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E Unum Pluribus: After Bond v. United States, State Law as a Gap Filler to Meet The International Obligations of the United States

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I. INTRODUCTION

Today, the United States Supreme Court jurisprudence clearly establishes that Congress had broad almost unfettered power to *make* treaties, but the concurring opinions in *Bond v. United States*[1] may foreshadow future limitations on Congress's ability to *implement* those treaties as part of the domestic law of the United States. Such limits would create a vacuum in the power of the federal government to prescribe its foreign relations. And open, for the first time, an independent space or role for the States in the foreign relations of the United States. This new role for the states would be based on principles of federalism rather than congressional consent or inaction. In the past, this limitation on the constitutional scope of the treaty making power may not have been a problem because of Congress's Commerce Clause powers.[2]

Historically, foreign policy involved big issues that clearly implemented Congress's "necessary and proper" power "to regulate

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1. 134 S. Ct. 2077, 2094–2111 (2014).

2. Bond v. United States (*Bond II*), 134 S. Ct. 2077, 2114 (2014). *Compare* Wickard v. Filburn, 63 S. Ct. 82 (1942), *and* Katzenbach v. McClung, 379 U.S. 294 (1964), *with* United States v. Lopez, 514 U.S. 549 (1995); Nat'l Fed'n of Indep. Bus. v. Sebelius, 132 S. Ct. 2566 (2012); *see also* Craig L. Jackson, *The Limiting Principle Strategy and Challenges to the New Deal Commerce Clause*, 15 U. PA. J. CONST. L. 11, 12 (2012).

commerce with foreign nations" or represented merely an agreement among sovereigns that had little or no impact on domestic law (i.e., regulating the behavior of private parties). Since the New Deal era, the Commerce Clause was also interpreted as granting Congress broad authority to regulate domestic commercial activities.[3] Recently, the Court has been more skeptical of the scope of the Commerce Clause.[4] Balancing the Senate's power to advise and to consent to treaties, and Congress's power under the Commerce Clause to enact legislation, the concurring justices in *Bond* suggest that there are foreign policy spaces that Congress cannot regulate and must be left to the sovereign states.

The third player in our constitutional form of federal government, the executive branch, may be equally powerless. The courts are increasingly skeptical of the executive branch's role in implementing the foreign relations obligations of the United States in the domestic arena.[5]

In the modern foreign relations of the United States, a foreign policy space in which the states may unilaterally act is problematic. Areas that were traditionally under the general police power of the states, such as wills and estates, are increasingly becoming potential areas of federal concern as part of a global move to harmonize

3. *See* Hodel v. Va. Surface Mining & Reclamation Ass'n, 452 U.S. 264, 308 (1981) (Rehnquist, J., concurring); *Sebelius*, 132 S. Ct. at 2677 (Thomas, J., dissenting) ("[T]he Court's continued use of that test 'has encouraged the Federal Government to persist in its view that the Commerce Clause has virtually no limits.'") (quoting United States v. Morrison, 529 U.S. 598, 627 (2000) (Thomas, J., concurring)). The Commerce Clause has three grants of power to Congress to regulate commerce: interstate commerce, commerce with foreign nations, and commerce with Indian tribes. *See* U.S. CONST. art. 1, § 8, cl. 3; *see also* Naomi Harlin Goodno, *When the Commerce Clause Goes International: A Proposed Legal Framework for the Foreign Commerce Clause*, 65 FLA. L. REV. 1139, 1196–97 (2013) (Court applies a different legal test for Congress's powers for each type of constitutional grant of power to regulate commerce under the Commerce Clause). This Article will narrowly assume that only the Congress's power to regulate interstate commerce is implicated in the legal questions presented in this Article.

4. *See, e.g.*, *Sebelius*, 132 S. Ct. at 2578–79; *Lopez*, 514 U.S. at 567–68 (invalidating the Gun-Free School Zone Act (GFSZA)); *Morrison*, 529 U.S. at 608–09; *Sebelius*, 132 S. Ct. at 2642 (Scalia, J., Kennedy, J., Thomas, J., Alito, J., dissenting); *see also* Misha Tseytlin, *As-Applied Commerce Clause Challenges*, 16 U. PA. J. CONST. L. 479, 485 (2013) (analyzing the recent cases narrowing the scope of the Commerce Clause).

5. *See* Medellin v. Texas, 552 U.S. 491, 504–05 (2008).

markets, promote trade, or protect human rights.[6] In many nations, the ratification of a treaty immediately changes its internal laws so that they are congruent with its new international obligations. However, in the United States, unless the language of the treaty is self-executing, Congress must affirmatively change domestic laws to conform to the language of the treaty.[7] Frequently, because of deadlock in Congress or disagreements with the executive branch, it is difficult—if not impossible—to get Congress and the President to agree on enabling legislation.[8]

Intellectual property issues are among the most significant and hotly contested issues in foreign policy that require treaties that regulate private domestic actors.[9] Therefore, this Article will analyze two intellectual property examples, one from Berne Convention and the other from the Paris Convention, where state law supplements federal law to provide the minimum level of legal protection required under each treaty. Part II provides an overview of *Bond v. United States*. Part III will analyze whether the federal law of preemption or

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6. *See, e.g.*, Convention Providing a Uniform Law on the Form of an International Will, Oct. 26, 1973, *available at* http://www.unidroit.org/instruments/succession; Ku & Yoo, *infra* note 49, at 166. There are many tragically funny examples of the use of foreign trade treaties to challenge domestic health and safety regulations, for example Australia's plain package requirements for tobacco products. See Simon Lester, *Plain Packaging and Protectionism: What is Free Trade?*, JURIST (Oct. 23, 2012, 5:00 PM) http://jurist.org/hotline/2012/10/simon-lester-plain-packaging.php, or the on-going WTO dispute between the US-Mexico regarding dolphin safe tuna labeling. Dispute Settlement, *United States—Measures Concerning the Importation, Marketing and Sale of Tuna and Tuna Products*, DS381 (Jan. 22, 2014), *available at* http://www.wto.org/english/tratop_e/dispu_e/cases_e/ds381_e.htm. The proposed Trans Pacific Partnership might also impose additional limitations on state health and welfare powers. *See* Press Release, Pub. Health Ass'n, Protecting the Health of Australians in the TPPA (Feb. 18, 2014) http://www.scoop.co.nz/stories/WO1402/S00215/protecting-the-health-of-australians-in-the-tppa.htm (discussing the potential impact in Australia).

7. *Medellin*, 552 U.S. at 504–05.

8. *Cf*. Sarah Binder, *Polarized We Govern?*, CTR. FOR EFFECTIVE PUB. MGMT. AT BROOKINGS, *available at* http://www.brookings.edu/research/papers/2014/05/27-polarized-we-govern-congress-legislative-gridlock-polarized-binder; *See* Kay King, *Congress and National Security*, COUNCIL ON FOREIGN RELATIONS (Nov. 2010), http://www.cfr.org/congresses-parliaments-national-legislatures/congress-national-security/p23359.

9. *See, e.g.*, Margot Kaminski, *The Origins And Potential Impact Of The Anti-Counterfeiting Trade Agreement (ACTA)*, 34 YALE J. INT'L L. 247 (2009); CCH International Encyclopedia of Laws, Cyber Law. 2013 WL 4301545 (C.C.H.); Meredith Kolsky Lewis, *The Trans-Pacific Partnership: New Paradigm Or Wolf In Sheep's Clothing?*, 34 B.C. INT'L & COMP. L. REV. 27 (2011); Wikipedia, *Trans Pacific Partnership*, http://en.wikipedia.org/wiki/Trans-Pacific_Partnership (Dec. 12, 2014).

principles of international law require states to develop their law in a manner consistent with US foreign policy. Part IV will discuss public policy reasons why a state should, if possible, develop state law in a manner consistent with the position of the United States in international forums. This Article concludes that if a judicially created federalism space in foreign relations is constructed in which Congress cannot act to enforce US foreign policy, the de facto motto will no longer be *e pluribus unum*—"out of many, one" from many one—but rather *e unum pluribus*—"out of one, many." This change would defeat the obligation and the intention of the founding fathers that the United States will speak in foreign lands with one voice.

II. *BOND V. UNITED STATES*

Through a convoluted series of cases and arguably a strategic error or concession by the United States, Carol Ann Bond was able to challenge her conviction under a federal law enforcing a chemical warfare treaty obligation on the grounds that such enforcement breached principles of federalism. Thus, this case clearly presented the scope of the treaty making power as opposed to the commerce clause power of Congress to enact legislation.

A. Bond v. United States (*Bond I*)

The United States alleged that Carol Ann Bond, a spurned wife, violated federal laws prohibiting chemical warfare by placing caustic substances (common chemical household cleaners) on surfaces that were likely to be touched by her husband's then-pregnant paramour and Bond's formerly close friend, Myrlinda Haynes.[10] Bond entered a conditional guilty plea for violating 18 U.S.C. § 229, essentially chemical warfare charges, and she reserved the right to challenge conviction contending that enacting § 229 was beyond Congress' constitutional powers under the Tenth Amendment.[11] Section 229 prohibits knowing possession or use of any chemical that "cause

10. Bond v. U.S (*Bond I*), 131 S. Ct. 2355, 2360 (2011)
11. *Id.* at 2360–61.

death, temporary incapacitation or permanent harm to humans or animals" if they are not used for "peaceful purposes."[12]

On appeal, the United States Court of Appeals for the Third Circuit dismissed Bond's appeal for lack of standing.[13] Bond filed a petition for writ of certiorari, the United States confessed error, and the United States conceded that Bond had standing to raise the constitutionality of § 229.[14] In *Bond I*, the United States Supreme Court in a virtually unanimous decision rejected dicta from *Tennessee Electric Power Co v. TVA* and subsequent case law in order to recognize that individuals may challenge federal laws based on a claim arising from the Tenth Amendment.[15] In particular, a unanimous Court stated in *Bond I* that "[w]hether the Tenth Amendment is regarded as simply a truism, or whether it has independent force of its own, the result here is the same."[16] A litigant is "not forbidden to object that her injury results from disregard of the federal structure of our Government."[17] Article III of the Constitution may require that standing to litigate some injuries caused by Congress exceeding its powers as circumscribed by the Tenth Amendment, may be limited to a state as a party. However, if there is a private injury caused by federal laws that conflict with the powers reserved either to the States or to the people for which a federal court may provide a remedy, then the injured party has standing to raise the issue before the courts. *Bond I* is significant because it sets a jurisprudential stage for private causes of action challenging federal laws under the Tenth Amendment.

B. United States v. Bond (*Bond II*)

At first blush, *Bond v. United States* (*Bond II*) is an unlikely case to change the ambit of the foreign relations powers of the federal

12. 18 USC § 229 (1998); *see also Bond I*, 131 S. Ct. at 2360.
13. *Bond*, 131 S. Ct. at 2361.
14. *Id.*
15. *Id.* at 2363, 2366 (where there were seven justices in the majority and two concurring).
16. *Id.* at 2367 (citation and internal quotation marks omitted). The concurring justices would have gone further in articulating a jurisprudence allowing individuals to assert defenses or challenges based on the constitutional rights of the States. *Id.* (Ginsburg, J. concurring).
17. *Id.* at 2366–67.

government.[18] However, the three concurring justices contend persuasively that the Constitution and principles of federalism require a greater deference to the States when Congress implements foreign policy in domestic legislation.[19] The *Bond II* Court was asked to consider "whether the Implementation Act also reaches a purely local crime . . . ."[20] Bond, an angry wife, tampered with the US mail and used commonly available household chemicals to cause a minor burned thumb on her estranged husband's paramour.[21] The state prosecutors declined to prosecute this rather pedestrian crime.[22] The Office of the United States Attorney took a different view and magnified the offense from simple assault and tampering with the US mails into the more grandiose and impressive federal charge of "possessing and using a chemical weapon in violation of [18 U.S.C. § 229(a)]."[23]

Bond II starkly presented the scope of Congress's domestic law making authority under the Treaty Clause because the United States waived its argument that 18 U.S.C. §229(a)(1) was a valid exercise of Congress's powers under the Commerce Clause.[24] The Third Circuit in affirming Bond's conviction relied on *Missouri v. Holland* which stated that "[i]f the treaty is valid there can be no dispute about the validity of the statute" that implements it "as a necessary and proper means to execute the powers of the Government[.]"[25] However, deftly, a majority of six justices avoided the constitutional question of whether Congress exceeded the scope of its power to enforce a treaty by limiting the resolution to solely one of statutory interpretation.[26]

18. *Bond II*, 134 S. Ct. at 2077.

19. *Id.* at 2094–2102 (Scalia, J., concurring); *Id.* at 2102–11 (Thomas, J. concurring); *Id.* at 2111 (Alito, J., concurring).

20. *Id.* at 2083. "Local" in this sense indicates non-commercial conduct that is not amenable to regulation under the Commerce Clause.

21. *Id.* at 2085, *see also Bond I*, 131 S. Ct. at 2360.

22. *Bond II*, 134 S. Ct. at 2092–93.

23. *Id.* at 2085–86. Grandiose because the use chemical weapons has arguably been a war crime since 1899. Hague Convention II with Respect to the Laws and Customs of War on Land and its Annex: Regulation concerning the Laws and Customs of War on Land: 29 July 1899, art. 23, 32 Stat. 1803, 1 Bevans 247, 26 Martens Nouveau Recueil (ser. 2) 949, 187 Consol. T.S. 429, entered into force Sept. 4, 1900.

24. *Bond II*, 134 S. Ct. at 2087.

25. *Id.* at 2086 (quoting Missouri v. Holland, 252 U.S. 416, 432 (1920)).

26. *Id.* at 2094. Justice Scalia scathingly dismissed this line of authority from *Holland*

Chief Justice Roberts, writing for the Court, held that Bond's conduct fell within the literal statutory contours of the offense of "possession and using a chemical weapon."[27] However, the scope of her activities, using common household chemicals that are legally available to cause a minor injury that did not require medical attention, was more correctly a state law crime.[28] Despite the clear language of the statute, however, the Court presumed under principles of federalism that Congress could not have intended to displace local police powers over such run of the mill criminal offenses without clearly so stating.[29] The Court held that "[a]bsent a clear statement of ['a serious reallocation of criminal law enforcement authority between the Federal Government and the States'], we will not presume Congress to have authorized such a stark intrusion into traditional state authority."[30] Finding nothing in the language of the act or in the legislative history (at least nothing the Court cited to) to indicate such a Congressional authorization, the Court held for Bond.[31] Thus narrowly construed, *Bond II* has little to teach us other than to reaffirm a long standing prudential doctrine that, in regulatory areas traditionally left to State police powers, any Congressional decision to legislate must be done using clear, explicit, and unambiguous language.[32]

However, *Bond II*'s references to federalism open the door to a broader understanding of State power. All of the justices agreed that if Congress desires to displace state police powers in areas that have been traditionally left to the States, Congress must do so unambiguously. The majority alluded to federalism constraints without addressing them, while the three concurring justices explicitly recognized that principles of federalism may constitute an independent constitutional limitation on the US ability to enter treaties that affect domestic law. The concurring opinions contended that federalism is an independent limitation on the president and

describing it as "[a]n unreasoned and citation-less sentence from our opinion." *Id.* at 2098.

27. *Id.* at 2090–91.
28. *Id.* at 2092–93
29. *Id.* at 2083.
30. *Id.* at 2093–94.
31. *Id*, at 2093–94.
32. *Id.* at 2089–90.

Congress's ability to prescribe the domestic effect of foreign relations law of the United States. In holding that the federal government was so limited, the concurring justices rejected almost two hundred years of common wisdom that Congress and the president possessed almost unfettered authority over the US foreign relations and the corresponding power to translate foreign policy into domestic law.[33]

The concurring justices agreed with the overall judgment of the Court but wrote separately, each contending that the statute was clear so that *Bond II* did not present a question of statutory interpretation and judicial presumptions. Rather, the concurring justices argued that the Court was required to face the difficult constitutional question of the scope of Congress's power to enact legislation supported by is treaty powers. The concurring justices framed the question before the Court as whether Congress, pursuant to its powers to make treaties, could validly criminalize purely local (i.e., non-commercial) conduct.

The three concurring justices concluded that the treaty powers under the Constitution did not permit the federal government to reach purely local conduct in areas that are traditionally occupied by the states.[34] Picturesquely, Justice Scalia quoting Federalist No. 48 wrote "The United States Congress—'every where [sic] extending the sphere of its activity, and drawing all power into its impetuous vortex.'"[35] The concurring opinions aimed to curtail the constitutional sweep of the vortex. However, rather than curtailing the threatened vortex, the Court may be setting the constitutional stage for unleashing the perfect storm. The concurring justices proposed limits on Congress's domestic constitutional authority in implementing foreign initiatives under the Treaty Clause and an increasingly narrow reading of the Commerce Clause may create an eye in the storm of competing constitutional and foreign policy interests. If *Bond* foreshadows a foreign policy space where Congress cannot act, then the states must by necessity of omission or commission become foreign policy actors that could further or frustrate a unified federal foreign policy agenda.

33. *Id.* at 2106–09 (Thomas, J., concurring in the judgment).
34. *Id.* at 2103 (Thomas, J., concurring in the judgment).
35. *Id.* at 2094 (Scalia, J., concurring in the judgment).

III. STATE LAW AS GAP FILLER

This Article will examine at three provisions of intellectual property law as a model to better understand the difficulties of using state law to satisfy federal treaty obligations by pulling examples from copyright, trademark, and trade secret law. First, it will analyze the protection of moral rights in the United States as an obligation under the Berne Convention; second, it will analyze the protection of well-known marks and trade secrets as an obligation under either the Paris Convention for the Protection of Industrial Property ("Paris Convention") or the Agreement on Trade Related Aspects of Intellectual Property ("TRIPS Agreement"). There are numerous law review articles hotly contesting whether the United States is in conformity with its international obligations and whether state law acts adequately as a gap filler for missing federal law in these three areas. This Article will not foray into this minefield of conflicting scholarship. Rather, it merely explores why state law may be necessary to fill in the gap of federal law in the context of moral rights, the protection of well-known marks, and trade secrets.

A. Copyright: Moral Rights

In member states, the Berne Convention protects the moral rights of the authors.[36] Article *6bis* provides that, for the life of the author plus 50 years, the author retains the right "to claim authorship of the work and to object to any distortion, mutilation or other modification of, or other derogatory action in relation to, the said work, which would be prejudicial to his honor or reputation"; even after the transfer of the author's economic rights.[37] Unlike economic rights, which are freely alienable, moral rights are inalienable rights under the Berne Convention.[38]

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36. Berne Convention for the Protection of Literary and Artistic Works, art. 6*bis*, Sept. 9, 1886, 828 U.N.T.S. 221 [hereinafter Berne Convention].

37. *Id.* Articles 8, 9, 11, 11*bis*, 11*ter*, and 12 of the Berne Convention define the author's economic rights. *Id.* at 239, 241–43.

38. *See* Aaron D. White, *The Copyright Tree: Using German Moral Rights as the Roots for Enhanced Authorship Protection in the United States*, 9 LOY. L. & TECH. ANN. 30 (2009–2010); *but see* DAVID NIMMER, NIMMER ON COPYRIGHT § 8D.01 [hereinafter NIMMER ON COPYRIGHT] (the Berne Convention "merely provides that the author's previous assignment of

As a member of the Berne Convention, the United States is required to protect the moral rights of authors of works protected in other Berne Convention countries. The Berne Convention is not a self-executing treaty.[39] Congress specifically provided in the copyright legislation implementing the Berne Convention that "No right or interest in a work eligible for protection under this title may be claimed by virtue of, or in reliance upon, the provisions of the Berne Convention, or the adherence of the United States thereto."[40] Even beyond its inability to support an independent cause of action, the Berne Convention may not be used by courts or arguably state legislatures when interpreting copyright laws or in drafting state law.[41] "Any rights in a work eligible for protection under this title that derive from this title, other Federal or State statutes, or the common law, shall not be expanded or reduced by virtue of, or in reliance upon, the provisions of the Berne Convention, or the adherence of the United States thereto."[42] Arguably, it is not clear if this congressional command is a mandatory cannon of interpretation to guide the courts or if it also includes the state legislatures.

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economic rights does not derogate from subsequent assertion of the attribution and integrity rights; but following transfer of moral rights, nothing in the Berne Convention requires that those rights must nonetheless rest inalienably with their authors.").

39. *See* Carter v. Helmsley-Spear, Inc., 71 F.3d 77, 83 (2d Cir. 1995); 17 U.S.C. § 104(c) (2002).

40. 17 U.S.C. § 104(c).

41. *Cf.* Elizabeth Bulat Turner, *The Relevancy of Foreign Law as Persuasive Authority and Congress's Response to Its Use: A Preemptive Attack on the Constitution Restoration Act*, 23 GA. ST. U. L. REV. 455 (2006) (discussing Congress's attempts to ban the use of foreign law and questioning their constitutionality).

42. 17 U.S.C. § 104(c). Independently, the TRIPS Agreement incorporates many of the articles of the Berne Convention as separate obligations of WTO member states; however, at the strenuous urging of the United States Article 6bis of the Berne Convention was not included in TRIPS as an obligation on WTO member states. Agreement on Trade-Related Aspects of Intellectual Property Rights, art. 9(1), Apr. 15, 1994, 1869 U.N.T.S. 299. 7 WILLIAM F. PATRY, PATRY ON COPYRIGHT § 23:62. So, there is no effective sanction on a member state for failing to comply with the treaty obligations of the Berne Convention thus making the Berne Convention a toothless tiger obligation. *See*, HOWARD B. ABRAMS, ELDRED, GOLAN, AND THEIR AFTERMATH, 60 J. COPYRIGHT SOC'Y U.S.A. 491, 510 (2013) ("[the] Berne Convention did provide that disputes "between two or more countries of the Union . . . may . . . be brought before the International Court of Justice," but this had no real effect as the Court had no real power.").

Whether the United States is in compliance with its obligations under 6*bis* of the Berne Convention is a hotly contested issue. One leading treatise author observed:

> The obligation of the United States to provide *droit moral* and the extent to which U.S. law, at the time of our adherence to the Berne Convention (1989), already satisfied the minimum requirements of Article 6*bis* were the single most contentious issues surrounding adherence. Given the opposition of key copyright industries to *droit moral*, adherence to the Berne Convention would not have occurred had the United States complied with Article 6. The solution, which had the blessing of the Director-General of the World Intellectual Property Organization (WIPO), Dr. Arpad Bogsch, was to create a web of fictional compliance: the existing combination of federal and state laws were deemed to satisfy the minimum Berne obligations.[43]

Another leading commentator concluded, "state or common law is more likely to implement Article 6*bis* of the [Berne] Convention than any other feature of Berne . . . ."[44] Similarly, all three authors of the leading copyright treatises agree that state law is necessary to bring the United States into even colorable conformity with its Article 6*bis* obligation to protect moral rights.

The need for state law to fill the gap left by federal disinterest in enforcing Article 6*bis* has been noted by the federal courts. The Seventh Circuit has observed, "Congress initially took the position that domestic law already captured the concept in existing copyright and common-law doctrines and in the statutory law of some states,"[45] and one district court judge wrote "[i]t is far from clear exactly how the language of Article 6*bis* is achieved under the United States' intellectual property laws."[46]

The need for state action is felt more strongly after the United States Supreme Court, in *Dastar Corp. v. Twentieth Century Fox*

43. PATRY, *supra* note 42, § 16.3.
44. 3-8D NIMMER ON COPYRIGHT § 8D.02[B]
45. *See* Kelley v. Chicago Park Dist., 635 F.3d 290, 297 (7th Cir. 2011).
46. Brainard v. Vassar, 561 F. Supp. 2d 922, 935 n.7 (M.D. Tenn. 2008).

Film Corp., invalidated both the Lanham Trademark Act § 43(a), prohibiting unfair competition—one of the pillars of US protection of moral rights—and analogous state law provisions as a "misuse or over-extension of trademark and related protections into areas traditionally occupied by patent or copyright."[47]

If Congress does intend to rely on state law to fill the gap, then it is potentially inviting the states to play a perhaps unwelcome role in the foreign relations of the United States. The principles of state law that create penumbras that protect the moral rights of authors include: defamation, invasion of privacy, breach of contract, and certain state statutes.[48] Any right that depends on the laws of individual states presents the prospect of the United States failing to meet its treaty obligation in at least one or more states.[49] The Constitution and case law is clear, however; in matters of foreign policy, the United States speaks with one voice, there is only one foreign relations law of the United States, and that single law governs all individual states.[50] Congress is free to implement its foreign policy obligations compelling states to pass treaty compliance laws, by incorporating into a treaty specific provisions that recognize that state law will be used to meet federal obligations or by ratifying the treaty with specific reservations.[51] However, at least in the intellectual property law context, Congress has failed to act.

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47. 539 U.S. 23, 34, 37 (2003) (citations and internal quotation marks omitted); Compare Dastar Corp., 539 U.S. 34, 37 with Gilliam v. American Broadcasting Co., 538 F.2d 14, 24 (2d Cir. 1976) (recognizing Lanham Act § 43(a) to create a cause of action for distorting a copyrighted work as an actionable misrepresentation).

48. *See* NIMMER ON COPYRIGHT, *supra* note 44, § 8D.02[A]; *see also* Nimmer, *supra* note 38, § 8D.02[D][1] ("Inasmuch as a large part of the moral rights protection canvassed in the sections that follow arises out of doctrines of state law, it is relevant to note that in adverting to U.S. domestic law, Congress intended to include both statutory and common law, at both the federal and state levels.").

49. *See* JULIAN KU & JOHN YOO, TAMING GLOBALIZATION: INTERNATIONAL LAW, THE U.S. CONSTITUTION, AND THE NEW WORLD ORDER 160–62 (Michael O'Malley & Kevin Pendergast eds., 2012).

50. *See* Container Corp. of Am. v. Franchise Tax Bd., 463 U.S. 159, 194 (1983); *see also* Japan Line, Ltd. v. Cnty. of Los Angeles, 441 U.S. 434, 448–49. The concept of one voice has recently been subject to severe academic criticism. *See* Sarah H. Cleveland, *Crosby And The 'One-Voice' Myth In U.S. Foreign Relations,* 46 VILL. L. REV. 975, 975 (2001); *see also* KU & YOO, *supra* note 49, at 162–68.

51. Julian G. Ku, *The Crucial Role of the States and Private International Law Treaties; A Model for Accommodating Globalism,* 73 MO. L. REV. 1063, 1066, 1066–67 (2008)

B. Trademark: Well-Known Marks

The United States is obligated to protect "well-known marks" under either 6*bis* of the Paris Convention or Article 16(2) of the TRIPS Agreement.[52] However, there is no generally accepted definition of what constitutes a well-known mark.[53] WIPO recommends considering the following factors:

> the degree of knowledge or recognition of the mark in the relevant sector of the public; the duration, extent and geographical area of any use of the mark; the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies; the duration and geographical area of any registrations, and/or any applications for registration, of the mark, to the extent that they reflect use or recognition of the mark; the record of successful enforcement of rights in the mark, in particular, the extent to which the mark was

(discussing treating with specific provisions for provincial or state enforcement).

52. Andrew Cook, *Do As We Say, Not As We Do: A Study Of The Well-Known Marks Doctrine In The United States*, 8 J. MARSHALL REV. INTELL. PROP. L. 412, 412–13 n.4 (2009) (citing Paris Convention 6bis, TRIPS Agreement Art 16, and NAFTA Art. 1708(6)).

53. *See Well-known Marks*, WORLD INTELLECTUAL PROPERTY ORGANIZATION, *available at* http://www.wipo.int/sme/en/ip_business/marks/well_known_marks.htm. The USPTO uses the "likelihood of consumer confusion" test to determine whether a mark is well known. This test considers (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression; (2) the similarity or dissimilarity and nature of the goods . . . described in an application or registration or in connection with which a prior mark is in use; (3) the similarity or dissimilarity of established, likely-to-continue trade channels; (4) the conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing; (5) the fame of the prior mark.; (6) the number and nature of similar marks in use on similar goods; (7) the nature and extent of any actual confusion; (8) the length of time during and the conditions under which there has been concurrent use without evidence of actual confusion; (9) the variety of goods on which a mark is or is not used; (10) the market interface between the applicant and the owner of a prior mark; (11) the extent to which applicant has a right to exclude others from use of its mark on its goods; (12) the extent of potential confusion; and (13) any other established fact probative of the effect of use. *See Office of Policy and External Affairs: Well-known Marks*, THE UNITED STATES PATENT AND TRADEMARK OFFICE (Feb. 20, 2013, 10:37 AM), http://www.uspto.gov/ip/global/trademarks/ir_tm_marks.jsp ("There is no separate analysis apart from likelihood of confusion or deceptiveness, as to whether a mark is well-known or not.").

recognized as well known by competent authorities; the value associated with the mark.[54]

Well-known marks although undefined by specific language in a treaty or statute are a species of intellectual property that is entitled to protection under US law.[55] However, neither the Paris Convention nor the TRIPS Agreement is a self-executing treaty, and Congress has not amended the Lanham Trademark Act to add express language in order to protect well-known trademarks without prior trademark use in commerce in the United States.[56]

Perhaps, Congress believes that it does not have to change the Lanham Trademark Act. The United States Patent and Trademark Office (USPTO) has stated its position that unregistered, international, well-known marks are protectable under §§ 43(a), 44(b), and 44(h) of the Lanham Trademark Act.[57] Section 43(a) can be read as a broad protection against the use of an unregistered, international, well-known mark in the United States even absent bona fide domestic use in US commerce by the global senior mark holder.[58] Section 43(a) does not require that international mark holders use the marks in commerce in the United States; it merely requires that alleged infringers use the mark in commerce.[59] However, existing case law rejects the USPTO's understanding of the Lanham Trademark Act. Courts have uniformly read into § 43(a) a requirement that the party claiming to have senior user rights in the

54. *See Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks*, WORLD INTELLECTUAL PROPERTY ORGANIZATION, http://www.wipo.int/export/sites/www/freepublications/en/marks/833/pub833.pdf (original formatting omitted).

55. *See* Grupo Gigante S.A. De C.V. v. Dallo & Co., 391 F.3d 1088, 1099 (9th Cir. 2004).

56. *See* 5 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §§ 29:61, 29:4 (4th ed.).

57. *Office of Policy and External Affairs: Well-known Marks*, THE UNITED STATES PATENT AND TRADEMARK OFFICE, *available at* http://www.uspto.gov/ip/global/trademarks/ir_tm_ marks.jsp; *see* Lee Ann W. Lockridge, *Honoring International Obligations In U.S. Trademark Law: How The Lanham Act Protects Well-Known Foreign Marks (And Why The Second Circuit Was Wrong)*, 84 ST. JOHN'S L. REV. 1347, 1359–60 (2010); Anne Gilson LaLonde, *Don't I Know You From Somewhere? Protection in the United States of Foreign Trademarks that Are Well Known But Not Used There*, 98 TRADEMARK REP. 1379, 1400–03 (2008).

58. Lockridge, *supra* note 57, at 1358, 1379–91; Lanham Act § 43(a). "Global senior mark holder" is defined as the first to use the mark globally.

59. LaLonde, *supra* note 57, at 1398.

mark to have actually used it in domestic US commerce.[60] The judicial gloss exists despite a cannon of statutory interpretation that "an act of Congress ought never to be construed to violate the law of nations if any other possible construction remains . . . ."[61]

Section 44(h) provides the holders of foreign trademarks "effective protection against unfair competition" such that, when interpreted in light of §44(b)'s capacious language,

> [a]ny person whose country of origin is a party to any convention or treaty relating to trademarks . . . or the repression of unfair competition, to which the United States is also a party . . . shall be entitled to the benefits of this section under the conditions expressed herein to the extent necessary to give effect to any provision of such convention, treaty. . . .[62]

According to this language, § 44(b) provides a statutory basis on which to claim that the United States protects well-known marks that have not yet been used within the United States—albeit one that the US courts have consistently rejected.

Recently, two US circuit courts of appeals have determined that the Paris Convention and the TRIPS Agreement are not self-executing treaties, and one court read the Lanham Trademark Act § 44 very narrowly to deny federal protection for unregistered, international, well-known marks.[63] The Ninth Circuit in *Grupo Gigante S.A. De C.V. v. Dallos & Co.*—an opinion that was strong on cogent policy and devoid of statutory analysis based in the Lanham Trademark Act—held that foreign well-known marks were protected in the United States by the Lanham Trademark Act.[64] Three years

60. *Id.* at 1399 (for several cases that discuss this judicially-created requirement, see 1399 n.84).

61. Murray v. Schooner Charming Betsy, 6 U.S. 64, 118 (1804).

62. *See* LaLonde, *supra* note 47, at 1399–1402; Lanham Act § 44(b), (h).

63. *See* ITC Ltd v. Punchgini, Inc., 482 F.3d 135, 161–64 (2d Cir. 2007), *cert. denied*, 552 U.S. 827 (2007).

64. *See generally Grupo Gigante S.A. De C.V. v. Dallos & Co.*, 891 F.3d 1088 (9th Cir. 2004). Just slightly tongue in cheek: it is possible, as individuals in the United States are citizens of both the United States and of an individual states, that a foreign government may use inconsistent state laws to grant citizens of the United States different rights depending on their state citizenship. *Cf.* CHAD P. BOWN AND JOOST PAUWELYN, THE LAW, ECONOMICS AND POLITICS OF RETALIATION IN WTO DISPUTE SETTLEMENT 75 (Cambridge Univ. Press 2010);

later, the Second Circuit in *ITC Ltd. v. Punchgini, Inc.* rejected the holding of the Ninth Circuit and invited Congress to amend the Lanham Trademark Act to protect foreign well-known marks.[65] The Supreme Court denied a petition for a writ of certiorari to resolve the circuit split.[66]

In both cases, state law played an interesting role as an adjunct to § 44. The Ninth Circuit found that well-known marks are not independently protectable under California trademark or unfair competition law.[67] In contrast, the Second Circuit found that New York state common law potentially protected well-known marks and certified the question to the New York Court of Appeals, which answered in the affirmative.[68] These cases show that foreign holders of well-known trademarks may be subject to inconsistent bodies of law depending on the circuit or state in which they choose to litigate. Furthermore, even within the Second Circuit, the rights of the senior foreign well-known trademark holder will depend on the law of the states.[69] This resulting conflict between circuits also frustrates the constitutional obligation that the United States speaks with one voice on matters relating to foreign relations and the expectations of its fellow sovereigns that they will enter into domestically enforceable treaties with the United States.[70]

OONA ANNE HATHAWAY AND HAROLD HONGJU KOH, FOUNDATIONS OF INTERNATIONAL LAW AND POLITICS 297 (Foundation Press 2005).

65. 482 F.3d at 165.

66. *See Punchgini, Inc.*, 552 U.S. at 827.

67. *See Dallos & Co.*, 391 F.3d at 1100–01.

68. ITC Ltd. v. Punchgini, Inc., 880 N.E.2d 852, 854, 859 (N.Y. 2007).

69. In *ITC Ltd. v. Punchgini, Inc.*, the federal court sat in diversity jurisdiction regarding the protection of an unused, well-known mark under New York state law. *See* 482 F.3d at 142 n.3. The court could have as easily applied the law of any other state or determined that New York's choice of law or conflict of laws scheme required the application of the law of a state other than New York to the dispute. *See* Klaxon Co. v. Stentor Elec. Mfg. Co., 313 U.S. 487, 496–97 (1941).

70. *See* United States v. Curtiss-Wright Export Corp., 299 U.S. 304, 316–17 (1936); *see also* THE FEDERALIST NO. 3 (John Jay), NO. 42 (James Madison), NO. 80 (Alexander Hamilton).

C. Unfair Competition: Trade Secret

The United States has entered into several treaties that obligate it to protect trade secrets.[71] Yet, no civil, federal trade secret law exists in the United States.[72] The United States relies on the laws of individual states that protect trade secrets to meet its treaty obligations.[73] The extent of trade secret protection required under the Paris Convention and TRIPS is unclear.[74]

1. Trade Secret (Restatement of Torts)

Trade secret law is largely an outgrowth of state common law protections against misappropriation and unfair business practices.[75] Although the majority of states have adopted the Uniform Trade Secret Act,[76] one commercially significant state with a strong international trade sector—New York—still relies on the Restatement (First) of Torts § 757 as an articulation of state common law.[77]

71. *See, e.g.*, TRIPS Article 39. The Paris Convention does not affirmatively require its members to protect trade secrets. It does however require signatories to protect against unfair competition. *See* Paris Convention for the Protection of Industrial Property art. 10*bis*, March 20, 1883, 25 Stat. 1372, as revised at Stockholm on July 14, 1967, 21 U.S.T. 1583, 828 U.N.T.S. 305 ("Paris Convention"). Article 10*bis* has been interpreted as requiring trade secret protection. *See* Doris Estelle Long, *The Protection of Information Technology in a Culturally Diverse Marketplace*, 15 J. MARSHALL J. COMPUTER & INFO. L. 129, 137 n. 23 (1996).

72. *See* Christopher Rebel J. Pace, *The Case for A Federal Trade Secrets Act*, 8 HARV. J.L. & TECH. 427, 442 (1995); JAMES POOLEY, CORP COUNSEL GUIDE TO PROTECTING TRADE SECRETS § 10:2 (Nov. 2011). There is however a federal unfair competition act; *see, e.g.*, Lanham Act § 43(a), and the International Trade Commission (ITC), can prohibit the importation of goods when it finds unfair competition under 19 U.S.C. § 1337. TianRui Group Co. Ltd. v. Int'l Trade Comm'n, 661 F.3d 1322, 1326 (Fed. Cir. 2011). Whether § 43(a) is coextensive with the United States' obligations under the Paris Convention or other treaties is an open question. *See ITC Ltd*., 482 F.3d at 161–65; *see generally* Lockridge, *supra* note 57. However, this article does not endeavor to opine on this question.

73. *See generally* Pace, *supra* note 72.

74. *See* Christopher G. Blood, *Holding Foreign Nations Civilly Accountable For Their Economic Espionage Practices*, 42 IDEA 227, 234 (2002).

75. *See* 1 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 1:8 (4th ed. 2014).

76. *See infra* Part III.C.2 (explaining UTSA).

77. *See* Big Vision Private Ltd. v. E.I. DuPont De Nemours & Co., 1 F. Supp. 3d 224, 257 (S.D.N.Y. 2014) (finding that a "trade secret is 'any formula, pattern, device or compilation of information which is used in one's business, and which gives [the owner] an opportunity to obtain an advantage over competitors who do not know or use it.'" (quoting Softel, Inc. v.

Consequently, it is worthwhile to discuss whether § 757 of the Restatement is fully compliant with TRIPS.

Under § 757 of the Restatement of Torts, "A trade secret may consist of any formula, pattern, device or compilation of information which is *used in one's business*, and which gives him an opportunity to obtain an advantage over competitors who do not know or use it."[78] Under the TRIPS Agreement Article 39.2, a trade secret:

a) is secret in the sense that it is not, as a body or in the precise configuration and assembly of its components, generally known among or readily accessible to persons within the circles that normally deal with the kind of information in question;

b) has commercial value because it is secret; and

c) has been subject to reasonable steps under the circumstances, by the person lawfully in control of the information, to keep it secret.[79]

TRIPS Art. 39.2 unlike the §757 of the Restatement, does require that the trade secret be used in the owner's business.[80] To the degree that any state legislature or court requires that a trade secret be used in the trade secret holder's business to receive protection against misappropriation, that state is imposing an additional obligation that is inconsistent with the minimum obligations of the United States under TRIPS article 39.2.[81]

Dragon Med. & Scientific Comms., Inc., 118 F.3d 955, 968 (2d Cir. 1997) (quoting RESTATEMENT (FIRST) OF TORTS § 757 cmt. b (1939)).

78. RESTATEMENT (FIRST) OF TORTS § 757 (2014) (emphasis added).

79. Agreement on Trade-Related Aspects of Intellectual Property Rights, Including Trade in Counterfeit Goods: General Agreement on Tariffs and Trade-Multilateral Trade Negotiations (The Uruguay Round), 33 I.L.M. 81 (Dec. 15, 1993), *available at* http://www.wto.int/english/docs_e/legal_e/27-trips.pdf [hereinafter TRIPS Agreement].

80. *Compare* NAFTA art. 1711(1), *and* TRIPS art. 39.2, *with* RESTATEMENT (FIRST) OF TORTS § 757 (2014).

81. *See* Pace, *supra* note 72, at 453–54.

2. Uniform Trade Secret Act

The Uniform Trade Secret Act (UTSA) has been adopted by almost of all the states in the United States, but to call the UTSA "uniform" is a misnomer.[82] Some states have enacted non-uniform versions of the UTSA,[83] and state courts have interpreted the UTSA in a non-uniform matter.[84] Finally, the federal courts sitting in their diversity jurisdiction have added further layers of complexity to trade secret law.[85] The UTSA defines a trade secret as:

> information, including a formula, pattern, compilation, program, device, method, technique, or process, that:
>
> (i) derives independent economic value, actual or potential, from not being generally known to, and not being readily ascertainable by proper means by, other persons who can obtain economic value from its disclosure or use,[86] and
>
> (ii) is the subject of efforts that are reasonable under the circumstances to maintain its secrecy.[87]

The USTA § 1 standard appears to be consistent with minimum treaty obligations and the right of the United States under TRIPS or NAFTA to choose how to implement its treaty obligations through domestic legislation.

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82. The major holdout states are New York, North Carolina, and Massachusetts. *Trade Secrets Act*, NAT'L CONFERENCE OF COMM'RS ON UNIFORM STATE LAWS, *available at* http://www.uniformlaws.org/LegislativeFactSheet.aspx?title=Trade%20Secrets%20Act (last visited Sept. 26, 2014).

83. *See* 3 MELVIN F. JAGER, TRADE SECRETS LAW Appendix A2 (Apr. 2014).

84. *Id.*

85. *See generally* David S. Almeling et al., *A Statistical Analysis of Trade Secret Litigation In Federal Courts*, 45 GONZ. L. REV. 291 (2009–10).

86. Several states have deleted "not being readily ascertainable by proper means" from their enactments. *See* Richard F. Dole Jr., *The Uniform Trade Secrets Act-Trends And Prospects*, 33 HAMLINE L. REV. 409, 418 (2010) (for example, California, Illinois, and Oregon have deleted the "not readily ascertainable by proper means" element).

87. UNIF. TRADE SECRETS ACT WITH 1985 AMENDMENTS § 1(4) (Nat'l Conference of Comm'rs on Uniform State Laws 1985), *available at* http://www.uniformlaws.org/shared/docs/trade%20secrets/utsa_final_85.pdf; 2 MELVIN F. JAGER, TRADE SECRETS LAW § 61:4 (April 2014). "The Uniform Act definition [of a trade secret] is thus considerably broader than that of Section 757 of the original Restatement of Torts . . ." JAMES POOLEY, TRADE SECRETS, § 2.03[2][A] (2009).

The UTSA only imposes liability on third parties when they knew or should have known that the trade secret was acquired by an improper means,[88] and at least one state (Iowa) requires that the third party have actual knowledge of the misappropriation.[89] The standard for imposing third-party liability under the TRIPS Agreement is much lower than that under the UTSA.[90] Even if one can interpret the USTA's higher mens rea standard as congruent with the TRIPS floor for minimum national trade secret protection, at least the law of one state is clearly outside the range of permissible interpretations of TRIPS requirements. Therefore, even with state law as a gap-filler, it is questionable whether the United States meets its international obligations to protect trade secrets.

3. Proposed Civil Federal Trade Secret Protection

In light of the perceived domestic demand for additional trade secret protection for US companies, Congress has considered whether to adopt a federal trade secret law on numerous occasions. There does not appear to be any attempt to displace or preempt state trade secret law by Congress. The proposed Protecting American Trade Secrets and Innovation Act of 2012 (PATSIA) was designed to provide federal court civil jurisdictions serious trade secret misappropriation suits. Generally, these would be trade secret misappropriation cases of such magnitude (or international commercial significance) that effective litigation would demand nationwide service of process or which involved the misappropriation of US trade secrets to a foreign country.[91] Because of the narrow jurisdictional limits in the act, it is reasonable to infer that the United States will still have to rely on

88. The UTSA only protects against third-party use and disclosure if "at the time of disclosure or use, [that person] knew or had reason to know that [the] knowledge of the trade secret was (I) derived from or through a person who had utilized improper means to acquire it; (II) acquired under circumstances giving rise to a duty to maintain its secrecy or limit its use; or (III) derived from or through a person who owed a duty to the person seeking relief to maintain its secrecy or limit its use[.]" *Uniform Trade Secrets Act*, §1 (definition of misappropriation).

89. IOWA CODE ANN. § 550.2(3) (West 1991); *see also* 6 MATTHEW G. DORE, IOWA PRACTICE SERIES, BUSINESS ORGANIZATIONS § 38:9 (2013).

90. *See* Pace, *supra* note 72, at 451–53.

91. Protecting American Trade Secrets and Innovation Act of 2012, S. 3389, 112th Cong. (2012) (proposing to amend 18 U.S.C. § 1836 (a)(2)(B)); *see also* 158 CONG. REC. S5086-101 (daily ed. July 17, 2012).

state trade secret law as a gap filler in the vast majority of trade secret misappropriation actions to meet its international obligations. Furthermore, even in those trade secret misappropriation cases that will fall under the proposed Act, as written, the bill is still inconsistent with the international obligations of the United States to protect trade secrets.

PATSIA would incorporate misappropriation either under state trade secret law or under 18 U.S.C. §§ 1831 or 1832 for federal misappropriation of trade secrets.[92] The language of the bill as structured, using a disjunctive "or" as a connector, appears to provide three separate and independent grounds on which to bring a trade secret misappropriation claim. This section will explore the possibilities for civil trade secret protection under PATSIA. Though the original Act failed, it was slightly modified and reintroduced in 2014, and it provides a convenient model to understand recent federal attempts to civilly protect trade secrets.

a. State Misappropriation Based Federal Court Jurisdiction

PATSIA provides that the owner of a trade secret may bring an action in federal court under the Act for "a misappropriation of a trade secret that is related to or included in a product that is produced for or placed in interstate commerce or foreign commerce."[93] This Article already discussed the manifold problems of using state trade secret law as a basis to provide a uniform level of protection that meets US treaty obligations.[94] PATSIA merely places a thin shellacking of federal protection for trade secret rights on top of this state law foundation by providing another independent jurisdictional basis on which federal courts may adjudicate these disputes.[95] One may speculate that PATSIA as envisioned by its proponents held more promise than deliverable reality, if enacted, in providing effective federal trade secret protection. Under their diversity jurisdiction, federal courts already hear state law-based trade secret

92. Protecting American Trade Secrets and Innovation Act of 2012 § 2(a)(1).
93. *Id.* § 2(a)(1)(B).
94. *See supra* Part III.C.1–2.
95. *See Text of the Protecting American Trade Secrets and Innovation Act*, GovTrack.us, *available at* https://www.govtrack.us/congress/bills/112/s3389/text

misappropriation cases on a regular basis.[96] And, if the Act is limited to "the most serious cases" as claimed by its proponents, then PATSIA should be limited to cases that would also meet the amount in controversy and other requirements for federal court diversity jurisdiction.[97]

Furthermore, to the degree that the basis of these civil suits rests on state law, the proposed Act was not a step forward in achieving national uniformity for the protection of trade secrets.[98] National uniformity requires a national law that preempts state laws that are inconsistent with the national policies of the United States.[99] PATSIA failed to achieve a national uniform trade secret law, insofar as it permitted state law-based trade secret misappropriation and merely provided an alternative jurisdictional basis on which the federal courts may hear trade secret cases without establishing a national floor of substantive protection.

b. Federal Trade Secret Law (18 USC § 1831 & 18 USC § 1831)

Federal law criminalizes the theft of trade secrets and the receipt of stolen trade secrets. Currently, however, there are no federal civil trade secret causes of action. One of the seminal features of criminal federal trade secret theft protection is its reliance on state law to create and enforce federal interests—and, arguably treaty interests—in protecting trade secrets.

96. For example, the search "trade +3 secret /p diversity-jurisdiction" in the Westlaw allfeds database resulted in 199 documents. The slightly broader search "trade +3 secret /p jurisdiction" in all feds resulted in 2215 documents, roughly one-third of the results of running the same query in allstates (8381 documents).

97. 158 CONG. REC. S5086-101 (daily ed. July 17, 2012).

98. *See, e.g.*, S. 3389, 112th Cong. § 2(d) (2012), expressly incorporating 18 U.S.C. § 1838 (1996) ("This chapter shall not be construed to preempt or displace any other remedies, whether civil or criminal, provided by United States Federal, State, commonwealth, possession, or territory law for the misappropriation of a trade secret . . . ."); Pace, *supra* note 72, at 467–68 (discussing the need for federal preemption of state trade secret laws).

99. One tack that Congress could adopt would be to enact trade secret legislation following a model based on Electronic Signatures in Global and National Commerce Act (ESIGN. See 15 U.S.C. 7002(a). ESIGN preempts state law, except in states that adopt a uniform version of the Uniform Electronic Transactions Act (UETA). *Id.* Similarly, Congress could craft a federal trade secret law that would only preempt non-uniform state adoptions of the Uniform Trade Secret Act. *Id.*

The Economic Espionage Act (EEA) already criminalizes the theft of, the attempt to steal, or a conspiracy to steal trade secrets.[100] The federal definition of a trade secret parallels the UTSA definition.[101] Section 1831(a) prohibits the knowing theft of trade secrets to benefit a foreign government or entity, and § 1832(a) prohibits the knowing theft of a trade secret for a product that is produced or placed in interstate or foreign commerce and knowing that the "offense will, injure any owner of that trade secret."[102]

Unlike state law civil trade secret misappropriation under the Restatement § 757 or the UTSA, federal law narrowly defines what constitutes criminal misappropriation: misappropriation is committed when the defendant "steals, or without authorization appropriates, takes, carries away, or conceals, or by fraud, artifice, or deception obtains a trade secret."[103] So, acts like legally flying over a competitor's construction site to obtain a trade secret would arguably not be a criminal act of misappropriating a trade secret. However, in a civil trade secret misappropriation case decided according to Restatement § 757, *E. I. duPont deNemours & Co. v. Christopher*, the Fifth Circuit broadly interpreted the Restatement element "improper means" in order to prohibit such skullduggery.[104] The court robustly defined the term "improper means" and, while it declined to define improper means in all its possible permutations, the *Christopher* court did hold that the term included **"**appropriat[ing]

100. *See* 18 U.S.C. § 1831(a) (2013).

101. *Compare* 18 U.S.C. § 1839(3) (1996), *with* UNIF. TRADE SECRETS ACT WITH 1985 AMENDMENTS § 1(4) (Nat'l Conference of Comm'rs on Uniform State Laws 1985); *see also* United States v. Chung, 659 F.3d 815, 824–25 (9th Cir. 2011) (noting semantic differences between the two definitions). Federal courts look to state UTSA cases to interpret the federal definition. *Chung*, 659 F.3d at 825.

102. *See* 18 U.S.C. § 1832(a) (2012). The EEA appears to be severely underutilized by prosecutors, if the theft of trade is as widespread as is claimed. Although the EEA is over fifteen years old, the author was only able to locate forty cases on Westlaw involving the EEA.

103. §§ 1831(a)(1), 1832(a)(1); *see also* UNIF. TRADE SECRETS ACT WITH 1985 AMENDMENTS § 1 (Nat'l Conference of Comm'rs on Uniform State Laws 1985).

104. *See* E.I. DuPont deNemours & Co. v. Christopher, 431 F.2d 1012, 1016 (5th Cir. 1970). In this case, Christopher flew over a duPont factory and took aerial photographs for an unnamed client. All prior Texas cases involving misappropriation of trade secrets included either a criminal law violation or a tort as part of the act of misappropriation. Here, the act of flying over the unfinished act was arguably legal, as was the taking of the photographs. *Id.* at 1014.

a trade secret through deviousness under circumstances in which countervailing defenses are not reasonably available."[105]

This new commandment of trade secret law could be operationalized as an application of *United States v. Carroll Towing Co*.[106] The *Carroll Towing Co.* court articulated the formula PL>B where B is the cost precautions, L is the amount of loss, and P is the probability of loss (L).[107] The product of P x L must be a greater amount than B to create a duty of due care for the defendant.[108] Similarly, the court in *Christopher* held that "[c]ommercial privacy must be protected from espionage which could not have been reasonably anticipated or prevented."[109] Thus, the court in *Christopher* implicitly balanced the reasonable costs of protecting a trade secret against foreseeable disclosure and the value of the trade secret, and held "[t]o require DuPont to put a roof over the unfinished plant to guard its secret would impose an enormous expense to prevent nothing more than a school boy's trick."[110]

In addition to prohibiting the theft of a trade secret, federal criminal trade secret law also prohibits the knowing receipt of a misappropriated trade secret.[111] Under this provision, arguably, the Christopher's are not criminally liable for stealing a trade secret (under the EAA) by flying over the factory. The Christopher's client, however, may be liable for receiving a civilly misappropriated trade secret.[112] As the EEA is a criminal act, it provides for no private cause of action or remedy for the aggrieved trade secret holder,[113] and of course, the government's burden for proving such a criminal act is

105. *Id.* at 1017.

106. *See* United States v. Carroll Towing Co. 159 F.2d 169 (2d Cir. 1947)

107. *Id.* at 173.

108. *Id.*

109. *Christopher*, 431 F.2d at 1016; *see also* Rockwell Graphic Sys., Inc. v. DEV Indus., 925 F2d 174, 180 (7th Cir. 1991).

110. *Christopher*, 431 F.2d at 1017.

111. *See* § 1831(a)(3) ("receives, buys, or possesses a trade secret, knowing the same to have been stolen or appropriated, obtained, or converted without authorization"); § 1832(a)(3) (same).

112. *Cf.* United States v. Yang, 281 F.3d 534, 543 (6th Cir. 2002) ("legal impossibility is not a defense to prosecution under § 1832(a)(4) and(5)"); United States v. Case, 656 F. Supp. 2d 603, 614 (S.D. Miss. 2009).

113. 158 CONG. REC. S5086-101 (daily ed. July 17, 2012).

"beyond a reasonable doubt."[114] Consequently, the EEA is not consistent with either the TRIPS floor for trade secret protection because the EEA lacks a private cause of action, narrowly defines criminal theft of a trade secret, and requires government prosecution to satisfy a high burden of proof. Furthermore, because federal courts have to look to state law in applying the EAA, trade secret holders again face the real possibility of inconsistency in the substance and application of state trade secret law.

IV. MATERIAL BREACH OF TREATY AND THE LAWS OF 50 STATES PLUS

The United States' compliance with its treaty obligations could be measured substantively or qualitatively. Substantively, the United States has breached its treaty obligations when the laws of an economically significant state or group of states no longer sufficiently protect an interest protected by a treaty to which the United States is a member. For instance, if the state laws of California, New York, or Texas provide inadequate protection for intellectual property rights, then the United States provides inadequate protection. Compliance could also be measured qualitatively, such that if the United States signed a treaty as a single entity, it is required to assure that every portion of its sovereign territory is compliant with its international obligations. The United States is, at a minimum, composed of fifty states and the District of Columbia.[115] This number is expanded when one considers that the United States also administers sixteen territories as insular territories, such as American Samoa, Guam, Northern Mariana Islands, Puerto Rico, and the United States Virgin Islands.[116] The United States is also responsible for the foreign relations of these territories.[117]

114. *See* United States v. Hsu, 155 F.3d 189, 203 (3d Cir. 1998).

115. *See, e.g.*, 18 U.S.C. § 5; BLACK'S LAW DICTIONARY 1675 (9th ed. 2009) ("United States of America"). The term "United States" can vary in US law for different purposes. *See The US Code Defines the term "United States,"* FREEDOM SCHOOL, *available at* http://freedom-school.com/code-defines-united-states.pdf.

116. *See* U.S. DEPT. OF STATE, FOREIGN AFFAIRS MANUAL VOL. 7, HOW TERRITORIES AND POSSESSIONS WERE ACQUIRED, *available at* http://www.state.gov/documents/organization/86756.pdf.

117. U.S. GOV'T ACCOUNTABILITY OFFICE, GAO/OGC-98-5, U.S. INSULAR AREAS:

Through the Supremacy Clause, the Constitution empowers Congress to assure that the domestic implementation of the foreign relations laws of the United States is national, uniform, and comprehensive.[118] Despite this power, Congress has occasionally chosen to allow a patchwork of state laws to substitute for uniform national laws.[119] Generally, intellectual property law treaties leave their implementation to the discretion of the domestic law of each member state. Member states are free to implement the treaty in any manner they choose, as long as their domestic laws provide the appropriate level of protection.[120]

V. PREEMPTION

The language of some federal intellectual property statutes may be sufficiently robust to support a colorable argument that the United States is complying with its treaty obligations to protect moral rights, unregistered well-known marks, and trade secrets. In reality, the actual obligation of the United States is to provide not colorable, but rather effective protection through its domestic implementation of these treaty obligations.[121] Effective protection may not be the case; however, because federal intellectual property statutes are construed and implemented through inconsistent federal or state court decisions relying on the common law of individual states. As discussed previously, New York State provides a cause of action against infringement of well-known marks even absent use in the state, while the state of California has no analogous provision. Consequently, no state law remedy exists in California, much less an ineffective one.[122]

APPLICATION OF THE U.S. CONSTITUTION (1997), at 3, *available at* http://www.gpo.gov/fdsys/pkg/GAOREPORTS-OGC-98-5/content-detail.html.

118. *See* Zschernig v. Miller, 389 U.S. 429, 436 (1968).

119. *See* Julian G. Ku, *The State Of New York Does Exist: How The States Control Compliance With International Law*, 82 N.C. L. REV. 457, 476, 502 (2004).

120. *See* TRIPS Agreement, Marrakesh Agreement Establishing the World Trade Organization art. 1(1), 1994, 33 I.L.M. 1197.

121. *See id.* art. 42(1) ("ensure that enforcement procedures . . . are available under [national] law so as to permit effective action against any act of infringement of intellectual property rights covered by" the TRIPS Agreement).

122. *See* Cal. R. Ct. 8.548. Of course, a party could file an action in federal court and request certification of the state law question to the California Supreme Court, or commence an action in California state court, and thus permit the state courts to organically develop new

California is the ultimate arbiter of whether its law protects unregistered, foreign, well-known marks that are not used by the mark holder in California. Though individual plaintiffs could bring suit to challenge such laws, strategic litigation to develop state common laws for effective trademark protection is at best an unreasonable burden to place on foreign trademark holder with rights guaranteed under international agreement.

Absent federal legislation, there is a powerful argument that if the United States is to conform with its treaty obligations—in the context of moral rights, trademark protection, and trade secret protection—then it must rely on state law provisions to fill the gap between the treaty obligations of the United States and positive enactments by Congress. This section will analyze federal preemption doctrines and their applicability to state law, with a focus on preemption doctrines related to the foreign relations of the United States and whether those doctrines limit states' ability to develop state laws inconsistent with US foreign policy.

A. Federal Courts

Under the Supremacy Clause of the United States Constitution, Congress when acting pursuant to its constitutional authority has the power to preempt state law and state laws that conflict with federal law are "without effect."[123] Federal courts have recognized two general types of federal preemption: express preemption and implied preemption. Implied preemption is often broken down further into conflict preemption and field preemption.[124] All federal preemption jurisprudence exists against a backdrop that a court reviewing any state law must indulge in a strong presumption that state law is not preempted and that the preferred interpretation of any purported

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common law for the state. Additionally, although extremely rare, state courts applying the law of another state may also certify questions of law to those alien jurisdictions. *See generally* Ira P. Robbins, *Interstate Certification of Questions of Law: A Valuable Process in Need of Reform*, 76 JUDICATURE 125 (Oct./Nov. 1992); UNIF. CERTIFICATION OF QUESTIONS OF LAW ACT § 2.

123. Maryland v. Louisiana, 451 U.S. 725, 746 (1981).

124. Michigan Canners and Freezers Ass'n, Inc. v. Agric. Mktg. and Bargaining Bd., 467 U.S. 461, 469 (1984); Freightliner Corp. v. Myrick, 514 U.S. 280, 287 (1995); *see* Stephen A. Gardbaum, *The Nature of Preemption*, 79 CORNELL L. REV. 767, 808 (1994).

conflict between federal and state law is the interpretation that disfavors preemption.[125] If the interpretation that disfavors preemption is the preferred interpretation, then that rule of thumb is built on two jurisprudential posits that "'the purpose of Congress is the ultimate touch-stone' in every pre-emption case"[126] and when Congress "'legislated . . . in a field which the States have traditionally occupied,' . . . [the court must] 'start with the assumption that the historic police powers of the States were not to be superseded by the Federal Act unless that was the clear and manifest purpose of Congress.'"[127]

1. Express Preemption

Express preemption requires that Congress explicitly stated its intention to displace all state regulation from an area that Congress is constitutionally empowered to regulate.[128] In the three examples discussed in this Article, moral rights, well-known marks, and trade secrets, Congress has not expressly expelled states from regulating in this area.

2. Implied Preemption

In the absence of express congressional preemption, courts may find state laws preempted in the case of either (i) conflict preemption where the state law conflicts with federal law, or (ii) field preemption where Congress intended federal law to occupy the field and displace all state regulation.[129] In either case, state law is preempted if it is impossible for third parties to comply with both state and federal law, or if the challenged law "stands as an obstacle to the accomplishment and execution of the full purposes and objects of Congress."[130] If the putative conflict involves an area historically committed to state

125. Bates v. Dow Agrosciences, LLC, 544 U.S. 431, 449 (2005).

126. Medtronic, Inc. v. Lohr, 518 U.S. 470, 485 (1996) (quoting Retail Clerks v. Schermerhorn, 375 U.S. 96, 103 (1963)).

127. *Id.* (quoting Rice v. Santa Fe Elevator Corp., 331 U.S. 218, 230 (1947)).

128. *See* Arizona v. United States, 132 S. Ct. 2492, 2500–01 (2012).

129. *See* Crosby v. Nat'l Foreign Trade Council, 530 U.S. 363, 372 (2000).

130. *See id.* at 372–73.

regulation, federal courts will not preempt state law unless "[it] was the clear and manifest purpose of Congress [to preempt state regulation]."[131] Furthermore, if there is more than one plausible interpretation of the statute, then courts should ordinarily prefer the interpretation that avoids preemption.[132]

As there are either ineffectual or no federal laws in the areas of moral rights, well-known marks, or trade secrets, the doctrine of implied preemption is irrelevant here.

B. State Statutes and State Courts

While the focus of scholarly and judicial attention appears to be on the federal government's ability to preempt state laws to assure compliance with national policies, a state could arguably embrace a doctrine that independently compels it to consider US foreign policy when developing its own law. At this time, however, the author has been unable to locate any such state-based requirement to defer to federal policies.

VI. THE LEGAL EFFECT OF A DIPLOMATIC COMMUNICATIONS

State laws and judicial decisions that are inconsistent with the treaties and other laws of the United States are clearly preempted by federal law under the Supremacy Clause of the Constitution.[133] If the language of the Lanham Trademark Act and the 1976 Copyright Act (including the Berne Convention implementation amendments) were pellucid in enforcing federal obligations, there would be no need to contend that, absent a change in federal law, the United States must rely on state law to meet its international obligations. However, foreign policy of the United States is not always established in the form of laws and treaties. Lesser acts relating to foreign policy positions of the United States include executive agreements between the President of the United States and other heads of state or

131. Altria Grp., Inc. v. Good, 555 U.S. 70, 77 (2008) (internal quotation marks omitted) (quoting *Rice*, 331 U.S. at 230).

132. *Id.*

133. *See* U.S. CONST. art. VI, cl. 2; Hillsborough Cnty. Fla. v. Automated Med. Labs., Inc., 471 U.S. 707, 712–13 (1985).

internationally recognized juridical entity, or statements made in response to questions posed in an international forum.

A. Treaties

Treaties are the clearest case of federal foreign policy. Treaties are a positive enactment of law under express congressional power granted to the president to negotiate and to the Senate to ratify the treaty.[134] In principle, treaties preempt inconsistent state law. However, the treaties on which this Article focuses are not self-executing. In fact, Congress has gone to inordinate lengths to prevent the Berne Convention from even inadvertently being considered a self-executing treaty.[135] Consequently, while a ratified treaty is a clear expression of federal law, it is does not have domestic effect until it is enacted by Congress in a separate act pursuant to one of Congress's enumerated powers.

B. Executive Agreements

An executive agreement is "[a]n international agreement entered into by the President, without approval by the Senate, and usually involving routine diplomatic or military matters."[136] Under federal preemption jurisprudence, constitutional executive agreements consistently preempt contrary state law. However, the lawful subject matter of an executive agreement has received remarkably inconsistent treatment over the years. Even absent an express preemption clause, a valid executive agreement preempts both state statutory and common law.[137] Consequently, while an executive agreement is not law per se, it has sufficient force of law to displace

134. *See generally Medellin v. Texas*, 552 U.S. 491 (2008).

135. 1 MELVILLE B. NIMMER AND DAVID NIMMER, NIMMER ON COPYRIGHT § 1.12(A) (Matthew Bender, Rev. Ed.). Almost one-third of the Berne Convention Implementation Act (BCIA) of 1988's sections are designed to "forestall any claim that the Berne Convention is self-executing under United States law." *Id.* Congress even assured that the BCIA went into effect simultaneously with the Berne Convention to prevent any argument that, as a later-adopted treaty, the Berne Convention modified any aspect of US law. *Id.* at n.6.

136. BLACK'S LAW DICTIONARY (9th ed. 2009).

137. *See* Am. Ins. Ass'n v. Garamendi, 539 U.S. 396, 416–17 (2003); *see generally* Celeste Boeri Pozo, *Foreign Affairs Power Doctrine Wanted Dead Or Alive: Reconciling One Hundred Years Of Preemption Cases*, 41 VAL. U. L. REV. 591 (2007).

inconsistent state laws. However, there are limits on a president's ability to preempt state laws through executive agreements. The executive agreement must comport with federal law and the Constitution of the United States.[138]

In theory, it may be possible for the United States to constrain the development of state law through executive agreements that create a binding interpretation of a treaty.[139] For example, in the case of a sole-executive agreement, the Court has found that state laws such as California's Holocaust Victim Insurance Relief Act (HVIRA), requiring any insurer doing business in California to disclose information about those policies to the California Insurance Commissioner that interfered with the President's foreign policy powers were preempted.[140] The President entered executive agreements with his European counterparts to encourage them to settle Holocaust-era insurance claims.[141] California chose to adopt an approach that relied on regulatory sanctions.[142] The Court held that "HVIRA's economic compulsion to make public disclosure, of far more information about far more policies than ICHEIC rules require, employs 'a different, state system of economic pressure,' and in doing so undercuts the President's diplomatic discretion and the choice he has made exercising it."[143] However, the most recent line of

138. *See Medellin*, 552 U.S. at 530.

139. *See* RESTATEMENT (THIRD) OF THE FOREIGN RELATIONS LAW OF THE UNITED STATES § 115 cmt. e ("Since any treaty or other international agreement of the United States, and any rule of customary international law, is federal law (§ 111), it supersedes inconsistent State law or policy whether adopted earlier or later. Even a non-self-executing agreement of the United States, not effective as law until implemented by legislative or executive action, may sometimes be held to be federal policy superseding State law or policy. In principle, a United States treaty or international agreement may also be held to occupy a field and preempt a subject, and supersede State law or policy even though that law or policy is not necessarily in conflict with the international agreement, (see § 1, Reporters' Note 5); *the matter has apparently not been adjudicated*.") (emphasis added).

140. *See*, American Ins. Assn' v. Garamedni, 539 U.S. 396, 420 (2003). American Ins. Assn' at 415 ("At a more specific level, our cases have recognized that the President has authority to make "executive agreements" with other countries, requiring no ratification by the Senate or approval by Congress, this power having been exercised since the early years of the Republic."). The sources of the President's constitutional authority to enter into sole executive agreements can arguably be found in Art. II, §3 of the U.S. Constitution. *See* KERMIT HALL, ET AL, THE OXFORD COMPANION TO AMERICAN LAW 283 (Oxford 2002).

141. *Garamedni.* 539 U.S. at 421–22.

142. *Id.*

143. *Id.* at 423–24.

Supreme Court precedent suggests that the president's powers to enter into executive agreements or to use the inherent powers of the presidency will be subjected the triparte test established in *Youngstown Sheet & Tube Co*.[144]

C. Other Presidential Communications

There also exist other communications between governments that are significantly less formal than treaties or executive agreements. In *Medellin v. Texas*, the Supreme Court considered the legal effect of a statement by then President George W. Bush that implemented an International Court of Justice (ICJ) decision in the *Case Concerning Avena and Other Mexican Nationals* (*Mex. v. U.S)*.[145] The ICJ held that the United States violated the Vienna Convention rights of fifty-one Mexican nationals when the United States failed to inform the Mexicans of their rights to consular services.[146] As a result, the ICJ ruled that the Mexican nationals were entitled to reconsideration of their US state court convictions and sentences, regardless of their procedural default under state habeas or appellate law by failing to previously raise these issues in the state court proceedings.[147]

President Bush, through a Memorandum to the Attorney General, declared that the United States would "discharge its international obligations . . . by having state courts give effect to the [ICJ's *Avena*] decision."[148] Relying on the President's Memorandum, a prisoner petitioned a Texas state court for a writ of habeas corpus.[149] The petition was denied on the grounds that granting the petition would constitute an abuse of the writ; because, the prisoner did not raise the issue in a timely manner, exactly the procedural default that the *Avena* decision aimed to correct.[150] The Supreme Court granted the petition for a writ of certiorari on the issue of whether the President's

144. *Medellin*, 552 U.S. at 524.

145. *Id.* at 497 (citing Avena and Other Mexican Nationals (Mex. v. U.S.), 2004 I.C.J. 12 (Mar. 31).

146. Avena and Other Mexican Nationals (Mex. v. U.S.), 2004 I.C.J. at 60, ¶ 122–23.

147. *Medellin*, 552 U.S. at 497–98.

148. *Id.* at 498.

149. *Id.* at 503.

150. *Id.* at 504.

Memorandum independently required state courts to reconsider the prisoner's conviction without regard to state default rules.[151]

The Supreme Court acknowledged that the *Avena* judgment constituted an international law obligation of the United States.[152] However, the Court found that the *Avena* judgment was not a domestic law obligation of the United States or of the individual states.[153] The *Medellin* Court then considered whether in cases where a treaty creates an obligation for the United States the Constitution "implicitly g[a]ve the President the authority to implement that treaty-based obligation."[154] The Court rejected this contention and found that "[t]he responsibility for transforming an international obligation arising from a non-self-executing treaty into domestic law falls to Congress."[155]

In *Youngstown Sheet & Tube Co.*, the Court first articulated a scheme recognizes that the scope of proper constitutional authority of the president comes from either an act of Congress or from the Constitution.[156] The president's power is at its highest when he acts pursuant to an express or implied authorization of Congress.[157] It is at a moderate level when he acts within a zone where both the legislative and executive branches share concurrent constitutional power, and "congressional inertia, indifference or quiescence" sustains the president's authority.[158] And presidential authority is at its lowest when the President acts against the express or implied will of Congress.[159] In this third situation, the Court can only sustain the president's actions by "disabling the Congress from acting upon the subject."[160]

The *Medellin* Court then analyzed the President's constitutional authority to order state court's to reconsider a procedural default

151. *Id.*
152. *Id.* at 510–11.
153. *Id.* at 511.
154. *Id.* at 525.
155. *Id.*
156. *Youngstown Sheet & Tube Co. v. Sawyer*, 343 U.S. 579, 636 (1952).
157. *Id.* at 637.
158. *Id.* 552 U.S. at 524 (quoting *Youngstown*, 343 U.S. at 637).
159. 343 U.S. at 637–38.
160. *Id.* at 525 (quoting *Youngstown*, 343 U.S. at 637–38).

using the *Youngstown Sheet & Tube Co.* tripartite scheme.[161] In *Medellin*, the Court recognized that the interest of the United States in protecting relations with foreign governments and demonstrating a commitment to international law was "plainly compelling."[162] However, it found, in light of the totality of *Youngstown Sheet & Tube Co.'s* analytical scheme including "the absence of congressional legislation, that the non-self-executing treaties at issue here did not 'express[ly] or implied[ly]' vest the President with the unilateral authority to make them self-executing."[163]

In a long unbroken line of cases, the Supreme Court has upheld the president's right to settle the civil claims of American citizens against foreign governments or foreign nationals.[164] The legitimacy of this presidential prerogative is based on its age—an almost two hundred year tradition to which Congresses has acquiesced.[165] But, as the Court noted, "[p]ast practice does not, by itself create power."[166] The Court then described President Bush's exercise of executive power as "unprecedented," and the Solicitor General was unable to identify a single instance where the president gave or Congress acquiesced to a presidential directive aimed at a state court.[167] Therefore because there was no constitutional basis, statutory basis, or past practice by the executive branch with congressional acquiesce, President Bush's Memorandum to the Attorney General had no legal effect in domestic law.[168] Consequently, the Court left the United States in violation of its treaty obligations, the President impotent to act, and Congress—as it often is—silent on a critical issue of foreign policy.

161. *Id.*
162. Medellin, 552 U.S. at 537.
163. *Id.* at 527 (quoting *Youngstown*, 343 U.S. at 635).
164. *Id.* at 531–32.
165. *Id.*
166. *Medellin*, 552 U.S. at 531–32 (quotation marks and citation omitted).
167. *Id.* at 532.
168. *Id.* at 532.

D. Statements by Government Officials

In addition to formal written executive agreements, the Executive branch sometimes makes statements assuring international partners that the United States is in conformity with its treaty obligations based on a body of state law.[169] For example, the United States relied on state laws that arguably protected moral rights in order to join the Berne Convention. The United States specifically relied on state causes of action.[170] A statement by a the Executive Branch in the course of negotiations or in the implementation of a treaty must carry less precedential authority in displacing state law than a Memorandum signed by the President then it is unlikely that positions taken by the United States assuring foreign governments that it is incompliance with its international obligations are in anyway binding on the individual states or even federal courts interpreting state or federal law.[171]

VII. CONCLUSION

The concurring justices in *Bond v. the United States* have identified a domestic constitutional (Tenth Amendment) space left to the states where Congress (and the President) cannot regulate under their constitutional authority (Treaty Clause) over the foreign relations laws of the United States.[172] Also, the more recent precedent from the Supreme Court suggests that the scope of Congress's constitutional powers under the Commerce Clause may be reaching their post-New Deal nadir.[173] Accordingly, as foreign relations law increasingly impacts the domestic lives of the American people which are traditionally regulated by the states, foreign policy spaces may appear where Congress cannot regulate under the Tenth

169. *Cf*. PATRY, *supra* note 42, at § 16.3 (discussing use of state law to convince WIPO to declare the US in compliance with the Berne Convention).

170. *Id.* § 16.3.

171. *Cf.* Medellin, 552 U.S. at 531–32 (rejecting the authority of the president to enforce an IJC order absence domestic legislation by Congress).

172. *Bond II*, 134 S. Ct. at 2103

173. *See, e.g.*, Misha Tseytlin, *As-Applied Commerce Clause Challenges*, 16 U. PA. J. CONST. L. 479, 485 (2013) (analyzing the recent cases narrowing the scope of the Commerce Clause).

Amendment and where states may have an opportunity to create their own laws. Moreover, even in areas where Congress can regulate under the Commerce Clause, Congress is increasingly content to satisfy its foreign relations obligations by relying on state law. Unless preempted by the Constitution or by domestic federal law, states are free to develop state domestic law in a manner that is inconsistent with the international obligations of the United States. Despite the broad freedom that states might enjoy under the Tenth Amendment, sound policy dictates that state legislatures and courts carefully consider US foreign policy positions as highly persuasive authority and only depart from them for compelling reasons. States are subordinate in foreign policy to the President and Congress. Under our federal system, no one state's choice of domestic law should impact the foreign relations of the United States nor expose the citizens of other states to the withdrawal of reciprocal rights or treaty benefits by aggrieved treaty-partners.

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