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BRIGHAM YOUNG UNIVERSITY
PRELAW REVIEW

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PRELAW REVIEW

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BRIGHAM YOUNG UNIVERSITY PRELAW REVIEW

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PUBLISHER'S NOTE

It is with great pleasure that I present to you the twenty-second volume of the *Brigham Young University Prelaw Review*. This year the *BYU Prelaw Review* has continued to reach new heights of professionalism thanks to the incredible efforts of our student editors and authors. Specifically, there are three things that have contributed to making this year's journal so impressive.

First, we have continued to modify the organizational structure of the journal to more accurately reflect the structure of a law school law review and to allow more students to take on individual responsibilities and excel in specific areas. In last year's edition, for the first time we created the positions of lead design editor, lead citations editor, and others to allow this to occur. This year's edition has built on that strong commitment to leadership, choosing students for leadership positions early in the spring from former staff members and giving full ownership to those leaders to fulfill their assigned tasks. The result has been that more students have worked in leadership roles in the production of this journal leading to a higher quality journal.

Second, we have continued to build on an academic class structure to complete the work on the *Prelaw Review*, going from a second block class fall semester and 1.0 credit class winter semester, to a full fall semester 1.0 credit class and a 2.0 credit class in the winter semester. The additional two months and extra hours in class have allowed authors and editors to work more thoroughly through the editing and publication process and produce a product that is both professional and gives meaningful insights into our current legal system. The extra time and additional edits have also allowed staff members to become experts at the Bluebook Citation Guide to a level that one would expect to see in law students, not undergraduates.

Third, thanks to the efforts of last year's staff and the work of LDS Philanthropies, in the spring of 2007, we were able to secure an endowment from the Rawlinson Family Foundation that will fund

the *Prelaw Review* annually into perpetuity. I cannot express how grateful I am for the individual donors who have contributed on an annual basis to fund the *Prelaw Review* to this point in time. Their contributions and support of the *Prelaw Review* from its earliest stages to what it is now have made this entire production possible. Additionally, I want to express my personal gratitude to the Rawlinson Family Foundation for being willing to establish an endowment that will now allow the *Prelaw Review* to continue being published on an annual basis.

The opportunity this *BYU Prelaw Review* affords all of the undergraduate students who participate in the journal each year is truly remarkable. Because of the editing, writing, and teamwork skills they learn, they are better equipped to succeed in their future academic and professional pursuits. Indeed, many of the students in the class have commented that participating on the staff of the *BYU Prelaw Review* has been the single best experience of their undergraduate career. I hope that as you read the journal you will concur that the work presented is of an unusually high quality for undergraduate students. What a pleasure it has been, and continues to be, to work with such fine individuals on a daily basis here at Brigham Young University.

Catherine Bramble, J.D.
Prelaw Advisor, BYU

EDITOR-IN-CHIEF'S NOTE

The 2008 *BYU Prelaw Review* demonstrates Brigham Young University's commitment to excellence in scholarship and student development. Throughout the past year, I have had the privilege to work with ambitious students and incredible faculty who want to produce the best possible undergraduate legal journal. I wish to commend these individuals for their efforts in accomplishing this goal.

Continuing the vision of past journals, this year's staff has worked arduously to present professional and current legal scholarship. Nearly one year ago, we started our preparation for this year's publication by selecting ten student legal articles. With topics ranging from gene patent law to the No Child Left Behind Act, we knew as students that our work on these articles involved more than just editing. Beginning last September, authors and editors studied to find court cases and law review articles to support their arguments. During the year, they remained current on issues pertaining to their topics. And consequently, each of these articles reflects the latest decisions from the courts and scholarship from the legal community. I sincerely thank Professor Steve Averett and the renowned BYU Law Library staff for directing us to the numerous legal resources available. Additionally, I especially acknowledge the meticulous efforts of our authors and editors who have made sure these articles are applicable today.

While producing a reputable legal journal is our main goal, this year the *Prelaw Review* has resolved to prepare each of its staff members for future professional scholarship and work in the legal field. Every member of the *Prelaw Review* has become proficient in Bluebook system of legal citations and all have spent countless hours editing and source checking each other's legal articles. I thank our lead editors Matt Duff, Shea Gibbons, Daniel Hoer, and Kristine Taylor for their committed assistance to their respective authors. Overall, our staff members know how to analyze pressing issues, incorporate legal citations, and present cogent legal arguments. Fur-

thermore, while all of the students have been thoroughly involved in the research and editing aspect of the journal, they have also received training in journal publishing. Alison Shakespear, Rachel Hill, and Matt Chandler have worked diligently to teach our staff Adobe InDesign and to ensure the Prelaw Review is of the highest professional quality. Certainly, members of this year's staff not only exhibit an understanding of legal issues, they possess the ability to excel in law and other professional pursuits.

Lastly, I thank Prelaw Advisor Catherine Bramble and Managing Editor Nathan Curtis for their tremendous efforts on this year's journal. Professor Bramble's legal background and commitment to the journal's success have made each issue of the BYU Prelaw Review a commendable work of legal writing. Additionally, Nathan Curtis's dedicated assistance, knowledge, and leadership on the journal foretell his promising future in law. Consequently, great faculty members, exceptional students, and generous donors such as the Rawlinson Family Foundation explain the excellent work of the 2008 BYU Prelaw Review. With great pleasure I present this journal to you for your enjoyment.

Scot Bayles
Editor-in-Chief

MANAGING EDITOR'S NOTE

Former Yale Law School professor Fred Rodell once wrote, “There are two things wrong with almost all legal writing. One is its style. The other is its content.” In my opinion, the 2008 *BYU Prelaw Review* is one of the exceptions to this rule. This new edition culminates a year’s worth of work put in by a highly qualified team of undergraduates, and it is representative of the future of legal writing.

The articles being published this year cover a diverse array of pertinent legal topics. The opinions and analysis put forth by the authors are well-researched and contain accurate insights into current legal situations in our country and abroad. It might be safe to speculate that this writing rivals that of some of the best undergraduate journals published all over the country. This of course would not be possible without the talented editors engaged by the *Review*. Never before has the *BYU Prelaw Review* had a group of such qualified, intelligent, dedicated, and experienced editors. Without their help we could not have completed this work. With the dedicated effort of these student authors and editors, this edition of the *Prelaw Review* continues the trend of reaching new heights each year.

A few people deserve to be mentioned by name. Our Editor-in-Chief Scot Bayles was a perfect example to us of hard work and dedication to the *Review*. Without his vision and leadership we could not have completed such professional work. He dedicated a significant number of hours of his free-time to this journal and any praise or recognition this journal receives is his. I would also like to thank Prelaw Advisor Catherine Bramble. She has taken time out of her busy schedule to mentor and assist our endeavors in publishing an undergraduate legal journal. The *BYU Prelaw Review* continues to progress each and every year through her support and guidance. Lastly, I would like to thank the Rawlinson Family Foundation for establishing an endowment that will establish the *BYU Prelaw Review* as a permanent fixture at Brigham Young University.

In conclusion, through the support, dedication, and work of each of the individuals and groups above, I am proud to present to you this edition of the *BYU Prelaw Review*. I hope you enjoy reading it as much as I enjoyed working with this staff in publishing it.

Nathan R. Curtis
Managing Editor

BRENDLIN V. CALIFORNIA: WHO'S IN THE DRIVER'S SEAT WHEN YOU'RE NOT IN THE DRIVER'S SEAT?

by Andrew Bennett¹

On June 18, 2007, the Supreme Court of the United States handed down a 9–0 decision on the case of *Brendlin v. California*.² The case involved the seizure of drugs and the conviction of Bruce Brendlin, an automobile passenger who was not the initial focus of a police officer's illegal traffic stop. The court's unanimous decision siding with Bruce Brendlin established an influential precedent that tightens law enforcement procedure and expands the interpretation of Fourth Amendment constitutional rights. To understand the ramifications of this decision, this paper discusses the case's history, the importance of the Fourth Amendment, and how the amendment relates to this case. Furthermore, it examines past Supreme Court rulings applied to *Brendlin v. California* and the long term results that will come from the Supreme Court siding with Brendlin.

I. CASE HISTORY

On November 27, 2001, while on patrol in Yuba City, California, Officer Robert Brokenbrough noticed that the registration tags on a brown 1993 Buick Regal had expired. There was a temporary tag displayed in the rear windshield, but with both vehicles in motion Officer Brokenbrough could not tell if the temporary tag matched the car. He decided to pull the car over for a routine traffic stop. The vehicle belonged to Karen Simeroth. In the passenger seat of the ve-

1 Andrew Bennett is a junior, majoring in English from Greensboro, North Carolina. He plans to go to law school or write.

2 *Brendlin v. Cal* 551 U.S. (2007).

hicle was Bruce Brendlin who, at the time had a warrant out for his arrest for violating parole. While questioning the driver, Officer Brokenbrough recognized Brendlin, removed him from the vehicle, and placed him under arrest. While searching Brendlin, the officer found marijuana on Brendlin's person and found ingredients for making methamphetamines in the car.³

Brendlin was officially charged with manufacturing methamphetamines. He filed a motion to suppress the evidence on the grounds that under the Fourth Amendment he was a victim of "unreasonable searches and seizures" due to a lack of probable cause or reasonable suspicion for the initial stop. Brendlin's claim did not deal with the first half of the amendment, regarding searches, but instead focused on the second half, which deals with the protection against unreasonable seizures. The court did not grant Brendlin's motion, explaining Brendlin was not seized in the original stop but was seized when the officer had him step out of the vehicle. Brendlin plead guilty to the charges and received a four year prison sentence.

Brendlin filed an appeal which was heard in January of 2007 by California's third District Court of Appeals. The appellate court reversed the district court's decision finding that Brendlin was clearly seized with the driver when pulled over and could, therefore, challenge the legality of the original stop. The court also ruled that since the officer had no real evidence to make the initial stop that he acted unreasonably and unlawfully.

The case was then taken before the California Supreme Court in June of 2006. A 4-3 decision reversed the appellate court's decision siding with the district court's initial finding that as a passenger Brendlin was not seized with the driver of the vehicle. They expressed the opinion that because passengers are not seized with drivers, the passenger's fourth amendment rights were not violated, and Brendlin was not bound to the scene because the officer had not indicated otherwise. On January 19, 2007, the United States Supreme Court granted certiorari, agreeing to review the case, and on June 18, 2007, sided with Brendlin in a 9-0 decision.

3

See *People v. Brendlin*, 38 Cal. 4th 1107, 1108 (Cal.2006) for a more detailed history.

II. THE FOURTH AMENDMENT, UNDERSTANDING THE CENTRAL ISSUE

At the heart of this matter lies the Fourth Amendment which declares, “the right of the people to be secure in their persons, houses, papers, and effects against unreasonable searches and seizures, shall not be violated.”⁴ An accurate summary of this amendment was given by Justice Louise Brandeis (1916–1939) who said the Fourth Amendment secures “the right to be let alone—the most comprehensive of rights and the right most valued by civilized men.”⁵ One of the most basic human desires is to have some form of privacy, to know that one’s personal belongings and personal space are not in danger of being violated.

Privacy was a great concern for our fledgling nation when the Bill of Rights was drafted. The United States had just thrown off an oppressive government which showed little regard for the violation of basic human rights, especially privacy. Consequently, the new country was leery that an oppressive government would again take charge. This was the genesis behind the Bill of Rights: to make a list securing basic privileges to the people including, and especially, the right to privacy. But the interpretation of the amendment that protects this “most comprehensive of rights” is left up to the Supreme Court. Many recent landmark Supreme Court cases have focused on this amendment, and in post 9/11 America, attention to and concern for the Fourth Amendment has only heightened.

The intention of the phrase “persons, houses, papers and effects,” has been interpreted over time. One example is in the decision of *Katz v. United States*, where Justice Potter Stewart (1958–1981) stated, “The Fourth Amendment protects people, not places.”⁶ Meaning that wherever a person may be, they have a right to privacy, including in a vehicle. This requires law enforcement officers to have procedures in place so as not to seize or search drivers unreasonably.

4 U.S. const. amend. IV.

5 *Olmstead v. U.S.*, 277 U.S. 438, 478 (1982).

6 *Katz v. United States*, 389 U.S. 347, 351 (1967).

This also makes relevant Brendlin's claim of having his Fourth Amendment rights violated. It is true that Brendlin did have a parole violation and, once stopped, was found to be breaking other laws. It is a great victory when law enforcement officers catch someone who has broken the law, but when one views the case of *Brendlin v. California*, the wrongs that Brendlin committed must be set aside, and one must focus on the fact that Officer Brokenbrough was able to apprehend Brendlin only because he made an unjustified stop. Yes, a criminal was caught, this time. But, how would one view the situation if everyone in the seized car turned out to be an upstanding citizen, or if it were you in the vehicle? One must keep in mind that these fundamental laws of the Constitution must be respected regardless of the outcome from their violation.

III. DEFINING SEIZURE

As mentioned earlier, the main issue of the case does not deal so much with the element of unreasonable searches as it does with unreasonable seizures. Brendlin's attorney, Elizabeth Campbell, was able to show that Mr. Brendlin was, in fact, "detained" or "seized" when Officer Brokenbrough made the stop. He can, therefore, question the legality of the stop and argue that his search was unreasonable, making all the collected evidence subsequently inadmissible.

When one examines past Supreme Court cases that address the topic of seizure, it becomes quite clear that Bruce Brendlin was, for all intents and purposes, seized when Officer Brokenbrough stopped Ms. Simeroth's vehicle. During the past thirty years the Supreme Court has issued three major statements regarding seizure that apply specifically to Brendlin.

The most solid argument for Brendlin's claim can be found in the 1980 Supreme Court case *United States v. Mendenhall*. In this case the respondent was taken aside in a California airport by two Drug Enforcement Agency agents who felt she was acting suspiciously. She was asked if she would mind coming to the DEA office. The agents then asked permission to search her luggage, and a female officer asked permission to do a strip search, all to which the respondent agreed. She was caught with heroin in her possession and

was arrested but filed for suppression of evidence claiming Fourth Amendment violations. The Supreme Court gave the opinion that her Fourth Amendment rights were not violated due to her consent to the officers' requests.

Justice Stewart delivered the court's opinion in which he stated, "A person has been 'seized' within the meaning of the Fourth Amendment only if, in view of all of the circumstances surrounding the incident, a reasonable person would have believed that he was not free to leave."⁷

This clear definition of seizure holds true when applied to *Brendlin v. California*. When in a moving vehicle, whether one is a passenger or the driver, if the vehicle is pulled over by a law enforcement officer a sense of being stopped or seized prevails for all the occupants of the vehicle. It is typically not until the officer approaches the automobile that the occupants have any idea as to what is the reason for the stop and on whom the stop is focused. Therefore, everyone in the car is seized. In the most basic of applications of this opinion, Rutgers University Law Professor Sherry Colb said:

As a passenger in the car that was stopped, [Brendlin] was necessarily made to stop as well. He was not free to leave, because he was relying on the vehicle in which he sat for transportation, and because the driver was stopped, the vehicle itself was not free to leave.⁸

Furthermore, in *Brendlin's* case even though Officer Brokenbrough was initially focusing on Ms. Simeroth, it was very unrealistic for *Brendlin* to, without saying a word, open his door and just walk away. If a police officer is on patrol when he makes a stop with multiple people inside the vehicle he is out numbered and is in a potentially dangerous situation. It is quite reasonable to assume that the officer would not look too favorably on a passenger getting out of the vehicle. The officer could feel threatened and interpret this as

7 Supreme Court U.S. v. Mendenhall, 446 U.S. 544, 554 (1979).

8 Colb, Sherry, Do Car Passengers Enjoy Fourth Amendment Rights? The Supreme Court Grants Review in *Brendlin v. California* (Feb. 21, 2007), <http://writ.news.findlaw.com/colb/20070221.html>.

a hostile act, or at least view this as a cause to further investigate the passenger thereby causing the passenger to incriminate himself or provide reasonable suspicion. It would only be a matter of time until an unnecessary action, such as a firearm drawn prematurely, would be made in the heat of the moment by law enforcement. Given all this, it is understandable why, contrary to the California Supreme Court's finding, Brendlin felt he could not walk away. He was "seized."

This clear definition of seizure resulting from *Mendehall* has since been used on many occasions as a test for the Supreme Court to determine if seizure actually took place.⁹

A further explanation of seizure with direct application to Brendlin can be found in the Supreme Court case *Brower v. Inyo County*, which was also used in Brendlin's case. Brower was represented by his descendents since he died in the incident. Brower lead police on a high speed chase with a stolen car and was stopped when he crashed into a police roadblock, which killed him. The descendents claimed unreasonable seizure occurred by excessive force. From this case came the simple statement that seizure consists of "the intentional acquisition of physical control."¹⁰ In Brendlin's case, Officer Brokenbrough's purpose for stopping the vehicle was in fact the "acquisition of physical control" of the vehicle and its occupants. For him to be able to take any action against any of the vehicle's occupants he first needed to have the vehicle in his control, or in other words it must be seized.

Additional insight can be gleaned from a case referred to by the Supreme Court which predates *Mendenhall*—*Terry v. Ohio*. In 1963 two Cleveland police officers approached John Terry for suspicious behavior. They patted Terry down and found he was armed. They charged him with having a concealed weapon. Terry petitioned for evidence to be suppressed on the grounds of illegal searches and seizures. His petition was denied. The Supreme Court upheld the original decision and gave the opinion that "[w]hen the officer, by means of physical force or show of authority, has in some way re-

9 See *I.N.S. v. Delgado*, 466 U.S. 210 (1984), *Florida v. Royer* 460 U.S. 491 (1983).

10 *Brower v. Inyo County* 489 U.S. 593, 596 (1984).

strained the liberty of a citizen may we conclude that a 'seizure' has occurred."¹¹ In Brendlin's case, his liberty was indeed restrained by the stop. Before the incident Brendlin and the others in the vehicle had the liberty to move about the state as they so desired. They also possessed the liberty to use the car involved to aid them in this purpose. But the stop had a direct affect on Brendlin's liberty to move. First the vehicle was literally stopped by Officer Brokenbrough so it was not at liberty to continue moving. Also, the moment the car was stopped Brendlin could no longer continue to enjoy the transportation provided to him by Ms. Simeroth's vehicle, so his liberty was restrained as well.

The argument could very well be presented that these cases may not fully apply to Brendlin because he was a passenger in a car and most Fourth Amendment precedents involving vehicles concern the driver, like Brower. As for the rest of the opinions mentioned in footnote 9, they are directed to a pedestrian and airline patron. Although the Supreme Court has not issued many official rulings specifically addressed to passengers of vehicles, a few cases do show that the court considers vehicle passengers part of the seizure.

One Supreme Court case in particular, *Delaware v. Prouse*, is strikingly similar to Brendlin's. An officer pulled a car over, not for traffic violations, but merely to check the driver's license and vehicle registration. Upon doing so the officer found marijuana in plain view. The initial motion by the driver to suppress the evidence was granted upon finding his Fourth Amendment rights had been violated. The Supreme Court upheld the ruling stating that "The Fourth and Fourteenth Amendments are implicated in this case because stopping an automobile and detaining its occupants constitute a "seizure" within the meaning of those Amendments."¹² The statement referred to the occupants as being seized, using the plural term to extend the opinion to more than just the driver, but also to the passengers, such as Brendlin.¹³

11 Terry v. Ohio 398 U.S. 1, 16 (1968).

12 Delaware v. Prouse 440 U.S. 648, 653 (1979).

13 For other rulings involving passengers see Maryland v. Wilson 519 U.S. 408 (1997) and Whren et al v. United States 517 U.S. 806 (1996).

IV. RESULTS OF THE DECISION

The overturning of the California Supreme Court's ruling was a decision that needed to happen. The Supreme Court's siding in favor of *Brendlin* has several beneficial results in defining and securing the Fourth Amendment rights of citizens of the United States. The first benefit is it will take the basic human right to privacy and extend its reach even further than before to encompass car passengers. A case like this may in some ways seem petty or irrelevant to many people. But, actually it is very beneficial and has an instantaneous impact on every United States citizen. The society we live in is constantly changing. As new technologies become norms, citizens should know how his or her Fourth Amendment rights apply to these new areas. These cases allow our Constitution to be interpreted to see how and where our privacy is protected in everyday life. In the case of car passengers, this ruling allows them to have a greater confidence and clearer understanding of what their rights actually are if stopped by law enforcement. Furthermore, it establishes legal grounds where upon these passengers can clearly contest illegal stops that directly effect their privacy.

Also, the ruling in favor of *Brendlin* will encourage law enforcement to be a bit more careful with their stops. Therefore, it is further reason to have a clear purpose behind their stops. As a result, law enforcement can not perform a stop without reason for suspicion. When these stops are made the officers lose the ability to prosecute the driver for illegal activity but the stop is still made in hopes of being able to prosecute the passengers for some sort of violation. It is almost a form of gambling in the sense that when officers do this they are taking a risk with expectations that there is a payoff at the end. Some might feel that this will serve as a hindrance to the law and law enforcement by making it easier for criminals to avoid apprehension. On the contrary; the necessity of law enforcement officers having clearer purposes for their stops will increase their awareness while on duty and offenders will be prosecuted with greater diligence and firmness. This will result in a drop in crime.

A byproduct of these two benefits is that there would be a decrease in the amount of racial profiling by law enforcement. Because

of this obvious effect, the NAACP, ACLU, and the AALDEF were heavily involved in the support of Brendlin, even going so far as to jointly file an amicus brief on Brendlin's behalf. Again, the subject of seizure among vehicle passengers may seem limited, but it will have a nationwide impact on all United States citizens because it can strengthen the trust we place in our nation's law enforcement officers. When the trust between civilians and police officers is weakened, liberty is impeded.

From all the precedence discussed above it is quite clear that Bruce Brendlin was indeed seized when Officer Brokenbrough pulled over Ms. Simeroth's car that November night. This argument was quite clear to the Supreme Court when they made their decision and gave their opinion. The results of the case can be summed up as increasing the privacy of citizens and encouraging better law enforcement, all of which will increase the peace of mind of this country's citizens and greater trust in their rights.

**“ONE NATION, UNDER GOD”:
DISCUSSING THE UNSETTLED ISSUE OF *ELK GROVE*
*UNIFIED SCHOOL DISTRICT V. NEWDOW***

by Jeremy D. Bowen¹

I. INTRODUCTION

On September 27, 2007, fifty high school students in Boulder, Colorado walked out of their school during the daily recitation of the Pledge of Allegiance and said their own pledge—the Pledge of Allegiance omitting the clause “under God.” One student remarked, “Boulder High has a highly diverse population, not all of whom believe in God, or one God. We didn’t think it was fair for the whole school to have to listen to it. It’s almost religious oppression.”² Are students subject to religious oppression when they hear or say that America is a nation “under God?” What about America on a larger scale—do some U.S. citizens feel religiously oppressed by reciting the Pledge of Allegiance?

The case was originally heard before the United States Court of Appeals for the Ninth Circuit in *Newdow v. U.S. Congress* (2002). Michael Newdow sued his daughter’s school district over a policy allowing recitation of the Pledge of Allegiance. The Ninth Circuit

1 Jeremy D. Bowen is an honors student at Brigham Young University. He is a senior and is majoring in English with a minor in psychology. He is considering participating in Teach for America while earning a Masters of Arts in Teaching before going on to law school. Jeremy is from Idaho Falls, Idaho.

2 Associated Press. *Colorado Students Walk Out During Pledge, Recite Own Version*, Sept. 27, 2007, <http://www.foxnews.com/story/0,2933,298336,00.html>.

ruled in favor of Mr. Newdow and against the constitutionality of the “under God” clause.³ The case was then brought before the U.S. Supreme Court on appeal. Although the appealed case suggested a re-evaluation of the “under God” clause, the Supreme Court dismissed the case because, as a noncustodial father, Mr. Newdow did not have legal standing to bring the suit in federal court. The Supreme Court reversed the Ninth Circuit Court’s decision and did not address the constitutionality of the “under God” clause in the Pledge of Allegiance.⁴ Debate continues to this day throughout the nation over the implications of this clause.

This open-ended debate has had major repercussions—from teenagers walking out of their high school to Congressman lining up on the steps of the state Capitol to recite the Pledge.⁵ Such a wide spectrum of actions evinces the feeling that there is strong support on both sides of this issue; however, it is important to realize the consequences of either removing or maintaining the “under God” clause. On one hand, some people feel their beliefs are disrespected if a deity is referred to in the Pledge of Allegiance. On the other hand, if the Ninth Circuit Court’s ruling were to be enforced it “would exhibit not neutrality but hostility to religion.”⁶

What then was the purpose of the 1954 Act, which inserted the words “under God” into the Pledge of Allegiance? Why was the insertion of these words so important to the members of Congress who signed the Act? What effect does the Act have upon American citizens? Also, in order to understand the effect the Act has upon the American people, it is important to look at the three tests—the coercion test, the endorsement test, and the Lemon test—that the Ninth Circuit used to argue against the constitutionality of the Pledge of Allegiance.⁷ By examining these three tests in relation to the Pledge

3 Newdow v. U.S. Congress, 292 F.3d 597, 597–615 (9th Cir. 2002).

4 Elk Grove Unified School District v. Newdow, 542 U.S. 1, (2004).

5 Alex Colvin, The Pledge of Allegiance Controversy: Is America “One Nation Under God?”, Religious Freedom Report, Feb. 2003, at 1, 6.

6 Allegheny v. American Civil Liberties Union, 492 U.S. 573, 623, (1989).

7 Newdow, *supra* note 3, at 605.

of Allegiance, there is ample evidence to argue that the pledge is indeed constitutional.

II. THE 1954 ACT

In *Newdow v. U.S. Congress*, the Ninth Circuit claimed that the 1954 Act was created for the sole purpose of advancing religion.⁸ However, two considerations provide a context for the legislative history concerning this clause.

First, we must clearly understand Congress’s motivation underlying the 1954 Act. The legislative report states:

At this moment of our history the principles underlying our American Government and the American way of life are under attack by a system whose philosophy is at direct odds with our own. Our American Government is founded on the concept of the individuality and the dignity of the human being. Underlying this concept is the belief that the human person is important because he was created by God and endowed by Him with certain inalienable rights which no civil authority may usurp.⁹

The members of Congress were acknowledging the fact that America was indeed founded on the principles of individual freedom. Similar language was used in the Declaration of Independence: “We hold these truths to be self-evident, that all men are created equal, that they are endowed by their Creator with certain inalienable Rights, that among these are Life, Liberty and the pursuit of Happiness.” The “concept of the individuality and the dignity of the human being” are maxims that this nation was founded upon and are reiterated in the 1954 Act’s reasoning.¹⁰ Members of Congress tacitly acknowledged that the principles of freedom should never be taken away from any man or woman because the right to do so is not in the hands of an

8 Newdow, *supra* note 3, at 610.

9 H.R. Rep. No. 83–1693, at 1–2 (1954), *reprinted in* 1954 U.S.C.C.A.N. 2339, 2340.

10 *Id.*

institution. This acknowledgement by the founding fathers serves not to advance religion, but rather to recognize a fundamental thread that is woven into this nation's historic framework. Does this mean that everyone must embrace one God or one religion? This is not the case. The founders were simply stating that no one entity, be it man or government, had the right to nullify fundamental freedoms. The Ninth Circuit's decision asserts that "the First Amendment requires that a statute must be invalidated if it is entirely motivated by the purpose to advance religion."¹¹ While this principle is true and should govern our judgment, the Ninth Circuit erroneously interpreted the legislative history and concluded that the 1954 Act was solely an advancement of religion rather than an acknowledgement of the founding principles our founders set forth in their own documents.

Second, the presence of religious rationale is not adequate grounds to dismiss the 1954 Act as unconstitutional. Instead, we need to consider the overall effect of the 1954 Act. Professor Thomas C. Berg¹² suggests that we should not look at the "input" of the 1954 Act alone, but we must also consider the "output," or the effect of the Act. He states, ". . . although the rationale or 'input,' for religious freedom may be religious, the 'output'—how government actually treats people of varying views—must be neutral."¹³ Professor Berg, referring to the "under God" clause, argues:

The two short words delve no further into theology than is necessary to establish the transcendent basis for limited government and human rights. The specifics about the nature of the transcendent authority that grounds rights are left to be filled in by individuals and the religious or other ideological communities to which they belong.¹⁴

11 Wallace v. Jaffree, 472 U.S. 38, 56 (1985).

12 Thomas C. Berg is a St. Ives Professor of Law and Co-Director of the Murphy Institute for Catholic Thought, Law, and Public Policy at the University of St. Thomas School of Law. University of St. Thomas School of Law, <http://www.stthomas.edu/law/faculty/bios/bergtom.htm>.

13 Thomas C. Berg, The Pledge of Allegiance and the Limited State, 8 Tex. Rev. L. & Pol. 41, 67 (2003).

14 *Id.* at 68.

Congress should be credited for its efforts to repel communistic ideals that threatened to undermine our established religious freedoms. This freedom allots to each one of us the right to believe whatever we want. However, we ought not to impose perspectives on others that would deny the very establishment that renders us the freedom to believe and worship—or not believe and not worship, for that matter—how we wish. Indeed, if religious “input” invalidates all “output,” then even Jefferson’s historic Virginia Statute for Religious Freedom would be considered unconstitutional due to the statute’s use of religious language¹⁵ (“[A]lmighty God,” “Holy author,” “Almighty power,” etc.).¹⁶

This argument seemingly justifies the religious “input,” the clause of the 1954 Act, but does this justify the “output?” In order to answer this question, we need to evaluate the three tests that the Ninth Circuit implemented to determine the proper separation of church and state—the coercion test, the Lemon test, and the endorsement test.

III. THE COERCION TEST

The coercion test was created in response to the questionable practice of including invocations and benedictions at public school ceremonies. The question proposed in *Lee v. Weisman* (1992) is “whether including clerical members who offer prayers as part of the official school graduation ceremony is consistent with the Religion Clauses of the First Amendment. . . .”¹⁷ The coercion test asks if, “at a minimum, the Constitution guarantees that government may not coerce anyone to support or participate in religion or its exercise, or otherwise act in a way which ‘establishes a [state] religion or religious faith, or tends to do so.’”¹⁸ For the clause to be removed it must be proved that a person is coerced into saying the Pledge of

15 *Id.* at 60.

16 The Virginia Statute for Religious Freedom, 16 January 1786, <http://www.lva.lib.va.us/whatwedo/k12/bor/vsrftext.htm> (last visited Mar. 18, 2008).

17 *Lee v. Weisman*, 505 U.S. 577, 580 (1991).

18 *Id.* at 587.

Allegiance. In order to examine Newdow's case affirming coercion, it is critical to apply the legal definition of coerce—"to compel by force or threat."¹⁹

According to California's Education Code, students, including Newdow's daughter, begin each school day with "appropriate patriotic exercises."²⁰ The recitation of the Pledge of Allegiance can fulfill this requirement. Newdow argued that this routine harmed his child by exposing her to the Pledge. Newdow "... claims that his daughter [was] injured when she [was] compelled to 'watch and listen as her state-employed teacher in her state-run school leads her classmates in a ritual proclaiming that there is a God, and that ours [sic] is "one nation under God.'"²¹ Yet, Newdow admits that his daughter was not being forced to recite the Pledge. Though it is certainly true that Newdow's daughter is young and may be vulnerable to unfamiliar beliefs, is it beneficial to insulate her from the inevitable diversity of the world in which she will live? Should the history and foundation of the United States be diminished to avoid exposure?

Furthermore, the Supreme Court has on a number of occasions recognized the place of religion in our nation's traditions and institutions. Former Chief Justice Warren Berger argued that "[o]ur history is replete with official references to the value and invocation of Divine guidance in deliberations and pronouncements of the Founding Fathers and contemporary leaders."²²

Even in a ruling against prayer in public schools, the Supreme Court in *Engel v. Vitale* (1962) argued for the accommodation of a reference to deity in the classroom.²³ Justice Hugo Black, writing for the majority, concluded the following:

There is of course nothing in the decision reached here that is inconsistent with the fact that school children and others are officially encouraged to express love for our country

19 BLACK'S LAW DICTIONARY 275 (8th ed. 2004).

20 Cal. Educ. Code § 52720 (1989).

21 Newdow, *supra* note 3, at 601.

22 Lynch v. Donnelly, 465 U.S. 668, 675 (1984).

23 Engel v. Vitale, 370 U.S. 421, 435 (1962).

by reciting historical documents such as the Declaration of Independence which contain references to the Deity or by singing officially espoused anthems which include the composer’s professions of faith in a Supreme Being, or with the fact that there are many manifestations in our public life of belief in God.²⁴

These examples are in harmony with the Supreme Court’s self-imposed restriction of avoiding a “rigid, absolutist view of the Establishment Clause.”²⁵ Even the Ninth Circuit Court acknowledged that the Supreme Court “has occasionally commented in dicta that the presence of ‘one nation under God’ in the Pledge of Allegiance is constitutional.”²⁶ For example, Justice William Brennan underlined the minimal religious effect of recitation of the Pledge of Allegiance:

The reference to divinity in the revised pledge of allegiance, for example, may merely recognize the historical fact that our Nation was believed to have been founded “under God.” Thus reciting the pledge may be no more of a religious exercise than the reading aloud of Lincoln’s Gettysburg Address, which contains an allusion to the same historical fact.²⁷

Again, the Ninth Circuit’s main argument, with respect to the coercion test, comes from the *Lee* case. The case involves public prayer at graduation in public schools. Addressing public prayer at a high school graduation ceremony, the Court noted “. . . heightened concerns with protecting freedom of conscience from subtle coercive pressure in the elementary and secondary public schools. . . .”²⁸ In addition, *Lee* states:

24 *Id.*

25 Lynch, *supra* note 22, at 678.

26 Newdow, *supra* note 3, at 611.

27 School District of Abington Township v. Schempp, 374 U.S. 203, 304 (1963).

28 Lee, *supra* note 17, at 592.

The undeniable fact is that the school district's supervision and control of a high school graduation ceremony places public pressure, as well as peer pressure, on attending students to stand as a group or, at least, maintain respectful silence during the invocation and benediction. This pressure, though subtle and indirect, can be as real as any overt compulsion.²⁹

Legal implications do arise when you have someone saying a prayer in front of a student body in elementary and secondary schools, but keep in mind, the Pledge of Allegiance has not been officially deemed a national prayer. It is thus difficult, though apparently possible, to make the necessary jump from the logic of the *Lee* case to the *Newdow* conclusion of blatant coercion. Further, the intensity of the alleged coercion, and the related legal ramifications, are also debatable. Judge Ferdinand F. Fernandez, dissenting from the Ninth Circuit Court's majority decision, highlights the inconsequential nature of *Newdow's* charge by insisting that the danger of the "under God" clause in the Pledge of Allegiance is "so miniscule as to be de minimis."³⁰ Truly, the familiarity of the word "God" today by no means compels or influences people to join a church or adhere to Christian principles. Coercion needs to be readily and clearly identifiable if *Newdow* intends to secure government elimination of the clause. Although the state of California has a policy that the Pledge of Allegiance may be recited at the beginning of each school day, no "force or threat"³¹ is compelling *Newdow's* daughter, nor any other student, to participate in the Pledge of Allegiance.

IV. THE LEMON TEST

Another case, *Lemon v. Kurtzman* (1971), adds to the current discussion. The case developed a test to evaluate and confirm the proper separation of church and state in public schools. There are

29 *Id.* at 593.

30 *Newdow*, *supra* note 3, at 613.

31 BLACK'S LAW DICTIONARY, *supra* note 19.

three parts to the Lemon test. “First, the statute must have a secular legislative purpose; second, its principal or primary effect must be one that neither advances nor inhibits religion; finally, the statute must not foster ‘an excessive government entanglement with religion.’”³²

A. The First Prong of the Lemon Test

The first prong of the Lemon test states that the “statute must have a secular legislative purpose.”³³ The Ninth Circuit argued that the 1954 Act failed the first prong of the Lemon test. The Court asserted that “[t]he Act’s affirmation of a ‘belief in the sovereignty of God’ and its recognition of ‘the guidance of God’ are endorsements by the government of religious beliefs.”³⁴ This argument, however, lacks validity when viewed in the light of our nation’s history and traditions. Justice William Douglas, writing the majority opinion for the Supreme Court in *Zorach v. Clauson* (1952), stated authoritatively that “[w]e are a religious people whose institutions presuppose a Supreme Being.”³⁵ Consequently, the 1954 Act’s simple acknowledgement of commonly accepted history to combat communism is sufficiently secular in purpose to pass the first prong of the Lemon test. The religious rationale supporting the Act serves only to enhance the appropriately secular “output” of defending our nation’s traditions and freedoms from a communist threat.

B. The Second Prong of the Lemon Test

The second prong of the Lemon test is that a law’s “principal or primary effect must be one that neither advances nor inhibits

32 *Lemon v. Kurtzman*, 403 U.S. 602, 612–613, (1971).

33 *Id.* at 612.

34 *Newdow*, *supra* note 3, at 609.

35 *Zorach v. Clausen*, 343 U.S. 306, 313 (1952).

religion.”³⁶ The key word is “primary” (i.e. of chief importance). What is the “primary effect” of the Act of 1954?

The Ninth Circuit Court claims that, according to legislative history, “the Act’s sole purpose was to advance religion.”³⁷ Therefore, the Act violates the Establishment Clause with its promotion of “religion at the expense of atheism.”³⁸ However, the words “atheistic and materialistic” are adjectives connected to the “primary intent”—i.e. defense against communism. For example, the Act’s legislative history states that one of the main reasons the 1954 Act was put in place was to “serve to deny the atheistic and materialistic concepts of communism. . . .”³⁹ Communism was the main threat addressed by the Act of 1954. Even if the primary purpose of condemning communism is couched in religious language, the primary and secular intent is to condemn communist influence. Since 1954, the Act has also played another important role in our society.

Concurring with the opinion in *Allegheny v. American Civil Liberties Union* (1989), Judge O’Connor stated that certain practices, despite religious roots, are now “generally understood as a celebration of patriotic values rather than particular religious beliefs.”⁴⁰ The 1954 Act’s inclusion of the “under God” clause in the Pledge of Allegiance has fulfilled this purpose of celebrating patriotic values. Judge Fernandez reaffirmed, in his dissent from the Ninth Circuit Court, that “the de minimis tendency of the Pledge to establish a religion or to interfere with its free exercise is no constitutional violation at all.”⁴¹ In essence, the “under God” clause passes the second prong of the Lemon test because it neither tends to advance nor prohibit religion. Rather, this clause reminds us and serves to protect the accommodation of a wide range of beliefs.

36 Lemon, *supra* note 32.

37 Newdow, *supra* note 3, at 610.

38 *Id.*

39 *Id.*

40 Allegheny, *supra* note 6, at 631.

41 Newdow, *supra* note 3, at 615.

C. *The Third Prong of the Lemon Test*

The third prong of the Lemon test prohibits the excessive entanglement of church and state.⁴² As previously stated, Newdow’s daughter was not forced to say the Pledge of Allegiance. In addition, a complete separation of church and state is not possible; rather, an accommodation of differing beliefs is in order. Justice Black of the Supreme Court argued that the “history of man is inseparable from the history of religion.”⁴³ The Supreme Court has found “no constitutional requirement which makes it necessary for government to be hostile to religion and to throw its weight against efforts to widen the effective scope of religious influence.”⁴⁴ Judicial hostility toward religion, as manifest by a proposed elimination of the “under God” clause from the Pledge of Allegiance, would be “preferring those who believe in no religion over those who do believe.”⁴⁵ The “under God” clause does not excessively entangle government with religion and therefore passes the third prong of the Lemon test. As a result, the “under God” clause successfully survives all three prongs of the Lemon test.

V. THE ENDORSEMENT TEST

In the 1984 case, *Lynch v. Donnelly*, which was mentioned previously, Justice Sandra Day O’Connor developed the “endorsement” test.⁴⁶ O’Conner states:

What is crucial is that a government practice not have the effect of communicating a message of government endorsement or disapproval of religion. It is only practices having that effect, whether intentionally or unintentionally, that make religion

42 Lemon, *supra* note 32, at 613.

43 Engel, *supra* note 23, at 434.

44 Zorach, *supra* note 35, at 314.

45 *Id.*

46 Lynch, *supra* note 22, at 687.

relevant, in reality or public perception, to status in the political community.⁴⁷

In relation to the Newdow case and the Act of 1954, no political standing is affected by the inclusion of the “under God” clause. People are not changing their beliefs about theology because of the mere mention of the words “under God.” In reference to Newdow’s daughter, her decision to say the Pledge or not will not affect her political standing nor her educational opportunities. Other than a political consideration, there is little or no need to delve further into the endorsement test.

VI. CONCLUSION

In summary, a closer examination of the coercion, the Lemon, and the endorsement tests confirms the constitutionality of the “under God” clause in the Pledge of Allegiance. The Ninth Circuit Court’s arguments ignited an important debate over the role and meaning of the 1954 Act’s insertion of the “under God” clause. This clause, in conjunction with other similar historically recognized references to our nation’s religious heritage, serves to provide a religious rationale for the defense of our individual freedoms. We have acknowledged, however, that this power of preservation is not in the hands of any one man or institution—nor should it ever be. The “under God” clause simply represents the ideal of religious freedom and should therefore be maintained within the Pledge of Allegiance.

47 Lynch, *supra* note 22, at 692.

VIACOM v. YOUTUBE:
THE CROSSROADS OF COPYRIGHT LAW

by Clark Collings¹

I. INTRODUCTION

When the borders of technology expand, copyright law must quickly expand with it to fill the void. If it cannot, anarchy is free to reign because the protection of the law is not provided. The issue is whether existing law can fill the gap, or if new law must be formed to keep new technology in check. In January 1984, the consumer release of the VCR rekindled this question. The debate reached the United States Supreme Court in the landmark copyright case of *Sony v. Universal City Studios*. Writing for the United States Supreme Court, Justice John Paul Stevens addressed this issue and suggested that one must find an equilibrium when applying copyright law to new technology: “. . . [interpreting copyright law] involves a difficult balance between the interests of the authors and the inventors in the control and exploitation of their writings and discoveries on the one hand, and society’s competing interest in the free flow of ideas, information and commerce on the other hand. . . .”² Once again, the expanding scope of copyright law has reached a new horizon, and the debate mentioned above, coupled with the balancing act described by Justice Stevens, takes center stage in the recent lawsuit of *Viacom v. YouTube*.

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2 *Sony Corporation of America v. Universal City Studios, Inc.*, 464 U.S. 417, at 429 (1984).

YouTube has innovated and currently operates a video sharing and viewing website in which the user has free access to post and view a variety of copyrighted content (e.g. the Daily Show and SpongeBob SquarePants) and non-copyrighted content (e.g. a family vacation video). By providing Internet users with an online forum where they can post any type of video media they wish, copyrighted or not, YouTube has been accused of violating several copyright and intellectual property laws. Most recently, these claims have been presented by the colossal cable media company Viacom (owner of The Daily Show and Sponge Bob Square Pants). Viacom's copyrighted media has frequently been exposed on the YouTube website and Viacom is seeking damages for the infringement of their works. Michael Fricklas, general counsel for Viacom, further explained the amount of the copyrighted media on YouTube when he said, "In fact, Plaintiffs [Viacom] have identified more than 150,000 unauthorized clips of their copyrighted programming on YouTube that had been viewed an astounding 1.5 billion times."³ In addition to these unauthorized clips that have been identified, Viacom alleges that YouTube posts many more copyrighted videos that have not been identified due to the difficulty of searching every posted video on the site. For these reasons, Viacom is currently suing YouTube and its parent company Google for \$1 billion in damages for the alleged copyright infringement that has taken place on YouTube's website.

Justice Stevens' careful balancing act, described years before in *Sony v. Universal City Studios*, runs parallel with the current case of *Viacom v. YouTube*. It is clear that there is sufficient law available to fill the gap left by the growth of technology. However, it is not clear whether a decision for Viacom will stifle the "free flow of ideas"⁴ provided by YouTube's site, or if a decision for YouTube would fail to protect the interests of the artists, and hence stifle creativity and innovation. Nevertheless, the opinion of the court in *Fox Film Corp. v. Doyal*, explains the basic goal of copyright law: "The immediate effect of our copyright law is to secure a fair return for an author's

3 Michael Fricklas, Our Case Against YouTube, Washington Post, Mar 24, 2007, at A17.

4 Sony, *supra* note 2.

creative labor. But the ultimate aim is, by this incentive, to stimulate artistic creativity for the general good of the public.”⁵ Given this purpose of copyright law—and by following a roadmap of analyzing key definitions, legislative law, and related cases—one will conclude that YouTube’s business model prohibits artist innovation and that YouTube should be held liable for copyright infringement.

II. BACKGROUND

There are several phrases of legal language that must be defined before an explanation of existing copyright legislative and common law can be treated. This section will briefly define the following copyright law terminology: fair use, substantial non-infringing use, vicarious infringement, and contributory infringement. After these have been defined, this article will then explore the legislative law and common law cases from which the following definitions have been derived.

A. Key Definitions

1. *Fair Use/Substantial Non-Infringing Use*—Fair use and substantial non-infringing use are similar concepts and on a general level can be used interchangeably. For our purposes we will use the definition of fair use. It is defined by Black’s Law Dictionary as, “A reasonable and limited use of a copyrighted work without the author’s permission, such as quoting from a book in a book review or using parts of it in a parody.” Copyright infringers often use fair use as a defense against liability in court. The concept of fair use is key when considering if a work has been used illegally or not. In regard to this concept, the opinion of the court in *Dellar v. Samuel Goldwyn* states that “[Fair use is] the most troublesome [problem] in the whole law of copyright.”⁶ Fair use is subjective in nature, causes confusion, and is central in *Viacom v. YouTube*.

5 Fox Film Corp. v. Doyal, 286 U.S. 123; at 52 (1932).

6 BLACK’S LAW DICTIONARY 634 (8th ed. 2004).

2. *Vicarious Infringement*—The idea of vicarious infringement is pivotal to the *Viacom v. YouTube* case, and is defined by Black’s Dictionary as, “A person’s liability for an infringing act of someone else, even though the person has not directly committed an act of infringement.”⁷ This act is also associated with the direct financial gain from a third party infringer.

3. *Contributory Infringement*—The doctrine of contributory infringement is closely related to vicarious infringement, and is divided into three parts: patents, copyright, and trademarks. The section regarding contributory infringement in the copyright arena is the section that is most applicable to the *Viacom v. YouTube* case. Black’s definition is as follows: “The act of either (1) actively inducing, causing, or materially contributing to the infringing conduct of another person, or (2) providing the goods or means necessary to help another person infringe.”⁸

B. Legislative Law

1. *United States Copyright Law*—Article I, Section 8 of the United States Constitution is the first point of interest when discussing the rights of authors and inventors, and it provides a means through which artists can protect their works. It states that “The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”⁹ Furthermore, Chapter 11 of the Copyright Law of the United States of America helps to clarify this constitutional statement and align its intended meaning with that of the current issue of copyright infringement of video media on the Internet. Chapter 11 specifically deals with “Unauthorized fixation and trafficking in sound recordings and music videos.”¹⁰ A more detailed analysis of Chapter 11 will be introduced later in the article. This particular basic law has

7 *Id.* at 797.

8 *Id.* at 796.

9 U.S. Const. art. I, § 8.

10 17 U.S.C. § 1101 (2003).

the need to be clarified for the purpose of certain newer technologies, and for this reason the DMCA was created to provide this much needed clarification.

2. *DMCA*—Another piece of legislative law that is heavily considered in this discussion and even thought by some to be the heart of the *Viacom v. YouTube* case is the recent Digital Millennium Copyright Act (DMCA).¹¹ The DMCA contains five titles; the title most relative to the *Viacom v. YouTube* case is Title II. The basic purpose of Title II sometimes referred to as the “Online Copyright Infringement Liability Limitation Act,”¹² is to protect certain Internet Service Providers (ISPs), like AOL, from being liable for copyright infringement. In other words, it “creates limitations on the liability of online service providers for copyright infringement when engaging in certain types of activities.”¹³ To qualify to be protected, an ISP must fulfill specific criteria. If the criteria are met, the ISP is then considered protected under the DMCA as a safe harbor ISP.¹⁴ The DMCA is usually the first piece of law used when a more recent copyright case comes about, and an overall knowledge of its purpose is necessary when considering the *Viacom v. YouTube* case.

C. Common Law Cases

In addition to the above legislative law, there is also a large amount of common law that applies to the particular case of *Viacom v. YouTube*. In this section, a short summary of each case with brief comments will provide a general knowledge of past and present issues in copyright law. Concerning the importance of common law, Justice Souter stated in *MGM v. Grokster* that “these doctrines of secondary liability emerged from common law principles and are

11 The Digital Millennium Copyright Act of 1998, Pub. L. No. 105–304, 112 Stat. 2860 (1998).

12 *Id.*

13 *Id.*

14 Brian P. Wikner, Comment, Copyrights to Come, Santa Clara Computer & High Tech. L.J. 949 (2006).

well established in the law.”¹⁵ An understanding of the following case law and the associated precedent is vital to understand the arguments of Viacom and YouTube.

1. *Buck v. Jewell-La Salle Realty Co.*—In 1931, a hotel owner was found liable for contributory infringement as the hotel broadcasted a popular radio show into each hotel room even after being notified that the radio program was infringing on copyrights. Although there was no agreement between the radio show and the hotel, the hotel benefited from the infringement of another. The court found that the La Salle Hotel was liable for infringing performances when it (1) could control the premises, and (2) obtained direct financial benefit from the audience, who paid to enjoy the infringing performance.¹⁶

2. *Gershwin Publishing Corp. v. Columbia Artists Management, Inc.*—Another fundamental case in which contributory and vicarious infringement were key issues was *Gershwin Publishing Corp. v. Columbia Artists Management Inc.* In this case, Columbia Artists Management, Inc. a concert artist management company was found liable for vicarious infringement when one of its performers publicly performed a song “for profit at a concert . . . without the permission of the plaintiff Gershwin Publishing Company, the copyright proprietor. . . .”¹⁷ In his opinion, Judge Anderson explained that “one may be vicariously liable if he has the right and ability to supervise the infringing activity and also has a direct financial interest in such activities.”¹⁸ Judge Anderson continued when he stated, “Similarly, one who, with knowledge of the infringing activity, induces, causes or materially contributes to the infringing conduct of another, may be held liable as a ‘contributory’ infringer. . . .”¹⁹ The following

15 *Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd.*, 125 S. Ct. 2764, at 930 (2005).

16 *Buck v. Jewell-La Salle Realty Co.* U.S., 23 U.S. 191, 51 S. Ct. 410 (1931).

17 *Gershwin Publishing Corp. v. Columbia Artists Management, Inc.*, 443 F2d 1159, at 1160 (1971).

18 *Id.* at 1162.

19 *Id.*

statement was then known as the “Gershwin Supra” and was applied to several cases thereafter. Again, one must consider and apply the same violations committed in this case to the case at hand, *Viacom v. YouTube*. In the analysis, the “Gershwin Supra” will be applied to our current case.

3. *Sony v. Universal City Studios, Inc.*—As mentioned in the introduction, one of the landmark cases regarding copyright infringement and fair use is the *Sony v. Universal City Studios* case. This case has been cited in a variety of copyright cases and has transformed the way copyright law has been tailored to new technological advances.

In the late 1970s and the early 1980s, Sony was manufacturing and selling a home recording device called the Betamax Video Tape Recorder (VTR). This new device allowed home users to record and retain live television public broadcasts. Universal City Studios saw this act of recording their live broadcasts as infringing and sought relief from the legal system. The Supreme Court rejected Universal City Studios appeal, and Sony was found not liable for copyright infringement. The manner in which the Supreme Court came to this decision is extremely relevant to the argument between Viacom and YouTube, and a further explanation of the court’s opinion will be treated.

The most relevant principle in the Sony case is that of substantial non-infringing use of copyrighted material. This means that the product is capable and used for many legal purposes in addition to some illegal purposes. The Court found that the chief use of the VTR was to watch programs for which a person could not be physically present to watch. This practice, known as time-shifting, enlarges the television viewing market. The court concluded that the VTR fell under the doctrine of substantial non-infringing uses, and that “Sony’s sale of such equipment to the general public does not constitute contributory infringement of respondent’s copyrights.”²⁰ The following opinion of the Court has come to be known as the “Sony Standard,” and will be applied to several cases in the future.

20 *Sony Corporation of America v. Universal City Studios, Inc.*, 464 U.S. 417, 104 S.Ct.774, at 456 (1984).

4. *Fonovisa Inc. v. Cherry Auction Inc.*—In the seemingly unrelated case of *Fonovisa Inc. v. Cherry Auction Inc.*, another ruling in regard to vicarious and contributory infringement was handed down. Cherry Auction owned and operated a local flea market management group. It was held liable for vicarious copyright infringement because, even though they were unaware, a certain booth in their market was selling copyrighted music. The criteria for vicarious infringement was fulfilled when the court proved that Cherry Auction benefited financially from the sale of the copyright music because of the revenues it received from admission fees, parking fees, and concession stand sales at the flea market. Cherry Auction was also held liable for contributory infringement because it was directly involved with providing the infringers with services and amenities such as retail space, parking, advertising, and most important, customers.²¹ The logic and application of law used in this case is pivotal in proving that YouTube has very little protection when it comes to providing a digital flea market for blatant infringement.

5. *A&M Records, Inc. v. Napster*—Another Internet media provider like YouTube who was recently held liable for copyright infringement was Napster, Inc. Two of the underlying principles in this case are the definition and application of the term fair use, and Napster's attempt to find safe harbor under the DMCA.

Napster provided software that allowed users to exchange MP3 file through a process called peer-to-peer file sharing.²² Another pivotal part of Napster's file sharing empire was not only dependant on the peer-to-peer sharing, but also on the fact that Napster uploaded this music to their own servers and then transferred the music to the users. Many of these shared files were copyrighted music files owned by A&M Records. With this direct infringement in mind, A&M Records filed a lawsuit against Napster in 2000. Napster argued two of the following issues: (1) that they were protected under the DMCA, and (2) that they were not liable because its users were "engaged in [the] fair use of the material."²³ In regard to fair use, Napster sought

21 *Fonovisa Inc. v. Cherry Auction Inc.*, C.A. 9 (Cal.), at 263–264 (1996).

22 *A&M Records, Inc. v. Napster, Inc.*, 239 F.3d 1004, at 1011 (2001).

23 *Id.* at 1014.

protection under the Sony doctrine, the idea upon which substantial non-infringing uses protect the alleged violator from liability. In this case, Napster likened its space-shifting of music to Sony's time-shifting of television shows. However, the court concluded that Napster's users were not fair users under the argument that when a user space-shifts a certain MP3 file in Napster's peer-to-peer environment, the copyrighted file is then distributed to the general public. This is unlike the Sony VTR, where the copy stays in the users' home. The Ninth Circuit Court also ruled that Napster was not considered an applicable candidate for safe harbor under DMCA. The outcome of this case was pivotal for developing software companies and further refined the use of the "Sony Standard."

6. *Metro-Golden-Mayer Studios Inc v. Grokster, LTD.*—This case was argued before the United States Supreme on March 29, 2005, and contains all the basic elements in *A&M Records v. Napster*. MGM sued Grokster for copyright infringement due to Grokster's peer-to-peer sharing network that provided users the opportunity to download copyrighted music and video owned by MGM artists. Grokster even used a similar defense to that used by Napster. In addition, Grokster contended that they were not liable because they did not house the copyrighted MP3's on their own servers. In light of this evidence the court still found Grokster liable for contributory infringement and Grokster was forced to shut down their operations.²⁴

7. *Robert Tur d/b/a Los Angeles News Service v. YouTube*—*Robert Tur v. YouTube* is one of the first and most recent copyright lawsuits to be brought against YouTube. Several months before Viacom filed its suit against YouTube, Robert Tur filed a suit in complaint that YouTube was infringing copyrighted media he filmed during the 1992 Los Angeles riots. Although the court has not come to a decision yet, shortly after the suit was filed, YouTube motioned for partial summary judgment under the DMCA. YouTube's motion was denied by the court under the argument that YouTube had insufficient evidence regarding the process that takes place from the act

24 *Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd.*, 125 S. Ct. 2764, (2005).

of the user's video upload to YouTube's server to the final posting of that video on YouTube's website. Due to the vague nature of YouTube's business model, the court was unable to consider YouTube for immediate protection under the DMCA.

III. ANALYSIS

Now that the basic principles, existing legislature, and current rulings regarding copyright law have been explained, we can apply this understanding to the key issues to *Viacom v. YouTube*. First, a discussion and application of YouTube's probable defense to Viacom's claims will be treated. Afterwards, Viacom's argument will be presented so that one will conclude that YouTube's business model prohibits artist innovation and that YouTube should be held liable for copyright infringement.

A. *YouTube's Defense*

Three of YouTube's main arguments against Viacom's claims of copyright infringement are as follows: (1) their site's substantial non-infringing uses and the Sony Standard, (2) their alleged protection under the DMCA, and (3) the fact that they do not encourage infringement among its users and cannot control their actions.

1. *Substantial Non-Infringing Uses and the Sony Standard*—YouTube claims that there exists a sufficient amount of non-infringing uses on its website to conclude that its service qualifies to be protected under the Sony Standard. Much like the idea of time-shifting of television shows, according to YouTube, a viewer may use the site to watch a television show they missed. Many authorized commercial uses are available on the YouTube site in addition to copyrighted works that have been approved for use by its owners. Another particular non-infringing benefit of YouTube is that “[s]ociety may benefit because YouTube provides an alternate forum compared to traditional methods of educating and influencing the public. . . . Unlike expensive television commercials, YouTube provides a free venue for the government and politicians to air their messages

to audiences traditionally difficult to reach.”²⁵ In addition to political candidates posting campaign information on YouTube, recently CNN and YouTube have teamed up to take full advantage of the 2008 presidential election. Several public debates between primary presidential candidates have been posted, and YouTube users have been given the opportunity to ask the candidates questions through a video posting. YouTube may consider the above uses sufficient to qualify for protection under the Sony Standard, but it also regards the DMCA as another protection against liability.

2. *Protection under the DMCA*—YouTube asserts that it qualifies for the safe harbor provision under the DMCA because of the nature of the services it provides. YouTube considered itself a service that provides the “storage of information on systems or networks at direction of users.”²⁶ As mentioned above, under this type of service, YouTube must pass the following requirements:

- (1) The provider must not have the requisite level of knowledge of the infringing activity. . . .
- (2) If the provider has the right and ability to control the infringing activity, it must not receive a financial benefit directly attributable to the infringing activity.
- (3) Upon receiving proper notification of claimed infringement, the provider must expeditiously take down or block access to the material.²⁷

To qualify for requirement one, YouTube claims they cannot control what happens on their site, hence exonerating themselves of any infringement liabilities. Requirement two is fulfilled in YouTube’s eyes because they also claim to receive no financial benefit from the video on their site. In the *Tur* case they claimed that “[YouTube] does not receive a financial benefit directly attributable to the allegedly in-

25 Michael Driscoll, Article, *Will YouTube Sail into the DMCA’s Safe Harbor or Sink for Internet Piracy?* J. Marshall L. Rev., 556 (2007).

26 The Digital Millennium Copyright Act of 1998, Pub. L. No. 105–304, 112 Stat. 2860 (1998).

27 *Id.*

fringing activity.”²⁸ In regard to the last requirement, YouTube states that as soon as they are alerted to infringing activities on their site, they immediately remove the material. If the above claims are true, then YouTube should be protected under the DMCA. In addition to their safe harbor defense, YouTube also stands by the fact that they lack control of their site and discourage infringement.

3. *Discouragement of Infringement and Control of Activity*—YouTube has expressed their stance in regard to their involvement in the infringing activity that is taking place on their site; they state,

“We don’t control the content on our site. Our users post the content on YouTube—including videos, comments, and ratings. Our community guidelines and clear messaging on the site make it clear that users must own or have permission from copyright holders to post any videos. We take copyright issues very seriously. We prohibit users from uploading infringing material and we cooperate with copyright holders to identify and promptly remove infringing content.”²⁹

YouTube also stated in the Tur case that “it does not have the right or ability to control the infringing activity.”³⁰ Though this defense did not hold up in the Napster and Grokster courts, YouTube is unique in the fact that it discourages infringement on its site as opposed to the preceding two companies.

B. Viacom’s Argument

Viacom may claim that YouTube is liable for copyright infringement because, (1) YouTube is not in accordance with Chapter 11 of the Copyright Law of the United States of America, (2) YouTube receives direct financial gain for the infringing acts, hence qualifying

28 Robert Tur d/b/a Los Angeles News Service v. YouTube, 2007 U.S. Dist., 3 (2007).

29 YouTube Fact Sheet, http://youtube.com/t/fact_sheet (last visited Mar. 15, 2007).

30 Robert Tur d/b/a Los Angeles News Service v. YouTube, 2007 U.S. Dist., Lexis 50254, at 3 (2007).

it for vicarious infringement, (3) YouTube is liable for contributory infringement because of the medium it provides for the copyright infringement, (4) YouTube does not provide ample fair use and non-infringing activities to be protected under the Sony Standard, and (5) YouTube does not qualify for safe harbor under the DMCA, therefore not protected from liability.

1. *United States Copyright Law*—If one were to examine the *Viacom v. YouTube* case from a distant perspective, they would quickly consider the most basic copyright law set in place in Chapter 11 of the Copyright Law of the United States, which is to protect the interest's of inventors and artists. As explained above, Chapter 11 clarifies the following as “unauthorized acts”.³¹

Anyone who, without the consent of the performer or performers involved—(1) fixes the sounds or sounds and images of a live musical performance in a copy or phonorecord, or reproduces copies or phonorecords of such a performance from an unauthorized fixation, (2) transmits or otherwise communicates to the public the sounds or sounds and images of a live musical performance, or (3) distributes or offers to distribute, sells or offers to sell, rents or offers to rent, or traffics in any copy or phonorecord. . . .³²

The service's provided on YouTube's site fits into each of the above categories. YouTube reproduces, transmits, communicates, offers, and traffics—without the permission of artists—copies of the artist's performances. This piece of law should be enough to demonstrate the illegality of YouTube's business practice. However, there is an enormous amount of case law that protects artists from what YouTube provides internet users.

2. *Direct Financial Gain and Vicarious Infringement*—In the official complaint to the District Court for the Southern District of New York, Viacom has claimed that “YouTube deliberately built up a library of infringing works to draw traffic to the YouTube site,

31 U.S. Const. art. I, § 8.

32 *Id.*

enabling it to gain a commanding market share, earn significant revenues, and increase its enterprise value.”³³ YouTube makes its revenues from selling advertising space on its website and drawing users to the site with its video content to see the placed advertising. Michael Fricklas, general counsel of Viacom, explains how YouTube earns its revenues as opposed to other web services. He says, “YouTube reaps financial benefits from that attraction through selling the traffic to advertisers . . . it lures consumers and competes by having great content—a resoundingly substantial part of which it did not create or pay for.”³⁴

As the common law cases cited above explain, when a third party infringer receives direct financial gain from a certain infringing activity, they are liable for vicarious infringement. In *Buck v. Jewell-La Salle Realty Co.*, the La-Salle Hotel was held liable for infringing performances when it was proven that it obtained direct financial benefit from playing copyrighted music through a master radio receiving set to its hotel guests who paid to enjoy the infringing performance. In the same fashion, YouTube has a master radio receiving set wired into homes, offices, schools, and internet cafes, broadcasting copyrighted material.

Another example of vicarious infringement mentioned above is *Gershwin Publishing Corp. v. Columbia Artists Management, Inc.*, The opinion of the court stated the cause for liability in a vicarious infringement and financial gain case. It states, “even in the absence of an employer-employer relationship one may be vicariously liable if he has the right and ability to supervise the infringing activity and also has a direct financial interest in such activities.”³⁵ Though YouTube has no direct relationship with its users, it definitely receives financial gain from its users much like the Columbia concerts.

These two cited cases clearly demonstrate that one who directly benefits from infringing activities is liable for vicarious infringe-

33 Compl. ¶ 5.

34 Michael Fricklas, *Our Case Against YouTube*, Washington Post, Mar 24, 2007, at A17.

35 *Gershwin Publishing Corp. v. Columbia Artists Management, Inc.*, 443 F2d 1159, at 1160 (1971).

ment. There is little difference between the La Salle Hotel, the Columbia concerts, and YouTube. Each of the three profited vicariously from copyrighted works. If these companies were held liable, there is no reason why YouTube should not be held liable.

3. *YouTube and Contributory Infringement*—YouTube provides its users with the means to post and watch the infringing material on YouTube’s website. In fact, YouTube goes as far as storing the copyright works on their own servers and allowing the users to access the video from YouTube. Viacom also identified that YouTube has a feature that allows any website to have an embedded YouTube video interface. “When a user clicks the play icon [on the host site], the embedded video plays within the context of the host website, but it is actually YouTube, not the host site, that publicly performs the video by transmitting the streaming video content from YouTube’s own servers to the viewer’s computer.”³⁶ The implication of this act is astounding. Not only is the copyrighted media exposed on YouTube’s website, but it is potentially available on any website on the entire Internet. Meanwhile, YouTube provides the software and the storage space for these infringers to perform such actions.

The services performed by YouTube that are described above are defined as contributory infringements, and resemble the acts performed by the liable parties described in the common law section. First, *Fonovisa Inc. v. Cherry Auction Inc.* demonstrates the fact that a simple flea market owner was held liable for contributory infringement when a booth at his market was selling copyrighted music. Judge Schroeder stated in this case that “[p]roviding the site and facilities for known infringing activity is sufficient to establish contributory liability.”³⁷

There is little difference between Cherry Auction’s open-air flea market and YouTube’s digital flea market. YouTube is providing the facilities for known infringement and should be held liable as was Cherry Auction. Second, *Grokster* was found liable for providing a peer-to-peer network for infringement to take place. In this case, *Grokster* did not even store the media on its own servers, but provid-

36 Viacom, *supra* note 33, at ¶ 32.

37 *Fonovisa Inc. v. Cherry Auction Inc.*, C.A. 9 (Cal.), at 263–264 (1996).

ed the means whereby its users could download material from others' computers. To repeat the opinion of the court, Justice Souter's states, "We hold that one who distributes a device with the object of promoting its use to infringe copyright, as shown by clear expression or other affirmative steps taken to foster infringement, is liable for the resulting acts of infringement by third parties."³⁸ If Grokster was liable under the preceding ruling, then YouTube should be held liable for housing copyrighted media on its servers. It is obvious by the manner in which YouTube provides its services, and the law created by *Cherry Auction* and *Grokster*, that YouTube is also liable for contributory infringement.

4. *Sony Standard Does Not Apply*—Another barrier YouTube has erected to guard itself from taking responsibility for the infringing activity on its site is the protection provided by the Sony Standard. As already mentioned above, YouTube considers its services as a means to provide fair use and substantial non-infringing uses. Both Napster and Grokster tried to seek protection under the same standard and failed to prove that their products supplied enough non-infringing uses to qualify.

Napster argued that time-shifting of music qualified for fair use. YouTube could make the same argument by stating that its users utilize the YouTube software to watch their favorite shows at a different time than when it was originally broadcasted. However, the same ruling handed down in the Napster court is applicable to YouTube's argument. The Napster court concluded that "it is obvious that once a user lists a copy of music he already owns on the Napster system in order to access the music from another location, the song becomes 'available to millions of other individuals,' not just the original user."³⁹ Furthermore, the Sony court stated that Sony was not held liable for infringement because the respondents [Universal City Studios] failed to demonstrate that time-shifting would cause any likelihood for non-minimal harm to the potential market for,

38 Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd., 125 S. Ct. 2764, at 919 (2005).

39 A&M Records, Inc. v. Napster, Inc., 239 F.3d 1004, at 1019 (2001).

or the value of, their copyrighted works.⁴⁰ In YouTube's case, the so-called time-shifting of videos does cause harm to the value and potential market of Viacom's copyrighted works.⁴¹

In the *Grokster* case, *Grokster* claimed that they received protection under the Sony Standard not because of time-shifting, but because they alleged their product to contain substantial non-infringing uses. In response, the court denied *Grokster* the protection of the Sony Standard as a defense and made the distinction between *Grokster* and Sony. This comparison and the above statements confirms that if the Sony Standard did not apply to *Grokster* and *Napster*, it should not be applied to YouTube.

5. *DMCA Does Not Apply*—The final loose link in YouTube's armor is its perceived protection under the DMCA. YouTube does not receive safe harbor under the DMCA because (1) it does not qualify for the safe harbor requirements, and (2) because previous cases with similar circumstances have denied YouTube, and similar companies, protection under the act.

As stated above, the requirements set by the DMCA for a company to receive safe harbor is that the company is a specific type of internet service provider (ISP) and fulfill the qualifications associated with that particular ISP standard. The only requirement that YouTube does fulfill in the DMCA is that it is used as a storage of information, that is the storage of copyrighted material for infringers.⁴² Other than that, YouTube does know and can control infringers on its site, and as has already been stated, YouTube receives direct financial benefit from the infringement. Therefore, under the current requirements stated by the DMCA, YouTube does not qualify for safe harbor.

In addition to YouTube not qualifying for the DMCA requirements, two separate courts have determined that the DMCA should not be applied to YouTube and similar companies. The *Napster* court

40 Sony Corporation of America v. Universal City Studios, Inc., 464 U.S. 417, 104 S.Ct.774, at 456 (1984).

41 Viacom, *supra* note 37.

42 The Digital Millennium Copyright Act of 1998, Pub. L. No. 105-304, 112 Stat. 2860 (1998).

states “we need to accept a blanket conclusion that Section 512 of the DMCA will never protect secondary infringers.”⁴³ In addition to this strong language, the court in the current case of *Tur v. YouTube* rejected YouTube’s motion for summary judgment under the protection of the DMCA. The *Tur* case stated:

There is insufficient evidence regarding YouTube’s knowledge and ability to exercise control over the infringing activity on its site. . . . YouTube also asserts that while it is able to remove clips once they have been uploaded and flagged as infringing; its system does not have the technical capabilities needed to detect and prescreen allegedly infringing videotapes. . . . Thus, there is insufficient evidence from which the court can determine YouTube’s right and ability to control the infringing act.”⁴⁴

YouTube’s motion for summary judgement was denied because their business model is too vague to be considered for safe harbor under the DMCA. These two court cases and the additional evidence presented are sufficient to establish that YouTube has no protection against the impending copyright infringement liabilities and should be exposed to the full measure of the law.

IV. CONCLUSION

As a result of the preceding arguments, it is apparent that YouTube stands liable for a multitude of copyright infringements. Because of the manner in which YouTube executes its business model, it has denied a fair return for artists’ creative work.⁴⁵ Whether YouTube is providing the means that enables its users to infringe or profiting from the traffic these copyrighted works attract, they cannot escape the consequences of breaking the law. For now, holding YouTube liable in its current case with Viacom will bring justice and

43 A&M Records, Inc. v. Napster, Inc., 239 F.3d 1004, at 1011 (2001).

44 Robert Tur d/b/a Los Angeles News Service v. YouTube, 2007 U.S. Dist. Lexis 50254 at 2–4 (2007).

45 *Id.*

compensation to the artists whose works have been infringed. More permanently, it will help companies like YouTube refine the way in which they provide services to their users and fill the void left by expanding technology with a precedent that will protect artists far into the future.

“NO MEXICANS SERVED”: REDEFINING RACE AS A SOCIAL CONSTRUCT IN *HERNANDEZ V. TEXAS*

by Scott Jensen¹

I. INTRODUCTION

Since May 17, 1954, *Brown v. The Board of Education* has been praised as the landmark case in the advancement of civil rights. In the minds of many it marks the beginning of a new era of social reform. But few know that just two weeks earlier on May 4, the same court handed down a ruling in a now often overlooked case, *Hernandez v. Texas*. This oversight is unfortunate as *Hernandez v. Texas* was so revolutionary in both its scope and ideals. Where *Brown v. Board* did little to challenge racism per se (it was in essence an administrative act, enforcing a constitutional amendment which the South had refused to respect), *Hernandez v. Texas* took great steps to look at the real heart of the race issue—that race is a social perception, not a question of skin color. Although initially the case was praised as a landmark victory, over fifty years later few have ever heard of *Hernandez v. Texas*. Despite its unique ruling and potential to redefine the civil rights movement, *Hernandez v. Texas* was largely ineffective because of the both the narrow language and the limited application of the ruling. Instead, the case should be viewed as a missed opportunity. So why mention it at all? The case set forth a unique legal philosophy, whenever a group is discriminated against, they constitute a body worthy of constitutional protection under the Fourteenth Amendment. This applies regardless of

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whether or not they are part of a distinct race. In other words, race is a social construct, not a matter of biology. This idea has not yet been fully integrated into our legal system. It is extremely important that the concept of race as a social perception be implemented today in the treatment of not only Mexican-Americans, but all racial and ethnic groups in America.

II. HISTORICAL BACKGROUND

In 1951 Pedro Hernandez known as “Pete” walked into a crowded bar and shot Joe Espinoza in the chest. Both men were Mexican-Americans. Although his case appeared hopeless, a brilliant legal team consisting entirely of Mexican-Americans decided that Pete Hernandez would make a perfect test case to take before the Supreme Court. Their purpose was to expand the rights of jury selection to all qualified persons of Mexican descent in the state of Texas, but they also sought to define once and for all the status of Mexican-Americans in American society. Over twenty-five years had passed since a person of Mexican descent had served on a jury in Jackson County, Texas where Hernandez would be tried. The racially charged environment of Texas in the 1950s was a harsh environment for the Mexican-American legal team. Michael A. Olivas, professor of law at the University of Houston, illustrated the team’s difficulties. After speaking with James deAnda, an attorney for the defense, Olivas noted that “they did not even feel safe enough to stay the night in Edna, Texas [where Hernandez was tried], and as a result retreated every night to their homes in Houston and San Antonio.”²

The jury selected for the *Hernandez* case was, as expected, entirely white. The attorneys for the defendant protested this homogeneous jury first during the trial and later on appeal to higher courts, but were denied time and again. In a ruling handed down from the Texas Supreme Court, it was stated that Pete Hernandez was white, and thus he *had* been tried before a jury of his peers. Of course the classification of Mexicans as whites did little to protect them against

2 Michael A. Olivas, *Commemorating the 50th Anniversary of Hernandez v. Texas*, 25 Chicano-Latino L. Rev. 1, 7 (2005).

discrimination tantamount to that against blacks. This technicality was a legal loophole Texas had been using to segregate Mexican-Americans for years. On this point Mexican-Americans had fallen into an ambiguous “other” category. For years people in the United States had debated the definition of race. The “one-drop” policy (one drop of African blood and you were considered black) turned race into an issue of color or heredity.³ To conform to this view, Mexicans had called themselves Americans of Spanish descent and attempted to fit in that way. Because of this tradition, *Hernandez v. Texas* represented an opportunity for the Latino community to establish an identity which had been long in question, even among themselves. Although Texas legally recognized Mexicans as white, a sign in a Texas restaurant, which declared “No Mexicans Served,” showed an attitude that went beyond the law.

The case was accepted by the Supreme Court of the United States and argued in January of 1954. Earl Warren, Chief Justice of the court at that time, had previously been given wide exposure to the problems of discrimination in the Latino community as an attorney, and later as governor of California.⁴ The attorneys for Hernandez decided that Gus Garcia would make the oral arguments along with Carlos Cadena. In May of 1954 the Warren Court ruled in favor of Hernandez, marking one of the first civil rights victories for Latinos in the highest court.

III. ARGUMENT FOR HERNANDEZ

The attorneys for Hernandez sought to distance themselves from a question of race. Mexicans as a rule were reluctant to give up their classification as whites. Because many of the more fair skinned Mexican-Americans could pass as whites, they found that they could enjoy many of the same protections under the law. Of course this did little for those whose skin color revealed their Mexican identity. The

3 F. James Davis, *Who is Black?: One Nation’s Definition* 5 (University Park, Pennsylvania State University Press 1991).

4 Kevin R. Johnson, *Hernandez v. Texas: Legacies of Justice and Injustice*, 25 *Chicano-Latino L. Rev.* 153, 161 (2005).

claim to whiteness was not the best method of ensuring their civil rights, but because the alternative was to be put in the same category as blacks and considering the explicit discrimination against blacks at the time, this would unambiguously leave them worse off. Attorneys at that time would typically argue that while Mexicans were white (allowing them to claim rights as Caucasians) they needed additional protection under the law because of the obvious racial discrimination. This approach, known as the “other white” strategy, had been used for years by those arguing for Mexican-American rights, and it was used again in the case of Hernandez. In the brief written by Carlos C. Cadena and Gus C. Garcia, race was rarely mentioned. Instead they sought to argue discrimination because of national origin. In so doing they could argue the need for minority protection and, in the true spirit of the other white approach, maintain their status as whites. As legal precedent they cited several instances where courts had protected white groups such as Irish-Catholics from discrimination.⁵ The brief submitted to the Supreme Court provided impressive evidence that jury discrimination was pervasive in Jackson County, Texas. They showed that in twenty-five years not one person of Mexican-American descent had served on a jury even though there was a pool of Mexican-Americans eligible for jury duty in the county.⁶ Of course the number of potential Mexicans jurors was much smaller than the number of eligible white jurors, but it was still hard to believe that of all those qualified, not one had been selected in twenty-five years.

Although they never distanced themselves from the other white philosophy, the petitioners did much to argue that Mexican-Americans were indeed a separate class. Many times the term “class apart” was used to describe the status of Mexican-Americans as an identifiable group worthy of protection. They attacked the notion that there were but two constitutionally protected groups—blacks and whites—and asserted that Mexican-Americans constituted another class altogether worthy of constitutional protection. The attorneys for Hernandez showed that Mexicans, being neither black nor fully

5 Brief for the Petitioner, *Hernandez v. Texas*, 347 U.S. 475, 4 (1953).

6 *Id.*

white, were largely overlooked. They stated in their brief that “[t]he Texas court requires a person of Mexican descent to show express discrimination, and it states frankly that persons of Mexican descent must bear a more onerous burden of proof solely and simply because they are not Negroes.”⁷ In other words, they were not entitled to the implicit protection provided in the constitution for whites, and were not entitled to the explicit protections of the Fourteenth Amendment for the blacks. Thus Mexican-Americans faced the same discrimination the blacks did, without the ability to legally challenge it. The lawyers for Hernandez sought to change this longstanding ambiguity by establishing Mexicans as an autonomous group, entitled to the full protection of the Fourteenth Amendment.

IV. ARGUMENT FOR THE STATE OF TEXAS

The State of Texas also avoided any real question of race, and focused on attacking the other white argument. First of all they claimed that no jury discrimination could have occurred because the jury was white and so was Pete Hernandez. This exploited the greatest weakness of the other white approach. For years Texans had used the whiteness of Mexicans to effectively discriminate against them. Because they were “equals,” treating them unequally was not discrimination. Where blacks had the advantage of being an identifiable racial group, Mexicans could be called whites and then be discriminated against as if they were blacks. Pete Hernandez, under this reasoning, had indeed been tried before a jury of his peers. If Hernandez then wanted to consider himself a unique class of white, then Texas envisioned a scenario in which “the white race [is divided] into small segments such as blondes and brunettes, or redheads and others.”⁸ Their idea was that if you gave Mexicans special treatment under the law, you would have to give all groups special protection until the divisions became so numerous as to “utterly ruin [the jury system] and nullify any good which might be expected from

7 *Id.*

8 Brief for the Respondent, *Hernandez v. Texas*, 347 U.S. 475, 4 (1953).

it.”⁹ Here we can see the real danger of the class apart or other white argument. By maintaining their status as other white the attorneys for Hernandez risked not being able to show sufficient necessity for constitutional protection. Either they were as white as anyone else, and Hernandez had no *prima facie* case or their differences were as insignificant as hair color, and they had no reason to expect a special designation as a class apart.

V. RULING OF THE WARREN COURT

On May 4, 1954, the Warren Court ruled unanimously in favor of Pete Hernandez. The statement issued by Chief Justice Warren can be divided into two parts. The first dealt with the actual facts of the case and states that jury discrimination did indeed take place while the second actually seeks to redefine the scope and definition of racism. In the first part of the ruling, the court refuted the claims of Texas that there had been no jury discrimination. They referred to the overwhelming evidence presented by the petitioner which showed a long history of exclusion. In the actual decision is a scathing rebuttal stating that Texas

. . . taxes our credulity to say that mere chance resulted in there being no members of this class among the over six thousand jurors called in the past 25 years. The result bespeaks discrimination, whether or not it was a conscious decision on the part of any individual jury commissioner. The judgment of conviction must be reversed.¹⁰

The court also stated, “The constitutional guarantee of equal protection of the laws is not directed solely against discrimination between whites and Negroes.”¹¹ Since discrimination was not limited to a question of white or black, and because the evidence showed that discrimination had taken place, Hernandez was entitled to protection under the constitution.

9 *Id.*

10 Hernandez v. Texas, 347 U.S. 475 (1954).

11 *Id.*

But the most important part of the ruling came in the more philosophical second part. Here the court actually defined race as a social construct. Race is deeper than skin color or nationality; race is a perception. The court said, “When the existence of a distinct class is demonstrated, and it is shown that the laws, as written or as applied, single out that class for different treatment not based on some reasonable classification, the guarantees of the Constitution have been violated.”¹² Whenever a group is being unfairly discriminated against, it is evidence that they constitute a distinct class worthy of protection under the constitution of the United States. Also the court stated that “[t]he evidence in this case was sufficient to prove that, in the county in question, persons of Mexican descent constitute a separate class, distinct from ‘whites.’”¹³

The definition of race as a perception rather than a color was revolutionary. The idea that the laws must match the perceptions of the people opens the door for an almost unlimited protection of all groups, regardless of skin color. Although the differences of Mexicans could be as insignificant as hair color, it did not matter. What made them a group worthy of protection was the fact that they were unfairly discriminated against. But the all-inclusive scope of the ruling was also its biggest weakness. The danger of defining race as something made apparent by discrimination was that the court then placed the burden of proof back on Mexican-Americans to prove their racial identity. The phrase qualifying the decision as applying to “the county in question,” was especially problematic in the way that it apparently limited the ruling to a single location.

What was happening in Texas in the 1950s was a national problem that both the Supreme Court and the American people had largely chosen to ignore. Up to this point civil rights laws were based on the commonly accepted black vs. white distinction. This overly simplistic view of race was the real origin of the problems surrounding the *Hernandez* case. The law was static, protecting only those proven to be of a different race and not taking into consideration the actual perceptions of the people. This oversimplification allowed

12 *Id.*

13 *Id.*

the people of Texas to say one thing and do another. The attorneys for Hernandez pointed out this glaring discrepancy and the court referred to it in the decision stating, “At least one restaurant in town prominently displayed a sign announcing ‘No Mexicans Served.’ On the courthouse grounds at the time of the hearing, there were two men’s toilets, one unmarked, and the other marked “‘Colored Men’ and ‘Hombres Aqui’ (‘Men Here’).”¹⁴ In the legal eyes of the state of Texas, Mexicans were called whites, but they were perceived to be another race to be segregated along with the blacks.

VI. WEAKNESS IN THE RULING

There are differing views on the effectiveness of *Hernandez v. Texas*. Many claim that the ruling was a moral victory, but did little to change the status quo. Others have recently praised the profound and insightful nature of the decision. The obvious disparity in opinions merits some explanation. In fact *Hernandez v. Texas* was both ineffective and groundbreaking at the same time. The ruling had enormous potential in its underlying ideas, but because the case has been largely neglected in practice, many wonder if it mattered at all. Interestingly, *Brown v. Board* played a role in rendering the ruling in *Hernandez v. Texas* ineffective, as demonstrated by two common criticisms of the *Hernandez* ruling.

First and foremost, the wording was notably specific to the case of Hernandez. Phrases such as “the county in question” and “when the existence . . . is demonstrated” limited the application to Jackson County. Many felt that the Supreme Court did not go far enough by not defining all Mexican-Americans as a class apart. In order to expand protections, further litigation was required—litigation that many in the Mexican-American community could scarcely afford. This was a primary distinction between *Brown v. Board* and *Hernandez v. Texas*. In the former, resources were fully available to follow up on the Supreme Court decision, which was in fact done in *Brown II* and even later in *Brown III*. The NAACP had the resources to ensure that the decision of the court was fully administered across

the US. In the latter case of *Hernandez* there was no ability to follow up and guarantee that the spirit of the Supreme Court decision would be enforced.¹⁵ There simply was not enough money or organization within the Mexican-American population to pursue each and every case. It was as if the Warren Court had given the Mexican-American community the legal right to freedom, but no way of getting there. As Steven Wilson, professor of History at Prairie View A&M University said, “In the absence of follow-on litigation, Mexican-American ethnic identity has remained fluid, and as a result, slippery.”¹⁶

A second criticism is that *Hernandez* furthered the other white strategy which came to adversely affect their position after *Brown v. Board*. Up to that point Mexican-Americans felt that they had a better chance of having their rights protected if they could be perceived by the law as whites. They recognized that, despite the Fourteenth Amendment, blacks received little protection from the Constitution. With *Brown v. Board* however, the court ruled segregation of any type to be unconstitutional and began to dismantle Jim Crow laws throughout the South. But the full protection of *Brown* was only given to non-whites. In other words, as James A. Ferg-Cadima of the Mexican-American Legal Defense and Education Fund (MALDEF) has said “*Hernandez*’ committed Mexican-Americans to defending their whiteness in further litigation, [leading] them to discount the utility of *Brown*, and kept them too long on what proved to be an unfruitful constitutional path.”¹⁷ Mexican-Americans could claim no protection under *Brown v. Board* because they had now legally established themselves as a separate class of whites, a direct result of

15 Steven H. Wilson, *Some Are Born White, Some Achieve Whiteness, and Some Have Whiteness Thrust Upon Them: Mexican Americans and the Politics of Racial Classification in the Federal Judicial Bureaucracy, Twenty-Five Years after Hernandez v. Texas*, in “Colored Men” and “Hombres Aqui” 123, 127 (Michael A. Olivas ed., 2006).

16 *Id.*

17 James A. Ferg-Cadima, *Black, White, Brown: Latino School Desegregation Efforts in the Pre- and Post- Brown v. Board of Education Era*, Mexican-American Legal Defense and Education Fund 1, 24 (2005) available at <http://www.maldef.org/publications/pdf/LatinoDesegregation-Paper2004.pdf>.

the *Hernandez v. Texas* ruling. *Hernandez* only provided protection when the discrimination could be proved, and as was said earlier, the Mexican-Americans discriminated against rarely had the resources to win a case.

VII. A MISSED OPPORTUNITY

The potential in the case lies in the definition of race as a social perception. According to Ian Haney Lopez, Professor of Law at Berkeley, the court ruled that “race is ultimately a question of norms and practices—that is, a social construction.”¹⁸ Racism and discrimination were no longer bound by a particular color, class or location. It could occur anywhere or at any time that one group looks down on another. Lopez called this “race as subordination, rather than race per se.”¹⁹ *Hernandez* opened the door for a new perception of race. But it appears that little has changed since the ruling.

What the Mexican-American community desperately needed was a legal identity. They were neither black nor white, but a separate group somewhere in between. Often they were called white, but frequently they were treated in the same unjust way as blacks at the time. The court never explicitly gave this identity. They did not come out and explicitly define Mexican-Americans as a legally recognizable and distinct group. Perhaps they reasoned that by making such a strong statement on behalf of Mexican-Americans the case would lose its relevance to racism in general. But there was no reason that the court could not have done both. In their profound view of civil rights, the court opened the door to any group facing discrimination, but they stopped short of giving the Mexican-American community a legal identity.

Sadly, in the years immediately following, *Hernandez* would prove to be legally ineffective. Texans continued to find ways around allowing Mexicans to serve on juries. They often used citizenship requirements, language requirements, or peremptory challenges to

18 See Ian Haney Lopez, *Race and Colorblindness After Hernandez and Brown* 25 Chicano-Latino L. Rev. 61, 67 (2005).

19 *Id.* at 62.

exclude Mexican-Americans.²⁰ This has changed very little today, as the number of Mexican-Americans serving on juries is disproportionately small. Some even say that the number is less today than in the years immediately following *Hernandez v. Texas*.²¹ Texas also used *Hernandez* to circumvent *Brown v. Board*. In what has been called Texas-style integration, the state put Mexicans and blacks in the same schools and then declared the schools “integrated.”²² In the years following *Hernandez*, Carlos C. Cadena tried to put together a string of litigation to develop the ruling further. He met with some limited success, but *Hernandez* failed to produce lasting changes.²³ One study looked at Grand Jury selection in Los Angeles County, California. It found that from 1959 to 1969 there were only 4 jurors selected with Spanish surnames out of 233 total selected.²⁴ Despite the failure of *Hernandez* to bring about any sort of lasting change, the case still has the potential to shape the future of race relations in America.

VIII. CURRENT APPLICATIONS

Today more than ever the principles of the *Hernandez* ruling could be used to mold a legal view of the Mexican-American community. The case is relevant in at least a few areas. First, *Hernandez* still has the potential to continue to influence race relations today. As of 2006 *Hernandez* had been cited only 38 times in cases argued before the Supreme Court, and in only four of those cases was it used to defend civil rights. In law reviews *Hernandez* was cited 392 times. Contrast this with *Brown v. Board* which has been cited in Supreme Court cases 176 times and been mentioned in over three thousand

20 Johnson, *supra* note 4, at 186-196.

21 *Id.* at 196.

22 Ferg-Cadima, *supra* note 17, at 26.

23 Johnson, *supra* note 4, at 184.

24 Lorenzo Arredondo & Donato Tapia, *El Chicano y the Constitution: The Legacy of Hernandez v. Texas Grand Jury Discrimination*, 6 U.S.F.L. Rev. 129, 136 (1971).

law reviews.²⁵ This implies that either *Hernandez* is insignificant in and of itself, or the case has been largely unused and overlooked. However it would be difficult to argue that the ruling is insignificant. The flaws in the ruling have already been discussed, but because the legal theory behind race as a social construct is so powerful, Ian Haney Lopez stated that *Hernandez* was “the single most insightful Supreme Court opinion on race ever handed down.”²⁶ *Hernandez* must be looked at again and applied today. The primary weakness of the ruling was that it required that discrimination be proved in every occurrence. This does nothing to change the underlying philosophy of race as a social construct developed in the ruling. If *Brown v. Board* changed the way races interact, *Hernandez* changed the way they are defined. Unfortunately, the classification of race remains largely a black and white binary.

A clear racial or ethnic identity is essential to any group seeking protection under the Fourteenth Amendment, but particularly in the case of Mexican-Americans. Never has the definition of their civil rights been more crucial. With the current debate over illegal immigration and the rising Mexican-American population across the country, it is vital that the principles of *Hernandez* be applied. As the *Hernandez* case established, wherever a group is unfairly discriminated against, they constitute a group worthy of constitutional protection under the Fourteenth Amendment. FBI statistics from 2007 show that crimes motivated by an anti-Hispanic bias account for 62.8 percent of all hate crimes stemming from nationality or ethnic discrimination.²⁷ This is up 25 percent since 2004.²⁸ Clearly this is a group that meets the *Hernandez* standard for Fourteenth

25 Richard Delgado, *Rodrigo's Roundelay: Hernandez v. Texas and the Interest-Convergence Dilemma*, 41 Harv. C.R.-C.L. L. Rev. 23, 36-38 (2006).

26 Ian Haney Lopez, *Race and Colorblindness After Hernandez and Brown*, 25 Chicano-Latino L. Rev. 61, 67 (2005).

27 2006 Hate Crimes Statistics (Nov. 2007), <http://www.fbi.gov/ucr/hc2006/victims.html>.

28 FBI Report Documents Hate Crimes Against Latinos at Record Levels (Nov. 19, 2007), <http://maldef.org/news/press.cfm?ID=444>.

Amendment protection. The study does not make a distinction between those Mexicans who are American citizens, and those who are illegal immigrants, but the Mexican-American Legal Defense and Educational Fund (MALDEF) suggests that the increase is due in part to the rising anti-immigrant sentiment.

One major obstacle facing the Mexican-American community today is that their position in society remains ambiguous. Recent census records show that this lack of an identifiable position extends to Mexican-Americans' own self-image. Steven Wilson noted: “Indeed, on the 2000 census, 47.9% of Hispanics identified their race as ‘white,’ and 42.2% declined to provide a racial categorization at all.”²⁹ If Mexican-Americans are not in accord concerning their racial and ethnic identity, one asks how they can be treated as a legally identifiable group protected under the Fourteenth Amendment. This lack of consensus is similar to the attitudes of Mexican-Americans in Texas at the time of the *Hernandez* ruling. Whereas in the 1950s, this reluctance to identify themselves as something other than white was driven by the fear of facing the same racial discrimination against blacks, today it is driven by a fear of being associated with illegal immigrants. As Johnson pointed out, “immigration status in modern times serves as a rough proxy for race.”³⁰ The raging debate over illegal immigration has amplified the problem of finding an identity.

Some anti-immigration groups take advantage of the unclear racial standing of Mexican Americans to discriminate against all people of Mexican ancestry in the United States. Their very standing as United States citizens is called into question. One of the results of the *Hernandez v. Texas* ruling should have been the establishment of Mexican-Americans as legal citizens of the United States. This is even more important in a country where some are suspected of having immigrated illegally. Although some arguments against illegal immigration are certainly grounded in legitimate concerns for the welfare of the United States, many are thinly veiled racism. Racist statements are able to hide behind a nationalistic rhetorical cover. A recent statement from Julie L. Myers, assistant secretary of

29 Wilson, *supra* note 15, at 142.

30 Johnson, *supra* note 4, at 187.

Immigration and Customs Enforcement reflects these undertones: “Violent foreign-born gang members and their associates have more than worn out their welcome, and to them I have one message: Good riddance.”³¹ A statement such as this directed at any other racial or ethnic group would be entirely unacceptable. Referring to Mexicans it is patriotic. This further illustrates the need for the Mexican-American community to obtain cogent legal identity and protection under the Fourteenth Amendment. *Hernandez v. Texas* has the potential to provide this in the same way *Brown v. Board* helped to define the rights of blacks.

Regardless of the debate over illegal immigration, the question of how to better protect Mexican-Americans under the constitution will persist. Before the law can begin to recognize their rights, there must be an identifiable group to protect. Juan F. Perea in the California Law review noted that “Full membership in society for Latinos/as will require a paradigm shift away from the binary paradigm and towards a new and evolving understanding of race and race relations.”³² This is precisely what *Hernandez v. Texas* has the potential to provide. It allows the issue of discrimination to transcend biology, and apply to race, ethnicity, or nationality. Ariela J. Gross, professor of law and history at the University of Southern California has said “For as long as we equate race with biology, and racism with the crudest forms of pseudo-science, as American courts have done, discrimination on the basis of cultural and linguistic difference will appear neutral and respectable and racial hierarchy will continue to flourish.”³³

As a society it is vital that we move towards the vision of *Hernandez v. Texas* to provide constitutional protection to whatever

31 Nina Bernstein, *Immigrant Workers Caught in Net Cast for Gangs*, N.Y. Times, Nov. 25, 2007, available at <http://www.nytimes.com/2007/11/25/nyregion/25raid.html>.

32 Juan F. Perea, *The Black/White Binary Paradigm of Race: The “Normal Science” of American Racial Thought* 85 Cal. L. Rev. 1213, 1215 (1997).

33 Ariela J. Gross, “*The Caucasian Cloak*”: *Mexican-Americans and the Politics of Whiteness in the Twentieth-Century Southwest*, 95 Geo. L.J. 337, 391-392 (2007).

groups are discriminated against. This protection should supersede whatever perceptions we have about a certain group’s racial or ethnic identity. Ian Haney Lopez recently said in an article for the New York Times, “After 50 years, the time has come for courts and scholars to install *Hernandez* where it belongs: at the center, with Brown, of a robust Fourteenth Amendment law committed to ending racial subordination.”³⁴ No longer can *Hernandez* be set aside as a minor civil rights case from the 1950s. The legal philosophy developed in the ruling must be applied to whatever groups are seeking protection. Indeed, the underlying principles of *Hernandez* could be used in cases of religious or gender based discrimination. Discrimination against homosexuals should also be protected under the Fourteenth Amendment if the principles of *Hernandez* are correctly applied.³⁵ This can be done by removing the focus on race, and instead emphasizing discrimination.

IX. CONCLUSION

The fact that Mexican-Americans would be permitted by the Supreme Court to serve as jurors after the *Hernandez* ruling cannot be described as anything less than an enormous victory. Even if Texas still found ways to exclude, to have a ruling from the Supreme Court was an incredible help to the self-image of Mexican-Americans. As Lopez pointed out “Trial by jury rests on the idea of peers being judged by peers. In the context of Texas race politics, however, to put Mexican-Americans on juries was tantamount to elevating them to equal status with whites.”³⁶ It was *Hernandez v. Texas* that philosophically defined discrimination as the subordination of one group by another, and the Mexican-American community that provided

34 Ian Haney Lopez, *Hernandez v. Brown*, N.Y. Times, May 22, 2004, at A17.

35 Michael J. Perry, *We the People the Fourteenth Amendment and the Supreme Court* 149 (New York, Oxford University Press 1999).

36 Ian Haney Lopez, *Race and Colorblindness After Hernandez and Brown* 25 *Chicano-Latino L. Rev.* 61, 63 (2005).

both the brain power and the persistence to see the case through. It is impossible to quantify the impact of the *Hernandez* ruling as a moral victory for the Mexican-American community. *Hernandez v. Texas* was not the landmark case that Garcia, Cadena, deAnda and the other attorneys for the petitioner expected, but any victory was a large victory considering the odds against the all Mexican-American legal team. What they did was unprecedented. They showed that Mexican-Americans are capable, articulate, and meaningful members of society. Now what remains is for that same reasoning to be developed through further litigation. The potential remains for *Hernandez* to change race relations not just for Mexican-Americans, but also for any group which faces discrimination. *Hernandez v. Texas* is best thought of not as an end in itself, but as a stepping stone.

THE EVOLUTION OF U.S. GENE PATENT LAW: FINDING THE BALANCE BETWEEN BLATANTLY OBVIOUS AND OVERLY-BROAD GENE PATENTS

by Jad Allen Mills¹

I. INTRODUCTION

Most anyone who has paid attention to stocks or medical journals knows that biotechnology is big business. The most exciting biotechnology developments often include the use of patented gene sequences. Genes encode protein structures and together they regulate how the body works. Gene patents are valuable because they allow the owner to control gene sequences used in gene therapies and in the testing and development of new treatments for debilitating diseases. Many people have argued against gene patents. Some individuals are opposed to all gene patents, while others argue only against the way that gene patent law has evolved in the United States. However, I maintain that the evolution of U.S. gene patent law has developed to prevent patents that close off entire industries, while providing a clear framework for determining whether a gene patent is obvious or not. The non-obviousness requirement for patents is designed to balance the interests of society and inventors by avoiding both overly-broad and blatantly obvious patents. The evolution of gene patent law preserves this balance and allows the discoverers of gene sequences to obtain funding and protect expected returns on their investments of time and money, resulting in the rapid evolu-

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tion of genetic technology. This paper first describes the controversy that surrounded early gene patents and common objections that were made against them. Then the development of the U.S. patent system is discussed to provide a framework to evaluate the evolution of U.S. patent law. Finally, this evolution is evaluated in terms of finding balance between the interests of society and intellectual property investors.

II. BACKGROUND

In 1991 the U.S. Supreme Court affirmed the 1987 patent of the erythropoietin gene, which codes for a hormone used to treat patients with kidney disease. The decision was of great financial importance to the parties involved because the owner of the patent was making over one billion dollars a year from the patent.² If the patent had not been affirmed, other companies would be allowed to compete for this business. This major case represented the kind of returns available from biomedical research and the importance of properly protecting intellectual property. Companies and inventors began testing the bounds of patent law by claiming increasingly broad patents with as little information as possible. As companies made and sometimes received broad claims of patent protection, the applications, lawsuits, and controversy intensified.

One such case occurred in October 1992 when the U.S. Patent and Trademark Office (PTO) granted patent rights to Agracetus Inc. for rights to all forms of genetically engineered cotton, regardless of the genes affected or the techniques used.³ Agracetus had used one procedure to genetically alter cotton in one way and received a patent on any kind of genetically altered cotton, no matter the process involved. In 1994 the European Patent Office (EPO) granted Agracetus a patent on all genetically engineered soybeans plants.⁴

2 Eliot Marshall, *Companies Rush to Patent DNA*, 275 SCI., NEW SERIES, 780-81 (1997).

3 Richard Stone, *Sweeping Patents Put Biotech Companies on the Warpath*, 268 SCI., NEW SERIES, 656 (1995).

4 *Id.* at 657.

The controversy and legal challenges erupted as people asked how one can patent all genetically altered forms of a natural product. They may have felt like the magician's guild had made a lucky rabbit's foot and was attempting to patent the whole rabbit. These broad patent claims intensified the race by biomedical companies to submit broader claims. The controversy reached an international furor in 1992 when a U.S. government body, the National Institutes of Health (NIH), submitted a patent application on cDNA pieces of approximately 5 percent of all human genes.⁵ The broad claims would have forced corporations to pay license fees for a patent that many argued was unpatentable as a natural product. While the NIH controversy was delayed and the broad claims were tied up in court, for many genetic researchers the question of the patentability of genetic material seemed unanswered. The law, on the other hand, had been prepared for this eventuality for some time.⁶

In 1980 the US Supreme Court reversed a PTO ruling denying a patent to Ananda Chakrabarty for the first genetically engineered organism.⁷ In essence Mr. Chakrabarty had created a bacterium that could clean up oil spills. The PTO had ruled that life could not be patented. The Supreme Court, however, ruled that, though living, this was an artificial substance. Further judicial decisions have made clear that even unchanged DNA sequences, once obtained from living beings, are artificial products, because these compounds do not exist in nature in an isolated, purified state.⁸ As John Doll, then PTO Biotech Section Chief explained, "Nobody owns the gene in your body, [but] inventors can own the right to exploit it commercially; you can't turn over a rock and find a gene."⁹ Between 1980 and 1997, over fifteen hundred of five thousand whole gene patent applications

5 Anna Maria Gillis, *The Patent Question of the Year*, 42 *BioSci.*, 336 (1992).

6 Marshall, *supra* note 2, at 780.

7 *Diamond v. Chakrabarty*, 447 U.S. 303, 310 (1980).

8 Marshall, *supra* note 2, at 781.

9 *Id.* at 781.

were granted.¹⁰ From 1980 to 1992 the PTO awarded over 112 patents on approaches to recombinant plant DNA and on genetically engineered plants alone.¹¹ Despite the intense opposition of the scientific community against patenting genes, the law was quite clear by 1990. As one U.S. Patent Office administrator, Charles Van Horn, put it, the furor was all about arguing over “what patent law should be, and not what it is.”¹²

III. THREE OBJECTIONS TO GENE PATENTS

Objections to the gene patents generally come in three varieties. The first objection is that patenting a human gene is immoral. For instance, objections to the EPO patent granted to Agracetus on genetically altered soybeans were based on an obscure statute regarding public morality.¹³ The suit claimed that a patent that broad created a monopoly on a vital food supply, and that such a threat to the world food supply was immoral. Interestingly enough, the European Parliament now claims that they prohibit gene patents because they offend morality¹⁴ and are an immoral inhibition to genetic research.¹⁵ Some may argue that gene patents are immoral because they say that any developments derived from our genes should be shared freely with all, and gene patents prevent this from happening. Others argue genetic research leads to increases in pollution and disease and decreases in genetic diversity and the value of human life.¹⁶ Egypt, India, Brazil, and the Andean Community all restrict gene patents to some degree or another.¹⁷ Although there may be a moral basis for

10 *Id.* at 781.

11 Stone, *supra* note 3, at 656.

12 Gillis, *supra* note 5, at 339.

13 Stone, *supra* note 3, at 657.

14 Nuno Pires De Carvalho, *The Problem of Gene Patents*, 3 WASH. U. GLOBAL STUD. L. REV. 701, 709 (2004) n21

15 *Id.* at 706.

16 Diamond, 447 U.S. 303, 316 (1980).

17 De Carvalho, *supra* note 14, at 707–708.

rejecting gene patents, this paper focuses instead on the legal basis for the validity of gene patents.

The second objection to gene patents is that genes should not be patentable because they are natural substances that exist in each of us, and natural substances should not be patented. Hubert Curien, then French Minister for Research and Technology, said:

A description of a short sequence of DNA or of cDNA is not an invention. It is knowledge about a part of the natural world that exists independently of the scientist, like the discovery of a new star or a new physical law. If the main argument for patenting cDNA sequences is that they are obtained thanks to innovative procedures, then let the procedures themselves be patented, but not the sequences established as a result of those procedures.¹⁸

Although Curien's argument makes a lot of sense to many people, his sentiments simply do not match up with the intent of the U.S. Patent system.

According to the United States Code, the PTO has power to grant patents to inventors for "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof."¹⁹ Though the naturally occurring gene as such is not patentable, the purified and isolated form is not considered a natural substance. The European Directive on Biotechnological Inventions captures the basic legal rationale for genes not being classified as natural substances. The directive states that "biological material which is isolated from its natural environment or produced by means of a technical process may be [the] subject of an invention even if it previously occurred in nature," and even if the isolated structure is identical to the natural one.²⁰ This distinction is justified by the claim that the isolated version of the gene is "the result of technical processes used to identify, purify and classify it and to reproduce it outside the human body," techniques that nature alone has not and never

18 Gillis *supra* note 5, at 336; (quotes Sci. 254:1711).

19 35 U.S.C. § 101 (2007)

20 De Carvalho, *supra* note 14, at 718 (See De Carvalho's notes 68 and 70).

will produce without human intervention. The difference between a natural substance and a manmade substance is that the manmade substance would not exist in its useful form without the intervention of a human; human authorship makes the substance artificial.

Some may question whether this definition makes anything a possible object of invention. For example, although patenting a method of isolating a diamond from a rock formation may be patentable, the diamond itself cannot be patentable because it exists naturally in isolated form. Because nature isolates diamonds from rock formations by the natural processes of erosion, both the isolated diamond and using natural erosion to isolate the diamond are not patentable. However, methods for isolating the diamond may be patentable if they isolate the diamond in some other way. Nature never isolates genes or purifies them into forms amenable to genetic research. For this reason genes and methods of obtaining gene are patentable subject matter. The difference comes in whether the invention would have “spontaneously come into existence without the applicants’ exertions.”²¹ Natural objects and phenomena occur without the aid of man, manipulatable genes do not.

Although this line of reasoning may not convince everyone that genes are potentially patentable material, precedence has already established this point of law in the United States. As I have mentioned before, the Supreme Court has already affirmed the validity of gene patents, some worth billions of dollars. Because U.S. law and the rule of law rely on binding legal precedence, it is not necessary to provide a comprehensive defense of the potential patentability of genes and genetic material.

The third common objection to gene patents is that the claims on these patents are too broad. Thomas Kiley, former vice president and general counsel at Genentech in California described the broad patents as an attempt to seek control of “not discoveries, but of the means of making discoveries.”²² With broad patents obtained on genes before the function or purpose of the gene was even known, companies may be able to profit from or control a field of unknown

21 Gillis, *supra* note 5, at 338.

22 *Id.* at 339.

potential. Such broad control would limit research to the handful of large corporations that hold control of these few broad patents. Although patents do not exclude research for academic purposes,²³ funding for ventures with no hope of financial gain would be extremely limited. In addition, the broad patent rights might increase cross-licensing cooperation among the large firms and drive smaller companies out of the business.²⁴ This argument seemed so compelling that a British Science Minister sought an agreement with its researchers to not seek patents on genes of unknown utility from research conducted using public funds.²⁵ In 1996, Francis Collin, director of the National Center for Human Genome Research, asked recipients of grants from his organization to release genetic data daily and not to seek patents on “raw genomic sequence” data because of the effect this would have on future research investment.²⁶

Whereas some countries have outright rejected gene patents on moral and legal grounds, the U.S. patent system has attempted only to regulate gene patents in order to prevent overly broad or unsupported patents from being issued. In 1993 the PTO rejected the NIH application citing a lack of proven commercial utility. As Bruce Lehman, then PTO commissioner explained, “a lot of this stuff is just data,” and data alone is not patentable.²⁷ Because of the volume of sequences per application and the percentage of sequences lacking sufficient description to prove commercial utility, the PTO limited each application to no more than ten sequences in order to force applicants to focus on real innovations. As recently as November 2007, PTO has once again attempted to alter patent examination rules to further regulate the issuance of patents.²⁸ The new rules would limit

23 *Id.* at 337.

24 Stone, *supra* note 3, at 658.

25 Gillis, *supra* note 5, at 336.

26 Eliot Marshal, *Is Data-hoarding Slowing the Assault on Pathogens*, 275 *SCL.*, NEW SERIES, 780 (1997).

27 *Id.* at 781.

28 Rules and Regulations, 72 *Fed. Reg.* 46,716 (August 21, 2007) (to be codified at 37 C.F.R pt. 1).

the number of automatic claims and continuations allowed per application. While the new rules will affect only 18 percent of all patent applications, they will affect 85 percent of biotech patents.²⁹

Over the years, biotechnology case law has developed to create a balance in the types of gene patents that are considered valid. The system seeks to prevent the issuance of overly-broad patents, without allowing patents to be issued for obvious inventions. Our current system resulted in part from those first broad and controversial gene patents just discussed in this background. In order to better illustrate the balance that has developed, I now review the basis and evolution of the U.S. patent system as it has adapted itself to properly apply the uniformity of the U.S. patent system to the development of genetic technology. I then review and evaluate some criticisms of this development. In this discussion I attempt to show that the current system is a natural outgrowth of the broad purposes of the patent system—to promote technological development by balancing the dichotomy between overly-broad and obvious patents.

IV. THE BASIS AND PURPOSE OF THE PATENT SYSTEM

Whereas some earlier patent systems served as arbitrary reward systems for favorites of the reigning king, the U.S. patent system was set up deliberately as a means for promoting technological progress. In sixteenth and seventeenth century England, patents were frequently abused by the sovereigns who would grant monopolies to their friends for practices that had long been common knowledge.³⁰ In contrast, Article I of the Constitution grants Congress the power to grant exclusive ownership rights in order to “promote the Progress [sic] of Science and useful Arts.”³¹ The constitution allows the federal government to grant monopolies for limited terms, but only

29 Letter from A. Scott Whitaker, Chief Operating Office, Biotechnology Industry Org., to Robert W. Bahr, Assistant Commissioner for Patents (May 2, 2006) <http://www.bio.org/ip/letters/20060502.pdf>.

30 *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 5 (1966).

31 U.S. Const. art. I, § 8, cl. 8 (See also *Diamond*, *supra* note 7, at 315 and *Graham*, *supra* note 30, at 5).

for “innovation, advancement, and things which add to the sum of useful knowledge.”³² This power was applied broadly from the very beginning. The Patent Act of 1793 described what could be patented as “any new and useful art, machine, manufacture, or composition of matter, or any new or useful improvement [thereof].”³³ Thomas Jefferson, the author of the 1793 patent legislation and one of the first patent commissioners stated that “certainly an inventor ought to be allowed a right to the benefit of his invention for some certain time. . . . Nobody wishes more than I do that ingenuity should receive a liberal encouragement.”³⁴

Patents exist to help address the economic problems of free-riders. People who create advances in technology are unlikely to share information with others because they will then lose their effective advantage gained by discovering the invention. However, if society will enforce their ownership of that information, the chances of disclosure increase. With increased disclosure, technological advances can take place more quickly as others can build upon the original advance. Thus the U.S. patent system is designed to encourage capital and intellectual investment in innovation by rewarding those who successfully invest by giving them a temporary monopoly. This encouragement comes at a price, as the monopolist will raise prices in the absence of competition. In order to reduce the cost of patents to the free market, patent systems seek to balance patent breadth by allowing neither “sweeping” patents nor patents of obvious innovations.

Inventors seek to construe the claimed invention to be as wide in applicability as possible in order to increase the market value of their patent. However, a sweeping patent may “foreclose entire portions of developing technologies in exchange for either insufficient or already available information,” thereby accomplishing an inefficient transfer

32 Graham, *supra* note 30 at 6.

33 Patent Act of Feb. 21, 1793, § 1, 1 Stat. 319 (See Diamond, *supra* note 7, at 314).

34 Letter to Oliver Evans (May 1807), V Writings of Thomas Jefferson, at 75–76 (Washington ed.); quoted in Graham, *supra* note 30, at 8.

of wealth.³⁵ If, however, patent scope is limited to avoid granting only a few, sweeping patents, a large number of limited patents may be granted, some of which may be obvious considering prior inventions. Thus, patent granting is a balancing act between allowing the overly broad, and allowing the blatantly obvious.

V. PATENT ELIGIBILITY CRITERIA

A. Novelty and Utility

Statutory subject matter, as described in the response to objection two, must also be novel, non-obvious, and useful in order to be patentable.³⁶ If any one of these three conditions is not met a patent cannot be granted.

To be novel an invention must not have been published or used anywhere in the world more than a year prior to the application for the patent. To have utility the invention must have at least one known credible and specific application. Utility also requires that the invention be enabled. Enablement includes providing a description of the preferred embodiment of the invention that contains sufficient description that an individual skilled in the technology (called an art) would be able to make and use the invention as intended without excessive experimentation.³⁷ If the description does not adequately explain the use of the claimed invention, then the standards of enablement and utility are not met and that invention cannot be patented. Meeting standards of utility and novelty have been requirements for receiving a patent since the U.S. patent statute of 1793.³⁸ More

35 Anita Varma and David Abraham, *Dna is Different: Legal Obviousness and the Balance Between Biotech Inventors and the Market*, 9 Harv. J. Law & Tec. 53, 55 (1996).

36 35 U.S.C. § 101, 102, 103 (2007).

37 John J. Doll, *The Patenting of DNA*, 280 SCI., NEW SERIES, 690 (1998).

38 Patent Act of Feb. 21, 1793, § 1, 1 Stat. 319 (See Diamond, *supra* note 7, at 314).

recent cases have helped to elucidate the meaning of these requirements for gene patents.

In 1966, the US Supreme Court ruled in *Brenner v. Manson* that chemical inventions must be coupled with a likely and useful application in order to be patentable.³⁹ The court stated that “unless and until . . . specific benefit exists in currently available form—there is insufficient justification for permitting an applicant to engross what may prove to be a broad field.”⁴⁰ However, the requirement of having utility does not mean that a patent must describe a completely optimized embodiment of the invention. In the 1980 8th Circuit case of *E. I. DuPont de Nemours & Co. v. Berkley & Co.*,⁴¹ the court found that “an invention does not lack utility merely because the particular embodiment disclosed in the patent lacks perfection or performs crudely. . . . A commercially successful product is not required.”⁴² In addition, not all possible uses must be known. The requirement is fulfilled if sufficient evidence is provided that the invention is potentially useful. The U.S. standard requires only a small threshold for proving utility. For example, U.S. patent law allows patents to be granted on protein or cDNA sequences even if the protein function is not yet known because the sequence has possible uses by itself, such as acting as a probe for karyotyping.⁴³ In contrast, in Great Britain, patent protection cannot be obtained unless the invention comprises an immediate industrial application.

B. Obviousness

In the first sixty years of U.S. patent law, commissioners and judges evaluated patent applications with the two defined parameters of novelty and utility, but also with a very vague requirement that it must describe an invention. In 1851 the Supreme Court formulated

39 Gillis, *supra* note 5, at 338–339.

40 *Brenner v. Manson* 383 U.S., 519, 535 (1966).

41 *E.I. du Pont de Nemours & Co. v. Berkley & Co., Inc.*, 620 F.2d 1247, 1257 (8th Cir. 1980).

42 Gillis, *supra* note 5, at 338.

43 *Id.*

a guideline for determining whether a claim truly constituted an invention. In *Hotchkiss v. Greenwood*, the Court invalidated a patent by introducing the requirement of non-obviousness. The Court held that an invention requires a contribution to the specific field of the innovation that would not be obvious to a practitioner of common skill in that particular field.⁴⁴ “Unless more ingenuity and skill . . . were required . . . than were possessed by an ordinary mechanic acquainted with the business, there was an absence of that degree of skill and ingenuity which constitute essential elements of every invention. In other words, the improvement is the work of a skillful mechanic, not that of the inventor.”⁴⁵ In *Hotchkiss*, the court tried to clarify a more specific parameter for determining whether some development is really an invention by introducing the requirement of non-obviousness. In so doing, the court also tied the non-obviousness threshold to the level of common skill in each particular art (field of invention).⁴⁶ In addition to making patent law industry specific, the requirement of non-obviousness also placed the patent system in a delicate balancing act. If obviousness depends on the level of expertise of the art’s common practitioner, fields with a low perceived threshold of skill in the art might be tempted to allow overly broad patents. On the other hand, in an attempt to avoid allowing patents of an overly sweeping scope, the patent office might allow a multitude of seemingly obvious patents.

In 1952, Congress incorporated and codified the requirement of non-obviousness into the 1952 Patent Act.⁴⁷ In *Graham v. John Deere*, the Supreme Court set out to determine whether the Patent Act of 1952 changed the statutory and judicial tests of patentability.⁴⁸ They concluded that the act merely included the judicial test described in the *Hotchkiss v. Greenwood* decision of 1851, and that “the general level of innovation necessary to sustain patentability

44 Graham, 383 U.S. 1, 11 (1966).

45 *Id.* (quotes *Hotchkiss v. Greenwood*, 11 How. 248, 268 (1851)).

46 Graham, *supra* note 44, at 14.

47 *Id.* at 3–5.

48 *Id.*

remains the same” as before the 1952 Patent Act.⁴⁹ In *Graham*, the court identified four parts to an obviousness inquiry.⁵⁰ The inquiry includes first determining the scope and content of the prior art, and second determining the difference between the claimed invention and the prior art. Thirdly, the level of ordinary skill in the pertinent art must be identified, after which the fourth step of considering any secondary indications of non-obviousness may be undertaken. Secondary indications may include commercial success or a long-felt need in the art.⁵¹ After completing these four steps, an innovation is determined to be obvious “[i]f the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”⁵² It is this standard that has been applied over the past fifty years to balance the intellectual property rights of the inventor with the needs of the market, all the while tailoring the inquiry to the current state of the particular art by tying obviousness to the level of skill of an average practitioner in that particular art.

C. *Prima Facie Obviousness*

Although this four-step plan seems simple enough, it becomes much more complex when one considers the incredible amount of prior art that has been accumulating over the last two centuries. In order to deal with this difficulty, procedures for determining prima facie obviousness have been developed. Patent applications are presumed patentable when filed with the PTO.⁵³ If the examiner can build a case of prima facie obviousness, the applicant must then pres-

49 *Id.*

50 *Id.*

51 Varma, *supra* note 35, at 66 (See also Varma’s notes 61 and 62, and *Graham*, *supra* note 30 at 17–18).

52 *Id.* at 65 (See Varma’s note 59).

53 See *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993) and *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

ent evidence to overcome the prima facie rejection.⁵⁴ One proposed method for establishing a prima facie case of obviousness includes using the “suggestion test.” The suggestion test asks whether teachings in the prior art “would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.”⁵⁵

Gene patents frequently claim methods of obtaining and using genes as well as actual structures (nucleotide sequences) of genes. When a gene structure (sequence) is claimed, the doctrine of structural similarity is generally applied to determine obviousness. The doctrine of structural similarity existed before the 1952 Patent Act and was reaffirmed in the Federal Circuit case of *In re Dillon*.⁵⁶ Since chemical function corresponds with structure, compounds with the same chemical structure are assumed to have similar functions. DNA and RNA are merely large, complex chemical compounds. As such, they have traditionally been evaluated by means of the structural similarity test.

In re Bell teaches that when a specific gene is claimed as a composition by detailing the sequence, only prior disclosure of that sequence or other sequences with an intrinsic motivation to convert it to the claimed sequence can be used to determine obviousness. The PTO initially rejected Bell’s patent because the primary sequence of the protein was known, as were methods of obtaining the DNA sequence.⁵⁷ The court ruled that “the PTO’s focus on Bell’s method is misplaced. Bell does not claim a method. Bell claims compositions, and the issue is the obviousness of the claimed compositions, not of the method by which they are made.”⁵⁸ This position was reaffirmed in *Deuel*.⁵⁹

Although a method of obtaining the correct gene sequence may be obvious, this does not make the gene sequence itself obvious, and

54 Varma, *supra* note 35, at 66–67.

55 *Id.* at 67 and 79.

56 *Id.* at 67.

57 *In re Bell* 991 F.2d 781, 785 (Fed. Cir. 1993).

58 *Id.* at 785.

59 *In re Deuel* 51 F.3d 1552, 1559 (Fed. Cir. 1995).

thus allows the gene sequence to be patented.⁶⁰ Given that Deuel claimed a new chemical entity in structural terms, prima facie obviousness would require that the prior art suggest the claimed structure, not simply how to obtain the structure.⁶¹ The court defined the issue in *Bell* and *Deuel* not as a matter of the uncertainty in obtaining a particular sequence, but in the uncertainty of predicting or visualizing from the prior art what sequence would be found.⁶²

The courts also dismissed the idea that the translational relationship between proteins and DNA makes the DNA sequence obvious based on the known protein sequence, “because the redundancy of the genetic code permits one to hypothesize an enormous number of DNA sequences coding for the protein. No particular DNA sequence can be obvious unless there is something in the prior art to lead to that particular DNA sequence and indicate that it should be prepared.⁶³ The actual structure of the sought gene sequence is almost never obvious in light of the protein sequence because the degeneracy of the genetic code allows multiple gene sequences to code for the same amino acid.

D. Actual Sequences Required to Define and Describe Genes

In addition to defining the nonobviousness threshold for genetic inventions, the structural similarity test also impacts the standard required to define the invention. The courts have long held that an actual gene sequence is required as part of a composition claim for a gene. In *Fiers v. Revel*, the court held that disclosing a method for isolating DNA that would enable an ordinary practitioner to have a reasonable chance of success in obtaining the DNA does not establish conception of the DNA sequence, and therefore cannot consti-

60 *Id.* at 1557–1558. See also *Bell*, *supra* note 56 at 784–785, and *In re Thorpe*, 777 F.2d 695, 697 (Fed. Cir. 1985).

61 *Id.* at 1557–1558.

62 Dan L. Burk and Mark A. Lemley, *Is Patent Law Technology-Specific*, 17 *Berkeley Tech. L. J.* 1155, 1179 (2002).

63 *Deuel*, *supra* note 59, 1558–1559.

tute a claim on the DNA itself.⁶⁴ Furthermore, the court held that it is “not sufficient to define it [the gene] solely by its principal biological property, e.g., encoding human erythropoietin [protein], because an alleged conception having no more specificity than that is simply a wish to know the identity of any material with that biological property.”⁶⁵ The court further explained that “when an inventor is unable to envision the detailed chemical structure of the gene so as to distinguish it from other materials, as well as a method for obtaining it, conception has not been achieved until reduction to practice has occurred, i.e., until after the gene has been isolated.”⁶⁶ “Irrespective of the complexity or simplicity of the method of isolation employed, conception of a DNA, like conception of any chemical substance, requires a definition of that substance other than by its functional utility.”⁶⁷ A definition by function only defines what the gene does and not what it is.⁶⁸ “Conception of a substance claimed *per se* without reference to a process requires conception of its structure, name, formula, or definitive chemical or physical properties.”⁶⁹

The actual sequence is required not only as proof of conception of the invention, but also to provide an adequate description of the invention.⁷⁰ “A bare reference to a DNA with a statement that it can be obtained by reverse transcription is not a description; it does not indicate that [the inventor is] in possession of the DNA.”⁷¹ This idea was confirmed in another case, the *Regents of the University of California v. Eli Lilly*.⁷² The court found that the specifics required for a competent description of DNA requires describing the “structure,

64 Fiers v. Revel 984 F.2d 1164, 1167 (Fed. Cir. 1993).

65 *Id.* at 1169.

66 *Id.*

67 *Id.*

68 Burk, *supra* note 62, at 1176.

69 Fiers, *supra* note 64, at 1169.

70 Burk, *supra* note 62, at 1175.

71 *Id.* at 1175 (See Burk’s note 81).

72 *Id.* (See Burk’s note 84).

formula, chemical name, or physical properties.”⁷³ A description requires more than just saying that the gene is part of the invention because one has part of the gene and a potential method for isolating the entire gene.⁷⁴

Each of these cases has refined biotechnology patent law to a position in which genes are not obvious based on the proteins they code for, and in which the sequence of that gene is required both to define and to describe the invention itself. According to one commentator:

The conceptual linkage of obviousness and enablement to the depiction of macromolecular sequences in, respectively, the prior art or the patent disclosure, dictates a particular and predictable result for the availability and scope of such biotechnology patents. The expected outcome is that DNA patents will be numerous but extremely narrow. Under the Federal Circuit’s precedent, a researcher will be able to claim only sequences disclosed under the stringent written description rules—the actual sequence in hand, so to speak. . . . At the same time, the inventor is shielded from obviousness by the lack of such explicit and detailed disclosure in the prior art. This lack of effective prior art seems to dictate that anyone who has isolated and characterized a novel DNA molecule is certain to receive a patent on it. But the inventor is certain to receive a patent only on that molecule, as the Federal Circuit appears to regard other related molecules as inadequately described until the sequence is disclosed.⁷⁵

VI. ATTACKING THE EVOLUTION OF GENE PATENT LAW

According to Varma and Abraham, this state of affairs in biotechnology patent law has upset the balance between protecting the

73 *Id.* at 1174 (See Burk’s note 78).

74 Fiers, *supra* note 64 at 1170. See also *Regents of the University of California v. Eli Lilly and Co.*, 199 F.3 1559, 43 USPQ2d 1398 (Fed. Cir. 1997).

75 Burk, *supra* note 62, at 1181.

interests of patent applicants and the interests of society.⁷⁶ Varma and Abraham argue that this occurred because court decisions have improperly applied the structural relationship test of obviousness to DNA,⁷⁷ improperly rejected general process disclosures from questions of obviousness of compositions,⁷⁸ and improperly applied the doctrine of selection inventions.⁷⁹ They argue that the structural relationship test does not work appropriately with DNA because the value of DNA is in its correlative relationship to protein structures, and not in its own structure.⁸⁰ Because seemingly minute changes in a DNA structure can cause enormous and unanticipated changes in protein structure, they claim that the structural relationship test is insufficient to determine obviousness of DNA sequences. This has led to an imbalance in favor of applicants seeking to patent gene sequences, as almost any gene sequence turns out to be patentable. Varma and Abraham cite the case of *DeForest Radio v. General Electric*⁸¹ to show that general processes have been used as prior art to invalidate compositions. Regarding the doctrine of selection inventions, they argue that it was inappropriately used in *Bell* and *Deuel* because the breadth of choices should be considered relative to the practitioner of average skill in the art, and not in absolute numbers.⁸² They urge use of the suggestion test instead of the structural similarity test and show that doing so will make most, if not all new gene patents, obvious in the current state of the art.

VII. DEFENDING THE EVOLUTION OF GENE PATENT LAW

In response to Varma and Abraham, I argue that their use of the suggestion test enforces a much higher standard of invention than

76 Varma, *supra* note 35, 55–56.

77 *Id.* at 69.

78 *Id.* at 76.

79 *Id.* at 73.

80 *Id.* at 68–69.

81 *DeForest Radio Co. v. General Elec. Co.*, 283 U.S. 664, (1931).

82 Varma, *supra* note 35, at 79.

was envisioned by the statute or constitution, and I contend that their use of *Deforest* is ill founded. In *Deforest*, the prior art disclosed the exact same structure for the exact same use.⁸³ A vacuum tube was described and claimed and it was suggested that a higher vacuum in the tube would be beneficial. A method for creating a higher vacuum was also described. The later patent that was invalidated merely disclosed the same vacuum tube from the prior art with the greater vacuum that had been suggested and enabled in the prior art patent.⁸⁴

Although anyone with a Ph.D. in a relevant field, given the proper time and funding can reasonably expect to isolate a gene sequence given the protein sequence, this still constitutes a real and important advance in available technology. Because a substantial investment is still required to obtain the invention and because the prior art cannot predict the exact nature of the invention, newly sequenced genes are not obvious. The reason gene sequences are so unpredictable from protein sequences lies not in the field of genetic technology, but in thermodynamics. Science's current understanding of the laws of thermodynamics has proven insufficient to accurately predict the effects of pinpoint gene mutations in final protein structures.⁸⁵ Because of this lack of comprehension, practitioners are almost entirely at a loss to accurately predict gene structure from protein structure. Making a completely unknown structure obvious simply because it is known to exist and methods of finding it can be postulated significantly increases the inventive standard envisioned by the drafters of both the original and subsequent patent acts. Doing so may be akin to ruling all inventions of any kind obvious because someone can envision a method of creating an invention.

To illustrate this point, I describe a generic method of creating an invention with four steps. Step 1: Determine an area of production or industry facing some sort of problem or inefficiency. Step 2: Design a novel way to address that problem or inefficiency. Step 3: Enable the method. Step 4: Apply for a patent on the method. Although

83 *Deforest*, *supra* note 81, at 675.

84 *Id.* at 676.

85 Interview with Mathew C. Asplund, Assistant Professor of Chemistry and Biochemistry at Brigham Young University in Provo, Utah (Dec. 4, 2007).

it may seem absurd that this method could make any invention obvious because the method is so generic, if followed by a practitioner of average skill in an art, that practitioner has a reasonable chance of arriving at a solution. The reason this method does not make that solution obvious is the same reason that DNA probing techniques do not make DNA sequence obvious: the methods give little or no information about the product being sought. My method cannot define nor describe the invention being sought, but if followed with diligence it will almost certainly yield a productive result.

There is a clear corollary in biotechnology that illustrates the absurd consequences of allowing generic methods of discovery to obviate particular inventions. Vaccines have been developed and used for years. Any immunologist can testify that there are tried and true methods of obtaining a vaccine for a normal pathogen. I say normal here, because some diseases, such as HIV, adapt so quickly that normal methods of vaccine development are not effective. The method includes identifying a pathogen-born disease to which one desires to develop a vaccine. One may then isolate weakened or dead samples of the pathogen and inject them into a healthy immune system. The immune system develops antibodies to the pathogen, and the researcher isolates, purifies, and mass produces the antibodies in a vaccine to administer to others. Despite the fact that the average practitioner in the art has a reasonable expectation of success in developing the antibody, the specific antibody, the doses required, and the ideal medium for administration, are unknown. Knowing a generic method of finding the desired product contributes little to our conception of the final product. Individuals must still go through the sometimes tedious process of invention and development, even knowing that they have a method that gives a reasonable probability of success.

The vaccine example also connects well with gene patents for a second reason. Both genes and antibodies are naturally occurring materials that become patentable compositions when they are isolated from their natural state and purified into a form that allows for their manipulation. Whereas two hundred years ago most inventions were merely the adaptation of naturally occurring minerals or fibers

for the use of mankind, genes and antibody inventions adapt naturally occurring micro-objects for the use of mankind. Traditionally, inventors made machines to transform a natural element into a man-made product; naturally occurring iron ore may be put into a smelter and processed to create steel. Some may find it distasteful to use a living thing, especially a human body, as part of a machine to transform the natural into the manmade. However, all of our machines are merely natural objects combined or adapted for the use we design for them. The fact that we have used a living organism, even a human, to develop a transferable immunity that would not otherwise naturally occur, is probably much more beautiful than it is scary. Along with genes, the antibody that is developed and isolated may be exactly like the one that may exist naturally in each of us. However, such antibodies do not tend to naturally jump from one person to immunize an entire population. Similarly, naturally occurring genes very infrequently pop out of people's bodies naturally in a condition where they can be manipulated by mankind. Even if the isolated antibody can be proven to be exactly like one naturally existing in our bodies, and even if the method used to obtain it could have been predicted to be successful by most immunologists out there, is there not still an inventive spark in developing that new vaccine? The presence of a pathogenic disease and a method of obtaining a vaccine against it certainly does not predict for us the specifics of that vaccine or the antibody within it. Then, certainly the existence of a protein and a method of obtaining a genetic sequence for it does not make the specifics of the gene obvious.

So far as fears that patents will have an adverse effect on research and biomedical progress, such has been the fear from the beginning of intellectual property protection in the 1790s. The same arguments were used forty years ago when polymer chemistry was introduced.⁸⁶ Critics claimed that patents granted on synthetic polymer products and processes would devastate the market. The truth was that the first polymer patent in 1965 did not prevent later patents of related inventions. Similarly, polymerase chain reaction (PCR) and HIV Protease patents did not hinder biotechnology research,

86 Doll, *supra* note 37, at 689.

but rather encouraged innovations based on the original patent.⁸⁷ That is the purpose of patents, to encourage investment and the dissemination of technology by ensuring the protection of intellectual property.

VIII. CONCLUSION

Though some will continue to question the morality of patenting a gene sequence derived from a living organism and especially from a human being, the fact is that as a matter of law, genes are patentable materials in the U.S. I began this paper by discussing the fear and controversy surrounding those first, broad gene patents. I then presented the basics of patent law and the evolution of gene patents that are defined specifically and narrowly by specific gene sequences. Next, I reviewed the argument from Varma and Abraham that this evolution has led us down a mistaken path and damaged the economic balance of the patent system. These objections, though interesting, are unconvincing. The non-obviousness requirement of patents is designed to balance the interests of society and inventors by finding the right path between granting sweeping, overly-broad patents, and allowing patents on the blatantly obvious. The current evolution of gene patents has struck that balance, allaying the fears about patenting entire industries with insufficient information while providing a clear framework for determining whether a gene patent is obvious or not. This framework allows discoverers of gene sequences to obtain funding and protect expected returns on their investments of time and money. Without patent protection, perhaps we would not have all of the gene sequences today that we do. The evolution of gene patent law, in light of the non-obviousness requirement, has preserved the careful balance between granting a few overly broad patents and granting many narrow patents that, if upset, may have inhibited financial investment and new discoveries.

87 *Id.* at 689.

NO CHILD LEFT BEHIND? ISSUES AND OPTIONS IN THE NEW WORLD OF EDUCATION

by Adam Neilson¹

I. INTRODUCTION

Predated by the Clinton administration's education program Goals 2000 and Ronald Reagan's report on the state of education in 1983, *A Nation at Risk*, the most recent incarnation of educational reform instituted by the government is the No Child Left Behind Act (NCLBA, or the Act) of 2001.² Its goal: use information gleaned from standardized testing to close achievement gaps between minority and low-income children and their Caucasian counterparts.³ The act requires schools to make "adequate yearly progress" (AYP) toward meeting this goal, as defined by each state's education department. In order to measure their progress, schools are required to test students' math and reading annually during grades three and eight as well as once during high school. If a school's scores do not meet the AYP requirement for two consecutive years, they face escalating sanctions; these sanctions include redevelopment or revision of school curriculum, school-funded after-school tutoring, and even allowing students to transfer schools. If the school continues to miss target AYP scores, they will ultimately be faced with removing staff, restructuring the school's organization, and extending the school day and year, as well as appointing expert advisors to help get

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2 See No Child Left Behind Act, 20 U.S.C. §§ 6301-7941 (2007).

3 *Id.* § 6301.

the school back on track. These sanctions, based on the information gleaned from test scores, frame the argument in this article.

Sections II and III will focus on how the Act's reliance on standardized test scores runs counter to the aims of the Act. While the Act provides a needed accountability program in public education, ultimately this program has one major flaw: the test score information the Act uses is not good information. Furthermore, with consequences based on questionable information, the Act has diverted focus away from actual student learning and harmed the educational environment in the process, especially for low-income and minority students.

But despite the current body of evidence against NCLBA, there is unlikely to be any legal relief in the short-term. Section IV of this article will discuss obstacles facing legal challenges to the Act. The chief problem facing any legal challenge is a lack of standing. Though NCLBA has been signed for nearly seven years, schools are not required to be fully compliant with the Act until 2014. As such, there have not been any sanctions levied against non-compliant schools, and thus no injury has occurred. This section will go on to discuss this problem in conjunction with recently decided court cases involving the Act. Section V will then suggest a better course of action for challenging the NCLBA.

II. STANDARDIZED TESTS: ARE THEY RELIABLE?

One of the main issues in evaluating schools and students through the NCLBA arises from the Act's reliance on standardized testing. In general, demonstrating the validity of standardized tests is difficult. One of the main reasons for this is that there must be a large body of empirical evidence to support the test and its methodology.⁴ This support must show that the test actually does measure what it sets out to measure and that the test does so in a fair manner. Research of this kind takes time to accumulate but is nevertheless necessary for proving test validity. The problem with the NCLBA is

4 See Mary Lee Smith & Patricia Fey, *Validity and Accountability in High-Stakes Testing*, 51 J. TEACHER EDUC. 334, 338 (2000).

that its state-designed and -implemented tests have not had the time to put together the necessary research, and without research, there simply is not enough knowledge about these tests to say they produce reliable measurements of proficiency. One of the gold standards in the field of standardized tests is the Iowa Test of Basic Skills, a test that has been used in some form since 1930, giving it ample time to demonstrate that it produces valid results. While it is true that the tests used for NCLBA compliance have to start somewhere, the difficulty lies in the fact that sanctions will be levied against schools and students before those tests are proven to be valid.

Another aspect confounding discussion of the Act's standardized tests is that test scores are being used to make important decisions. By placing such high stakes on test scores, the Act has created an educational environment where teachers forgo teaching as they would normally and instead specifically focus their curriculum on the test. This kind of environment, however, is problematic. When curriculum focuses on test material and strategies, it undermines the validity of the test since the test no longer measures learning in classrooms but rather the ability of a student to take a test. To illustrate, suppose a teacher gave an English test where students were asked to only point out all grammar mistakes. While passing this test might point to the student's ability in identifying grammar problems, this test cannot certify that the student is proficient in grammar because the test neglects to address related proficiencies such as the ability to use grammar properly in different contexts.

A study by Koretz, Linn, Dunbar, and Shephard⁵ bears this out. In order to demonstrate how teaching to the test can affect test scores, Koretz et al. studied the scores of a group of students on two similar tests. The first test was a low-stakes test that had not been "taught to" in the classroom, and the second test was a high-stakes test which had been "taught to." Koretz et al. posited that if a taught-to high-stakes test indeed does measure actual achievement in these areas, students' scores on both tests should theoretically be

5 See Daniel Koretz et al., Professor, Harv. Graduate Sch. of Educ., Address at the American Educational Research Association: The Effects of High-Stakes Testing: Preliminary Evidence about Generalization across Tests (April 1991).

similar. However, their study showed that scores on high-stakes tests were months ahead of scores on low-stakes tests. They concluded that this was because “students are prepared for the high-stakes testing in ways that boost scores on that specific test substantially more than actual achievement in the domains that the tests are intended to measure.” The scores in the high-stakes test did not actually point to achievement but rather the ability to take the test. Again, this type of study highlights that standardized tests, in their current context, are likely to produce questionable results. And unfortunately, these questionable results will be used to make far-reaching decisions.

III. AN UNDESIRABLE EDUCATIONAL ENVIRONMENT

As a result of the pressure to “teach to” tests required by the Act, schools are also finding that they must eliminate other educational areas like music, art, science, and even recess.⁶ While reading, math, and science—the only areas currently tested under the Act—are definitely integral pieces to an adequate education for all students, so are subjects like art and science. A diverse education enriches students’ educations and eliminating that diversity is one of the first steps toward creating a substandard learning environment on a national level. A diverse education also offers students a plethora of opportunities to find the area in which they excel, something that contributes to developing a love for learning. By taking these study areas away, schools run the risk of creating apathy among their students. In a book on standardized testing, one education expert writes, “Test-driven classrooms exacerbate boredom, fear, and lethargy, promoting all manner of mechanical behaviors on the part of teachers, students, and schools, and bleed schoolchildren of their natural love of learning.”⁷ These kinds of classroom settings are not desirable for students.

In low-income and minority schools, test focus is even more pronounced. In a study on the effects of high-stakes testing in these

6 See Marcia Gentry, *Examining Disability and Giftedness in Schools*, 10 PROF. SCHOOL COUNSELING 73, (2006).

7 PETER SACKS, *STANDARDIZED MINDS* 256 (Perseus Books 1999).

schools, researchers found that as the school year progressed toward end-of-year tests, schools with 30 percent or more poverty spent 27 percent more time on test preparation than low-poverty schools.⁸ The total percentage of time spent on test preparation for these schools was 77 percent. The main problem with a 77 percent focus on tests is that it exacerbates the validity problem even further in minority and low-income classrooms. In these classrooms, the likelihood that test scores are not valid assessments increases with the amount of time spent on preparing. This cheats the students who are supposed to be benefiting from the Act. They need to be measured by fair and valid tests in order to help future students in these schools close the gap with white students.

Another peril of eliminating curriculum is that it sends a poor message to students. By mandating tests that ultimately define and limit curriculum, children learn that achieving high test scores is the primary function of education. Again, this is an area where the effects of NCLBA explicitly run counter to its aims. While it may be that sufficient learning will produce acceptable test scores, it is not necessarily the case that acceptable test scores point to sufficient learning. As students learn that test scores are their goal, they, along with their teachers and administrators, will find little use for actual learning beyond what they need to know for their tests. For some students, especially those students on the extremes of the educational spectrum, this test-centric culture will be devastating and will further alienate them from the system. Moreover, setting up a culture like this will also lead to an increased proclivity among students, teachers, and administrators to cut corners. Even now states are identifying loopholes and other means to circumvent the Act in order to exploit them.⁹ They then use these loopholes to lower standards and delay full-scale implementation of the Act. It has become a race to the bottom. Not only are schools teaching to the test, they are also emphasizing the minimum each student needs to know. Ac-

8 Current Issues in Education: Volume 6 Number 8, <http://cie.asu.edu/volume6/number8/> (last visited Jan. 17, 2008).

9 See, e.g., Shelley B. Wepner, *Testing Gone Amok: Leave No Teacher Candidate Behind*, 33 TCHR. EDUC. Q. 135, 136 (2006).

ording to one educational expert, this approach is fundamentally flawed because it

[h]as very little to do with intellectual life, where risk-taking, exploration, uncertainty, and speculation are what it's about. And if you create a culture of schooling in which a narrow means/ends orientation is promoted, that culture can undermine the development of intellectual dispositions.¹⁰

While the reasons for reducing curriculum in schools are understandable, the problems that stem from that elimination contribute to the degradation of the learning environment. It is this degradation of the learning environment combined with a reliance on high-stakes testing that especially harms the very students the Act seeks to help.

IV. LACK OF POTENTIAL LEGAL RELIEF

In response to much of the data concerning tests and other problematic aspects of the NCLBA, many states and interest groups have turned to the legal system for relief from the Act's provisions. However, much like the Act's test reliance, legal challenges to the Act are problematic at best. In spite of taking the next logical step to the courts, these potential plaintiffs face significant obstacles that will hinder any efforts in this arena.

A. Constitutionality

One possible method is that of challenging the constitutionality of the NCLBA due to its infringement into education, an area of control traditionally reserved for the states. The Constitution provides that any power not expressly given to the federal government is a power given to the states,¹¹ and as there is no mention of education within the provisions of the Constitution, education has primarily

10 Elliot Eisner, *What Does it Mean to Say a School is Doing Well?*, 82 PHI DELTA KAPPAN 367, 369 (2001).

11 See U.S. CONST. amend. X.

remained the concern of the states. In the General Education Provisions Act (GEPA), the federal government makes a bold claim re-asserting the limits to their influence in the public school system. They state that “no provision . . . should be construed to authorize any department, agency, office or employee of the United States to exercise any direction, supervision, or control over the curriculum, program of instruction, administration or personnel of any education institution, school or school system.”¹² The GEPA and the Elementary and Secondary Education Act (ESEA), both predecessors to the NCLBA, garnered much support from the states through this claim. Unfortunately, government action since then has not made good on that claim. From the time of the enactment of the GEPA, federal influence over public schools has increased, albeit indirectly, culminating with the provisions of the NCLBA.

Unfortunately, challenging the constitutionality of the Act faces two distinct issues: first, the Act is not a mandatory program, but merely a way for states to receive federal funding to supplement their own funding; and second, the Act’s conditional disbursement of funding to states is subject to the discretion of Congress, an area where only a low threshold of constitutionality must be established.

Although there are a plethora of requirements for compliance with the NCLBA, the government maintains that compliance with its education programs is optional. The problem with this position from the states’ point of view is that funding from the federal government is vital to schools in low-income areas. A study into the role of federal funding in low-income areas shows that federal funds comprised a more significant portion of revenues per student at the poorest schools than they did at the more affluent (11 percent versus 2 percent, respectively).¹³ Despite the higher percentage of federal funding, these low-income schools still saw less money per student than did more affluent schools. Since the study concluded, the government has poured more money into school grants than ever before, making low-income schools even more dependent on these

12 20 U.S.C. § 1232a (2007).

13 See JAY CHAMBERS ET AL., *STUDY OF EDUCATION RESOURCES AND FEDERAL FUNDING: FINAL REPORT 10* (Dep’t of Educ.) (2000).

funds, which are now only accessible through NCLBA compliance. As these states argue, the NCLBA is a de facto mandate from the federal level for these schools. Unfortunately, a challenge to the Act based on this information is likely to fail, given that the federal government's position is strong in this area.

As a reauthorization of the ESEA, the NCLBA builds upon some of the same principles that governed the ESEA, namely that the receipt of Title I funds (funds directed toward high-poverty schools) is meant to be supplementary and not sufficient for an adequate education.¹⁴ Were these funds meant to be sufficient, the federal government would clearly be impinging upon the role of the states in education, and thus violating their stated position with regard to state sovereignty over education. As states and other stakeholders look into any challenge of the Act, particularly those based on insufficient funding, this distinction presents a significant obstacle.

Even further, states challenging the constitutionality of the government's withholding of funds face an even greater test. Given that the NCLBA is tied to the spending power of Congress, any challenge in this area would need to demonstrate that Congress had violated any one of four rules governing Congressional spending. In their decision in *South Dakota v. Dole*, the Supreme Court outlined these rules.¹⁵ First, spending must be geared toward increasing the general welfare of the country.¹⁶ Second, conditions for the receipt of federal funds must be unambiguous.¹⁷ Third, the conditions stipulated through Congress must be related to the purpose of the funds.¹⁸ Finally, the conditions themselves must not be unconstitutional.¹⁹ States and other potential plaintiffs will be hard-pressed to demonstrate that the conditions of the NCLBA do not meet any of these criteria. Of these four rules, the one most suitable to potentially use

14 See 20 U.S.C. § 1114 (2008).

15 See *S.D. v. Dole*, 483 U.S. 203, 207-208 (1987).

16 See *id.*

17 See *id.*

18 See *id.*

19 See *id.*

against NCLBA is the first rule regarding general welfare. Unfortunately, however, the Supreme Court further qualified this rule by holding that a determination of whether Congressional spending is for the general welfare of the country or not should depend heavily on Congressional judgment.

B. Lack of Standing

To date, there have not been any constitutional challenges to the Act, though some have challenged the Act through different means. They, too, have met with significant obstacles. The most important among these obstacles is that of demonstrable legal standing. In *Ctr. for L. and Educ. v. Dep't of Educ.*, the plaintiffs argued that the rule-making committee created by the NCLBA did not meet the Act's stated goal of achieving an "equitable balance between representatives of parents and students and representatives of educators and education officials."²⁰ Further, the plaintiffs argued that because the committee did not have adequate representation for parents and students, the committee would be hindered in creating policy beneficial to all parties. The judge's ruling in this case is indicative of the problems plaintiffs face in establishing standing and injury.

For the two advocacy group plaintiffs, Center for Law and Education and Designs for Change, the court held that, as these groups sued on their own behalf, they did not meet the "irreducible constitutional minimum"²¹ for establishing standing. Specifically, they could not demonstrate their particularized interests had been injured through the composition of the rulemaking committee. As for the sole individual plaintiff, Rachel Lindsey, a parent whose children attend a school receiving funds under NCLBA, the court held that she lacked standing to make a valid legal claim.²² The court wrote that the Act did not give her, as an individual, any enforceable right to make sure the committee had been constituted in any particular

20 *Ctr. for L. & Educ v. Dep't of Educ.*, 315 F.Supp.2d 15, 17 (U.S. Dist. 2004).

21 *Id.* at 22.

22 *See id.* at 29.

way, thus removing from consideration that she had, in fact, been injured.²³

This case brings to light two problems facing future plaintiffs. First, because of the complexity of the NCLBA, establishing standing and demonstrating injury is problematic. Given that many of the sanctions against schools have not yet begun, demonstration of injury is unlikely to be as forceful in the short-term. Many short-term challenges to the Act will be based on tenuous arguments like the one here in *Ctr. for L. and Educ.* Some have tried to bring suit based on future sanctions,²⁴ but the courts have held that these suits also lack standing because the injuries are not ripe but are rather merely speculative. Second, because the cost of bringing suit is often prohibitive, many parents will need to enlist the help of groups with means beyond their own. Doing so further complicates the matter by moving the issue of standing further away from where the actual injury occurs and may reduce the forcefulness of their claims.

Of course, the success of challenges by advocacy groups depends, in part, on their choice of whether to sue on their own behalf or on the behalf of their members. In order to sue for their members, groups would The advocacy groups in *Ctr. for L. and Educ.* may have met with a different result had they instead sued on behalf of their members where the requirements for standing were perhaps more suited to the case.

C. Ripeness

Another of the few cases directly challenging the NCLBA elicits a similar legal obstacle. In *Conn. v. Spellings*, the state argued that as federal funds are insufficient for the state to implement all provisions required by the Act, that the state should be relieved of required compliance with those unfunded provisions.²⁵ Specifically, the state argued that the cost of administering standardized tests to all stu-

23 See *id.* at 28.

24 See No. 03-2232-KHV, 2003 U.S. Dist. LEXIS 18012, at 8 (D. Kan. 2003).

25 See *Conn. v. Spellings* 453 F.Supp.2d 459, 474 (U.S. Dist. 2006).

dents, including non-native English speakers and special education students, would cost more than the federal funding they received would allow.²⁶ According to the state, this inability to pay for the requirements of the Act violated the Unfunded Mandates Provision of the NCLBA.²⁷ This provision states that “nothing in this act shall be construed to . . . mandate a State or any subdivision thereof to spend any funds or incur any costs not paid for under this Act.”²⁸

Though certainly the state’s claim in this case is more forceful than that in *Ctr. for L. and Educ.*, the court similarly ruled against the state. In its ruling, the court held that since the required provisions had not yet been fully enforced, it lacked jurisdiction to rule on the state’s complaints because the state’s injury was not sufficiently ripe.²⁹ The court further clarified its ruling by writing that although the state had met the required thresholds for standing and injury, the final, unequivocal step by the Secretary to withhold funds would give the court cause to review the matter at hand,³⁰ in keeping with the prudential ripeness doctrine.³¹

The failure of both *Ctr. for L. and Educ.* and *Conn.* to move beyond preliminary proceedings may be disconcerting in light of the Act’s many problems, but they do provide a good roadmap for future legal challenges. *Ctr. for L. and Educ.* elucidates the difficulty and necessity of demonstrating standing in NCLBA-related cases, while the findings in *Conn.* point to the extent in which a ripe injury will be vital to challenging the NCLBA despite the struggle to do so in the short-term. *Conn.* also touched on a potentially weak area in the defense of the NCLBA—its Unfunded Mandates Provision.³² Mentioned previously, the federal government has a particularly strong case given that the NCLBA is, according to them, an entirely op-

26 *See id.* at 476.

27 *See id.*

28 *Id.* at 474.

29 *See id.* at 485.

30 *See id.*

31 *See id.* at 489-490.

32 20 U.S.C. § 7907 (2002).

tional program meant to supplement state and local education spending. Despite this, future plaintiffs may find success here if they can illustrate how they are or will be harmed by this “optional” program. A plaintiff from a high poverty area who can demonstrate particular harm due to the loss of federal funds when there were insufficient funds at the outset may be especially successful.

V. CONCLUSION

So where is change in the Act likely to come from? Clearly the Act is detrimental to learning in the classroom, and unfortunately, little progress has been made through the courts. The last option for remedying the problems with the NCLBA in the short-term is to go back to where the Act began: Congress. Fortunately, Congress seems to be amenable to making changes despite their earlier reluctance. In response to much of the pressure placed on the Act through the courts and in schools and communities, Congress began preparations for a reauthorization of the Act. Though the Act will continue to be in effect through 2014 regardless of the vote, reauthorization presents a promising opportunity for change. Already the government has made changes, most recently by expanding a pilot program for states wanting to use growth models to determine their AYP,³³ a big step forward in creating a fair system for schools. In fact, two of the Act’s original creators have already begun work on introducing a few more needed alterations.³⁴

Certainly, the future provides more options outside of pressuring lawmakers for change. Parents and school districts will be able to make forceful, ripe claims in courts as soon as sanctions begin being placed on them. The challenges most likely to succeed in precipitating change are those which incorporate various elements of failure in the Act, chief among them are the lack of sufficient funding for

33 See Press Release, U.S. Dept. of Educ., Secretary Spellings Invites Eligible States to Submit Innovative Models for Expanded Growth Model Pilot (Dec. 7, 2007) (on file with author).

34 See Alyson Klein & David J. Hoff, *NCLB-Renewal Ideas Circulate on Capitol Hill*, EDUC. WK., Jul. 18, 2007, at 25.

NCLBA programs and a pronounced detrimental effect in low-income and minority schools. The latter will be particularly forceful because this group is the target of the Act. Successful challenges will also likely stay away from questioning the constitutionality of the NCLBA. However, until the Act's sanctions become imminent for specific schools, the best course of action for addressing change in the NCLBA is continued pressure on lawmakers at all levels of government.

ICANN UNIFORM DISPUTE RESOLUTION POLICY—A MODEL OF INTERNATIONAL INTELLECTUAL PROPERTY LAW ENFORCEMENT

by Clayton Nylander¹

I. INTRODUCTION

During the nineteenth century, the social and economic development of major countries within Europe and North America compelled these nations to utilize laws and courts to protect the intangible rights of their creative geniuses. Property rights for the works of inventors, authors, composers, and publishers became increasingly important to provide a marketable incentive for these people to continue their creative works. The value of exclusive ownership was realized as intellectual property rights began to blossom. Although some countries still do not recognize the value of intellectual property protection, others have flourished because of the economic incentives provided by exclusive property rights.

Intellectual property (IP) describes the legal property rights of intangible information and ideas in their expressed form.² The purpose of intellectual property is to provide exclusive ownership in the commercialization of a product or idea. The great economic incentive for the owner to obtain and create intellectual property is the right to exclude the use or reproduction of a product or service.

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2 Karla C. Shippey, *INTERNATIONAL INTELLECTUAL PROPERTY RIGHTS 1* (World Trade Press) (2002).

The potential profitability in obtaining intellectual property rights has led to a growing demand for these rights in an international context. Useful intellectual property is often imported into a country for that country's benefit. Additionally, the available profitability of marketing intellectual property internationally produces an incentive for many countries to generate competitive ideas and products. The lure of international markets has been the catalyst for the creation of large amounts of intellectual property in recent years. Thus, the global diffusion of international intellectual property has increased dramatically.

The rise of international intellectual property mandates effective methods of regulation and enforcement. As this enforcement is paramount in maintaining the economic incentive of intellectual property, it has emerged as a controversial issue with global proportions. The Uniform Dispute Resolution Policy (UDRP) was created to resolve the international conflict involving the distribution and possession of Internet domain names. This paper first seeks to discuss the current problems originating from international intellectual property regulation, and then discuss how many of these same problems arise in the regulation of Internet domain names. The discussion will then describe how these problems with Internet domain names prompted the creation of the UDRP as well as describe some of the leading opposition for the UDRP. Finally, this paper will discuss the components of the policy that make it effective, and end with suggestions and recommendations on how to overcome some of the problems inherent in its application and structure. The purpose of this paper is to contend that the Uniform Dispute Resolution Policy, as a means of regulating the use of Internet domain names, displays many components of effective application, structure, and regulation to effectively resolve Internet domain names and, with the proper modification, can serve as a model regulatory policy to overcome many of the pitfalls that currently plague international IP law.

II. CURRENT PROBLEMS WITH INTERNATIONAL INTELLECTUAL PROPERTY LAW

The international community faces several problems that prevent effective enforcement of international intellectual property laws. In the current international context, IP rights established in one country “vanish abruptly and completely at the national border.”³ The vast difference of international IP laws across the globe is a primary contributor to the lack of harmonized international IP enforcement. Most countries make no concessions to recognize the IP laws of any country but their own. As clarified by G. Gregory Letterman, the IP rights provided to an IP possessor seeking legal protection internationally are predicated upon the allowances specifically provided by each jurisdiction where IP protection is sought.⁴

IP laws often vary by country because the existence and enforcement of such laws present varying degrees of benefits to different countries. This disparity becomes vividly apparent in the context of developing countries and their deliberate avoidance of IP regulation. The struggle between those who seek enforcement of IP laws and those who do not has developed a chasm between the developed and underdeveloped countries of the world. Countries such as China, India, and South Korea have deliberately avoided IP law regulation because of the economic benefits that they derive from this illicit activity.⁵ The developed countries are crying for stiffer regulation as the under-developed countries continue to enjoy the benefits of infringement. A worldwide conflict of interests has developed.⁶ The current structure and regulation of IP laws, however, does little to resolve this issue.

3 G. Gregory Letterman, *Basics of International Intellectual Property Law* 12 (Transnational Publishers, Inc. 2001) (2001).

4 *Id.* at 16.

5 Mary Kopczynski, *Robin Hood Versus the Bullies: Software Piracies and Developing Counties*, 33 *Rutgers Computer & Tech. L.J.* 299, 307 (2007) (discussing the benefits of avoiding IP regulation to under-developed countries).

6 *Id.* at 301.

Experts cite multiple reasons to explain why developing countries choose not to enforce intellectual property rights. A lack of resources is one particular obstacle for IP enforcement. Resources such as time and money are required for the litigation of IP infringement, yet such resources are often lacking in developing countries. A proposed violation of an IP right in one country could cause years of investigation as well as astronomical amounts of litigation fees. Many governments deem such use of time and money as a poor allocation of resources. As a result, in some countries, IP infringement flourishes. India, for example, has left major IP infringement issues, such as software piracy, unrestrained because effective enforcement exists as “a mandate disproportionate to its resources.”⁷

Additionally, the lack of cost-benefit trade-offs further reduces incentive for developing countries to enforce intellectual property laws. Because intellectual property in a developed country often comes from a more developed nation, the regulation for that IP is often instigated by the developed country. Thus, the majority of IP enforcement taking place in a country such as India exists to directly benefit the foreign owners of the intellectual property. The protection of domestic industries is yet another reason why developing countries fail to enforce IP laws. Jobs created by engaging in IP infringing activities typically employ more and create a larger economic return for the country than the more specialized jobs associated with IP enforcement. Countries would not want to divert precious resources away from an illicit activity, such as piracy, to the less profitable activity of intellectual property enforcement. Some developing countries even cite the “Robin Hood” mentality, that of stealing from the rich to help the poor, in order to rationalize their own lack of intellectual property enforcement.⁸ In short, different countries continue to produce differing IP laws that lack the congruence necessary for widespread use, and the resulting problems have only escalated in recent years.

The problems described above affect all areas of intellectual property, including Internet domain names. Although the enforce-

7 *Id.* at 315.

8 *Id.* at 301.

ment of Internet domain names described below is not divided precisely between developed and under-developed countries, the issue of Internet domain name enforcement contains many of the same regulatory difficulties described above. Many domain name users seek to free-ride and enjoy the benefits of established trademarks. No central regulatory agency has existed in the past to ensure the proper regulation of Internet domain names. The remainder of this paper will examine the problems concerning Internet domain names and how the UDRP, within the scope of proper application, has effectively solved many of the regulatory issues plaguing international intellectual property law.

III. CURRENT PROBLEMS WITH INTERNET DOMAIN NAMES

A. Cybersquatting

The growing issue of Internet domain name disputes manifests many of the problems faced by international intellectual property. Domain names are a type of trademark that were originally created to allow Internet users to locate computers and people in a convenient manner. In recent years, however, the use of domain names has increased in significance as they are used to identify commercial businesses, many of which already possess identifying trademarks protected by existing intellectual property rights. The presence of domain name disputes often arises from cases of cybersquatting, the strategy of an individual or company registering certain trademarks as private domain names. As described by the World Intellectual Property Organization (WIPO), cybersquatters exploit the easiness of domain name registration by reserving domain names of unrelated businesses or celebrities for personal gain. As owners of such domain name registration, cybersquatters often attempt to sell their domain name rights to their corresponding businesses at prices high above typical registration. As an alternative, cybersquatters may maintain their domain name rights to use the company's trademark to at-

tract business of their own.⁹ Original trademark holders often take legal action to have the disputed domain name transferred from the respondent or registrant (the party seeking to control the contended domain name) to the complainant (the original trademark holder).

B. Trademark Law and Internet Domain Names

Until the mid-nineties, trademark law did little to combat the problems derived from cybersquatting. Trademark laws are typically created by national jurisdictions and are typically organized around regional and geographical borders. The Internet, however, is “defiantly ignorant” of these borders.¹⁰ According to the Lanham Act, which contains the United States’ statutes on trademark law, trademark infringement requires “commercial use in commerce” of the trademark by the accused infringer.¹¹ Courts have varied in their interpretation of what constitutes “commercial use.” Courts often rule that a cybersquatter using another entity’s trademark as their own domain name is illegal due to trademark infringement or dilution. (Dilution refers to the reduction of the value of a trademark when an outside party abuses the trademark.) The landmark case of *Panavision International v. Toeppen*¹² found that selling a registered domain name to the original trademark owner of the name for a profit is considered commercial use under the Federal Trademark

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- 9 World Intellectual Property Organization, <http://www.wipo.int/amc/en/center/faq/domains.html#5> (last visited Nov. 23, 2006).
- 10 A. Michael Froomkin, ICANN’s Uniform Dispute Resolution Policy—Causes and (Partial) Cures, 67 *Brooklyn Law Review*, 608, 608 (2002) (discussing the regulation of Internet trademark law).
- 11 Mark A. Lemley, The Modern Lanham Act and the Death of Common Sense, 108 *Yale L.J.* 1687, 1702 (1999) (discussing the meaning of “commercial use in commerce”).
- 12 *Panavision International, LP, v. Toeppen* 141 F.3d 1316, 1316–1327 (9th Cir. 1998). See also Michael A. Froomkin, Wrong Turn in Cyberspace: Using ICANN to Route Around the APA and The Constitution, 50, *Duke L.J.* 17, 60-61 (2000).

Dilution Act.¹³ Courts found that Princeton Review's registering the domain name kaplan.com, its primary competitor, was primarily for commercial profit, and thus illegal.¹⁴ Other cases' decisions have not been as unambiguous. Some courts have ruled that "reserving" a domain name by merely registering it does not constitute trademark infringement, given the registrant makes no use of the name.¹⁵ The growth of cybersquatting on the Internet during the middle to late nineties revealed that existing trademark laws could not be easily applied to this new breed of trademark infringement cases.

C. The Need to Combat Cybersquatting

Domain name conflicts between the registrant and the original trademark holder have been raging for over a decade. The first case to highlight the issue occurred in 1994 when Joshua Quittner seized the domain name mcdonalds.com and then publicized the issue in an article in Wired Magazine.¹⁶ Quittner's move quickly exposed the potential rewards available to registrants who can procure an extremely valuable domain name at minimal cost and inconvenience. Domain names are available on a first-come, first-serve basis.¹⁷ In order to use a domain name, an organization may obtain the right to a certain domain name for a certain period. An entity simply must contact any one of a number of registrars, who then officially register the domain name for the registrant. The entity may renew its use of the domain name after the designated period of time comes to an end.¹⁸ This convenient and inexpensive application process, coupled

13 Federal Trademark Dilution Act, 15 U.S.C. § 1125 (2000).

14 Lemley, *supra* note 11.

15 See Juno Online Service v. Juno Lighting, Inc. 979 FSupp 684 (1997).

16 See <http://www.wirednews.com/wired/archive/2.10/mcdonalds.html>.

17 Milton Mueller, Rough Justice: An Analysis of ICANN's Uniform Dispute Resolution Policy 3-4 (Syracuse University School of Information Studies 2000) (2000).

18 Jeff Lenning, Protect Your Domain Name, 48 Orange County Lawyer 18, 18. (Sept. 2006) (discussing process of registering internet domain names).

with the lure of the resale of attractive domain names at six-figure values, led to a surge in registered domain names during the middle and late nineties.¹⁹

Abuses began to develop. Companies began to register the domain names of their competitors in order to re-direct Internet traffic to their own business. So-called “oops” domain names propagated where slight variations of popular company, service, and celebrity names (up to twenty or thirty of them) were registered in order to draw the attention of unsuspecting Internet users who misspelled their targeted site.²⁰ As the popularity and widespread use of the Internet increased, so did the resulting incidences of cybersquatting. WIPO claims that the stimulation of business, the difficulty in discovering the true user of a trademark, and the principle of freedom of expression all contribute to the recent increase in improper domain name registration. Additionally, the growing value of Internet business has increased the profitability of owning business trademarks online.²¹

A negative by-product of cybersquatting developed as original trademark owners began to use “their legal and financial muscle to evict legitimate domain name holders from valuable registrations” that the registrant not only wanted but had a justifiable right in owning.²² This phenomenon, dubbed reverse domain name hijacking, illustrates how the complainants, the alleged trademark owner, often receive undue power, while little protection is given to the domain name registrar. Often the “legally untutored or resource poor” registrants are forced to surrender domain names to the frivolous claims of the trademark holders.²³ A computer consulting company, whose owner’s surname was Prince, legally registered prince.com, but the sports equipment manufacturer later sued Mr. Prince for rights to the

19 Mueller, *supra* note 17, at 3.

20 *Id.*

21 World Intellectual Property Organization, <http://www.wipo.int/amc/en/center/faq/domains.html#5> (last visited Nov. 29, 2006).

22 Mueller, *supra* note 17.

23 Froomkin, *supra* note 10, at 692–693.

domain name. The registrant ended up spending over three hundred thousand dollars in order to protect the domain name.²⁴

The resulting situation involving disputes over Internet domain names is complex, with no clear victim or culprit.²⁵ Trademark disputes across the Internet are not similar to standard trademark infringement against which current intellectual property laws fight. The development of Internet domain name disputes required a form of regulation that existing trademark law did not satisfy. The need for a new means of regulation was larger than ever before.

IV. THE CREATION OF THE UNIFORM DISPUTE RESOLUTION POLICY

WIPO is one of multiple specialized agencies created by the UN with the intention of promoting “the protection of intellectual property throughout the world through cooperation among States and, where appropriate, in collaboration with any other international organization.”²⁶ In 1998, the U.S. Department of Commerce issued the Statement of Policy on Management of Internet Names in which it called upon WIPO to initiate a balanced and transparent process, which includes the participation of trademark holders and members of the Internet community who are not trademark holders, to

(1) develop recommendations for a uniform approach to resolving trademark/domain name disputes involving cyberpiracy (as opposed to conflicts between trademark holders with legitimate competing rights), (2) recommend a process for protecting famous trademarks in the generic top level domains, and (3) evaluate the effects, based on studies conducted by independent organizations . . . of adding new gTLDs [generic top level domains] and related dis-

24 Mueller, *supra* note 17, at 4.

25 *Id.* at 14.

26 A. Michael Froomkin, Semi-Private International Rulemaking: Lessons Learned from the WIPO Domain Name Process, see <http://personal.law.miami.edu/~froomkin/articles/TPRC99.pdf> (last visited Dec 12, 2007).

pute resolution procedures on trademark and intellectual property holders.²⁷

WIPO began investigating the growing issue of domain names and trademark usage on the Internet.²⁸ Following their investigation, WIPO recommended instituting a policy that would affect all Internet domain name registrars, controlling dispute resolution of Internet domain space. WIPO gave the Internet Corporation for Assigned Names and Numbers (ICANN), created by the U.S. Government to provide technical management of the Internet's infrastructure, the responsibility to create a policy that would satisfy the criteria and recommendations set forth by WIPO. They sought to create a regulatory regime for domain name protection to optimize trademark protection. Subsequent subcommittees were formed which thereafter submitted a proposed policy to the ICANN board as a consensus recommendation. In October 1999, the ICANN board approved the implementation of the Uniform Dispute Resolution Policy (UDRP).²⁹ ICANN's Uniform Dispute Resolution Policy requires every registrant on the Internet to agree to arbitration provided by ICANN's arbitration providers that should there be any possible trademark dispute between an existing trademark holder and the registrant.³⁰

The overall purpose of the UDRP is to resolve conflicts resulting from the misuse of trademarks within Internet domain spaces. Under the UDRP, a complainant may file a case that specifies the disputed domain name, the holder of domain name rights, the registrar of the domain name, and the grounds for the complaint. ICANN specified the following three criteria that must be met in order to challenge a domain name:

27 *Id.*

28 ICANN, <http://www.icann.org/udrp/udrp-schedule.htm> (last visited Nov. 20, 2006).

29 ICANN, <http://www.icann.org/udrp/udrp-schedule.htm> (last visited Nov. 20, 2006).

30 Michael A. Froomkin, *Wrong Turn in Cyberspace: Using ICANN To Route Around the APA and the Constitution*, 50, *Duke LJ*, 17, 25 (2000).

The domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

The registrant has no rights or legitimate interests in respect of the domain name; and

The domain name has been registered and is being used in bad faith.³¹

All three of the above conditions must be met before the case is ruled in favor of the complainant.³² After a decision is made, the domain name is either transferred, canceled, or the complaint is denied.³³ ICANN further defined the term “bad faith”, establishing the criteria for the complainant to indicate bad faith as well as the criteria needed for respondent to establish that no bad faith was used in the registration of the name. Despite the stipulated criteria, enough latitude exists in the language of the UDRP to allow drastically different interpretations of the cases, depending on the dispute resolution provider.³⁴

In cases involving the UDRP, ICANN utilizes four organizations to act as arbitrators to resolve disputes. These major dispute resolution service providers are: the World Intellectual Property Organization (WIPO), based in Switzerland; the National Arbitration Forum (NAF), from the U.S.; eResolution, from Canada; and the CPR Institute for Dispute Resolution (CPRADR), also based in the U.S.³⁵ These arbitration panels utilize diversified arbitrators from across the globe. Diversified panels reduce the probability of national bias, as well as to improve the international scope of the UDRP’s enforcement.

31 Mueller, *supra* note 17, at 21.

32 *Id.*

33 World Intellectual Property Organization, <http://www.wipo.int/amc/en/center/faq/domains.html#2> (last visited Nov. 20, 2006).

34 Mueller, *supra* note 17, at 21.

35 *Id.* at 10.

V. OPPOSITION TO THE UDRP

Despite the apparent benefits of the UDRP, opponents to the policy claim several reasons to explain its ineffectiveness. ICANN currently allows the complainant to choose the dispute resolution service provider. Evidence shows that the selection of a service provider by the complainant can often lead to “forum shopping” which can bias the decision. Statistically, WIPO and NAF have a record of ruling in favor of the trademark holders. Not surprisingly, WIPO and NAF attract the largest number of cases (61 percent and 31 percent respectively) by complainants. eResolution, which typically rules in favor of the defendant, typically attracts only 7 percent of cases.³⁶ The bias from selecting a favorable service provider is compounded, opponents argue, by the policy’s current inability to challenge an arbitrator if believed to be biased or to have a conflict of interest. Currently, arbitrators are expected to reveal any possible conflicts of interest. If the arbitrator is truly biased, however, efforts will be made to skew the degree of conflict. Therefore, regulation must exist to effectively determine the existence of an intolerable conflict of interests. For example, if the arbitrator is a member of a firm, and that firm maintains a position on a disputed arbitration law, speculation would surface if the arbitrator is allowed to decide a case involving a similar law.³⁷ Because the current policy lacks such stipulations, UDRP opponents have demanded an effective means to eliminate the possibility of biased arbitrators.

Another argument made by UDRP opponents involves the arbitrators’ negligence to legitimate ownership of domains. Kieren McCarthy explains that in order for a complainant to reclaim a domain name from the registrant, the complainant must show the arbitrators that the registrant “has no rights or legitimate interests” in the name. UDRP opponents claim that large amounts of arbitrators have a history in trademark law.³⁸ Arbitrators’ background in trademark law

36 *Id.* at 2.

37 Froomkin, *supra* note 10, at 638.

38 See Kieren McCarthy, *The Registrar*, (Oct. 4, 2001), http://www.theregister.co.uk/2001/10/04/what_the_hell_is_udrp/.

often translates into a bias toward major trademark owners. This bias, challengers claim, often causes even legitimate domain names to be judged unfairly. Such arbitrator bias has been manifested in the numerous sucks.com cases, having the form [company]sucks.com. Many claim this to be a fair use of a domain name. However, WIPO determined that such sites violated the UDRP because of their damaging effects to the company and its trademark.³⁹

VI. EFFECTIVENESS OF THE UDRP

A. Application

Notwithstanding the minor flaws inherent in the application of this policy, the UDRP has unfolded to be an effective example of international intellectual property regulation. One of the applications of the UDRP that contributes to its success is its use of arbitration panels. Typically used as the cost-effective alternative to litigation, arbitration is particularly useful in settling disputes that involve the private rights of two parties. According to WIPO, arbitration can be useful in dealing with highly technical areas and an arbitrator with a technical background is often used. Additionally, arbitration is often more time efficient than court litigation. IP cases brought before the arbitration of WIPO are normally resolved within two months.⁴⁰ The average time it takes to settle a case when brought before one of the four dispute resolution providers is forty-three days.⁴¹ Traditional litigation, however, would mandate years for the same resolution. The cost of arbitration is also consistently lower than the typical costs of courtroom cases. The fees involved with using such an arbitration panel equate to a fraction of those involved with litigation. WIPO describes that cases involving multiple patent names often only require

39 McCarthy, *supra* note 38.

40 World Intellectual Property Organization, <http://www.wipo.int/amc/en/center/faq/domains.html#2> (last visited Dec. 3, 2006).

41 Mueller, *supra* note 17, at 17.

a few thousand dollars of fees.⁴² The U.S. Department of Commerce commended the UDRP as being “an efficient, inexpensive procedure for the resolution of disputes.”⁴³ Such time and cost efficiency in filing domain name disputes has helped battle the high volume of domain name dispute cases in recent years.

Yet another unique advantage presented by the UDRP is the focused nature of its application. Often the international application of IP laws is unfeasible, because of the inability of a single policy to apply appropriately to the multitude of situations in each tried case. A regulatory body cannot create a policy that accommodates all possible circumstances. The UDRP, however, narrows the scope of its application in order to provide feasible application. As explained by ICANN laws, the UDRP can only be applied to .com, .net, and .org top-level domain names.⁴⁴ Kieren McCarthy of The Register explains that only the misuse of registered trademarks recognized by WIPO can merit an investigation. The policy only applies to trademark holders contending with non-trademark holders. The UDRP purposefully avoids cases involving the use of personal names, the names of places, and the names of drugs and governmental organizations.⁴⁵ Narrowing the scope of the UDRP’s application prevents vain investigation of unregistered trademarks. The focused function of the UDRP allows it to hurdle over the application problems that burden most existing international IP law.

B. Structure

In addition to its application, certain structural components of the UDRP add to its effectiveness. The diversified and objective arbitrators used by ICANN are a structural advantage of the UDRP. Currently, an expert panelist or group of panelists is chosen to re-

42 World Intellectual Property Organization, <http://www.wipo.int/amc/en/center/faq/domains.html#2> (last visited Dec. 2, 2006).

43 Froomkin, *supra* note 10, at 609.

44 ICANN, <http://www.icann.org/udrp/udrp-second-staff-report-24cot99.htm>, (last visited Dec. 3, 2006).

45 McCarthy, *supra* note 38.

view the debated domain name. As outlined by WIPO policy, the specific circumstances of each case, such as the nationality and languages of the parties dictate the selection of these panels. Although opponents argue the inherent bias of many arbitrators, these panelists are chosen from a roster of qualified independent individuals. Furthermore, arbitrator bias is avoided by having a large selection of arbitrators from whom/which to choose. The panelists must also disclose to WIPO adequate information to show the absence of a conflict of interest in the case and all other facts that would affect their appointment to the case.⁴⁶ Through the selection and use of neutral panelists, ICANN thus minimizes the problem of biased arbitrators. Limiting this problem is yet another building block that has allowed the UDRP to rise above the difficulty of international intellectual property law.

Another structural advantage of the UDRP is the ease by which arbitration can occur. The rules established by ICANN stipulate that for cases involving cybersquatting, the consent of both parties is not mandated for an investigation to take place. So long as the arguing party provides the necessary evidence and documentation, arbitration can begin to investigate the possibility of domain name misuse. On the other hand, if a domain name is transferred or canceled, the owner of the domain name is given a period of time to demand further investigation of the case.⁴⁷ In order to aid registrars who are legally uninformed, the arbitrators are required to clearly stipulate in a letter the domain holder's rights and options for re-investigation.⁴⁸ Thus, the delineated rights of the parties involved in the dispute provide an uncomplicated arbitration method to allow justice to be served. The simplicity of the arbitration process is yet another factor that contributes to the efficient implementation of the UDRP.

46 World Intellectual Property Organization, <http://www.wipo.int/amc/en/center/faq/domains.html#2> (last visited Dec. 2, 2006).

47 ICANN, <http://www.icann.org/udrp/udrp-second-staff-report-24oct99.htm> (last visited Nov. 20, 2006).

48 Telephone interview with Jim Belshe, Attorney, Workman Nydegger Law Firm, in Salt Lake City, UT (Dec. 5, 2006).

Additionally, although opponents argue that reverse domain name hijacking and excessive complaints against existing domain name holders are harmful, the structure of the UDRP mandates that there is no default judgment during decision-making. Belshe explains that in typical court litigation, default judgment refers to judgment that benefits the plaintiff when the defendant has not acted according to court orders. This type of judgment does not exist with the UDRP. In other words, inaction by the domain name holder does not guarantee success for the complainant.⁴⁹ For example, a complainant may file a case to retrieve a certain domain name. Under UDRP rules, the complainant does not need the consent of the domain name holder to file the case. Typical law states that inaction by the defendant, regardless of whether the defendant was informed, could result in a ruling in favor of the plaintiff. The UDRP, however, in order to prevent any unfair action taken against an unsuspecting domain name holder, allows the arbitration panel to cause a complainant to lose the case if the panel deems his/her evidence insufficient. This lack of default judgment allows the UDRP to better protect legally uninformed domain name owners. The unique structure and content of the UDRP eliminate many of the obstacles that encumber internet domain name rights.

C. Regulation

The regulation and enforcement of the UDRP is yet another ingenious component that has contributed to the success of this policy. ICANN specifies that, according to the UDRP, all registrars of domain spaces must register under the contract mandated by ICANN. A domain space cannot be granted unless the registrar agrees to the contractual agreement implemented by ICANN and WIPO.⁵⁰ This contractual agreement thus regulates the distribution of Internet domain names. Any registrar of a .com, .net, and .org domain name is required to adopt the UDRP as the procedure of their domain

49 Belshe, *supra* note 48.

50 ICANN, <http://www.icann.org/dndr/udrp/policy.htm> (last visited Nov. 23, 2006).

name dispute resolution procedure if they are to be recognized by ICANN.⁵¹ All involved parties, regardless of location, are thus required to abide by the laws established by ICANN and WIPO. Any breaching of the contract will cause the involved parties to be subject to the consequences set forth in the contract.

Most IP laws fall short of providing international protection because of the difficulty in harmonizing the IP laws of individual countries. The effectiveness of the UDRP, however, is not restricted to a single country. Many governments across the globe are lauding the success of the UDRP, claiming to support its principles. Over twenty countries require it in the registration of their domestic country-code top-level domains. Additionally, the Free Trade Area of the Americas (FTAA) has recently selected UDRP as the dispute resolution provider of all of its signature states.⁵² The ability of WIPO to regulate and enforce domain name registrars across the globe overcomes the obstacle of national borders and provides the UDRP an international scope unprecedented by previous international IP laws.

VII. CONCLUSION AND RECOMMENDATIONS

The Uniform Dispute Resolution Policy has helped to regulate the large increase in Internet domain name disputes in recent years. The success of UDRP does not imply that it is free of imperfections. Many problems have arisen from the current rule that allows the complainant to choose the dispute resolution provider. As discussed previously, forum shopping often occurs, and can create a bias in the decision making process. Complainants will obviously choose the provider that statistically rules in favor of new domain name holders. There are several potential remedies to this bias. Some feel that the respondent should be required to pre-select a dispute resolution provider at the time of registering the domain name. Feeling that this solution only shifts the bias in the opposite direction, others have proposed that both parties agree to a single provider, where a third party or even a lottery could decide on a provider if the complain-

51 Mueller, *supra* note 17, at 5.

52 Froomkin, *supra* note 10, at 609–610.

ant and registrant cannot reach an agreement. Although such an arrangement is still not free from problems, both parties' involvement in the selection process greatly reduces the provider's tendency to be biased.⁵³

Another component of the UDRP that stands in need of reform is its ability to withstand reverse domain name hijacking (RDNH). Critics claim that the policy is "one-sided" and that action should be taken to protect registrants from being "victims of frivolous complaints."⁵⁴ A. Michael Froomkin, an advocate of UDRP reform, has advocated the institution of a "surety bond," of approximately five thousand dollars, to be awarded to the registrant from the complainant if the arbitration panel finds reverse domain name hijacking.⁵⁵ This bond could prevent complainants from anxiously seeking to force a feeble registrant into surrendering his/her domain name.

The UDRP is a sound policy to better reform Internet domain name disputes as a type of international intellectual property infringement. The above-mentioned reforms to the policy will improve the effectiveness of the policy. Given these minor changes, the UDRP embodies the necessary application, structure, and regulation to remove the web of difficulties that currently hinder international intellectual property law. The UDRP's ability to utilize arbitration panels as a time and cost efficient means of law enforcement has been pivotal to its success. The international success of the UDRP is also possible due to the focused scope of its application. The use of unbiased arbitrators and the ease of the arbitration process also add to the policy's effectiveness. ICANN's international application of the UDRP to all Internet domain name registrars overcomes the obstacle of differing international IP laws. The unmatched effectiveness of the UDRP has established a model and precedent that future international intellectual property law can follow.

53 Froomkin, *supra* note 10, at 691.

54 *Id.* at 693.

55 *Id.* at 693–694.

THE FUTURE OF THE EUROPEAN UNION

by Tyson Smith¹

I. INTRODUCTION

As President Hans Pottering said in his inaugural speech as President of the European Parliament, “Europe is a complex continent. This faces all of us with huge challenges. The European Union (EU) can no longer operate using the inadequate instruments of current treaty law.”² Arguably, efficiency, as in many large organizations, needs to be addressed; complex treaty amendments could be simplified and various EU institutions could be reworked. Yet as the EU contemplates its future as a supranational organization, care must be taken to ensure that it does not overstep its bounds as it engages in this process. Founded in the wake of World War II, the original EU was established to bring peace to a war-torn continent and to promote the shared goal of prosperity.³ As the EU facilitates these foundational principles of peace and prosperity, it must be careful not to stifle two other integral underpinnings of the European Union, namely democracy and subsidiarity. Yet as it has grown in size and scope, the EU has become an increasingly cen-

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 - 2 Hans-Gert Pottering, Inaugural Address by the President of the European Parliament (Feb 13, 2007), *available at* <http://www.europarl.europa.eu/sides/getDoc.do?pubRef=-//EP//TEXT+CRE+20070213+ITEMS+DOC+XML+V0//EN#creitem3>.
 - 3 *See* Dinan, Desmond, *Europe Recast: A History of the European Union* 1–9, 13–45 (2004).

tralized government with extensive legislative powers. The Treaty of Lisbon, evolved from the proposed Constitution for Europe and signed by EU leaders on December 13, 2007, will take the EU in a direction even further removed from its original role as a facilitator of peace and prosperity. Institutional changes included in the Treaty of Lisbon and in the Charter of Fundamental Rights show how subsidiarity is reduced and that the EU is overstepping its bounds.

The future of the EU should be shaped by the role it was created to play within Europe. It should continue to facilitate peace and prosperity while protecting democracy and subsidiarity. Yet, while the European Union was established to accomplish these ends, the Treaty of Lisbon moves the EU further from these founding principles by creating a more powerful, more centralized government. The initiators of this Treaty believe it will enhance democracy, but the Treaty of Lisbon will further erode the democratic system of the EU by reducing the sovereignty and authority of each nation through the institutional reforms and the Charter of Fundamental Rights which it enacts.

II. FOUNDING VALUES—WORKING TOWARDS COMMON GOALS

A. Peace and Prosperity

As a supranational organization, the European Union was founded on certain fundamental principles. As the history of the EU illustrates, peace is the foundation on which the European Union is built. After centuries of conflict, the end of World War II brought together courageous and revolutionary leaders such as Robert Schuman, Konrad Adenauer, Alcide de Gasperi and Winston Churchill, who envisioned Europe becoming a place united by peace. In 1950, French Foreign Minister Robert Schuman presented a plan for even deeper cooperation than the peace treaty that ended the war, and by 1951, six countries—Belgium, the Federal Republic of Germany, France, Italy, Luxembourg, and the Netherlands—had come together to create the European Coal and Steel Community (ECSC), determined to use common values and resources to establish peace. These

six countries all signed a treaty to run their heavy industries—coal and steel—under a common management. In this way, none of these countries could make weapons of war to turn against the other, as in the past.⁴ Thus, the first priority of this unique coalition of countries was to facilitate peace. Even today, more than fifty years after the European Economic Community (EEC) was founded, European Parliament President Hans Pottering said, speaking of the EU: “The greatest success has been overcoming the division of Europe. Our shared values have prevailed.”⁵ As a result, by allowing common values and resources to be shared, the European Union has been, and continues to be, a tremendous facilitator of peace.

History of the EU also demonstrates its role as a facilitator of prosperity. Cooperation was achieved between these original six countries as they worked together towards common goals in shared institutions, and in 1957 the Treaty of Rome was put into effect. This Treaty broadened the economic scope of the cooperation and established the EEC. The name of this treaty bespeaks the purpose of the EEC: the common goal of economic prosperity. The common institutional platform put in place allowed countries to begin working together towards greater economic prosperity. The success of the EEC prompted other European countries to join the EEC. Thus, during this first enlargement, the United Kingdom, Denmark, and Ireland joined the original six. The EU continued to enlarge and develop, and by 1986, Greece, Spain, and Portugal had joined. The economic structure continued to develop, and although it is debatable whether the current scope of the economic union is appropriate, the European Community did provide a valuable facilitating role as it furthered the founding values of peace and prosperity throughout Europe.

These principles, peace and prosperity, form the foundation of what the European Union is trying to accomplish. This being said, the EU must use caution to not overextend its powers in facilitat-

4 See Philip Malcolm Waller Thody, *An Historical Introduction to the European Union* 1–2 (1997). See also Dinan, *supra* note 3, at 45–83.

5 Hans-Gert Pottering, Inaugural Address by the President of the European Parliament (Feb 13, 2007), available at <http://www.europarl.europa.eu/sides/getDoc.do?pubRef=-//EP//TEXT+CRE+20070213+ITEMS+DOC+XML+V0//EN#creitem3>.

ing these objectives. Otherwise, it runs the risk of undermining two other founding principles: democracy and subsidiarity.

B. Democracy and Subsidiarity

The EU should accomplish its role as a facilitator of peace and prosperity without stifling well-established principles of democracy and subsidiarity. It can readily be seen that democracy is an espoused virtue of the EU. For example, while member states of the EU have obvious differences in their government institutions, each nation state in the EU must demonstrate that they function as a democracy before they can become a member of the EU.⁶ If the EU requires its members to be run by democratic governments, it must also follow the same principle.

Working hand-in-hand with the principle of democracy is what the EU refers to as subsidiarity. Subsidiarity means that “the Community [i.e. the European Union] shall take action . . . only if and in so far as the objectives of the proposed action cannot be sufficiently achieved by the Member States and can therefore, by reason of the scale or effects of the proposed action, be better achieved by the Community.”⁷ Even as the European Community transformed itself from an economic to a political entity, the Treaty on European Union of 1992, which forms the “European Union,” declares that the European Union is “RESOLVED to continue the process of creating an ever closer union among the peoples of Europe, in which decisions are taken as closely as possible to the citizen in accordance with the principle of subsidiarity.”⁸ As the EU decides what is “appropriate” for action on the European level, it must remember to take decisions

6 Presidency Conclusions, Copenhagen European Council (June 1993), available at http://ue.eu.int/ueDocs/cms_Data/docs/pressdata/en/ec/72921.pdf.

7 Treaty on European Union, July 29 1992, O. J. (C 42), available at http://europa.eu/eur-lex/en/treaties/dat/EU_treaty.html.

8 Consolidated Version of the Treaty on European Union, Dec. 24, 2002, 2002 O.J. (C 325) 9, available at http://eur-lex.europa.eu/en/treaties/dat/12002M/pdf/12002M_EN.pdf.

as close to the people as possible. Subsidiarity is thus an important concept in the EU, and it is a characteristic of any democratic nation. Rhetoric extolling the need for subsidiarity within the European Union is heard in speeches and in official literature of the Union. For example, in the document “Communication from the Commission to the European Council” issued in October 2006, we read that “[t]he EU must respect the principle of subsidiarity, acting at the European level only when appropriate.”⁹ However, the course that the Treaty of Lisbon sets for the EU will reduce subsidiarity rather than encourage it.

III. SHIFTING AWAY FROM DEMOCRACY AND SUBSIDIARITY

As the EU charts its future as a facilitator of peace and prosperity, it should be promoting these two vital, governing principles of democracy and subsidiarity. What’s more, as the EU has grown both institutionally and through enlargement, it must be particularly vigilant in promoting subsidiarity. Support for the Treaty of Lisbon claims that promotion of democracy is one of the purposes of the Treaty, which states the desire “to complete the process started by the Treaty of Amsterdam and by the Treaty of Nice with a view to enhancing the efficiency and democratic legitimacy of the Union.”¹⁰ Yet the Treaty of Lisbon will create institutional changes in the name of democracy that push the Union even further from subsidiarity and open up more doors to do so even further in the future.

A. Fundamental Changes

For example, the Treaty provides for moving from one Commissioner per country (twenty-seven) to only eighteen commissioners

9 Communication From the Commission to the European Council, A Citizens’ Agenda Delivering Results for Europe, COM(2006) 211 final (Nov. 5, 2006), available at <http://eur-lex.europa.eu/LexUriServ/LexUriServe.do?uri=COM:2006:0211:FIN:EN:HTML>.

10 Treaty of Lisbon, Dec. 17, 2007, 2007 O.J. (C 306) 3, available at <http://eur-lex.europa.eu/JOhtml.do?uri=OJ:C:2007:306:SOM:EN:HTML>.

in 2014 (i.e. two-thirds of the member states).¹¹ This will abolish the link between the Commission and country, thus reducing subsidiarity even more as these Commissioners are instructed to look after “the general interest of the Union.”¹² The new treaty also makes the European Council (the heads of state of the EU nations) an official institution,¹³ thus subjecting the heads of state to sanction by the Court of Justice of the European Union (ECJ), the highest court of the EU.¹⁴

Another important inclusion in the Treaty of Lisbon officially recalls the primacy of EU law over the law of Member States in accordance with the case law of the ECJ.¹⁵ While already somewhat in practice, this official recognition of the primacy of EU law will give more clout to EU laws when pitted against national laws. Also, a new office, “High Representative of the Union for Foreign Affairs and Security Policy,” i.e. European Foreign Affairs Minister, is created by the new treaty.¹⁶ The High Representative will be the Vice-President of the Commission and President of the Council for Foreign Affairs, and as such will represent the EU in international relations. While the Treaty says the powers of this new position “do not affect the responsibilities of Member States . . . for the formulation and conduct of their foreign policy,” creation of such an influential position will give the EU extended influence in foreign affairs and security matters and open the door to increased usurpation

11 Treaty of Lisbon, *supra* note 10, at 20.

12 *Id.* at 19.

13 *Id.* at 16.

14 *Id.* at 22.

15 Draft Declaration, Intergovernmental Conference (July 23, 2007) 54, available at <http://www.consilium.europa.eu/uedocs/cmsUpload/cg00003.en07.pdf>.

16 Treaty of Lisbon, *supra* note 10, at 17.

of competency from Member States in the areas of foreign affairs and security.¹⁷

Institutional reforms are needed, but they are needed to help the EU return to a facilitating role based on national subsidiarity instead of a creating a more central legislative body that can more readily impose its will upon its member states in an undemocratic fashion as these changes do.

B. Charter of Fundamental Rights

Another part of the Treaty of Lisbon not reflective of subsidiarity is a clause that contains a cross reference to the Charter on Fundamental Rights. The clause gives the Charter the same legal value as the Treaties and sets out the scope of its application.¹⁸ The EU has long spoken of its commitment to human rights and fundamental freedoms, and this Charter of Fundamental Rights seeks to guarantee these rights to all citizens of the EU, rights that are said to be based on common values and a resolution to share a peaceful future.¹⁹ The motives for this Charter may be pure, but whether or not the resulting legislation reflects the “inalienable rights” of human beings, to borrow a phrase from the U.S. Declaration of Independence, is not the issue. The issue is that the EU should not be imposing its will upon its members on certain applications of the Charter or be making decisions that Member States have the right to decide for themselves. As can be seen in the following two examples, the Charter of Fundamental Rights is one part of the Treaty of Lisbon that reduces subsidiarity and shifts power from the member states to the EU.

17 Presidency Conclusions, Brussels European Council (June 2007) 19, available at http://www.consilium.europa.eu/ueDocs/cms_Data/docs/pressData/en/ec/94932.pdf.

18 Treaty of Lisbon, *supra* note 10, at 13.

19 Charter of Fundamental Rights art. 2, Dec. 7, 2000, available at http://www.europarl.europa.eu/charter/pdf/text_en.pdf.

1. ECJ interpretation of the Charter and primacy of EU law

The first example indicative of how the Charter is not reflective of the subsidiarity principle is that the EU defines what the words in the Charter mean, not the Member States. Title I of the Charter is “Dignity,” which states, “Human dignity is inviolable. It must be respected and protected.”²⁰ The second Article (Article II-62) under this title deals with the right to life. It declares that “[e]veryone has the right to life.”²¹ Pro-life activists, who argue against abortion and destruction of the live embryo for embryonic stem cell research, would seemingly be exultant at this declaration. Ireland, for example, is a nation that has traditionally been “pro-life” according to this definition in that they haven’t legalized abortion. Yet the ECJ has defined who “everyone” is, and “everyone,” according to its definition, does not include unborn children. As already established, the Treaty of Lisbon officially recalls the primacy of EU law over the law of Member States in accordance with the case law of the ECJ,²² and the Charter is given the same legal value as the Treaties.²³ Thus, if the Charter of Fundamental Rights becomes binding upon the countries in the EU, the ECJ’s definition of “everyone” will apply, and the right of dignity and the right of life (i.e. the right to not be aborted) is not extended to unborn children. Ireland (and more importantly the people of Ireland) will not get to decide if abortion will be legal, but instead the legal institution of the EU will decide. The issue is not whether or not abortion should be legal; the issue is that, based on the principle of subsidiarity, the European Union should not be deciding for its Member States, like Ireland, on issues such as this.

2. Binding nature of the Charter

A second example is found in the reason the United Kingdom fought for an opt-out from the binding nature of the Charter. One of

20 *Id.*

21 *Id.*

22 Draft Declaration, *supra* note 15.

23 Treaty of Lisbon, *supra* note 10, at 13.

the UK's concerns with the original proposed Constitutional Treaty was the legal status given to the Charter of Fundamental Rights. The UK, along with the Netherlands and a few other countries, did not want to have the Charter included as part of the new treaty. While the Charter is not included in the text of the Treaty of Lisbon, it is, as already mentioned, given the same legal value of the Treaties.²⁴ Article II-88, under Title IV, Subsidiarity, declares the “[r]ight of collective bargaining and action.”²⁵ This, in other words, gives the right to strike. The UK has its own labor laws, as does each country, and labor leaders in the United Kingdom are concerned with a Charter guaranteeing the right to strike and the implications it might have for their labor laws.

What those implications are does not matter; what does matter is that, based on subsidiarity, the UK's own democratic system of government should be responsible for governing its own citizens. As with the right to life, the issue is not whether the right to strike should be guaranteed; it is whether or not the EU should be taking upon itself more control of matters belonging to the member states. That the UK has obtained an ‘opt-out’ from the enforceability of this Title is irrelevant; the point remains that through the Charter of Fundamental Rights, the EU is assuming rights that “can be sufficiently achieved by the Member States” without EU involvement.²⁶

The EU, instead of devolving itself of decision making prerogatives to comply with the principle of subsidiarity, has, with the legalization of the Charter and the establishment of primacy of EU law, usurped control from its Member States that is inconsistent with subsidiarity.

IV. CONCLUSION

As a supranational institution, the European Union has a unique role to build upon common principles and shared values of its member states without encroaching on the individuality of those member

24 *Id.*

25 Charter of Fundamental Rights, *supra* note 19.

26 Treaty on European Union, *supra* note 7.

nations. The future of Europe depends on the shape this role takes. In 1849, Victor Hugo dreamed that “[a] day will come . . . when all [the] nations of [this] continent will, without losing [their] distinct qualities or [their] glorious individualities, be blended together in a superior unity, and constitute a European fraternity. A day will come when the only battlefield will be the market opening to commerce and the mind opening to new ideas. A day will come when bullets and bombs will be replaced by votes.”²⁷ Hugo’s vision for a better Europe was based on common values of peace, prosperity, and democracy. These three values must continue to guide Europe as it determines what its future will be. In order to restore the appropriate balance of government, the EU must become more of a facilitator and coordinator, as it was created to do, and less of a central legislator. The EU must continue to promote peace, as it was established to engender in this historically war-prone region of the world. It must also facilitate democracy by increasing the subsidiarity of its institutions and encouraging European nations to do the same. However, as can be seen in institutional changes it will effect and the Charter of Fundamental Rights it will make binding, the current Treaty of Lisbon goes beyond its bounds of facilitating peace and prosperity by reducing democracy and subsidiarity. The future of the European Union rides on its ability to create a framework that will promote peace and prosperity while protecting democracy and subsidiarity. If that can be done, the future of Europe looks bright.

27 American Peace Society, *The Advocate of Peace* 67 (American Peace Society, ed., 1837).

MOVIE EDITING AND “THE ESSENCE OF THE LAW OF COPYRIGHT”

by P. Tayler Summers¹

I. INTRODUCTION

By current standards, technological advances determine the standing of civilized nations; technology is the measurement of progress, and it rapidly evolves and develops. Yet with developments in technology arise new, complex questions which the law is asked to confront and answer. *Olmstead v. United States* is one such example where the Court was obliged to answer a new question because of new technology. Roy Olmstead was convicted of bootlegging in Washington State during Prohibition. He appealed the district court’s decision because the conviction was based on evidence gathered against him by prohibition officers through the means of wire tapping. The Supreme Court heard his case based on his claim that wire tapping violated his Fourth Amendment right to protection against unlawful search and seizure and the Fifth Amendment’s protection against self-incrimination. The Supreme Court found no violation of these rights.² While the Court upheld the previous decision, one dissenting opinion adds something interesting. He comments, “[d]iscovery and invention have made it possible for the Government, by means far more effective than [previously available], to obtain disclosure in court of what is whispered in the closet.”³ Just

1 Tayler is a senior at Brigham Young University studying English. He is originally from Queen Creek, AZ. After graduating, Tayler hopes to attend law school and pursue a career in law.

2 *Olmstead v. United States*, 277 U.S. 438, 455 (1928).

3 *Id.* at 473 (Brandeis, J., dissenting).

as wire tapping allowed government greater access to Olmstead's private conversations, computer technology has facilitated consumers' ability to obtain and manipulate copyrighted work in unforeseen ways, and thus a new question has come to the court. *Clean Flicks of Colo., LLC v. Soderbergh* involves various businesses that deleted the scenes, words, and sounds which they considered inappropriate from digital copies of movies and then sold the copies of their altered movies to the public on digital video discs. The copyright holders felt that, by doing so, the movie-editing companies were infringing on their rights as copyright owners. In their defense, the movie-editing companies claim protection under the doctrine of fair use found in section 107 of the U.S. Copyright Law. As in Olmstead's case, the copyright holders have brought a new question before the court and requested a new interpretation because of changes in technology. Judge Richard P. Matsch, in order to overcome the newness of the questions brought up by technology, appeals to the "essence of the law of copyright" in his decision.⁴ Judge Matsch explains that the essence of the law of copyright is "the intrinsic value of the right to control the content of the copyrighted work."⁵ When the "essence" is found and applied, that which was unclear and indistinguishable becomes clear and easier to interpret and the new question becomes easier to answer. Therefore, this article will illustrate how companies such as Clean Flicks of Colorado, despite their efforts to prove exemption through the fair use doctrine, used technology in violation of copyright law as is shown when the question is held up to the "essence of the law of copyright."⁶

II. CONTEXTUAL BACKGROUND FOR *CLEAN FLICKS OF COLO., LLC v. SODERBERGH*

The history leading up to the case is brief since the technology that makes it possible to remove clips and sound from movies has

4 *Clean Flicks of Colo., LLC v. Soderbergh*, 433 F. Supp. 2d 1236, 79 U.S.P.Q.2D (BNA) 1302 (Colorado, 2006).

5 *Id.* at 1242.

6 *Id.*

only recently been made available to the public, yet there is some historical precedent showing the public's desire for what they consider appropriate content. In the nineteenth century, Reverend Thomas Bowlder and his daughter published a well-known volume of Shakespeare's work, removing scenes and lines that he thought were inappropriate for family audiences.⁷ Yet the lawfulness of the issue went unquestioned in this instance since the copyright on Shakespeare's work had long since been released by the nineteenth century when the volume was published. In the above-mentioned case, the counterclaim defendants Clean Flicks of Colorado; CleanFlicks, LLC; CleanFilms; Family Flix USA, LLC; and Play It Clean Video, LLC; were involved in the fairly-new industry of editing movies. In the industry, digital equipment is used in order to find and remove "objectionable content."⁸ Copies of the edited films are made then rented or sold to the public. The industry began shortly after "Titanic" was released in 1998; the first movie-editing company began removing two scenes because of allegedly unacceptable material from VHS format movies.⁹ Since that time many distributors of edited movies have been established. The editing companies bought, edited, and sold the edited copies on a one-to-one ratio, meaning that for each edited movie they sold or rented, they had bought an original copy.¹⁰ The lawfulness of their industry was officially brought into question when Clean Flicks of Colorado, LLC brought a pre-emptive lawsuit against the Directors Guild of America in order to receive legal justification for the movie-editing industry.¹¹ CleanFlicks, LLC; CleanFilms; Family Flix USA, LLC; and Play It Clean Video, LLC joined Clean Flicks of Colorado (known in the case as the counterclaim defendants) when the original suit was countered by Steven Soderbergh and fifteen other directors (including Martin Scorsese, Steven

7 David Bevington ed., *THE NECESSARY SHAKESPEARE* xcvi (2d ed. 2005).

8 *Clean Flicks of Colo.*, 433 F. Supp. 2d at 1240.

9 Sharon Weinberg Nokes, *E-Rated Movies: Coming Soon to a Home Theater Near You?*, 92 *Georgetown L.J.*, 611, 611-12 (2004).

10 *Clean Flicks of Colo.*, 433 F. Supp. 2d at 1236.

11 Weinberg, *supra* note 9, at 624.

Spielberg, and Robert Redford), eight large movie studios (including Metro-Goldwyn-Meyer, Time Warner, Sony, and Disney), and the Directors Guild of America (collectively known as the “defendants counterclaimants”).¹²

The use of computers by the public to edit and copy a protected work was previously unheard of; another question of copyright law revealed itself as a result of the newly available technology. The studios and directors ask the question of the court, “Are Clean Flicks, et al. allowed to change and sell our work without our permission?” Soderbergh, et al. allege that Clean Flicks of Colorado, et al., using technology recently made available, are defying a movie maker’s and studio’s “[E]xclusive rights to . . . (1) reproduce the copyrighted work in copies or phonorecords[,] (2) to prepare derivative works based upon the copyrighted work[, and] (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending” as established in the Copyright Act.¹³ In *Clean Flicks of Colo., LLC v. Soderbergh*, they asserted that the practices of the counterclaim defendants violated all of these and caused “irreparable injury to the creative artistic expression in the copyrighted movies.” Judge Matsch explains,

The Studios have not asked for damages for any loss of revenue to them; they have not sought to recover the counterclaim defendants’ profits and they do not ask for statutory damages under 17 U.S.C. § 504. Their objective in the motion for partial summary judgment is to stop the infringement because of its irreparable injury to the creative artistic expression in the copyrighted movies. There is a public interest in providing such protection despite the injury the infringers may sustain.¹⁴

The movie studios and directors’ only request that the court protect and defend their rights as copyright owners.

12 *Clean Flicks of Colo.*, 433 F. Supp. 2d at 1243.

13 Copyright Act, 17 U.S.C. § 107 (2003).

14 *Clean Flicks of Colo.*, 433 F. Supp. 2d at 1243.

III. FAIR USE DOCTRINE

The defense presented to the court by Clean Flicks of Colorado, et al. considers their rights under the fair use doctrine included in copyright law. Fair use doctrine has developed with time through the decisions of various cases and became an official part of copyright law when it was codified in section 107. Section 107 of the Copyright Act, 17 U.S.C. affords others besides the copyright owner the right to reproduction of copyrighted works without infringement *if* the copied materials are "for purposes such as criticism, comment, news reporting, teaching . . . scholarship, or research."¹⁵ Clean Flicks of Colorado, et al. claimed that by editing and making their edited copies available "they [were] criticizing the objectionable content commonly found in current movies and that they [were] providing more socially acceptable alternatives to enable families to view the films together, without exposing children to the presumed harmful effects emanating from the objectionable content."¹⁶ If this practice constituted educational use, it would validate their claim of working under the fair use doctrine which limits the *exclusive* copyright and distribution rights of the copyright owners. To judge the validity of any "fair use" claim there are four criteria in the doctrine which, in *Campbell v. Acuff-Rose Music, Inc.*, the Supreme Court "instructed that the fair use doctrine must be applied using a case-by-case analysis, considering all four of the statutory factors, [and that] no one of which should be considered controlling."¹⁷ The counterclaim defendants' work, in other words, is to be scrutinized on its own according to the four factors set down by the Copyright Act, without any precedent influencing the decision. In order to do so, Judge Matsch finds the "essence of the law of copyright" in each of the criteria, and, in this manner, resolves a new question in law.

15 Copyright Act, 17 U.S.C. § 107 (2003).

16 *Clean Flicks of Colo.*, 433 F. Supp. 2d at 1240.

17 Judge Matsch here quotes *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 114 S. Ct. 1164, 127 L. Ed. 2d 500 (1994).

A. First Factor

According to the fair use doctrine, “the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes,” must first be considered when judging any claim to protection under fair use.¹⁸ Clean Flicks of Colorado, et al. admit that their practices are commercial, but, as mentioned above, the Supreme Court has decided that one factor cannot determine the outcome. They argue that through their commercial enterprise they have endeavored to prove, through a public policy test, that they *are* criticizing what is found in movies.¹⁹ Furthermore, in *Clean Flicks of Colo., LLC v. Soderbergh*, Judge Matsch writes that the counterclaim defendants brought many testimonials from appreciative customers of the counterclaim defendants who enjoy the movies without worrying about the appropriateness of the content. All these efforts, however, were ruled inconsequential. He explained that they were of no consequence in the trial or his decision because the argument was “addressed in the wrong forum.” He also explained that his “[c]ourt is not free to determine the social value of copyrighted works. What is protected are the creator’s rights to protect its creation in the form in which it was created.”²⁰ The counterclaim defendants’ arguments for the first factor of the “fair use” act did not hold up in this light. In order to rule against the counterclaim defendants’ claim of protection under the first factor of the Act, Judge Matsch knowledgeably separated what was useful and in line with the essence of the law and what was not. Doing so, he answered one part of these new questions.

B. Second Factor

The second factor of the fair use doctrine states that the “*nature* of the copyrighted work”²¹ should also be considered when deciding on

18 Copyright Act, 17 U.S.C. § 107(1) (2003).

19 *Clean Flicks of Colo.*, 433 F. Supp. 2d at 1240.

20 *Id.*

21 Copyright Act, 17 U.S.C. § 107(2) (2003) (emphasis added).

the applicability of the "fair use" act. The defendants counterclaimants' argument is that the counterclaim defendants are violating their exclusive right to create "derivative works." The counterclaim defendants attempt to establish their work as transformative, claiming, as mentioned, that they edit movies in order to criticize the movie makers' use of violent, crude, sexual, or other material in their movies. Judge Matsch claims, though, that for a work to be considered as transformative it must contribute something original enough to benefit the public. Based on *Campbell v. Acuff-Rose Music, Inc.*, the work is transformative if it adds to the existing work. In *Bill Graham Archives v. Dorling Kindersley Ltd.*, a case similar to *Clean Flicks of Colo., LLC v. Soderbergh*, the defendant used copyrighted images from Grateful Dead paraphernalia in order to make a book.²² According to that decision, as emphasized by Judge Matsch, the difference rested on the transformative nature of the work that contained the copyrighted images. The book did not seek to exploit the value of the images for gain, but that they had value in a historical book. In contrast, the counterclaim defendants of *Clean Flicks of Colo., LLC v. Soderbergh* used the actual work, removing, not adding, scenes and words for commercial purposes. This "weigh[ed] heavily in favor of the Studios under the second factor." The other factor in "the nature of the copyrighted work"²³ is the "creative expression of the movies."²⁴ Since each piece of a movie can have meaning, as is inherent in their nature, removing parts can limit the director's right to express her or himself. These factors, as determined by Judge Matsch, were enough to decide that the counterclaim defendants had infringed on the second factor used in determining whether or not a work has protection under fair use. As each factor comes into question, the law seems to become clearer and easier to understand.

22 *Bill Graham Archives v. Dorling Kindersley Ltd.*, 448 F.3d 605 (2d Cir. 2006).

23 Copyright Act, 17 U.S.C. § 107(2) (2003).

24 *Clean Flicks of Colo.*, 433 F. Supp. 2d at 1241.

C. Third Factor

Article three of section 107 in the Copyright Act establishes that “the amount and substantiality of the portion used in relation to the copyrighted work as a whole” must also be considered to determine if fair use is applicable to the work in question. This would mean that if an unsubstantial amount of the copyrighted work in relation to the complete is used, fair use could apply if the work met the three other factors as well. The purpose of an edited movie is to provide as much of the movie’s story as possible while eliminating what the editor considers inappropriate. Clearly an edited movie must provide most of the movie in order for them to succeed in giving the audience most of the same story given in the unedited version. Judge Matsch rules the use in edited movies as substantial because they “are copied in almost their entirety.”²⁵

D. Fourth Factor

With one last factor of the fair use doctrine to weigh, there is yet one more question to answer as a result of this intersection between law and technology. The fourth factor states that a judge must consider “the effect of the use upon the potential market for or value of the copyrighted work”²⁶ when deciding if a work truly is protected from copyright laws because of fair use. The primary argument of the counterclaim defendants lies, in Judge Matsch’s opinion, in this factor of fair use doctrine.²⁷ The counterclaim defendants claim that their business did not cause a negative effect on the “potential market or value of the copyrighted work,” but instead that their business generates more sales of the directors’ movies.²⁸ This claim is based on the fact that they buy an original copy of the movie for each movie the edit and sell. They further claim that if edited movie consumers did not have the option to buy the movies in edited form,

25 *Id.*

26 Copyright Act, 17 U.S.C § 107(4) (2003).

27 *Id.*

28 *Clean Flicks of Colo.*, 433 F. Supp. 2d at 1239.

they would not buy them at all. Besides the "superficial appeal," this argument achieves no validity because, as Judge Matsch contends, it ignores the intrinsic value of the right to control the content of the copyrighted work which is the essence of the law of copyright."²⁹ Again, the superficial is overlooked, as it must be, and the essence of the law is reviewed in order to overturn this argument. The questions regarding fair use and this new situation are satisfied with this conclusion.

In response to the ruling, various questions have been asked, questions that also help explain copyright law, answering questions of their own. Many people, in reaction to the ruling, have wondered why it is illegal to edit something they own, a DVD or videocassette in this case. The essence of the law of copyright provides an answer to this question as well. The essence of the law, according to Judge Matsch, states that those who produce the work have the right to control it. The Copyright Act permits the producer to distribute their work in the form they desire and limits a purchaser's ability to make changes to the distributed work unless it is justified by the fair use doctrine. Since 2005, some leniency has been granted on the issue. According to the Family Movie Act passed by Congress in 2005, a person may edit a work for personal, in-home use, but that person may not make a fixed copy, such as a copy on DVD, of what she or he edited.³⁰ The right to make fixed copies of any movie that was edited for that private household use was not granted. This is a partial concession and acknowledgement by Congress of the need that Clean Flicks, et al. presented to the court for movies without objectionable content, yet it does not completely remove the copyright owner's rights to control over her or his work as Clean Flicks, et al. were doing.

Others contend that there is an inconsistency in the law since airlines and television stations are allowed to show edited forms of movies without any adverse action taken against them. In order to understand this seeming dichotomy, Allen Goluboff, president of the Directors Guild of Canada, explains that an airline or television sta-

29 *Id.* at 1242.

30 *Id.* at 1240.

tion must buy a license from the owner of the copyright in order to receive permission to show the films in an altered state.³¹ After the director, or whoever else is involved, receives an agreed-upon amount of money, the compensator is given permission to show the edited versions of the director's work. If a television station or airline is showing an edited movie it is because there is a legal agreement between the copyright owner and the airline companies giving them the right to do so. Those companies have bought the right to show edited movies whereas Clean Flicks of Colorado, et al. had not, and could not claim the same approval from the copyright owners. Consequently, it is possible that the industry of movie editing has a future if the studios or directors agreed on allowing them to edit and distribute their films. For now, though, there is no legal contract between any movie studio and the editing companies as exists with airlines and television stations.

Recently, more movie-editing companies in Utah were closed as a result of the ruling in this case. Flix Club of Orem and Cougar Video of Provo, among others, were operating under the pretense of educational use. They continued to edit, sell, and rent movies in a manner that had been found in violation of copyright law in *Clean Flicks of Colo., LLC v. Soderbergh*. With the ruling of *Clean Flicks of Colo.* clearly in their favor, movie studios have begun seeking out the last of the movie-editing companies like Flix Club and Cougar Video and ordering the termination of their illegal activity. As of December 31, 2007, these companies agreed to close their doors in light of the fact that they have no protection under the law.³²

31 CBC-TV & Andrew Nichols, *Axing Sex, Swearing from Films Violates Copyright: Court*, 2006 CBC.CA, July 9, 2006, <http://www.cbc.ca/clips/mov/nichols-scrub-flim-intvu-060710 mov> (Quicktime movie).

32 Sara Israelsen-Hartley, *Edited-films Stores in Utah County Closing*, DESERET MORNING NEWS, (2007), available at <http://deseretnews.com/article/1,5143,695233362,00.html>.

IV. CONCLUSION

When new technology becomes available, it is necessary for the subtle lines of the law to be more carefully defined in order to encompass the technological advances. In *Clean Flicks of Colo.*, it was incumbent upon Judge Matsch to seek out the core principles of copyright law. With these core principles in hand, he was able to reassess the application of copyright law in reference to film editing. Editing and distributing edited movies for profit has been found illegal by weighing it against those core principles. Although companies like Clean Flicks argue that their work should be exempt from copyright restrictions because they are criticizing the directors' work, they were found to be in the wrong and outside of the protection of fair use doctrine. Though it was a new question, with new complications brought about by the rapid advances of the present technological age, it has been solved by looking to and interpreting the law in light of the new question. In the face of the true core of the essence of the law of copyright, though the specific question was new to the legal realm, the claims made by Clean Flicks, et. al are simply found wanting.

EMBRYONIC STEM CELL RESEARCH: WHEN SHOULD IT BE ALLOWED?

by Collin D. Zundel¹

Embryonic stem cell research is a greatly debated subject. Proponents see it as an opportunity to help those with serious diseases, while opponents believe the research process destroys precious life. The purpose of this paper is to create a rule outlining in which cases embryonic stem cell research should be permitted. Opposing sides can come to a compromise when the research is permitted under certain criteria. Embryonic stem cell research should only be allowed when humans are not killed or severely harmed, when intended to cure serious illness or injury, when there is consent from the donor, and when accredited scientific researchers conduct it. This essay will first discuss the background of embryonic stem cell research, including the controversy and government involvement. Next, it will breakdown and discuss the elements of the rule, discussing and applying when stem cell research should be permitted. Finally, the paper will discuss an alternative form of research which does not use embryonic stem cells, but instead obtains stem cells from adults.

I. THE BACKGROUND

At the end of 1998, it was announced that James A. Thompson and his colleagues from the University of Wisconsin were able to

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successfully isolate embryonic stem cells.² This breakthrough discovery marked the beginning of the stem cell controversy, a controversy that has been a hotly debated topic for many years. While stem cells have been a highly discussed subject, the issue is perhaps deeper and more complicated than a surface discussion may conclude. One fact about stem cells is that they are pluripotent, which means they are capable of turning into any cell type.³ They are also infinite, meaning they can divide an infinite number of times, whereas other cells divide only a finite number of times.⁴ A cell, such as a stem cell, which is both pluripotent and infinite, has the potential to turn into any type of cell or organ. This means a stem cell holds the ability to become a heart cell, lung cell, red blood cell, or any other type of cell for the body. Scientists see enormous possibilities in a cell with these two special characteristics. They believe that embryonic stem cell research will bring about therapies that will possibly treat and cure stroke, diabetes, Alzheimer's disease, Parkinson's disease, and many other currently incurable diseases.⁵

A stem cell has the unique capacity to renew itself indefinitely and turn into specialized cell types.⁶ To obtain this special form of cell, stem cells are taken from the blastocyst in embryos and fetal tissue. A blastocyst is a group of cells called the inner cell mass, which is a part of the early embryo. The blastocyst contains about two hundred to two hundred and fifty cells. Obtaining embryonic stem cells from a blastocyst results in the destruction of the embryo. Stem cell research that results in the destruction of human embryos is what brings up many ethical concerns.⁷

2 Nancy E. Snow, *STEM CELL RESEARCH: NEW FRONTIERS IN SCIENCE AND ETHICS 2* (University of Notre Dame Press, 2003).

3 *Id.* at 3.

4 *Id.*

5 *Id.*

6 A. Thomson et al., *Embryonic Stem Cell Lines Derived from Human Blastocysts*, 282 *SCI.*, 1146 (1998), <http://www.sciencemag.org/cgi/reprint/282/5391/1145.pdf>.

7 *Id.*

As a result of the embryonic stem cell debate, President Bill Clinton asked the National Bioethics Advisory Commission (NBAC) to conduct research on the issue. The NBAC published its report in 1999 and 2000.⁸ They covered scientific, legal, ethical, religious, and public policy perspectives as well as policy recommendations for stem cell research. After the publication of the report, the Clinton administration permitted federal funding for stem cell research using aborted fetal tissue, placentas, umbilical cord blood, and adult stem cells. The Clinton administration also provided funding for research of stem cells obtained from frozen embryos, also known as in vitro embryos. These in vitro embryos were created for the purpose of fertility treatments and were in excess of clinical need. This new policy did not stop the debates because many were unhappy with the Clinton administration's decision regarding embryonic stem cell research. They disagreed with the distinction made between destroying embryos for research purposes and using previously derived embryonic stem cells for research.⁹

President George W. Bush announced a conservative change on August 9, 2001.¹⁰ The change provided that federal funds would be given if three criteria were met.¹¹ First, that the derivation process, which begins with the destruction of the embryo, must have been initiated prior to nine o'clock P.M. EDT on August 9, 2001. Second, the stem cells must have been derived from an embryo that was created for reproductive purposes and was no longer needed. Third, informed consent must be obtained for the donation of the embryo from the person who possessed the embryo, and that donation must not have involved financial inducements.¹² Federal funds were allocated to adult stem cell research and research using stem cells taken

8 Snow, *supra* note 2, at 2.

9 *Id.*

10 George W. Bush, Pres. of the U. S., President Discusses Stem Cell Research, The Bush Ranch (Aug. 9 2001), <http://www.whitehouse.gov/news/releases/2001/08/20010809-2.html>.

11 Stem Cell Information, <http://stemcells.nih.gov/policy> (last visited Jan. 29, 2008).

12 *Id.*

from umbilical cord blood and placentas. Federal funding would not go to research involving the creation or destruction of human embryos. President Bush's decision did not touch the issue of using aborted fetal tissue for stem cell research. Research using aborted fetal tissue continued to be eligible for federal funding.¹³

There are various debates between the ethical and scientific sides of embryonic stem cell research. Since embryos are potential humans, an important question is whether using stem cells derived from embryos should be considered murder. Arguing that embryonic research is murder, Senator Sam Brownback addressed Congress on June 29, 2006.¹⁴ He says that in our legal system embryonic stem cells are either a person or a piece of property. The law does not observe a transition from property to personhood because there is no dividing line. If you start out as a human being, then you will end up as a human being. If something has the potential to be human life, then it can never be property. He believes that once the process of life begins, it is human life from then on. Therefore, once it has been started, it is murder to stop the process of an embryo becoming a human.¹⁵

Giving a very different view, Senator Byron Dorgan addressed Congress on July 10, 2006.¹⁶ He said research that can find cures to diseases such as Alzheimer's, Parkinson's, heart disease, and diabetes must be a priority. More than one million people have been born through in vitro fertilization. However, fertility clinics fertilize many more eggs than are actually implanted in a woman's uterus. These clinics across the nation contain approximately four hundred thousand cryogenically frozen embryos. Eight thousand to ten thousand of these frozen embryos are simply discarded every year. This does not amount to murder any more than embryonic stem cell research. Those embryos will never become human beings because

13 Snow, *supra* note 2, at 2.

14 Marcia Clemmitt, *STEM CELL RESEARCH: IS PRESIDENT BUSH BLOCKING IMPORTANT MEDICAL RESEARCH?*, 16 CQ RES. 699, 713 (2006), <http://library.cqpress.com/cqresearcher/cqresrre2006090100>.

15 *Id.*

16 *Id.*

they are not implanted in a woman's uterus. Senator Dorgan believes this issue is about giving new life and opportunities to those who are suffering from disease.¹⁷ These two opinions are good examples of the opposing views between ethics and science. Both sides make important points that are necessary in the formulation of the rule.

II. THE BREAKDOWN AND DISCUSSION OF THE CRITERIA

In what cases should embryonic stem cell research be permitted? The rule stated earlier says that embryonic stem cell research should only be permitted when it does not kill or severely harm humans, when it is intended to cure disease or injury, when there is consent from the donor, and when it is conducted by accredited scientific researchers. This is still somewhat ambiguous and will need to be broken down to give the rule more clarity. For this purpose, it is necessary to define several key elements of the rule.

The first part of the rule says that stem cell research should not kill or severely harm humans. To "kill" would mean anything that ends human life.¹⁸ "Severe harm" means any measure that may have severe negative side effects, cause serious injury, or exploit humans.¹⁹ The third important part of this element is the definition of human life. This would mean a human at any stage of life, including a viable embryo. A viable embryo is one that is implanted in a woman's uterus.²⁰

The next criterion says the research must be intended to cure serious disease or injury. This means that the intention of embryonic stem cell research does not include reproductive cloning or therapeu-

17 *Id.*

18 http://dictionary.oed.com/cgi/entry/50126602?query_type=word&queryword=kill&first=1&max_to_show=10&sort_type=alpha&result_place=5&search_id=rjmj-hlRy1o-13529&hilite=50126602 (last visited Feb. 2, 2008).

19 Interview with Robert White, Philosophy Department, Brigham Young University, in Provo, Utah (Mar. 12, 2007).

20 *Id.*

tic cloning. This condition narrows the instances when this research should be permitted.

The rule also says that research should only be allowed when there is consent from the donor. This would mean that consent must be obtained from those who are giving the stem cells. In the case of embryonic stem cells, it would include the donors of the egg and sperm.

The last criterion is that accredited scientific researchers must conduct the research. Only certain people can do research with stem cells. A scientist must be accredited through schooling and experience to be allowed to conduct the research. They must be trained scientists and doctors who have gone through the proper steps of schooling.

Proponents strongly in favor of embryonic stem cell research would argue that nothing is killed. They do not believe that a five-to seven-day-old embryo is a human life. This brings up the question of when life actually begins during human development. Many people believe that an embryo is not a human life until birth, others believe that life begins at conception, and others believe life begins somewhere between conception and birth. These questions are not answerable by objective evidence. The argument should turn more to the potential of an embryo. When an embryo is implanted in the uterus, it has the potential to grow to be a full human being. When an embryo is on its way to this goal, it should not be interrupted. To not interrupt this process, the rule states that stem cell research must not result in the destruction of the embryo.

In order not to destroy viable embryos, researchers turn to excess in vitro fertilization for embryonic stem cell research. There are clinics all across the country that have excess in vitro embryos, which comes from couples who have donated eggs and sperm for the purpose of their own familial development.²¹ There are many in vitro embryos left behind that couples will no longer need. Therefore, the question is raised of what to do with unused in vitro embryos. Many feel that excess in vitro embryos should be donated to other couples who may not have the capability of providing eggs and

21 Clemmitt, *supra* note 14, at 710–711.

sperm.²² Although this is the preferable solution, the supply is more in excess than can be used by couples in need.²³ Also, couples may not be comfortable with someone else using their embryo to have a baby. An alternative solution to supplying couples in need or simply discarding the embryos would be to donate the embryos to science for the use of embryonic stem cell research.²⁴ If the embryos are used for research instead, they could be used to potentially cure serious disease or injury.

Stem cell research should be limited to the condition of curing serious disease or injury. Stem cells have the potential to treat spinal cord injuries and diseases such as leukemia and diabetes among others.²⁵ Embryonic stem cells have the possibility to cure injuries and diseases for which there was previously no treatment. The sensitivity of embryonic stem cells coupled with its major possibilities makes it reasonable for its allowance with limitations. Through limitations and regulations, the nature of life will be protected, and researchers will be prevented from pursuing their own selfish interests.

The consent from the donor is essential because it prohibits manipulating people in order to conduct research without their permission. People should have a say when their property is used for research. This ensures that those who are against embryonic stem cell research will have no part in it. It is also important that only accredited scientific researchers and doctors conduct the research. Only those who are specially trained should be allowed to conduct the research. This bans people from trying to conduct the research without the necessary qualifications. Regulating the researchers will preserve the precious stem cells that are available and will help to ensure that they are taken seriously and not wasted. The last two parts of the rule make it complete and allow for the progress of research and the preservation of human life.

22 *Id.*

23 *Id.*

24 *Id.*

25 Joseph Panno, *STEM CELL RESEARCH: MEDICAL APPLICATIONS AND ETHICAL CONTROVERSY* 36 (Facts on File, 2005).

III. APPLICATION OF THE FOUR CRITERIA

The rule can now be further illustrated through test cases as it has been properly defined. The first example is with two doctors who have been researching at a reputable medical school for a number of years. They were among the first to take the lead in stem cell research and have given a number of lectures promising its results. They have put their reputations at risk saying that new cures will be coming for problems like Parkinson's disease and severe spinal cord injuries. They have asked several pregnant women who do not want to continue in their pregnancy to come in. Their research has proved promising, but they have not yet come up with a way for doing the research without destroying the fetus in the woman's uterus. Both doctors feel that the benefit of the stem cell research will far outweigh the cost of destroying the embryos.

This case could be somewhat controversial because the doctors have had some promising results. There is evidence the research is being conducted by accredited scientific researchers as it is performed at a medical institution. Also, the researchers are performing research for the right purpose of curing disease and serious injury. However, the research is being performed at the cost of human life. They are destroying viable human embryos. Although the doctors are justifying their research, it still falls short of the rule created earlier. The fact that it falls short for just one part of the rule makes the research in this case unacceptable.

The next case is of a pregnant twenty-four year old. She has just found out she is pregnant and has decided not to keep the baby. She has met with her doctor, and together they decided to abort the fetus. The doctor suggests that the fetus be used for stem cell research. He explains to her that the stem cells will be studied and used to help people who have disease or are seriously injured. The embryo will be destroyed, but the stem cells will be used for research purposes. She agrees to participate in the research and allows them to take the embryonic stem cells.

This case is more controversial because it brings up the question of what to do with embryos that will be destroyed no matter what. This case satisfies all the criteria of the rules except for the killing

of a viable embryo. The fact that she is aborting the fetus is already controversial because human life is destroyed. The destruction of life is not for the purpose of embryonic stem cell research. The embryo should be used for stem cell research because it will be destroyed no matter what. Another example of this would be of a murdered person donating organs. The donated organs do not sanction the murder just as taking stem cells does not sanction the abortion. Though life is being lost, the bodily organs can provide help to those in need. This example therefore satisfies all the criteria of the rule.

The third example is of a young married couple. They have wanted to become pregnant for a long time but have been unable. They decided to use the process of in vitro fertilization to become pregnant. The process was a success and the wife is now pregnant. The excess in vitro embryos will be discarded because they can no longer be used to help anyone become pregnant. The doctor tells the couple that the excess in vitro embryos can be used for stem cell research to help those with disease and serious injury. They decide to donate their excess in vitro embryos to a reputable medical research program.

This case seems to satisfy all of the requirements to allow for stem cell research under the proper conditions. The research is not killing or harming viable human embryos. It is intended for the right purpose of helping those with disease and injury. It was given with the consent of the donor, and will be performed by accredited scientific researchers. This research should be allowed according to the criteria of the rule.

The rule for stem cell research applies to the different cases that have been presented. It is reasonable to assume that the rule will hold for even the most difficult cases. Embryonic stem cell research should only be performed when no one is killed or harmed, when accredited professionals conduct the research, when there is consent, and when it is for the right purpose. A strong base is formed when creating and applying the different elements of the rule. Stem cell research will most likely continue to be a highly debated subject. It is important to consider its possibilities coupled with the sensitivity of human life. The medium between limitations and its allowance will bring about much progress in the future.

 IV. OTHER ALTERNATIVES

Many people argue that adult stem cell research is just as effective as embryonic research and does not raise the same ethical concerns that embryonic research raises. David A. Prentice, Professor of Life Sciences at Indiana State University, says that despite twenty years of experiments with mouse embryonic stem cells and the fervor that has arisen regarding human embryonic stem cells, their advantage over adult stem cells are unsubstantiated. He further points out that there is “no current clinical treatment using embryonic stem cells.”²⁶ There are few and modest advances with embryonic stem cells in animal models of disease, and there is difficulty obtaining pure cultures in the laboratory dishes. He says the stem cells themselves are even difficult to maintain in culture. Proponents of embryonic stem cell research admit that potential treatments run the risk of immune rejection by the patient and of tumor formation. He also points out that a report from 2001 states that “embryonic stem cells are genomically unstable, exhibiting variable gene expression even in the controlled conditions of the laboratory.”²⁷ If adult stem cell research can be proven to be more promising than embryonic stem cell research, then, in the future, we may have good reason to focus entirely on adult stem cells.

William B. Slayton, of the Department of Pediatrics, College of Medicine at the University of Florida, and Gerald J. Spangrude, of the Department of Oncological Sciences at the University of Utah, give an overview of adult stem cells in their essay called “Adult Stem Cell Plasticity.”²⁸ They say that adult stem cells may provide “solutions that avoid the legal and ethical problems of cloning and fetal stem cell approaches.”²⁹ Until recently, popular belief held that adult

26 David A. Prentice, THE PRESENT AND FUTURE OF STEM CELL RESEARCH: SCIENTIFIC, ETHICAL, AND PUBLIC POLICY PERSPECTIVES, IN STEM CELL RESEARCH: NEW FRONTIERS IN SCIENCE AND ETHICS 18 (Nancy E. Snow ed., 2003).

27 *Id.*

28 William B. Slayton & Gerald J. Spangrude, *ADULT STEM CELL PLASTICITY*, IN *ADULT STEM CELLS* 1 (Kursad Turksen ed., 2004).

29 *Id.*

stem cells were restricted in their ability to produce tissue different from their original source tissue. Studies have shown that adult stem cells are plastic, meaning they can differentiate into their own source tissue and also unrelated tissue. However, Slayton and Spangrude outline four current controversies involving adult stem cell plasticity.³⁰ The first is that plasticity has been inferred from an undefined mixture of cells. It is therefore unclear which cells give rise to the new types and whether separate cell lineages arise from the same cell. The second problem has to do with the culture period. They say it becomes unclear whether the stem cells, as originally isolated, had the ability to produce the results or whether modifications occurred because of the period. The third problem is that most studies have not shown the ability of transdifferentiating stem cells to self-renew. Finally, most studies have not shown the functionality of transdifferentiated stem cells. In summary, these problems demonstrate that science has not furnished sufficient evidence for adult stem cell plasticity.³¹ Much work is necessary to confirm that the cells exhibiting plasticity are the adult stem cells. They conclude that focusing only on adult stem cell research and ignoring the potential of embryonic stem cells may lead to missed opportunities. Each approach has the possibility of being advantageous in certain clinical situations.³² It is important to take this article into consideration because both aspects of stem cell research show potential and deserve attention.

V. CONCLUSION

This short paper has discussed the background of embryonic stem cell research and the reasons it has become a controversial subject in the United States. A rule was proposed that embryonic stem cell research should only be permitted when it does not kill or severely harm humans, when it is intended to cure serious disease, when there is consent, and when it is conducted by accredited scientific researchers. The rule was further explained and then outlined in a

30 *Id.* at 5.

31 *Id.*

32 *Id.* at 15.

number of test cases where it was found to apply. Finally, this review discussed other alternatives of stem cell research. Although these other methods have potential, many agree that researchers should still explore the potential of embryonic stem cells. This has been a controversial subject, but both sides of the debate have justification. Compromising on the subject may be the only way to preserve and enhance life in both cases.