

ARTICLE

PROTECTIONS FOR TRADITIONAL KNOWLEDGE UNDER STATE COMMON LAW AND CONSTITUTIONAL LAW

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INTRODUCTION

Nearly fifty years ago, former United States (“U.S.”) Supreme Court Justice William Brennan published an article in the Harvard Law Review emphasizing the central role of state constitutions in protecting individual rights.² A half century later, Justice Brennan’s prescience proves all the more salient. With a gridlocked Congress,³ a President unconcerned with the protection of minority groups,⁴ and a Supreme Court unwilling to acknowledge unenumerated due process rights,⁵ little advancement has occurred in realizing the guarantees of freedom and equality under the U.S. Constitution. In particular, one minority group often excluded from the national conversation of these rights are the indigenous peoples of the U.S., known collectively as Native Americans.⁶

Native Americans have one of the highest poverty rates of any minority group in the U.S.⁷ and the enduring damage to Native Americans by European and American aggressors is not limited to economic harms. For example, the forced

² See generally William Brennan, *State Constitutions and the Protection of Individual Rights*, 90 HARV. L. REV. 489, 491 (1977) [hereinafter *State Constitutions*].

³ Christopher Ingraham, *Congressional Gridlock has Doubled since the 1950s*, THE WASH. POST (May 28, 2014), https://www.washingtonpost.com/news/wonk/wp/2014/05/28/congressional-gridlock-has-doubled-since-the-1950s/?utm_term=.176df4a4b7c1 [https://perma.cc/4B8S-Z3XV].

⁴ See *Trump Administration Civil and Human Rights Rollbacks*, THE LEADERSHIP CONFERENCE ON CIVIL & HUMAN RIGHTS, <https://civilrights.org/trump-rollbacks/> [https://perma.cc/3PC2-6CRA].

⁵ See, e.g., John F. Basiak Jr., *The Roberts Court and the Future of Substantive Due Process: The Demise of “Split-the-Difference” Jurisprudence?*, 28 WHITTIER L. REV. 861, 902-03 (2007) (reviewing the first term of the Roberts Court approach to substantive due process).

⁶ For the purpose of this article, I collectively refer to the indigenous peoples of the United States, American Indians, Alaska Natives, and Native Hawaiians as Native Americans or tribes for consistency, unless statutory language requires otherwise.

⁷ See Jens Manuel Krogstad, *One-in-four Native Americans and Alaska Natives Are Living in Poverty*, PEW RESEARCH (June 13, 2014), <http://www.pewresearch.org/fact-tank/2014/06/13/1-in-4-native-americans-and-alaska-natives-are-living-in-poverty/> [https://perma.cc/C38L-758Y].

migration and integration of Native Americans into American Western culture has resulted in the extinction of Native American history and languages.⁸ The U.S. has the second-highest number of endangered languages in the world, with “[s]ome 40 languages . . . hav[ing] fewer than 10 native speakers.”⁹ In recognition of centuries of colonialism, the global community is beginning to rethink its approach to governmental relations with indigenous peoples, especially regarding intellectual property (“IP”).¹⁰

Most extant IP regimes, primarily patent and copyright, are based on Western European conceptions of inventorship and authorship.¹¹ However, the oral histories, community authorship, and cultural significance of knowledge goods developed over time by indigenous peoples, referred to collectively as “traditional knowledge” (“TK”),¹² challenge these regimes and economic justifications.¹³ While some commentators have expressed reluctance towards the inclusion of IP rights into the defenses of TK,¹⁴ others have emphasized that

⁸ See Jane O’Brian, *Saving Native American Languages*, BBC NEWS (Apr. 1, 2009), <http://news.bbc.co.uk/2/hi/americas/7964016.stm> [<https://perma.cc/9U54-33FK>]; see also Jorge Noriega, *American Indian Education in the United States: Indoctrination for Subordination to Colonialism*, in *THE STATE OF NATIVE AMERICA: GENOCIDE, COLONIZATION, AND RESISTANCE* 371, 371 (M. Annette Jaimes ed., 1992).

⁹ O’Brian, *supra* note 8.

¹⁰ See generally Ruth Okediji, *Traditional Knowledge and the Public Domain*, CENTER FOR INT’L GOVERNANCE INNOVATION: CIGI PAPERS NO. 176, 1-3 (June 2018) (evaluating the use of public domain as a policy tool and how the modern conception of the public domain impedes the protection of traditional knowledge); but see David Skillman & Christopher Ledford, Note, *Limiting the Commons with Uncommon Property: A Critique of Chander & Sunder’s the Romance of the Public Domain*, 8 OR. REV. INT’L L. 337, 341-43 (2006) (arguing that a more robust public domain can aid in technology and economic flow to developing and least-developed nations).

¹¹ See Anupam Chander & Madhavi Sunder, *The Romance of the Public Domain*, 92 CALIF. L. REV. 1331, 1136, 1339, 1347 (2004) (criticizing the current use of the public domain as a relic of Romantic-era conceptions of authorship).

¹² The World Intellectual Property Organization (“WIPO”) uses the term traditional knowledge to refer to “tradition-based literary, artistic or scientific works; performances; inventions; scientific discoveries; designs; marks, names and symbols; undisclosed information; and all other tradition-based innovations and creations resulting from intellectual activity in the industrial, scientific, literary or artistic fields.” WIPO, *INTELLECTUAL PROPERTY NEEDS AND EXPECTATIONS OF TRADITIONAL KNOWLEDGE HOLDERS: WIPO REPORT ON FACT-FINDING MISSIONS ON INTELLECTUAL PROPERTY AND TRADITIONAL KNOWLEDGE* (1998-1999), at 25 (2001).

¹³ See Okediji, *supra* note 10, at 4-5 (“demystifying” the traits of traditional knowledge such as multiple authorship, subject matter, and duration).

¹⁴ See, e.g., Stephen Munzer & Kal Raustiala, *The Uneasy Case for Intellectual Property Rights in Traditional Knowledge*, 27 CARDOZO ARTS & ENT. L.J. 37, 40 (2009).

a radical transformation of IP is not required to protect TK.¹⁵ In the U.S., the Bureau of Indian Affairs has prioritized misappropriation as a key tool in protecting indigenous cultural goods despite objections made by Native American groups who oppose the notion that most TK is in the public domain and thus incapable of protection through IP rights.¹⁶ Given the international movement toward IP-like protections for TK, it is at least worth considering IP as a non-exclusive framework for these issues.¹⁷ Nevertheless, we must continually question what role IP plays in the protection of TK.

The U.S. has made little domestic progress on extending IP-related protections to TK as Congress has favored legislation employing copyright and patent protections of TK.¹⁸ However, all hope for IP-related protections is not lost because in our dual federal system, the sovereign states can extend protections, subject to preemption limitations, above and beyond those provided by federal law.¹⁹ Former U.S. Supreme Court Justice Louis Brandeis, in a now oft-repeated misquote, referred to the states as the laboratories of democratic experimentation.²⁰ This statement meant that states are free to interpret and create law under their own common law schemes and state constitutions as long as those state actions do not produce outcomes that violate the U.S.

¹⁵ See, e.g., Jay Erstling, *Using Patents to Protect Traditional Knowledge*, 15 TEX. WESLEYAN L. REV. 295, 297-300 (2009) (surveying the use of patents to protect traditional knowledge).

¹⁶ See The National Congress of American Indians [NCAI], *Calling for Immediate and Direct Consultation by the United States with Tribes Regarding On-Going International Negotiations in the World Intellectual Property Organization on Matters that May Affect Tribal Sovereignty including Protection of Indigenous Traditional Knowledge*, at 2, Res. PHX-16-054 (Oct. 9-14, 2016), http://www.ncai.org/attachments/Resolution_ZlGiMHNGVtAbKpBODZObySfdKgbkPYPgDGnKYMSigaCfeNCnOIP_PHX-16-054%20final.pdf [<https://perma.cc/GT5E-WKXT>].

¹⁷ See Sue Noe & Melody McCoy, *World Intellectual Property Organization Instruments on Traditional Knowledge, Genetic Resources, and Traditional Cultural Expression*, NATIVE AMERICAN RIGHTS FUND, <https://www.narf.org/cases/wipo/> [<https://perma.cc/HW4C-5FB2>]; see generally World Intellectual Property Organization [WIPO] General Assembly, Twenty-Sixth Session, *Matters Concerning Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore*, WIPO Doc. WO/GA/26/6 (Aug. 25, 2000), https://www.wipo.int/edocs/mdocs/govbody/en/wo_ga_26/wo_ga_26_6.pdf [<https://perma.cc/4J5U-LPAW>].

¹⁸ Only one federal law, the Indian Arts and Crafts Act of 1990, tangentially addresses the IP of Native Americans. 18 U.S.C. § 1159 (2012). This law makes it a crime to “offer or display for sale or sell any good . . . in a manner that falsely suggests it is Indian produced.” *Id.* Because this law only applies to false claims of manufacture, it does not address the broader issue of misappropriation of TK. See *id.* Congress has passed several *sui generis* laws to preserve Native American religious and historic artifacts and goods, languages, and sites, however, almost all of these laws are either (1) limited to tangible, extant goods; or (2) related to funding programs and not property rights. See *infra* Section II.

¹⁹ See *infra* Sections I & II.

²⁰ *New State Ice Co. v. Liebmann*, 285 U.S. 262, 311 (1932) (Brandeis, J., dissenting).

Constitution.²¹ States have embraced this opportunity for experimentation, affording protections above and beyond those espoused by the U.S. Supreme Court, even when interpreting language in their state constitutions that is identical to language in the U.S. Constitution.²²

In this article, I propose that state courts establish a cause of action for the “misappropriation of traditional knowledge”²³ or interpret their respective state constitutions to establish a functionally similar due process right to TK. This proposal proceeds in three parts. Part I reviews the complicated federal preemption scheme of the four main areas of IP rights (patents, copyright, trademark, and trade secrets) to provide an understanding of the limits on states’ lawmaking authority. Part II analyzes the specific competing authorities of the federal and state governments in the regulation of Native American activities. Part III reviews the benefits and detriments of state court recognition of common law and state constitutional rights in TK.

I emphasize again at the outset, that whether or not cultural goods should be subject to an IP system is not a settled question. However, this article operates primarily on the assumption that IP provides a useful framework for analyzing the underlying issues of TK, including what deserves protection, who should enjoy protection, and what fundamental interests are served by offensive and defensive legal regimes.

I. PREEMPTION ISSUES WITH INTELLECTUAL PROPERTY

Not all IP is equal. The federal regimes that govern the main areas of IP (patents, copyright, trademark, and trade secrets) identify different, sometimes overlapping, protectable subject matter, balance interests of the rights-holder and the public, and reflect preemption schemes that allow greater or lesser state action.²⁴ Even within a particular regime, such as copyright, various theories and justifications for property protections result in different adjustments to the underlying doctrine.²⁵ The interests at stake for the protection of TK may both overlap with and diverge from traditional forms of IP.²⁶ For example, the image

²¹ See Brennan, *supra* note 2, at 501 n.80 (noting that the U.S. Supreme Court cannot review decisions of state courts interpreting their respective state laws, even if the case also involves a federal issue).

²² See *id.* at 495-502 (reviewing state court decisions interpreting state constitutions contrary to similar interpretations of the U.S. Constitution by the U.S. Supreme Court).

²³ Thomas J. Krumenacher, *Protection for Indigenous Peoples and Their Traditional Knowledge: Would a Registry System Reduce the Misappropriation of Traditional Knowledge*, 8 MARQ. INTELL. PROP. L. REV. 143, 143 (2004).

²⁴ See generally Deepa Varadarajan, *Trade Secret Fair Use*, 83 FORDHAM L. REV. 1401, 1406-07 (2014) (comparing fair use protections of copyright and patents to lack of fair use protections in trade secret law).

²⁵ See generally William Fisher, *Theories of Intellectual Property*, in NEW ESSAYS IN THE LEGAL AND POLITICAL THEORY OF PROP. 168, 168 (Stephen Munzer, ed. 2001).

²⁶ See Erstling, *supra* note 15, at 298-301.

protections of publicity rights and secrecy protections of trade secrets may align well with the desired protections of Native American imagery and rituals.²⁷ In contrast, the strict utilitarian justifications of patent law are highly discordant with the environments under which new technologies and discoveries are developed in traditional cultures.²⁸ From this comparison, it is clear that understanding why protections exist is required to understand when protections should exist.²⁹ In light of this understanding, a review of the federal preemption scheme for federal IP rights follows to emphasize the relatively broad scope of protections available for the states to enact and expand.

A. Patents

Patent law is exclusively federal and preempts any state law that offers patent-like protections for unpatentable subject matter.³⁰ Much like the preemption scheme of copyright law,³¹ there exists an intense debate over which state protections directly conflict with the objectives of federal patent law.³² On one hand, patent law, which encourages disclosure at the expense of a time-limited monopoly, does not wholly displace trade secret law, which encourages non-disclosure on a theoretically infinite time scale.³³ On the other hand, in accordance with the intent of state and federal trademark law, unfair competition laws that prevent the copying of public unpatented or unpatentable designs will generally be preempted absent the requirement of preventing consumer confusion.³⁴ Similarly, misappropriation claims based upon asserted inventorship of patentable subject matter, the sole determination of which belongs to the federal courts via the U.S. Patent and Trademark Office, are also

²⁷ See Okediji, *supra* note 10, at 11-12.

²⁸ See Erstling, *supra* note 15, at 296-97; Fisher, *supra* note 25.

²⁹ See Erstling, *supra* note 15, at 297-98.

³⁰ See *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 231 (1964) (“Obviously a State could not, consistently with the Supremacy Clause of the Constitution, extend the life of a patent beyond its expiration date or give a patent on an article which lacked the level of invention required for federal patents . . . Just as a State cannot encroach upon federal patent laws directly, it cannot, under some other law, such as forbidding unfair competition, give protection of a kind that clashes with the objectives of federal patent laws.”).

³¹ See *infra* Section I.B.

³² See *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 154 (1989).

³³ See *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 493 (1974) (“Trade secret law and patent law have co-existed in this country for over one hundred years . . . Trade secret law encourages the development and exploitation of those items of lesser or different invention than might be afforded protection under patent laws.”).

³⁴ See *Bonito Boats*, 489 U.S. at 158 (“The ‘protection’ granted a particular design under the law of unfair competition is thus limited to one context where consumer confusion is likely to result; the design ‘idea’ itself may be freely exploited in all other contexts.”).

preempted.³⁵ However, unlike a claim under patent law, a claim under trade secret laws may escape federal preemption because of the requirements that the property interest be both secret and misappropriated.³⁶ The conflict of state trade secret and federal patent law is further examined in Section I.D.³⁷

Private corporations, chief among them pharmaceutical companies, have benefitted greatly from unfettered access to TK in genetic resources.³⁸ The international community's response to the absence of such regulation was the 2010 Nagoya Protocol to the Convention on Biological Diversity.³⁹ The Nagoya Protocol requires that parties to the protocol take measures to obtain informed consent from TK holders prior to accessing their genetic resources⁴⁰ and to ensure fair and equitable benefit-sharing from any proceeds obtained by such genetic resources.⁴¹ However, the U.S. has never signed, ratified, nor implemented the Nagoya Protocol.⁴² As such, the limitations of federal patent law, including a lack of community ownership, challenges of prior art, and limited durations of protection, are all that remain available at the federal level.⁴³ Given the rigidity of the federal courts' application of preemption to any patent-like protections that do not qualify as trade secrets, or to those that are designed to prevent consumer confusion, it is unlikely that protections for patentable subject matter will be protectable under state law.

³⁵ See, e.g., *Univ. of Colo. Found., Inc. v. Am. Cyanamid Co.*, 196 F.3d 1366, 1372 (Fed. Cir. 1999) (“[T]he field of federal patent law preempts any state law that purports to define the rights based on inventorship.”).

³⁶ Unfair competition laws that lack the misappropriation of trade secrets requirement are often preempted. See, e.g., *Motion Med. Techs., L.L.C. v. ThermoTek, Inc.*, 875 F.3d 765, 775, 777–78 (5th Cir. 2017) (finding that the Patent Act preempted a Texas unfair competition by misappropriation claim since “[t]here was no fraud or dishonesty element . . .”).

³⁷ See *infra* Section I.D.

³⁸ See Francesca Grifo et al., *The Origins of Prescription Drugs*, in *BIODIVERSITY AND HUMAN HEALTH* 131, 137, 139 (Francesca Grifo & Joshua Rosenthal eds., 1997) (noting that over 90% of the 35 plant-derived drugs in the top 150 brand name prescription drugs contain at least one compound directly related to the same use in traditional medicine).

³⁹ Nagoya Protocol on Access to Genetic Resources and the Fair and Equitable Sharing of Benefits Arising from their Utilization to the Convention on Biological Diversity, Oct. 29, 2010, UNEP/CBD/COP/DEC/X/1 [hereinafter Nagoya Protocol].

⁴⁰ *Id.* art. 6, para. 2.

⁴¹ *Id.* art. 5, para. 2.

⁴² See Status of Treaties, *Nagoya Protocol on Access to Genetic Resources and the Fair and Equitable Sharing of Benefits Arising from their Utilization to the Convention on Biological Diversity*, UNITED NATIONS TREATY COLLECTION, https://treaties.un.org/pages/ViewDetails.aspx?src=TREATY&mtdsg_no=XXVII-8-b&chapter=27&lang=en [<https://perma.cc/X63T-YL4K>].

⁴³ For a more detailed analysis of these challenges, see Erstling, *supra* note 15, at 329-31; see, e.g., Richard A. Guest, *Intellectual Property Rights and Native American Tribes*, 20 AM. INDIAN L. REV. 111, 120–23 (1995-96) (detailing the challenges of protecting traditional Zuni crop varieties with plant patents).

B. Copyright

Unlike the Patent Act, the Copyright Act of 1976 contains express preemption and non-preemption provisions that both limit and expand the scope of its authority.⁴⁴ Preemption requires both that the object of state law protection fall within the subject matter of copyright and that the rights afforded under state law overlap with those enumerated in Section 106 of the U.S. Code.⁴⁵ Courts have adopted a two-part test to tease out these features and have affirmed that, like patent law, federal copyright law may coexist with trade secret law, though the contours of this coexistence continue to be the subject of judicial debate.

1. Section 301(a) (preemption)

Section 301(a) of the Copyright Act explicitly preempts “all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by Section 106 . . . and come within the subject matter of copyright as specified by Section 102 and 103”⁴⁶ This preemption applies regardless of the date the work was created.⁴⁷ Therefore, even though the scope of the statute is limited by both rights and subject matter,⁴⁸ because something does not fall under the literal terms of Section 301(a), like an uncopyrightable idea, does not mean that states are free to legislate unrestricted.

Courts apply a two-part test to determine if a state law claim is preempted under Section 301(a).⁴⁹ First, courts look to the copyrightable and uncopyrightable subject matter enumerated under Section 102.⁵⁰ In applying this test, the Fifth Circuit held that Section 301(a) preemption not only applies to works fixed in a tangible medium of expression, but also extends to any ideas or information contained or reflected within those documents.⁵¹ The Second and Ninth Circuits also follow the Fifth’s approach for similar preemption matters.⁵² In general, courts have concluded that:

[O]ne function of § 301(a) is to prevent states from giving special protection to works of authorship that Congress has decided should be in the public domain, which it can accomplish only if “subject matter of

⁴⁴ See 17 U.S.C. § 301 (2012).

⁴⁵ *Id.* § 301(a).

⁴⁶ *Id.*

⁴⁷ *Id.*

⁴⁸ *Id.*

⁴⁹ *Spear Mktg., Inc. v. BancorpSouth Bank*, 791 F.3d 586, 594 (5th Cir. 2015).

⁵⁰ *Id.*

⁵¹ *Id.* at 596-98.

⁵² *Id.* at 595-96; *but see Dunlap v. G&L Holding Group, Inc.*, 381 F.3d 1285, 1297 (11th Cir. 2004) (holding that “ideas are substantively ineligible for copyright protection” and fall outside Section 301(a) preemption even if capable of being expressed in a tangible medium of expression).

copyright” includes all works of a type covered by sections 102 and 103, even if federal law does not afford protection to them.⁵³

For the second portion of the preemption test, if a claim falls within the subject matter limitation of Section 301(a), courts then examine if the legal and equitable rights available under state law mirror those in Section 106.⁵⁴ This step is often called the “equivalency test.”⁵⁵ Section 106 delineates the exclusive rights in copyrighted works as the right of reproduction, preparation of derivative works, distribution, public performance, public display, and performance via digital audio transmission.⁵⁶ Other claims falling outside of copyright include conversion of physical property,⁵⁷ trade secret misappropriation,⁵⁸ and publicity rights.⁵⁹ The inclusion of a scienter requirement is likely insufficient to shield a state law from preemption, despite copyright infringement’s strict liability nature.⁶⁰

2. Section 301(b)–(c) (non-preemption)

While Section 301(a)’s large reach captured many common law copyright claims, some claims still remained outside its jurisdiction. In *Capitol Records, Inc. v. Naxos of America, Inc.*, the Court of Appeals of New York held that common law copyright claims were not preempted for pre-1972 sound recordings, a class of works explicitly omitted from Section 301.⁶¹ A subsequent case, *Flo & Eddie, Inc. v. Sirius XM Radio, Inc.*, held that public performance

⁵³ *Wrench LLC v. Taco Bell Corp.*, 256 F.3d 446, 455 (6th Cir. 2001) (quoting *ProCD, Inc. v. Zeidenberg*, 86 F.3d 1447, 1453 (7th Cir. 1996)).

⁵⁴ Section 301 also contains an express preemption and non-preemption scheme for the Visual Artists Rights Act, detailed *infra* Section I.B.3. See 17 U.S.C. § 301(f) (2012).

⁵⁵ *Spear Mktg.*, 791 F.3d at 597.

⁵⁶ 17 U.S.C. § 106(1)–(6) (2012).

⁵⁷ *Spear Mktg.*, 791 F.3d at 597.

⁵⁸ See discussion on limitations *infra* Section I.D.

⁵⁹ *Spear Mktg.*, 791 F.3d at 595 (citing *Brown v. Ames*, 201 F.3d 654, 658 (5th Cir. 2000)) (“[A] persona is not an original work produced by an author.”); *but see* *Maloney v. T3Media, Inc.*, 853 F.3d 1004, 1011 (9th Cir. 2017) (“[W]hen a likeness has been captured in a copyrighted artistic visual work and the work itself is being distributed for personal use, a publicity-right claim interferes with the exclusive rights of the copyright holder, and is preempted by section 301 of the Copyright Act.”).

⁶⁰ *Spear Mktg.*, 791 F.3d at 598 (quoting *M-I LLC v. Stelly*, 733 F. Supp. 2d 759, 791 (S.D. Tex. 2010)) (“[E]lements of knowledge do not establish an element that is qualitatively different from a copyright infringement claim.”).

⁶¹ *Capitol Records, Inc. v. Naxos of Am., Inc.*, 830 N.E.2d 250, 263 (N.Y. 2005). Pre-1972 sound recordings will be extended federal copyright protection under the Music Modernization Act, though limited to public performance by digital audio transmission. Music Modernization Act, Pub. L. No. 115-264, 132 Stat. 3676, 3728-32 (codified at 17 U.S.C. § 1401(a)). This same provision explicitly non-preempts state common law of pre-1972 recordings, except for public performance by digital audio transmission. *Id.* § 1401(d).

was not a protected right at common law.⁶² The discerning eye and incremental approach taken by the courts in these two cases exemplifies the notion within the realm of IP common law that courts are aware of the societal implications of their decisions. As the *Sirius* court noted, “[t]he common law, of course, evolves slowly and incrementally, eschewing sudden or sweeping changes.”⁶³ Taken together, if a potentially preempted claim fails to meet either prong of the Section 301(a) two-part test or falls explicitly under non-preempted subject matter, the claim would survive non-preempted.⁶⁴

3. Moral rights

In 1990, Congress added a set of moral rights limited to a specific subset of works by enacting the Visual Artists Rights Act (“VARA”)⁶⁵ to bring the U.S. into compliance with the Berne Convention.⁶⁶ Unlike economic rights, the author retains moral rights in their copyrighted work after its sale, rendering these moral rights effectively inalienable.⁶⁷ At the time of VARA’s passage, eleven states already had existing laws that granted limited moral rights to authors.⁶⁸ Prior to VARA, the general consensus was that moral rights were not preempted by existing federal copyright law.⁶⁹ These state-protected moral rights often included the rights of attribution and integrity.⁷⁰

VARA, however, changed the moral rights landscape. VARA contains its own preemption provision that is similar to the Section 301(a) preemption bipartite test, but limits its preemption to subject matter covered by VARA,⁷¹ “works of visual art.”⁷² VARA defines a work of visual art by limiting (1) the

⁶² *Flo & Eddie, Inc. v. Sirius XM Radio, Inc.*, 70 N.E.3d 936, 947 (N.Y. 2016) (emphasizing that “copy right prevents copying of a work, but does not prevent someone from using a copy, once it has been lawfully procured, in any other way the purchaser sees fit”).

⁶³ *Id.* at 941 (citing *Norcon Power Partners v. Niagara Mohawk Power Corp.*, 705 N.E.2d 656 (1998)).

⁶⁴ See 17 U.S.C. § 301(a)-(c) (2012); *Spear Mktg.*, 791 F.3d at 593-97.

⁶⁵ Visual Artists Rights Act of 1990, Pub. L. No. 101-650, 104 Stat. 5128, 5129-33 (codified as amended at 17 U.S.C. §§ 101, 106A, 107, 113, 301, 411(a), 412, 501(a), 506 (2012)).

⁶⁶ Joshua H. Brown, Note, *Creators Caught in the Middle: Visual Artists Rights Act Preemption of State Moral Rights Laws*, 15 HASTINGS COMM. & ENT. L.J. 1003, 1004 (1992).

⁶⁷ See, e.g., 17 U.S.C. § 106A(e) (2012) (making rights under VARA non-transferrable, but waivable).

⁶⁸ See Brown *supra* note 66 (citing H.R. REP. NO. 514, 101st Cong., 2d Sess. 9 & n.18 (1990)).

⁶⁹ See *id.* at 1006 n.15 (citing *Wojnarowicz v. Am. Family Ass’n*, 745 F. Supp. 130, 136 (S.D.N.Y. 1990)) (finding New York’s moral rights law was not preempted by the 1976 Copyright Act).

⁷⁰ See, e.g., CAL. CIV. CODE § 987 (West 2019).

⁷¹ 17 U.S.C. § 301(f) (2012).

⁷² *Id.* § 101.

subject matter of the work, and (2) the number of copies of the extant work to less than 200.⁷³ Accordingly, VARA does not cover subject matter such as written folklore or paintings with more than 200 copies.⁷⁴ Similarly, works not of “recognized stature” fall outside of VARA’s scope.⁷⁵ Additionally, VARA’s moral rights terminate upon the author’s death.⁷⁶ State moral rights can therefore fully exist after the death of the author, as they are explicitly non-preempted by VARA.⁷⁷ This non-preemption may work in favor of Native Americans, because much of their TK was created long before the statute’s enactment or is otherwise in the public domain and is therefore unprotected under the Copyright Act.⁷⁸

VARA’s limits may be interpreted as permitting, and perhaps even requiring, state moral rights regimes to comply with international obligations under the Berne Convention.⁷⁹ Indeed, California’s moral rights law, the California Arts Preservation Act (“CAPA”),⁸⁰ has provided a cause of action concurrently with VARA for destruction of murals and similar works.⁸¹ Some federal district courts have found certain causes of action in CAPA that are preempted by VARA,⁸² while also denying preemption of other CAPA claims, such as conversion and negligence.⁸³

⁷³ See *id.*

⁷⁴ *Id.* § 106A (stating that protection under VARA covers “work[s] of visual art”) and *id.* § 101 (defining a work of visual art as “a painting, drawing, print, or sculpture, existing ... in a limited edition of 200 copies or fewer”).

⁷⁵ *Id.* § 106A(a)(3)(B).

⁷⁶ *Id.* § 301(f)(2)(C).

⁷⁷ See *id.*; see also *Bd. of Managers of Soho Int’l Arts Condo. v. City of New York*, No. 01 Civ.1226 DAB, 2003 WL 21403333, at *14 (S.D.N.Y. June 17, 2003) (“Only after the termination of VARA’s protections would such causes of action again be available at common law or under a state moral rights statute.”).

⁷⁸ Gregory Youngling, *Traditional Knowledge Exists; Intellectual Property is Invented or Created*, 36 U. PA. J. INT’L L. 1077, 1082 (2015).

⁷⁹ See Joseph Bauer, *Addressing the Incoherency of the Preemption Provision of the Copyright Act of 1976*, 10 VAND. J. ENT. & TECH. L. 1, 25 (2007) (arguing “the United States may well be dependent on state law to fulfill its obligations under the Berne Convention to afford some measure of protection to certain moral rights.”).

⁸⁰ See CAL. CIV. CODE, *supra* note 70.

⁸¹ See, e.g., *Kammeyer v. United States Army Corps of Engineers*, No. EDCV 15-869 JGB (KKx), 2015 WL 12765463, at *1 (C.D. Cal. Oct. 9, 2015). The district court ultimately rejected the plaintiff’s CAPA claim - not on VARA preemption grounds - but rather because the defendant in this case, the United States, was immune from state regulation under the Supremacy Clause. *Id.* at *6.

⁸² See, e.g., *Whalen v. United Food & Commercial Workers Local 135*, No. 14cv3017-WQH-BLM, 2016 WL 2866875, at *3 (S.D. Cal. May 17, 2016).

⁸³ See *id.* (“Given VARA’s specific language that VARA does not preempt rights that are not equivalent to any of the rights it confers, Plaintiffs have alleged facts that could support a claim for conversion. VARA does not preempt Plaintiff’s common law conversion and

One instructive case on VARA preemption is *Phillips v. Pembroke Real Estate, Inc.*,⁸⁴ in which a sculptor brought claims under both VARA and the “rarely litigated”⁸⁵ Massachusetts moral rights statute, the Massachusetts Art Preservation Act (“MAPA”).⁸⁶ The real estate company sought to remove and relocate 27 public sculptures by the plaintiff, and the plaintiff objected, arguing that the site-specific nature of the sculpture gave it artistic significance and removing it would render it “destroyed” under Massachusetts law.⁸⁷ The district court, on a decision for a preliminary injunction, rejected an argument that the entire park (with the sculptures forming an integral part) constituted a work of visual art under VARA, though the sculptures themselves could qualify under that category.⁸⁸ Examining MAPA, the court recognized that MAPA provided broader protections than VARA that persist for 50 years after the death of the author.⁸⁹ Under MAPA’s broader definition of “fine art,” the park as a whole could qualify for protection.⁹⁰ Both the strict limitations of VARA’s preemption scheme and the extant state moral rights landscape reflect the significant potential for moral rights protections in TK at the state level, in contrast with the limited scope of economic rights available non-preempted by the Copyright Act.

C. Trademark

Trademark law, which protects “identifying marks, words, symbols, or images” used in connection with the sale of goods,⁹¹ is a legal field where federal and state law coexist.⁹² Under federal law, trademarks are governed by the Lanham Act.⁹³ States are allowed to register trademarks with legal effect limited to their own borders; however, they are forbidden from requiring “alteration of a [federally] registered mark.”⁹⁴ As such, trademark law is governed by conflict preemption and state laws are only preempted by federal law to the extent that

negligence claims which seek damages for the intentional deprivation of Plaintiffs’ ownership or title rights to the mural.” (internal quotation marks omitted)).

⁸⁴ *Phillips v. Pembroke Real Estate, Inc.*, 288 F. Supp. 2d 89, 92 (D. Mass. 2003).

⁸⁵ *Id.* at 100.

⁸⁶ MASS. GEN. LAWS ANN. ch. 231, § 85S (West 1984).

⁸⁷ *Phillips*, 288 F. Supp. 2d at 93-96.

⁸⁸ *Id.* at 99.

⁸⁹ *Id.* at 100-01.

⁹⁰ *Id.* at 101 (MAPA defines protected “fine art” as “any original work of visual or graphic art of any media which shall include, but not limited to, any painting, print, drawing, sculpture, craft object, photograph, audio or video tape, film, hologram, or any combination thereof, of recognized quality.” § 85S(c)).

⁹¹ Jill Kelley, *Owning the Sun: Can Native Culture Be Protected through Current Intellectual Property Law?*, 7 J. HIGH TECH. L. 180, 187 (2007).

⁹² See J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 22:1 (5th ed. 2018).

⁹³ 15 U.S.C. § 1051–1141n (2012).

⁹⁴ *Id.* § 1121(b).

those state laws directly conflict with federal law.⁹⁵ To obtain a federal trademark, the mark must be used in either interstate or foreign commerce.⁹⁶

State trademark law's persistence despite federal law is perhaps unsurprising as trademarks, which arose out of the need for unfair competition laws, were once exclusively the purview of the states.⁹⁷ Similarly, much of trademark law was developed in the common law prior to its enactment as positive law.⁹⁸ Indeed, trademark law traces its history throughout centuries of common law "through actual use of marks by guild associations in Europe to identify the sources of their products."⁹⁹

While some commentators have suggested that Native Americans may have a misappropriation cause of action in Section 43(a) of the Lanham Act, these lawsuits have generally been unsuccessful.¹⁰⁰ Similarly, Section 1052(a),¹⁰¹ which prevents the registration of disparaging trademarks,¹⁰² was held unconstitutional by the Supreme Court's decision in *Matal v. Tam*¹⁰³ as a violation of applicant's free speech rights under the First Amendment.¹⁰⁴

⁹⁵ See *JCW Investments, Inc. v. Novelty, Inc.*, 482 F.3d 910, 919 (7th Cir. 2007) ("In the area of trademark law, preemption is the exception rather than the rule.").

⁹⁶ See 15 U.S.C. § 1127 (2012) (defining "commerce" under the Lanham Act as "all commerce which may lawfully be regulated by Congress"); U.S. CONST. art. I, § 8, cl. 3 (limiting Congress's power to regulate only interstate, foreign, and tribal commerce).

⁹⁷ See Trade-Mark Cases: *United States v. Steffens*; *United States v. Wittemann*; *United States v. Johnson*, 100 U.S. (10 Otto.) 82, 92 (1879) (stating that "[t]he whole system of trademark property and the civil remedies for its protection existed long anterior to that act, and have remained in full force since its passage.>").

⁹⁸ See *id.* ("The right to adopt and use a symbol or a device to distinguish goods or property made or sold by the person whose mark it is, to the exclusion of use by all other persons, has long been recognized by the common law."); see also Bradlee Frazer, *Common-law Trademarks or Trade-name Rights in Geographical Areas of Prior Use*, 22 AM. JURIS. PROOF OF FACTS 3D 623, § 7 (reviewing common-law rights in trademark); Ethan Horowitz & Benjamin Levi, *Fifty Years of the Lanham Act: A Retrospective of Section 43(a)*, 7 FORDHAM INTEL. PROP. MEDIA & ENT. L.J. 59, 60 (1996) ("[M]arks to distinguish merchandise had long been protected under the common law and state statutes").

⁹⁹ Guest, *supra*, note 43, at 126.

¹⁰⁰ See, e.g., *Navajo Nation v. Urb. Outfitters, Inc.*, No. 12-195 BB/LAM, 2016 WL 3475342, at *3-4 (granting summary judgment on dilution for defendant clothing manufacturer using the term "Navajo" because "Navajo" is not a nationally recognized household name, instead referring to it as a "niche" mark at best.). For a critical analysis of this case, see Katharyn Moynihan, *How Navajo Nation v. Urban Outfitters Illustrates the Failure of Intellectual Property Law to Protect Native American Cultural Property*, 19 RUTGERS RACE & L. REV. 51 (2018).

¹⁰¹ 15 U.S.C. § 1052(a) (2012).

¹⁰² See *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 455 (E.D. Va. 2015) (affirming the Trademark Trial and Appeals Board cancellation of the Washington Redskins trademarks), *vacated by Pro-Football, Inc. v. Blackhorse*, 709 Fed. Appx. 182 (4th Cir. 2018).

¹⁰³ *Matal v. Tam*, 137 S. Ct. 1744 (2017).

¹⁰⁴ *Id.* at 1751.

Ultimately, so long as a state law claim does not expressly conflict with a validly-registered federal trademark, the claim will likely survive federal preemption.¹⁰⁵ However, a state trademark ban on disparaging marks will receive the same First Amendment challenges as they would under the Lanham Act.

D. Trade Secret

Trade secret law is similar to trademark in that it originated through the common law and coexists today with state and federal law. A trade secret consists of information used in the course of business that is kept secret and provides an economic advantage due to its secrecy or use.¹⁰⁶ Trade secret law finds its origins in the industrial revolution, but did not reach a semblance of uniformity until the Uniform Trade Secrets Act (“UTSA”),¹⁰⁷ first published in 1979.¹⁰⁸ Even then, as a model law, states were and are free to modify the UTSA.¹⁰⁹ In 2016, the Defend Trade Secret Act (“DTSA”) was enacted to provide a federal cause of action for misappropriation of trade secrets.¹¹⁰ The DTSA explicitly does not preempt state law.¹¹¹ However, even with non-preemption of trade secrets established under the DTSA, both federal patent and copyright law may cover trade secret subject matter and therefore preempt protections.

¹⁰⁵ *Id.* at 1753.

¹⁰⁶ See 18 U.S.C. § 1839(3) (definition of a “trade secret” under the Defend Trade Secrets Act). The economic *advantage* requirement does not necessarily preclude protection of traditional knowledge for which commercial value is not readily apparent. In many cases, the mere act of appropriation implies the knowledge possesses economic value. Moreover, the knowledge of what to do often encompasses the knowledge of what not to do. This is referred to as “dead-end” or “negative” information and possesses commercial value by directing firms where to avoid wasting resources. See, e.g., Michael Rosen, *The Role of “Negative Trade Secrets” in the Uber-Waymo Settlement*, AEIDEAS (Feb. 21, 2018), <https://www.aei.org/publication/the-role-of-negative-trade-secrets-in-the-uber-waymo-settlement/> [<https://perma.cc/7RLU-GDGV>].

¹⁰⁷ Most states have adopted the UTSA in some form. In fact, only New York and North Carolina have declined to adopt the UTSA. *Trade Secrets Act*, UNIFORM LAW COMM’N, <https://www.uniformlaws.org/committees/community-home?communitykey=3a2538fb-e030-4e2d-a9e2-90373dc05792&tab=groupdetails> [<https://perma.cc/MPM3-95NS>].

¹⁰⁸ See Brittany Bruns, *Criticism of the Defend Trade Secrets Act of 2016: Failure to Preempt*, 32 BERKELEY TECH. L.J. 469, 475 (2017).

¹⁰⁹ *Id.*

¹¹⁰ Defend Trade Secrets Act of 2016, Pub. L. 114–153, 130 Stat. 376, 376 (2016) (codified as amended at 18 U.S.C. § 1836 (2016)).

¹¹¹ See 18 U.S.C. § 1838 (2012); see also Bruns, *supra* note 107, at 469. The lack of preemption has been criticized as a restriction on employee mobility and fair competition. See *id.*

The federal judiciary has grappled with the extent of copyright law's preemption of state trade secret misappropriation causes of action.¹¹² The DTSA's explicit non-preemption clause "signals Congress's clear belief that basic state trade secrecy rights are not inconsistent with existing Federal intellectual property law."¹¹³ As detailed in Section I.B.1, when an exclusive right under the Copyright Act is impinged by the appropriation of a trade secret, consisting of copyrightable subject matter and the exclusive remedies of the Copyright Act tied to it, the trade secret law is likely to be preempted.

Federal patent law, though lacking an explicit preemption provision, has been applied and interpreted to actually preempt state law. One of the earliest cases in which courts addressed this preemption matter was *Sears, Roebuck & Co. v. Stiffel Co.*,¹¹⁴ in which a unanimous U.S. Supreme Court held that an unpatented and unpatentable lamp design could not be protected from copying by state unfair competition laws.¹¹⁵ The Court reasoned that the enumeration of Congressional power to craft national, uniform patent law clearly prevented a state from effectively "giv[ing] a patent on an article which lacked the level of invention required for federal patents" nor could a state through unfair competition law "give protection of a kind that clashes with the objectives of the federal patent laws."¹¹⁶ A determination that the lamp design was unpatentable placed the design in the public domain and, importantly, states could not "block off from the public something which federal law has said belongs to the public."¹¹⁷

While *Sears* dealt generally with unfair competition law, the U.S. Supreme Court addressed the conflict between patent law and trade secret law in *Kewanee Oil Co. v. Bicron Corp.*¹¹⁸ There, the Court held that Ohio's trade secret law was not preempted by federal patent law.¹¹⁹ The Court began by noting the unique restrictions on a trade secret cause of action, which included that the information need be secret and that the secret need be obtained or misappropriated by "improper means."¹²⁰ The Court then quoted *Sears* in addressing the question whether trade secret law presented "too great an encroachment on the federal

¹¹² See *Spear Mktg., Inc. v. BancorpSouth Bank*, 791 F.3d 586, 597–600 (5th Cir. 2015) (holding a Texas trade secret law preempted by the Copyright Act).

¹¹³ JAMES BOYLE & JENNIFER JENKINS, *INTELLECTUAL PROP.: LAW & THE INFO. SOC'Y* 774 (4th ed. 2018).

¹¹⁴ *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 225-33 (1964).

¹¹⁵ *Id.* at 232–33.

¹¹⁶ *Id.* at 231.

¹¹⁷ *Id.* at 231–32.

¹¹⁸ *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470 (1974).

¹¹⁹ *Id.* at 493.

¹²⁰ *Id.* at 475–76 (citing *B.F. Goodrich Co. v. Wohlgenuth*, 192 N.E.2d 99, 104 (Ohio Ct. App. 1963); then citing *Nat'l Tube Co. v. Eastern Tube Co.*, 3 Ohio C.C. (N.S.), 459, 462 (1902), *aff'd*, 70 N.E. 1127 (Ohio 1903) and then citing RESTATEMENT (FIRST) OF TORTS § 757A.

patent system to be tolerated.”¹²¹ The Court focused on the disclosure requirement in the Patent Act, stating that “the patent policy of encouraging invention is not disturbed by the existence of another form of incentive to invention.”¹²² For nonpatentable subject matter, the absence of trade secret law would provide practically no protection nor motivation to innovate.¹²³ Simply put, “[t]rade secret law will encourage invention in areas where patent law does not reach.”¹²⁴ Furthermore, “[n]othing in the patent law requires States refrain from action to prevent industrial espionage.”¹²⁵

The most difficult question, however, lies with “clearly patentable invention[s]” where Congress has explicitly balanced the protection/disclosure trade-off.¹²⁶ Here, trade secret law’s weaker protections did not conflict with patent law’s protections, such that “there is no real possibility that trade secret law will conflict with the federal policy favoring disclosure of clearly patentable inventions.”¹²⁷ This reasoning brought the Court to the conclusion that even “partial preemption [was] inappropriate” because it would “create problems for state courts in the administration of trade secret law.”¹²⁸

The Court concluded:

Trade secret law and patent law have coexisted in this country for over one hundred years. Each has its particular role to play, and the operation of one does not take away from the need for the other. Trade secret law encourages the development and exploitation of those items of lesser or different invention than might be accorded protection under the patent laws, but which items still have an important part to play in the technological and scientific advancement of the Nation. Trade secret law promotes the sharing of knowledge, and the efficient operation of industry; it permits the individual inventor to reap the rewards of his labor by contracting with a company large enough to develop and exploit it. Congress, by its silence over these many years, has seen the wisdom of allowing the States to enforce trade secret protection. Until Congress takes affirmative action to the contrary, States should be free to grant protection to trade secrets.¹²⁹

The Court’s promotion of state trade secret laws in *Kewanee* holds true today as trade secrets coexist at both the state and federal level, and Congress’s choice not to preempt state law under the DTSA reaffirms state trade secret laws’

¹²¹ *Id.* at 482 (quoting *Sears*, 376 U.S. at 232).

¹²² *Id.* at 484.

¹²³ *Id.* at 485.

¹²⁴ *Id.*

¹²⁵ *Id.* at 487.

¹²⁶ *Id.* at 489.

¹²⁷ *Id.* at 491.

¹²⁸ *Id.* at 491-92.

¹²⁹ *Id.* at 493.

continued validity and potency.¹³⁰ The Court's focus on the requisite secret nature of trade secret protection to prevent conflict with patent law, as well as the differing justifications for promoting innovation, guide the extent to which states may protect TK.

This secrecy requirement comports with at least one proposal for a tiered approach to protecting TK. Professor Ruth Okediji has detailed a system in which "closely held"¹³¹ TK would have to be disclosed if relied upon in an IP application.¹³² Disclosure of origin not only serves as an important procedural legal tool, but has societal externalities associated with failed disclosure, including "consumer boycotts, reprimands from trade organizations or affiliate groups, professional discipline on researchers or scientists involved, or organized campaigns to expose the firm's behavior to the public."¹³³ Ultimately, while trade secret law may provide thinner protections for TK known by the wider public, trade secrets may nevertheless provide instruction on the crafting for a common law misappropriation of TK cause of action.

E. How to Survive Federal IP Law Preemption

States are left with several options on how to survive federal preemption within the contexts of patent, copyright, trademark and trade secret law described in Section I.¹³⁴ For patentable subject matter, states have very little preemption flexibility as the only patentable subject matter that generally escapes preemption is that covered by the additional requirements of misappropriation under trade secret law and laws aimed at preventing consumer confusion.¹³⁵ Even if patent law fails to provide such statutory preemption, copyright law still may possess that ability. However, a state law either granting a right outside of those prescribed in Section 106 or covering subject matter outside of Section 102, would remain non-preempted.¹³⁶ However, the Copyright Act preempts traditional state law claims like publicity rights if they satisfy the Section 301 two-part test.¹³⁷ In light of this regime, the proposal in Part III details what appropriate limitations state courts may engage under their common law or constitutional interpretative powers to survive preemption.

¹³⁰ See 18 U.S.C. § 1838 (2012).

¹³¹ Professor Okediji contends "closely held" knowledge to have three minimum conditions: (1) it must be knowledge that it is linked to a distinct indigenous group or local community; (2) it must be knowledge that acts to enrich, sustain, or address the needs of the indigenous group or local community; and (3) the indigenous group or local community must recognize the knowledge as subject to its local norms, rules, or processes that govern how it can be used, shared, or otherwise disseminated. Okediji, *supra* note 10, at 313.

¹³² *Id.* at 313–14.

¹³³ *Id.* at 317.

¹³⁴ See *supra* Section I.A-D.

¹³⁵ Motion Med. Techs., LLC v. ThermoTek, Inc., 875 F.3d 765, 777 (5th Cir. 2017).

¹³⁶ See 17 U.S.C. § 301(a) (2012).

¹³⁷ See, e.g., Maloney v. T3media, Inc., 853 F.3d 1004, 1010 (9th Cir. 2017).

Before undergoing that analysis, Part II discusses and evaluates preemption issues that exist between federal and state law and its application to Native American tribes recognized under federal American Indian law.

II. PREEMPTION ISSUES WITH NATIVE AMERICAN TRIBES

American Indian law reflects the challenges present when three sovereigns (federal, state, and tribal governments) compete and challenge one another for power in a constitutional hierarchy. The federal government is the supreme sovereign, albeit with enumerated powers.¹³⁸ The states and Native American tribes both exist as inferior sovereigns, though each are provided with inherent powers that may exceed those enumerated for the U.S.¹³⁹ However, the Supremacy Clause of the U.S. Constitution binds state or Native American tribal law to federal law and requires that federal law must be applied when a conflict arises between those legal frameworks.¹⁴⁰ A more complicated constitutional scenario occurs when a regulatory conflict arises between the states and tribes themselves. Cohen's Handbook of Federal Indian Law illustrates this succinctly: "State and tribal jurisdictions are determined by different tests and do not always lead to complementary results: in some situations, tribes and states both have jurisdiction; in others, tribes and states both lack jurisdiction; and in others, the existence of tribal authority bars state authority."¹⁴¹

Preemption of laws affecting Native Americans are analyzed by identifying: (1) the subject of the regulation; (2) the regulated activity; and (3) where the regulated activity is occurring.¹⁴² In matters involving "tribal member Indians in Indian country,"¹⁴³ these individuals are subject to tribal jurisdiction unless there is an established governing federal law.¹⁴⁴ Criminal matters committed by non-tribal members on tribal land are also generally a matter of tribal law.¹⁴⁵ The primary exception to this rule is that state courts retain jurisdiction when both the defendant and victim are non-tribal members.¹⁴⁶

¹³⁸ See U.S. CONST. art. I, § 8.

¹³⁹ See Brennan, *State Constitutions*, *supra* note 2, at 498-99.

¹⁴⁰ See U.S. CONST. art. VI, cl. 2.

¹⁴¹ FELIX S. COHEN, COHEN'S HANDBOOK OF FED. INDIAN LAW 44 (2012 ed. Supp. 2019).

¹⁴² See *generally id.*

¹⁴³ *Id.*

¹⁴⁴ *Id.*; see also *Worcester v. Georgia*, 31 U.S. 515, 557 (1832) ("[T]he several Indian nations [are] distinct political communities, having territorial boundaries, within which their authority is exclusive."). *Worcester* involved non-native people residing in Native American territory; however, the general principles of tribal sovereignty in such cases has been consistently reaffirmed. See, e.g., *United States v. Lara*, 541 U.S. 193, 210 (2004) (affirming tribal authority over non-tribal Native Americans in tribal land).

¹⁴⁵ See *New York ex rel. Ray v. Martin*, 326 U.S. 496, 499-500 (1946).

¹⁴⁶ *Id.* at 500 (reaffirming that "States, by virtue of their statehood, have jurisdiction over such crimes notwithstanding [federal criminal law]").

The proposal that follows would ultimately regulate private citizens for civil acts that occur within states (i.e., outside tribal land), which are traditionally the realm of state authority. The lattermost requirement, that the activity is regulated *outside* tribal land, avoids the complicated preemption/infringement test first established in *Williams v. Lee*.¹⁴⁷ The primary issues arise because of the tribal nature of the class of plaintiffs (tribes and individual tribal members) as well as the subject matter of the suit. Whether the subject matter of the suit makes the case subject to Congressional authority over commerce affecting the Indian tribes is a critical question addressed next.

A. Constitutional preemption and the dormant Indian Commerce Clause

The force of the Commerce Clause on state law affecting tribal members outside tribal land is unclear.¹⁴⁸ Whether the Indian Commerce Clause can preempt similarly to the “dormant”¹⁴⁹ Commerce Clause is the subject of ongoing scholarly debate.¹⁵⁰ Because a state common law cause of action exclusively affects tribal members as both plaintiffs and through the underlying subject matter of the claim, it is necessary to review the competing arguments surrounding this preemption question.

For example, “[m]odern Supreme Court doctrine states that ‘the central function of the Indian Commerce Clause is to provide Congress with plenary power to legislate in the field of Indian affairs.’”¹⁵¹ Professor Robert Natelson, in an extensive historical review surrounding the original understanding of the relationship between the states, Indian tribes, and federal government, argued

¹⁴⁷ See *Williams v. Lee*, 358 U.S. 217, 223 (1959) (rejecting state court jurisdiction over a claim brought by a plaintiff non-Indian whose store was located on tribal land to collect on a debt by an Indian); see generally Nathan Quigley, *Defining the Contours of the Infringement Test in Cases Involving the State Taxation of Non-Indians a Half-Century after Williams v. Lee*, 1 AM. IND. L.J. 147, 148 (2012) (analyzing subsequent cases involving taxation issues after *Williams*). It is possible that counterclaims that may arise in litigation would face a *Williams* challenge. However, tribal initiation of a suit would likely constitute a waiver to tribal sovereignty as it does when states bring suit. See, e.g., Jason Kornmehl, *Ericsson, Inc. v. Regents of the University of Minnesota and a New Frontier for the Waiver by Litigation Conduct Doctrine*, 2018 PEPP. L. REV. 1, 4 (2018).

¹⁴⁸ COHEN, *supra* 140, at n.33.

¹⁴⁹ The “dormant” commerce clause preempts state law, despite a lack of Congressional enactment, when the state law either “discriminated against out-of-state interests or unduly burdens the free flow of commerce among the states. Martin H. Redish & Shane V. Nugent, *The Dormant Commerce Clause and the Constitutional Balance of Federalism*, 1987 DUKE L.J. 569, 570 (1987).

¹⁵⁰ Compare Robert Clinton, *The Dormant Indian Commerce Clause*, 27 CONN. L. REV. 1056, 1058 (1995) (arguing the Indian Commerce Clause field preempts state laws), with Robert Natelson, *The Original Understanding of the Indian Commerce Clause*, 85 DENV. U. L. REV. 201, 212 (2007) (arguing the Indian Commerce Clause does not preempt state laws).

¹⁵¹ Natelson, *supra* note 148, at 211 (quoting *Cotton Petroleum Corp. v. New Mexico*, 390 U.S. 163, 192 (1989)).

that the resulting text of the Indian Commerce Clause “suggests that this congressional power was *not* exclusive.”¹⁵² The original public meaning, of course, is functionally irrelevant unless given legal force by the courts.

The Commerce Clause, of which the Indian Commerce Clause is a part, is not only a grant of positive authority to legislate, but also “contain[s] some implied limitations on the exercise of state authority over the same subject [of federal authority].”¹⁵³ As a general rule, the U.S. Supreme Court, when interpreting the scope of the dormant Commerce Clause, “has had more tolerance for local state regulations that do not pose a threat to interstate commerce than those applied to foreign commerce.”¹⁵⁴ Likewise, in part due to the federal government’s historically exclusive diplomatic powers with the Indian tribes, “the Court [has] treated the Indian Commerce Clause as imposing greater limitations on the states than the interstate Commerce Clause.”¹⁵⁵ However, this tilt in favor of implied constitutional preemption has shifted dramatically in the last thirty years.

In a 1989 landmark decision, *Cotton Petroleum v. New Mexico*, the U.S. Supreme Court addressed and defined the modern scope of the Indian Commerce Clause.¹⁵⁶ This case capped years of dwindling tribal sovereignty wins in the Supreme Court by holding that “the Indian Commerce Clause of the Constitution imposed no judicially enforceable restraints on the exercise of state power over persons or property in Indian country.”¹⁵⁷ Sixteen years prior to *Cotton Petroleum*, in *Mescalero Apache Tribe v. Jones*, the Court held that tribal properties located outside reservations could be subject to state income taxes.¹⁵⁸ A series of subsequent cases, primarily dealing with issues of taxation, increasingly questioned the level of legislative authority states possessed over reservation specific activities.¹⁵⁹ In *Cotton Petroleum*, the plaintiff claimed the State of New Mexico had unlawfully applied an oil and gas severance tax to a non-Native American lessee of the Jicarilla Apache Tribe’s on-reservation wells, who was already subject to a similar tax from the Apache tribe itself.¹⁶⁰ The Supreme Court found that no federal law or treaty expressly authorized or forbade such taxation by the State.¹⁶¹ Thus, while it seems that the question should have implicitly turned on the reach of the Indian Commerce Clause, the Court expressly discussed only the Interstate Commerce Clause, holding that the

¹⁵² *Id.* at 241 (reviewing the history of colonial laws, the Articles of Confederation, and the Constitutional Convention relating to Indian “commerce”) (emphasis added).

¹⁵³ Clinton, *supra* note 148, at 1059–60.

¹⁵⁴ *Id.* at 1061–62.

¹⁵⁵ *Id.* at 1062.

¹⁵⁶ *Cotton Petroleum v. New Mexico*, 490 U.S. 163 (1989).

¹⁵⁷ Clinton, *supra* note 148, at 1057–58.

¹⁵⁸ *Mescalero Apache Tribe v. Jones*, 411 U.S. 145, 148–49 (1973).

¹⁵⁹ *See* Clinton, *supra* note 148, at 1191–1216 (reviewing cases); *see also* Quigley, *supra* note 146, at 149–54 (reviewing cases).

¹⁶⁰ *Cotton Petroleum*, 490 U.S. at 166–70.

¹⁶¹ *Id.* at 177, 180, 186–87.

tribe did not qualify as a state for dormant Commerce Clause purposes.¹⁶² Scholars have criticized the Court's reasoning in "that the dormant Indian Commerce Clause imposed no judicially enforceable limitations on the exercise of state power in Indian affairs."¹⁶³ While *Cotton Petroleum* can be read as "enlarg[ing] state authority in Indian country at the expense of tribal sovereignty,"¹⁶⁴ an increase in state authority may also have the opposite effect of permitting states to grant rights outside the borders of tribal land above those currently established by Congress unless explicitly preempted by federal law.

B. Statutory landscape of federal Indian property laws

There are five overarching federal laws that seek to protect or promote Native American property and culture: the Native American Graves Protection and Repatriation Act ("NAGPRA"), the Archaeological Resources Protection Act ("ARPA"), the National Historic Preservation Act ("NHPA"), the Native American Languages Act ("NALA"), and the Indian Arts and Crafts Act ("IACA").¹⁶⁵ These protections, however, are either limited to tangible goods, contain few enforcement mechanisms, or fail to address the cognizable harms of rampant appropriation of cultural knowledge goods. Nevertheless, these laws contain gaps that Congress has implicitly left for the states to fill, especially in light of the Supreme Court's recent trend toward increasing permissive state statutory authority.¹⁶⁶

1. The Native American Graves Protection and Repatriation Act

NAGPRA creates a right for "Indian tribes and Native Hawaiian organizations, and their lineal descendants, to obtain repatriation of certain human remains, funerary objects, sacred objects, and objects of cultural patrimony from federal agencies and museums that are owned and funded by the federal government."¹⁶⁷ NAGPRA requires a showing of proof by an extant tribe of a relationship to the human remains that among other things can "reasonably be traced."¹⁶⁸ There are four exceptions to the duty to repatriate: (1) scientific study; (2) right of possession; (3) competing claims; and (4) takings of property.¹⁶⁹ The most glaring exception is the major scientific benefit

¹⁶² *Id.* at 191–92.

¹⁶³ Clinton, *supra* note 148, at 1220–21.

¹⁶⁴ *Id.* at 1225.

¹⁶⁵ For an in-depth review of these laws, see generally COHEN, *supra* note 140, at 1271.

¹⁶⁶ See Clinton, *supra* note 140, at 1062–63.

¹⁶⁷ COHEN, *supra* note 140, at 1271.

¹⁶⁸ *Bonnichsen v. United States*, 217 F. Supp. 2d 1116, 1143–44 (D. Or. 2002), *aff'd & remanded*, 357 F.3d 962 (9th Cir. 2004), *opinion amended & superseded on denial of reh'g*, 367 F.3d 864 (9th Cir. 2004). For a review critical of the 9th Circuit's interpretation of NAGPRA, see COHEN *supra* note 140, at 1272–73.

¹⁶⁹ 25 U.S.C. § 3005 (2012).

exception.¹⁷⁰ This exception, which applies to both human remains and cultural items, does not create an affirmative duty to repatriate remains until 90 days after the conclusion of a scientific study if those remains or items are “indispensable for completion of a specific scientific study” that “would be of major benefit to the United States.”¹⁷¹

NAGPRA also contains a “grave protections” provision that protects the removal or excavation of Native American cultural items, requires both the production of written notice and a consultation with tribes or Native Hawaiian organizations culturally affiliated with potential excavations on any federal lands.¹⁷² If these excavations occur on tribal land, consent of the specific Native American tribe or Native Hawaiian organization is required.¹⁷³ NAGPRA’s reach is limited to tangible cultural items associated with the burial remains of the individual.¹⁷⁴

2. The Archaeological Resources Protection Act

ARPA, enacted 11 years before the NAGPRA, functions similarly to NAGPRA, but has more restrictive definitions of Indian land and those remains subject to permitting.¹⁷⁵ ARPA does not contain any repatriation provisions but does prohibit interstate commerce in archeological resources taken unlawfully.¹⁷⁶ ARPA, unlike NAGPRA, contains no private right of action and instead grants power in a federal land manager to assess a civil penalty.¹⁷⁷ In this manner, ARPA is a precursor to NAGPRA and embodies Congress’s slow evolution in the realm of indigenous peoples’ rights.

3. The National Historic Preservation Act

NHPA is known for creating the National Register of Historic Places,¹⁷⁸ but also addresses the preservation of historic property of Indian tribes.¹⁷⁹ The Secretary of the Interior administers these preservation programs and must adapt them “to ensure that tribal values are taken into account to the extent feasible” and “may waive or modify requirements [of the preservation program] to

¹⁷⁰ See, e.g., Douglas W. Ackerman, *Kennewick Man: The Meaning of Cultural Affiliation and Major Scientific Benefit in the Native American Graves Protection and Repatriation Act*, 33 TULSA L. REV. 359, 370-73 (1997) (reviewing cases).

¹⁷¹ *Id.* § 3005(b).

¹⁷² *Id.* § 3002(c).

¹⁷³ *Id.* § 3002(c)(2).

¹⁷⁴ See *id.* § 3001(3)(a)-(d).

¹⁷⁵ For example, Indian land subject to ARPA is only that land held in trust or restricted. 16 U.S.C. § 470cc(g) (2012). The archeological resources must also be over 100 years old to qualify under ARPA. *Id.* § 470bb(1).

¹⁷⁶ *Id.* § 470ee(c).

¹⁷⁷ *Id.* § 470ff(a).

¹⁷⁸ *Id.* § 302101-08.

¹⁷⁹ *Id.* § 302701(a)-(b).

conform to the cultural setting of the tribal heritage preservation goals and objectives.”¹⁸⁰ The Secretary must consult with tribes themselves in implementing these programs.¹⁸¹ NHPA also gives tribes authority to act as State Historic Preservation Officers on tribal land.¹⁸² Moreover, “property of traditional religious and cultural importance to an Indian tribe or Native Hawaiian organization” is eligible for inclusion on the National Register of Historic Places.¹⁸³ If any federal agency action would affect any “historic property”¹⁸⁴ “that attaches religious and cultural significance” by an Indian tribe or Native Hawaiian organization, the relevant agency is required to consult with the affected tribe.¹⁸⁵ Notably, NHPA only requires consultation, it does not require the agency to accede to the tribe’s requests or recommendations.¹⁸⁶ While NHPA requires input from the tribes, its lack of substantive restrictions on state and federal government and its subject matter limitation to tangible goods echo a now-familiar lack of federal protection for TK.

4. The Native American Languages Act

NALA was designed to reverse the U.S. government’s long-standing policy of eradicating Native American languages by exclusively teaching English at Indian schools.¹⁸⁷ Perversely, this induced scarcity benefitted the federal government when Navajo and other tribal languages were used to create “the only unbroken oral code in military history.”¹⁸⁸ NALA advances several primary goals, such as encouraging the inclusion of Native American languages in schools, especially those funded by the Department of Interior, and allowing tribes to conduct official business in their own native languages.¹⁸⁹ However, NALA is currently structured merely as a policy declaration and does not contain any requirements enforceable through private action against states.¹⁹⁰

¹⁸⁰ *Id.* § 302701(c).

¹⁸¹ *Id.* § 302701(e).

¹⁸² *Id.* § 302702.

¹⁸³ *Id.* § 302706(a).

¹⁸⁴ Under NHPA, “historic property” means “any prehistoric or historic district, site, building, structure, or object included on, or eligible for inclusion on, the National Register, including artifact, records, and material remains relating to the district, site, building, structure, or object.” *Id.* § 300308.

¹⁸⁵ *Id.* § 302706(b).

¹⁸⁶ *San Juan Citizens Alliance v. Norton*, 586 F. Supp. 2d 1270, 1294 (D.N.M. 2008) (“ . . . NHPA only requires that an agency take procedural steps to identify cultural resources; it does not impose a substantive mandate on the agency to protect the resources.”).

¹⁸⁷ 25 U.S.C. §§ 2901-2906 (2012). For a summarized history of this policy, see COHEN, *supra* note 140, at 1300-03.

¹⁸⁸ See COHEN, *supra* note 140, at 1300-03.

¹⁸⁹ See 25 U.S.C. § 2903.

¹⁹⁰ See *Office of Haw. Affairs v. Dep’t of Educ.*, 951 F. Supp. 1484, 1494-95 (D. Haw. 1996).

Nevertheless, the government does provide grants through NALA to carry out its goals.¹⁹¹ Similar to other federal legislation affecting Native American tribes, NALA has large aspirational goals and noble intentions, but few concrete mechanisms to enforce and effectuate them.¹⁹²

5. The Indian Arts and Crafts Act

IACA's "overall purpose . . . is the protection and promotion of Native American art; the promotion of tribal self-sufficiency; the protection of Native American culture; and the protection of consumers against imitations."¹⁹³ It is considered the most effective federal law aimed at reducing appropriation of Native American cultural goods by making it a crime to "offer or display for sale or sell any good . . . in a manner that falsely suggests it is Indian produced."¹⁹⁴

IACA's strength derives from its broad definitions and enforcement mechanisms.¹⁹⁵ For example, the term "Indian tribe" is defined to include not only federally-recognized tribes, but also state-recognized tribes.¹⁹⁶ IACA also confers "a private right of action on Indian tribes and individual tribe members, who could both sue on behalf of themselves or on behalf of an Indian arts and crafts organization."¹⁹⁷ This right extends to Indian arts and crafts organizations too.¹⁹⁸ IACA notably does not contain a preemption provision, as one was proposed and ultimately rejected prior to the statute's passage, suggesting that state law claims mirroring those of IACA could complement federal law.¹⁹⁹

IACA is essentially a truth-in-advertising law, in that it uses a market-based approach through the lens of consumer protection to reduce the appropriation of TK.²⁰⁰ It ensures that goods falsely attributed to Indian manufacturing, are illegal

¹⁹¹ 42 U.S.C. §§ 2991b-3, 2992d(e) (2012).

¹⁹² See Office of Haw. Affairs, 951 F. Supp. at 1494–95.

¹⁹³ Guest, *supra* note 43, at 134.

¹⁹⁴ 18 U.S.C. § 1159(a) (2012).

¹⁹⁵ See generally 25 U.S.C. § 305e (2012 & Supp. V 2018).

¹⁹⁶ There are currently over sixty state-recognized tribes not recognized by the federal government. *Federal and State Recognized Tribes*, NAT'L CONFERENCE OF STATE LEGISLATURES (Nov. 2018), <http://www.ncsl.org/research/state-tribal-institute/list-of-federal-and-state-recognized-tribes.aspx#State> [<https://perma.cc/Z556-KFNR>] (listing the state tribes that are recognized).

¹⁹⁷ *Native Am. Arts, Inc. v. Contract Specialties, Inc.*, 754 F. Supp. 2d 386, 389 (D.R.I. 2010).

¹⁹⁸ *Id.*; 25 U.S.C. § 305e(b)-(d).

¹⁹⁹ William Hapiuk, Jr., *Of Kitsch and Kachinas: A Critical Analysis of the Indian Arts and Crafts Act of 1990*, 53 STAN. L. REV. 1009, 1018–19 (2001). In fact, eleven states at the time already had laws regulating the manufacture and sale of inauthentic Native American arts and crafts. *Id.* at 1018–19 n.41.

²⁰⁰ *The Indian Arts and Crafts Act of 1990*, U.S. DEP'T OF INTERIOR, <https://www.doi.gov/iacb/act> [<https://perma.cc/C5A4-2E5G>]; see also Hapiuk *supra* note 196, at 1027.

and face harsh penalties.²⁰¹ However, IACA has several key limitations. First, IACA only applies to goods sold or offered for sale.²⁰² It does not prevent an individual from appropriating TK, like folklore, and using it in a non-commercial manner.²⁰³ This goods-for-sale requirement starkly contrasts with federal copyright protections that prevent the reproduction and distribution of all copyrighted materials, regardless of whether money changed hands.²⁰⁴ A second limitation of IACA is that it only protects against false attribution of Indian manufacturing.²⁰⁵ In this manner, a seller of appropriated Native American TK would escape liability under IACA if the product was labelled correctly.²⁰⁶ Due to these limitations, even though IACA offers some strong recourse against non-Native Americans profiting from Native American TK, its protections ultimately fall short of preventing systemic appropriation and misuse of culturally and religiously significant knowledge goods, especially those that are considered non-tangible.

C. Equal protection concerns

Notwithstanding the preemption issue, a legal regime that gives preferential or exclusive treatment to a particular class of individuals is considered suspect under the Equal Protection Clauses of the 5th and 14th Amendments²⁰⁷ This is precisely the issue that was addressed in the landmark case *Morton v. Mancari* in which the unanimous U.S. Supreme Court rejected a 5th Amendment challenge to the Bureau of Indian Affairs' ("BIA") preferential hiring practices for Indians.²⁰⁸

In doing so, the Court noted "the unique legal status of Indian tribes under federal law" and "the plenary powers of Congress . . . to legislate on behalf of federally recognized tribes."²⁰⁹ Citing the Indian Commerce Clause, the executive treaty making powers of the President, and the entirety of Title 25 of the U.S. Code as the "historical and legal context" under which the constitutionality of the BIA hiring practices would be determined, the Court emphasized that these practices were not "racial discrimination," nor even "racial preference."²¹⁰ Instead, the practices were "an employment criterion reasonably designed to further the cause of Indian self-government and to make

²⁰¹ IACA offers a minimum of "\$1,000 for each day on which the offer or display or sale continues" in damages as well as punitive damages. 25 U.S.C. § 305e(b)–(c).

²⁰² See 18 U.S.C. § 1159(b)(1)(a) (2012).

²⁰³ Hapiuk Jr., *supra* note 196, at 1041.

²⁰⁴ Fair use exception notwithstanding. See 17 U.S.C. § 107(1) (2012) (non-commercial nature of a work cuts in favor of fair use).

²⁰⁵ See 18 U.S.C. § 1159(a); see also Hapiuk Jr., *supra* note 196, at 1010.

²⁰⁶ See 18 U.S.C. § 1159(a).

²⁰⁷ See generally *Morton v. Mancari*, 417 U.S. 536, 554–55 (1974).

²⁰⁸ *Id.* at 555.

²⁰⁹ *Id.* at 551.

²¹⁰ *Id.* at 552–54 (internal quotation marks omitted).

the BIA more responsive to the needs of its constituent groups.”²¹¹ The Court compared the BIA practices with the requirement that in order to serve as a senator for a specific state, that individual had to be a resident of the state they wished to represent.²¹² Moreover, the practices were not open to all Indians as a racial group, only to federal-recognized tribes.²¹³ This rendered them more a “political rather than racial” category.²¹⁴ Ultimately, the Court determined that the hiring practices at the BIA were “reasonably and directly related to [the] legitimate, nonracially based goal” of furthering federally-recognized Indian tribal self-governance.²¹⁵

The Court’s language in *Morton* suggests that providing preferential treatment to federally-recognized tribes in furtherance of, and in alignment with, federal priorities would overcome any potential constitutional challenges.²¹⁶ This preferential treatment of federally-recognized tribes was analyzed once again by the Supreme Court in *Rice v. Cayetano*,²¹⁷ wherein the Court held that Native Hawaiians who lack federal recognition are not entitled to the benefits upheld by *Morton*.²¹⁸ While *Morton* and *Rice* have tested the boundaries of federal priorities, no case has tested whether *Morton* applies to the states. That is, whether the states’ practice of providing preferential treatment to a federally-recognized tribe that furthers the tribe’s self-governance and interests, would survive a challenge under the 14th Amendment.

As a general rule, state action in accordance with valid federal law does not offend rights guaranteed by the 14th Amendment.²¹⁹ Prior to the enactment of the 14th Amendment, the U.S. Supreme Court held that states were free to enact protections for Native Americans so long as those protections did not conflict with federal law.²²⁰ Since *Morton*, lower courts have reached conflicting decisions as to whether state classifications are afforded the same deference.²²¹

D. How to Survive Federal Indian Law Preemption

In light of the statutory and constitutional landscape of federal Indian law, a state common-law cause of action to protect TK is likely to survive federal

²¹¹ *Id.* at 554.

²¹² *Id.*

²¹³ *Id.* at 553 n.24.

²¹⁴ *Id.*

²¹⁵ *Id.* at 554.

²¹⁶ *See id.* at 555.

²¹⁷ *Rice v. Cayetano*, 528 U.S. 495, 520 (2000).

²¹⁸ *Id.* at 520; For a further discussion of the context of *Rice* in Hawaiian governance, *see infra* note 295 and accompanying text.

²¹⁹ *See, e.g.,* *Peyote Way Church of God, Inc. v. Thornburgh*, 922 F.2d 1210, 1218–19 (5th Cir. 1991) (upholding state exemption from criminal peyote use by a federally-recognized tribe in light of an identical, valid federal exception).

²²⁰ *See New York ex rel. Cutler v. Dibble*, 62 U.S. 366, 370–71 (1859).

²²¹ COHEN, *supra* note 140, at 960-61.

Indian law preemption if: (1) The plaintiffs are limited to federally-recognized tribes; (2) the infringing activity occurs within state boundaries (i.e. outside tribal land); (3) the accused infringer is not a member of a federally-recognized tribe; and (4) the protections further the federal government’s role in promoting the interest of the relevant tribe.²²² The extant federal laws protecting the intellectual and cultural property of Indian tribes and Native Hawaiian organizations are unlikely to serve as an impediment to the proposed state cause of action due to their limited scope and explicit lack of preemption provisions. This narrowed framework provides the states with sufficient room to enact preferential legislation without interfering with federal Indian law.

III. COMMON LAW AND CONSTITUTIONAL PROPOSALS FOR STATE PROTECTIONS OF TRADITIONAL KNOWLEDGE

A. Sources of Law

To analyze the proposals set forth in this Section III aimed at improving the state protection of TK, it is important to first understand the sources of law that state courts use when deciding TK-related cases, beginning with a discussion of international law. Negotiations at the World Intellectual Property Organization’s Intergovernmental Committee (“WIPO IGC”) often struggle to reach agreement surrounding international protection of TK.²²³ Despite this, extant international law may serve as a source of inspiration, or even obligation, for the states to combat the issues they face regarding TK protection.²²⁴ Chief among these influential international provisions is the United Nations Declaration on the Rights of Indigenous Peoples (“UNDRIP”).²²⁵ UNDRIP provides indigenous peoples self-determination rights,²²⁶ including ways to “financ[e] their

²²² See *supra* Section II.B.(1)-(5).

²²³ See generally WIPO Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore, *The Protection of Traditional Knowledge: Draft Articles – Rev. 2*, WORLD INTELLECTUAL PROP. ORGANIZATION [WIPO] (Sept. 5, 2018) https://www.wipo.int/meetings/en/doc_details.jsp?doc_id=414871 [<https://perma.cc/HVP8-34CG>].

²²⁴ Customary international law is generally thought to be binding upon the states as federal common law through the Supremacy Clause. See RESTATEMENT (THIRD) OF THE FOREIGN RELATIONS LAW OF THE UNITED STATES § 111 (AM. LAW. INST. 1987); see also Gary Born, *Customary International Law in United States Courts*, 92 WASH. L. REV. 1641, 1642–43 (2017).

²²⁵ G.A. Res. 61/295, *Universal Declaration on the Rights of Indigenous Peoples* (Sept. 13, 2007) [hereinafter UNDRIP]. The United States was one of only four countries to vote against UNDRIP. UNITED NATIONS DEP’T OF ECON. & SOC. AFFAIRS, *United Nations Declaration on the Rights of Indigenous Peoples*, UNITED NATIONS, <https://www.un.org/development/desa/indigenouspeoples/declaration-on-the-rights-of-indigenous-peoples.html> [<https://perma.cc/7MG7-3Q4E>].

²²⁶ UNDRIP, *supra* note 222, art. 4.

autonomous functions.”²²⁷ UNDRIP also requires member states to “provide effective mechanisms” to prevent deprivation of indigenous peoples “cultural values or ethnic identities,”²²⁸ and to prevent the taking of their “cultural, intellectual, religious and spiritual property” without prior and informed consent.²²⁹ These principles were further explicated in the Nagoya Protocol, a supplemental agreement to the Convention on Biological Diversity.²³⁰

The Nagoya Protocol requires member nations to ensure that “traditional knowledge associated with genetic resources that is held by indigenous and local communities is accessed” on mutually agreed upon terms and with prior informed consent.²³¹ The Protocol promotes the development of model contractual clauses to improve access and benefit sharing.²³² Using these guiding principles in both UNDRIP and the Nagoya Protocol, state courts may craft common law or constitutional TK misappropriation principles to function as baseline implied contractual or privacy expectations.²³³ For example, state courts could find that non-Native Americans who have gained knowledge from Native Americans to be bound under the doctrine of promissory estoppel,²³⁴ and could further supplement this implied contract with essential terms²³⁵ drawn from the Nagoya Protocol. State courts could also find that use of traditional knowledge gained from Native Americans without prior informed consent, as required by Nagoya, to be “highly offensive to a reasonable person,” which is a required component of many privacy torts.²³⁶

Suggesting that states look to international law as a source of domestic policies is not a radical proposal. While putative judicial action is the focus of this article, state legislatures and executive branches have already looked to international agreements to craft policy. In light of the United States’ withdrawal from the Paris Agreement on climate change, numerous states and cities have announced voluntary accession toward meeting the agreement targets.²³⁷ Some

²²⁷ *Id.*

²²⁸ *Id.* art. 8(2)(a).

²²⁹ *Id.* art. 11(2).

²³⁰ Nagoya Protocol, *supra* note 39; Konstantia Koutouki & Katherine Rogalla von Bieberstein, *The Nagoya Protocol: Sustainable Access and Benefits-Sharing for Indigenous and Local Communities*, 13 VT. J. ENVTL. L. 513, 514-15 (2013).

²³¹ Nagoya Protocol, *supra* note 39, art. 7, at 10.

²³² *Id.* art. 19, at 16.

²³³ See RESTATEMENT (SECOND) OF TORTS § 652A-E (AM. LAW INST. 1977) (describing various privacy torts); Rex D. Glensey, *The Use of International Law in U.S. Constitutional Adjudication*, 25 EMORY INT’L L. REV. 197, 265-66 (2011) (discussing how the Supreme Court applies international law when the United States is not a signatory).

²³⁴ See RESTATEMENT (SECOND) OF CONTRACTS § 90 (AM. LAW. INST. 1981).

²³⁵ See *id.* § 204.

²³⁶ See RESTATEMENT (SECOND) OF TORTS, *supra* note 234, at § 652A, B, D, & E.

²³⁷ See Kevin De Leon & Kevin Ranker, *A Year after Trump Exited the Paris Climate Accord, Here’s How States Are Going Even Further*, CNBC (May 31, 2018, 11:02 AM), <https://www.cnbc.com/2018/05/31/after-trump-paris-climate-accord-exit-states-take-the->

states went so far as to form the U.S. Climate Alliance.²³⁸ These states make up half of the population²³⁹ and gross domestic product of the U.S.,²⁴⁰ which represents one quarter of the United States' carbon dioxide emissions.²⁴¹ This alliance, were it a country, would be the third largest economy in the world, behind only the U.S. and China.²⁴² States have a sovereign interest in preserving not only their own physical lands but also the health and well-being of citizens and indigenous peoples, including cultural expression. In much the same as the elected branches of state governments have already adhered to the policies of international agreements, in the absence of the federal government, so too can the judicial branch look to international law to craft the policies underlying its common law powers.

B. Common Law Cause of Action: Misappropriation of Traditional Knowledge

Due to the slow development of legal positivism for IP rights, state common law courts are considered the historical guardians of property rights.²⁴³ Professor Balganesch refers to the state courts' affirmative actions as "pragmatic incrementalism," in which these common law courts "look to the practical needs of a particular area, recognize multiple values as relevant consideration there, and then adopt a highly contextual approach to protection"²⁴⁴ Professor Balganesch's explanation of Congress's incompetence towards property rights

lead.html [https://perma.cc/97KP-ZK4V]; see, e.g. State Legislators United for Climate Action, NAT'L CAUCUS OF ENVTL. LEGISLATORS, https://ncel.net/climate-action/ [https://perma.cc/2AS4-ZFWN].

²³⁸ For a list of states participating, see *About Us*, UNITED STATES CLIMATE ALL., https://www.usclimatealliance.org/about-us [https://perma.cc/SEG4-5FHR].

²³⁹ *Annual Estimates of Resident Populations for the United States, Regions, States, and Puerto Rico: April 1, 2010 to July 1, 2018*, UNITED STATES CENSUS BUREAU, https://www.census.gov/data/tables/time-series/demo/popest/2010s-state-total.html [https://perma.cc/LTS2-TAWH].

²⁴⁰ Regional Data, UNITED STATES BUREAU OF ECONOMIC ANALYSIS https://apps.bea.gov/iTable/iTable.cfm?0=1200&isuri=1&reqid=70&step=10&1=1&2=200&3=sic&4=1&5=xx&6=-1&7=-1&8=-1&9=70&10=levels#reqid=70&step=10&isuri=1&7003=200&7035=-1&7004=naics&7005=1&7006=xx&7036=-1&7001=1200&7002=1&7090=70&7007=-1&7093=levels [https://perma.cc/2U9S-KBQD].

²⁴¹ *State Carbon Dioxide Emissions*, UNITED STATES ENERGY INFO. ADMINISTRATION (Oct. 31, 2018), https://www.eia.gov/environment/emissions/state/ [https://perma.cc/4W57-FMBF].

²⁴² Andrew Light, *The World Is Moving On Since Trump Announced Intent To Withdraw From the Paris Agreement on Climate Change*, WORLD RES. INSTITUTE (May 30, 2018), https://www.wri.org/blog/2018/05/world-moving-trump-announced-intent-withdraw-paris-agreement-climate-change [https://perma.cc/YLQ2-RQ8F].

²⁴³ See Shyamkrishna Balganesch, *The Pragmatic Incrementalism of Common Law Intellectual Property*, 63 VAND. L. REV. 1543, 1544-45 (2010).

²⁴⁴ *Id.* at 1545.

protections is that “Congress has repeatedly extended the term and coverage of copyright protection, often bereft of any reason other than pure industry rent seeking”²⁴⁵ Attempts to reform these regimes face “interest group gridlock” that results in little substantive change to the subject matter of patents and copyright.²⁴⁶ Moreover, the justifications and limitations of current IP law do not conform to the needs of indigenous people and TK.²⁴⁷ For example:

[T]ribal interests may differ from other interests in intellectual property in several ways: the rights may be held collectively rather than individually; the rights may be held in trust by the tribe as a whole or a subgroup for the benefit of others in the tribe; the tribe may have religious or other interests in keeping the information secret or in refusing to talk about it with outsiders or even insiders; the tribe may have interests in preventing, rather than exploiting, the commercial use of the resources; and the interests may be intertwined with sacred ceremonies or religious traditions that give them special significance and demand special treatment.²⁴⁸

A number of commentators, including Professors Balganesch, Dan Burk and Mark Lemley, have all called for a re-engagement of courts and the common law in our rights regimes, particularly regarding IP rights.²⁴⁹ While the common law method has its detractors,²⁵⁰ an increasing understanding of how creativity develops may require “situational flexibility [that] may be more valuable than the certainty derived from inadequate information” of ex ante IP legislation.²⁵¹ And while the legislatures of both the states and federal government have codified certain areas of IP law, such as copyright and trade secrets, these areas of law stem from the common law.²⁵² As our current statutory rights for IP

²⁴⁵ *Id.* at 1546.

²⁴⁶ *Id.* at 1547. The most recent change to the patent regime, the Leahy-Smith America Invents Act, Pub. L. 112–29, consists almost entirely of procedural changes, such as switching from a first-to-invent to a first-to-file system as well as creating additional proceedings to invalidate a patent on limited grounds. Smitha Uthaman, *Summary of the America Invents Act*, THE NAT'L L. REV. (Apr. 12, 2012), <https://www.natlawreview.com/article/summary-america-invents-act> [<https://perma.cc/M7B5-G6Z6>].

²⁴⁷ See COHEN, *supra* note 140, at 1308.

²⁴⁸ *Id.* at 1308–09; see also Terence Dougherty, *Group Rights to Cultural Survival: Intellectual Property Rights in Native American Cultural Symbols*, 29 COLUM. HUM. RTS. L. REV. 355, 378 (1998) (arguing for group rights under the Lanham Act); Rebecca Tsosie, *Reclaiming Native Stories: An Essay on Cultural Appropriation and Cultural Rights*, 34 ARIZ. ST. L.J. 299, 346–58 (2002) (evaluating a hypothetical right to culture to accommodate the unique needs of indigenous peoples).

²⁴⁹ See Balganesch *supra* note 237, at 1546; see also Dan L. Burk & Mark A. Lemley, THE PATENT CRISIS AND HOW THE COURTS CAN SOLVE IT 104, 104 (2009).

²⁵⁰ See, e.g., Frederick Schauer, *The Failure of the Common Law*, 36 ARIZ. ST. L.J. 765, 781–82 (2004).

²⁵¹ Balganesch, *supra* note 237, at 1549.

²⁵² *Id.* at 1554–56, 1562–64 (tracing the common law history of trade secrets and copyright law).

originated from and developed through the common law, so too can a right to protect TK.

I renew the reminder that IP rights are not the exclusive lens through which to view the protection of TK. Instead, this proposal discusses IP for two primary reasons. First, the development of IP rights through the common law, especially those of trade secret misappropriation, provides a useful template for the development of rights in TK. So too, of course, can the rubric of other positive common law causes of action. This includes tort, trespass, breach of implied contract, unjust enrichment, and unfair competition, in addition to defensive protections against falsely identified goods through the promulgation of databases. These areas of law inform the courts as they develop the common law of TK rights. Second, the specter of a preemptive regime of federal IP law requires that a common law right in TK be appropriately crafted to evade preemption.

For those common law courts uneasy with the extension of TK rights,²⁵³ these courts may define this right at the outset in several ways. First, courts may limit the right based on a specific relationship between the parties.²⁵⁴ This requirement is central to trade secret and misappropriation claims.²⁵⁵ Second, courts may limit the right based on subject matter. This requirement is central to common law copyright, as well as statutory regimes like patents and federal copyright.²⁵⁶ The benefit of subject matter limitations is that they filter protection “independent of the defendant’s actions.”²⁵⁷ Third, courts may limit the right based on remedy or underlying rights.²⁵⁸ This requirement of limiting remedies to those such as specific injunctive relief (attribution), avoids preemption by federal copyright and further ensures that the remedy is proportional to the harm.²⁵⁹

A common law regime to protect TK may therefore restrict itself by engaging all three requirements, to varying degrees, and evolve over time after observing the externalities of its cause of action. These restrictions serve two important purposes. The first, and most practical, is that these restrictions would aid the cause of action in surviving preemption challenges. The second is that these restrictions would allow the courts to effectively test the waters; to observe the short-term and long-term impacts of its balance between promoting the free exchange of ideas and preventing non-indigenous persons from unjustly enriching in the cultural fruits of TK-holders and subsequently adjust the doctrine accordingly.

²⁵³ See Munzer & Raustiala, *supra* note 14 at 43-45.

²⁵⁴ See, e.g., Balganes, *supra* note 237, at 1570-71 (referring to such property interests as “relational property”).

²⁵⁵ *Id.* at 1571.

²⁵⁶ *Id.* at 1572.

²⁵⁷ *Id.*

²⁵⁸ See *infra* Section III.B.3.

²⁵⁹ *Id.*

1. Relational limitations

An example within the small group of successful claims of misappropriation of TK, *Havasupai Tribe v. Arizona Bd. of Regents*, required a stringent pre-existing relationship between the parties.²⁶⁰

In *Havasupai Tribe*, an Arizona State University (“ASU”) professor had formed an educational relationship with the Havasupai Tribe over the course of several decades.²⁶¹ A self-perceived epidemic among the tribe led the professor, interested more in schizophrenia, to successfully pursue a grant and subsequently collect blood samples from over 200 Havasupai.²⁶² In exchange for the blood samples, ASU permitted 15 Havasupai to attend some summer classes for free.²⁶³ Despite the project’s cessation, researchers inside and outside of ASU, continued to study the blood sample data.²⁶⁴ The published articles based on the genetic resources discussed “inbreeding and theories about ancient human population migrations from Asia to North America” which was antithetical to the “Havasupai belief that, as a people, they originated in the Grand Canyon.”²⁶⁵ Professor Martin, upon discovering the research was still being conducted without the tribal members’ consent, complained to ASU and informed the tribe.²⁶⁶

The Havasupai Tribe ultimately sued, filing an amended complaint based on “breach of fiduciary duty, fraud, negligence and trespass.”²⁶⁷ A companion case filed by members of the Havasupai Tribe including member Tilousi, claimed “negligent and intentional infliction of emotional distress and negligence.”²⁶⁸ After the trial court dismissed the claims, the issue on appeal was whether the plaintiffs had complied with an Arizona state statute, which required the claim be accompanied by notice of a proposed settlement amount and supporting facts.²⁶⁹ The Tilousi case is emblematic of the fundamental problems with TK. How does one value TK, such as genetic resources, to comply with procedural requirements?

This fundamental struggle is also found in the U.S. Supreme Court’s decision in *International News Service v. Associated Press*.²⁷⁰ In *International News*

²⁶⁰ See generally *Havasupai Tribe v. Ariz. Bd. Of Regents*, 204 P.3d 1063 (Ariz. Ct. App. 2008).

²⁶¹ *Id.* at 1066.

²⁶² *Id.* at 1066-67.

²⁶³ *Id.* at 1067.

²⁶⁴ *Id.*

²⁶⁵ *Id.*

²⁶⁶ *Id.*

²⁶⁷ *Id.* at 1070.

²⁶⁸ *Id.* at 1071.

²⁶⁹ *Id.* at 1073; see also ARIZ. REV. STAT. ANN. § 12-821.01A. (2015). The tribes in the initial lawsuit had sought a lump sum of \$50,000,000 whereas the individual plaintiffs in the second lawsuit sought up to \$190,000 each. *Havasupai Tribe*, 204 P.3d at 1071.

²⁷⁰ *Int’l News Serv. v. Associated Press*, 248 U.S. 215, 246 (1918).

Service, the Court sustained an equitable claim of misappropriation of “hot news” stories.²⁷¹ Insofar as *International News Service* was based on a federal general common law claim, it was overruled by *Erie Railroad Co. v. Tompkins*.²⁷² However, the 1976 amendments to the Copyright Act explicitly acknowledged that claims like those made in *International News Service* under state law survive preemption.²⁷³ Specifically, the legislative history of the 1976 amendments reveals that:

[S]tate law should have the flexibility to afford a remedy, (under traditional principles of equity) against a consistent pattern of unauthorized appropriation by a competitor of the facts (i.e. not the literary expression) constituting “hot” news, whether in the traditional mold of [*International News Service*] or in the newer form of data updates from scientific, business, or financial data bases.²⁷⁴

In this sense, misappropriation under the *INS* rubric does not require the sort of special relationship of trade secrecy or even the pre-existing relationship of *Havasupai Tribe*. Instead, a more capacious definition of which entities constitute “competitor[s] of the facts” could encompass a right in TK.²⁷⁵ For example, a tribe could create a database of its TK and protect it through both defensive measures including invalidating patents under prior art,²⁷⁶ and offensive measures such as database misappropriation claims similar to *INS*.

2. Subject matter limitations

Some commentators have proposed TK protections under the veil of trade secret law.²⁷⁷ However, such protections are generally insufficient as they would only protect knowledge kept secret and having potential economic benefit by virtue of its secrecy.²⁷⁸ These requirements eliminate protection for TK that has a public nature to it, such as traditional dances or other religious ceremonies taking place in public areas like national parks. These requirements also

²⁷¹ *Id.* at 245–46.

²⁷² *Erie R.R. Co. v. Tompkins*, 304 U.S. 64, 78 (1938).

²⁷³ *Nat’l Basketball Ass’n v. Motorola, Inc.*, 105 F.3d 841, 845 (2d Cir. 1997) (citing H.R. REP. NO. 94–1476, at 132 (1976)).

²⁷⁴ H.R. REP. NO. 94–1476, at 132.

²⁷⁵ *See id.*

²⁷⁶ WIPO, for example, hosts several online repositories of submitted TK that serves as a source of prior art. *See Online Databases and Registries of Traditional Knowledge and Genetic Resources*, WIPO https://www.wipo.int/tk/en/resources/db_registry.html [<https://perma.cc/2HKR-AMCR>]. In addition, some countries have an explicit *sui generis* database right. *See Database Directive*, 96/9, 1996 O.J. (L 77) 20, 21 (EC). However, the United States does not protect databases unless their organization reflects creative expression. *See Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345–46, 348 (1991).

²⁷⁷ *See* Gelvina Rodriguez Stephenson, *Trade Secrets: The Secret to Protecting Indigenous Ethnobiological Knowledge*, 32 N.Y.U. INT’L L. & POL. 1119, 1119–21 (2000).

²⁷⁸ *See* UNIF. TRADE SECRETS ACT § 1.4 (UNIF. LAW COMM’N 1985).

eliminate protection for TK that lacks a cognizable economic benefit by virtue of its secrecy. Many forms of TK, like particular patterns and other works of art, only have economic value when used in public trade. Certain other forms of TK may have no economic value regardless of their public nature, instead having immense and incalculable cultural value that the law has traditionally struggled to evaluate.

Moreover, requiring TK be kept secret furthers a misunderstanding of indigenous peoples by society at large. Certain indigenous groups may wish to publicly share and explain the cultural value of their heritage with the simultaneous expectation that others will not appropriate it in a manner that the originators find culturally harmful.

3. Right/Remedy Limitations

While subject matter and relational limitations are one means of avoiding copyright preemption, remedial limits based on the specific underlying right are another. The benefit of a remedial limitation is that it allows a wider range of subject matter to be protected. Contrastingly, the obvious detriment is the relative lack of court-enforceable rights. Nevertheless, for many TK-holders, the exclusive rights protected by Section 106 of the Copyright Act may not be required to satisfy the degree of protection desired, especially since the exclusive rights under Section 106 are primarily economic rights, for which TK-holders may have little interest in enforcing.²⁷⁹

As a reminder, the exclusive rights of a copyright holder upon which a remedy may be afforded are the rights of reproduction, preparation of derivative works, distribution, public performance, public display, and public digital audio transmission.²⁸⁰ Untested is if subject matter protected by federal copyright under Section 102 would be preempted if the sole rights afforded were the moral rights of, for example, attribution and integrity.²⁸¹ The plain text of the preemption provisions would suggest that these claims would not be preempted.²⁸² Accordingly, a tribe could bring a common law claim covering, for example, a particular weaving design traditionally used by the tribe and sue a manufacturer of knock-off products using the traditional design.²⁸³ If the manufacturer clearly labels the product as non-authentic, they avoid liability under IACA, leaving the tribe with no federal recourse. The tribe could, however, under the proposed common law action, require the manufacturer to clearly attribute the design to the indigenous tribe. To avoid possible VARA preemption, the claim would either comprise subject matter not covered by

²⁷⁹ See 17 U.S.C. § 106 (2006).

²⁸⁰ *Id.*

²⁸¹ See *id.* § 102.

²⁸² For a more thorough analysis of the preemption scheme of federal copyright, see *supra* Section I.B.

²⁸³ Styles, such as typefaces, are not copyrightable. See 37 C.F.R. § 202.1(e) (2017).

VARA, i.e. anything besides a work of visual art under Section 101,²⁸⁴ or the common law claim could only be brought after the death of the author.²⁸⁵

Whether the tribe could claim a right of integrity is a far more difficult question. For extant works, like historical cultural and religious objects, a tribe may be able to bring a common law claim against a non-federally funded museum or private owner, both of which escape the reach of NAGPRA.²⁸⁶ The tribe could claim that the placement of such a cultural object in a museum or in the hands of a private holder offends the integrity of the author's reputation, especially if the original purpose of the object was for use in private religious ceremonies.

Even more challenging under a right of integrity would be the situation where a replica of the original traditional work was then altered and used in a manner that offends the integrity of the tribe. The creation of the replica would clearly be a reproduction under Section 106,²⁸⁷ thus preempted, and any subsequent physical alteration is arguably a derivative work. In these cases, it may be that the right of integrity is preempted by federal copyright.

In sum, common law courts may look not only to international law governing protections for TK, but also traditional common law causes of action such as misappropriation. To escape preemption, a common law cause of action for misappropriation of TK could either protect subject matter not governed by federal patent or copyright law, like that content protectable under trade secret law, or provide rights and remedies not available under federal law, like the moral rights of attribution and integrity. A common law cause of action could then find a defendant liable for misappropriation of TK when:

1. The defendant knowingly produces, uses, publicly displays, sells, or offers for sale a tangible or intangible object that:
 - A. Adopts the traditional style, imagery, folklore, language; or
 - B. Uses genetic resources in a manner consistent with the traditional use thereof; and
2. The traditional knowledge is held by a federal or state recognized tribe or member therefrom; and
3. The defendant, without permission, fails to properly, publicly, and correctly attribute the source of the traditional knowledge; and
4. The defendant's use occurred outside of tribal or federal land.

Such a cause of action would ultimately provide one additional avenue for indigenous peoples of the U.S. to deter misappropriation of their TK goods.

²⁸⁴ 17 U.S.C. § 101 (defining a "work of visual art").

²⁸⁵ *Id.* § 106A(d) (defining VARA rights as terminating at the death of the author); *Id.* § 301(f)(2)(c) (explicitly non-preempting state "legal or equitable rights which extend beyond the life of the author").

²⁸⁶ 25 U.S.C. §§ 3001-3013 (2012).

²⁸⁷ 17 U.S.C. § 106(1) (2012).

C. Recognizing Native American Rights under State Constitutions

Absent the common law as a source of TK rights for Native Americans, state constitutions themselves may serve a similar role.²⁸⁸ Several state constitutions contain explicit substantive rights for indigenous peoples that state courts have, in fact, enforced. The Montana State Constitution and educational rights for American Indian children and the Hawai'i State Constitution and customary land rights of Native Hawaiians are analyzed below. Both of these provisions, as well as the general substantive due process provisions of other state constitutions, may serve as sources of substantive rights for indigenous people to enforce their protected cultural rights.

1. The Montana Constitution, Article X, and Education

The State of Montana ratified a new state constitution in 1972.²⁸⁹ In doing so, Montana adopted a unique provision in Article X that acknowledged the “distinct and unique cultural heritage of the American Indians,”²⁹⁰ “committing the state in its educational endeavors to the preservation of Indians’ cultural integrity.”²⁹¹ This provision confers “a special burden in Montana for the education of American Indian children” in school funding.²⁹² Despite the fact that American Indian Schools receive federal funding, the state legislature is not relieved of its own financial responsibilities towards the schools.²⁹³ Montana courts have acknowledged that this supplemental funding is required “because of the extraordinary educational difficulties present [for Native American students]—language barriers, poverty, unemployment, and cultural differences.”²⁹⁴ Indeed, drawing power from Article X, Montana courts have emphasized that they “are cognizant of [the court’s] responsibility to promote and protect the unique Indian cultures [in the] state for all future generations of Montanans.”²⁹⁵

²⁸⁸ Cf. Brennan, *supra* note 2. Of course, state legislatures have far broader powers to enact law. For the reasons described in Section II, the courts have the ability to more rapidly respond to changes in the underlying doctrine based upon actual cases and controversies before them.

²⁸⁹ G. Alan Tarr, *The Montana Constitution: A National Perspective*, 64 MONT. L. REV. 1, 4 (2003).

²⁹⁰ MONT. CONST., art. X, § 1, para. 2.

²⁹¹ Tarr, *supra* note 283, at 16.

²⁹² Helena Elementary Sch. Dist. No. 1 v. State, 769 P.2d 684, 693 (Mont. 1989).

²⁹³ *See id.* at 692.

²⁹⁴ *Id.*

²⁹⁵ Matter of M.E.M., 635 P.2d 1313, 1316 (Mont. 1981); *accord.* Matter of Adoption of Riffle, 922 P.2d 510 (Mont. 1996) Both of these adoption cases involved the application of the Indian Child Welfare Act and matters in which Montana’s state courts cited their own obligations under the Montana Constitution to preserve and promote the cultural identities of American Indians. *See also* State v. Shook, 67 P.3d 863, 866-67 (Mont. 2002) (citing Article X of the Montana Constitution in upholding a regulation that denied non-tribal Indian members the ability to hunt big game on tribal land).

In at least one case, a party alleged that Article X, in conjunction with Article II, provides that “the dignity of the human being is inviolable”²⁹⁶ and creates a private right of action to challenge a school district’s use of offense Native American imagery and mascots.²⁹⁷ The Montana Supreme Court did not address this issue and instead, required the plaintiffs to first exhaust their administrative remedies by first bringing the issue to the Montana Human Rights Commission.²⁹⁸ Should a putative plaintiff exhaust administrative remedies and bring a ripe claim before the Montana Supreme Court, the value of cultural expression and self-determination in the educational setting, as the federal government has recognized through NALA, could be recognized under the state constitution.²⁹⁹

2. The Hawaiian Constitution and Customary Rights

Hawai’i is one of the few states that has written into its state constitution an office dedicated to, governed by, and elected by indigenous people: the Office of Hawaiian Affairs (“OHA”).³⁰⁰ The lattermost requirement, however, was held unconstitutional under the 15th Amendment of the U.S. Constitution by the U.S. Supreme Court in *Rice v. Cayetano*.³⁰¹ The 9th Circuit similarly held the Native Hawaiian ancestry requirement for OHA trustee candidates unconstitutional under the 15th Amendment in *Arakaki v. Hawai’i*.³⁰² The Hawai’i Constitution also codifies the recognition of customary and traditional rights of Native Hawaiian tenants in housing law.³⁰³

Native Hawaiian customary law plays an important role in the legal system of Hawaii. While statutory law supersedes inconsistent customary law, customary law displaces inconsistent common law and can clarify ambiguous statutes.³⁰⁴ Of particular note is the effect the state courts have given to customary law in the realm of real property.³⁰⁵ For example, the Hawai’i

²⁹⁶ MONT. CONST., art. II, § 4. The cruel and unusual punishment provision of Article II has been affirmed by the Montana Supreme Court to provide protections above and beyond those of the nearly identically worded 8th Amendment of the United States Constitution. *See Walker v. State*, 68 P.3d 872, 885 (Mont. 2003).

²⁹⁷ *Dupuis v. Board of Trustees*, 128 P.3d 1010, 1013 (Mont. 2006).

²⁹⁸ *Id.* at 1013–14.

²⁹⁹ *See supra* Section III.B.4.

³⁰⁰ HAW. CONST. art. XII, §§ 5-6.

³⁰¹ *Rice v. Cayetano*, 528 U.S. 495, 523-24 (2000). The Court arrived at this conclusion due to the fact that Congress had not yet determined that Native Hawaiians held similar status to Indian tribes, nor delegated its inherent authority to regulate them to the State of Hawaii. *Id.* at 519–20.

³⁰² *Arakaki v. Hawai’i*, 314 F.3d 1091, 1093 (9th Cir. 2002).

³⁰³ HAW. CONST. art. XII, § 7.

³⁰⁴ COHEN, *supra* note 140, at 960-61 (citing cases that have upheld this practice).

³⁰⁵ *See generally* Balganes, *supra* note 237, at 1579–80 (discussing the utility of custom in the common law).

Supreme Court analyzed the conflict between customary law and matters involving trespass in *State v. Hanapi*.³⁰⁶ The defendant in *Hanapi* had been convicted of criminal trespass after he had entered and refused to leave a neighboring property containing a pair of fishponds undergoing wetland restoration that he claimed his family had used for “traditional native Hawaiian religious, gathering, and sustenance activities.”³⁰⁷ On appeal, the defendant argued that the trial court improperly excluded testimony meant to establish his constitutional right under customary law as a Native Hawaiian to enter the private property.³⁰⁸ The Hawai’i Supreme Court examined his claim, noting that “[t]his court has consistently recognized that the *reasonable* exercise of ancient Hawaiian usage is entitled to protection under article XII, section 7.”³⁰⁹ Moreover, Native Hawaiians possessed a limited property interest in Hawaiian land.³¹⁰ Such limited property interest, combined with reasonable traditional use, could “qualify as a privilege for purposes of enforcing criminal trespass statutes.”³¹¹

To qualify for the privilege, however, the defendant had to show: (1) that they were a native Hawaiian, (2) that their act is protected as a customary or traditional native Hawaiian practice, and (3) that the act occurred on undeveloped or underdeveloped land.³¹² The second requirement was the only one at issue in *Hanapi*, and the Hawai’i Supreme Court found that the defendant had failed to produce evidence at trial to support such a finding.³¹³ While the defendant subjectively believed that his actions were protected, objective evidence was ultimately required and, in this case, did not exist.³¹⁴

There is little justification to limit the traditional and customary rights of Native Hawaiians to real property.³¹⁵ Instead, “the retention of a Hawaiian tradition should in each case be determined by balancing the respective interests and harm once it is established that the application of the customer has continued

³⁰⁶ *State v. Hanapi*, 970 P.2d 485, 495 (Haw. 1998).

³⁰⁷ *Id.* at 486.

³⁰⁸ *Id.*

³⁰⁹ *Id.* at 492 (internal quotation marks and citations omitted, emphasis in original).

³¹⁰ *Id.*

³¹¹ *Id.*

³¹² *Id.* at 493-94.

³¹³ *Id.* at 495.

³¹⁴ *See id.* (At trial, the defendant “reiterated his responsibility and sense of obligation to the land, as a native Hawaiian tenant, to justify his privileged access to [the] property.”).

³¹⁵ Some Native Hawaiian groups have called for an engagement of state trademark law to protect traditional cultural expressions. *See* Nina Mantilla, *The New Hawaiian Model: The Native Hawaiian Cultural Trademark Movement and the Quest for Intellectual Property Rights to Protect and Preserve Native Hawaiian Culture*, 3 AM. U. INTELL. PROP. BR. 25, 38–41 (2011). *See also* R. Hokulei Lindsey, *Reclaiming Hawai’i: Towards the Protection of Native Hawaiian Cultural and Intellectual Property*, 1 UCLA INDIGENOUS PEOPLES’ J. L., CULTURE, AND RESISTANCE 110, 130-32 (2004).

in a particular area [or discipline].”³¹⁶ Common law courts have proven particularly adept at balancing the interests.³¹⁷ The courts of Hawai’i have consistently recognized that cultural rights can coexist with those of Western private property rights.³¹⁸ Though intellectual property rights of Native Hawaiians are yet to be fully recognized under the Hawaiian Constitution, judicial awareness of the cultural values of Native Hawaiians is, at least, a good first step.³¹⁹

CONCLUSION

Extant federal law provides some avenues of protection of TK created by Native American tribes, Native Hawaiian Organizations, and Alaska Native Corporations. These federal protections, however, are highly limited in subject matter and scope. In a federal system like that of the U.S. states serve a critical role in promoting the flourishing of historically disadvantaged groups. State common law and constitutional causes of action provide avenues to protect TK from both financial and cultural appropriation. State laws governing moral rights of attribution and misappropriation, and substantive state constitutional rights all may fill the void left in federal law. The courts, by exercising their common law and interpretive powers, may not only facilitate the self-determination of indigenous peoples, but also adjust and adapt the underlying doctrines to provide socially optimal outcomes.

³¹⁶ *Kalipi v. Hawaiian Trust Co.*, 656 P.2d 745, 751 (Haw. 1982).

³¹⁷ See generally Balganes, *supra* note 237 at 1545-45, 1549.

³¹⁸ For a review of Hawaiian Supreme Court decisions on the application of Native Hawaiian traditional and customary law, see Danielle Conway, *Indigenizing Intellectual Property Law: Customary Law, Legal Pluralism, and the Protection of Indigenous Peoples’ Rights, Identity, and Resources*, 15 TEX. WESLEYAN L. REV. 207, 242 (2009).

³¹⁹ See, e.g., *Reece v. Island Treasures Arts Gallery, Inc.*, 468 F. Supp. 2d 1197, 1199–200 (D. Haw. 2006) (discussing the cultural importance of hula dance in the context of copyright infringement). *But see* Conway, *supra* note 312, at 241–42, 45–51 (discussing the inherent limitations of *Reece* and criticizing its absent discussion of the Hawaiian Constitution).