# THE CONSTITUTIONAL IMPERATIVES OF US INTELLECTUAL PROPERTY

BY

JOHN ADAMS

# INTRODUCTION

- The fault lines which had been apparent in the Constitutional discussions after the Treaty of 1784 between those like Thomas Jefferson in favor of state rights, and those like James Madison of a more federalist persuasion, crystallized after the coming into force of the Constitution along political lines, in the form of the Republican Party led by Jefferson, and the Federalist Party led by John Adams

- In due course, after Jefferson became President, it led to his bitter struggle with the Federalist Supreme Court Chief Justice John Marshall
- This in turn defined the relationship between the executive and the judicial branches of the government, and reverberates to the present day

# THE US CONSTITUTION

- Federal intellectual property, like all other Federal law, must have a constitutional basis
- The two key provisions are Article 1.8(3) and (8)

- 1.8(3) To regulate commerce with foreign nations, and among the several states, and with the Indian tribes; …
- 1.8(8)To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries’

- As we will see, the first provision provides the justification for Federal trade marks law, and the latter for the law of copyright and patents

# PATENTS

- The range of patentable subject-matter is wider in the US
- This is partly because of the difficulty of introducing at a Federal level new forms of intellectual property
- We will return to this at appropriate points

- The Patents Act §101 authorizes patents for -
  - “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.”

- Thus designs are registrable under this system, but confer only a 14 year period of protection which runs from the date of grant
- Plants are also patentable, provided they have not previously existed in nature, and provided they have characteristics that are clearly distinguishable from existing varieties

- Until the America  Invents Act (previously called the Patent Reform Act of 2011) passes into law the first to invent rule applies in the US, under the Patents Act §101

# TRADE MARKS

- Trade marks are not within Article 1.8(8) of the Constitution which provides the basis of both Federal patent and copyright law

- An Act of 1876 to punish the counterfeiting of trade marks and the sale or dealing in counterfeit trade mark goods was declared unconstitutional in *US v Steffens*, *US v Wittemann*, and *US v Johnson*

- The Trade Marks Act 1881 was enacted in response to this decision, and in due course replaced by the 1905 Act
- In *Dad's Root Beer Co v Doc's Beverages Inc.* it was held that under the Lanham Act which in 1946 had replaced the 1905 Act, infringers need not have acted within interstate commerce; their activities need only have caused some injury to a plaintiff's interstate business

- It follows from the above, that in order to secure a Federal registration, the applicant must either demonstrate use of the mark in interstate commerce, or a *bona fide* intention to use the mark in interstate commerce

# COPYRIGHT

- A significant difference between US and UK law stems from the constitutional basis of US Federal copyright law
- UK law recognizes copyright in derivative works such as sound recordings
- This is not possible under the US Constitution

- Federal law did not protect domestic US sound recordings at all prior to 1972, though state laws may protect them until February 15, 2047

# DESIGNS

- §101 Copyright Act provides -
  - ‘The design of a useful article ... shall be considered a pictorial, graphic, or sculptural work [*and therefore copyrightable*] only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features, *that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article* [*emphasis supplied*]’

- In the interesting case of *Brandt International v Cascade Pacific Lumber Co* a sculptor made an abstract sculpture which he later realised would make rather a good bicycle rack
- After some minor alterations to improve that function, the rack went into mass production and won design awards
- Held: not copyrightable

# DATABASES

- At present there is no specific Federal protection for databases, and it is unclear whether in Constitutional terms there could be

# CONCLUSION

- It is impossible to understand US intellectual property without an understanding of the Constitution, and what is permissible under it