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**THE EVER-EXPANDING COMPLETE PREEMPTION DOCTRINE AND
THE COPYRIGHT ACT: IS THIS WHAT CONGRESS REALLY
WANTED?**

Elizabeth Helmer¹

*This comment explores the ways in which the doctrines of preemption, and more recently, complete preemption are being applied to the Copyright Act. In deciding whether claims are preempted by the Copyright Act, courts apply the “Extra Element Test.” However, courts are increasingly applying this test by looking at the facts underlying the claim, rather than the elements needed to prove the claim, and preempting more readily. Once satisfied that the claim is preempted, some courts are allowing complete preemption to take hold, and removing the claim to federal court. Courts have traditionally tried to determine whether Congress intended to allow removal, since Congressional intent is the touchstone of removal jurisdiction. However, in light of the Supreme Court’s decision in *Beneficial National Bank v. Anderson*, some courts have departed with the Congressional intent requirement, holding that by wholly displacing an area of law, Congress intended to create complete preemption. This lax application of the complete preemption doctrine has led to unexplainable results, undermines Congressional intent to preserve various state law claims, and threatens to erode long standing jurisdictional principles.*

I. INTRODUCTION

Under the long established “well pleaded complaint” rule, a cause of action arises under federal law only when the face of the

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complaint raises a federal issue.² A complaint presents a federal question by invoking federal law as the basis for relief.³ It does not suffice that the facts alleged in support of an asserted state-law claim would also support a federal claim.⁴ Thus the plaintiff, as “master of the complaint,”⁵ can craft a cause of action as arising under state rather than federal law and “a defendant cannot remove on the basis of a federal question even if the plaintiff could have asserted a federal claim.”⁶ As this pertains to cases falling within the scope of the Copyright Act, the “well pleaded complaint” doctrine suggests that by bringing a cause of action under state law, rather than the Copyright Act,⁷ the plaintiff can effectively avoid federal question jurisdiction.⁸

Although the well pleaded complaint requirement continues to apply in most cases, in limited circumstances it has been supplanted by the doctrine of “complete preemption.” Complete preemption is distinct from the doctrine of ordinary preemption

² *Metro. Life Ins. Co. v. Taylor*, 481 U.S. 58, 63 (1987) (citing *Gully v. First Nat'l Bank*, 299 U.S. 109 (1936); *Louisville & Nashville R. Co. v. Mottley*, 211 U.S. 149 (1908)).

³ *Beneficial Nat'l Bank v. Anderson*, 539 U.S. 1, 12 (2003) (Scalia, J., dissenting).

⁴ *Id.*

⁵ The master of the complaint doctrine was first announced by Justice Holmes in 1913: “Of course the party who brings a suit is master to decide what law he will rely upon and therefore does determine whether he will bring a 'suit arising under' the . . . law of the United States.” *The Fair v. Kohler Die & Specialty Co.*, 228 U.S. 22, 25 (1913).

⁶ *Freeman v. Bechtel*, 936 F. Supp. 320, 324 (M.D.N.C. 1996) (citing *Caterpillar, Inc. v. Williams*, 482 U.S. 386, 392 (1987)).

⁷ Federal law governs when a plaintiff pleads a cause of action arising under the Copyright Act, pursuant to § 1338 (a) of Title 28 of the United States Code.

⁸ Christopher Blackford, *Attention Shoppers: The Federal Circuit's Failure To Preempt Contractual Provisions Prohibiting Reverse Engineering May Create A Blue Light Special On Jurisdictional Forums*, 57 SMU L. REV. 63, 79 (2004); see *Caterpillar*, 482 U.S. at 392; *Die & Specialty Co.*, 228 U.S. at 25 (1913) (“Of course, the party who brings a suit is master to decide what law he will rely upon.”) (Holmes, J.); see also *Merrell Dow Pharm., Inc. v. Thompson*, 478 U.S. 804, n.6 (1986) (“Jurisdiction may not be sustained on a theory that the plaintiff has not advanced.”); *Great North R. Co. v. Alexander*, 246 U.S. 276, 282 (1918) (“[T]he plaintiff may by the allegations of his complaint determine the status with respect to removability of a case.”).

and has significant differences in terms of removal jurisdiction. Ordinarily, preemption is raised as a defense and does not serve as a basis for removal because the plaintiff's claims do not raise any federal issue and do not satisfy the "well pleaded complaint" rule. Rather, if the court finds that the plaintiff's state law claim is preempted by federal law, the claim is simply dismissed.⁹ A claim may be preempted expressly or impliedly. Express preemption occurs when Congress authorizes preemption within the statute itself.¹⁰ Implied preemption applies in situations where Congress has expressed intent to entirely occupy a field of legislation.

Preemption has long-been held to apply to claims falling within the scope and general subject matter of the Copyright Act.¹¹ In other words, when a claim is brought in state court that involves an original work of authorship fixed in a tangible medium of expression, and the right asserted is equivalent to one of the rights protected by federal copyright law, the claim is preempted and consequently dismissed.¹²

"Complete preemption," on the other hand, is a term used to define those situations in which preemption does provide a basis for removal. The complete preemption doctrine, which has been invoked in an ever-increasing number of cases and contexts, holds that narrow classes of claims are so "necessarily federal" that they will always permit removal to federal court, even if a federal issue is not raised on the face of the complaint.¹³ Thus, if a plaintiff files suit in state court based upon a state cause of action, and the defendant removes the case on the basis of a valid complete preemption defense, the federal district court will re-characterize

⁹ 14B CHARLES ALAN WRIGHT, ARTHUR R. MILLER & EDWARD H. COOPER, FEDERAL PRACTICE AND PROCEDURE: JURISDICTION 3D § 3722.1 (3d ed. 1998 and Supp. 2005) (discussing the difference in ordinary and complete preemption) (hereinafter "WRIGHT").

¹⁰ By saying, for example, "we hereby preempt."

¹¹ See 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT, § 1.01[B] at 1-10 (2004) (hereinafter "NIMMER").

¹² *Id.* See discussion of test *infra* pp. 11-13.

¹³ WRIGHT, *supra* note 9; see *Franchise Tax Bd. of Cal. v. Constr. Laborers Vacation Trust for S. Cal.*, 463 U.S. 1, 22-23 (1983) (Brennan, J., explaining Supreme Court's decision in *Avco Corp. v. Aero Lodge No. 735, Ass'n of Machinists & Aerospace Workers*, 390 U.S. 557 (1968)).

the plaintiff's claim as arising under federal law, making removal proper on the basis of federal question jurisdiction.¹⁴ In this way, the complete preemption doctrine overrides longstanding values of federalism as well as important limiting doctrines of federal subject matter jurisdiction, such as the "well pleaded complaint" rule and the principle that the plaintiff is master of the complaint.¹⁵

Since the emergence of the complete preemption doctrine, the Supreme Court has held that complete preemption applies in three types of cases: those that fall under the scope of the Labor and Management Relations Act ("LMRA"),¹⁶ the Employee Retirement Income Security Act ("ERISA"),¹⁷ and most recently, the National Bank Act ("NBA").¹⁸ The Supreme Court has not, however, addressed complete preemption under the Copyright Act. As a result, lower courts have been forced to grapple with the doctrine, fashioning various tests in an attempt to identify when, if ever, it would apply to the Act.¹⁹

This Comment will argue that in light of evolving legal methodologies, the once narrow doctrine of complete preemption is being applied more liberally, and in effect, denying plaintiffs the long-held freedom to act as the master of the complaint in deciding

¹⁴ See 28 U.S.C. § 1441(b) (2000) (governing removal and stating that "any civil action of which the district courts have original jurisdiction founded on a claim or right arising under the Constitution, treaties or laws of the United States shall be removable without regard to the citizenship or residence of the parties").

¹⁵ See WRIGHT, *supra* note 9; Tristin K. Green, *Complete Preemption—Removing the Mystery from Removal*, 86 CAL. L. REV. 363, 371 (1998).

¹⁶ See generally *Avco Corp.*, 390 U.S. 557 (1968) (holding that a state-court lawsuit to enjoin a defendant union from striking actually arose under § 301 of the Labor Management Relations Act ("LMRA") and allowing removal). Although the *Avco* Court did not mention artful pleading, preemption, or even the well-pleaded complaint rule, *Avco* is known for promulgating these doctrines based on the Court's later characterization of the case in *Franchise Tax Board v. Construction Laborers Vacation Trust*, 463 U.S. 1, 23-24 (1983).

¹⁷ See generally *Metro. Life Ins. Co. v. Taylor*, 481 U.S. 58 (1987) (holding that Congress intended to allow removal of claims that fell within the scope of ERISA).

¹⁸ See generally *Beneficial Nat'l Bank v. Anderson*, 539 U.S. 1 (2003) (holding that Usury claims against a nationally chartered bank are preempted by the National Bank Act).

¹⁹ WRIGHT, *supra* note 9.

whether to bring a cause of action under state or federal law. Part I explores the differences in the doctrines of ordinary and complete preemption. Since the Supreme Court has not expressly ruled on complete preemption under the Copyright Act, lower courts have struggled with a number of tests that often hinged on whether Congress intended not only to preempt claims under the Act, but more specifically, allow for complete preemption and removal.²⁰

Part II outlines the test lower courts have applied to determine whether a claim is preempted and expresses dissatisfaction with their application of the “extra element” test.²¹ Rather than comparing the elements needed to prove a state law claim with the elements needed to prove a Copyright claim, courts are scrutinizing claims to determine whether the facts giving rise to a state claim could theoretically give rise to a Copyright claim and then allowing preemption to take hold.

Part III argues that the Supreme Court’s ruling in *Beneficial National Bank v. Anderson*²² virtually eliminates the need to delve into Congressional intent before applying complete preemption, suggesting that by wholly displacing an area of law, Congress intended to allow removal. This more lenient standard essentially blurs the justifications that once separated ordinary and complete preemption doctrines. Complete preemption historically required a more explicit finding of Congressional intent because it represents a more drastic deviation from well-settled jurisdictional principles and should therefore be applied sparingly.²³

²⁰ See *Blab T.V. of Mobile, Inc. v. Comcast Cable Commc’ns, Inc.*, 182 F.3d 851, 856-57 (11th Cir. 1999) (describing the myriad of tests used by other Circuits).

²¹ The “extra element” test is supposed to ensure that rights and remedies that are different in nature from the rights comprised in a copyright and that may continue to be protected under State common law or statute. For example, a claim of fraud should remain unaffected because it included the additional element, breach of confidentiality. See H.R. Rep. No. 94-1476, at 132 (1976).

²² 539 U.S. 1 (2003).

²³ Another reason suggested for the Supreme Court’s reluctance to extend the doctrine is its potential to expand the courts’ federal question jurisdiction, a move that would increase the federal courts’ already burdened caseload. WRIGHT, *supra* note 9, at § 3522.2.

Part IV attempts to distinguish the Copyright Act from other statutes which the Supreme Court has held warrant complete preemption. Because the Copyright Act was drafted after the emergence of the doctrine of complete preemption, courts should continue to defer to Congressional intent, and find that Congress did not intend to allow for removal of claims under the Copyright Act.

Part V argues that the increasingly lax application of the complete preemption doctrine leads to unexplainable results, undermines Congressional intent to preserve various state law claims, and threatens to erode long-standing jurisdictional doctrines such as the “well pleaded complaint rule.”

This Comment concludes by summarizing the developments that have led to the expansion of the complete preemption doctrine and emphasizes the need to use a more rigorous standard that will ensure that our jurisdictional values are not ultimately eclipsed by it.

II. ORDINARY PREEMPTION UNDER THE COPYRIGHT ACT

Although ordinary preemption does not confer subject matter jurisdiction on a federal court, finding that ordinary preemption applies is a necessary predicate to the doctrine of complete preemption. In essence, complete preemption requires a more explicit finding of Congressional intent to control an area of the law than ordinary preemption. Therefore, lower courts must find that ordinary preemption applies before considering whether “Congress desired to control the adjudication of the federal cause of action to such an extent” that it not only provided preemption as a defense, but “replaced the state law with federal law and made it clear that the defendant has the ability to seek adjudication of the federal claim in a federal forum.”²⁴

Ordinary preemption applies to claims that fall under the Copyright Act. However, determining whether a claim actually falls under the Copyright Act is a task that has caused confusion

²⁴ WRIGHT, *supra* note 9.

among lower courts. Most courts apply a two part test: (1) the work must fall under the subject matter of copyright as an original work of authorship fixed in a tangible medium of expression (subject matter prong); and (2) the right asserted must be equivalent to one of the rights protected by federal copyright law (general scope prong).²⁵ Consequently, in a situation where the rights asserted under state or common law are not equivalent to a right protected under federal copyright law, ordinary preemption will not take hold.

A. *Subject Matter Prong*

The “subject matter” prong requires that the particular work to which the claim is being applied falls within the type of works protected by the Copyright Act under 17 U.S.C. §§ 102 and 103. Copyright protection subsists, in accordance with § 102:

in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

- (1) literary works;
- (2) musical works, including any accompanying words;
- (3) dramatic works, including any accompanying music;
- (4) pantomimes and choreographic works;
- (5) pictorial, graphic, and sculptural works;
- (6) motion pictures and other audiovisual works;
- (7) sound recordings; and
- (8) architectural works.

A work need not consist entirely of copyrightable material in order to meet the subject matter requirement, but instead need only fit into one of the copyrightable categories in a broad sense.²⁶

²⁵ See NIMMER, *supra* note 11.

²⁶ See Nat'l Basketball Ass'n v. Motorola, Inc., 105 F.3d 841, 848-50 (2d Cir. 1997) (holding that preemption under § 301 bars state law misappropriation claims with respect to “uncopyrightable as well as copyrightable” elements of televised basketball game).

B. *General Scope Prong*

Second, the “general scope” prong requires finding that the state claim seeks to vindicate rights equivalent to one of the exclusive rights protected by copyright law under 17 U.S.C. § 106.²⁷ Under 17 U.S.C. § 106, the owner of a copyrighted or derivative work has the exclusive rights to: reproduce the work, prepare derivative works based upon the copyrighted work, distribute the work to the public, perform the work publicly, display the work publicly, and perform the work publicly by means of a digital audio transmission.

A right granted by state law is regarded as equivalent when it provides an infringement action for the acts of “reproduction, adaptation, performance, and display, as set forth in § 106.”²⁸ On the other hand, a state claim is not preempted if it consists of “extra elements” that make it qualitatively different from a copyright infringement claim.²⁹ The Fourth Circuit has described the widely used “extra element” test in the following manner:

[W]hen a state law violation is predicated upon an act incorporating elements beyond mere reproduction or the like, the rights involved are not equivalent and preemption will not occur. To avoid preemption, a cause of action defined by state law must incorporate elements beyond those necessary to prove copyright infringement, and must regulate conduct qualitatively different from the conduct governed by federal copyright law.³⁰

This test is reinforced by 17 U.S.C. § 301(b)(3), which admonishes, “[n]othing in this title annuls or limits any rights or remedies under the common law or statutes of any State with respect to . . . activities violating legal or equitable rights that are

²⁷ *Rosciszewski v. Arete Assocs.*, 1 F.3d 225, 229 (4th Cir. 1994); *Briarpatch Ltd., L.P. v. Phoenix Pictures, Inc.*, 373 F.3d 296, 305 (2nd Cir. 2004).

²⁸ MARSHALL A. LEAFFER, *UNDERSTANDING COPYRIGHT LAW* § 11.7 (3rd. ed. 1999).

²⁹ *See Ritchie v. Williams*, 395 F.3d 283, 286 (6th Cir. 2005) (noting that most circuits use the “extra element” test).

³⁰ *Trandes Corp. v. Guy F. Atkinson Co.*, 996 F.2d 655, 660 (4th Cir. 1993) (holding that to prove misappropriation of a trade secret, plaintiff was required to prove elements beyond those required in a copyright infringement claim).

not equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106”³¹

Though the “extra element” test appears to provide somewhat of a safeguard against complete preemption, it has failed to provide any real guidance to the courts.³² One commentator lamented:

There is always some difference between the state law and the Copyright Act, so a court that wants to avoid preemption can always find some difference, however small, that is the “extra element” needed to avoid preemption. The net result is that courts seem to first decide independently whether or not they think preemption should apply, and then label the result accordingly. . . . Thus, the “extra element” test has proved circular in practice, and the cases are ad hoc, inconsistent, or wrong.³³

A review of recent court decisions, however, reveals that many courts are applying the “extra element” test in a manner that focuses more on the facts used to plead a claim, rather than the elements needed to prove a claim. This probing application of the test, perhaps more accurately called the “Let’s Get to the Bottom of this Complaint Test,” lends itself to supporting complete preemption under the Copyright Act.

For example, in *Briarpatch Ltd. v. Phoenix Pictures*,³⁴ the plaintiff brought an action for unjust enrichment. The basic elements for unjust enrichment in New York require proof that: (1) the defendant was enriched; (2) at the plaintiff’s expense; and (3)

³¹ 17 U.S.C. § 301(b) (2000). “The evolving common law rights of ‘privacy,’ ‘publicity,’ and trade secrets, and the general laws of defamation and fraud, would remain unaffected as long as the causes of action contain elements, such as an invasion of personal rights or a breach of trust or confidentiality, that are different in kind from copyright infringement.” H.R. REP. NO. 94-1476, at 132 (1976).

³² See Schuyler Moore, *Straightening Out Copyright Preemption*, 9 UCLA ENT. L. REV. 201, 204 (2002). One commentator complained that it “simply states a conclusion. When is a right provided by state law qualitatively different, and how different in nature must it be to escape preemption? In all but the simplest cases, the ‘extra element’ test cannot be applied with any certainty.” MARSHALL A. LEAFFER, UNDERSTANDING COPYRIGHT LAW § 11.7[C] (3d ed. 1999).

³³ Moore, *supra* note 32 at 204.

³⁴ See *Briarpatch Ltd., L.P. v. Phoenix Pictures, Inc.*, 373 F.3d 296 (2d Cir. 2004).

equity and good conscience militate against permitting defendant to retain what the plaintiff is seeking to recover.³⁵ In contrast, under copyright infringement, “a plaintiff must show that: (1) it owned a valid copyright; and (2) the defendant copied original elements of its copyrighted work.”³⁶ The different elements that make up the two claims are readily apparent. However, moving beyond the traditional confines of the “extra element” test, the court found that the plaintiffs’ unjust enrichment claim was the equivalent of a copyright infringement claim,³⁷ and therefore completely preempted. The court went on to hold that “while enrichment is not required for copyright infringement, we do not believe that it goes far enough to make the unjust enrichment claim qualitatively different from a copyright infringement claim.”³⁸

The Sixth Circuit recently endorsed an even more far-reaching approach, seemingly abandoning the “extra element” test altogether, in favor of what they perceive to be a national interest in ensuring unity under the Copyright Act.³⁹ In *Ritchie v. Williams*,⁴⁰ the defendant (Williams) brought counterclaims against the plaintiff (Kid Rock) for breach of contract, unjust enrichment, misrepresentation, conversion, and injunctive relief against further misappropriation of income derived from Kid Rock’s songs. Despite explicit Congressional intent to preserve breach of contract claims,⁴¹ as well as a myriad of other claims involving an extra element, the Sixth Circuit held that both the contract⁴² and tort

³⁵ *Id.* at 306 (citing *Clark v. Daby*, 751 N.Y.S. 2d 622, 623 (2002)).

³⁶ *Trandes Corp. v. Guy F. Atkinson Co.*, 996 F.2d 655, 660 (4th Cir. 1993) (citing *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991)).

³⁷ The court found that the plaintiff was essentially claiming the defendant had adapted a novel, copyrighted property, into a film without authorization. *Briarpatch*, 373 F.3d at 306.

³⁸ *See id.* at 305.

³⁹ *See generally Ritchie v. Williams*, 395 F.3d 283 (6th Cir. 2005).

⁴⁰ *Id.* at 288.

⁴¹ “Nothing in the bill derogates from the rights of parties to contract with each other and to sue for breaches of contract . . .” H.R. REP. NO. 94-1476, at 132 (1976).

⁴² Arguably, claims based on contract should never be preempted, since the rights arise under the contract, not state law, so preemption cannot logically apply. Moore, *supra* note 32. However, some courts have found that the contract itself or even a promise within the contract provide the extra element

claims were subject to complete preemption under the Copyright Act:

The parties agree . . . that these various 1989 alleged agreements were designed to control the ownership, performance rights and exploitation of copyrights on songs written by Kid Rock, including the performance, recording and distribution of those songs. The Williams group alleges that Kid Rock performed these songs and transferred to other parties the right to publish, record and distribute them, thereby breaching his contracts with Williams, the Michigan production company, the recording company and the publishing company.⁴³

In applying the “extra element” test, the court acknowledged that despite the presence of extra elements, if such elements were “merely illusory,” then the claim was equivalent to a copyright action.⁴⁴ The court focused on the facts underlying the claim rather than the elements needed to prove it. It found that all of the contractual and tort claims were “equivalent” to infringement claims and lacked a “meaningful ‘extra element’” needed to “remove the reformulated claims from the policy of national uniformity established by the preemption provisions of § 301 (a).”⁴⁵ To use Judge Friendly’s phrase, they are “infused with . . . national interests,” because the various publishing and

that would foreclose preemption. *See, e.g., Nat'l Car Rental Sys., Inc. v. Computer Assocs. Int'l, Inc.*, 991 F.2d 426, 431 (8th Cir. 1993) (“We conclude that the alleged contractual restriction on National’s use of the licensed programs constitutes an extra element in addition to the copyrighted rights making this cause of action qualitatively different from an action for copyright.”); *Dorsey v. Money Mack Music, Inc.*, 304 F. Supp. 2d 858, 865 (E.D. La. 2003) (“The existence of a promise . . . renders plaintiff’s claims qualitatively different from a copyright infringement claim, and thus cannot be preempted.”); *see also* Mark A. Lemley, *Beyond Preemption: The Law and Policy of Intellectual Property Licensing*, 87 CAL. L. REV. 111, 143 (1999) (“Courts considering . . . preemption of contract terms have reached different results in different cases. A number of courts have preempted contracts under both patent law and copyright law. Other courts have refused to preempt contract terms asserted to be at odds with the copyright or patent statutes.”).

⁴³ *Ritchie*, 395 F.3d at 288.

⁴⁴ *See id.*; *see also* *Bowers v. Baystate Technologies, Inc.*, 320 F.3d 1317, 1324 (Fed Cir. 2003) (“Claims might be preempted whose extra elements are illusory . . .”).

⁴⁵ *Ritchie*, 395 F.3d at 288.

performance rights of Kid Rock's songs should be the same in Michigan as they are in New York and other states.⁴⁶

Following this lax application of the "extra element" test, the court went on to consider whether it should dismiss the claims, as typically done pursuant to preemption, or recharacterize the claims as arising under the Copyright Act and remove the case to federal court. The Sixth Circuit, addressing complete preemption under the Copyright Act for the first time, concluded that Congress had indicated that "complete preemption is necessary in this field."⁴⁷ Once the court was satisfied that all claims had been completely preempted, warranting their recharacterization as copyright claims, the claims were dropped because the statute of limitations had run under the Copyright Act. Hence, the plaintiff was left without a valid complaint and no legal recourse.⁴⁸ This ironic result exemplifies the manner in which the application of the complete preemption doctrine undermines the principle that plaintiff is master of his complaint.

Imagine the following hypothetical scenario, as laid out by one commentator:

An enthusiastic film producer has a great idea for a film that she has never written down, and she tells this great idea to a studio executive over lunch. The studio executive then goes back to his office and writes a script based on the idea and proceeds to make a film based on the script. The producer then brings a state law claim, alleging misappropriation, conversion, unjust enrichment, fraud, and other nasty things. Putting aside the question of whether or not the producer should ultimately win the case, the producer should not be prohibited from bringing the state law claim on the basis of copyright preemption, because the producer does not own any exclusive rights to the tangible work (i.e., either the script written by the studio executive or the film produced by the studio).⁴⁹

Unfortunately, under current case law, whether the plaintiff is the owner of any exclusive rights to the tangible work in question

⁴⁶ *Id.* (internal citation omitted).

⁴⁷ *Id.*

⁴⁸ As Nimmer puts it, the alternative approach (allowing infringement claims even though a free-standing ownership claim would be time-barred) leads to results that are "potentially bizarre." NIMMER, *supra* note 11.

⁴⁹ MOORE, *supra* note 32.

is irrelevant. Once again, the plaintiff's state claims would be subject to preemption under the Copyright Act, leaving potential for those claims to be dropped altogether, despite the inequitable result.⁵⁰ This is precisely what happened in *Dielsi v. Falk*.⁵¹ The plaintiff, in *Dielsi*, a speech coach asserted that he wrote a potential script for "Columbo" entitled "Never Trust a Gambler." He submitted the script to the show's producer, though it was never accepted or rejected. The plaintiff alleged that his script was later used as the basis for an episode of "Columbo" entitled "Strange Bedfellows."⁵² The plaintiff's suit alleged a number of wrongs, including conversion and negligence. A California district court found that the plaintiff's claims of conversion and negligence were completely preempted by the Copyright Act, warranting removal to federal court.⁵³ Upon removal, however, the defendants pointed out that the copyright claim was procedurally defective. Though the work fell within copyright protection because it was an "original [work] of authorship fixed in a tangible medium of expression," it was not registered, and "no action for infringement of the copyright in any work shall be instituted until registration of the copyright claim has been made in accordance with [the copyright laws]."⁵⁴ Therefore, the claims were dropped, leaving the plaintiff without remedy.

These decisions indicate a growing willingness by the lower courts to allow preemption, and more specifically, complete preemption, even when doing so would leave the plaintiff without a remedy. Rather than looking for extra elements that should prevent preemption, courts are actually asking whether the claim is grounded on facts that *could have, in theory*, been the basis for a claim under the Copyright Act.⁵⁵

⁵⁰ Alternatively, the court could find that the claim was not preempted because this work of authorship was not fixed in any tangible medium of expression, and was therefore not within the subject matter protected by the Copyright Act.

⁵¹ See *Dielsi v. Falk*, 916 F. Supp. 985, 994 (C.D. Cal. 1996).

⁵² *Id.* at 987.

⁵³ *Id.* at 993.

⁵⁴ *Id.*

⁵⁵ Theoretically, in *Ritchie*, the plaintiff could have brought an action under the Copyright Act if the statute of limitations had not run. Similarly, in *Dielsi v.*

III. DETERMINING WHETHER COMPLETE PREEMPTION APPLIES

A. *Looking at Congressional Intent*

Though courts agree that preemption applies to claims arising under the Copyright Act, the issue of *complete* preemption remains unsettled. Once satisfied that a claim is preempted by the Copyright Act, courts, until recently, attempted to determine whether removal on the basis of § 301(a) of the 1976 Copyright Act (complete preemption) was proper. Mindful of separation of powers and federalism concerns, courts typically declined to allow removal absent Congressional intent to provide an exclusive federal cause of action.⁵⁶ Courts examined the substance and language of the federal statute, as well as the legislative history.⁵⁷ In essence, a complete preemption analysis focused on evaluating Congressional intent, the “touchstone” of federal court removal jurisdiction.⁵⁸

The statutory basis for preemption, § 301(a) of the Copyright Act, provides:

On or after January 1, 1978, 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 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103, whether created before or after that date and whether published or unpublished, are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any work under the common law or statutes of any State.⁵⁹

Falk, the plaintiff could have brought an action under the Copyright Act if she had registered her work.

⁵⁶ Arthur R. Miller, *Artful Pleading: A Doctrine in Search of Definition*, 76 TEX. L. REV. 1781, 1800 (1998).

⁵⁷ In *Avco* and *Metropolitan Life*, the statutory language provided an express federal remedy for the plaintiffs' claims. In addition, the legislative history “unambiguously described an intent to treat such actions as arising under the laws of the United States.” See *Beneficial Nat'l Bank v. Anderson*, 539 U.S. 1 (2003) (describing *Avco* and *Metropolitan Life*).

⁵⁸ *Metro. Life Ins. Co. v. Taylor*, 481 U.S. 58, 66 (1987).

⁵⁹ 17 U.S.C. § 301 (2000).

In *Rosciszewski v. Arete Associates*, a Fourth Circuit panel was among the first to extend the complete preemption doctrine to § 301(a) of the Copyright Act.⁶⁰ Reaching this decision, the panel focused on Congressional intent, particularly the legislative history, stating that “section 301 is intended to be stated in the clearest and most unequivocal language possible, so as to foreclose any conceivable misinterpretation of its unqualified intention that Congress shall act preemptively.”⁶¹ Although Congress did not use language in the Copyright Act similar to that found in the Labor and Management Relations Act (“LMRA”) or Employee Retirement Income Security Act (“ERISA”) to demonstrate its intent to allow removal,⁶² the panel nonetheless concluded that the broad preemptive force of § 301(a), in combination with the grant of exclusive federal court jurisdiction for actions arising under the Copyright Act, “compel[led] the conclusion that Congress intended that state-law actions preempted by § 301(a) of the Copyright Act arise under federal law.”⁶³ In other words, since Congress intended that such claims “arise under federal law,” the court allowed the claims to be recharacterized as federal claims, making removal proper. Many district courts have found *Rosciszewski* to be particularly instructive and deferred to its finding that Congressional intent compels complete preemption under the Copyright Act.⁶⁴ However, the issue has been directly addressed by few circuit courts and is far from settled.⁶⁵

⁶⁰ 1 F.3d 225 (4th Cir. 1994).

⁶¹ *Rosciszewski v. Arete Assocs.*, 1 F.3d 225, 232 (4th Cir. 1994) (quoting H.R. REP. NO. 9401476, at 130 (1976)), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5746).

⁶² ERISA explicitly provides for removal to federal court. *See* 28 U.S.C. § 1441(a).

⁶³ *Rosciszewski*, 1 F.3d at 232.

⁶⁴ Numerous district courts in California and elsewhere have concurred with the *Rosciszewski* analysis. *See, e.g.,* *Metrano v. Fox Broad., Co., Inc.*, 2000 WL 979664, at 3 (C.D. Cal.) (“Accordingly, state claims that are equivalent to federal copyright claims are completely preempted by the Copyright Act.”); *Info. Handling Servs., Inc. v. LRP Publ’ns, Inc.*, 2000 WL 433998, at 4 (E.D. Pa.) (“Finally, other courts that have considered the issue have found the Copyright Act to be completely preemptive.”); *Worth v. Universal Pictures, Inc.*, 5 F. Supp. 2d 816, 821 (C.D. Cal. 1997) (“Complete preemption has been found for claims brought under the Copyright Act.”); *Dielsi v. Falk*, 916 F.

B. *Expanding Complete Preemption: Beneficial National Bank v. Anderson*⁶⁶

The Supreme Court has long-held affirmative evidence of congressional intent to be “the touchstone of the federal district court’s removal jurisdiction.”⁶⁷ Therefore, prior to the Supreme Court’s 2003 holding in *Beneficial National Bank v. Anderson*, lower courts would not apply complete preemption without addressing: (1) whether ordinary preemption applied; and (2) whether Congress intended to allow removal based on complete preemption.⁶⁸

In light of the Supreme Court’s 2003 decision in *Beneficial*, however, such a foray into Congressional intent to allow complete preemption is apparently unnecessary. In *Beneficial*, the Supreme Court held that because §§ 85 and 86 of the National Bank Act⁶⁹

Supp. 985, 993 (C.D. Cal. 1996) (“Although there is no Ninth Circuit authority on point, a common law claim preempted by federal copyright law is clearly *completely* preempted under these principles.”) (emphasis in original); Wharton v. Columbia Pictures Indus., Inc., 907 F. Supp. 144, 146 (D. Md. 1995) (following *Rosciszewski*); Patrick v. Francis, 887 F. Supp. 481, 485 (W.D.N.Y. 1995) (following *Rosciszewski*).

⁶⁵ In *Ritchie v. Williams*, the Sixth Circuit, holding that complete preemption did apply to the Copyright Act, noted that only the Second and Fourth Circuits had directly addressed the issue and decided in favor of complete preemption.

⁶⁶ See *Beneficial Nat’l Bank v. Anderson*, 539 U.S. 1 (2003).

⁶⁷ See *Metro. Life Ins. Co. v. Taylor*, 481 U.S. 58, 66 (1977).

⁶⁸ For example, the Fourth Circuit examines whether: (1) the rights underlying the state cause of action are equivalent to the exclusive rights granted under a federal statute; and (2) the statutory language and legislative history evinces Congress’ intent that litigation to protect the federal rights occur in federal courts. The Tenth Circuit adopted a similar test, examining whether: (1) Congress has provided a federal cause of action to enforce the federal law, thus revealing congressional intent to allow removal in such cases; and (2) the state claim is displaced by federal law under an ordinary preemption analysis. The Fifth Circuit uses a three-part test, requiring: (1) the existence of a federal cause of action within the federal statute; (2) a provision conferring jurisdiction to the federal courts for the cause of action that “closely parallels” the jurisdictional provisions of the LMRA and ERISA; and (3) evidence of “the kind of congressional intent found to exist with respect to ERISA.” See *Blab T.V. of Mobile, Inc. v. Comcast Cable Commc’ns, Inc.*, 182 F.3d 851, 856-57 (11th Cir. 1999).

⁶⁹ 12 U.S.C. § 85 (2000).

provided an exclusive federal remedy for state law claims against nationally chartered banks, there was “no such thing as a state-law claim of usury against a national bank.”⁷⁰ The Court did not require that Congress provide an express statement indicating its intent to completely preempt an area of law, instead finding that by wholly displacing an area of law, Congress intended to create complete preemption.⁷¹

Thus, rather than searching for explicit Congressional intent to permit removal, as had previously been the case, *Beneficial* suggests that courts are merely required to determine whether the federal statute preempts state law because Congress has provided an exclusive federal remedy, thereby creating an exclusive federal cause of action.⁷² This more lenient standard for finding complete preemption is akin to the criteria that had previously been used to find implied ordinary preemption, a defense that did not allow removal. A number of lower courts have used *Beneficial*’s logic as a platform to extend the doctrine of complete preemption to other areas of the law, such as the Copyright Act. This was precisely the approach taken by the Second Circuit’s recent decision in *Briarpatch Ltd., L.P. v. Phoenix Pictures, Inc.*⁷³

In *Briarpatch*, the court held that the plaintiff’s unjust enrichment claim was completely preempted by the Copyright Act, and allowed removal, despite the plaintiff’s adamant protests that he did not seek relief under the Copyright Act. Discussing complete preemption in light of *Beneficial*, the Second Circuit concluded that the Supreme Court had intended to extend complete preemption to any federal statute that creates an exclusive federal cause of action.⁷⁴ “The Copyright Act does just that. Like the National Bank Act in *Beneficial*, the Copyright Act lays out the

⁷⁰ 539 U.S. at 11.

⁷¹ *Id.*

⁷² See RICHARD H. FALLON, JR., THE FEDERAL COURTS AND THE FEDERAL SYSTEM 22 (5th ed. Supp. 2003) (reaching the same conclusion).

⁷³ 373 F.3d 296 (2d Cir. 2004).

⁷⁴ “Until the Supreme Court’s recent decision in [*Beneficial National Bank v. Anderson*] we would have hesitated to extend the complete preemption doctrine into the copyright field.” *Briarpatch Ltd., L.P. v. Phoenix Pictures, Inc.*, 373 F.3d 296, 304 (2d Cir. 2004).

elements, statute of limitations, and remedies for copyright infringement.⁷⁵ It therefore follows that the district courts have jurisdiction over state law claims preempted by the Copyright Act.”⁷⁶

While *Briarpatch* was not the first case to apply complete preemption under the Copyright Act, it was the first to find that complete preemption unequivocally applies to the Act, because it provides an exclusive federal cause of action without further inquiry into Congressional intent. The Sixth Circuit recently agreed.⁷⁷ Though this result seems a logical extension of the Supreme Court’s holding in *Beneficial*, ignoring Congressional intent with regard to the Copyright Act not only undermines Congress’ explicit desire to preserve certain causes of action, but disregards long established limits on federal jurisdiction and can lead to incongruous results.

C. The Shortened Test for Complete Preemption Under the Copyright Act

If courts continue to agree with *Briarpatch*, and find that complete preemption applies under the Copyright Act, they will no longer need to explore Congressional intent, but merely apply *Briarpatch*’s more lenient test to determine whether ordinary preemption applies. In other words, by finding that a claim satisfies the subject matter and general scope prongs of the ordinary preemption test, a court could justify removal simply because the Copyright Act wholly displaces an area of law. A more stringent standard should be required for complete preemption to ensure that only narrow exceptions are carved out of established jurisdictional principles.

⁷⁵ See 17 U.S.C. §§ 501-513 (2000).

⁷⁶ *Briarpatch*, 373 F.3d at 305.

⁷⁷ See *Ritchie v. Williams*, 395 F.3d 283, 286 (6th Cir. 2005) (approving *Briarpatch* by noting that “the Second Circuit analyzed the Act in light of the *Anderson* case . . . and found that the doctrine of complete preemption clearly applies”).

IV. PROBLEMS APPLYING *BENEFICIAL* TO THE COPYRIGHT ACT

Congress has broad authority to control the jurisdiction of the lower federal courts.⁷⁸ Accordingly, the existence of removal jurisdiction in a particular case should turn on whether Congress has granted it, and not simply whether Congress provided an exclusive remedy. Under such a lax standard, many claims that were previously subject to ordinary preemption—often because Congress did provide an exclusive remedy—will consequently be subject to complete preemption and removed to federal court, rather than simply dismissed. This result disrupts the balance of power between state and federal courts and undermines the “well pleaded complaint” rule, “master of the complaint” doctrine, and even Congressional intent. Because complete preemption represents a grave deviation from these well-settled principles, it should be applied sparingly.

A. *A Brief History of Complete Preemption*

The concept of complete preemption was first conceived in 1968 in *Avco Corp. v. Aero Lodge No. 735*,⁷⁹ which held that that a cause of action arising under § 301 of the Labor and Management Relations Act (“LMRA”) was preempted and subject to removal.⁸⁰ Although the opinion in *Avco* did not specifically use the term “complete preemption,” its significance was brought to life in *Franchise Tax Board v. Construction Laborers Vacation Trust*,⁸¹ which noted that “the pre-emptive force of § 301 is so powerful as to displace entirely any state cause of action for violation of contracts between an employer and a labor organization.”⁸² The court did not take the opportunity in either *Avco* or *Franchise Tax*

⁷⁸ *Kline v. Burke Constr. Co.*, 260 U.S. 226, 233-34 (1922) (observing that, aside from the Supreme Court, “Only the jurisdiction of the Supreme Court is derived directly from the Constitution. Every other court created by the general government derives its jurisdiction wholly from the authority of Congress”).

⁷⁹ 390 U.S. 557 (1968).

⁸⁰ *See Avco Corp.*, 390 U.S. at 560.

⁸¹ 463 U.S. 1, 22-23 (1983).

⁸² *Id.* at 23.

Board to explain why the preempted claims were “exempt from the strictures of the well-pleaded-complaint rule, nor did it explain *how* such a state-law claim can plausibly be said to ‘arise under’ federal law.”⁸³ Justice Scalia subsequently described *Avco*’s holding as “jurisdictional alchemy,”⁸⁴ grounded in misplaced reliance on the dicta of *Textile Workers v. Lincoln Mills*,⁸⁵ which held that “[a]ny state law applied [in a § 301 case] will be absorbed as federal law and will not be an independent source of private rights.”⁸⁶

Whether decided rightly or wrongly, these landmark cases laid the framework for the anomalous doctrine of complete preemption. However, nearly two decades passed before the Court decided to extend the complete preemption doctrine, albeit reluctantly, to actions arising under § 502 of the Employee Retirement Income Security Act (“ERISA”).⁸⁷ Although the holding in *Metropolitan Life Insurance Co. v. Taylor*⁸⁸ provided little justification for further extension of the doctrine, ERISA’s unique legislative history provided a strong nail upon which the Court could rest its hat.⁸⁹ Specifically, the legislative history is laden with evidence that when drafting ERISA, Congress, aware of the *Avco* decision and newly-recognized complete preemption doctrine, intended to allow for removal of claims arising under ERISA, in the same manner as claims that were deemed to arise under the Labor and Management Relations Act.⁹⁰

⁸³ See *Beneficial Nat’l Bank v. Anderson*, 539 U.S. 1, 14 (2003) (Scalia, J., dissenting).

⁸⁴ *Id.*

⁸⁵ 353 U.S. 448 (1957).

⁸⁶ *Beneficial*, 539 U.S. at 14 (Scalia, J., dissenting) (citing *Textile Workers v. Lincoln Mills*, 353 U.S. 448, 457 (1957)).

⁸⁷ See generally *Metro. Life Ins. Co. v. Taylor*, 481 U.S. 58 (1987) (holding that Congress intended to allow removal of claims that fell within the scope of § 502 of ERISA).

⁸⁸ 481 U.S. 58 (1987).

⁸⁹ ERISA was passed in 1974, two years before the Copyright Act of 1976.

⁹⁰ “No more specific reference to the *Avco* rule can be expected and the rest of the legislative history consistently sets out this clear intention to make § 502(a)(1)(B) suits brought by participants or beneficiaries federal questions for the purposes of federal court jurisdiction in like manner as § 301 of the LMRA.”

First, the statutory text in § 502(a)⁹¹ not only provided an express federal remedy for the plaintiffs' claims, but also included a jurisdictional subsection⁹² with similar language to that at issue in *Avco*, indicating that Congress wanted the two statutes construed in the same way.⁹³ Second, the legislative history unambiguously described Congress' intent to treat ERISA actions "as arising under the laws of the United States in similar fashion to those brought under section 301 of the [LMRA] of 1947."⁹⁴

The court wrote:

*In the absence of explicit direction from Congress Even with a provision such as § 502(a)(1)(B) that lies at the heart of a statute with the unique pre-emptive force of ERISA . . . we would be reluctant to find that extraordinary pre-emptive power, such as has been found with respect to 301 of the LMRA, that converts an ordinary state common law complaint into one stating a federal claim for purposes of the well-pleaded complaint rule.*⁹⁵

When *Metropolitan Life* was decided, the Supreme Court was clearly looking beyond the fact that ERISA provided an exclusive federal remedy, for a more express indication of Congressional intent, the "touchstone" of removal jurisdiction.⁹⁶

B. *So why the sudden change in Beneficial?*

Beneficial National Bank v. Anderson,⁹⁷ handed down in 2003, purports to change the focus from whether Congress intended to allow for removal, to whether Congress intended to provide the

Metro Life, 481 U.S. at 66 (citing *Pilot Life Ins. Co. v. Dedeaux*, 481 U.S. 41, 54-55 (1987)).

⁹¹ 29 U.S.C. § 1132 (2004).

⁹² § 502(a)(1)(b).

⁹³ *Metro. Life Ins. Co. v. Taylor*, 481 U.S. 58, 65 (1987).

⁹⁴ *Beneficial Nat'l Bank v. Anderson*, 539 U.S. 1, 8 (2003) (citing H.R. REP. NO. 93-1280, at 327 (1974) (Conf. Rep.)).

⁹⁵ *Metro. Life*, 481 U.S. at 64-65 (emphasis added).

⁹⁶ "Indeed, as we have noted, even an 'obvious' pre-emption [sic] defense does not, in most cases, create removal jurisdiction. In this case, however, Congress has clearly manifested an intent to make causes of action within the scope of the civil enforcement provisions of § 502(a) removable to federal court." *Metro. Life*, 481 U.S. at 66.

⁹⁷ 539 U.S. 1 (2003).

exclusive federal remedy.⁹⁸ One justification for this change is grounded in the unique facts of the case. The National Bank Act, (“NBA”) at issue in the case, was passed in 1864, eleven years prior to the passage of the statute authorizing removal, thus pre-dating federal question jurisdiction, the “well pleaded complaint” rule, and the doctrine of complete preemption.⁹⁹ Congress had no reason to address issues, such as removal, that did not yet exist. Therefore, Congressional intent to permit removal based on complete preemption would have been impossible. Although the facts of the case demanded a test that focused on whether Congress intended to provide an exclusive federal remedy as opposed to allow for removal, such a lenient standard should be confined to those situations involving statutes passed prior to the removal statute, and before the establishment of principles such as the “well pleaded complaint” rule.

C. Congress did not intend for complete preemption under the Copyright Act

Since the inception of removal jurisdiction, the “well pleaded complaint” rule and the complete preemption doctrine, Congress has taken care to explicitly provide for removal under various statutes—the Copyright Act is not one of them.¹⁰⁰ When passing ERISA in 1974, Congress referenced the rule of *Avco* and indicated that claims coming within the scope of § 502 of ERISA should be recharacterized as federal claims and removed, just as had been done with LMRA claims.¹⁰¹ Congress has also passed statutes that explicitly provide for complete preemption. For example, the Price-Anderson Act, originally passed in 1957, was amended in 1988 to include a preemption provision¹⁰² that not only

⁹⁸ See *id.* at 9 (n.5).

⁹⁹ *Id.*

¹⁰⁰ Neither doctrine existed with the National Bank Act, at issue in *Beneficial*, was passed. *Beneficial Nat’l Bank v. Anderson*, 539 U.S.1, 9 (2003) (n.5).

¹⁰¹ *Metro. Life*, 481 U.S. at 66.

¹⁰² See 42 U.S.C. 2010(n)(2) (2004) (“With respect to any public liability action arising out of or resulting from a nuclear incident, the United States district court . . . shall have original jurisdiction without regard to the citizenship of any party or the amount in controversy. Upon motion . . . any such action

gives federal courts original jurisdiction over tort actions arising out of nuclear accidents, but expressly provides for removal to federal court when an action is brought in state court, even if the complaint asserts only state-law claims.¹⁰³ Congress undoubtedly recognizes the need to explicitly provide for removal. Nevertheless, two years after ERISA's passage, when drafting the Copyright Act of 1976, Congress, aptly familiar with the doctrine of complete preemption, made no mention of the *Avco* decision nor did it provide for removal. Therefore, it would be incongruous to assume that every time Congress provides an exclusive remedy, it also intends that claims falling within that statute be removed to federal court, rather than simply dismissed.

Unless Congress desired to control the adjudication to such an extent that it provided not only a federal defense, but intended to allow for removal, complete preemption should not apply. There is no such explicit language in the Copyright Act. To the contrary, Congress expressly intended to preserve various state causes of action.

Numerous courts previously relied on the Fourth Circuit's findings in *Rosciszewski*, that the preemptive force of § 301(a) along with the grant of exclusive federal court jurisdiction for actions arising under the Copyright Act, demonstrated that Congress intended to permit removal.¹⁰⁴ However, in doing so,

pending in any State court (including any such action pending on August 20, 1988) or United States district court shall be removed or transferred to the United States district court having venue under this subsection . . .").

¹⁰³ See *id.*; see also *El Paso Natural Gas Co. v. Neztosie*, 526 U.S. 473, 484 (1999) ("The Act not only gives a district court original jurisdiction over such a claim . . . but provides for removal to a federal court as of right if a putative Price-Anderson action is brought in a state court.").

¹⁰⁴ See, e.g., *Metrano v. Fox Broad., Co., Inc.*, 2000 WL 979664, at 3 (C.D. Cal.) ("Accordingly, state claims that are equivalent to federal copyright claims are completely preempted by the Copyright Act."); *Info. Handling Servs., Inc. v. LRP Publ'ns, Inc.*, 2000 WL 433998, at 4 (E.D. Pa.) ("Finally, other courts that have considered the issue have found the Copyright Act to be completely preemptive."); *Worth v. Universal Pictures, Inc.*, 5 F. Supp. 2d 816, 821 (C.D. Cal. 1997) ("Complete preemption has been found for claims brought under the Copyright Act."); *Dielsi v. Falk*, 916 F. Supp. 985, 993 (C.D. Cal. 1996) ("Although there is no Ninth Circuit authority on point, a common law claim preempted by federal copyright law is clearly *completely* preempted under these

courts undermine or completely ignore the language of Subsection 301(b)(3), which states:

Nothing in this title annuls or limits any rights or remedies under the common law or statutes of any State with respect to . . . activities violating legal or equitable rights that are not equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106

Certainly the rights to rely on one's contracts, be free from misrepresentations, and be able to vindicate unlawful conversions involve legal and equitable rights and remedies that are not equivalent to those protected under the Copyright Act. The legislative history further supports the theory that Congress did not intend to preempt other types of state law claims. For instance, the original language of § 301(b)(3) expressly states that rights not preempted by section 301 include "rights against misappropriation not equivalent to [any of the exclusive rights within the general scope of copyright], breaches of contract, breaches of trust, trespass, conversion. . . and deceptive trade practices. . . ." ¹⁰⁵ This non-exhaustive list of examples was "intended to illustrate rights and remedies which are different in nature from the rights comprised in a copyright and that may continue to be protected under State common law or Statute." ¹⁰⁶

Therefore, even if it is decided that complete preemption applies under the Copyright Act, courts have a duty to apply the "extra element" test in a more meaningful way that focuses on the elements needed to prove the cause of action rather than the facts pled to prove them. ¹⁰⁷ By focusing on the facts used to prove a claim, courts allow preemption simply because a plaintiff theoretically could have brought a claim under the Copyright Act. This approach, in turn, may leave the plaintiff without any cause of action.

principles.") (emphasis in original); *Wharton v. Columbia Pictures Indus., Inc.*, 907 F. Supp. 144, 146 (D. Md. 1995) (following *Rosciszewski*); *Patrick v. Francis*, 887 F. Supp. 481, 485 (W.D.N.Y. 1995) (following *Rosciszewski*).

¹⁰⁵ H.R. REP. NO. 94-1476, at 132 (1976).

¹⁰⁶ *Id.*

¹⁰⁷ *Trandes Corp. v. Guy F. Atkinson Co.*, 996 F.2d 655, 660 (4th Cir. 1993) (upholding a district court decision that the Copyright Act did not preempt plaintiff's trade secret claims).

V. REVERSING THE TREND OF COMPLETE PREEMPTION

Unless courts take steps to reverse the trend of complete preemption, individuals may find themselves reluctant to express ideas that are not protected by copyright registration, and for good reason. If that idea is misused, unless plaintiffs can pursue a claim under the Copyright Act, they may have no claim at all. In addition to the chilling effect complete preemption may have on expression, it also threatens to undermine the “well pleaded complaint” rule and the principle that the plaintiff is master of his complaint.

In determining whether complete preemption applies to the Copyright Act, courts should not disregard Congressional intent, which forms the “touchstone” of federal court removal jurisdiction.¹⁰⁸ As the *Briarpatch* court conceded, “[w]e had understood the [complete preemption] doctrine to be restricted to ‘the very narrow range of cases where Congress has clearly manifested an intent to make specific action within a particular area removable.’”¹⁰⁹ Yet the court found that its own inquiry into Congressional intent was unnecessary in light of the Supreme Court’s holding in *Beneficial*. This understanding nullifies the test once used to differentiate claims subject to ordinary preemption from the more narrow class subject to complete preemption. Under this view, by simply determining that ordinary preemption applies to the Copyright Act,¹¹⁰ which did not allow removal, courts will now automatically be permitted to remove the claim.¹¹¹

¹⁰⁸ See *Metro. Life Ins. Co. v. Taylor*, 481 U.S. 58, 66 (1987).

¹⁰⁹ *Briarpatch Ltd., L.P. v. Phoenix Pictures, Inc.*, 373 F.3d 296, 304 (2nd Cir. 2004).

¹¹⁰ Ordinary preemption undisputedly does apply to the Copyright Act as long as a claim satisfies the subject matter and general scope prong (extra-element test).

¹¹¹ Previously, once satisfied that preemption applied under the Copyright Act, courts had to determine whether Congress intended to apply complete preemption to the Copyright Act. Although the Fourth Circuit thought that complete preemption did apply, this issue was still debatable. *Briarpatch*, 373 F.3d at 304.

A more stringent standard should be required for finding complete preemption to ensure that only narrow exceptions are carved out of established principles such as the “well pleaded complaint” rule, and preserving the balance of power between the state and federal courts. Unless Congress desired to control the adjudication to such an extent that it provided not only a federal defense, but intended to allow for removal, complete preemption should not apply. There is no such explicit language in the Copyright Act. To the contrary, Congress expressly intended to preserve various state causes of action.

VI. CONCLUSION

The rapid expansion of the complete preemption doctrine threatens to rip from the moorings our longstanding values of federalism, including such basic notions as the “well pleaded complaint rule” and the principle that the plaintiff is “master of his complaint.” In so far as complete preemption applies to the Copyright Act, almost any time a claim involves creative expression fixed in a tangible medium, it will be subject to complete preemption under the Copyright Act. In light of the Supreme Court’s holding in *Beneficial*,¹¹² courts are no longer required to determine that Congress intended to permit removal. In addition, the “extra element” test, once an effective limit on complete preemption, is now applied in a way that focuses on the facts used to plead a claim, rather than the elements needed to prove a claim. Under this more rigorous test, almost any state or common law claim could arguably be touted as a mere pretense for a copyright claim. An increasing number of state law claims are being pushed into federal courts against the plaintiff’s will, occasionally leaving the plaintiff without any remedy at all.

In order to preserve our longstanding balance of power between state and federal court systems, courts should not ignore Congressional intent, which explicitly favors continuing to allow a variety of state law claims to be litigated in state courts. In addition, courts should strive to apply the “extra element” test as it

¹¹² 539 U.S. 1 (2003).

was intended—by focusing on whether the state or common law claim included an element that falls outside of the exclusive rights protected under the Copyright Act. In this way, a plaintiff will be free to frame claims as he chooses, courts will not unjustifiably deprive plaintiffs of a remedy under the law, and the balance of power between state and federal courts will be preserved.

