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Notes of the 1991 Advisory  
Committee for the Amendment of  
Federal Rule of Civil Procedure  
45: Is the Compulsion to Testify  
of an Unretained Expert Witness  
a Taking?

For this nation's justice system to work effectively, "it is necessary that *all* relevant evidence be available" to the litigants.<sup>1</sup> To that end, "[t]he public has . . . a right to every man's evidence,' except for those persons protected by a constitutional, common-law, or statutory privilege."<sup>2</sup> A general duty exists requiring citizens to provide evidence when justice demands it; privileges are the exception to this general duty.<sup>3</sup>

The vehicle for compelling witnesses to provide their testimony is the subpoena.<sup>4</sup> Attorneys are given wide latitude in issuing subpoenas and, therefore, the process is subject to abuse.<sup>5</sup> One common type of misuse is the subpoenaing of a non-party expert to testify without paying expert fees.<sup>6</sup> Compelling an expert to testify can jeopardize the expert's economic interests be-

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<sup>1</sup> *Wright v. Jeep Corp.*, 547 F. Supp. 871, 873 (E.D. Mich. 1982).

<sup>2</sup> *Id.* (quoting *United States v. Nixon*, 418 U.S. 683, 709 (1973)).

<sup>3</sup> *Wright*, 547 F. Supp. at 875.

<sup>4</sup> 9A CHARLES ALAN WRIGHT & ARTHUR R. MILLER, *FEDERAL PRACTICE AND PROCEDURE* § 2451, at 15 (2d ed. 1995).

<sup>5</sup> *Id.* § 2463, at 68.

<sup>6</sup> *Bio-Tech. Gen. Corp. v. Novo Nordisk Pharm., Inc.*, No. 02-235-SLR, 2003 U.S. Dist. LEXIS 7911, at \*8 (D. Del. 2003).

cause it denies him the opportunity to bargain for the sale of his services and is arguably a taking of the expert's intellectual property.<sup>7</sup>

This method of abuse was specifically addressed in the 1991 amendment to the Federal Rules of Civil Procedure when subsection (c) was added to Rule 45.<sup>8</sup> Rule 45(c)(3) is split into two main subsections, (A) and (B).<sup>9</sup> The former lists situations in which a court *must* quash a subpoena, and the latter indicates situations in which a court *should* quash one.<sup>10</sup> At issue in this Comment is Rule 45(c)(3)(B)(ii), which states that a subpoena should be quashed if it "requires disclosure of an unretained expert's opinion or information not describing specific events or occurrences in dispute and resulting from the expert's study made not at the request of any party."<sup>11</sup>

An unretained expert witness is not, however, protected absolutely by Rule 45(c)(3)(B)(ii).<sup>12</sup> The final sentence of Rule 45(c)(3)(B)(iii) allows the party seeking the discovery to prevail if it is able to (1) show a substantial need for testimony that cannot be gathered elsewhere without undue hardship; and (2) assure that the witness will be "reasonably compensated."<sup>13</sup> In assessing whether a request to compel testimony should be granted, the court should consider the *Kaufman v. Edelstein* balancing factors which include, but are not limited to, the following:

- (1) [T]he degree to which the expert is being called because of his knowledge of facts relevant to the case rather than in order to give opinion testimony;
- (2) the difference between testifying to a previously formed or expressed opinion and forming a new one;
- (3) the possibility that, for other reasons, the witness is a unique expert;
- (4) the extent to which the calling party is able to show the unlikelihood that any comparable witness will willingly testify; and
- (5) the degree to which the witness is

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<sup>7</sup> WRIGHT & MILLER, *supra* note 4, § 2463, at 76-77.

<sup>8</sup> *Bio-Tech. Gen. Corp.*, 2003 U.S. Dist. LEXIS 7911 at \*8. Prior to the 1991 Amendments, expert witnesses were protected with a combination of Federal Rule of Civil Procedure (FRCP) 45(b) and FRCP 26(c). Virginia G. Maurer, *Compelling the Expert Witness: Fairness and Utility Under the Federal Rules of Civil Procedure*, 19 GA. L. REV. 71, 88-89 (1984).

<sup>9</sup> WRIGHT & MILLER, *supra* note 4, § 2463, at 70 nn.17-18.

<sup>10</sup> *Id.*

<sup>11</sup> FED. R. CIV. P. 45(c)(3)(B)(ii).

<sup>12</sup> *Bio-Tech. Gen. Corp.*, 2003 U.S. Dist. LEXIS 7911, at \*8-9.

<sup>13</sup> FED. R. CIV. P. 45(c)(3)(B)(iii); *Bio-Tech. Gen. Corp.*, 2003 U.S. Dist. LEXIS 7911, at \*9.

able to show that he has been oppressed by having continually to testify.<sup>14</sup>

Currently, in applying this balancing test, courts are required to balance the needs of the litigants with the burden on the expert witness.

In an attempt to apply the 1991 advisory committee notes for the amendments to Rule 45,<sup>15</sup> this Comment will first examine the copyrightability of an expert witness's testimony through a discussion of the *Feist* fact/expression dichotomy. Second, it will discuss whether the testimony can be considered property other than through copyright law. Third, it will discuss how to apply traditional Fifth Amendment takings analysis to the taking of intellectual property. Finally, this Comment will provide a recommendation for courts in handling this scenario in the future.

## I

### FEIST: FACT OR EXPRESSION

Article I, section 8, clause 8 of the United States Constitution allows Congress “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”<sup>16</sup> The three major subject areas that have arisen under this clause are copyrights, patents, and trademarks. In each of these subject areas there is an underlying theme that not all intellectual property is eligible for constitutional protection. In patent law, no inventor may secure a monopoly over a natural phenomenon or a scientific principle.<sup>17</sup> Trademark law prohibits any protection

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<sup>14</sup> *Bio-Tech. Gen. Corp.*, 2003 U.S. Dist. LEXIS 7911, at \*9 (quoting *Schering v. Amgen, Inc.*, 1998 U.S. Dist. LEXIS 13452, at \*8-9 (D. Del. 1998)); *see also* FED. R. CIV. P. 45 advisory committee's note (citing *Kaufman v. Edelstein*, 539 F.2d 811, 822 (2d Cir. 1976)).

<sup>15</sup> The specific note of the advisory committee in question here is: “Arguably the compulsion to testify can be regarded as a ‘taking’ of intellectual property.” FED. R. CIV. P. 45(c)(3)(b)(ii) advisory committee's note.

<sup>16</sup> U.S. CONST. art. I, § 8, cl. 8.

<sup>17</sup> *O'Reilly v. Morse*, 56 U.S. 62, 120 (1854). In *O'Reilly*, one of Samuel Morse's claims in his patent for the telegraph was at issue. *Id.* at 112. Morse attempted to patent any means by which electricity was used to create a letter at a distance. *Id.* at 120. The Court found that this was tantamount to a patent on electricity as an electromotive force. *Id.* Patent law does not allow for an inventor to patent a natural phenomenon such as electricity. *Id.* In explaining this proposition, it is said that Albert Einstein could not have secured a patent in his famous equation,  $E=MC^2$ . *Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980).

for a mark that is either generic or entirely functional.<sup>18</sup> Furthermore, no copyright shall be issued to protect the underlying facts of the work; only the expression is protected.<sup>19</sup>

The testimony provided by an expert witness is most analogous to a copyrightable work. Patents and trademarks, though vital to intellectual property jurisprudence, do not lend themselves well to describe an opinion of an expert witness.<sup>20</sup> This section, therefore, will discuss expert witness testimony in light of copyright law. The critical aspect of copyright law, as it relates to the proposition that compelled testimony of an expert amounts to a taking, is the fact/expression dichotomy. For if the expert's testimony is merely factual, no traditional intellectual property interest is vested in the witness and no taking can occur. The fact/expression dichotomy is best outlined in the Supreme Court decision *Feist Publications, Inc. v. Rural Telephone Services Co.*<sup>21</sup>

#### A. *Feist Background*

In *Feist*, the plaintiff was the local telephone company for a portion of northwestern Kansas.<sup>22</sup> Kansas law required that each sanctioned monopolistic telephone company provide a white pages phone book.<sup>23</sup> The plaintiff provided the white pages to its clientele free of charge.<sup>24</sup> The lucrative endeavor in the making of phone books is the yellow pages.<sup>25</sup> In the yellow pages, the phone company sells advertisements to local merchants vying for

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<sup>18</sup> *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (1976):

[N]o matter how much money and effort the user of a generic term has poured into promoting the sale of its merchandise and what success it has achieved in securing public identification, it cannot deprive competing manufacturers of the product of the right to call an article by its name.

<sup>19</sup> *Feist Publ'ns, Inc. v. Rural Tel. Servs. Co.*, 499 U.S. 340, 344-45 (1991) ("The most fundamental axiom of copyright law is that 'no author may copyright his ideas or the facts he narrates.'") (quoting *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 556 (1985)).

<sup>20</sup> A patent issues to a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof." 35 U.S.C. § 101 (2000). "The term 'trademark' includes any word, name, symbol, or device, or any combination thereof . . . [used] . . . to identify and distinguish . . . goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown." 15 U.S.C. § 1127 (2000).

<sup>21</sup> 499 U.S. at 340.

<sup>22</sup> *Id.* at 342.

<sup>23</sup> *Id.*

<sup>24</sup> *Id.*

<sup>25</sup> *Id.*

the business of the local residents.<sup>26</sup>

In an attempt to garner market share in the yellow pages industry, the defendant, which was not a state-sanctioned phone company, wished to create its own set of white and yellow pages.<sup>27</sup> The defendant planned to have a larger listing, covering the territory of eleven different phone companies.<sup>28</sup> At first, the defendant contacted each of the eleven phone companies to work out a license agreement to use the listings in the existing white pages.<sup>29</sup> All of the eleven phone companies entered into an agreement except for the plaintiff.<sup>30</sup> Ultimately, the defendant used a portion of the plaintiff's listings without a license agreement, and the plaintiff filed suit.<sup>31</sup>

At trial, summary judgment was entered for the plaintiff with the district court citing myriad lower court decisions holding that telephone directories are copyrightable.<sup>32</sup> In an unpublished opinion, the Tenth Circuit affirmed the decision for “‘substantially the same reasons given by the district court.’”<sup>33</sup> The Supreme Court reversed, setting forth conclusively the constitutional mandate of originality in copyrights.

### *B. Sweat of the Brow*

The constitutional mandate of originality, however, was not ubiquitous prior to *Feist*. An exception to the requirement existed in some jurisdictions as a result of erroneous interpretation of the 1909 Copyright Act.<sup>34</sup> The 1909 Act expressly listed categories that were amenable to copyright protection.<sup>35</sup> One of the listed categories was compilations.<sup>36</sup> Some courts felt that compilations were *per se* copyrightable because the category was listed by the statute.<sup>37</sup> A common rationale for this rule was that the copyright was a reward for the hard work involved in compil-

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<sup>26</sup> *Id.*

<sup>27</sup> *Id.* at 342-43.

<sup>28</sup> *Id.* at 343.

<sup>29</sup> *Id.*

<sup>30</sup> *Id.*

<sup>31</sup> *Id.*

<sup>32</sup> *Id.* at 344.

<sup>33</sup> *Id.*

<sup>34</sup> *Id.* at 352.

<sup>35</sup> *Id.*

<sup>36</sup> *Id.*

<sup>37</sup> *Id.*

ing the facts.<sup>38</sup> This rationale came to be known as the Sweat of the Brow doctrine.<sup>39</sup>

### C. Constitutional Mandate of Originality

“The *sine qua non* of copyright is originality.”<sup>40</sup> To be original, a work must be independently created and have a minimum degree of creativity.<sup>41</sup> Congress’ power to create copyright law is derived from Article I, section 8, clause 8.<sup>42</sup> From this clause, the terms “author” and “writings” are the basis for the originality requirement. In *Burrow-Giles Lithographic Co. v. Sarony*, the Court defined author as “he to whom anything owes its origin; originator; maker.”<sup>43</sup> In *The Trade-Mark Cases*, the Court declared that “[t]he writings which are to be protected are *the fruits of intellectual labor*, embodied in the form of books, prints, engravings, and the like.”<sup>44</sup>

From these definitions, the fact/expression dichotomy is apparent. An author cannot secure a copyright in facts because facts do not owe their existence to the author.<sup>45</sup> This distinction was particularly important in *Feist* because phonebooks, as a compilation, are collections of facts. The Court held that compilations are copyrightable, but the copyright exists based on the selection, coordination, and arrangement of the facts.<sup>46</sup> The plaintiff’s alphabetical arrangement of phone listings did not demonstrate the minimal creativity required to secure a copyright.<sup>47</sup> The defendant had extended sufficient effort to make the directory useful, but not enough to make it original.<sup>48</sup> In fact, the Court stated that if this directory were copyrightable, it would be virtually impossible to think of a compilation that would fail to receive protection.<sup>49</sup> Though the plaintiff expended great effort to produce the white pages directory, copyright law is designed to reward

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<sup>38</sup> *Id.*

<sup>39</sup> *Id.*

<sup>40</sup> *Id.* at 345.

<sup>41</sup> *Id.*

<sup>42</sup> *Id.* at 346.

<sup>43</sup> *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884).

<sup>44</sup> *The Trade-Mark Cases*, 100 U.S. 82, 94 (1879).

<sup>45</sup> *Feist*, 499 U.S. at 347.

<sup>46</sup> *Id.* at 348.

<sup>47</sup> *Id.* at 362-63.

<sup>48</sup> *Id.*

<sup>49</sup> *Id.* at 364.

originality, not effort.<sup>50</sup> No matter how original the format, the underlying facts are never copyrightable.<sup>51</sup>

#### D. Intersection of Feist and Kaufman

*Kaufman v. Edelstein* was decided in 1976, predating the Supreme Court's 1991 *Feist* decision by fifteen years. It seems clear, from the non-exclusive five-factor list, that the majority of the factors tend to ensure that testimony is available for litigation. Only the first factor, "the degree to which the expert is being called because of his knowledge of facts relevant to the case rather than in order to give opinion testimony,"<sup>52</sup> really takes account of the nature of the expert's testimony. For this reason, courts should expend considerable effort to assess the nature of the expert's testimony, including assessing its copyrightability.

The very use of an expert witness's testimony—to aid the trier of fact in understanding the evidence or to determine a fact in issue<sup>53</sup>—precariously places the opinion into fact/expression considerations. For this reason, the first step in assessing an expert witness's testimony should be a *Feist* inquiry into whether the testimony will be merely a recitation of facts or the witness's own expression. If the testimony is inseparable from the facts upon which it is built, no copyrightable interest would vest in the expert.<sup>54</sup> In this case, the witness should be compelled to give his testimony, and the traditional duty to testify will suffice as a rationale. If, however, the expression of the witness's opinion displays the modicum of originality constitutionally required for copyrightability, the court should be wary of compelling the unretained witness to divulge this testimony. This is the sentiment outlined in the advisory committee notes to the 1991 amendment of Rule 45. The inquiry into the copyrightability of work, however, cannot end here.

In addition to the requirements outlined in *Feist*, a work is

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<sup>50</sup> *Id.*

<sup>51</sup> *Id.* at 349.

<sup>52</sup> *Kaufman v. Edelstein*, 539 F.2d 811, 822 (1976).

<sup>53</sup> FED. R. EVID. 702.

<sup>54</sup> This concept is known as the merger doctrine. *CCC Info. Servs., Inc. v. MacLean Hunter Mkt. Reports, Inc.*, 44 F.3d 61, 68 (2d Cir. 1994) ("It is also well established that, in order to protect the immunity of ideas from private ownership, when the expression is essential to the statement of the idea, the expression also will be unprotected, so as to insure free public access to the discussion of the idea.").

copyrightable if it is an “original work[ ] of authorship fixed in any tangible medium of expression, now known or later developed, from which [it] can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.”<sup>55</sup> A work is fixed when its “embodiment in a copy . . . is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.”<sup>56</sup>

When an expert is retained by a party to testify at trial, Federal Rule of Civil Procedure 26(a)(2)(B) requires the submission of a written statement, signed by the expert witness, containing all the opinions to be expressed.<sup>57</sup> Certainly a public court document would meet the criteria of fixation outlined in 17 U.S.C. § 101. This notion, however, gives rise to a fundamental policy question in copyright law. Works created by the government, including judicial opinions, are not copyrightable.<sup>58</sup> In this case, the question is whether copyright protection should be extended to the legal documents that become components of non-copyrightable judicial opinions. There are undoubtedly strong arguments for both sides. As it relates to the question at hand, however, the issue is moot because, unfortunately for the unretained expert witness, Rule 26(a)(2)(B) only applies to *retained* witnesses.<sup>59</sup> The unretained expert must, therefore, seek to fix his work independently.

Traditionally, getting a copyright would also require that the expert’s work meet notice, registration, and deposit requirements.<sup>60</sup> Presently, United States copyright law does not require that a work be registered or have notice, but provides significant advantages to authors that do so.<sup>61</sup> Attorneys’ fees, for example, are only available to the author that registers his work with the Copyright Office,<sup>62</sup> while a work containing notice precludes the

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<sup>55</sup> 17 U.S.C. § 102 (2000).

<sup>56</sup> 17 U.S.C. § 101 (2000).

<sup>57</sup> FED. R. CIV. P. 26(a)(2)(B).

<sup>58</sup> CRAIG JOYCE ET AL., COPYRIGHT LAW § 2.03[B] (6th ed. 2003).

<sup>59</sup> FED. R. EVID. 705 cmt.

<sup>60</sup> Prior to the enactment of the Berne Convention Implementation Act of 1988, the Copyright Act of 1976 required that an author provide notice of copyright, register the copyright, and deposit copies of the work with the Copyright Office. JOYCE, *supra* note 58, § 6.03, at 449-50.

<sup>61</sup> *Id.* § 6.03 at 450.

<sup>62</sup> 17 U.S.C. § 412 (2000).



use of the innocent infringement defense.<sup>63</sup> An expert witness whom is being compelled to provide testimony would therefore be well served by fixing his opinions in writing and registering them with the Copyright Office.<sup>64</sup> This way, the expert witness can secure a valid property interest in his work and use this as a foundation for argument against compulsion.

Furthermore, the law allows the licensing of the rights vested in copyrights. If an expert were able to secure a copyright in the expression of his testimony, use of the expression in a judicial proceeding could be granted through a non-exclusive license. By using licensing principles, authors would be able to retain more control over their works (much like software companies). Similarly, the copyright statute currently has six instances of compulsory licenses.<sup>65</sup> Normally, a license can only be obtained through negotiations with the author, and prices are controlled by the market.<sup>66</sup> With a compulsory license, however, no permission is needed from the author so long as the user pays the royalties established by the statute.<sup>67</sup> Perhaps a system of compulsory licensing could be utilized for providing expert testimony as well.

A real dilemma, however, is present if an expert witness registers his work with the Copyright Office. Records deposited with the Copyright Office are made public. Therefore, if the expert registers and deposits a copy of the work with the Copyright Office, the party seeking to compel the expert's testimony would be able to gather the information freely, that is, without paying licensing fees. This is the exact situation the expert witness is seeking to avoid. To prevent this from happening, the expert could request "special relief" from the Copyright Office.<sup>68</sup> If special relief is granted, the expert may be excused from having his work made publicly available.<sup>69</sup>

It may be too kind to say, however, that the United States'

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<sup>63</sup> 17 U.S.C. § 401(d) (2000).

<sup>64</sup> There is a nonrefundable filing fee required to register a work with the Copyright Office. JOYCE, *supra* note 58, § 6.03[B], at 458. Therefore, the expert should balance the value of the testimony with the cost of registering the work.

<sup>65</sup> *Id.* § 7.01[C] at 487. They are: The Cable Television License, The Digital Performance Right in Sound Recordings License, The Mechanical License, The Public Broadcasting License, The General Satellite Retransmission License, and The Local-to-Local Satellite Retransmission License. *Id.*

<sup>66</sup> *Id.*

<sup>67</sup> *Id.*

<sup>68</sup> 37 C.F.R. § 202.19(e) (2001).

<sup>69</sup> *Id.* § 202.19(e)(1)(i).

copyright law is complex. It is unlikely that an unretained expert witness will be savvy enough in copyright jurisprudence to identify without the aid of an attorney the benefits conferred through a registered and published copyright. The expert, however, may be reluctant to spend money on an attorney, fearing an imminent monetary loss if compelled to testify. The results are unfortunately cyclical; if the expert decides not to hire an attorney, he may proceed unaware of any benefits conferred by copyright law. If he hires an attorney too late, the author will be statutorily precluded from an award of attorney's fees. Furthermore, a request for special relief is by no means guaranteed. An expert may be denied special relief and be back at square one even after hiring an attorney.

The second classification in the *Kaufman* balancing test, "the difference between testifying to a previously formed or expressed opinion and forming a new one,"<sup>70</sup> considers the extent to which the expert had to prepare in order to give the testimony but assumes that the testimony is opinion and not fact. This consideration is at odds, however, with the teachings of *Feist*. In assessing this factor, it would appear that courts are being asked to give credence to the amount of labor an expert has expended in order to provide the testimony. The plain reading of the factor would indicate that an expert who had to prepare the testimony anew should be given more protection than an expert who had previously created their opinion. This is eerily familiar to the sweat of the brow rationale that was explicitly rejected in *Feist*. Perhaps the best use for this consideration is in determining the value of the testimony given, not whether testimony should be given at all.

The final three factors in the *Kaufman* balancing test all speak to the availability of the testimony. These factors include the uniqueness of the witness, the likelihood that another witness will testify, and the number of times the witness has previously been asked to testify.<sup>71</sup> These considerations do nothing to help expert witnesses protect their information. Rather, they help ensure that neither the interested party, nor the expert witness, is burdened by the court's decision. Though important, these factors do not get to the underlying issue of whether the expert wit-

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<sup>70</sup> *Kaufman v. Edelstein*, 539 F.2d 811, 822 (1976).

<sup>71</sup> *Id.*

ness has a valid property interest in the testimony being compelled as mentioned in the advisory committee's notes.

It is obvious from the foregoing discussion that copyright jurisprudence does not lend itself perfectly to addressing compulsion of unretained expert testimony. It is unrealistic to think that each expert witness will obtain a copyright in his opinion. Furthermore, there are inherent difficulties in obtaining a copyright in oral testimony; the fixation requirement is one such problem. That said, the underlying copyright theory is useful in understanding the property interest an unretained expert has in his information. If no copyright is available, however, does this mean that there is no relief for the unretained expert witness?

## II

### INFORMATION IS PROPERTY

The drafters of the United States Constitution were influenced by the Enlightenment.<sup>72</sup> This influence led to an intellectual property tradition that resisted recognizing a property interest in information.<sup>73</sup> The drafters felt that the dissemination of information and ideas was essential to the creation of a free society.<sup>74</sup> Recently, however, these notions have been disregarded, and information has been deemed property.<sup>75</sup>

Though the outright declaration that information is property is recent, the underlying notion is not new. In 1918, the Supreme

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<sup>72</sup> Pamela Samuelson, *Information as Property: Do Ruckelshaus and Carpenter Signal a Changing Direction in Intellectual Property Law?*, 38 CATH. U. L. REV. 365, 365 (1989).

<sup>73</sup> *Id.*

<sup>74</sup> This sentiment was expressed by Justice Brandeis in *Whitney v. California*:

Those who won our independence believed that the final end of the State was to make men free to develop their faculties; and that in its government the deliberative forces should prevail over the arbitrary. They valued liberty both as an end and as a means. They believed liberty to be the secret of happiness and courage to be the secret of liberty. They believed that freedom to think as you will and to speak as you think are means indispensable to the discovery and spread of political truth; that without free speech and assembly discussion would be futile; that with them, discussion affords ordinarily adequate protection against the dissemination of noxious doctrine; that the greatest menace to freedom is an inert people; that public discussion is a political duty; and that this should be a fundamental principle of the American government.

274 U.S. 357, 375 (1927) (Brandeis, J., concurring).

<sup>75</sup> See *Carpenter v. United States*, 484 U.S. 19 (1987); *Ruckelshaus v. Monsanto Co.*, 467 U.S. 986 (1984).

Court recognized a quasi-property interest in news information.<sup>76</sup> In *International News Service v. Associated Press* (“INS”), the defendant was reporting news it gathered from the plaintiff’s early edition newspaper and news office bulletin boards.<sup>77</sup> In deciding the case, the Supreme Court’s opinion weaved an argument between unfair competition and property interests.<sup>78</sup> Ultimately, the Court stated that news had all the attributes necessary to be considered property.<sup>79</sup> The news did, however, have some characteristics that precluded it from being categorized as property entirely.<sup>80</sup> The news was unique in that the property interest only lasted up until the publication of the newspaper.<sup>81</sup> Similarly, any person that purchased a newspaper was free to make use of the news thereafter.<sup>82</sup> This and other characteristics led the Court to classify the news as quasi-property.<sup>83</sup> Though *INS* is best known as the “unfair competition case,” it did lay the groundwork for a shift in United States intellectual property jurisprudence.<sup>84</sup>

#### A. Ruckelshaus Background

Sixty-six years after deciding *INS*, the Supreme Court was again faced with the question of intangible property interests; this time, state sanctioned trade secrets were at issue.<sup>85</sup> In *Ruckelshaus v. Monsanto Co.*, Monsanto challenged the constitutionality of several provisions of the Federal Insecticide, Fungicide, and Rodenticide Act of 1947 (“FIFRA”).<sup>86</sup> FIFRA was initially a licensing and labeling statute that required all pesticides to be registered with the Secretary of Agriculture before being sold in interstate or foreign commerce.<sup>87</sup> Any entity seeking to register a pesticide was required to submit certain safety data to the Secretary of Agriculture.<sup>88</sup> This version of the law prohibited the

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<sup>76</sup> Samuelson, *supra* note 72, at 388 (citing *Int’l News Serv. v. Associated Press*, 248 U.S. 236 (1918)).

<sup>77</sup> Samuelson, *supra* note 72, at 388.

<sup>78</sup> *Id.*

<sup>79</sup> *Id.* at 390.

<sup>80</sup> *Id.* at 391.

<sup>81</sup> *Id.*

<sup>82</sup> *Id.*

<sup>83</sup> *Id.*

<sup>84</sup> *Id.* at 388.

<sup>85</sup> *Ruckelshaus v. Monsanto Co.*, 467 U.S. 986, 998-99 (1984).

<sup>86</sup> *Id.* at 990.

<sup>87</sup> *Id.* at 991.

<sup>88</sup> *Id.*

Department of Agriculture from disseminating any information regarding the formulas of the products.<sup>89</sup> The Act was silent about any such restriction on the safety information, but it was admitted that no such information was dispersed.<sup>90</sup>

In 1970, the FIFRA responsibilities were transferred from the Secretary of Agriculture to the newly created Environmental Protection Agency (“EPA”).<sup>91</sup> Thereafter, Congress revised FIFRA and created the Federal Environmental Pesticide Control Act of 1972.<sup>92</sup> As amended, FIFRA required the EPA to determine that each registered pesticide did not cause “unreasonable adverse effects on the environment.”<sup>93</sup> In addition, the 1972 amendments allowed submitting parties to designate portions of the data as trade secrets or commercial or financial information.<sup>94</sup> The EPA was not allowed to disclose any such information without the consent of the submitting party.<sup>95</sup>

One means by which the EPA made information public was by comparing new applicant data with existing registered pesticides during the application process.<sup>96</sup> If similarities existed between the two pesticides, the EPA would institute a mandatory licensing scheme.<sup>97</sup> The EPA was not, however, permitted to use any information designated as a trade secret in this process.<sup>98</sup> Unfortunately, the relevant statutory terms were not clear and myriad litigation ensued.<sup>99</sup>

To correct for the inadequacies of the legislation, Congress amended the statute again in 1978.<sup>100</sup> The amendments created limited monopolies on the use and disclosure of submitted data.<sup>101</sup> The applicant would receive a ten-year monopoly for any data submitted after September 30, 1978.<sup>102</sup> Any data submitted between December 31, 1969 and September 30, 1978 could be cited in the consideration of subsequent applications for

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<sup>89</sup> *Id.*

<sup>90</sup> *Id.*

<sup>91</sup> *Id.*

<sup>92</sup> *Id.*

<sup>93</sup> *Id.* at 992 (quoting 86 Stat. 980).

<sup>94</sup> *Id.*

<sup>95</sup> *Id.*

<sup>96</sup> *Id.*

<sup>97</sup> *Id.*

<sup>98</sup> *Id.* at 992-93.

<sup>99</sup> *Id.* at 993.

<sup>100</sup> *Id.* at 993-94.

<sup>101</sup> *Id.* at 994.

<sup>102</sup> *Id.*

fifteen years after the initial submission, but only if the subsequent applicant offered to compensate the initial submitter.<sup>103</sup> Arbitration would be used to determine a price if one could not be agreed upon.<sup>104</sup> All other data could be used without limitation.<sup>105</sup>

### B. *Trade Secrets Are Property*

Monsanto argued that the required submission of its data to the EPA effected a taking of property without just compensation in violation of the Fifth Amendment.<sup>106</sup> In assessing the argument, the Court first had to determine whether Monsanto's trade secrets were property.<sup>107</sup> First, the Court noted that trade secrets have many similarities with tangible property: trade secrets are assignable and they can form the res of a trust and pass to trustees in bankruptcy.<sup>108</sup> Second, in the very statute at issue, Congress stated that submitters had a legal ownership of their data.<sup>109</sup> Similarly, the Court quoted Blackstone in finding that the "perception of trade secrets as property is consonant with a notion of 'property' that extends beyond land and tangible goods and includes the products of an individual's 'labour and invention.'"<sup>110</sup> Third, the Court cited precedent in which it had found other intangible interests to be property.<sup>111</sup> Ultimately, the Court held "that to the extent that Monsanto has an interest in its health, safety, and environmental data cognizable as a trade-secret property right under Missouri law, that property right is protected by the Takings Clause of the Fifth Amendment."<sup>112</sup>

It is important to note that trade secrets are unlike the other major categories of intellectual property in that they are primarily concerned with keeping information out of the public forum. The constitutional foundation of patents and copyrights is to enrich the foundation of knowledge so that others may build upon

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<sup>103</sup> *Id.*

<sup>104</sup> *Id.* at 994-95.

<sup>105</sup> *Id.* at 995.

<sup>106</sup> *Id.* at 998-99.

<sup>107</sup> *Id.* at 1000.

<sup>108</sup> *Id.* at 1002.

<sup>109</sup> *Id.*

<sup>110</sup> *Id.* at 1002-03 (citing 2 W. BLACKSTONE, COMMENTARIES 405; see J. LOCKE, THE SECOND TREATISE OF CIVIL GOVERNMENT, ch. 5 (J. Gough ed. 1947)).

<sup>111</sup> *Id.* at 1003. The court had previously found that materialmen's liens, real estate liens, and contracts were property within the meaning of the Takings Clause.

<sup>112</sup> *Id.* at 1003-04.

it. Trade secrets, however, do just the opposite. A trade secret is kept so that one person (or more likely, one corporation) can benefit commercially from his knowledge. Essentially, the public is at the mercy of the trade secret holder to obtain the benefits of the information.

The important similarity, however, is that the underlying theme in intellectual property, copyrights, patents, and trade secrets alike is a legally protected interest in information. In fact, it is exactly the divergence in the purposes of trade secrets as compared to copyrights and patents that so strongly supports a property interest in information. If it were not the information that was protected, why would trade secrets be protected at all? Copyrights and patents have constitutional foundations; trade secrets do not. The fact that property rights are found in patents and copyrights—as well as trade secrets, which are completely opposite in purpose—is evidence that the underlying information is the source of the property interest in all three. It is only information that links all three subjects and since all three areas are property, the genesis of the property interest must be rooted in the underlying information.

### C. Carpenter *Background*

Three years later, in a decision that cited *INS* and *Ruckelshaus*, the Supreme Court held definitively that information is property.<sup>113</sup> In *Carpenter v. United States*, the defendants were convicted of violating the Securities Exchange Act of 1934, violating the federal mail and wire fraud statutes, and conspiracy.<sup>114</sup> R. Foster Winans was a writer for the Wall Street Journal (“Journal”).<sup>115</sup> At the Journal, Winans was the author of a column called “Heard on the Street.”<sup>116</sup> The weekly column provided insight on certain stocks and was well respected in the investment community.<sup>117</sup> It was so well respected that after publication it had a noticeable effect on the value of the stocks reviewed.<sup>118</sup>

After observing the effect on the reviewed stocks, Winans entered into an investment scheme with his roommate, Carpenter, and Brant and Felis, two brokers from the Kidder Peabody bro-

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<sup>113</sup> See *Carpenter v. United States*, 484 U.S. 19, 25 (1987).

<sup>114</sup> *Id.* at 20-22.

<sup>115</sup> *Id.* at 22.

<sup>116</sup> *Id.*

<sup>117</sup> *Id.*

<sup>118</sup> *Id.* at 22-23.

kerage firm in New York City.<sup>119</sup> The idea was to provide the brokers with the column's information prior to publication.<sup>120</sup> By providing the information early, the brokers could buy or sell the stocks depending on the effect the column would have.<sup>121</sup> All the proceeds of the scheme were to be split among the four participants.<sup>122</sup> Eventually, the brokerage firm noticed a correlation between the broker's purchases and the column and began to investigate.<sup>123</sup> The Securities and Exchange Commission ("SEC") also investigated the matter.<sup>124</sup> After initial denials of impropriety, the relationship between the conspirators broke down, and Carpenter and Winans went to the SEC and confessed the entire scheme.<sup>125</sup>

#### *D. Information Is Definitely Property*

At trial, the district court convicted the defendants, finding that they had knowingly misappropriated prepublication information.<sup>126</sup> The defendants appealed and the court of appeals affirmed, finding that Winans had misappropriated property within the meaning of the mail and wire fraud statutes.<sup>127</sup> The defendants appealed to the Supreme Court and argued that they could not have violated the mail and wire fraud statutes because their activities did not obtain money or property, which is a necessary element of the crime.<sup>128</sup> The defendants argued that information is an intangible interest that does not amount to property.<sup>129</sup>

The Supreme Court disagreed, finding that information is property and affirming the convictions.<sup>130</sup> Specifically, the Court held that "the object of the scheme was to take the Journal's confidential business information—the publication schedule and contents of the 'Heard' column—and its intangible nature does not make it any less 'property' protected by the mail and wire

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<sup>119</sup> *Id.* at 23.

<sup>120</sup> *Id.*

<sup>121</sup> *Id.*

<sup>122</sup> *Id.*

<sup>123</sup> *Id.*

<sup>124</sup> *Id.*

<sup>125</sup> *Id.*

<sup>126</sup> *Id.* at 23-24.

<sup>127</sup> *Id.* at 24.

<sup>128</sup> *Id.* at 25.

<sup>129</sup> *Id.*

<sup>130</sup> *Id.*



fraud statutes.”<sup>131</sup> Furthermore, the Court found that the Journal had been deprived of its right to the exclusive use of the information and that exclusivity is an important aspect of a property right.<sup>132</sup>

*E. Expert Testimony Is Information, Expert Testimony Is Property*

In light of the holdings of *Ruckelshaus* and *Carpenter*, it is difficult to imagine a scenario in which a witness’s expert testimony is not property. The purpose of the expert’s testimony is to impart information to the trier of fact. According to Federal Rule of Evidence 702, the expert’s testimony is used to assist the trier of fact in understanding the evidence or determining an issue of fact.<sup>133</sup> It is true that the expert’s information is intangible. The teachings of *Ruckelshaus* and *Carpenter*, however, make clear that property interests do not exist exclusively in tangible forms.

Furthermore, compelling an expert to testify deprives the expert of his right to the exclusive use of his information, one of the most important “sticks in the bundle” of property rights.<sup>134</sup> Just as this deprivation amounted to a violation of a property interest in *Carpenter*, it should be considered similarly when an expert witness is forced to testify. Whether a delinquent employee is misusing the company’s information or a court is forcing an expert to testify, no exclusivity exists because an entity other than the owner is using the property.

Just as Monsanto had an interest in its safety data, and the Journal had an interest in its pre-publication information, an expert has an interest in his expertise. In fact, an expert may be more reliant on his information than either Monsanto or the Journal. In *Ruckelshaus* and *Carpenter*, the interested parties were large corporations, each with diverse holdings. Had a property interest *not* been found in either case, the party could have relied on other aspects of its business for economic support. Experts, however, are often skilled exclusively in a distinct area, either by “knowledge, skill, experience, training or education.”<sup>135</sup> If they are compelled to divulge their hard-earned information

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<sup>131</sup> *Id.*

<sup>132</sup> *Id.* at 26-27.

<sup>133</sup> FED. R. EVID. 702.

<sup>134</sup> *Kaiser Aetna v. United States*, 444 U.S. 164, 176 (1979).

<sup>135</sup> FED. R. EVID. 702.

without compensation, their knowledge has been robbed of its value. Who pays for information that can be obtained for free? Unlike the institutional parties, these subject-area experts may have no other resources on which to rely.

Information has been definitively classified as property by the Supreme Court. Expert testimony is information and, therefore, is property. This should be given great weight when courts are utilizing the *Kaufman* balancing test. It is no longer a balancing of a burden on the expert with the need to have competent testimony at trial. Now, courts must balance the expert's property interest with the need for competent testimony. A property interest should counsel more deference from the courts than merely a question of burden. If the doctrine of *stare decisis* does not require courts to follow the holdings in *Ruckelshaus* and *Carpenter* in this manner, the policy argument discussed in the preceding paragraph should persuade the courts to be more willing to protect the interests of unretained expert witnesses.

It is precisely from the juxtaposition of the Federal Rules of Evidence and Supreme Court precedent that the potential benefit for a compulsory licensing scheme is apparent. The courts will want to follow the teachings of the Supreme Court in respecting the property rights of the expert witnesses. Similarly, the courts will be tempted to compel the testimony of the experts in order to elucidate the issues for the trier of fact. A compulsory licensing scheme may help to alleviate the conflicting nature of these rules of law by securing both payment for the experts and testimony for the litigants. This, however, is fodder for the legislature. Currently, courts still need to assess whether their actions amount to a taking of an unretained expert witness's property.

### III

#### IS THERE A FIFTH AMENDMENT TAKING?

After determining that information is property, or finding that the expert has a valid copyright, an inquiry must follow as to whether a taking occurs through the compulsion of an unretained expert witness's testimony. The first step in this process is to determine which variation of takings analysis is appropriate to apply: physical takings, regulatory takings, or an exaction. Guidance for this determination can be found in *Ruckelshaus*. A brief description of the three takings varieties, however, is beneficial.

### A. Physical Invasion Takings

A physical invasion occurs when “a governmental entity exercises its eminent domain powers or acts in an ‘enterprise capacity, where it takes unto itself private resources and uses them for the common good.’”<sup>136</sup> A physical invasion was the type of taking that occurred in both *Kaiser Aetna v. United States* and *Loretto v. Teleprompter Manhattan CATV Corp.*<sup>137</sup> In *Kaiser Aetna*, the defendants leased a large portion of land on the island of Oahu in the state of Hawaii.<sup>138</sup> A lake existed on a portion of the defendant’s leased land that covered 523 acres.<sup>139</sup> The lake was separated from Maunalua Bay and the Pacific Ocean by a narrow barrier island.<sup>140</sup> The defendants leased the land in order to build a housing community.<sup>141</sup>

Part of the development included building a boat docking facility in the lake for the residents to use.<sup>142</sup> To facilitate this use, the defendant dredged the lake to an average depth of six feet, increased the clearance of a local bridge between the lake and the bay to thirteen-and-one-half feet, and made a passageway through the barrier island.<sup>143</sup> All of these changes would make the bay and ocean accessible to the new residents of the development.<sup>144</sup> The defendant submitted its plan to the Army Corp of Engineers and, with one comment regarding beach erosion, was allowed to proceed.<sup>145</sup>

After the defendant finished the work and opened the lake to the use of its residents, the United States informed the defendant that the lake was now a navigable waterway under the control of the United States and could no longer be used exclusively by the defendant.<sup>146</sup> Ultimately, the United States sued Kaiser Aetna in

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<sup>136</sup> *Bormann v. Kossuth County Bd. of Supervisors*, 584 N.W.2d 309, 317 (Iowa 1998) (quoting JOHN W. SHONKWILER & TERRY MORGAN, *LAND USE LITIGATION* § 1.02, at 6 (1986)).

<sup>137</sup> *Kaiser Aetna*, 444 U.S. at 164; *Loretto v. Teleprompter Manhattan CATV Corp.*, 458 U.S. 419 (1982).

<sup>138</sup> *Kaiser Aetna*, 444 U.S. at 166-67.

<sup>139</sup> *Id.* at 166.

<sup>140</sup> *Id.*

<sup>141</sup> *Id.* at 167.

<sup>142</sup> *Id.* at 167-68.

<sup>143</sup> *Id.*

<sup>144</sup> *Id.* at 167.

<sup>145</sup> *Id.*

<sup>146</sup> *Id.* at 168.

the United States District Court for the District of Hawaii.<sup>147</sup> At trial, the district court found that the water was indeed navigable, but if the government wanted it to be open to the public, the government would have to pay reasonable compensation.<sup>148</sup> The government appealed, and the Ninth Circuit reversed the district court's ruling regarding the payment of compensation.<sup>149</sup> The defendant appealed to the United States Supreme Court.

The Supreme Court reversed the Ninth Circuit, holding that the government's plan to allow for public use of the lake would directly curtail the defendant's right to exclude others from its property.<sup>150</sup> The situation may have been different, however, if the government had attempted to regulate the use of the lake prior to approving the defendant's work.<sup>151</sup> By not doing so, however, the defendant came to rely on the fact that its private property would remain private in the future.<sup>152</sup> The defendant's reliance on the Army Corp of Engineers' statements preserved its right to exclude.<sup>153</sup> The public, with the aid of the government, would be physically invading the defendant's privately owned marina, and the government could not possibly facilitate this invasion without paying just compensation.<sup>154</sup>

In *Loretto*, a decision citing *Kaiser Aetna*, the plaintiff purchased a five-story apartment building in New York City.<sup>155</sup> After purchasing the building, the plaintiff noticed that a series of cable wires and boxes had been installed on the building.<sup>156</sup> The boxes were connected by bolts to the roof of the building and the wires, connected by masonry nails or screws, ran across the top of the building and down to the first floor.<sup>157</sup> Prior to 1973, the defendant cable television company had to obtain authorization from building owners before installing any equipment.<sup>158</sup> The wires in this case were installed with the authorization of the pre-

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<sup>147</sup> *Id.* at 168-69.

<sup>148</sup> *Id.* at 169.

<sup>149</sup> *Id.*

<sup>150</sup> *Id.* at 179-80.

<sup>151</sup> *Id.* at 179.

<sup>152</sup> *Id.*

<sup>153</sup> *Id.*

<sup>154</sup> *Id.* at 180.

<sup>155</sup> *Loretto v. Teleprompter Manhattan CATV Corp.*, 458 U.S. 419, 421 (1982).

<sup>156</sup> *Id.* at 424.

<sup>157</sup> *Id.* at 422.

<sup>158</sup> *Id.* at 423.

vious owner.<sup>159</sup> After 1973, however, the installation of cable television hardware was facilitated by a New York state law.<sup>160</sup> The law protected the installation of cable television hardware from interference by landlords, to ensure that everyone had access to the service.<sup>161</sup> The plaintiff filed a class action suit on behalf of all the real property owners in the state.<sup>162</sup> In her complaint, the plaintiff alleged that the cable television installation was a trespass and, insofar as it was done with the blessings of state law, was an unconstitutional taking of private property under the Fifth Amendment.<sup>163</sup>

At trial, the court granted summary judgment for the defendants, upholding the state law.<sup>164</sup> The plaintiff appealed, and the New York Court of Appeals affirmed, over dissent, that the statute was constitutional.<sup>165</sup> The plaintiff appealed to the United States Supreme Court, where this decision was reversed.<sup>166</sup> The Court found error in the use of a balancing test, holding that when the government authorizes a permanent physical invasion of private property, it amounts to a taking, regardless of the government's interest.<sup>167</sup> Furthermore, the Court stated that the owner of property suffers a special kind of injury when a stranger occupies the property.<sup>168</sup> The long-standing premise in property jurisprudence is that the owner has an expectation to remain relatively undisturbed in the possession of property.<sup>169</sup> The Court went on to say that requiring an owner to "permit another to exercise complete dominion [over the property] literally adds insult to injury."<sup>170</sup>

### *B. Regulatory Takings*

There are two categories of takings that require compensation without any inquiry of additional factors.<sup>171</sup> The first is a perma-

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<sup>159</sup> *Id.* at 421-22.

<sup>160</sup> *Id.* at 423.

<sup>161</sup> *Id.*

<sup>162</sup> *Id.* at 424.

<sup>163</sup> *Id.*

<sup>164</sup> *Id.*

<sup>165</sup> *Id.*

<sup>166</sup> *Id.* at 425-26.

<sup>167</sup> *Id.* at 425-26.

<sup>168</sup> *Id.* at 436.

<sup>169</sup> *Id.*

<sup>170</sup> *Id.*

<sup>171</sup> *Borman v. Kossuth County Bd. of Supervisors*, 584 N.W.2d 309, 316 (Iowa 1998).

ment physical invasion, such as in *Kaiser Aetna* and *Loretto* described above. The second is a regulation that denies the owner all economically beneficial or productive use of the property.<sup>172</sup> The quintessential example is in *Lucas v. South Carolina Coastal Council*.<sup>173</sup>

In *Lucas*, the Court held that it was beyond the purview of historical state land regulation to enact laws rendering an owner's property valueless, unless it could be shown that the owner's interest was invalid to begin with.<sup>174</sup> The plaintiff in *Lucas* purchased two plots of land on South Carolina's Isle of Palms.<sup>175</sup> In an effort to enforce the Coastal Zone Management Act of 1972, the South Carolina Coastal Council enacted the Beach Front Management Act.<sup>176</sup> The effect of this enactment prohibited the plaintiff from constructing any habitable structures on his two plots of land.<sup>177</sup> At trial, the state court found that this regulation rendered the plaintiff's land "valueless."<sup>178</sup> The Court declared that for South Carolina to avoid compensating the plaintiff it must demonstrate that, through background principles of nuisance and property law, the use the plaintiff seeks to enjoy is prohibited regardless.<sup>179</sup>

If neither a physical invasion nor a complete diminution in value has occurred, a balancing test, outlined by Justice Brennan in *Penn Central Transportation Co. v. New York City*, must be employed to weigh the juxtaposed interests of the property owner and the state.<sup>180</sup> The Court has admitted, however, that no distinct standard has been found to address the balancing and each case depends on its own particular circumstances.<sup>181</sup> The balancing test is described in three parts: 1) the character of the governmental action; 2) its economic impact; and 3) the interference with reasonable investment-backed expectations.<sup>182</sup>

Generally, the regulations that create questions of Fifth

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<sup>172</sup> *Id.*

<sup>173</sup> *Lucas v. S.C. Coastal Council*, 505 U.S. 1003 (1992).

<sup>174</sup> *Id.* at 1027.

<sup>175</sup> *Id.* at 1006-07.

<sup>176</sup> *Id.* at 1007.

<sup>177</sup> *Id.*

<sup>178</sup> *Id.*

<sup>179</sup> *Id.* at 1031.

<sup>180</sup> *Penn Cent. Transp. Co. v. New York City*, 438 U.S. 104 (1978).

<sup>181</sup> *Id.* at 123-24.

<sup>182</sup> *Kaiser Aetna v. United States*, 444 U.S. 164, 175 (1979) (citing *Penn Cent. Transp. Co.*, 438 U.S. at 124).

Amendment takings have their genesis in the legislative branch. This is not exclusively the case, however. In *Stevens v. City of Cannon Beach*, the plaintiffs purchased property on the Oregon coast in 1957.<sup>183</sup> In 1989, the plaintiffs submitted a building permit application to enable the construction of a seawall on the dry sand portion of their beach.<sup>184</sup> The permit was denied, and the plaintiff filed suit against the defendants, the City of Cannon Beach and the State of Oregon.<sup>185</sup> The trial court dismissed the claim, saying that the plaintiffs never had the right to obstruct the public from access to the beach.<sup>186</sup> Both the court of appeals and the Supreme Court of Oregon affirmed.<sup>187</sup> The plaintiff appealed to the United States Supreme Court, but certiorari was denied.<sup>188</sup> In his opinion dissenting from the denial of certiorari, Justice Scalia made clear the point that courts too can effect an unconstitutional regulatory taking.<sup>189</sup>

### C. Exactions

Exaction is the process whereby the state conditions a benefit, such as a building permit, on the grant of a property interest to the public by the landowner. In *Nollan v. California Coastal Commission*, the plaintiffs owned a 504-square-foot bungalow on a piece of land in Ventura County, California.<sup>190</sup> After years of renting the bungalow to vacationers, the property fell into disrepair.<sup>191</sup> The plaintiffs wanted to knock down the bungalow and build a new house on the land.<sup>192</sup> They submitted a building permit application to the defendant in order to proceed.<sup>193</sup> The defendant, however, refused to approve the permit unless the plaintiffs granted a lateral easement for public use across a seaward portion of their land.<sup>194</sup>

After myriad proceedings, a hearing was held that found the

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<sup>183</sup> *Stevens v. City of Cannon Beach*, 510 U.S. 1207, 1207 (1994) (Scalia, J., dissenting from denial of *cert.*).

<sup>184</sup> *Id.*

<sup>185</sup> *Id.*

<sup>186</sup> *Id.*

<sup>187</sup> *Id.*

<sup>188</sup> *Id.*

<sup>189</sup> *Id.* at 1334 (“No more by judicial decree than by legislative fiat may a State transform private property into public property without compensation.”).

<sup>190</sup> *Nollan v. Cal. Coastal Comm’n*, 483 U.S. 825, 827 (1987).

<sup>191</sup> *Id.*

<sup>192</sup> *Id.* at 828.

<sup>193</sup> *Id.*

<sup>194</sup> *Id.*

new house would block the public's view of the beach and contribute to a psychological barrier to the beach.<sup>195</sup> The defendant again conditioned the approval of the building permit on the exaction of the easement.<sup>196</sup> The plaintiffs objected and filed suit in the superior court.<sup>197</sup> The superior court agreed with the plaintiffs and struck the condition.<sup>198</sup> The defendant appealed to the California Court of Appeals, but before the appeal was complete, the plaintiffs had the house built.<sup>199</sup> The court of appeals reversed the superior court and the plaintiffs appealed to the United States Supreme Court.<sup>200</sup>

On appeal to the Supreme Court, the easement condition was found to be a taking.<sup>201</sup> An easement that laterally traversed the seaward side of the property would not have any ameliorating effect on the defendant's stated interest.<sup>202</sup> That interest was preventing the psychological barrier to the beach.<sup>203</sup> Since the easement would not do anything to enhance the public's view of the ocean, the requisite "essential nexus" between the harm and the exaction did not exist.<sup>204</sup>

The decision in *Nollan*, however, left an important question unanswered: "[W]hat is the required degree of connection between the exactions imposed by the city and the projected impacts of the proposed development[?]"<sup>205</sup> This question was resolved when the Court decided *Dolan v. City of Tigard*.<sup>206</sup> In *Dolan*, the plaintiff was the owner of a plumbing supply store in the defendant city.<sup>207</sup> She filed an application with the city to receive a permit to increase the size of her store and build a paved parking lot.<sup>208</sup> Instead of granting the permit outright, the defendant conditioned the permit on the granting of an easement to the city in the land that was within the 100-year floodplain of

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<sup>195</sup> *Id.*

<sup>196</sup> *Id.* at 829.

<sup>197</sup> *Id.*

<sup>198</sup> *Id.*

<sup>199</sup> *Id.* at 829-30.

<sup>200</sup> *Id.* at 830-31.

<sup>201</sup> *Id.* at 841-42.

<sup>202</sup> *Id.* at 836.

<sup>203</sup> *Id.*

<sup>204</sup> *Id.* at 837.

<sup>205</sup> *Dolan v. City of Tigard*, 512 U.S. 374, 377 (1994).

<sup>206</sup> *Id.*

<sup>207</sup> *Id.* at 379.

<sup>208</sup> *Id.*



the nearby creek, for the purpose of a public greenway.<sup>209</sup> In addition, the city required a fifteen-foot strip of land outside of the floodplain be reserved for the construction of a foot/bike path.<sup>210</sup>

In challenging the city's requests, the plaintiff exhausted her administrative remedies and ultimately appealed through the Oregon Court of Appeals and Oregon Supreme Court to the United States Supreme Court.<sup>211</sup> The plaintiff alleged that the city's demands amounted to an impermissible taking of her property under the Fifth Amendment.<sup>212</sup> The plaintiff admitted that the city was permitted to condition her permit on the granting of some property rights to the city.<sup>213</sup> The plaintiff's complaint, however, was that the city had not sufficiently made a showing to justify the exactions in this case.<sup>214</sup> The plaintiff argued that more than meeting the essential nexus test was required to protect the state from liability under the Fifth Amendment.

The Court held that in addition to meeting the essential nexus test, the state must also meet a "rough proportionality" test.<sup>215</sup> That is, the "city must make some sort of individualized determination that the required dedication is related both in nature and extent to the impact of the proposed development."<sup>216</sup> In assessing the facts at hand, the Court found that a private greenway could just as easily solve the flood problem.<sup>217</sup> Furthermore, the city did not meet its burden of establishing that the additional bicycle and automobile traffic, caused by the larger store, would be enough to justify a public path through the plaintiff's property.<sup>218</sup>

#### *D. Regulatory Taking Is Best Suited for Compelled Expert Testimony*

In the case of a court's compelling an unretained expert to testify, the best-suited takings analysis is regulatory takings. First, the intangible nature of the information makes the concept of

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<sup>209</sup> *Id.* at 380.

<sup>210</sup> *Id.*

<sup>211</sup> *Id.* at 382-83.

<sup>212</sup> *Id.* at 383.

<sup>213</sup> *Id.* at 385-86.

<sup>214</sup> *Id.*

<sup>215</sup> *Id.* at 391.

<sup>216</sup> *Id.*

<sup>217</sup> *Id.* at 393.

<sup>218</sup> *Id.* at 395.

physical invasion an impossible exercise in metaphysics. Second, it is unlikely that the expert's information would be rendered valueless after being compelled. The expert will still retain all of the information even if the unlikely scenario occurred in which the imparting of his knowledge to the court would confer the same expertise on those listening.<sup>219</sup> To that end, the expert will only have lost the profits associated with providing the compelled testimony, but he can still utilize his information in other situations.<sup>220</sup> Finally, exaction analysis is misplaced in this context. The court is not conditioning a benefit for the expert witness on the witness's willingness to provide expert testimony.

Further evidence that regulatory takings analysis is the appropriate means to use is that the Supreme Court utilized this

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<sup>219</sup> Thomas Jefferson eloquently described this principle when he wrote:

Stable ownership is the gift of social law, and is given late in the progress of society. It would be curious then, if an idea, the fugitive fermentation of an individual brain, could, of natural right, be claimed in exclusive and stable property. If nature has made any one thing less susceptible than all others of exclusive property, it is the action of the thinking power called an idea, which an individual may exclusively possess as long as he keeps it to himself; but the moment it is divulged, it forces itself into the possession of every one, and the receiver cannot dispossess himself of it. Its peculiar character, too, is that no one possesses the less, because every other possesses the whole of it. He who receives an idea from me, receives instruction himself without lessening mine; as he who lights his taper at mine, receives light without darkening me. That ideas should freely spread from one to another over the globe, for the moral and mutual instruction of man, and improvement of his condition, seems to have been peculiarly and benevolently designed by nature, when she made them, like fire, expansible over all space, without lessening their density in any point, and like the air in which we breathe, move, and have our physical being, incapable of confinement or exclusive appropriation. Inventions then cannot, in nature, be a subject of property. Society may give an exclusive right to the profits arising from them, as an encouragement to men to pursue ideas which may produce utility, but this may or may not be done, according to the will and convenience of the society, without claim or complaint from any body.

*Graham v. John Deere Co.*, 383 U.S. 1, 8 n.2 (1966) (quoting VI WRITINGS OF THOMAS JEFFERSON 180-81 (Washington ed., 1903)).

<sup>220</sup> This seems to be at odds with my previous statement that the expert witness cannot rely on other interests such as an institutional party. The difference is that institutions are making money through other means concurrently with the information that they have lost. The expert can only be in one place at a time; if he is in court they are not making money elsewhere and have lost the opportunity to do so. It is similar to the concept of being a "lost volume seller" in contract jurisprudence. To that end, this statement is only made to determine which takings analysis is best suited to address the possible taking. This differentiates only between the takings methods utilized and does not affect the expert witness's right to compensation in one form or another.

method in *Ruckelshaus*.<sup>221</sup> There, the Court found that the question hinged on the “reasonable investment-backed expectations” factor outlined in *Penn Central*.<sup>222</sup> Based on the changes in FIFRA, described in detail above, the Court identified three distinct time periods in which the investment-backed expectations required analysis.<sup>223</sup> The first was for all the data submitted to the EPA after the 1978 amendments.<sup>224</sup> The second was for the data submitted to the government prior to the 1972 amendments.<sup>225</sup> The third was for the data submitted in the time between the 1972 amendments and the 1978 amendments.<sup>226</sup>

In the first instance, the Court found that Monsanto was fully aware of the conditions for submitting the data.<sup>227</sup> A ten-year monopoly was established and Monsanto could not reasonably have any investment-backed expectations beyond those limits.<sup>228</sup> Accordingly, no taking was effected by the regulation.<sup>229</sup> For the time prior to the 1972 amendments, the statute was silent on the question of how the EPA could utilize submitted data.<sup>230</sup> The industry, however, had long been the subject of public concern, and it was likely that the EPA could find disclosure of such information in the public’s interest.<sup>231</sup> The lack of any guarantee regarding the confidentiality of any data submitted and the public concern over the industry meant that no reasonable investment-backed expectation could exist in submitting the information during this time period.<sup>232</sup>

The situation was different, however, for the data submitted between 1972 and 1978.<sup>233</sup> During this time period, applicants were given the option to designate certain information as a trade

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<sup>221</sup> *Ruckelshaus v. Monsanto Co.*, 467 U.S. 986, 1005 (1984).

<sup>222</sup> *Id.*

<sup>223</sup> *Id.* at 1005-10.

<sup>224</sup> *Id.* at 1006.

<sup>225</sup> *Id.* at 1008.

<sup>226</sup> *Id.* at 1010.

<sup>227</sup> *Id.* at 1006.

<sup>228</sup> *Id.* at 1006-07.

<sup>229</sup> *Id.* at 1007. Thus, as long as Monsanto is aware of the conditions under which the data are submitted, and the conditions are rationally related to a legitimate government interest, a voluntary submission of data by an applicant in exchange for the economic advantages of a registration can hardly be called a taking. *Id.*

<sup>230</sup> *Id.* at 1008.

<sup>231</sup> *Id.* at 1008-09.

<sup>232</sup> *Id.* at 1009.

<sup>233</sup> *Id.* at 1010.

secret.<sup>234</sup> Under this version of FIFRA, the EPA was precluded from disclosing information designated as a trade secret.<sup>235</sup> This iteration of the statute provided a reasonable basis for Monsanto to understand that the confidentiality of the information would be maintained.<sup>236</sup> The submissions, therefore, were accompanied with a “reasonable investment-backed expectation” that Monsanto would retain “control over the use and dissemination of the data it had submitted.”<sup>237</sup>

In the case of an unretained expert witness, it is reasonable for him to have an expectation, backed by investment, that he alone has the exclusive right to use and disseminate his information. In the case of an expert who is so designated because of his education, it is unlikely that the expert paid for his education for the altruistic purpose of ensuring justice in litigation. In other words, the expert did not complete his education in order to provide competent expert testimony. Rather, the expert gained his education in order to provide for himself, or at the very least to gain intellectual stimulation. In any case, it is hardly true that the expert expected to provide his services for free on demand. Similar justifications can be given for experts so designated for their knowledge, skill, experience, and training.

In assessing another of the *Penn Central* factors, the nature of the government action is extremely severe. First, court orders are government actions that can amount to a regulatory action.<sup>238</sup> The compelled expert witness does not have a realistic choice of options. The expert is faced with an order from a federal court commanding that he appear and divulge his hard-earned information. If an expert decides to disobey the court order, he will face either a criminal or civil contempt charge. Considering that contempt charges can carry a prison sentence, it is hard to imagine a more severe form of government action.

Similarly, in the vein of the final *Penn Central* factor, determining the economic impact of compelled testimony is not beyond the abilities of the courts. It is likely that data exists to determine fees that have been charged for similar testimony in the past. The expert may also be able to provide data regarding

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<sup>234</sup> *Id.*

<sup>235</sup> *Id.* at 1011.

<sup>236</sup> *Id.*

<sup>237</sup> *Id.*

<sup>238</sup> See *supra* notes 183-89 and accompanying text.

the fees charged in other engagements requiring the dispensation of the same or similar opinions.

Information has been deemed property and, therefore, it is possible to be taken in violation of the Fifth Amendment. In short, the balancing test outlined in *Penn Central* is well suited to assess takings claims regarding intellectual property. The nature of any investment-backed expectation is discoverable, the extent of the governmental action has the potential to be severe, and the economic impact of compelling expert testimony is readily obtainable.

#### IV

#### RECOMMENDATIONS

As early as the 1950s, the United States was a worldwide leader in the export of intellectual property.<sup>239</sup> By the early 1980s, the United States was the world's largest exporter of intellectual property.<sup>240</sup> These developments were the impetus for the United States to join the Berne Convention in 1989.<sup>241</sup> By joining the Berne Convention, the United States ensured protection for its authors' copyrights in all of the member nations.<sup>242</sup> One immediate effect was copyright protection in two dozen countries with which the United States did not previously have intellectual property treaties.<sup>243</sup> Undoubtedly, the United States recognized the inherent value of intellectual property and made these changes to protect its valuable assets.

Pamela Samuelson warned that a new attitude in the law's recognition of property rights in intellectual property may be upon us.<sup>244</sup> Her warning came in 1989, and fifteen years later it now seems that this premonition has come true. Many of today's wealthiest people are in the business of information.<sup>245</sup> Congress has recognized this trend and changed copyright laws to protect

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<sup>239</sup> JOYCE, *supra* note 58, § 1.04[B][2], at 32.

<sup>240</sup> *Id.* § 1.04[C][1], at 36.

<sup>241</sup> *Id.* § 1.04[B][3], at 33 ("The Berne Convention is administered by the World Intellectual Property Organization ("WIPO"), an intergovernmental organization with headquarters in Geneva, Switzerland. WIPO is a specialized agency within the United Nations system. Its central role is to conduct studies and provide services designed to facilitate protection of intellectual property."). *Id.*

<sup>242</sup> *Id.* § 1.04[C][1], at 36.

<sup>243</sup> *Id.*

<sup>244</sup> Samuelson, *supra* note 72, at 395.

<sup>245</sup> Three of Forbes' "World's Richest People" made their fortunes in software technology: Bill Gates and Paul Allen of Microsoft, and Lawrence Ellison of Oracle.

these valuable assets accordingly.<sup>246</sup> Now it is time for the courts to make this same recognition and protect unretained expert witnesses from being compelled to testify under Rule 45.

When deciding whether to compel an expert's testimony, the courts are guided by assessing the copyrightability of the expert's work. In so doing, analyzing the issue from the perspective of the *Feist* fact/expression dichotomy will aid the courts in determining if the issue is one of fact, appropriate for compelling, or an issue of opinion in which a copyrightable property interest exists. If the courts are able to locate a copyright property interest, serious consideration must be given against compelling the testimony without compensation. Analyzing the issue in terms of copyrights helps to identify property interests in intangible intellectual works. Similarly, a court may be more willing to recognize a copyright property interest if it is hesitant to recognize information as property in following *Ruckelshaus* and *Carpenter*.

In addition, copyright jurisprudence may be beneficial in supplying a model for the licensing of expert witness testimony. Expert witnesses should retain the right to bargain for the use of their services, as the advisory committee notes suggest. There are situations, however, where the expert witness will lack bargaining power or the need for the testimony will be so great that the temptation to compel the witness will be unbearable. In these situations, a system of compulsory licensing may be beneficial to protect both the property interests of the expert witnesses and the litigants' right to competent testimony at trial. The teachings of copyright law will be instrumental in administering any such compulsory licensing scheme.

If no copyrightable interest can be found in the expert's testimony, however, a property interest may still be present. It is precisely the holdings of *Ruckelshaus* and *Carpenter* that give rise to this interest. The Supreme Court has unequivocally held, twice, that information is property. Federal courts are bound by this precedent and must recognize this property interest in the information sought to be compelled from an expert through Rule 45.

After recognizing a property interest in an expert's testimony,

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Forbes.com, World's Richest People 2003, at <http://www.forbes.com/2003/02/26/billionaireland.html> (last visited Jan. 18, 2005).

<sup>246</sup> JOYCE, *supra* note 58, § 5.01[B][1], at 342 ("On October 27, 1998, President Clinton signed into law the Sonny Bono Copyright Term Extension Act (Title I, Pub. L. No. 105-298) extending the basic term of protection to life-plus-70 years.").

courts should find guidance for compensation questions in the traditional *Penn Central* regulatory takings analysis. In completing the analysis, courts should seek to determine the economic impact of compelling the testimony. Similarly, the nature of a court order compelling a witness to testify should be considered. Finally, courts should assess the reasonable investment-backed expectations, if any, that exist in the expert. After completing this analysis, courts should be able to determine if compelling the expert would amount to a taking. Furthermore, this analysis should have the added benefit of determining reasonable compensation that may be owed to an expert forced to testify under Rule 45(c)(3)(B)(iii).

#### CONCLUSION

Ultimately, an expert witness should never be forced to divulge his information without compensation. The discretionary language of Rule 45(c)(3)(B)(ii) should be modified from *may* to *shall* to match that of Rule 45(c)(3)(A). As the advisory committee's notes to the 1991 amendment of Rule 45 suggest, forcing an expert to testify amounts to a taking of his property. The holdings in *Ruckelshaus* and *Carpenter* make this clear. Analyzing the question of compulsion in light of *Feist* will aid courts in determining whether the desired information is factual or expressive. In the former, compulsion does not reach the Fifth Amendment takings question. In the latter, however, courts must recognize the property interest that has become the bedrock of the United States economy and must order just compensation.

