8, nor to the Commerce Clause.<sup>91</sup> He wrote that "Congress does not retain a general police power over every person who has ever served in the military."<sup>92</sup> He disagreed with the majority that SORNA was quite similar to the existing Wetterling Act,<sup>93</sup> and questioned what a measure generally meant to protect the public has to do with regulating the armed forces.<sup>94</sup> Justice Thomas deplored that the Court had gone a step further than it had in *Comstock* given that the defendant in *Kebodeaux* was not even in federal custody when Congress enacted SORNA, and yet he became subject to the law's requirements.<sup>95</sup>

These recent cases exemplify the Supreme Court's unwillingness to rein in the holding from *Perez* or to limit *Wickard* to civil cases, contrary to what this Article argues it should be doing. The refusal to constrict federal power over criminal law largely crosses ideological lines, affecting the decisions of both Republican and Democratic appointees to the Supreme Court.<sup>96</sup> The Court's refusal has also

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88. *Id.*

89. *Id.* at 2509 (Alito, J., concurring).

90. *Id.* at 2509-10 (Scalia, J., dissenting).

91. *Id.* at 2512-13 (Thomas, J., dissenting).

92. *Id.*

93. *Id.* at 2514 n.3.

94. *Id.* at 2516.

95. *Id.* at 2517.

96. Justice Scalia joined Justices Kennedy, Souter, Ginsburg, and Breyer in upholding the Controlled Substances Act in *Gonzales v. Raich*, 545 U.S. 1, 33 (2005) (Scalia, J., concurring). Chief Justice Roberts and Justice Alito joined Justices Ginsburg, Sotomayor, and Kagan in upholding the Sex Offender Registration and Notification Act in *Kebodeaux*, 133 S. Ct. at 2499.

extended to the fates of individuals who were most likely engaged in victimless behavior, such as in *Raich*,<sup>97</sup> and those who suffered repercussions for their potential as future dangers to others, such as in *Comstock*<sup>98</sup> and *Kebodeaux*.<sup>99</sup> Viewing the defendants from these cases in the aggregate should give us particular pause, as all the cases involved defendants who were punished or seriously encumbered by the federal government, even though the likelihood that they would inflict harm on society was based on a heavy dose of conjecture. This is not to say that none of them could conceivably pose a danger. Rather, the question is how much deference Congress should receive in those areas as a constitutional matter.

## II. THE CASE FOR A CONSTITUTIONAL CHALLENGE TO CRIMINAL SANCTIONS FOR IP INFRINGEMENT

Congress has shown little concern that any of the criminal statutes it has enacted related to copyright or trademark infringement might be unconstitutional. The legislative history of the first federal statute criminalizing copyright infringement in 1897, which was limited to only public performance of a dramatic or musical work, gave no indication that enacting criminal copyright laws was in any way considered to exceed Congress's authority.<sup>100</sup> Although members of Congress objected to the criminalization of public performances of copyrighted works for being either too severe or an unnecessary measure to protect copyright owners, they did not discuss the constitutional source of congressional power to make copyright infringement a misdemeanor.<sup>101</sup> Similarly, in the legislative history leading up to the Copyright Act of 1909, which expanded criminal liability for copyright infringement to all works except for sound recordings, the discussion did not indicate that such laws could be beyond Congress's power to enact. At the proceedings of the Conference on Copyright—the body that discussed and drafted the

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97. *Raich*, 545 U.S. at 6-7 (majority opinion).

98. *United States v. Comstock*, 560 U.S. 126, 129 (2010).

99. *Kebodeaux*, 133 S. Ct. at 2503.

100. See Zvi S. Rosen, *The Twilight of the Opera Pirates: A Prehistory of the Exclusive Right of Public Performance for Musical Compositions*, 24 CARDOZO ARTS & ENT. L.J. 1157, 1203-07 (2007) (discussing the dynamics surrounding inclusion of criminal sanctions for copyright infringement at that time).

101. See 29 CONG. REC. 85-91 (1896).

1909 Act—some attendees debated whether the “penalty clause,” which would now be understood as a statutory or liquidated damages provision, should be framed in a moderate manner so as to convince Congress to adopt both the “penalty clause” provision and the criminal provision.<sup>102</sup> There may have been some sentiment that the combination of deterrent measures in the new law could amount to unnecessarily broad protection that Congress would be unwilling to adopt. There was no express indication, however, that greater protection would run afoul of the Constitution. Speakers during the hearings before the Committee on Patents directed any objections to the criminal provisions of the Act to the injustice of criminalizing infringement, but no one levied constitutional arguments against the law.<sup>103</sup>

The Trademark Counterfeiting Act of 1984 was the first federal law to criminalize trademark infringement following the Supreme Court’s invalidation of the early trademark statutes in the *Trade-Mark Cases*.<sup>104</sup> Again, like in the case of criminal copyright legislation, the legislative history contains no suggestion that Congress ever viewed criminal trademark infringement laws as unconstitutional.<sup>105</sup> And like in the criminal copyright context, objections to criminal trademark laws rested on the grounds that the imposition of criminal penalties for infringement represented too harsh a solution for the problems that counterfeiting posed, but opponents never stated that enacting criminal laws in this context exceeded Congress’s power if Congress deemed them necessary.<sup>106</sup> The proponents of the bill did, however, indicate that they wished to limit the criminal provisions to uses of trademarks in a commercial context,

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102. See 3 LEGISLATIVE HISTORY OF THE 1909 COPYRIGHT ACT 227, 229, 230 (E. Fulton Brylawski & Abe Goldman eds., 1976).

103. See *Pending Bills to Amend and Consolidate the Acts Respecting Copyright: Hearings Before the H. & S. Comms. on Patents*, 60 Cong. (1908), reprinted in 5 LEGISLATIVE HISTORY OF THE 1909 COPYRIGHT ACT, *supra* note 102, at 155.

104. For a discussion of the debates about the introduction of a criminal provision for trademark counterfeiting, see generally Zvi S. Rosen, *In Search of the Trade-Mark Cases: The Nascent Treaty Power and the Turbulent Origins of Federal Trademark Law*, 83 ST. JOHN’S L. REV. 827, 842-46 (2009).

105. See *Trademark Counterfeiting Act of 1984: Hearings on H.R. 2447 Before the Subcomm. on Crime of the H. Comm. on the Judiciary*, 98th Cong. (1984); H.R. REP. NO. 98-997 (1984); S. REP. NO. 98-526 (1984); 130 CONG. REC. 24,658-61 (1984).

106. See H.R. REP. NO. 98-997, at 35-36 (providing additional views of Robert W. Kastenmeier).

rather than simply possession of counterfeit goods or advertising, so as to avoid constitutional concerns.<sup>107</sup>

This Part argues that despite Congress's apparent lack of misgivings on the subject, constitutional concerns may exist about the current enforcement of criminal sanctions against copyright infringers and trademark counterfeiters.

#### A. A Due Process Critique of Federal Criminal Law

Shortly after the Supreme Court issued the *Raich* decision, Margaret Lemos criticized the Court's federal criminal law jurisprudence on the basis that some of it violated the constitutional requirement that all "the facts that expose an individual to criminal punishment be proved to a jury beyond a reasonable doubt."<sup>108</sup> She argued that Congress, with the blessing of the Court, has been using the Commerce Clause as a shield against meeting this requirement by tying the prohibited conduct to interstate commerce, the Court preferring to find those facts itself instead of submitting them to a jury in every case.<sup>109</sup> Some acts Congress has passed contain a so-called "jurisdictional element," which establishes the basis for federal power for every offense by showing a connection between a defendant's actions and interstate commerce and requiring prosecutors to show that this connection exists in any given case beyond a reasonable doubt.<sup>110</sup> But other statutes, like the one discussed in *Raich*, just involve the implicit conclusion that the type of conduct at bar affects interstate commerce.<sup>111</sup> Lemos believes that part of the problem is that the Supreme Court has simply imported its jurisprudence from civil Commerce Clause cases into the criminal arena and

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107. *See id.* at 10.

108. Margaret H. Lemos, *The Commerce Power and Criminal Punishment: Presumption of Constitutionality or Presumption of Innocence?*, 84 TEX. L. REV. 1203, 1203 (2006); *see In re Winship*, 397 U.S. 358, 364 (1970). For a discussion of due process issues arising under the Fifth Amendment as they relate to intellectual property in the form of gene patents, *see generally* Sapna Kumar, *Life, Liberty, and the Pursuit of Genetic Information*, 65 ALA. L. REV. 625 (2014).

109. Lemos, *supra* note 108.

110. *Id.* at 1205-06.

111. *Id.* *See generally* Tara M. Stuckey, Note, *Jurisdictional Hooks in the Wake of Raich: On Properly Interpreting Federal Regulations of Interstate Commerce*, 81 NOTRE DAME L. REV. 2101 (2006) (questioning the effect of jurisdictional elements post-*Raich*).

incidentally eliminated constitutionally mandated protections.<sup>112</sup> The Supreme Court itself in *United States v. Lopez* raised the problem of the lack of a jurisdictional element in the federal firearms possession statute as an argument against a finding of constitutionality. It criticized the statute for having “no express jurisdictional element which might limit its reach to a discrete set of firearm possessions that additionally have an explicit connection with or effect on interstate commerce.”<sup>113</sup> Such an “element ... would ensure, through case-by-case inquiry, that the firearm possession in question affects interstate commerce.”<sup>114</sup> One could thus argue that a consistent application of *Lopez* actually prevents Congress from leaving jurisdictional elements out of statutes in an attempt to evade constitutional requirements.

Under the Federal Rules of Evidence, judges can decide facts for themselves even in criminal cases, but the Rules limit this ability to facts generally known or easily ascertainable; juries receive explicit instruction that they are not required to accept such judicial notice as conclusive.<sup>115</sup> Scholars, such as Chip Carter, have warned that even if the Sixth Amendment and the Federal Rules of Evidence appear inefficient with respect to the jurisdictional elements of crimes, “the desire for efficiency should not trump the defendant’s right to jury trial.”<sup>116</sup> In other words, not all shortcuts are constitutional.

For federal criminal sanctions, cases like *Perez v. United States* introduced a dangerous heuristic by stating that Congress may regulate certain groups due to their effects on interstate commerce as a class even when the government demonstrated no effect in an individual case.<sup>117</sup> The decision in *Perez* has the constitutional analysis backwards when it states that courts do not have the power to excise individuals when Congress may otherwise regulate a class.<sup>118</sup> The default is supposed to be that the federal government can only regulate areas in which the Constitution allows it to do so. To say,

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112. Lemos, *supra* note 108, at 1205-07.

113. *United States v. Lopez*, 514 U.S. 549, 562 (1995).

114. *Id.* at 561.

115. See William M. Carter, Jr., “Trust Me, I’m a Judge”: Why Binding Judicial Notice of Jurisdictional Facts Violates the Right to Jury Trial, 68 MO. L. REV. 649, 650 (2003).

116. *Id.* at 690.

117. 402 U.S. 146 (1971).

118. *Id.*



like the *Perez* Court did, that courts cannot excise individuals from a class that Congress can regulate *presupposes* that Congress can regulate individuals even if their personal actions bear no relation to interstate commerce. If a class that Congress can regulate is always drawn up of only individuals whose actions do affect interstate commerce, then the courts would not need to excise anyone from the class.

The Supreme Court has effectively allowed Congress to impose regimes of collective guilt. In the case of *Raich*, Congress made a probabilistic evaluation that the average marijuana user affects interstate commerce.<sup>119</sup> The requirement that all elements of an offense must be proved beyond a reasonable doubt, however, precisely opposes the idea of allowing probabilistic judgments and heuristics above an unavoidable minimum. If four brothers are sitting in prison as convicted murderers and their fifth brother is now suspected of murder, we do not allow prosecutors to tell a jury that based on the behavior of his brothers, he is likely guilty as well. This analogy can be critiqued from a number of angles, but the key point remains: the law generally wants to know what a jury can say with near certainty about a single individual. I am not aware of any court decision that explains why jurisdictional facts should be treated differently from other facts under the Sixth Amendment, yet judges seem to implicitly assume this to be the case. Lemos and Carter have written about the constitutional issues that arise as a result of courts' choices to treat jurisdictional facts differently in the context of the Commerce Clause<sup>120</sup> and territorial jurisdiction.<sup>121</sup> The following Section shows how this creates problems in the context of criminal sanctions for certain forms of trademark infringement. Part II.C expands this discussion to possible constitutional implications for criminal enforcement of copyright within the context of the IP Clause.

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119. See *Gonzales v. Raich*, 545 U.S. 1, 22 (2005).

120. See generally Lemos, *supra* note 108.

121. See Carter, Jr., *supra* note 115, at 650.



*B. Due Process Implications for Criminal Enforcement Against Trademark Counterfeiting*

The Commerce Clause has traditionally been the constitutional source of congressional power over trademark law, including over the imposition of criminal sanctions for certain forms of infringement.<sup>122</sup> Therefore, the requirement that every element in a criminal prosecution be proven beyond a reasonable doubt, including the nexus to interstate commerce discussed above, fully applies in the context of criminal prosecutions for trademark offenses. The main statute of interest in this area is 18 U.S.C. § 2320, which outlaws trafficking in counterfeit goods or services.<sup>123</sup> The language of the law, including its definitional section, does not refer to interstate commerce. The word “traffic” is defined as “to transport, transfer, or otherwise dispose of, to another, for purposes of commercial advantage or private financial gain, or to make, import, export, obtain control of, or possess, with intent to so transport, transfer, or otherwise dispose of.”<sup>124</sup> The statute explains what types of goods constitute counterfeits but never references interstate commerce.<sup>125</sup> The closest that the statute comes to tying the offense to interstate commerce is in its definition of “counterfeit mark.” A counterfeit must be “identical with, or substantially indistinguishable from, a mark registered on the principal register”<sup>126</sup> and “applied to or used in connection with the goods or services for which the mark is registered.”<sup>127</sup> One could argue that because only marks used in interstate commerce can be registered,<sup>128</sup> by definition, a counterfeit can infringe on only a mark that has been used in interstate commerce. This argument would raise the question of whether the counterfeit mark is ontologically the “same” as the original mark

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122. Viva R. Moffat, *Mutant Copyrights and Backdoor Patents: The Problem of Overlapping Intellectual Property Protection*, 19 BERKELEY TECH. L.J. 1473, 1488 (2004) (citing *United States v. Moghadam*, 175 F.3d 1269, 1278-79 (11th Cir. 1999)).

123. 18 U.S.C. § 2320 (2012).

124. *Id.* § 2320(f)(5).

125. *Id.* § 2320(a). *But see id.* § 2320(h)(2)(C)(ii) (prohibiting the “transshipment and exportation” through or from the United States of any goods or services of which the statute prevents trafficking).

126. *Id.* § 2320(f)(1)(A)(ii).

127. *Id.* § 2320(f)(1)(A)(iii).

128. “The word ‘commerce’ means all commerce which may lawfully be regulated by Congress.” 15 U.S.C. § 1127 (2012).

when it comes to use in commerce; thus, by definition, the link to interstate commerce would be present for every counterfeit.<sup>129</sup>

More likely, however, to satisfy due process requirements, a prosecutor would have to show that the counterfeit goods in a given case either (1) made use of the channels or instrumentalities of interstate commerce, or (2) affected interstate commerce. Just because the original trademark was used in interstate commerce does not necessarily mean that the counterfeit was as well. Hence, the government would have to prove beyond a reasonable doubt that the counterfeit was actually used in interstate commerce, which is currently not a requirement.<sup>130</sup> In many cases, this would represent a minor hurdle because, for example, goods sold over the Internet would likely qualify as having made use of the channels or instrumentalities of interstate commerce.<sup>131</sup> If no channels or instrumentalities of interstate commerce were used, prosecutors would have to work harder to demonstrate that intrastate counterfeiting affected interstate commerce. Increasing prosecutors' burden as well as the amount of resources needed for a given type of case could decrease the already small number of cases brought every year.<sup>132</sup> Or, the currently small number could lead to a fairly modest absolute increase in the government's total burden, and although the costs of individual prosecutions would rise, the number of cases could remain steady.<sup>133</sup>

So far, the few constitutional challenges to § 2320 have generally focused on the claim that the statute is unconstitutionally vague; all have failed.<sup>134</sup> To my knowledge, no case has entailed the type of due

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129. See *infra* Part II.E.

130. See 18 U.S.C. § 2320; Lemos, *supra* note 108.

131. Christopher Lieb Nybo, Comment, *Dialing M for Murder: Assessing the Interstate Commerce Requirement for Federal Murder-for-Hire*, 2001 U. CHI. LEGAL F. 579, 596 n.130 (2001) (summarizing cases in which courts held that the Internet is an instrumentality of interstate commerce).

132. Miriam Bitton, *Rethinking the Anti-Counterfeiting Trade Agreement's Criminal Copyright Enforcement Measures*, 102 J. CRIM. L. & CRIMINOLOGY 67, 89-90 (2012) (discussing the relationship between the high costs of intellectual property infringement prosecutions and the low number brought every year).

133. I would like to thank Will Baude for our conversation on this point.

134. See, e.g., *United States v. Chong Lam*, 677 F.3d 190 (4th Cir. 2012) (rejecting a constitutional challenge that relied on a claim of vagueness); *United States v. Bohai Trading Co.*, 45 F.3d 577 (1st Cir. 1995) (same); *United States v. McEvoy*, 820 F.2d 1170 (11th Cir. 1987) (same).

process challenge to the trademark counterfeiting criminal statute on the basis described in this Article.

*C. Extending the Due Process Critique to Criminal Enforcement Against Copyright Infringement*

Unlike the criminal sanctions for trademark law, criminal copyright laws have their roots in the IP Clause of the Constitution rather than in the Commerce Clause—an important distinction in the context of the due process question. Before engaging in an analysis of how the requirement that every element be proved beyond a reasonable doubt should apply in a criminal copyright case, it is worth exploring why some scholars have argued that copyright can be regulated under *only* the IP Clause and not under the Commerce Clause. One's first instinct might be to conclude that if Congress is unable to pass a law governing intellectual property under the IP Clause, it should be able to revert to the Commerce Clause to do so if the regulation could fall under the purview of the latter. Several scholars, however, have made interesting claims as to why and how the IP Clause is not only an enabling, but also a limiting, provision when it comes to congressional power. This Section shows how the due process analysis should proceed both under the traditional view of the IP Clause and under this limiting version. It is important to note at the outset that due process protections should apply regardless of one's views of the IP Clause, and the differences arise when it comes to the specific implementation.

Basing her argument on constitutional text and history in addition to subsequent congressional actions and Supreme Court decisions, Jeanne Fromer argues that Congress is allowed to promote the progress of science and useful arts *only* through laws that give authors and inventors exclusive rights for limited times.<sup>135</sup> As a

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135. Jeanne C. Fromer, *The Intellectual Property Clause's External Limitations*, 61 DUKE L.J. 1329, 1331-32 (2012). One common concern that arises is whether this theory would make entities such as the National Science Foundation or National Institutes of Health and their activities unconstitutional. Fromer answers in the negative, stating that "as conventionally structured, federal funding of artistic and scientific works seeks to promote the progress of science and useful arts so as to secure exclusive rights to authors and inventors for limited times in their works." *Id.* at 1412. She states that this takes place through "providing funding to authors and inventors to create their works in the first place and by enabling them generally—although not requiring them—to seek copyright and patent protection in those

result of her analysis, she questions the constitutionality of some laws passed pursuant to an expansive interpretation of the Commerce Clause or for other reasons, giving as examples laws concerning trade secrets, anti-bootlegging, copyright restoration, and database protection.<sup>136</sup> Part of Fromer's thesis rests on the fact that the IP Clause is unique in being the only clause to specify the means through which Congress shall carry out its power.<sup>137</sup> She states that the natural reading of its language leads to the conclusion that "Congress has the power to promote the progress of science and useful arts using solely the specified means."<sup>138</sup> Larry Solum has sought to dispel the notion that the phrase "[t]o promote the Progress of Science" is simply a preamble that is followed by a power grant; rather, he states that the history and structure of the Constitution suggest that this language is part of the power grant itself.<sup>139</sup> Dotan Oliar's work largely agrees with the conclusion that the IP Clause grants Congress the power to protect copyright and patents only to the extent that this promotes the progress of science and useful arts and only for limited times.<sup>140</sup> As a related matter, Paul Heald and Suzanna Sherry argue that a consistent application of

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works as further incentive to create and disseminate them." *Id.* For a discussion of the complex relationship between Congress's treaty powers and the IP Clause's limitations, see generally Graeme B. Dinwoodie, *Copyright Lawmaking Authority: An (Inter)Nationalist Perspective on the Treaty Clause*, 30 COLUM. J.L. & ARTS 355 (2007); Fromer, *supra*, at 1385-90; Timothy R. Holbrook, *The Treaty Power and the Patent Clause: Are There Limits on the United States' Ability to Harmonize?*, 22 CARDOZO ARTS & ENT. L.J. 1 (2004). For an overview of how other countries deal with the relationship between intellectual property and criminal law, see generally CRIMINAL ENFORCEMENT OF INTELLECTUAL PROPERTY: A HANDBOOK OF CONTEMPORARY RESEARCH (Christophe Geiger ed., 2012).

136. See Fromer, *supra* note 135, at 1391-1407.

137. *Id.* at 1340.

138. *Id.* Only one other clause in Article I, Section 8 both grants power and limits it via a mention of both means and ends, namely the Militia Clause. Lawrence B. Solum, *Congress's Power to Promote the Progress of Science: Eldred v. Ashcroft*, 36 LOY. L.A. L. REV. 1, 19 (2002). Solum argues that the extension of copyright to life of the author plus seventy years and the retroactive application of copyright were unconstitutional because "the actions of the first Congress are consistent with the notion that the 'to Authors' limitation has real bite and precludes Congress from acting directly to grant exclusive rights to natural or legal persons who are not the authors of the works in which the rights are granted." *Id.* at 41.

139. Solum, *supra* note 138, at 22-23; see also George A. Mocsary, Note, *Explaining Away the Obvious: The Infeasibility of Characterizing the Second Amendment as a Nonindividual Right*, 76 FORDHAM L. REV. 2113, 2161 (2008) (discussing the role of preambles in the Constitution).

140. Dotan Oliar, *Making Sense of the Intellectual Property Clause: Promotion of Progress as a Limitation on Congress's Intellectual Property Power*, 94 GEO. L.J. 1771, 1790-92 (2006).

the principles of constitutional interpretation that have guided the Supreme Court in the context of other clauses should impose absolute limits on Congress's power to legislate under the IP Clause.<sup>141</sup>

So far, the Supreme Court has never curtailed the power of Congress in the area of copyright based on any limitations within the IP Clause. The question has prominently arisen twice in recent times. First, in *Eldred v. Ashcroft*, a number of groups argued that the Copyright Term Extension Act (CTEA) of 1998 was unconstitutional because it violated the provision in the IP Clause that protection shall only extend for "limited Times."<sup>142</sup> The petitioners argued that the CTEA's extension of copyrights for an additional twenty years for existing works was problematic because the initial copyright term represented an outside boundary that Congress could not exceed.<sup>143</sup> The Court rejected the argument that the CTEA sought to evade the "limited Times" constraint and risked creating perpetual copyrights.<sup>144</sup> The petitioners tried a number of other arguments, including that the CTEA failed to "promote the Progress of Science."<sup>145</sup> The Court, however, emphasized that Congress can decide how best to pursue the objectives of the IP Clause and stated that Congress had been making unchallenged adjustments to copyright duration for over two hundred years.<sup>146</sup> Justice Stevens dissented, stating that "[n]either the purpose of encouraging new inventions nor the overriding interest in advancing progress by adding knowledge to the public domain is served by retroactively increasing the inventor's compensation for a completed invention."<sup>147</sup> He explained

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141. Paul J. Heald & Suzanna Sherry, *Implied Limits on the Legislative Power: The Intellectual Property Clause as an Absolute Constraint on Congress*, 2000 U. ILL. L. REV. 1119, 1119. *But see* Paul M. Schwartz & William Michael Treanor, *Eldred and Lochner: Copyright Term Extension and Intellectual Property as Constitutional Property*, 112 YALE L.J. 2331, 2358-65 (2003) (disagreeing with the limiting theories of the IP Clause as a historical and jurisprudential matter).

142. 537 U.S. 186, 193 (2003).

143. *Id.* at 199.

144. *Id.* at 209.

145. *Id.* at 210-14.

146. *Id.* The Court specifically mentioned that "a contemporaneous legislative exposition of the Constitution when the founders of our Government and framers of our Constitution were actively participating in public affairs, acquiesced in for a long term of years, fixes the construction to be given [the Constitution's] provisions." *Id.* at 213 (quoting *Myers v. United States*, 272 U.S. 52, 175 (1926)).

147. *Id.* at 226 (Stevens, J., dissenting).

that the history of previous copyright extensions was relevant but not conclusive for this case, and that the lack of scrutiny that previous extensions received does not immunize the CTEA from such an inquiry.<sup>148</sup> Justice Breyer also dissented, writing that the CTEA exceeds the bounds of Congress's power because it crosses the line between what is unwise and what is unconstitutional.<sup>149</sup> He concluded that "the incentive-related numbers are far too small for Congress to have concluded rationally, even with respect to new works, that the extension's economic-incentive effect could justify the serious expression-related harms."<sup>150</sup>

The second major case to test congressional power over copyright was *Golan v. Holder*, in which several groups challenged the constitutionality of the Uruguay Round Agreements Act (URAA).<sup>151</sup> The law granted rights to the owners of some preexisting foreign works that were protected in their countries of origin but were in the public domain in the United States.<sup>152</sup> The petitioners argued that the text of the IP Clause provides a barrier against protection for works after they are in the public domain, but the Court saw no such barrier in the text, history, or precedents.<sup>153</sup> Like in *Eldred*, the Court rejected an argument that the extension (or even creation) of terms conflicted with the "limited Times" language or potentially promoted a scheme of perpetual copyright.<sup>154</sup> The Court pointed to several instances of copyright term restoration and rejected the idea that the URAA failed to promote progress just because it applied to preexisting works; the Court stated that not only creation but also dissemination of works constitutes progress.<sup>155</sup> Justice Breyer again dissented, this time joined by Justice Alito, arguing that the URAA neither incentivized new works nor promoted dissemination.<sup>156</sup>

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148. *Id.* at 239.

149. *Id.* at 243 (Breyer, J., dissenting).

150. *Id.* at 257. For an extensive discussion of the *Eldred* decision, see, for example, Schwartz & Treanor, *supra* note 141, at 2359. Schwartz and Treanor detail the multiple reasons that lead them to believe that *Eldred* left open numerous questions regarding the proper constitutional treatment of the IP Clause. *See id.* at 2359-63.

151. 132 S. Ct. 873 (2012).

152. *Id.* at 884.

153. *Id.*

154. *Id.* at 884-85.

155. *Id.* at 886, 888-89.

156. *Id.* at 900 (Breyer, J., dissenting). *See generally* Aziz Z. Huq, *Tiers of Scrutiny in Enumerated Powers Jurisprudence*, 80 U. CHI. L. REV. 575 (2013) (analyzing the levels of

It is useful to conduct the criminal due process inquiry as to the IP Clause under both the traditional interpretation and that proposed by Fromer, Solum, Oliar, and Heald and Sherry, among others.<sup>157</sup> Courts have not yet accepted the latter theory in the civil context, but the gravity of criminal sanctions may eventually provide the additional impetus needed to seriously consider these scholars' arguments. The idea that every element must be proved beyond a reasonable doubt in a criminal prosecution, as proposed by Lemos and Carter and discussed above in the context of criminal enforcement against trademark offenses,<sup>158</sup> applies with equal force in the context of the IP Clause as of the Commerce Clause. There are differences, however, in how the two clauses are phrased that modify the precise inquiry. For trademarks, federal courts have legitimate power only if the defendant engaged in interstate commerce beyond a reasonable doubt.<sup>159</sup> The IP Clause, however, does not discuss the behavior of defendants but rather focuses solely on the relationship between the government and an author.<sup>160</sup> The IP Clause speaks to Congress's constitutional ability to "secur[e] for limited Times ... the exclusive Right."<sup>161</sup> Federal courts therefore have power over a defendant only if he has violated an exclusive right. The inquiry would simply consist of establishing beyond a reasonable doubt that the defendant violated an owner's copyright. The act of "securing" would naturally include writing and enforcing laws so as to protect exclusive rights.<sup>162</sup> Under the traditional view of the IP Clause, the due process scrutiny ends here.<sup>163</sup> There is, however,

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constitutional scrutiny that the Court used in *Eldred* and *Golan* and contrasting them with those in other cases).

157. See *supra* notes 135-41 and accompanying text.

158. See *supra* notes 108-22 and accompanying text.

159. See *supra* Part II.B.

160. See *supra* note 138 and accompanying text.

161. U.S. CONST. art. I, § 8, cl. 8.

162. For a discussion of whether Congress should enforce moral rights in addition to the exclusive rights enumerated in 17 U.S.C. § 106 (2012), see Kenneth Einar Himma, *Towards a Lockean Moral Justification of Legal Protection of Intellectual Property*, 49 SAN DIEGO L. REV. 1105, 1125-27 (2012).

163. The traditional inquiry may not even require that step if the law and individual prosecution at bar are alternatively found to be a constitutional application of the Commerce Clause. See generally Thomas B. Nachbar, *Intellectual Property and Constitutional Norms*, 104 COLUM. L. REV. 272 (2004) (arguing that under an evolving understanding of the Commerce Clause and the IP Clause, laws invalid under the latter could be passed under the former).



a second and more complex step if one accepts that the first part of the IP Clause has a limiting purpose.<sup>164</sup> Combining this theory with the due process requirement suggests that a defendant can be convicted only if a prosecutor can show beyond a reasonable doubt that the way the “securing” of exclusive rights took place against the defendant served “[t]o promote the Progress of Science and useful Arts.”<sup>165</sup> If the prosecutor cannot prove that, then the federal court has no jurisdiction over the defendant, just as it lacks jurisdiction over trademark defendants who have not engaged in interstate commerce.

So far, criminal copyright statutes have largely remained unchallenged. One statute that has seen more action in the courts than others is § 2319A, which criminalizes the “unauthorized fixation of and trafficking in sound recordings and music videos of live musical performances.”<sup>166</sup> Significantly, the Court of Appeals for the Second Circuit held in *United States v. Martignon* that even if the statute was an impermissible exercise of congressional authority under the IP Clause, Congress had the power to enact the law under the Commerce Clause.<sup>167</sup> The district court had found the statute unconstitutional.<sup>168</sup> The Second Circuit, however, declined to decide whether the term “Writings” placed live performances outside the purview of the IP Clause, instead concluding that such works could constitutionally be protected under the Commerce Clause.<sup>169</sup> The Second Circuit expressed the view “that the Supreme Court’s cases allow the regulation of matters that could not be regulated under the Copyright Clause in a manner arguably inconsistent with that

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164. See *supra* note 142 and accompanying text.

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

166. 18 U.S.C. § 2319A (2012).

167. 492 F.3d 140, 144-45 (2d Cir. 2007). A California district court case dealing with a similar issue explained that “the question is not whether legislation empowered by the Copyright Clause—but invalid under it—can otherwise be empowered by the Commerce Clause. The question is whether matters not encompassed within the Copyright Clause can be addressed by the Commerce Clause free of the restrictions of the Copyright Clause.” *Kiss Catalog, Ltd. v. Passport Int’l Prods., Inc.*, 405 F. Supp. 2d 1169, 1176 (C.D. Cal. 2005). This perspective ignores the possibility that the promotion of science and the useful arts may be under the exclusive province of the IP Clause and not the Commerce Clause. See generally Fromer, *supra* note 135.

168. See *United States v. Martignon*, 346 F. Supp. 2d 413, 417 (S.D.N.Y. 2004).

169. *Martignon*, 492 F.3d at 145-46.



clause unless the statute at issue is a copyright law.”<sup>170</sup> The court explained that § 2319A does not fall under the purview of the IP Clause because:

[It] does not create and bestow property rights upon authors or inventors, or allocate those rights among claimants to them.... It is, perhaps, analogous to the law of criminal trespass. Rather than creating a right in the performer him- or herself, it creates a power in the government to protect the interest of performers from commercial predations. Section 2319A does not grant the performer the right to exclude others from the performance—only the government can do that.<sup>171</sup>

The Second Circuit’s reasoning is rather problematic. When a law prohibits person A from taking an action against person B, it is generally fair to say that this law creates a form of right for B. It is not clear why it is relevant who enforces that right—whether B does so in a civil action or the government in a criminal action. Further, as Jeanne Fromer explains, Congress clearly enacted § 2319A to further the goals of intellectual property, and among other things, even labeled both the civil and criminal portions as “[c]opyright [p]rovisions.”<sup>172</sup>

Fromer also criticizes the idea that just because unfixed performances are not “Writings,” they escape the limitations of the IP Clause. To the contrary, she argues, their lack of status as “Writings” constitutes an attempt by Congress “to promote the progress of science and useful arts without confining itself to the IP Clause’s prescribed means.”<sup>173</sup>

A different case, *United States v. Moghadam*, dismissed the importance of determining which constitutional provision Congress believed provided the relevant power to enact an anti-bootlegging law.<sup>174</sup> The court in *Moghadam* “decline[d] to decide ... whether the

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170. *Id.* at 149.

171. *Id.* at 151.

172. Fromer, *supra* note 135, at 1398 (alteration in original) (internal quotation marks omitted).

173. *Id.* at 1401.

174. 175 F.3d 1269 (11th Cir. 1999). The law prohibits the unauthorized fixation of live musical performances and is unrelated to alcohol-related bootlegging. See 18 U.S.C. § 2319A (2012).

fixation concept of the Copyright Clause [could] be expanded so as to encompass live performances.”<sup>175</sup> The court held that the statute was a proper exercise of authority under the Commerce Clause despite the lack of legislative findings tying the conduct to interstate or foreign commerce and the absence of a jurisdictional element in the statute.<sup>176</sup> The court went on to say that “[t]he absence of such a jurisdictional element simply means that courts must determine independently whether the statute regulates activities that arise out of or are connected with a commercial transaction, which viewed in the aggregate, substantially affect commerce.”<sup>177</sup> As explained above, in the case of a criminal statute, the aggregate effect on commerce is insufficient; at a minimum, assuming that regulation under the Commerce Clause is otherwise proper, the prosecutor should have to prove beyond a reasonable doubt the defendant’s link to commerce.<sup>178</sup>

The court in *Moghadam* also addressed whether Congress’s use of the Commerce Clause power via an anti-bootlegging provision conflicted with the limitations of the IP Clause. It acknowledged some tension in the previous case law regarding whether a statute that runs afoul of the limitations inherent in one constitutional provision can be upheld under another provision.<sup>179</sup> The court concluded that “although a live musical performance may not have been fixed, or reduced to tangible form, as of the time the bootleg copy was made, it certainly was subject to having been thus fixed.”<sup>180</sup> The court explained that because a previous legislative change allowed performers to protect live performances simply by simultaneously transmitting them, “the anti-bootlegging law seems to us like more of an incremental change than a constitutional breakthrough.”<sup>181</sup>

Even if that were true, it may be the increment that breaks the camel’s back. In the case of transmission, the transmitted work is

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175. *Moghadam*, 175 F.3d at 1273-74. The court also noted that the law would potentially run afoul of the “limited Times” provision, though the defendant at bar failed to raise this latter issue. *Id.* As with the fixation issue, the court “decline[d] to address the argument in light of its disposition.” *Id.* at 1274 n.9.

176. *Id.* at 1275-76, 1282.

177. *Id.* at 1276.

178. *See supra* Part II.B.

179. *Moghadam*, 175 F.3d at 1279-80.

180. *Id.* at 1280.

181. *Id.* at 1280-81.

considered fixed, and therefore an individual who records the live performance is creating a work identical to the fixed one, even if she is not drawing the data from the transmission.<sup>182</sup> Although the fixation and copying occur simultaneously and draw data from the same source, it is fair to say that at any given time, the illegal recording is of a thing that is also in that same moment fixed. Bootlegs, however, refer to works that the performer, by definition, *never* fixed.<sup>183</sup> This is a crucial distinction. To imply, as the *Moghadam* court did, that the step between previous fixation to simultaneous fixation is of the same quantum or type as the step between simultaneous fixation and no fixation, is untenable. If no fixation occurs, as Fromer states, Congress goes from promoting progress in a manner the Constitution authorizes to one it does not.<sup>184</sup> There is logic to accepting simultaneous transmission as fixation, but there is no ambiguity about the fact that a performance that was never recorded or transmitted simply cannot be designated as fixed.<sup>185</sup> Congress's goal, however, was to promote progress via the anti-bootlegging provisions, so Fromer has a valid claim that the provisions are unconstitutional altogether if one accepts the limiting view of the IP Clause.<sup>186</sup>

In every case, it is essential to understand into which rubric a specific IP-related criminal statute falls by determining whether it is an exercise of the IP power or the Commerce power. First, if the

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182. See *id.* at 1280 (basing a similar conclusion on “the definition of ‘fixed’ in 17 U.S.C. § 101”).

183. Part of this may depend on one's understanding of the meaning of a “work.” The composition was often written down even if the performance was not. This Article argues that the composition is not the relevant “work” for purposes of *Moghadam* because copyright law specifically distinguishes between compositions and performances in a number of contexts. See, e.g., *Newton v. Diamond*, 349 F.3d 591, 595-96 (9th Cir. 2003) (noting that a copyright holder who licenses a sound recording retains an independent copyright in the underlying composition); H.R. REP. NO. 94-1476, at 107 (1976) (wording the legislation to “avoid the danger of confusion between rights in a sound recording and rights in the musical composition”). I would like to thank Jake Linford for our conversation on this topic.

184. See generally Fromer, *supra* note 135.

185. See, e.g., David Nimmer, *The End of Copyright*, 48 VAND. L. REV. 1385, 1409 (1995) (noting that no reasonable interpretation of the term “writings” could encompass an untaped opera performance).

186. See Fromer, *supra* note 135, at 1401. Even if Congress had not made this intent explicit, it could have been surmised from other pieces of evidence such as statutory structure and context. See *id.* at 1398. Thus, Congress would not be able to escape the limitations of the IP Clause simply by omitting any mention of legislative intent.

criminal statute does not fit with the former but only with the latter, one has to ascertain that it does not conflict with the language of the IP Clause, or else the statute is unconstitutional altogether under the limiting version of the IP Clause.<sup>187</sup> Second, if a statute is constitutional, the constitutional provision that otherwise authorizes the statute dictates the contours of the due process inquiry in every individual case. As discussed, for the Commerce Clause, the prosecution must demonstrate beyond a reasonable doubt the link between the defendant's conduct and interstate commerce.<sup>188</sup> For the IP Clause, the prosecution would have to show beyond a reasonable doubt that a conviction helps to secure the exclusive rights of an author and, if one adopts the limiting understanding of the IP Clause, that this act of securing rights against the defendant serves to promote progress.<sup>189</sup> The next Section illustrates how these types of analyses would proceed.

#### *D. The Due Process Inquiry Applied*

The first matter of interest is exploring what kinds of cases would encounter problems under the Commerce Clause. As discussed, the government would have to prove beyond a reasonable doubt that the trademark counterfeits were sold or transported through the channels of interstate commerce or at least affected commerce for a criminal prosecution to be constitutional.<sup>190</sup> In many past cases, this explicit requirement would likely not have affected the outcome of the legal proceedings because numerous defendants were caught red-handed in the process of sale or transportation.<sup>191</sup> So far, alleged counterfeiters have not tried to make the constitutional argument proposed in this Article. There could be multiple reasons for this.

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187. *See id.* at 1401.

188. *See supra* Part II.B.

189. *See infra* Part II.E. A number of interesting issues may arise in this context, such as whether the particulars of the work and of the author are relevant to that determination. This Article cabins these questions, but the issues merit further exploration before the due process requirements discussed here are fully implemented. I would like to thank Jake Linford for his comments on this matter.

190. *See supra* Part II.B.

191. *See, e.g.*, *United States v. Diallo*, 476 F. Supp. 2d 497 (W.D. Pa. 2007) (involving a defendant who had purchased counterfeit Louis Vuitton goods in New York and was transporting them to Indiana when he was pulled over in Pennsylvania).

First, their attorneys may not have considered the constitutional argument. Second, their attorneys may have considered it, but believed it would fail given the courts' stare decisis on the Commerce Clause, or for other reasons. Finally, the counterfeiters—like past defendants—may have been unable to deny that the illicit goods were linked to interstate commerce. Whatever the reasons that have led to the decisions we have seen, this Article provides examples of situations that could cause problems for prosecutors.

One scenario would involve an individual creating a counterfeit for personal intrastate use. This scenario has some parallels to growing medical marijuana for oneself in that there is no guarantee that a thing created for such personal use will never enter interstate commerce.<sup>192</sup> This may have been implausible in the past due to the technical difficulties in creating counterfeits, but 3D printing technologies and their potential to create counterfeit fashion items are likely to vastly increase the number of such cases in coming years.<sup>193</sup> The question of how large trademark owners will react both in the civil realm and in relation to pressuring the government to prosecute is a subject ripe for speculation.<sup>194</sup> The fluid nature of the modern marketplace magnifies the importance of the matter. Something made in one's home is just a few mouse clicks away from being sold on Etsy<sup>195</sup> or eBay.<sup>196</sup> The shift between selling counterfeits in one's own state and selling them across state lines may also potentially be a rapid one, and increasing numbers of defendants whose behavior is on the cusp of being subject to federal power may get caught up in legal action.

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192. For a discussion of *Gonzales v. Raich*, see *supra* Part I.D.

193. See, e.g., Deven R. Desai & Gerard N. Magliocca, *Patents, Meet Napster: 3D Printing and the Digitization of Things*, 102 GEO. L.J. 1691 (2014) (discussing the new legal issues arising in patents, trademarks, and copyright as a result of this technology); Lucas Osborn, *Regulating Three-Dimensional Printing: The Converging Worlds of Bits and Atoms*, 51 SAN DIEGO L. REV. 553 (2014).

194. Large trademark owners have a long history of encouraging increased sanctions and more expansive legislation to protect their goods. See, e.g., Manta, *Puzzle of Criminal Sanctions*, *supra* note 3, at 510-11.

195. The Etsy website allows individuals to sell crafted goods to customers worldwide. *Etsy About*, ETSY, <https://www.etsy.com/about/?ref=ftr> (last visited Mar. 30, 2015) [<http://perma.cc/B9J2-V2JV>].

196. The eBay website allows individuals and businesses to sell goods to others, including via an auction mechanism. See *How to Sell Online with EBAY*, EBAY, <https://www.ebay.com> (last visited Mar. 30, 2015) [<http://perma.cc/HUD5-QWE5>].

Another interesting issue is how to handle defendants who attempt to sell or transport counterfeits in interstate commerce and for some reason do not complete their attempts. Although the law generally does not recognize causes of action for attempted criminal copyright infringement or the like,<sup>197</sup> attempting to traffic in counterfeit goods is explicitly prohibited by § 2320.<sup>198</sup> For example, in the unreported case *United States v. Ohri*, the government seized infringing goods that a delivery truck was about to bring to the defendants' business premises.<sup>199</sup> Section 2320 explains that "the term 'traffic' means to transport, transfer, or otherwise dispose of, to another, for purposes of commercial advantage or private financial gain, or to make, import, export, obtain control of, or possess, with intent to so transport, transfer, or otherwise dispose of."<sup>200</sup> To maintain constitutionality in cases of counterfeiting prosecution, attempts to traffic would, at a minimum, need to be attempts to traffic *in interstate commerce*. In scenarios similar to *Ohri*, the prosecution would have to prove beyond a reasonable doubt that the defendants were not only trying to make a profit by disposing of counterfeits, but that these future activities would specifically take place in interstate commerce.<sup>201</sup> Depending on the circumstances, this element may be difficult to demonstrate. In some cases, the defendants may not deny it or may have set up a website that already sells other infringing goods across the nation, which could potentially provide sufficient circumstantial evidence for a guilty verdict.<sup>202</sup> In other cases, however, law enforcement may have stepped in before any such steps were taken, making the prosecutors' task of meeting their burden of proof more difficult.<sup>203</sup>

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197. "[T]here is no liability for an attempt to infringe under the Copyright Act." *Capitol Records, Inc. v. Thomas*, 579 F. Supp. 2d 1210, 1218 (D. Minn. 2008). The closest that Congress has come to inchoate liability for copyright offenses is its criminalization of attempted circumvention of digital rights management (DRM) technologies that copyright owners place in music, a criminalization that Congress accomplished via the 1998 Digital Millennium Copyright Act (DMCA). *See* 17 U.S.C. § 1201(a)(1)(A) (2012).

198. 18 U.S.C. § 2320(a) (2012).

199. No. 1:06cr245, 2007 WL 150799, at \*1 (E.D. Va. Jan. 16, 2007).

200. 18 U.S.C. § 2320(f)(5).

201. *See supra* Part II.B.

202. In other contexts, courts have held that the Internet is either a channel or instrumentality of interstate commerce. *See, e.g., United States v. MacEwan*, 445 F.3d 237, 245 (3d Cir. 2006).

203. For a broader discussion of questions of attempt in federal criminal law, see generally

The standards I delineate for how the presumption of innocence should apply in the case of copyright engender their own complications. As mentioned, if one adopts a limiting view of the IP Clause, situations involving copyrightable subject matter should be analyzed under only the IP Clause and should not be allowed to fall under the purview of the Commerce Clause.<sup>204</sup> In many criminal copyright cases so far, courts have lumped the Commerce Clause into the discussion,<sup>205</sup> which would need to cease if criminal copyright violations could be analyzed under only the IP clause. From here on, the analysis will focus mainly on the way to ensure constitutionality under the IP Clause alone given that this provides, if anything, the more difficult hurdle. In a few instances, courts have explicitly stated that a criminal statute generally furthers progress, although in the cases at bar they did not specify whether the law was doing so beyond a reasonable doubt.<sup>206</sup> Admittedly, my proposed change could greatly increase the burden on courts and give juries a lot of power in constitutional matters.<sup>207</sup> That being said, juries always have significant power in such matters because they decide whether the prosecutor proved each element of the offense.<sup>208</sup> One of the reasons that we have juries is to provide a check on governmental power, as exemplified by the doctrine of jury nullification.<sup>209</sup>

Although criminal copyright law does not deal with attempt, courts have convicted defendants of conspiracy to commit criminal copyright infringement. A recent case involved a plan by the Internet piracy group IMAGiNE to reproduce and distribute tens of

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Robert E. Wagner, *A Few Good Laws: Why Federal Criminal Law Needs a General Attempt Provision and How Military Law Can Provide One*, 78 U. CIN. L. REV. 1043 (2010).

204. See *supra* Part II.C.

205. See *supra* notes 167-82 and accompanying text.

206. See, e.g., *United States v. Elcom, Ltd.*, 203 F. Supp. 2d 1111, 1140 (N.D. Cal. 2002) (“Protecting the exclusive rights granted to copyright owners against unlawful piracy by preventing trafficking in tools that would enable widespread piracy and unlawful infringement is consistent with the purpose of the Intellectual Property Clause’s grant to Congress of the power to promote the useful arts and sciences.”).

207. See generally Meghan J. Ryan, *Juries and the Criminal Constitution*, 65 ALA. L. REV. 849 (2014) (examining the relationship between juries and constitutional questions).

208. Cf. *id.* at 897 (detailing how juries determine liability on the elements in a § 1983 action).

209. But see Jonathan Bressler, *Reconstruction and the Transformation of Jury Nullification*, 78 U. CHI. L. REV. 1133, 1176-77 (2011) (suggesting that the Fourteenth Amendment’s Framers did not find jury nullification consistent with the sort of civil rights that courts were meant to enforce in former slave states).



thousands of works—such as infringing copies of movies—before the works could be released on legitimate DVDs.<sup>210</sup> Cases involving conspiracies to infringe on copyrighted works would have to fall under the same type of analysis as do completed actions; prosecutors would have to show that securing a copyright by punishing a conspiracy serves the progress of science and the useful arts, whereas for trademark-related conspiracies, they would need to establish a link to the Commerce Clause.<sup>211</sup>

In some cases, the breadth of the progress analysis for criminal copyright infringement prosecutions, whether for conspiracies or completed actions, could become difficult to define.<sup>212</sup> What is the proper time span to measure said progress? What if allowing the infringement in a given case is likely to promote progress, even though disallowing it would serve as a tool of progress in a narrower sense—that is, is the measure of promotion of progress absolute or relative? To what extent does the analysis have to account for effects of the case outcome on the behavior of third parties and their increased or decreased contributions to progress? Some of these inquiries will require juries or judges to make uncomfortable and even quasi-legislative determinations. Yet, if one agrees with the limiting nature of the IP Clause and with the principle that the presumption of innocence applies to jurisdictional hooks, the alternative legitimate solution may be nothing short of a constitutional amendment.

The effects of these increased burdens on the number and types of prosecutions in trademark and copyright cases are a matter of interest and some speculation. As mentioned previously, the overall number of cases could either remain similar or diminish depending on various factors.<sup>213</sup> It appears plausible from the analysis in this

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210. See Press Release, U.S. Dep't of Justice, Leader of Internet Piracy Group "IMAGiNE" Pleads Guilty to Copyright Infringement Conspiracy (Aug. 29, 2012), <http://www.justice.gov/opa/pr/leader-internet-piracy-group-imagine-pleads-guilty-copyright-infringement-conspiracy> [<http://perma.cc/86VC-5NVQ>].

211. Cf. *United States v. Pickney*, 85 F.3d 4, 8 (2d Cir. 1996) (requiring the government to prove either that stolen auto parts had moved in interstate commerce or that the conspirators believed the parts had moved in interstate commerce).

212. As mentioned, the Supreme Court seems to have set a fairly low bar in *Eldred* and *Golan* for what constitutes progress. See *supra* Part II.C.

213. See *supra* text accompanying notes 132-33. Alternatively, prosecutors may push harder for plea bargains through techniques like charge stacking if they view the actual court costs as problematically high under my proposed rules. For a discussion of charge stacking,



Part that the prosecutorial burden will effectively rise less for trademark counterfeiting cases than for copyright infringement ones because many of the former are likely to meet the “beyond a reasonable doubt” requirement for the jurisdictional hook, whereas the latter may run into difficulties more frequently if courts also adopt the limiting view of the IP Clause. In 2012, the latest year on record, federal prosecutors filed 110 cases for trafficking in counterfeit goods or services under § 2320.<sup>214</sup> They filed only forty cases for criminal copyright infringement under § 2319 and its complement § 506.<sup>215</sup> The number of criminal copyright infringement cases is small even though private organizations like the RIAA, MPAA, and others lobby to have the government pursue such actions and contribute their own resources to maximize enforcement.<sup>216</sup> Private organizations have even pushed state prosecutors to pursue copyright infringers, a practice of questionable constitutionality given preemption concerns, but one that could increase as more federal prosecutors run into constitutional obstacles under the proposals in this Article.<sup>217</sup> Copyright owners may also turn to more aggressive tactics in civil enforcement, although these often represent a second-best option due to their costliness and their more limited ability to achieve general deterrence.<sup>218</sup>

### *E. Questions About the Due Process Inquiry*

The due process inquiry proposed here raises a number of questions, and this Section seeks to address the most pertinent ones. The

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see Manta, *High Cost*, *supra* note 3, at 195-99. I would like to thank Joseph Fishman for our discussion on this point.

214. U.S. DEPT OF JUSTICE, FY 2012 PERFORMANCE AND ACCOUNTABILITY REPORT app. D, at D-5 (2012), available at <http://perma.cc/39RS-83DT>.

215. *Id.* at D-3.

216. See, e.g., Kim F. Natividad, Note, *Stepping It Up and Taking It to the Streets: Changing Civil & Criminal Copyright Enforcement Tactics*, 23 BERKELEY TECH. L.J. 469, 485 (2008).

217. See, e.g., Andrew Scurria, *Calif. AG Tees Up Preemption Fight on Film Piracy*, LAW360 (June 25, 2013, 5:00 PM), <http://www.law360.com/articles/452211/calif-ag-tees-up-preemption-fight-on-film-piracy> [<http://perma.cc/LFN6-9EE5>].

218. See Manta, *Puzzle of Criminal Sanctions*, *supra* note 3, at 494, 502-03 (discussing how criminal prosecutions can shift litigation costs away from intellectual property owners to the government and how criminal sanctions can especially serve to deter defendants that would be judgment-proof in civil actions).

first issue, which is mentioned above, is why it is insufficient to show that counterfeiting took place against a federally registered mark even though that original mark must have been in interstate commerce.<sup>219</sup> The second question discussed here is why the individualized analysis of constitutionality should be limited to criminal intellectual property cases rather than also encompass civil ones. Although the optimal type and level of scrutiny for civil cases remains subject to future exploration, I give a brief account of the elements that divide the criminal and civil inquiry, showing that it does not inexorably follow from my analysis that the civil law should go the way of the criminal one. In short, I demonstrate that there is no constitutionally mandated presumption of innocence for civil cases, and that Congress's ability to reverse presumptions that favor defendants is significantly greater in the civil than in the criminal context. Third, I briefly delineate the applicability of my analysis to trade secrets. Last, I discuss some of the practical issues related to the implementation of my proposal.

The first topic of interest is why we cannot constitutionally punish a defendant simply for creating a counterfeit of a federally registered mark.<sup>220</sup> The reason for potentially taking the opposite tack is that the original mark must have been in interstate commerce, and so any counterfeit is necessarily an infringement indirectly tied to interstate commerce. As a statutory matter, the trademark counterfeiting statute currently emphasizes only the for-profit nature of the illicit conduct.<sup>221</sup> If counterfeiting any federally registered mark were enough, then it could potentially suffice to show infringement as long as the mark was properly registered beyond a reasonable doubt (which would include that the original mark must have been used in interstate commerce). This approach is problematic for a number of reasons. First, it would allow the criminal counterfeiting statute to potentially reach *more* behaviors than the civil infringement provisions in the Lanham Act. Even for registered marks, the Lanham Act imposes liability only on behavior that occurred in connection with commerce.<sup>222</sup> The term "commerce" is defined as "all commerce which may lawfully be

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219. *See supra* Part II.B.

220. I would like to thank Felix Wu for our conversation on this point.

221. *See* 18 U.S.C. § 2320 (2012).

222. *See* 15 U.S.C. § 1114 (2012).

regulated by Congress.”<sup>223</sup> The courts have held that this includes intrastate activities that substantially affect interstate commerce, including a negative impact on a trademark owner’s reputation and goodwill.<sup>224</sup> At no point have courts suggested that, as a constitutional matter, this definition of “commerce” could encompass intrastate behavior that does *not* have an impact on interstate behavior just because interstate commerce is a prerequisite to the federal trademark registration of the original trademark.<sup>225</sup> It appears inconsistent for Congress’s power to reach only certain kinds of interstate commerce-related activities in the civil context and yet all for-profit activities regardless of their relationship with interstate commerce in the criminal context.

Another point to consider is that a trademark registration cannot be treated the same way as a gun. The post-*Lopez* statute requires that a firearm “has moved in or ... otherwise affects interstate ... commerce” before its use in a school zone can be criminalized.<sup>226</sup> Some would argue that the original trademark’s travels in interstate commerce before it received federal registration suffice in that the counterfeit mark is “the same” as the original, an idea briefly mentioned in Part II.B. The statutory definition of a counterfeit mark does not seem to allow for that interpretation. For example, one of the definitions for a counterfeit mark is “a spurious mark ... that is identical with, or substantially indistinguishable from, a mark registered on the principal register in the U.S. Patent and Trademark Office (PTO).”<sup>227</sup> All definitions of a counterfeit mark call it a “spurious mark” or a “spurious designation” of various sorts.<sup>228</sup> The original federally registered mark is not and cannot be literally

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223. *Id.* § 1127.

224. *See, e.g.,* *Coca-Cola Co. v. Stewart*, 621 F.2d 287, 290 (8th Cir. 1980) (citing *Franchised Stores of N.Y., Inc. v. Winter*, 394 F.2d 664, 669 (2d Cir. 1968)).

225. This issue is not to be confused with the one of whether “use in commerce”—which is a separately defined term in 15 U.S.C. § 1127 and whose legislative history received much discussion in *Rescuecom v. Google*, 562 F.3d 123, 132-36 (2d Cir. 2009)—should apply to infringing behavior. “The Act frequently employs the term ‘in commerce’ for the distinct purpose of invoking Congress’s Commerce Clause jurisdiction and staying within its limits.” *Id.* at 134 (citing 15 U.S.C. § 1127). The *Rescuecom* court explicitly distinguished the phrase “use in commerce” from the requirement that infringing activity take place in commerce, “a jurisdictional predicate for Congress’s power to legislate in this area.” *Id.* at 136.

226. Gun-Free School Zones Act, 18 U.S.C. § 922(q) (2012).

227. 18 U.S.C. § 2320(f)(1).

228. *See id.*

the same thing as the spurious mark. In the post-*Lopez* statute, the gun itself must have traveled in interstate commerce at some point. Just because the PTO provides protection for an intangible good when it awards federal trademark registration does not mean that said intangible good can be said to be the same one that showed up in the form of a counterfeit several states away. Hence, for the criminal counterfeiting statute to have a constitutionally sufficient jurisdiction hook, the counterfeit itself must have been sold in, have traveled in, or at least have affected interstate commerce.

The second question to address is why the conclusions I draw in the criminal context need not necessarily apply in the civil one. The answer to this question relates to the additional protections present in criminal matters. In a case involving a juvenile charged with an act that would constitute a crime if an adult had committed it, the Supreme Court held in *In re Winship* that every element of a crime has to be proved beyond a reasonable doubt rather than by a preponderance of the evidence.<sup>229</sup> This holding was later extended outside the juvenile context to mean that the government must prove beyond a reasonable doubt every relevant element of a crime.<sup>230</sup> Additionally, the Supreme Court has held under a principle known as the “rule of lenity” that courts should resolve statutory ambiguities in criminal prosecutions in favor of defendants.<sup>231</sup> This combination of constitutional and statutory doctrines exists because of the special harshness of criminal sanctions, which can include deprivations of liberty or even—outside the intellectual property context—of life.

As courts have held and scholars have explained, there is no true equivalent to these doctrines in the civil context.<sup>232</sup> The theories

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229. 397 U.S. 358, 367-68 (1970). Meanwhile, the basic requirement of the presumption of innocence has been recognized in American jurisprudence for a long time. *See Coffin v. United States*, 156 U.S. 432, 453 (1895) (“The principle that there is a presumption of innocence in favor of the accused is the undoubted law, axiomatic and elementary, and its enforcement lies at the foundation of the administration of our criminal law.”).

230. *See, e.g., Apprendi v. New Jersey*, 530 U.S. 466, 466 (2000).

231. *See McNally v. United States*, 483 U.S. 350, 359-60 (1987). For a broader discussion of the rule of lenity and its applications, see generally Zachary Price, *The Rule of Lenity as a Rule of Structure*, 72 *FORDHAM L. REV.* 885 (2004).

232. *See, e.g., Rabon v. Great Sw. Fire Ins.*, 818 F.2d 306, 310-11 (4th Cir. 1987) (overturning a finding of liability on the basis that the trial court instructed jurors that the presumption of innocence applies in both the criminal and civil settings); *Reed v. State*, 574 N.E.2d 433, 436 (N.Y. 1991) (“We long ago held that the presumption of innocence is not

delineated in this Article about the courts' obligations when criminally convicting defendants in copyright or trademark cases cannot be applied to civil cases without further ado. Margaret Lemos's critique of the Supreme Court's Commerce Clause jurisprudence is precisely that importing conclusions from the civil setting into the criminal one would be a mistake.<sup>233</sup> This Article has shown how those types of conclusions run afoul of the presumption of innocence in the context of criminal sanctions for intellectual property infringement. It would similarly be a mistake at this juncture to turn around and assume that the analysis here, which is based on principles specific to criminal law, should necessarily change constitutional doctrine in civil cases. For example, my critique of *Perez*—itself a criminal case—is based on principles unique to criminal due process.<sup>234</sup> If courts turn away from *Perez*, they should follow suit and abdicate the principles established in *Raich* pursuant to *Perez*. That does not necessarily mean, however, that striking down *Perez* would automatically entail deeming federal civil sanctions for marijuana-related offenses unconstitutional. Perhaps such civil sanctions are indeed unconstitutional for other reasons, but if that is the case, it does not result from notions tied to the presumption of innocence because the Supreme Court has never extended this presumption to the civil context. It is not simply a matter of there being an equivalent but lower bar on the civil side. Rather, there is currently no principle in civil jurisprudence imposing a burden of this *kind* at all. Should future scholars wish to argue that the analysis in this Article ought to apply in the civil context as well, they will at a minimum first have to show why such a burden needs to exist as a constitutional matter.

The third issue worth examining is how trade secrets fit into the framework developed in this Article. The term trade secret refers to a variety of information that is protected at the state and/or federal

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indulged in a civil action because of the lesser burden of proof."); Ellen S. Podgor, *International Computer Fraud: A Paradigm for Limiting National Jurisdiction*, 35 U.C. DAVIS L. REV. 267, 307 (2002) ("[T]he presumption of innocence and the reasonable doubt burden accorded the criminally accused does not match that used in civil cases. Civil wrongs do not entail jail time, are not premised on the same punishment theories, and do not carry the stigma that is associated with criminal penalties.").

233. See generally Lemos, *supra* note 108.

234. *Perez v. United States*, 402 U.S. 146 (1971); see *supra* notes 53-55, 117-19 and accompanying text.

level, and this Section limits its analysis to trade secrets as protected by the Economic Espionage Act to provide illustration while streamlining the discussion.<sup>235</sup> Congress passed the Economic Espionage Act in 1996 to protect against the theft of trade secrets and the improper disclosure of trade secrets intended to benefit foreign governments, instrumentalities, or agents.<sup>236</sup> Some scholars argue that this law was a legitimate congressional exercise of Commerce Clause powers.<sup>237</sup> If that is correct, then courts must treat trade secrets like trademarks as analyzed in this Article, and prosecutors must prove a link to commerce in the same individualized manner. Some of the offenses covered under the Economic Espionage Act already require this type of link. For example, § 1832 covers theft of a trade secret “that is related to a product or service used in or intended for use in interstate or foreign commerce.”<sup>238</sup> Section 1831, however, deals with economic espionage and only mandates intent or knowledge “that the offense will benefit any foreign government, foreign instrumentality, or foreign agent.”<sup>239</sup> To square this particular section with the analysis in this Article, prosecutors would additionally need to show that the espionage in a given case took place in or affected interstate commerce. Alternatively, if one adopts the limiting interpretation of the IP Clause, then the Economic Espionage Act is likely unconstitutional altogether because the “law has a strong structural purpose of promoting the progress of science and useful arts, but ... does not comply with the IP Clause’s limited means.”<sup>240</sup>

Other federal provisions, including those prohibiting bootlegging and the like, must be analyzed similarly to trade secret laws.<sup>241</sup> The first question is whether one adopts the traditional or limiting view of the IP Clause. If the former, one must examine whether a law fits into either the Commerce Clause or the IP Clause in an individualized manner. If the answer is no to both, that law is

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235. 18 U.S.C. § 1839 (2012).

236. *Id.* §§ 1831-1836.

237. *See, e.g.,* William Patry, *The Enumerated Powers Doctrine and Intellectual Property: An Imminent Constitutional Collision*, 67 GEO. WASH. L. REV. 359, 394 (1999).

238. 18 U.S.C. § 1832.

239. *Id.* § 1831.

240. Fromer, *supra* note 135, at 1391-92.

241. *See id.* at 1396-1402 (arguing that federal antibootlegging laws are unconstitutional under the limiting view of the IP Clause).

unconstitutional. If it is yes to either, it is constitutional. To determine if one should instead adopt the limiting view of the IP Clause, one must ask whether the law at bar is one that falls into the category of seeking to promote progress. If no, one would analyze its constitutionality under the Commerce Clause in an individualized manner and draw conclusions accordingly. If yes, one would analyze its constitutionality under the IP Clause in an individualized manner and ensure that it meets the other elements of the IP Clause, such as that it covers actual “Writings,” after which one would make a final determination depending on whether it meets all these requirements.<sup>242</sup>

The final question as to the due process inquiry proposed in this Article, is how courts will be able to practically conduct the inquiry if it is coupled with the limiting understanding of the IP Clause. As mentioned previously, under the traditional theory of the IP Clause, prosecutors would, at most, bear the additional obligation of showing in each case that the securing of an author’s right is occurring beyond a reasonable doubt.<sup>243</sup> If courts adopt the limiting understanding, however, prosecutors will further have to show that the protection of rights via convictions promotes progress. The first step to doing so may entail bringing in experts who can discuss the economic effects of a defendant’s infringement and the way that stopping him would promote progress. Although making economic predictions can be complex, it is a task that experts already perform in the courtroom in matters such as copyright fair use cases, in which experts have to forecast the effect of the defendant’s work on the market for the plaintiff’s work,<sup>244</sup> or antitrust cases, in which experts must gauge the impact on the market of potentially anticompetitive behavior.<sup>245</sup> The government also sometimes uses experts

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242. For a discussion of *United States v. Moghadam*, see *supra* Part II.C.

243. See *supra* Part II.B-C.

244. See, e.g., Glynn S. Lunney, Jr., *Fair Use and Market Failure: Sony Revisited*, 82 B.U. L. REV. 975, 1026-27 (2002) (discussing the role that expert testimony played in the judicial fair use analysis in regard to the Napster file-sharing technology).

245. Experts testify to such matters both in civil and criminal antitrust cases. For a general discussion of the role of experts in that context, see generally Rebecca Haw, *Adversarial Economics in Antitrust Litigation: Losing Academic Consensus in the Battle of Experts*, 106 NW. U. L. REV. 1261 (2012). For a more detailed explanation of the merits of different statistical methods to predict the impact of allegedly improper practices in the antitrust context, see generally Daniel L. Rubinfeld, *Econometrics in the Courtroom*, 85 COLUM. L. REV. 1048 (1985). These methods would certainly necessitate further study before being adapted to the



who testify about more general market effects in criminal copyright prosecutions.<sup>246</sup>

If one adopts both my proposal and the limiting understanding of the IP Clause, the same kinds of experts would have to provide more refined testimony, addressing matters relevant to the jurisdictional hook in individual cases. The defense would have the opportunity to cross-examine such experts in criminal copyright cases and bring in its own experts, and the jury would ultimately decide whether to believe the prosecution's experts beyond a reasonable doubt. The conclusions of the jury could vary depending on a number of factors, including the amount of infringement that a defendant committed. The Department of Justice already pursues primarily large-scale infringers, which is not necessarily a downside from a policy perspective, and such infringers are more likely to be found to impede progress than small-scale infringers would. Although the due process inquiry places higher burdens on the prosecution and possibly increases costs for defendants if they choose to hire their own experts, even if courts adopt the stricter limiting interpretation of the IP Clause, the due process inquiry will not impose any truly new or unusual requirements on the parties and courts, but rather will build on existing mechanisms.

### CONCLUSION

Until now, the Constitution has played a fairly modest role in constraining the enforcement of criminal sanctions for intellectual property infringement outside of the mandates that are also placed on other types of criminal prosecution. As this Article has shown, however, there are constitutional issues unique to the IP context to which courts need to pay attention before convicting defendants. Prosecutors must prove beyond a reasonable doubt that trademark counterfeits traveled or were sold in interstate commerce, or at least affected that commerce, before a jury can convict a defendant for a trademark violation. Less intuitively, prosecutors should have to

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particular context that this Article proposes, but nothing inherently stands in the way of doing so.

246. *See, e.g.*, *United States v. Slater*, 348 F.3d 666, 669 (7th Cir. 2003) (“The government also presented expert testimony on the harmful effect of Internet piracy on the potential market for the copyrighted work, though we think this point is fairly obvious.”).

demonstrate beyond a reasonable doubt that convicting a defendant for criminal copyright infringement will serve to secure the owner's rights, and if one adopts a limiting view of the IP Clause, that this occurs in such a manner as to promote the progress of science and the useful arts. Neither of these readings fits smoothly with the Supreme Court's recent jurisprudence on related matters, but both are derived from what I consider the proper understanding of the text and logic of the Constitution. Implementing these changes may also help to better align criminal prosecution practice with the key policy goals of intellectual property law by, for example, preventing counterfeiters from disrupting national commerce on the trademark side and hampering infringers who seek to interfere with the process of creation on the copyright side.

Adopting my proposal is likely to change prosecutorial behavior more in the copyright than in the trademark context if it occurs in conjunction with a move toward a limiting view of the IP Clause, and doing so could lead to a shift away from some types of copyright-related prosecutions. For both trademarks and copyright, the model I delineate could increase the cost of prosecutions or decrease the likelihood of conviction. It is certainly true that IP owners have a lot of power and lobbying resources and that they would likely deploy these resources in favor of rules that permit expanded prosecution. Nonetheless, history has shown that constitutional protections tend to remain robust over time, even in the face of challenges from powerful interests. Mere power alone, without a broad consensus of justice, is unlikely to bring about the constitutional amendment that would change this predicament.