

THE MYTHICAL BEGINNINGS OF INTELLECTUAL PROPERTY

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INTRODUCTION

People commonly justify intellectual property protection with homage to utilitarianism (maximizing the incentive to create, invent, or produce quality goods)¹ or natural rights (people should own the product of their creative, inventive, or commercial labor).² Despite the on-going dominance of these theories, a dissatisfying lack of a comprehensive explanation for the value of intellectual property protection remains.³ One reason for this failure is that economic analysis of intellectual property law tends to undervalue its humanistic element.⁴ Whereas utilitarianism and natural rights theories are familiar, at least one other basis for intellectual property protection exists. This Article explains how intellectual property protection is rooted in narrative theory.⁵ It contends that all the U.S. copyright, patent, and trademark regimes are structured around and

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¹ William Fisher, *Theories of Intellectual Property*, in *NEW ESSAYS IN THE LEGAL AND POLITICAL THEORY OF PROPERTY* 168, 169 (Stephen R. Munzer ed., 2001) (describing utilitarian theory as the “most popular” theory of intellectual property); Lemley, *Property, Intellectual Property, and Free Riding*, 83 *Tex. L. Rev.* 1031, 1031 (2005) (“Intellectual property protection in the United States has always been about generating incentives to create.”)

² Justin Hughes, *The Philosophy of Intellectual Property*, 77 *Geo. L.J.* 287, 296-330 (1988); Alfred C. Yen, *Restoring the Natural Law: Copyright as Labor and Possession*, 51 *Ohio St. L. J.* 517, 523-29 (1990).

³ Madhavi Sunder, *IP3*, 59 *Stan. L. R.* 257, 260 (2006) (“To put it bluntly, there are no ‘giant-sized’ intellectual property values.”)

⁴ *Id.* at 259 (“Intellectual property utilitarianism does not ask who makes the goods or whether the goods are fairly distributed to all who need them.”) See also James Boyd White, *Economics and Law: Two Cultures in Tension*, 54 *Tenn. L. Rev.* 162, 172-85 (1987) (criticizing the moral and political implications of economics).

⁵ Understanding law through narrative theory is not a new endeavor, only largely overshadowed by other theories of human understanding and behavior. See, e.g., Carol Rose, *Property and Persuasion: Essays on the History, Theory and Rhetoric of Ownership* 5-6 (1994) (bridging the gap between the neo-utilitarian and communitarian theories of real property regimes with “norms and narration” explaining that “in fact, if (as I argue) [real] property regimes

legitimated by central origin myths—stories that glorify and valorize enchanted moments of creation, discovery, or identity. As a cultural analysis of law,⁶ rather than the more familiar economic theory of law,⁷ this Article seeks to explain how these intellectual property regimes work the way they do.⁸ And as a narrative explanation for the structure of intellectual property protection, this Article enhances the more customary economic or philosophical accounts because narrative, especially one devoted to myth—making in our society, provides “models for human behavior and, by that very fact, gives meaning and value to life.”⁹

An “origin myth” or an “origin story” is a narrative that explains how a culture came into being.¹⁰ Genesis is an origin story, as is the story of the Founding Fathers of the United States Constitution. I will have more to say about the structure and function of origin myths in Part I, *infra*, but at its core an origin story serves both ontological and epistemological functions.¹¹ It infuses everyday life and relations with significance by explaining why things are as they are and by providing guidance for how things should evolve based on what we already understand about

cannot get over the self-interest problem without imparting some sense of the common good, then narratives, stories, and rhetorical devices may be essential in persuading people of that common good”).

⁶ “[C]ultural analyses of law attempt to describe the processes by which law contributes to the articulation of meanings and values in everyday life.” Susan S. Silbey, *Making a Place for Cultural Analyses of Law*, 17 *Law & Soc. Inq.* 39, 42 (1992).

⁷ See WILLIAM M. LANDES & RICHARD A. POSNER, *THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY LAW*, 37-165, 294-333 (2003) (discussing copyright and patent rights). See also *id.* at 166 (“[T]rademark law [is] highly amenable to economic analysis”).

⁸ Although I draw a distinction between explanation and justification, I understand that explanations are not free of normative implications. As the foregoing discussion of origin myths will make clear, origin myths are structured around certain social values and not others. To describe intellectual property protection in terms of origin myths, therefore, is to show how intellectual property law elevates certain principles over others. If we value the principles that origin myths omit or denigrate, then we can argue that the structure of intellectual property protection as a function of origin myths is flawed.

⁹ MIRCEA ELIADE, *MYTH AND REALITY* (1963) 2 (trans. W.R. Trask). See also David Engel, *Origin Myths: Narratives of Authority, Resistance, Disability, and Law*, 27 *Law & Soc. Rev.* 785, 789 (1993) (“The role of narrative in constructing concepts of self and society has become clear in a multitude of studies, including those addressing a broad range of law-related issues such as race, gender, community, and the practice of law.”)(internal citations omitted).

¹⁰ JOANNE H. WRIGHT, *ORIGIN STORIES IN POLITICAL THOUGHT: DISCOURSES ON GENDER, POWER AND CITIZENSHIP* 1 (2004). See also Eliade, *supra* note __ at 5-6.

¹¹ Generally speaking, an ontological inquiry is the study of reality or the nature of being and an

our world. As David Engel has written, the “retelling of [origin] myths is . . . many things at once: an act of insight, a reinterpretation of the past, a reaffirmation of core values and beliefs, and a ‘reactualization’ of the cosmic order.”¹²

Parts II, III, and IV of this Article investigate the statutory regimes and common law that govern intellectual property protection in the United States in light of the narrative theory of Part I. Patent, copyright, and trademark law each instantiate the importance of origins, albeit in different ways. Patent law protects that which the inventor conceived, the inventor being the first to reduce her conceived invention to practice.¹³ Copyright law protects original works of authorship, the expression having originated with the author.¹⁴ Trademark law protects signifiers as distinctive source identifiers.¹⁵ These Parts of the Article, when read together, contrast the three statutory intellectual property regimes for their structured valuation and reification of their own origin myth. They also show how the political origin myths structuring intellectual property protection articulate a well-worn story about the origins and continuing vitality of the American republic (rugged individualism and the American dream¹⁶). Each part also draws on popular cultural stories about intellectual property and a recent intellectual property dispute to illuminate how origin myths structure the respective discourses of these intellectual property systems and

epistemological inquiry is the study of the methods and limitations of knowledge or ways of knowing.

¹² Engel, *supra* note __ at 792.

¹³ *Ethicon, Inc. v. United States Surgical Corporation*, 135 F. 3d 1456, 1460 (Fed. Cir. 1998).

¹⁴ 17 U.S.C. § 102(a).

¹⁵ 15 U.S.C. § 1127.

¹⁶ Herbert Hoover, Rugged Individualism Speech, October 22, 1928 (“We were challenged with a... choice between the American system of rugged individualism and a European philosophy of diametrically opposed doctrines of paternalism and state socialism. The acceptance of these ideas would have meant the destruction of self-government through centralization... [and] the undermining of the individual initiative and enterprise through which our people have grown to unparalleled greatness.”). The content of the “American Dream” is as diverse as our nation, but the dominant narrative tracing the American Dream has been repeated by numerous political theorists and American presidents. “The American dream that we were all raised on is a simple but powerful one - if you work hard and play by the rules you should be given a chance to go as far as your God-given ability will take you.” President Bill Clinton, Speech to Democratic Leadership Council, 1993 as quoted in JENNIFER HOCHSCHILD, *FACING UP TO THE AMERICAN DREAM: RACE, CLASS AND THE SOUL OF A NATION* 18 (1995).

explain adjudicative results.

In contrast to the structural importance of the origin story in defining and substantiating intellectual property schemes, Part V briefly examines recent developments in trademark, patent, and copyright law that drift away from the protection of origins to alternative sources of value. Trademark law has experienced the federalization of anti-dilution law, which protects less the source identifying function of the mark than it does a right in gross.¹⁷ Congress is currently debating a reformation of the Patent Act that would substantially change the definition of an inventor from one who first conceives an invention to one who first files for patent protection.¹⁸ In copyright law, recent debates about the United States' obligations under the Berne Convention (e.g., obligations regarding moral rights, the right of attribution, and the current practice among certain authors who grant royalty-free non-exclusive licenses of digital works on the condition that attribution be granted upon publication and distribution) underscore competing notions of whether and how the originator of a work will be protected by the law.¹⁹ The final part of this Article discusses these changes in the various intellectual property regimes and analyzes them for what they say about the inevitability of competing origin stories in law and culture. In contrast to Parts II, III, and IV, in which I take seriously the claim that each intellectual property regime is structured around an origin myth, Part V outlines current intellectual property debates that undercut the heuristic role of these origin myths to demonstrate instead the myth of origins.

This Article participates in the growing body of interdisciplinary legal scholarship that

¹⁷ 15 U.S.C. § 1125(c).

¹⁸ Patent Reform Act of 2007, H.R. 1908, S. 1145, 110th Cong.

¹⁹ For debates about the “droit moral” or the “right of attribution” under current United States intellectual property regimes, see, e.g., Jane C. Ginsburg, *The Right to Claim Authorship in U.S. Copyright and Trademark Law*, 41 *Hous. L. R.* 263 (2005). For a royalty-free non-exclusive license, see, e.g., Creative Commons Attribution-NonCommercial-Sharealike-1.0 License, § 4(d) (requiring attribution of authorship upon exercise) at <http://creativecommons.org/licenses/by-nc-sa/1.0/legalcode>.

takes as its premise the inseparability of law and culture. In this vein, the Article’s aim is threefold. Primarily, the Article provides a new explanation for intellectual property protection in light of a novel theory of the narrative structure of the origin myth. Secondly, the Article discerns from a comparative analysis of the contemporary debates concerning the three federal intellectual property regimes competing narratives of value, which reveals an inherent uncertainty about the origins of human creation. And lastly, the Article aims to demonstrate how close attention to narrative theory and cultural tropes enriches the analysis of law .²⁰

I. ORIGIN MYTHS

A. *As a Heuristic for an Individual and Community*

Origin myths are a special kind of narrative. “The retelling of myths about origins represents an attempt to transcend historical time, with its relentless linear progression, its ‘irreversibility.’ . . . The return to primal events allows humans to clarify existential meanings that are sometimes obscured by the misfortunes and suffering that drain everyday life of its value and direction.”²¹ Origin myths have explanatory force, collapsing the inquiries of “who are we” with “where did we come from.” They are so foundational to human existence and society that as cultural narratives they come “as close to a universal phenomenon as might be imagined.”²² Moreover, the study of origin stories is not relegated to literature and cultural anthropology. Spanning religious studies, archeology, evolutionary biology, astronomy, chemistry, and

²⁰ In writing an origin story (this Article) about origin stories (the origin myths that structure intellectual property law), I am participating in, as much as I am critiquing, the law’s facilitation of origin stories. Unpacking the significance of this recursivity is beyond the scope of this project, but its irony is not lost on me.

²¹ Engel, *supra* note __ at 792 (quoting MIRCEA ELIADE, *COSMOS AND HISTORY: THE MYTH OF THE ETERNAL RETURN* 75 (1949) (trans. W. R. Trask 1959)).

²² Wright, *supra* note __ at 3.

political theory, “our origins preoccupy us.”²³ In these ways, origin stories are heuristic, “explor[ing] fundamental questions and problems and . . . assign[ing] meaning to our human existence.”²⁴

Origin myths are not necessarily narratives of bygone eras, either. The creation and perpetuation of myth is as much part of our contemporary culture as it was part of Ancient Greece.²⁵ Myths are essential to most cultures and communities precisely because they establish “deeper meanings and . . . archetypes rather than . . . objective certainty. [Myth] starts with the materials of human experience but transforms their particularities into narratives that speak more broadly about the essential nature of self and society.”²⁶ Origin myths bring order to social relations by explaining the nature of the self and her entitlements, role in, and relation to her society.²⁷

One ubiquitous origin story is the political origin myth, the story that explains how a society or civilization came into existence. These narratives are not only stories about the literal birth of a society but about the political outlines of social life as well. They designate a “script[] of citizenship”²⁸ and concern themselves with “the beginnings of politics and power.”²⁹ Genesis is one such origin myth, establishing the beginning of human civilization with God’s creation of man in His image and the subordination of Eve through her birth (“origin”) in Adam’s rib.³⁰ The

²³ Id.

²⁴ Id. at 8. See also Steven Goldberg, *Kennewick Man and the Meaning of Life*, 2006 U. Chi. L. Forum 271, 283 (2006) (“Questions concerning human origins and the origin of life matter a great deal to all of us because they speak not only to where we come from, but also to whether and how our lives have meaning.”)

²⁵ CLAUDE-LEVI STRAUSS, *STRUCTURAL ANTHROPOLOGY* 209 (1963).

²⁶ Engel, *supra* note __ at 791 (citing to Norman Austin, *Meaning and Being in Myth*, 1990 (“[M]yth, though determined in its form by its immediate historical context, transcends any historical moment, being at the fundamental level the quest for the self.”)).

²⁷ Levi-Strauss, *supra* note __ at 211.

²⁸ Wright, *supra* note __ at 19.

²⁹ Wright, *supra* note __ at 3.

³⁰ Id. at 8. (Wright discusses the abolition of Lilith from the Garden of Eden for her insubordination toward Adam

story of Romulus and Remus, mythological founders of Rome who were fathered by Mars (the god of war) but raised by a wolf, stresses the divine status of Rome and the domination of the Roman Empire.³¹ Thomas Hobbes' *Leviathan* is another political origin story, describing a brutal, warring "anarchic and pre-social state that is ultimately transcended by a social contract" that establishes the security of individuals in society through the control by the (English) sovereign.³²

Plato's myth of the metals is a well-known political origin story. He writes: "The earth moulds its children carefully, fashioning each for a specific role in the city. Those who rule are composed primarily of gold, those who protect the city, silver, and the farmers and artisans have iron and brass in their constitution."³³ Socrates explains the need for this "'noble lie' to persuade the inhabitants of the city to accept the logic of its organization."³⁴ As Plato's myth of the metals was meant to "quell uprisings and disorder, and to ensure conformity to his envisioned hierarchy,"³⁵ Genesis legitimates the politics of gender hierarchies. Likewise, the story of Romulus and Remus justifies Rome's violent aggression towards and control over its neighbors. And Hobbes' *Leviathan* justifies inequality in civil society and absolute obedience to the sovereign.

Origin myths are heuristic because they answer fundamental questions about and assign meaning to our lives. The heuristic benefits do not only apply at an individual level, but on a societal one as well. An origin story reflects a society's image of itself, its central values and goals. Consider some of the United States' national heroes who are intimately tied to the United

and the rebirth of woman as the submissive Eve as another version of the Genesis origin story.)

³¹ HENRY TUDOR, *POLITICAL MYTH* 97, 134 (1972).

³² Wright, *supra* note 56-57.

³³ Wright, *supra* note ___ at 4.

³⁴ *Id.* at 4.

States' origin story: George Washington (the quintessential commander-in-chief, mastermind of the Revolutionary War, humble, yet strong and victorious), Thomas Jefferson (asserting the divine right to equality, a master of letters, and a defender of state's rights), Benjamin Franklin (representing American innovation and independence), Abraham Lincoln (establishing the right to racial equality and asserting the unity of the nation above all in its rebirth after the Civil War). They each exemplify the spirit and pride that many people believe the United States represents and display characteristics that citizens believe explain the nation's successes.

B. *As a Measure of Authenticity*

Origin stories are about the “how” of political beginnings, just as much as they are about the “why” of those beginnings. Origin myths authorize the initial social structure by appealing to authenticity. They do so in two related ways: through essentialism and being first-in-time.

Origin stories often explain and legitimate certain social relations by hinting at a theory of human nature.³⁶ For example, Genesis describes the “natural” differences between the sexes to justify hierarchical gender relations. Plato's myth of the metals describes the “natural” difference among people who are either reasonable (made of gold) and thus legitimate members of the ruling class, spirited (made of silver) and thus the best kind of protectors, or all body (made of brass), and thus industrious but dim and worthy only of laborer status.³⁷

Origin stories also convincingly describe a person or circumstance who existed “in the beginning” and thus who is sufficiently blessed or wise to originate this society. This person (or

³⁵ Id. at 4-5.

³⁶ Id. supra note __ at 74-75.

³⁷ We see recourse to “human nature” with regard to certain discourses concerning evolutionary biology. From scientific theories concerning evolution and human biology, we learn facts about our biological make-up (facts that are presumably amoral and apolitical) that are then explained as inevitable features of our sociality. See, e.g. Anne Moir and David Jessel, *Brain Sex: The Real Difference Between Men and Women* (1991) (explaining that the reason men have been the dominant sex throughout human history

circumstance) therefore garners the authority and legitimacy necessary to wield power and control and to exert the force of law.³⁸ “[P]olitical origins discourse assumes that origins contain essential and indispensable data from which political solutions are molded.”³⁹ In this way, invocation of a political origin, such as the Founding Fathers of the United States and their intent in drafting the Constitution, can justify present circumstances and assertions of right with an appeal to the past.⁴⁰ “Origin stories, then, are essentialist narratives that do more than simply uncover beginnings: they authorize implicitly particular solutions.”⁴¹

C. *As Establishing Consent*

Origin myths authorize certain political and social arrangements through narratives of consent or by manufacturing consent through their repetition.⁴² The social contract is the quintessential example of an origin story that justifies absolute obedience to a government with a story of consent.⁴³ Consent comes in all forms in origin stories—written and explicit political contracts (constitutions), oral or civil contracts (the marriage contract, “I do”), tacit consent or acquiescence (as in parental relations with children).⁴⁴ As we will see *infra*, the origin stories that circulate about intellectual property protection span all three forms. The repetition of these

lies in the difference in their fetal brain development).

³⁸ See WALTER BENJAMIN, *ILLUMINATIONS* 220 (1968) (trans. Harry Zohn). (“The presence of the original is the prerequisite to the concept of authenticity.”)

³⁹ *Id.* at 9.

⁴⁰ Oren Bracha, *Owning Ideas: A History of Anglo-American Intellectual Property, Interlude: the Constitutional Moment?! 273* (2005) (unpublished S.J.D. dissertation, Harvard Law School), available at <http://www.obracha.net/oi/oi.htm> (“The longing for an ‘original meaning’ laid down by the almost mythical authority of the founding fathers, enshrined as part of the most sacred artifact of American civic religion—the Constitution—and serving as a supposed shield against judicial subjectivism, is a longstanding fixture of American jurisprudence and of the American political ethos in general.”). See also PHILIP ABBOTT, *EXCEPTIONAL AMERICA: NEWNESS AND AMERICAN IDENTITY* (1999) (describing the Federalist Papers as a “sacred text” and an origin of American exceptionalism).

⁴¹ Wright, *supra* note ___ at 10.

⁴² *Id.* at 5-6,

⁴³ “The foundation of Hobbes’ social contract is consent. Men make a choice to consent to absolute power rather than to continue to exist in an unlivably insecure condition of war.” *Id.* at 58.

stories of consent throughout the case law, the litigation that becomes case law, and the statutory and constitutional history behind the law, serves to further reinforce the message of consent. As each person, community, or court repeats the origin myth that explains and justifies the particular intellectual property protection as appropriate, that person, community, or court has signaled acceptance of that particular political arrangement.⁴⁵

Other than legitimate political, civil or social arrangements, explain a community's identity and purpose, or "uncover an illusive primordial truth" about human nature or civilization,⁴⁶ origin stories also mask the violence of beginnings. This is Hannah Arendt's theory of origin myths: that all political beginnings are "intimately connected with violence" and that "no beginning could be made without using violence, without violating."⁴⁷ To be sure, some origin myths might be told to avoid further violence. A court that invokes an origin story to justify a certain property arrangement relies on narrative to avoid or quash further conflict between the parties (be it violent or otherwise). And some origin myths might be told to uncover originary violence, such as the reemergence of Lilith in radical feminism in the 1970s.⁴⁸ In any case, studying the relation of origin myths to violence may help to better understand the motivation behind the telling and retelling of origin myths in society generally, and law, specifically.

⁴⁴ Id. at 89.

⁴⁵ This is what Mircea Eliade calls "the eternal return." Eliade writes that "an object or act becomes real only insofar as it imitates or repeats a archetype." MIRCEA ELIADE, *THE MYTH OF THE ETERNAL RETURN* 34 (1954) (trans. Willard Trask). Eliade further says that "this repetition, by actualizing the mythical moment when the archetypal gesture was revealed, constantly maintains the world in the same auroral instant of the beginnings." Id. at 90. Repetition thus helps to fashion consent in the contemporary community as it also reminds the community through its evocation of the distinctive and exceptional character of the originating moment (it's aura).

⁴⁶ Wright, *supra* note __ at 11.

⁴⁷ HANNAH ARENDT, *ON REVOLUTION* 10 (1963). "In the beginning, there was a crime." Id. at 11.

⁴⁸ Wright, *supra* note __ at 8. See also id. at 11 ("Feminist origins theorists bring to the surface the violence of a patriarchal war, and of an original rape and/or matricide. They replace the myth of consent between the genders with the 'truth' of war and violence.").

In sum, origin myths are a heuristic, explaining fundamental questions about and assigning meaning to our lives. They authorize or confer authority on preconceived political solutions, deriving (and thus justifying) society's extant power relations and hierarchies with homage to authenticity and through narratives of consent. As Roland Barthes has written, "myth . . . purifies [things], it makes them innocent, it gives them a natural and eternal justification."⁴⁹ It does so to hide or avoid violent human conflict. Retelling the mythic narrative assures consent to the arrangement, either explicitly as a form of contract or implicitly through acquiescence. The "truth" of origin stories is not important for this analysis. As with most analyses of narrative, the point is to discern how these stories function to order social relations (intellectual property relations) through the development and maintenance of narrative authority.⁵⁰

II. PATENT LAW

A. *Patent Origins*

The origin myth that structures U.S. patent law has as much to do with the "what" of patents (the invention) as with the "who" of patents (the inventor). Although the property right granted by a patent may be dressed in the trappings of real property like Blackacre—granting its owner the right to exclude others from making, using, selling, or offering to sell the property during a specific period of time⁵¹—it also has mystical underpinnings.

⁴⁹ ROLAND BARTHES, MYTHOLOGIES 143 (1972) (trans. Annette Lavers).

⁵⁰ See, e.g., Ross Chambers: Story and Situation: Narrative Seduction and the Power of Fiction 212 (1984).

⁵¹ 35 U.S.C. § 154(a). See also Philip C. Swain, The One Thing Judge Rich Wanted everybody to Know About Patents, 9 Fed. Cir. B.J. 97, 100 (1999) ("This right to exclude others is the essence of any property right, including an 'intellectual property' right, as well as a land owner's real property right to keep someone from trespassing in his or her backyard.").

1. As a Measure of Authenticity to Legitimate Hierarchy

Patents describe inventions that must originate in the mind of the inventor. As one early Court said, “Invention is the work of the brain, not the hands.”⁵² An inventor is one who is the first to conceive of the invention and reduce it to practice.⁵³ Conception—itself a loaded term concerning origins and mythical moments—is

the complete performance of the mental part of the inventive act. All that remains to be accomplished in order to perfect the act or instrument belongs to the department of construction, not invention. It is therefore the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention as it is thereafter to be applied in practice that constitutes an available conception within the meaning of the patent law.⁵⁴

Indeed, mental conception is so central to being an inventor by law that courts no longer require reduction to practice.⁵⁵ “The primary meaning of ‘invention’ in the Patent Act unquestionably refers to the inventor’s conception rather than to a physical embodiment of that idea. The statute contains no express ‘reduction to practice’ requirement and it is well settled that an invention may be patented before it is reduced to practice.”⁵⁶

In this way, patent law is not the right to own your own labor or a system of law and community that guarantees and values that right. The *labor* of invention (reduction to practice)—performed by those made of silver or brass in Plato’s Myth of the Metals—is trivial compared to

⁵² Edison & Foote v. Randall, 1871 C.D. 80 (1871).

⁵³ 35 U.S.C. § 102(a) & (g)(2). See also Erben v. Yardley, 267 F. 345, 346 (D.C. Cir. 1920) (“the first to conceive and reduce to practice” is the inventor). See also 2 R. Carl Moy, Moy’s Walker on Patents §§ 10.11 (4th ed. 2003) (“Courts have repeatedly asserted that the person who conceives of the invention is the inventor regardless of who else contributes to the invention finally being completed . . . [U]nder the usual view inventorship does not attach from the act of accomplishing a reduction to practice.”).

⁵⁴ Townsend v. Smith, 36 F.2d 292, 295 (CCPA 1929).

⁵⁵ Mario Biagioli, [Patent Republic: Specifying Inventions, Constructing Authors and Rights. 73 Social Research 1129, 1138-39 \(2006\) \(briefly tracing the waning of the reduction-to-practice requirement in United States patent law from the original patent act to the present\).](#)

⁵⁶ Pfaff v. Wells Electronics, Inc., 525 U.S. 52, 55 (1998). See In re Hardee, 223 U.S.P.Q. 1122, 1123 (Comm’r Pat. & Trademarks 1984) (“The threshold question in determining inventorship is who conceived the invention. . . . Insofar as defining an inventor is concerned, reduction to practice, *per se*, is irrelevant.”).

conception—achieved by those with gold in their constitution. Brain, not brawn, is essential in patent law. Moreover, whatever your genius output, you must be the *first* to conceive it, as being first indicates the genuine and authentic inventor.⁵⁷ Being the “first and true inventor”⁵⁸ is so critical to patent law that once the patent issues in an inventor’s name, the law blesses inventor with a presumption of authenticity (the patent is presumed valid and the inventorship correct) such that any subsequent challenge to inventorship can only succeed with clear and convincing evidence.⁵⁹

2. Establishing Consent (to legitimate power and property relations)

The patent’s presumption of validity would make sense were inventorship subject to critical review at the Patent and Trademark Office. But instead, sworn declarations alone primarily determine inventorship.⁶⁰ In other words, each inventor’s “creation story” is left to faith.⁶¹ For example, in the absence of disagreement, the PTO takes the inventor’s word at face value even if it lacks corroborating evidentiary support.⁶² As evidence of this trust, each patent applicant must sign the declaration of inventorship under penalty of perjury. The declaration is,

⁵⁷ See also *infra* at ____ (nothing the importance of chronology in the novelty analysis).

⁵⁸ This language comes from the first U.S. patent statute requiring that the subject of the invention was "not before known or used" and the applicant be the "first and true inventor." Act To Promote The Progress of Useful Arts (1790 Patent Act), ch. 7, 1 Stat. 109, at §§1, 5.

⁵⁹ *Hess v. Advanced Cardiovascular Sys., Inc.*, 106 F.3d 976, 980 (Fed. Cir. 1997).

⁶⁰ See 37 C.F.R. 1.63; *Fritsch v. Lin*, Interference No. 102,097 (Bd. Pat. App. & Inter., Dec. 3, 1991) (“Statements in patent application as to sole or joint inventorship are prima facie evidence of such fact and a party relying upon his application does not have to prove such facts.”);

⁶¹ Even in interference cases, when the PTO is the first tribunal to be adjudicate the legality of the patent, which would include the correctness of inventorship, the PTO considers its job is to determine *priority* of inventorship not inventorship itself. *Ellsworth v. Moore*, Interference No. 104,528 (Bd. Pat. App. & Inter., Nov. 20 2001) (“This is not a typical interference where a party seeks to establish priority vis-à-vis an opponent who may have independently made a patentable invention. Rather, the interference is an inventorship contest.”).

⁶² *Fritsch v. Lin*, Interference No. 102,097 (Bd. Pat. App. & Inter., Dec. 3, 1991). See also *Brader v. Schaeffer*, 193 U.S.P.Q. 627, 631 (Bd. Pat. Inter. 1976) (regarding correction of inventorship, “[a]s between inventors, their word is normally taken as to who are the actual inventors” when there is no disagreement).

in fact, an “oath” executed by the inventor and made true by her signing.⁶³

Sympathetically, one might ask how the PTO would precisely investigate claims to inventorship when the requirement for that status is “the complete performance of the mental part of the inventive act.”⁶⁴ How else but by reliance on a sworn declaration? What kind of evidence would substantiate the fabled eureka moment—the “flash of genius”?⁶⁵ To be sure, congress has amended the Patent Act and courts have further modernized it through common law to reflect the prevailing realities of scientific research to include collaborative science and joint inventorship⁶⁶ through which inventions are the product of social interactions rather than isolated meditation.⁶⁷ However, the language of conception and the stories told about inventors still manifest the solo mad scientists flying kites in lightning-filled skies whose inventions appear like a cloud of smoke above their heads.⁶⁸ This mythical moment of invention, the “aha” moment of discovery that only a single person in a quiet but stunning moment of reflection can

⁶³ See 37 C.F.R. 163 (“Oath or Declaration” stating “that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought”). See also *Board of Education ex rel Board of Trustees of Florida State University v American Bioscience Inc*, 67 USPQ 2d 1252 (Fed. Cir. 2003) (stating that “[i]t is the responsibility of the applicants and their attorneys to ensure that the inventors named in a patent application are the only true inventors” and that patent examiners in the United States normally do not review the correctness of inventor naming, but rely on the solemn inventor declaration or oath that is a required part of a patent application); *Driscoll v. Cebalo*, 5 U.S.P.Q.2d 1477, 1481 (Bd. Pat. Inter. 1982) (“The party or parties executing an oath or declaration under 37 CFR 1.63 are presumed to be the inventors.”).

⁶⁴ *Townsend*, 36 F.2d at 295.

⁶⁵ *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U.S. 84, 92(1941). “The patent system . . . added the fuel of interest to the fire of genius, in the discovery and production of new and useful things.” A. Lincoln, *Second Lecture on Discoveries and Inventions*, (Feb. 11, 1859), in 3 *The Collected Works of Abraham Lincoln* 356, 363 (Roy P. Basler ed., 1953).

⁶⁶ 35 U.S.C. § 116. See also 130 Cong. Rec. 28,069-71 (1984) (legislative history of the 1984 amendments to the Patent Act, including section 116 adding a provision for joint invention “recogniz[ing] the realities of modern team research”); *Ethicon, Inc. v. United States Surgical Corp.*, 135 F.3d 1456, 1469-1470 (Fed. Cir. 1998) (describing the purpose of the new §116, as among others, “to remedy the increasing technical problems arising in team research, for which existing law, deemed to require simultaneous conception as well as shared contribution by each named inventor to every claim, was producing pitfalls for patentees, to no public purpose”). See *id.* at 1470 (“The progress of technology exacerbated the inventorship problems. Patents were invalidated simply because all of the named inventors did not contribute to all the claims . . .”).

⁶⁷ Corynne McSherry describes “invention [as] a social act.” *WHO OWNS ACADEMIC WORK: BATTLING FOR CONTROL OF INTELLECTUAL PROPERTY* 154 (2001).

experience, remains the heart of what it means to be an inventor. As such, the PTO and courts are left to consider only the inventor's story of creation, his sworn testimony that legitimates the patent: an originary contract binding the inventor, her collaborators, and the United States government to the terms therein.

3. As a Heuristic of an Individual and a Nation

When considering inventive subject matter, rather than the inventive moment, courts have attempted to bring patent law down to earth by honing the scope of patentable subject matter. Doing so would ideally add a measure of consistency and fairness to the process. Indeed, one impetus behind the U.S. patent system was to create a system of rights and entitlements as distinct from the discretionary and quixotically granted monopolistic privileges conferred under the English monarchy.⁶⁹ Importantly, “[t]here is no discretion on the part of the PTO as to whether or not to grant the patent—if the statutory requirements are met [of novelty, non-obviousness and usefulness], a patent is issued.”⁷⁰ Some of the earliest known debates surrounding the intellectual property clause in the Constitution⁷¹ and the first Patent Act of 1790 go as far as to suggest that “each American citizen has a constitutional *right* to his property in the product of his genius and that it should be secured by the National Legislature.”⁷²

⁶⁸ See *infra* Part I.B.

⁶⁹ Oren Bracha, *The Commodification of Patents 1600-1836: How Patents Became Rights and Why We Should Care*, 38 *Loy. L. Rev.* 117, 184-187 (2004).

⁷⁰ *Markman v. Westview Instruments, Inc.* 52 F.3d 967, 985 n.14 (1995). See also 35 U.S.C. § 151.

⁷¹ “Congress shall have the power . . . [t]o promote the progress of science and the useful arts by securing for a limited time to authors and inventors the exclusive right to their respective rights and discoveries;” Const. Art. 1, § 8, cl. 8.

⁷² Oren Bracha, *supra* note __ at 218 (citing Joseph Barnes, *Treatise on the Justice, Policy and Utility of Establishing an Effectual System for Promoting the Progress of Useful Arts by Assuring Property in the Products of Genius* 16 (Phila. 1792)). Bracha calls this the “patent-rights” model. *Id.* at 182. The man asserting the existence of patent rights in early America (as opposed to patent privileges) was Joseph Barnes, attorney to James Rumsey, who was fighting with John Fitch in the early 1790s over certain riverboat engine technology. As a right, rather than a privilege, Barnes simply had to prove that he was the “first and true inventor” of patentable subject matter and the patent would have to issue. Conception would be taken on faith as long he was the first to conceive the invention and as long as the invention described was within the parameters of patentable subject matter. Rumsey was originally

What is the patentable subject matter from which inventors have a right to exclude all others? The Supreme Court has famously said that “anything under the sun that is made by man” can be patented,⁷³ suggesting anyone may earn the privilege. However, the Patent Act requires that inventions be novel, useful, and non-obvious.⁷⁴ Despite attempts at clarity, defining these three categories remains almost as elusive as determining the moment of conception.

The requirement of novelty feeds the ideology of the patent inventor as investigating previously untraveled terrain—the brave and curious explorer. To prove novelty, the inventor must distinguish the invention from prior art, showing how the invention makes a new contribution to the field.⁷⁵ This requirement makes sense from a traditional patent policy perspective. “If patent applicants did not have to demonstrate that their inventions were previously unknown, they would . . . be able to withdraw information [, machines, and processes, etc.] from the public domain by securing patents on pre-existing devices and industrial processes, and the patent system would degenerate into a race to secure monopolies on existing technologies.”⁷⁶ This would frustrate the constitutional prerogative “to promote the progress of science and useful arts” by changing the incentive from innovation to acquisition.⁷⁷

Persuading a patent examiner or court that an invention is novel is not as technical as it may seem. Generally speaking, unless the prior art discloses *all* of the elements of the claimed invention (i.e., “anticipates” the invention), the invention is novel.⁷⁸ Indeed, novelty

backed by George Washington and Fitch by Benjamin Franklin (interestingly enough, both considered originary founders of the United States), neither of whom disputed the “first to invent” model of patent rights but instead were dueling about priority of invention. See Edward C. Walterscheid, Priority of Invention: How the U.S. Came to Have a ‘First-to-Invent’ System, 23 AIPLA Q. J. 263, 270-278 (1995).

⁷³ *Diamond v. Chakrabarty*, 447 U.S. 303 (1980).

⁷⁴ 35 U.S.C. §§ 101-103.

⁷⁵ 35 U.S.C. § 102(a).

⁷⁶ Robert Schechter, *Intellectual Property* 265 (2006).

⁷⁷ Const. Art. I, § 8, cl. 8.

⁷⁸ *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367 (Fed. Cir. 1986) (“[E]very element of claimed

determinations often devolve into questions of chronology: to defeat prior art references that might anticipate the claimed invention, the inventor must show that she conceived her invention before the date of the prior art.⁷⁹ Given the ethereality of conception, substantiating it requires a persuasive creation story describing in words, more often than proving through tangible evidence, how the inventor originated the invention from her own mind first. The novelty requirement thus values both the authenticity of actually being the first to invent as well as an innovator who is a persuasive storyteller, one with the talent and allure to seduce and conquer his audience.⁸⁰

Of the three requirements, non-obviousness has been called “the ultimate condition for patentability.”⁸¹ It is the newest of the three requirements but serves important policy functions that are said to underlie the patent system.⁸²

The requirement ensures that patent protection is not given to inventions that have no social benefit because they are of minimal advance over what has already been done and others would have developed the idea even without the incentive of a patent. Providing protection for obvious ideas is socially harmful because it can lead to a proliferation of economically insignificant patents that are expensive to search and to license.⁸³

Nonetheless, like the novelty requirement, nonobviousness has roots in the mythical aspects of

invention must be identically shown in a single reference.”). The disclosure must also be enabling to one skilled in the art, *Novo Nordisk Pharmaceuticals, Inc., v. Bio-Technology General Corp.*, 424 F.3d 1347 (Fed. Cir. 2005), the relevance of which I will discuss *infra*.

⁷⁹ Robert Schechter, *Intellectual Property* 266 (2006) (“Novelty is all about chronology.”)

⁸⁰ On the seduction of storytelling, see Ross Chambers: *Story and Situation: Narrative Seduction and the Power of Fiction* (1984). “[T]he further claim is now made that such [narrative] seduction, producing authority where there is no power, is a means of converting (historical) weakness into (discursive) strength.” *Id.* at 212. Certainly, most successful litigation requires persuasive and seductive story tellers. My assertion here is that the touchstone of patent protection (conception) depends on a good origin story above most else.

⁸¹ Nonobviousness—The Ultimate Condition of Patentability (John F. Witherspoon ed., 1980). One scholar calls it the “fundamental gatekeeper” to patenting. John R. Thomas, *Formalism at the Federal Circuit*, 52 *Am. U. L. R.* 771, 789 (2003). Utility may be the lowest hurdle of the three requirements and I do not discuss it here. “[T]he threshold of utility is not high . . . and relatively few patents are denied on utility grounds. Schechter, *supra* note ___ at 286, citing *Juicy Whip, Inc. v. Orange Bang, Inc.*, 185 F.3d 1364 (Fed. Cir. 1999).

⁸² The novelty requirement was not added to the Patent Act until 1952. See Christopher A Cotropia, *Nonobviousness and the Federal Circuit: An Empirical Analysis of Recent Case Law*, 82 *Notre D. L. Rev.* 911, 916 (2007).

invention and inventorship. Grasping the meaning of nonobviousness and its application in determining patentability inevitably requires contemplation of the quality of genius.

Although the standard for obviousness is whether the invention “would have been obvious at the time the invention was made to a person having ordinary skill in the art [(“PHOSITA”)],” the PHOSITA standard is neither ordinary nor common.⁸⁴ As John Duffy has recently chronicled, the nonobviousness standard has roots in the United States as far back as the first Patent Act of 1790 when the invention or discovery had to be “sufficiently . . . important.”⁸⁵ The 1793 Act amended this language, stating that “simply changing the form or proportion of any machine . . . in any degree, shall not be deemed a discovery.”⁸⁶ Merely changing form or proportion is not a “sufficiently . . . important” invention to garner a monopoly.⁸⁷ Instead, a change “in principle” is required, and no such change will have occurred if it was “obvious . . . to any mechanic.”⁸⁸ This became the *Hotchkiss* standard, in 1851, which required for patentability a showing of more “ingenuity or skill . . . than . . . possessed by an ordinary mechanic acquainted with the business.”⁸⁹ Here are signs of that mythic mad scientist as a “heroic figure.”⁹⁰ As Corynne McSherry has written, this is not anachronistic, but very much part of our national story. “By the late seventeenth century, . . . inventors were being represented as heroic figures who wrestled with material nature to dislodge its secrets, and legal theorists were suggesting that

⁸³ Id.

⁸⁴ 35 U.S.C. § 103(a).

⁸⁵ John Duffy, *Inventing Invention: A Case Study of Legal Innovation*, 28, Working Paper available at <http://www.utexas.edu/law/conferences/ip/DuffyPaper.pdf>.

⁸⁶ Act of Feb. 21, 1793, § 2, 1 Stat. 318, 321.

⁸⁷ John Duffy, *Inventing Invention: A Case Study of Legal Innovation*, 28, Working Paper available at <http://www.utexas.edu/law/conferences/ip/DuffyPaper.pdf>.

⁸⁸ *Hovey v. Stevens*, 12 F. Cas. 609, 612 (C.C.D. Mass. 1846).

⁸⁹ *Hotchkiss v. Greenwood*, 52 U.S. 248, 267 (1851).

⁹⁰ McSherry, *supra* note __ at 43.

patents could be claimed as the natural rights of genius.”⁹¹

Compare the description of the inventor whose invention is worthy of a patent monopoly with that of the mechanic. The inventor has “ingenuity,” the mechanic only “ordinary” skill.⁹² The inventor possesses “genius,”⁹³ even “a flash of creative genius,”⁹⁴ whereas the mechanic is a “mere artisan.”⁹⁵ To be sure, the 1952 Patent Act ratcheted down this high standard of patentability, requiring only that the difference between the new subject matter and the prior art not be “obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”⁹⁶ But the application of this standard has been fraught with difficulty. The Supreme Court requires that courts determine the level of ordinary skill in the pertinent art, but does not say how.⁹⁷ This leaves the lower courts, and in particular the Federal Circuit, to define this “mysterious personage.”⁹⁸

For thirty years, the Supreme Court stayed out of the debate. In 2007, however, it decided *KSR Intern. Co. v. Teleflex*⁹⁹ to address the criticism that becoming an inventor was too easy (i.e., the obviousness threshold was too low). In other words, the critics believed the PTO and

⁹¹ Id. (quotations and citations omitted). Mario Biagioli argues persuasively that the United States patent system with its novel and non-obviousness requirements (as represented in the patent specification) are part and parcel of the developing political constitution of the new nation. Mario Biagioli, [Patent Republic: Specifying Inventions, Constructing Authors and Rights](#) 73 *Social Research* 1129, 1140 (2006) (“That specifications were absent in the colonial period, but began to emerge after the Declaration of Independence to become eventually codified in the first US Patent Act supports a correlation between political representation and patent representations.”).

⁹² *Hotchkiss*, 52 U.S. at 267.

⁹³ *Reckendorfer v. Faber*, 92 U.S. 347, 357 (1876) (“inventive genius”).

⁹⁴ *Cuno Engineering Corp v. Automatic Devices Corp.*, 314 U.S. 84 (1941).

⁹⁵ *Standard Electrical Works v. Manhattan Electrical*, 212 F. 944, 945 (1914).

⁹⁶ 35 U.S.C. § 103(a).

⁹⁷ *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966).

⁹⁸ Joseph P. Meara, *Just Who is This Person Having Ordinary Skill in the Art? Patent Law’s Mysterious Personage*, 77 *Wash. L. Rev.* 267 (2002). See also Duffy, *supra* note __ at 42 (“it would have been better if the Court had tried to articulate a much greater detail the circumstances under which the obviousness doctrine was important for barring patents on novel developments); Meara, *supra* note __ at 286 (“Current Federal Circuit methodology for determining the level of ordinary skill in the art does not advance the nonobviousness inquiry.”); Cotropia, *supra* note __ at 918 (describing recent criticism of the Federal Circuit’s nonobviousness jurisprudence).

⁹⁹ *KSR Intern. Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007).

the Federal Circuit erred too often on the side of ordinary rather than innovative.¹⁰⁰ The Supreme Court agreed, ratcheting up the nonobviousness standard and attempting to clarify the distinction between an obvious mechanical change and an innovative creation or development over the prior art.

When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under §103.¹⁰¹

With *KSR*, the Supreme Court has affirmed the myth of the genius scientist who illuminates discoveries with the light bulb over the head, returning us to where we started: distinguishing the ordinary, predictable, and the common sense from the stuff of patents, “real innovation,” and extraordinary creativity.¹⁰²

Who is this “first and true” inventor whose new and useful creation comes not of nature but of his mind and is non-obvious to the ordinary person skilled in the particular art at issue? Consider that this special person did not merely discover some law of nature or product of nature, however new or useful to human society.¹⁰³ The inventor is a creator. Secondary considerations—indicia of nonobviousness, such as the prior failure of others skilled in the art to solve the same technical problem or unexpected results that show the invention is counterintuitive in some way—further distinguish the invention and its creator from all the others

¹⁰⁰ *Cotropia*, supra note __ at 913 (discussing two reports that claim that the Federal Circuit has improperly relaxed the nonobviousness requirement). The criticism was mainly directed at the teaching, suggestion or motivation test, which is one part of the obviousness inquiry.

¹⁰¹ *KSR Intern. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1742 (2007).

¹⁰² *Id.* at 1741 (“Granting patent protection to advances that would occur in the ordinary course without real innovation retards progress and may, in the case of patents combining previously known elements, deprive prior inventions of their value or utility.”)

¹⁰³ *Chakrabarty*, 447 U.S. 303 (1980) (“a new mineral discovered on the earth, or a new plant found in the wild is not patentable subject matter.”).

(mechanics?) as someone special, unordinary.¹⁰⁴ In this way, patent law describes a person and a community, his nature and its values.

As inventors became owners they also became guarantors for several foundational dualisms: monopoly/freedom, creator/work, and . . . public/private. . . [P]atent law . . . assum[es] and invok[es] an autonomous liberal subject, in the personal of the heroic . . . inventor, which a property claim to the product of his or her inventive effort.¹⁰⁵

If this sounds like the individual citizen at the heart of John Locke's theory of civilization¹⁰⁶ or Thomas Hobbes' theory of government and sovereignty,¹⁰⁷ then the origin myth of patent law (and its heuristic function for describing the American individual and her nation) has emerged clearly. Indeed, one scholar has recently argued that the development in the United States of the persona of the inventor as genius directly parallels the birth of republican government in the United States, and, to a lesser extent in France.¹⁰⁸

The patent law origin story, therefore, explains how and why we grant certain people and not others this special and valuable monopoly. It justifies the distinction between the haves and the have-nots with allusion to differences between people, those who are ordinary, mere artisans

¹⁰⁴ *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17 (1966)(listing secondary considerations that indicate nonobviousness).. *Allen Archery, Inc. v. Browning Mfg. Co.*, 819 F.2d 1087, 1092 (Fed. Cir. 1987) (same)..

¹⁰⁵ McSherry, *supra* note __ at 45.

¹⁰⁶ Grossly simplified, John Locke theorized the origin of property on the right to own the product of one's own labor. For recent discussions on John Locke and the United States intellectual property regime, see, e.g., Robert Merges *Locke Remixed* ;-), 40 U.C. Davis L.R. 1259, 1265 (2006) and Adam Mossoff, *Who Cares What Thomas Jefferson Thought about Patents? Reevaluating the Patent "Privilege" in Historical Context*, 92 *Cornell L. Rev.* 953, 971-72 (2007).

¹⁰⁷ For Hobbes, state power and control (e.g., its regulation of property) was a prerequisite to civil stability. See, e.g., Helen Stacy, *Relational Sovereignty*, 55 *Stan. L. R.* 2029, 2032-33 (2003) (citing to Thomas Hobbes, *Leviathan* 186 (C.B. MacPherson, ed. 1968) (1671)).

¹⁰⁸ Mario Biagioli, [Patent Republic: Specifying Inventions, Constructing Authors and Rights](#), 73 *Social Research* 1129, 1142, 1147 (2006). [The irony is rich here. Whereas the birth of the American inventor might arise from contemporary political developments valuing representation and transparency \("disclosure" in patent terms\) in a government promising a role or place for everyman, this American inventor is defined by that which distinguishes him from everyone else. Indeed, just as voting rights were severely curtailed in the early republic by race and property despite the move to representative democracy, the inventor-identity as American citizen was a right reserved for only those could represent themselves in the polity \(or through the patent specification\) as unique. Id. at 1140-1142, 1147.](#)

and those who are not.¹⁰⁹ The patent law protects the creative output of the uncommon or remarkable person.¹¹⁰ Moreover, invocation of conception and description of this “first and true” inventor as memorialized in the patent itself (the oath of inventorship, a contract between relevant parties¹¹¹) substantiates present circumstances of rights and entitlements (e.g., a right to exclude and a royalty stream under the patent) with an appeal to the past and mythical beginnings.

B. *Patent Stories*

Consider how the following recent inventorship dispute mobilizes the origin myth of patents described above.¹¹² The patent at issue arose out of a joint collaboration between Massachusetts General Hospital (MGH), Massachusetts Eye and Ear Infirmary (MEEI) and a small biotech firm in Vancouver named QLT.¹¹³ The drug developed, called Visudyne, is the first of its kind to treat age-related macular degeneration, which is the leading cause of blindness in people over the age of 50.¹¹⁴ Once the FDA approved the drug for medical use, it has been a

¹⁰⁹ “Th[e] identification of conception as the heart of invention links the discourse of inventorship . . . to the idealized individual originary genius. . . . Invention . . . is the province of heroic individuals who are able to observe the works of nature and man and recombine those works to the nonobvious, novel, and useful effect.” McSherry, *supra* note __ at 179.

¹¹⁰ Who are examples of remarkable people that supported the “first to invent” system? George Washington, Benjamin Franklin and Thomas Jefferson, the first (the story goes) to battle behind the scenes in the first priority contest for a patented invention. Waltersheid, *supra* note __ at 270. See also Adam B. Jaffe & Josh Lerner, *Innovation and Its Discontents* (2004). “Perhaps the most compelling explanation for this decision lies in historical accident: at the time the Patent Act of 1793 was enacted, two dueling inventors, James Rumsey and John Fitch, were locked in a battle over the ownership of riverboat engine technology. Each had made several patent applications, but the orders of application and invention differed. So the particular design of the patent system would have an enormous influence on their individual fortunes. Not surprisingly, the men and their financial backers, who had included both George Washington and Benjamin Franklin exerted heavy influence to try to shape the system for their benefits.” *Id.* at 163.

¹¹¹ See Mario Biagioli, *supra* note __ at 1131-32 (describing the “patent bargain” as one between the inventor and his fellow citizens).

¹¹² Although I was part of a large team representing QLT during the early phases of this litigation (which lasted over eight years), everything I say about this case is based on public record. Nothing contained herein should be construed to be the view of any of the parties or attorneys in the case.

¹¹³ *Massachusetts Eye and Ear Infirmary v. QLT Phototherapeutics, Inc.*, 412 F.3d 215, 221-22 (1st Cir. 2005).

¹¹⁴ *Id.* at 221.

multi-million dollar product, turning the small Canadian biotech company into a very profitable one.¹¹⁵ One reason the drug is so special is its unique delivery system. The drug is photosensitive and is activated by light.¹¹⁶ It is administered intravenously and travels throughout a patient's body, but it treats only the very delicate eye blood vessels upon directing a very precise, nonthermal laser beam into the eye.¹¹⁷

The dispute concerned the division of the profits from the drug.¹¹⁸ The inventors had assigned their rights to their respective institutions. And as joint-owners, each institution could separately make, use, or sell the invention without accounting to the other owners.¹¹⁹ QLT sought exclusive rights in the patent, however, and so it negotiated with both MGH and MEEI for a transfer of their exclusive rights in exchange for a royalty on the sale of the drug, which QLT was prepared to market world-wide.¹²⁰ QLT reached a license agreement with MGH, but MEEI wanted a larger royalty than MGH agreed to.¹²¹ When QLT and MEEI could not reach an agreement on a royalty term,¹²² QLT, with equal patent rights to that of MEEI, began selling the drug and paying royalties to MGH under their license, but paid nothing to MEEI.

MEEI sued, angry that it received none of the invention's royalties. One of its claims was that QLT's scientist, Julia Levy, was not a real inventor of the invention described by the

¹¹⁵ Id. at 223. See also *Massachusetts Eye and Ear Infirmary v. QLT, Inc.*, C.A. No. 00-10783-WGY (Memorandum and Order, July 10, 2007) at 64 (on file with author).

¹¹⁶ *Massachusetts Eye and Ear Infirmary v. Novartis Ophthalmics, Inc. and QLT, Inc.*, 353 F.Supp. 2d, 170, 171-172 (D. Mass. 2005).

¹¹⁷ Id.

¹¹⁸ 412 F.3d at 229-232, 233-34.

¹¹⁹ 35 U.S.C. § 262.

¹²⁰ 412 F.3d at 224.

¹²¹ *Massachusetts Eye and Ear Infirmary v. QLT, Inc.*, C.A. No. 00-10783-WGY (Memorandum and Order, July 10, 2007) at 46 (on file with author)

¹²² *Massachusetts Eye and Ear Infirmary v. QLT, Inc.*, C.A. No. 00-10783-WGY (Memorandum and Order, July 10, 2007) at 46 (on file with author)

patent.¹²³ Removing Levy from the patent would return the control of the invention and its profits to MEEI and MGH.

Throughout the litigation, the parties wrestled with the above-mentioned mystical underpinnings of inventorship law. In particular, what does “conception” mean: who is the “first and true” inventor of Visudyne? QLT would need to tell a convincing story about how Julia Levy conceived of the invention, and why she deserved to be named on the patent. After all, a well-regarded Harvard-affiliated teaching hospital sued QLT, a Canadian pharmaceutical company, in Boston. While Levy may have begun the research on photosynthetic delivery of the drug, MEEI would say that its clinical studies transformed the idea of the photosensitive drug into a reality, by determining the drug’s effective dosage. Its work cured the disease.¹²⁴

If MEEI has a persuasive argument, it lies in the changing world of collaborative research that the 1984 amendments to the Patent Act were meant to address.¹²⁵ The 1984 amendments “remedied the increasing technical problems arising in team research, for which existing law, deemed to require simultaneous conception as well as shared contribution by each inventor to every claim, was producing pitfalls for patentees, . . . [T]he amendment recognizes the realities of modern team research.”¹²⁶ In a world of collaborative research that spans the globe, where scientists in Bologna and Boston can jointly contribute to an invention claimed in a patent without working together in the same laboratory, the notion of inventor is changing. Inventors under the law are not the mad scientists of myth. As the 1984 amendments recognized, inventors of the 20th and 21st century exist in teams and inventions are made over the course of

¹²³ 353 F. Supp. 2d at 172. See also *Massachusetts Eye and Ear Infirmary v. QLT, Inc.*, C.A. No. 00-10783-WGY (Memorandum and Order, July 10, 2007) at 39-40 (on file with author).

¹²⁴ *Massachusetts Eye and Ear Infirmary v. QLT, Inc.*, C.A. No. 00-10783-WGY (Memorandum and Order, July 10, 2007) at 28-30 (on file with author).

¹²⁵ *United States Surgical Steel v. Ethicon*, 135 F.3d at 1470-71.

years and not in the poof of a moment.

In support of its equitable argument, MEEI relied on Judge Newman’s dissent in *United States Surgical Steel v. Ethicon*, in which Newman relying on the history behind the 1984 Amendments, berates the majority for reading sections 116 and 262 of the Patent Act¹²⁷ together to mean that even if someone contributed only a single claim to a patent that person was nonetheless an inventor of the entire invention who could make, use, or sell the invention without accounting to the other owners.¹²⁸ Newman complained that prior to the 1984 amendments only “a person who had fully shared in the creation of the invention [as a whole] was deemed to be a joint owner of the entire patent property . . . on a legal theory of tenancy in common.”¹²⁹ Drawing on the history of patent ownership prior to 1984, Newman explained that “the law had never given a contributor to a minor portion of an invention a full share in the originator’s patent.”¹³⁰ Newman argued that courts are mistakenly applying section 262 of the Patent Act “to treat all persons, however minor their contribution, as full owners of the entire property as a matter of law.”¹³¹

In light of MEEI’s arguments, QLT would have to tell a persuasive story about how Julia Levy was an inventor who had fully shared in the creation of the invention, how she was the “first and true” inventor. It would be an origin story, with homage to authenticity and reliance on evidence of consent, that would legitimate her claim to the patent and justify the apparent inequities in the division of the royalties in the way that myths do. This was QLT’s story.¹³²

¹²⁶ 135 F.3d at 1469-7

¹²⁷ 35 U.S.C. § 116 (joint ownership); 35 U.S.C. § 262 (joint inventorship). .

¹²⁸ 135 F.3d at 1469-70.

¹²⁹ Id.

¹³⁰ Id. at 1471.

¹³¹ Id.

¹³² The below story comes from Julia Levy’s testimony at trial as recounted in the District Court’s opinion, *Massachusetts Eye and Ear Infirmary v. QLT, Inc.*, C.A. No. 00-10783-WGY (Memorandum and Order, July 10,

When Julia and her husband were raising their young children, they had a cottage on a remote island off the coast of Vancouver. There her children often played in fields that were covered with cow parsley, a low-growing ground cover. She noticed that after playing in the fields, her children's skin was more susceptible to sunburn. She spoke with a botanist friend and learned that cow parsley has photodynamic qualities—it exudes an oil that absorbs sunlight. Fascinated with this chemical process as a biochemist, she wondered if the process could enrich her biomedical research. When her mother developed macular degeneration and no cure was available, in part because targeting and treating the delicate blood vessels behind the eye is so difficult, Julia began developing a drug bearing photosynthetic qualities (i.e., one activated by light like the precise point of a laser). She conceived of a biochemical structure that would bind especially well to the small blood vessels of the eye such that when a doctor shined a non-thermal laser through the eye, the drug bearing photosynthetic qualities would operate only on those vessels and nowhere else in the body. Visudyne originated, QLT argued, in the cow parsley patches of Julia Levy's summer cottage and was fully conceived in the mind of the biochemist as she searched for a drug to cure her mother's illness. Her collaboration with MEEI came much, much later.

This is a good origin story. Despite the fact that the law of inventorship supported QLT, this story alone explained and justified Julia's inclusion on the patent as an inventor. It had all the qualities of an origin myth.

Levy's inventor status is rooted in authenticity, essential truths buried in the beginning of the idea of Visudyne. Julia is the person who originated the idea of photodynamic therapy to

2007) at 22-23 and passim (on file with author) and Massachusetts Eye and Ear Infirmary v. QLT, Inc., C.A. No. 00-10783-WGY, Trial Tr. Day 12, pp. 1584-1587 (on file with author). See also Robert Baun, QLT's Biotech Success Story Emerged from Humble Roots, AllBusiness.com, Oct. 1, 2004 available at <http://www.allbusiness.com/north->

treat AMD, and thus she garners the authority and legitimacy necessary for law's protection. The beginning of Visudyne lay with her in her summer retreat and her relationship to her mother.

This origin story is also political in nature, justifying a particular hierarchy of people and outcomes. It is not a "noble lie"¹³³ as it is based entirely on fact if one is to believe Julia Levy, and there is no reason not to.¹³⁴ But it nonetheless refutes the perceived inequities in claiming Levy as an inventor on the same patent at MGH and MEEI scientists. After all, according to the patent, Levy contributed to only two claims on a patent that had more than a dozen claims.¹³⁵ And MGH and MEEI's clinical work, or so they claimed, over the course of many years honed the administration of the drug so that it could treat people.¹³⁶ Nonetheless, Levy conceived of the drug's chemical structure and provided the compound with which MEEI clinicians experimented.¹³⁷ She was the mind controlling the body, the brain to MEEI's brawn. MEEI's complaints of unfairness and disadvantage rely on incredible assertions of vulnerability (the small, nonprofit teaching hospital up against a big pharmaceutical company), which sound in emotion rather than fact.¹³⁸ Levy's story of her inspired moment—the story of the formation in her mind of a definite and permanent idea of the invention—resonates with her high status (her gold, rational status) as an inventor.

This origin story relies not only on authenticity in conception to naturalize certain wealth

[america/united-states-colorado/903845-1.html](http://www.allbusiness.com/north-america/united-states-colorado/903845-1.html).

¹³³ Wright, *supra* note ___ at 5.

¹³⁴ Recall that conception of an invention begins as a matter of faith. See *supra* note ___.

¹³⁵ See *Massachusetts Eye and Ear Infirmary*, 353 F. Supp. 2d 170, 172, 176 (D. Mass. 2005) (citing to U.S. Patent Nos. 5,798,349 and 6,225,303, the patents in dispute).

¹³⁶ *Massachusetts Eye and Ear Infirmary v. QLT, Inc.*, C.A. No. 00-10783-WGY (Memorandum and Order, July 10, 2007) at 28-30 (on file with author).

¹³⁷ 353 F. Supp.2d. at 172-173.

¹³⁸ MEEI is a very successful and well-respected hospital affiliated with Harvard University. And at the time that Visudyne was invented, QLT had yet to turn a profit. See Robert Baun, *QLT's Biotech Success Story Emerged from Humble Roots*, AllBusiness.com, Oct. 1, 2004 available at <http://www.allbusiness.com/north-america/united-states-colorado/903845-1.html> (stating that QLT became profitable only in 2000 upon the launch of Visudyne in the United

and power relations, but also a narrative of consent. MEEI cannot complain that QLT and its founding scientist took power unfairly (notoriety and riches backed by the force of a legal document, the patent), because MEEI signed a declaration of inventorship attesting under oath to the correctness of inventors listed on the patent, which included Julia Levy.¹³⁹ The status hierarchies or different financial positions in which the institutions and inventors eventually found themselves was a direct result of the agreed-to relations between the parties.¹⁴⁰ That MEEI and QLT failed to reach an agreement later as to a license has nothing to do with inventorship. Like the social contract, the parties agreed to this property arrangement and should be loathe to protesting now, years later, when they cannot reach a licensing deal.

MEEI has a response: it only consented to the patent filing because QLT promised it a better situation in return.¹⁴¹ In other words, its consent was quid pro quo for a reasonable royalty, which QLT failed to offer. Here, we see the origin myth as a reflection of a perennial social and cultural preoccupation: equality. QLT's story of the beginning, when a patent was discussed, describes scientists who were all equally situated in relation to the invention. All were on the patent and all contributed to at least one of its claims. But MEEI deconstructs this origin myth claiming that the story QLT tells entrenches its status as originator with the permanence of nature.¹⁴² MEEI says, in the beginning, hierarchies existed, not equality. MEEI is a nonprofit teaching hospital; QLT is a big pharmaceutical company. QLT always had the upper hand and used that power to get its jointly-invented patent and prevent MEEI from reaping its fair share of the profits. This is Hannah Arendt's theory of origin stories: they ignore the violence of

States).

¹³⁹ See supra notes 59-62.

¹⁴⁰ 412 F.3d. at 224.

¹⁴¹ 412 F.3d. at 224, 234.

¹⁴² "Contingent political arrangements that are the result of accident and dissension are invested with truth and

beginnings.¹⁴³ That was MEEI's theory of the case.

Although a twenty-first century battle over a path-breaking drug, the stories QLT and MEEI told were about inventors and power, laborers and disparate wealth, and they resonate with the stuff of legends. They rehearse the origin myth of patents, the difference between the genius and the mechanic, the person who is first and true and those that merely implement previous orders, all to justify the intellectual property arrangement at the center of the dispute.¹⁴⁴

III. COPYRIGHT LAW

A. *Copyright Origins*

Of all three statutory intellectual property regimes, copyright may be most obviously structured around an origin myth, because original creation is the touchstone of copyright protection. The Copyright Act provides copyright protection for “original works of authorship fixed in any tangible medium of expression.”¹⁴⁵ Key to this protection is defining “originality” and “work of authorship” and understanding what these terms exclude.

1. As a Measure of Authenticity to Legitimate Hierarchy

Much like the inventor of a patent, an author of a copyrightable work has been variously described as a “creative genius”¹⁴⁶ taken hold by a “creative spark.”¹⁴⁷ Authors reap the “creative

essence in origin myths.” Wright, *supra* note __ at 10.

¹⁴³ HANNAH ARENDT, *ON REVOLUTION* 11 (1963).

¹⁴⁴ The dispute between QLT and MEEI continues today. United States District Court Judge William Young issued a Memorandum and Order on July 10, 2007 affirming a jury verdict in favor of MEEI on the basis of two state law claims (unjust enrichment and unfair business practices). Significant to the above-described origin story, the status of the patent's inventorship remains stable and uncontested. See *Massachusetts Eye and Ear Infirmary v. QLT, Inc.*, C.A. No. 00-10783-WGY (Memorandum and Order, July 10, 2007).

¹⁴⁵ 17 U.S.C. § 102(a).

¹⁴⁶ *United States v. Paramount Pictures, Inc.*, 334 U.S. 131, 158, 68 S.Ct. 915, 92 L.Ed. 1260 (1948). See also *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884) (“Nor is it supposed that the framers of the constitution did not understand the nature of copyright and the objects to which it was commonly applied, for copyright, as the exclusive right of a man to the production of his own genius or intellect.”).

¹⁴⁷ *Feist Publ'ns, Inc. v. Rural Tel. Serv., Co.* 499 U.S. 340, 345 (1991).

powers of the[ir] mind”¹⁴⁸ using their “fancy,”¹⁴⁹ “imagination,”¹⁵⁰ and “intellect.”¹⁵¹ Although many people have written that the first copyright acts benefited booksellers and not writers, the cult of the Romantic author (much like that of the hero-inventor) runs deep in the statutory history and cases of U.S. copyright law.¹⁵²

An author, although left undefined by the Copyright Act, straddles the domains of the human and divine. As a model of human ingenuity, the author “wr[ites] a ‘self’”¹⁵³ possessing the unique qualities of an individual, owning his words and thus owning himself.¹⁵⁴ He is nonetheless divinely inspired. The author as a concept began with the author as a vessel for independent, God-like forces.¹⁵⁵ Indeed, the metaphor of the author as divinely gifted is an active metaphor in copyright case law and its statutory history.¹⁵⁶ Roberta Kwall has traced this parallel between authorship and God calling it a “mirroring argument,” comparing the first Creation narrative in Genesis to the wonders of artistic creation: “man’s capacity for artistic creation mirrors or imitates God’s creative capacity.”¹⁵⁷

¹⁴⁸ *In re Trade-Mark Cases*, 100 U.S. 82, 94 (1879).

¹⁴⁹ *Id.*

¹⁵⁰ *Id.*

¹⁵¹ *Bobbs-Merrill Co. v. Straus*, 210 U.S. 339, 347 (1908).

¹⁵² Martha Woodmansee, *The Genius and the Copyright: Economic and Legal Conditions of the Emergence of the “Author,”* 17 *Eighteenth-Century Stud.* 425-448 (1984) (linking copyright to the Romantic construct of authorship)[hereinafter *Genius and Copyright*]. See also Martha Woodmansee, *On the Author Effect: Recovering Collectivity*, in *THE CONSTRUCTION OF AUTHORSHIP: TEXTUAL APPROPRIATION IN LAW AND LITERATURE* 15, 28 (Martha Woodmansee & Peter Jaszi eds., 1994); Peter Jaszi, *Contemporary Copyright and Collective Creativity*, in *THE CONSTRUCTION OF AUTHORSHIP: TEXTUAL APPROPRIATION IN LAW AND LITERATURE* 29 (Martha Woodmansee & Peter Jaszi eds., 1994); MARK ROSE, *AUTHORS AND OWNERS: THE INVENTION OF COPYRIGHT* (1993).

¹⁵³ C. DAVIDSON, *REVOLUTION AND THE WORD: THE RISE OF THE NOVEL IN AMERICA* 52 (1986) (discussing John Locke’s theory of property that “saw every mind as a blank page upon which experience wrote a ‘self’”).

¹⁵⁴ Peter Jaszi, *Toward a Theory of Copyright: The Metamorphosis of ‘Authorship,’* 1991 *Duke L. J.* 455, 47-0-471 (describing the rise of the concept of authorship as part of the 18th century theory of “possessive individualism”)[hereinafter *The Metamorphosis*].

¹⁵⁵ *Genius and Copyright*, supra note __ at 426.

¹⁵⁶ Mark Rose, *Copyright and Its Metaphors*, 50 *UCLA L. Rev.* 1, 11 (2002) (noting that the “creative spark . . . if unpacked could be shown to carry a numinous aura evocative ultimately of the original divine act of creation itself.”).

¹⁵⁷ Roberta Kwall, *Inspiration and Innovation: The Intrinsic Dimension of the Artistic Soul*, 81 *Notre D. L. Rev.* 1945, 1952 (2006).

The coexistence of these dual qualities in the author, the human and the divine, functions as an ideology of uniqueness to underwrite the authority that authorship garners. An author is the creator of an original work, but “original” does not necessarily mean novel; it means only independently created by the author himself.¹⁵⁸ The work must literally have originated from him and not from anyone else. As the Supreme Court said in one of the more famous copyright cases, an author is “in that sense . . . he to whom anything owes its origin; originator; maker; one who completes a work of science or literature.”¹⁵⁹ This turns out to be a very low threshold for originality—only the merely “trivial” contributions are excluded from copyright protection¹⁶⁰—and yet it seems to embed within it the ideological notion of the uniqueness of each individual. Each person has something to contribute that is “recognizably his own.”¹⁶¹ This is a common American narrative: the rugged individuality of each person contributing to the nation’s economic, social, and political successes.¹⁶²

Consider that copyright law will protect two identical poems under separate copyright as long as each work originates with a separate individual, allowing for the theoretical possibility that the exact same expression can arise from two different authors.¹⁶³ This is only a theoretical possibility, of course,¹⁶⁴ because the cult of the author, like the myth about snowflakes, assumes that no two people will create the exact same work because no two authors are exactly alike.¹⁶⁵ “Personality always contains something unique. It expresses its singularity even in handwriting,

¹⁵⁸ *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 490 (1976).

¹⁵⁹ *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58, (1884).

¹⁶⁰ Feist, 499 U.S. at 359.

¹⁶¹ *L. Batlin & Son*, 536 F.2d at 490.

¹⁶² Herbert Hoover, Rugged Individualism Speech, *supra* note ___.

¹⁶³ Feist, 499 U.S. at 346.

¹⁶⁴ Robert Schechter, *supra* note __ at 168 (“Such situations [of parallel independent creation] rarely come up in the real world, because it is highly unlikely two authors will create identical works of any complexity.”)

¹⁶⁵ Alan L Durham, *The Random Muse: Authorship and Indeterminacy*, 44 *Wm. & Mary L. Rev.* 569, 629 (2002) (“every author who does not slavishly copy from another source is likely to introduce something unique”).

and a very modest grade of art has in it something irreducible, which is one man's alone."¹⁶⁶ The origin myth of copyright begins with this heuristic about human nature: the belief in the singular essence of each person (whether from God or nature), which then develops into the right of ownership that each of us has, or should have, over that which is uniquely our own.

Authorship is expressly linked to authority, the authority and control each author has or should have over that which originates from him or herself.¹⁶⁷ This is not necessarily because of the premium placed on owning oneself but because of the value placed on authenticity. An original work of authorship is inauthentic (lacks originality) if it is copied from somewhere else. Independent creation thus justifies authority over the work.¹⁶⁸ A copy is the antithesis of the authentic work and lies at the core of the infringement right of action.¹⁶⁹

2. Establishing Consent (to Legitimate Power and Property Relations)

Originating an expression is not the only means to legitimate the power of exclusion through copyright. Joint-authorship and works-for-hire create a situation where originating an expression is not enough. Indeed, in the latter case it does not matter.¹⁷⁰ What is of consequence is that the parties agree regarding the status and ownership of the finished product. In the case of co-authored works, the individual asserting joint-authorship must establish that each of the co-

¹⁶⁶ *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 250 (1903). See also, *Feist*, 499 U.S. at 350 (“[C]opyright is limited to those aspects of the work . . . that display the stamp of the author’s originality.”)(quoting *Harper & Row v. Nation Enters.*, 471 U.S. 539, 547 (1985)).

¹⁶⁷ To be sure, this is circular reasoning, but it is nonetheless an on-going justification for copyright protection. “In a feat of circular reasoning, the radically autonomous individual author-genius was confirmed by the work’s uniqueness, while the uniqueness of the work was confirmed by the individuality of the author.” McSherry, *supra* note __ at 40.

¹⁶⁸ *Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 490 (2d Cir. 1976) (“originality is ... distinguished from novelty; there must be independent creation, but it need not be invention in the sense of striking uniqueness, ingeniousness, or novelty ...”).

¹⁶⁹ *Id.* at 490, citing *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102-03 (2d Cir. 1951).

¹⁷⁰ 17 U.S.C. § 101(1) (employee can originate the work but as long as made within scope of employment, work belongs to the employer).

authors made independent copyrightable contributions to the work *and* that they each fully intended to be co-authors.¹⁷¹ This standard, unexamined by the Supreme Court but widely-embraced throughout the circuits,¹⁷² “creates a great deal of mischief, for it allows one collaborator—the dominant party—to lure others into contributing material to a unitary work, all the while withholding the intent to share in its economic and reputational benefits.”¹⁷³ The standard’s requirement for consent is exacting, demands certainty, and disregards the amount or quality of the putative co-author’s creative contribution to the original work.¹⁷⁴ As explained more fully below, consent is not easily given by authors (or found by courts).¹⁷⁵ Consent must originate from he who had the authority or control over the initial creative arrangements. He is the genius as between contenders and only by his grace may others participate. Without his consent, they cannot.¹⁷⁶

Works-for-hire wreak a similar injustice that can be explained away with homage to consent, a central feature of political origin myths. When an employee originates a copyrightable work of authorship, the work belongs to the employer.¹⁷⁷ As long as an employee produced the work within his scope of employment, he has impliedly consented to transfer authorship (and

¹⁷¹ Thomson v. Larson, 147 F.3d 195, 200 (2d Cir. 1998). The language of intent, which goes to consent, is in the statute, 17 U.S.C. § 101, although there is a difference between the language of the statute and the language in Larson. Compare 17 U.S.C. § 101 (“a work prepared by two more authors with the intention that their contributions be merged into inseparable or interdependent parts of a whole”) with Larson, 147 F.3d at 201 (“all participants fully intend to be joint authors”).

¹⁷² Brown v. Flowers, 196 Fed. Appx. 178, 186 (4th Cir. 2006); Aalmuhammed v. Lee, 202 F.3d 1227 (9th Cir. 2000); Erickson v. Trinity Theater, Inc., 13 F.3d 1061, 1068 (7th Cir. 1994); BTE v. Bonneze, 43 F. Supp. 2d 619, 622 (E.D. La. 1999); Papa’s-June Music, Inc. v. McLean, 921 F. Supp. 1154, 1157 (S.D. N.Y. 1996); Cabrera v. Teatro Del Sesenta, Inc., 914 F. Supp. 743, 764 (D.P.R. 1995). See also Goldstein, *supra* note __ at § 4.2.1.2.

¹⁷³ Rochelle Cooper Dreyfuss, Collaborate Research Conflicts on Authorship, Ownership, and Accountability, 53 Vand. L. Rev. 1161, 1206 (2000).

¹⁷⁴ Aalmuhammed v. Lee, 202 F.3d 1227, 1235 (9th Cir. 2000). See generally Peter Jaszi, On the Author Effect: Contemporary Copyright and Collective Creativity, 10 Card. Arts & Enter. L. J. 293, 314-16 (1992)(criticizing the doctrine of joint authorship and its reliance on an individualistic notion of authorship).

¹⁷⁵ See *infra* III.A.3.

¹⁷⁶ I am grateful to Rebecca Tushnet for the phrasing behind this idea and its placement at this point in the argument.

¹⁷⁷ 17 U.S.C. § 101(1).

therefore ownership) of it to the employer.¹⁷⁸ An employee, or independent contractor, can also explicitly consent to sign away his authorship status through contract.¹⁷⁹ These provisions of the Copyright Act are justified by relying on several of copyright's founding goals: encouraging and efficiently disseminating creative output.¹⁸⁰ "The work for hire doctrine is . . . best understood as a way to put decisions on disseminating, revising, or building on works in the hands of the entity that will maximize creative value."¹⁸¹ But these provisions make certain assumptions about the employer-employee relationship that may frustrate these and other goals of copyright. In particular, employees or potential employees may not have any meaningful control over the scope of their employment nor may frank discussion of authorship occur regularly and honestly..¹⁸² Likewise, when a work-for-hire requires a contract, often times "parties have other relationships with one another that turn the signature into an inadequate bargaining tool."¹⁸³

3. As a Heuristic of an Individual and a Nation

Respect for the ideal act of consent that originates the collaborative and creative project smoothes the wrinkles from these doctrines. As already mentioned, consent is a central

¹⁷⁸ Id. See also *Community for Creative Non-Violence v. Reid*, 490 U.S. 730 (1989) (ascertaining the scope of employment through agency law).

¹⁷⁹ A work-for-hire can also be created explicitly through contract and it falls into a specific category designated by the statute. 17 U.S.C. § 101(2).

¹⁸⁰ See *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 558 (1985) ("By establishing a marketable right to the use of one's expression, copyright supplies the economic incentive to create and disseminate ideas."). Cf. *Jessica Litman, Copyright Myth*, 53 U. Pitt. L. Rev. 235, 242 (1991) (comparing the prevailing public myth of copyright with its articulated basis in the law).

¹⁸¹ Rochelle Cooper Dreyfuss, *supra* note __ at 1202. See also *id.* ("In this way, all exploitation decisions are put in the hands of a single entity.").

¹⁸² See *id.* at 1203 (describing how the work-for-hire doctrine works poorly in a research university setting). See *McSherry*, *supra* note __ at 89 (reporting how discussions of authorship on collaborations are described by subjects as "embarrassing" and "uneasy" and thus often avoided altogether or resolved without attention to original contribution but human relation).

¹⁸³ Id. ("In the university setting . . . untenured faculty may have difficulty refusing to sign. Certainly the students and research fellows who are often protagonists in these disputes might be too concerned about getting their degrees or employment references to negotiate forcefully.").

justification for the inequities that might result from works-for-hire and joint-works of authorship. But why should that be? What work does the parable of consent do for the vitality of the origin myth of copyright? If we believe that original and creative expression is sufficiently valuable to designate it as property of its maker, and if copyright law serves to incentivize authors to create more original works, why redirect that incentive and the ownership right to the dominant co-author or to the employer?¹⁸⁴

The answer lies in the origin story copyright law tells about the nature of authorship. The doctrines of joint authorship and work-for-hire do not protect an “author” as a literal source but instead as a functional origin of expression. Instead of privileging one who actually wrote the words or shaped the sculpture, these copyright doctrines ask who propelled and encouraged the inspiration. This is a theory of patronage, suggesting that without it, no creative expression would take place in the first instance. In this way, the origin myth of copyright expressly embodies a theory of the American citizen, his nature and his possibility. The law confers the privilege of copyright (e.g., the power to exclude) only on an author who has the capacity to originate (through manufacture, promotion, influence or superior management) creative work.

Regardless of who produced the original arrangement, it was the individual or firm who could claim ‘authorship’ to the work’s initiative ‘motivating factor’ and inspiration. In effect, the visionary component of Romantic ‘authorship’ was disaggregated from the associated component of intellectual and physical labor. The employer was cast as the visionary, and the employee as a mere mechanic following orders.¹⁸⁵

This origin myth explains why the author of a work-for-hire is not the writer/employee

¹⁸⁴ See *The Metamorphosis*, supra note __ at 490 (describing problems with work-for-hire doctrine that follow from the Supreme Court’s decision of *Community for Creative Non-Violence v. Reid*, saying that the Court’s “particular version of the ‘authorship’ construct emphasized in the ‘work-for-hire’ cases may, in practice, be inimical to the concrete pecuniary and moral interests of writers, photographers, sculptors and other flesh-and-blood creative workers”).

¹⁸⁵ *The Metamorphosis*, supra note __ at 488-489 (discussing *Picture Music Inc. v. Bourne, Inc.*, 457 F.2d 1213 (2nd

but the employer, because the employer has already fulfilled the American dream of ownership and command, albeit over only a small dominion—a single mind or a community of people. The origin myth explains the rule of joint authorship: the individual who controls the terms of the relationship will determine whether or how the work is co-authored.¹⁸⁶ Courts justify the potential inequity that might result from the joint-authorship rule by explaining that the doctrine as it currently exists “prevents . . . spurious claims by those who might otherwise try to share the fruits of the efforts of a sole author.”¹⁸⁷ Concern over unjust enrichment claims of one putative co-author at the expense of another has led to a rule that favors the party who already is a property owner.¹⁸⁸ The clarity of this rule might effectively minimize conflict (in the language of origin myths, it forestalls violence), but it also quite explicitly sanctions the extant power relations and hierarchies that are based on controlling the means of reproduction (labor) that shape our post-industrial society.¹⁸⁹

These doctrines, and their governing narratives, produce the same status hierarchy that operated in patent law. In patent law, they distinguish the genius from the mechanic to discriminate, and in copyright law they divide authors and all others. Indeed, the language of the “mechanic” (as compared to the artist-author) also runs throughout copyright law. As one oft-cited treatise writer said: “(o)ne who has slavishly or mechanically copied from others may not

Cir. 1972) which becomes the basis of 17 U.S.C. § 101(1) upon amendment in 1976).

¹⁸⁶ Rochelle Cooper Dreyfuss, *Collaborate Research Conflicts on Authorship, Ownership, and Accountability*, 53 *Vand. L. Rev.* 1161, 1204-1210 (2000); Peter Jaszi, *On the Author Effect: Contemporary Copyright and Collective Creativity*, 10 *Card. Arts & Enter. L. J.* 293, 314-16 (1992).

¹⁸⁷ *Childress v. Taylor*, 945 F.2d 500, 507 (2nd Cir. 1991).

¹⁸⁸ See Dreyfuss, *supra* note __ at 1218 (suggesting that the joint-authorship test announced in *Childress* is animated by the “concern that secondary contributors would receive too rich a reward—an undivided half interest in the entire collaborative product”).

¹⁸⁹ Keith Aoki has persuasively argued that the “author trope” serves not only to reify preexisting property regimes within a country but between nations as well. He says that authorial property is a form of, or at least closely related to, the concept of national sovereignty (which includes notions of cultural, economic and political ascendancy and dominance). Keith Aoki, *(Intellectual) Property and Sovereignty: Notes Toward a Cultural Geography of*

claim to be an author.”¹⁹⁰ Otherwise put: copying, while laborious, is not inspired. Labor is not necessarily rewarded under the copyright regime. That we protect only the authentic or original works of authorship, and not the product of significant labor, reflects our society’s hierarchy of values and underscores certain fundamental propositions about who we are and what kind of expression is meaningful. In Plato’s terms, “authors” are made of gold, not brass. The brass—the laborers—are felled by *Feist*’s “sweat of the brow” doctrine.¹⁹¹ We embrace this story of human originality because we want to believe we are each unique and thus each capable of creating copyright-protected expression. This mythic narrative of rugged individualism is a motor behind our market theories,¹⁹² our republican form of government,¹⁹³ and many other facets of liberal

Authorship, 48 Stan. L. Rev. 1293, 1297-1299 (1996).

¹⁹⁰ 1 M. Nimmer, *The Law of Copyright* § 6, at 10.2 (1984).

¹⁹¹ *Feist*, 499 U.S. at 349 (“The primary objective is not to reward the labor of authors, but to promote the Progress of the Science and useful Arts.”)(internal quotation marks omitted). See also *id.* at 353 (describing the flaws of the “sweat of the brow” doctrine).

¹⁹² Scott Burris, *The Invisibility of Public Health: Population-Level Measures in a Politics of Market Individualism*, 87 Am. J. of Public Health 1607, 1608 (1997) (“The heuristic of market individualism offers three tools for analyzing the problems of governing: the supremacy of the free market as a regulatory device, a belief in individual freedom of choice and personal responsibility, and the elevation of individual satisfaction as the chief goal of society.”).

¹⁹³ Jonathan Toren, *Protecting Republican Government From Itself: The Guarantee Clause of Article IV, Section 4*, 2 N.Y.U. J. L & Liberty 371, 406 (2007) (“the idea of one-person-one-vote could reasonably be construed as an essential element of a republican form of government”); Akhil Reed Amar, *The Central Meaning of Republican Government: Popular Sovereignty, Majority Rule, and the Denominator Problem*, 65 U. Colo. L. Rev. 749, 749-52 (1994) (“The central pillar of Republican Government, I claim, is popular sovereignty. In a Republican Government, the people rule.”).

This theory of the author-citizen-employer coincides with the theory of copyright’s origin in Anglo-American law as protecting property owners rather than artists and writers. There are, of course, other (some related) theories of the origin of copyright protection. See, e.g., Mark Rose, *supra* note _ at 9 (noting that the “historical emergence [of copyright] is related to printing technology”); *id.* at 48 (describing the rise of authorship centered on notions of honor and reputation); Cyrill P. Rigamonti, *The Conceptual Transformation of Moral Rights*, 55 Am. J. Comp. L. 67, 70 (2007) (tracing the rise of moral rights and copyright doctrine); Alfred C. Yen, *Restoring the Natural Law: Copyright as Labor and Possession*, 51 Ohio St. L.J. 517, 529-39 (1990) 529- 39 (stressing that natural law concepts are inherent in copyright law); *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 430-31 (1984) (“From its beginning the law of copyright has developed as a response to significant changes in technology. Indeed, it was the invention of a new form of copying equipment--the printing press --that gave rise to the original need for copyright protection.”); B. Zorina Khan, *The Democratization of Invention: Patents and Copyrights in American Economic Development, 1790-1920* (2005) (discussing the development of copyright law alongside the nation’s economic development). But this only shows that origin myths themselves are instable narratives, underscores the myth of origins. More on this in Part V *infra*.

legalism that dominate American culture.¹⁹⁴

At certain junctures, copyright law could flatten its hierarchical structure of privilege. Although the term “authorship” may traditionally evoke the image of an artist-writer, pen in hand, pouring over blank pages the Supreme Court expanded the category to include craftsmen of new technology (photographers¹⁹⁵) and of popular art (circus posters¹⁹⁶). The study of art and art history has long dissolved the distinction between “high” art and “low” art.¹⁹⁷ Copyright law was not immune to this development, indeed it was ahead of its time. In 1903, the Supreme Court explicitly refrained from reinforcing a hierarchy of works of authorship, saying that

[i]t would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At one extreme some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the published learned the new language in which their ‘author’ spoke.¹⁹⁸

This pronouncement would seem a welcome respite from the language of “geniuses” and “mechanics,” except that much copyright doctrine remains preoccupied with valuing certain works of authorship more strongly than others, describing weak copyrights as “thin” where they copy too much from other works¹⁹⁹ or are based on information and facts that are part of the public domain.²⁰⁰ And so, here too, copyright returns to the hierarchical distinctions that value art more highly if it “results from the true imagination rather than mere application, particularly

¹⁹⁴ By calling these narratives “myths,” I don’t mean to call them untrue, only that they are stories that dominate our culture, bringing order to social relations by explaining the nature of the self and her entitlements, her role in and her relations to a specific kind of society. See *supra* Part I.A.

¹⁹⁵ *Burrow-Giles*, 111 U.S. 53 (1884).

¹⁹⁶ *Bleistein*, 118 U.S. 239 (1903).

¹⁹⁷ See Susan Sontag, *Notes on Camp*, in *Against Interpretation* 275-292 (1966).

¹⁹⁸ *Bleistein*, 118 U.S. at 249-51.

¹⁹⁹ For example, derivative works are based on preexisting works of authorship, 17 U.S.C. § 106(2), and are only copyrightable to the extent that the new work is a distinguishable variation that is more than merely trivial over the preexisting work. *L. Batlin & Son*, 536 F.2d 486 (1976). Even then, the copyright in the derivative work extends only to the new material. 17 U.S.C. § 103(b).

if its creator draws inspiration directly from nature,” a hallmark of English Romanticism.²⁰¹

What category of thought or expression outranks the precious gold-standard of “original works of authorship”? Only facts and ideas are so valuable that no one can own them;²⁰² and so they are left in the commons. From the perspective of a market-driven society in which private ownership maximizes productivity, innovation, and personal wealth, leaving the most valuable commodities free for everyone is puzzling, unless they are truly non-rivalrous, non-excludable public goods. Of course, this is the debate around facts and ideas: although they are non-rivalrous and non-excludable, how exactly do we separate a fact or an idea from copyrightable expression so that we protect the latter from intrusion but leave the former free?²⁰³

Again, attention to the mythical origin helps here. Searching for a human source can distinguish facts and ideas from copyrightable expression. “No one may claim originality as to facts,”²⁰⁴ because facts are not original to anyone, but are discovered. They existed previously and were merely found.²⁰⁵ For example, the facts of a United States’ president’s life (e.g., when and where he was born) are free for all to use, but the sentences and expressions that incorporate those facts (e.g., a presidential autobiography) are subject to copyright and only the author can permit their reproduction.²⁰⁶ Facts pre-exist expression. Their tangible manifestation in written

²⁰⁰ Feist, 499 U.S. at 349.

²⁰¹ Jaszi, *supra* note __ at 462-63. See *id.* at 495 (“In effect, artists who work directly from personal experience, in proximity to the natural raw materials of the creative process, are given a legal preference over those who merely rework prior art — no matter how ably.”).

²⁰² 17 U.S.C. § 102(b). See also Paul Goldstein, *Copyright*, § 2.3.1 (2005).

²⁰³ I will have more to say about this problem *infra*, Part III.B.

²⁰⁴ Feist, 499 U.S. at 347 (citing Nimmer, § 2.11[A], p. 2-157).

²⁰⁵ *Id.* (“The distinction is one between creation and discovery: the first person to find and report a particular fact has not created the fact; he or she has merely discovered its existence.”). Recalling the comparison of the public domain to an “orphan” is irresistible here, see Jessica Litman, *Digital Copyright* 77 (2001) (quoting Jack Valenti describing the public domain as an “orphan”), as both of the public domain and orphans are no longer lucky enough to have parents (caretakers) of their own — people or a person to whom one can point as their originator (author).

²⁰⁶ *Harper & Row v. Nation Enters.*, 471 U.S. 539 (1985).

language is merely a recordation.²⁰⁷ But the autobiography, in contrast, is original human expression, par excellence.²⁰⁸ “The discoverer merely finds and records,”²⁰⁹ whereas expression results from human creativity, a product of the mind. Of course, this distinction between expression and facts—“between creation and discovery” as the Supreme Court has said²¹⁰—is not stable.²¹¹ Only faith in a discernible origin, reputable or customary, maintains it.

B. *Copyright Stories*

Copyright disputes rehearsing the copyright’s origin myth are plentiful. The following example is one whose outcome remains very much contested.²¹²

The case involved the action of Peter Veeck, who operates a non-commercial website, “RegionalWeb,” that displays information about northern Texas.²¹³ Veeck purchased a copyright-protected 900-page model code from Southern Building Code Congress International, Inc. (SBCCI) for \$72 contained on computer disks that bore prominent copyright warnings and that bound the user to a licensing agreement upon opening and installation.²¹⁴ Veeck installed the model code onto his computer and cut and pasted all of the text onto his website for public users

²⁰⁷ This is like the product of nature doctrine in patent law. *Supra* at ___.

²⁰⁸ Interestingly enough, the genre of autobiography is said to create a life, rather than record one. Jessica Silbey, *Criminal Performances: Film, Autobiography and Confession*, 37 *New Mex. L. J.* 189, 207-211 (2007).

²⁰⁹ *Feist*, 499 U.S. at 347.

²¹⁰ *Id.*

²¹¹ See John Searle, *The Construction of Social Reality* (1995) (distinguishing between social reality, which is maintained by custom, and brute reality, which is independent of human agreement, and defining certain things—like money, property, government—as existing in our social reality only because we believe them to exist). See also Peter L. Berger and Thomas Luckmann, *The Social Construction of Reality: A Treatise on the Sociology of Knowledge* (1966) (in their treatise on sociology of knowledge, examining how social order is a human product and therefore relative and contingent).

²¹² Compare *Practice Mgmt. Info. Corp. v. Am. Med. Ass’n*, 121 F.3d 516, 518 (9th Cir. 1997) (standards are protected by copyright even when adopted by reference into law) and *CCC Info. Servs. v. Maclean Hunter Mkt. Reports*, 44 F.3d 61 (2d Cir. 1994) (same) with *Veeck v. S. Bldg. Code Congress Int’l*, 293 F.3d 791, 801 (5th Cir. 2002) (contra).

²¹³ *Veeck v. Southern Building Code Congress International, Inc.*, 293 F.3d 791, 793 (5th Cir. 2002) (en banc).

²¹⁴ *Id.*

to view.²¹⁵ Veeck did not credit SBCCI with authorship of the 900-page code or recognize SBCCI's copyright.²¹⁶ Veeck identified the model code as the building codes of the towns of Anna and Savoy, Texas.²¹⁷

Both Anna and Savoy, Texas, had adopted by reference SBCCI's model building code as a municipal ordinance.²¹⁸ SBCCI is a non-profit organization "whose primary purpose, since 1940, has been to create uniform model codes to guide the safe design, construction, and operation of commercial and residential buildings."²¹⁹ Organizations like SBCCI are widespread in the United States and are growing.²²⁰ They provide an invaluable service, especially to small towns, which do not have the resources or expertise to develop safety standards of their own.²²¹ Indeed, the benefit of these private standard developers also runs to the federal government. The Office of Management and Budget of the United States directs all federal agencies to incorporate privately developed standards "whenever practicable and appropriate," thereby "eliminating the cost to the Government of developing its own standards."²²² Recognizing that the standards systems depends on maintenance of copyright, the OMB requires agencies to "observe and protect the rights of the copyright holder"²²³ SBCCI and its

²¹⁵ Id.

²¹⁶ Id.

²¹⁷ As it turns out, the version of the model code that Veeck posted on his website was not an accurate version of the law that Anna and Savoy had enacted. The text of the law included provisions that resolved conflicts between the model code and previous city laws and certain clarifications. Id. at 809, n. 4.

²¹⁸ Id.

²¹⁹ SBCCI's Petition for Writ of Certiorari to the United States Court of Appeals for the Fifth Circuit, 2002 WL 32151704.

²²⁰ Id. As early as 1981, 97% of United States cities has adopted model building codes from one standard developer or another. This is up from 47% in 1964. Bureau of Economics, Federal Trade Commission, Local Building Codes and the Use of Cost Saving Methods 11, 16 (Jan. 1989). See also National Conference of States on Building Codes and Standards, Inc., Directory of Building Codes & Regulations (1998 ed.) (listing adoptions of building-related model codes and standards).

²²¹ Veeck, 293 F.3d at 817.

²²² Federal Participation in the Development and Use of Voluntary Consensus Standards and in Conformity Assessment Activities, 63 Fed. Reg. 8546, 8554-55 (Feb. 19, 1998) (revising the 1983 OMB Circular A-119).

²²³ Id. at 855.

competitors develop model codes and encourage local government to enact them.²²⁴ The local government pays nothing to do so.²²⁵ SBCCI supports its mission by selling its model codes to individuals or private organizations.²²⁶

SBCCI sent Veeck a cease-and-desist letter when it learned that Veeck had posted its entire 900-page model code on RegionalWeb.²²⁷ Believing that he was not infringing any copyright, Veeck filed a declaratory judgment action against SBCCI seeking a ruling to that effect.²²⁸ Veeck did not dispute that SBCCI had had a valid copyright in the model code when it was originally drafted.²²⁹ Veeck insisted, however, that upon adoption into law by Anna and Savoy, Texas, the copyright expired. SBCCI, or any other standard developer, could no longer hold a copyright in its original expression because, through enactment into law, it had become part of the public domain.²³⁰ If Veeck was correct, SBCCI's would lose approximately one-third of the revenue that it generates by sales of model codes to contractors, potentially harming SBCCI's business and thwarting the public service it provides.²³¹

SBCCI made several arguments to support its counterclaim of copyright infringement that resonate with some of the doctrinal foundations of copyright law and attempt to justify its authorship status. For example, the constitutional purpose of copyright law is "to Promote the Progress of the Science and useful Arts"²³² by "secur[ing] a fair return for an author's creative labor . . . to stimulate artistic creativity for the general public good."²³³ This is precisely what

²²⁴ Veeck, 293 F.3d at 794.

²²⁵ Id.

²²⁶ Id.

²²⁷ Id.

²²⁸ Id.

²²⁹ Veeck v. SBCCI, 241 F.3d 398, 403 (5th Cir. 2001).

²³⁰ Veeck v. SBCCI, 49 F. Supp. 2d 885, 888 (E.D. Tex. 1999).

²³¹ Veeck, 293 F.3d at 816 & n. 24.

²³² U.S. Const. art. 1, § 8, cl. 8.

²³³ Twentieth Century Music Corp. v. Aiken, 422 U.S. 151, 156 (1975) (internal quotations omitted).

SBCCI and other model code drafters were doing—promoting the public good by creating standards that protect health and safety. Without its copyright revenue, this public service would be lost. SBCCI further explained that without the rights that pertain to authorship, it would have little incentive to disseminate its model codes, which it creates less expensively and more efficiently than the municipalities that had enacted them.²³⁴ This, too, is a central tenet of copyright law: protecting authored works.²³⁵ Finally, SBCCI explained that when Anna and Savoy adopted SBCCI’s model code by reference into its law, instead of drafting their own code at their own expense, these municipalities acknowledged SBCCI’s authorship status by entering into a licensing agreement that retains for SBCCI the exclusive right to publish these codes or license their reproduction and publication.²³⁶ SBCCI also, however, “ensures free access [to the code] by specifying [in the license] that once a governmental unit enacts such a model code into law, copies must be made available for inspection by the public in the enacting government’s office. As a general proposition, members of the public may make or obtain copies of portions of the adopted versions of SBCCI codes from city officers or local libraries or may purchase copies of the codes directly from SBCCI.”²³⁷ Veeck did not pursue copies of codes at Anna’s and Savoy’s municipal offices, finding the services there “inconvenient.”²³⁸

In response to what appears to be a clear case of willful infringement, Veeck made

²³⁴ See Brief of Amicus Curiae Texas Municipal League et al., On Petition for Writ of Certiorari to the United States Court of Appeals for the Fifth Circuit, at 18 (approximating the cost of the model code at eight cents per page when purchased through SBCCI, which is less than the cost of photocopying in public libraries or municipal offices) (on file with author).

²³⁵ Harper & Row v. Nation Enters., 471 U.S. 539, 577 (1985) (“By establishing a marketable right to the use of one’s expression, copyright supplies the economic incentive to create and disseminate ideas”).

²³⁶ Veeck, 293 F.3d at 808.

²³⁷ Veeck, 293 F.3d at 808-09. “SBCCI does not permit governmental entities to publish its model codes when they are enacted. Instead, it permits their adoption by reference and furnishes a copy of the adopted code to the entity. SBCCI also generously allows that if a governmental entity were to publish the building code on an Internet site to meet its due process obligation, that would be a fair use.” Id. at 800 n. 12.

²³⁸ SBCCI’s Petition for Writ of Certiorari to the United States Court of Appeals for the Fifth Circuit, 2002 WL

several arguments. In particular, he claimed that the author cannot copyright the “the law” (i.e., the enacted model code) for two reasons: (1) due process and right of access prohibits private control of public law to which citizens are accountable, and (2) once the model code becomes “the law,” its expressive quality has merged with the fact of the law such that the fact/idea doctrine of merger precludes copyright protection.²³⁹ The First, Second, and Ninth Circuits had previously addressed both issues and had ruled in favor of model code developers that were in positions similar to SBCCI.²⁴⁰ The United States Court of Appeals for the Fifth Circuit, in a divided en banc opinion (with two dissents), created a circuit split on the issue when it ruled in Veeck’s favor.²⁴¹ The majority drew primarily on a nineteenth century Supreme Court case and a single decision from the Court of Appeals for the First Circuit that discussed the issue but did not decide it.²⁴² The reasoning of the majority opinion counters SBCCI’s doctrinal arguments about the purpose and scope of copyright protection with a story about mythical origins of “the law” itself.

In holding that the law cannot be copyright protected, whether a judicial opinion, a statute, or a local ordinance that adopts by reference a privately-owned model code, the Court of Appeals for the Fifth Circuit relied on *Banks v. Manchester*,²⁴³ a Supreme Court case from 1888.

32151704. See also Veeck, 293 F.3d at 793 (“Veeck made a few attempts to inspect several towns’ copies of the Building Code, but he was not able to locate them easily.”).

²³⁹ Veeck, 49 F.Supp. 2d at 888. Veeck made other arguments that are not relevant for the foregoing discussion, including a claim of copyright misuse and waiver. *Id.*

²⁴⁰ *Practice Mgmt. Info. Corp. v. Am. Med. Ass’n*, 121 F.3d 516 (9th Cir.) cert. denied, 522 U.S. 933 (1997) (where Federal Health Care Financing Administration adopted regulations requiring physicians to use a version of a copyrighted standard owned by the American Medical Association, copyright was not placed in the public domain); *CCC Information Svcs., Inc., v. Maclean Hunter Mkt. Reports*, 44 F.3d 61 (2d Cir. 1994) (where New York statute requires insurance companies to use copyright protected “Red Book” as one of several standards in calculating payments upon total loss of vehicle, “Red Book”’s copyright did not pass into the public domain); *Bldg. Officials and Code Adm’rs v. Code Technology, Inc.*, 628 F.2d 730 (1st Cir. 1980).

²⁴¹ Veeck, 293 F.3d 791.

²⁴² *Id.* at 795 (citing *Banks v. Manchester*, 128 U.S. 244 (1888)); *id.* at 798 (citing *Building Officials and Code Adm. v. Code Technology, Inc.*, 628 F.2d 730 (1st Cir. 1980)).

²⁴³ *Banks v. Manchester*, 128 U.S. 244 (1888).

In that case about a court reporter seeking copyright in his publication of judicial opinions, the Court wrote:

there has always been a judicial consensus . . . that no copyright could . . . be secured in products of the labor done by judicial officers in their discharge of their judicial duties. The whole work done by the judges constitutes the authentic exposition and interpretation of the law, which, binding every citizen, is free for publication to all, whether it is a declaration of unwritten law, or an interpretation of a constitution or statute.²⁴⁴

A principle of access prompts this anti-property stance: “It needs no argument to show that justice requires that all should have free access to the opinions, and that it is against sound public policy to prevent this.”²⁴⁵ But another reason for this ruling, at least as the Fifth Circuit understood it, resulted from a particular understanding of who exactly “authors” the law. SBCCI contends that Banks does not deny copyrightability to all legal enactments, only that “judges have no need for the Copyright Act’s economic incentives in order to author judicial opinions.”²⁴⁶ The law, be it a judicial opinion or a statute, is a “work for hire,” whereas the model codes, drafted by private companies on their own dime, are not.²⁴⁷

The Fifth Circuit opinion refuted the application of the work-for-hire doctrine and the incentive rationale for copyright, and instead reached for a higher level of abstraction. “Banks refers to the source of the judges’ salary in order to explain that it is the *public at large*, not the judges, who have the pecuniary interest or proprietorship in the fruits of their labors.”²⁴⁸ The notion of the “public” as distinct from the judge as the origin of the law’s authority, grows even more fabled when the Fifth Circuit relied on a phrase from an earlier First Circuit case that

²⁴⁴ Banks, 128 U.S. at 253.

²⁴⁵ Nash v. Lathrop, 142 Mass. 29 (1886).

²⁴⁶ Veeck, 293 F.3d at 796.

²⁴⁷ Id. “Judges . . . receive from the public treasury a stated annual salary, fixed by law, and can themselves have no pecuniary interest or proprietorship, as against the public at large, in the fruits of their judicial labors.” Banks, 128 U.S. at 253.

identified the “real premise[] of *Banks*” as that of the “‘metaphorical concept of citizen authorship’ of the law.”²⁴⁹ When the local government who represent the citizens of the town enacted SBCCI’s model code into law, SBCCI’s model code was no longer an original work of authorship by the private standard developer but an assertion by the people of Anna and Savoy, Texas, of their sovereignty and self-determination. The statement of law needn’t be inventive or unusual. It must only originate (have its source of authority derive) from the particular community or person who *intends* their expression to be inseparable or interdependent parts of the whole.²⁵⁰ In addition to describing how joint authors create original works of expression, this describes the ideal by which each citizen “authors” their own government.

If Veeck’s win seems an unfair result the Fifth Circuit opinion reached for the panacea of consent, that which serves to legitimate unequal distribution of power and property.

Not only is the question of authorship ‘of the law’ exceedingly complicated by SBCCI [and its position on] . . . the ‘authorship’ question, [but it] ignores the democratic process. Lawmaking bodies in this country enact rules and regulations only with the consent of the governed. . . . The citizens are the authors of the law, and therefore its owners, regardless of who actually drafts the provisions, because the law derives its authority from the consent of the public, expressed through the democratic process.²⁵¹

This political origin story justifies the redistribution of property from private sweat and equity to “the people” who are thereby enriched (albeit via an enrichment of the public domain) with the casting of a ballot. The authenticity and authority of the expression—the model code cum law—derives not from the labor that made it, but the power and force (and myth) of the people

²⁴⁸ Veeck, 293 F.3d at 797 (emphasis added).

²⁴⁹ Id. at 798.

²⁵⁰ 17 U.S.C. § 101 (defining joint works). Working with this “metaphorical concept of citizen-authorship,” rather than against it, SBCCI could have asserted that the laws of Anna and Savoy, Texas, were “collective works,” under 17 U.S.C. § 101, in which the “public” could own rights to the whole, and SBCCI retains rights in its separable contribution (if there was any). But this arrangement would diminish the authority of the “public,” reducing it to editor-like status, rather than author.

²⁵¹ Id. at 799 (internal citations and quotation marks omitted).

speaking their desire as one. The origin here is not the source of the model code but the source of the law, the people who invent themselves through consensual self-government.

This is a compelling story, a story that a nation devoted to the philosophy of self-government and the creed of independence likes to believe about itself. To this, SBCCI might only say that the Court's origin myth based on the "citizen-author" is actually a story of paternalism, saving the citizens of Anna and Savoy from their own preferences by denying to them the sovereign choice to enter into the agreement in which they in fact did: a license for SBCCI's finished and copyrighted work that permits them to use it as the standard to measure building safety in both Anna and Savoy.²⁵² As one dissent in the case wrote:

The cities could have hired counsel and engineers to draft a code, recouping its expense either from all taxpayers or by charging a fee to users for a copy of its ordinance. . . . [T]he refrain passes by the fact that it was legislators who chose what they thought was the most practical path, to adopt a technical code developed at the expense of others under a licensing agreement.²⁵³

Lest this be a tale of the government taking property from its citizens without compensating them,²⁵⁴ the Fifth Circuit played a trump card. It held that whether or not the author of the codes is the citizenry of Anna and Savoy, Texas or SBCCI, once adopted into law, the model code becomes a "fact" or an "idea" which the Copyright Act does not protect.²⁵⁵ The

²⁵² Id. at 800 n. 12.

²⁵³ Id. at 808.

²⁵⁴ The risk is real that the government will be seen this way, given the explicit language of the Copyright Act, 17 U.S.C. § 201(e): Involuntary Transfer. When an individual author's ownership of a copyright . . . has not previously been transferred voluntarily by that individual author, no action by any governmental body or other official or organization purporting to seize, expropriate, transfer, or exercise rights of ownership with respect to the copyright, . . . shall be given effect under this title, except as provided under title 11 [regarding bankruptcy]." The purpose of this section "is to reaffirm the basic principle that the United States copyright of an individual author shall be secured to that author, and cannot be taken away by any involuntary transfer." H.R. Rep. No. 1476, 94th Cong., 2d Sess. 173 (1976). See also Trotter Hardy, The Copyrightability of New Works of Authorship: "XML Schemas" as an Example, 38 Hous. L. Rev. 855, 878 (2001) (protecting under this section of the Copyright Act those model building codes authored by private entities and adopted by a legislative body).

²⁵⁵ Veeck, 293 F.3d at 800.

codes “are the unique, unalterable expression of the ‘idea’ that constitutes local law.”²⁵⁶

Applying the merger doctrine to the adoption of the model code as law, the Court explained that once an expression is law, it cannot be expressed in any other way (or at least in only a limited number of ways).²⁵⁷ “The law is the law,” the majority seemed to say. And in one way, they are right. “Courts routinely emphasize the significance of the precise wording of laws presented for interpretation.”²⁵⁸ But are laws, facts or ideas discovered without human origin rather than an expression created by a deliberate or fortuitous act? Certainly SBCCI’s model code is an original expression that is but one possible manifestation of the many expressive possibilities for the “idea” or the “fact” of a building code. SBCCI’s competitors in the model code industry that produce diverse versions of model codes, among those Anna and Savoy were free to choose, prove this point. For the Court’s logic to be anything but circular,²⁵⁹ the law’s existence or expression must be destined, beyond human intervention.

This narrative runs counter to that of the deliberative citizen-author, hence its presentation by the Court as an argument in the alternative.²⁶⁰ But it is an origin myth nonetheless. It is the story of how “the law,” devoid of interpretive or expressive content that is uniquely human, exacts deference and submission. This is a divine creation story that hides the messiness of our law—inevitably messy because it is a living, evolving language that

²⁵⁶ Id. at 801.

²⁵⁷ Harper & Row, 471 U.S. at 556; Baker v. Selden, 101 U.S. 99 (1879).

²⁵⁸ Id.

²⁵⁹ The en banc court’s error appears to be conflating the fact of the adoption of the model code as law with the model code itself. In effect, the court says that because it is a fact that Anna and Savoy have adopted SBCCI’s model code as law, that model code loses its copyright and may be copied in its entirety. Veeck, 293 F.3d at 800-01. This is a mistake. It is akin to saying, as SBCCI pointed out, that “Irvine Welsh’s final draft of *Trainspotting* merged with the fact of being the novel *Trainspotting* upon publication. True, that is the unique expression of the book *Trainspotting*. No responsible observer, however, would think that the impossibility of conveying this novel in any way other than through the exact text of the novel nullified Welsh’s copyright.” SBCCI’s Petition for Writ of Certiorari to the United States Court of Appeals for the Fifth Circuit, 2002 WL 32151704.

²⁶⁰ Id. at 800.

nonetheless must function as a set of commands. The Court says that “the U.S. Constitution is a fact; the Federal Tax Code and its regulations are facts. . . . What SBCCI and the dissent ignore . . . is the graphic merger of its model building codes with ‘the law’ as enacted by Anna and Savoy, Texas.”²⁶¹ But “the law,” whether the U.S. Constitution or the municipal codes of Texas, is no more a fact than is a poem.²⁶² The Court’s assertion of it as a pure “idea” or “fact” rests on the desire for law to be holy and sublime, the font from which all else flows. This application of the merger doctrine, however flawed,²⁶³ serves the “deeper meaning” of the role of law in our society.²⁶⁴ Like fact and ideas, the law (whether or not all three share essential qualities) is so precious, so fundamental to liberty, equality, and the pursuit of knowledge, that no one person can stake a claim to it. This proposition ignores that which makes the common law system so effective at keeping the peace: its unavoidable malleability due to its intimate involvement with law’s diverse subjects. The people, including SBCCI and the legislators who chose SBCCI’s model code, make law work, not the other way around. But suppressing this commonplace in favor of the mythic in order to reify the status of “the law” as authoritative in our society (an “author” of our society) is what origin stories are all about.²⁶⁵

III. TRADEMARK LAW

²⁶¹ Veeck, 293 F.3d at 801-02.

²⁶² See supra note __ [Trainspotting fn].

²⁶³ Whether or not a “fact” or “idea” is inseparable from its expression is a context-driven determination, not something that is simply declared, as a matter of law without analysis. See, e.g., *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930) (L. Hand, J.) (describing the analysis in what has become known as the ‘abstractions’ test). The Fifth Circuit en banc majority opinion fails to engage in this sort of examination. It does not examine any of the other current model building codes, which exemplify the variety of expressive possibilities for the “idea” or “fact” of a building code. Nor does it even assert that the only way to express the underlying “facts” or “ideas” of SBCCI’s model code is as SBCCI actually expressed them in the 900 pages of its model code. These missing analyses are necessary prerequisites for a finding of merger. See, e.g., 4 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 13.03[A][1][a]-[d] at 13-31 – 13-44 (2001).

²⁶⁴ Engel, supra note __ at 791.

²⁶⁵ See supra pages __ and accompanying footnotes (citing to Wright, supra note __ at 4-5, 9).

A. *Trademark Origins*

Federal trademark protection also glorifies or valorizes a certain kind of origin. At first blush, the basis of trademark protection might seem less lofty or fabled than the origin myth that structures patent and copyright protection. Trademarks are not constitutionally protected, for example. But an examination of the statute, foundational cases, and treatises reveals a well-rooted origin myth as the basis for trademark protection.

1. As a Heuristic of an Individual and Society

The touchstone of trademark protection is the mark's source-identifying function. Frank Schecter opens his canonical essay *The Rational Basis of Trademark Protection* with the "orthodox definition of 'the primary and proper function of a trademark' [:]. . . to identify the origin or ownership of the goods to which it is affixed."²⁶⁶ He goes on to discuss the historical roots of trademark in the marketplace as primarily proprietary (to identify the good's owner) or regulatory (to inform consumers about the source of defective or counterfeit goods).²⁶⁷ He went on to explain that the "mark was a true mark of origin, designating as it did the actual producer of the goods."²⁶⁸

As Schecter noted, the literal origin-designating function of the trademark has evolved from its historical roots. Even by 1927, when Schecter was writing, consumers looked to trademarks as reputational designations, indicating the purity or unadulterated quality of the good. Purchasers of goods might not know that Walter Baker & Co., Ltd makes Baker's

²⁶⁶ Frank Schecter, *The Rational Basis of Trademark Protection*, 40 Harv. L. Rev. 813, 813-14 (1927) (citing *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 412 (1916)).

²⁶⁷ *Id.* at 814.

²⁶⁸ *Id.*

Cocoa.²⁶⁹ Instead, the BAKER'S COCOA mark informs the consumer that the product will be the same as it was last time because it originates from the same place.

[The mark] indicates, not that the article in question comes from a definite or particular source, the characteristics of which or the personalities connected with which are specifically known to the consumer, but merely that the goods in connection with which [the mark] is used emanate from the same—possibly anonymous—source or have reached the consumer through the same channels as certain other goods that have already given the consumer satisfaction, and that bore the same trademark.²⁷⁰

The modern formulation of this trademark function is this: distinctive of a consistent, if anonymous source, and distinct from other marks in the marketplace, trademarks reduce consumer search costs by making goods easier to identify and purchase and therefore encourage consistent quality among goods for consumer satisfaction.²⁷¹ Protecting the producer's investment in good will and the consumer's expectations of quality and consistency, the mark (as a sign of a particular product of consistent quality) facilitates the sale of the good.²⁷²

This branding system works because trademark law prohibits confusion among marks on similar goods.²⁷³ “If a competitor were able to market its goods under a confusingly similar symbol, consumers may mistakenly purchase the wrong goods, and the producer's investment in the goodwill of the product would be appropriated.”²⁷⁴ The benefits of trademark protection thus

²⁶⁹ Id. at 815 (citing *Walter Baker & Co., Ltd. v. Slack*, 130 Fed. 514, 518 (C.C.A. 7th 1904)).

²⁷⁰ Id. at 816.

²⁷¹ Stacey L. Dogan & Mark A. Lemley, 41 *Hous. L. Rev.* 777, 786-787 (2004). For the “anonymous source doctrine,” see 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 15:8 (4th ed.2004) (stating that to establish secondary meaning, a plaintiff needs to show “that the ordinary buyer associates the mark with a single, albeit anonymous source”) and 15 U.S.C. § 1127 (defining “trademark”).

²⁷² Schecter, *supra* note __ at 815 (citing *Powell v. Birmingham Vinegar Brewery Col., Ltd.*, 13 *Rep. Pat. Cas.* 235, 250 (1896) (“His mark, as used by him, has given a reputation to his goods. His trade depends greatly on such reputation. His mark sells the good.”). Of course, Schecter's theory is not purely an economic theory of goodwill and market dominance. He understands the psychological and cultural aspect of trademarks. “[T]oday, the trademark is not merely the symbol of good will but often the most effective agent for the creation of good will, imprinting upon the public mind an anonymous and impersonal guaranty of satisfaction, creating a desire for further satisfactions. The mark actually *sells* the goods.” Id. at 819 (emphasis in original).

²⁷³ 15 U.S.C. §§ 1114, 1125(a).

²⁷⁴ Graeme B. Dinwoodie, *The Rational Limits of Trademark Law in U.S. Intellectual Property: Law and Policy* 61

inure to the consumer, who can shop more efficiently and presumably with more choice, and to the producer, who reaps the reputation-related rewards of its investment in its product through branding.²⁷⁵ In this description are echoes of an origin story that concerns the mythic relationship between the consumer and product manufacturer. Unlike the patent, which is born of inventors, or copyrightable expression, which is born of authors, trademarks are born not in the enchanted solitude of creation or discovery but of the social relations between marketplace actors.

Trademarks are born of the identity-relation between consumer and manufacturer, the venerated origin of which is a frictionless and unambiguous market economy where free actors reign.²⁷⁶

Who is this consumer who makes her home in the market place and who values the efficiency of branding symbols?

Just as copyright doctrine has based itself upon a largely mythical ‘author construct,’ so trademark doctrine has based itself upon a largely mythical ‘consumer construct.’ Where the former describes an impossibly romantic producer, however, the latter describes an impossibly utilitarian consumer. Both figures are conceived as sovereigns, that is to say, as egoists, but where the ‘sovereign author’ is inspired, even capricious in her egoism, the ‘sovereign consumer’ is a utility-maximizing agent of unbounded rational choice.²⁷⁷

This rational consumer is a comparison shopper, an individual who thrives in as much as she motivates the quality and choice of goods in the market around her. This is a story of a consumer

(2006). See also Dogan & Lemley, *supra* note __ at 789 (“Trademark law thus historically limited itself to preventing uses of marks that ‘defraud[ed] the public’ by confusing people into believing that an infringer’s goods were produced or sponsored by the trademark holder.”).

²⁷⁵ Dinwoodie, *supra* note __ at 62 (“Trademark protection against confusing simulation thus advances the interests of producers and consumers by protecting the integrity of consumer understanding and the producer’s investment in creating goodwill.”).

²⁷⁶ R.H. Coase, *The Problem of Social Cost*, 3 *J.L. & Econ.* 2-15 (1960). See also Jonathan Macey, *The Nature of Conflicts of Interests within the Firm*, 31 *J. Corp. L.* 613, 615 (2006) (“The Coase Theorem posits that under conditions of zero transaction costs and well-specified property rights, market participants will organize their activities in ways that inevitably will achieve efficient outcomes.”).

²⁷⁷ Barton Beebe, *Search and Persuasion in Trademark Law*, 103 *Mich. L. Rev.* 2020, 2022-23 (2005)[hereinafter *Search and Persuasion*]. See also Ann Bartow, *Likelihood of Confusion*, 41 *San Diego L. R.* 721, 723-24 (2004) (asking “Why, in trademark litigation decisions, do judges so often write about representative members of the public as if we are astoundingly naïve, stunningly gullible, and frankly stupid?” and arguing that likelihood of confusion determinations underestimate the consumer leading to broader trademark protection at the expense of the public).

and marketplace that the United States prides itself on having originated, both as a basis of our post-industrial economic success and our democratic government.

2. As a Measure of Authenticity (to legitimate hierarchies based on quality and distinction)

This origin story of trademark's protection—the rational consumer and the pareto-optimal market—assumes (or at least, it instantiates) a culture that is premised on the value of authenticity and difference. Trademarks stand for the integrity of the good, its authenticity, or its unadulterated quality as if to say, “this is the real thing” or “straight from the source”.²⁷⁸

Trademarks are also only valued inasmuch as they distinguish the good of one from the goods of another. In this, uniqueness of a good and difference between goods are two sides of one coin, describing the winning branding strategy.

Moreover, one only acquires rights in a trademark when the trademark successfully differentiates products in a consumer-populated marketplace. When, for example, similar marks that brand like products collide, trademark law determines property interests based on the relative success of each mark in communicating identity and authenticity to the consumer first. The canonical case of *Blue Bell Inc. v. Farah Manufacturing Company*²⁷⁹ or the more recent case of *Thrifty Rent-A-Car System v. Thrift Cars, Inc.*²⁸⁰ teaches that a mark's first “use in commerce,”²⁸¹ which determines the scope of the trademark right at issue, depends on the assessment of the ability of the mark to communicate its branding identity to the relevant

²⁷⁸ Consider how mayonnaise is marketed, for example, often with the qualifier “real mayonnaise,” see Kraft Mayo Real Mayonnaise® and Hellmann's Real Mayonnaise®. Or consider Coors beer slogan “Brewed with Pure Rocky Mountain Spring Water®” which dates from the 1950s.

²⁷⁹ *Blue Bell, Inc. v. Farah Mfg. Co., Inc.*, 508 F.2d 1260 (C.A. Tex. 1975) (first “use in commerce” is sale of properly branded goods to purchasing public, not sale of goods to company sales representatives or sale of different goods branded with new mark to public).

²⁸⁰ *Thrifty Rent-A-Car System, Inc. v. Thrift Cars, Inc.*, 639 F. Supp 750 (D. Mass. 1986).

²⁸¹ 15 U.S.C. § 1127.

community of consumers. In the case of *Thrifty Rent-A-Car System*, for example, *Thrifty Rent-A-Car* moved its business (with its federally registered trademark) into Massachusetts and collided with Thrift Car's related business and confusingly similar common law trademark, which had been first to operate in southeastern Massachusetts.²⁸² The Court applied the limited use exception of section 33(b) of the Lanham Act to preclude Thrift Car from expanding its business appurtenant to its mark beyond southeastern Massachusetts because, the Court found, Thrift Car had not established any consumer recognition beyond that limited area.²⁸³ Thrift Car lost, despite being "first" in Massachusetts, because it had yet to successfully communicate its brand beyond a limited area. Beyond southeastern Massachusetts consumers, it had no distinct identity as a business with a brand and thus Thrifty could freely establish a market relationship with consumers in the rest of the state.

Branding, the art of trademarks, is as much about market share and consumer identification as it is about personal identity politics in today's twenty-first century. We buy goods for what they are **and** for what they say about each of us: our hipness, athleticism, politics, or sexual preference.²⁸⁴ Insofar as trademark law revolves around the consumer construct,²⁸⁵ the trademark origin myth tells the story of how to be unique and different in today's overcrowded, overly-visually stimulated society.

The promise of branding is so intrinsic to our market culture that some marks are inherently distinctive without proof of their capacity to designate a source. Whereas descriptive

²⁸² TK-footnote This paragraph should likely have pincites to the case. Should be an easy thing to do and our members can do that.

²⁸³ 639 F. Supp at 753-54.

²⁸⁴ Barton Beebe, *Semiotic Analysis of Trademark Law*, 51 *UCLA L. Rev.* 621, 659 (2004) (describing *Boston Prof'l Hockey Ass'n, Inc. v. Dallas Cap & Emblem Mfg., Inc.*, where the mark (professional hockey team logo) refers not to the professional hockey team but "the consumer himself. He is the commodity-form about which the trademark is designed to convey information.").

marks (e.g., SOFTSOAP) require proof of secondary meaning (that the good originates from a consistent, if anonymous, source), trademarks that are suggestively descriptive, fanciful or arbitrary are immediately registrable as trademarks.²⁸⁶ Although the rationale for this rule is that inherently distinctive marks do not deplete the pool of useful words to facilitate the activity and growth of the marketplace,²⁸⁷ the other basis resonates with the central premise of trademark's political origin myth: being inherently distinctive facilitates choice and expression, both of which are operative currencies in a democratic republic whose mantra is diversity.²⁸⁸

The functionality doctrine shows the on-going vitality of trademark's origin myth. If a mark does more than indicate origin (e.g., if the mark serves an aesthetic purpose or is useful) the mark is not protectable.²⁸⁹ The Supreme Court in *Qualitex*²⁹⁰ "elevated the importance of the functionality doctrine by casting it, and not the ontological status of the mark subject matter, as the sentinel of competition."²⁹¹ The past decade has seen a strengthening of the functionality doctrine through the restriction of trade dress protection²⁹² and by imposing the burden of

²⁸⁵ Search and Persuasion, supra note __ at 2 ("The consumer, we are led to believe, is the measure of all things in trademark law. Trademarks exist only to the extent that consumers perceive them as designations of source.")

²⁸⁶ 15 U.S.C. §§ 1052, 1053. See also *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).

²⁸⁷ *Abercrombie & Fitch Co. v. Hunting World, Inc.* 537 F.2d 4, 11 (2d Cir. 1976). *Wal-mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 213-215 (2000).

²⁸⁸ See Barton Beebe, *A Semiotic Analysis of Trademark Law*, 51 U.C.L.A. L. Rev. 621, 681 (2004) (describing the "arresting uniqueness" and "singularity" and "identity" of marks per Schecter's analysis). See also Search and Persuasion, supra note __ at 2062-2963 ("One's theory of trademark law . . . is a species of one's theory of politics. And as a theory of politics, the apologists and restrictionist schools offer us in the schizoid consumer the worst of each of their worlds. The political-economic subject is either confused or deluded; he either chooses on instinct but mistakenly chooses other than what his instinct instructed him to choose, or he chooses what he intended but chooses it according to external command. In either case, the subject may be said to have lost control over the ends of his actions, i.e., to have lost his sovereignty. This is of, course, an outcome that both the Right and the Left are otherwise committed to avoiding, each in their own way, in the name of 'liberty' and 'authenticity.'").

²⁸⁹ 15 U.S.C. § 1052(e)(5). See also *Qualitex Co. v. Jacobson Prods.*, 514 U.S. 159 (1995).

²⁹⁰ *Qualitex Co. v. Jacobson Prods.*, 514 U.S. 159 (1995).

²⁹¹ Graeme B. Dinwoodie, *The Death of Ontology: A Teleological Approach to Trademark Law*, 84 Iowa L. Rev. 611, 655 (1999).

²⁹² *Wal-mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 214 (restricting inherently distinctive trade dress to product packaging out of concern that product design serves purposes other than source identification and therefore protecting it without proof of secondary meaning would have anticompetitive effects).

proving non-functionality on the plaintiff seeking protection of an unregistered trademark.²⁹³

Designating origin must be the *only* thing the mark does. The singular identity relation between consumer and product (i.e., the authenticity of the source) is paramount. Other worldly features cannot clutter the mark, however useful or pretty. As the Protestant church reformed man's relationship with God making it a one-to-one relationship (singular, sacred, and personal) rather than one in need of an intermediary, the evolved functionality doctrine streamlines the relationship between the consumer and her choice of good, a relationship that branding both cultivates and cements. We are not only what we eat. We are what we wear, buy, and promote.²⁹⁴

Trademarks "R" us.

3. Consensual Market Relations

The power and control that branding culture exudes might overwhelm the tourist in Times Square. And yet the origin myth of trademarks features empowered individuals who choose the products that can best represent them and satisfy their desires. In our choices (consensual exchanges and purchases), we actively shape our identities and forge our paths in society.²⁹⁵ Here, the dimension of the origin myth that rehearses a narrative of consent surfaces yet again to rationalize and legitimate the force that markets have over our daily lives. A peaceable consumer culture depends in part on the belief that we have some control over the advertisements that bombard us; we can deflect the ones we disdain and grab for those (or the products to which they refer) that please

²⁹³ 15 U.S.C. § 1125(a)(3).

²⁹⁴ When drawn this broadly, the protection that trademark law provides has been criticized as going too far. This criticism is found in scholarship and cases arguing that there should be no (or at least only a limited) merchandising right when it serves expressive purposes rather than the traditional trademark function of source identification. See, e.g., Stacey L. Dogan & Mark A. Lemley, *The Merchandising Right: Fragile Theory of Fair Accompli?* 54 *Emory L. J.* 461, 465 (2005) (arguing that the merchandising right as protected in the case law "relegates competition and consumer search costs to secondary status").

²⁹⁵ This is the sovereign consumer, as Barton Beebe describes her. *Search and Persuasion*, *supra* note __ at 2022. The other side is the fool. *Id.* at 2024.

us.²⁹⁶ Historian Jackson Lears sees twentieth-century advertising in this light as peculiar to “Anglo-American Protestant culture: extraordinary natural abundance, combined with a proliferation of charlatans and confidence men in a society committed to sincerity and self-command.”²⁹⁷ Lears explains that that early branding practices fostered “personal efficiency” and “discipline[.]” to control a “hedonistic culture of consumption.”²⁹⁸ In other words, the will and efficiency of the American citizen validates her purchasing choices. And with every purchase she consents further to the branding practices in place around her.

And yet, as early as 1948, trademarks were perceived as teasers, “induc[ing] a purchaser to select what he wants, or what he has been led to believe he wants.”²⁹⁹ We are not necessarily sovereign consumers, the counter-narrative goes, we are also fools.³⁰⁰ Ralph Brown’s seminal article on trademarks followed a consumer movement of the 1920s and 1930s in which organized groups lobbied against the growing advertising industry.³⁰¹

The movement objected to the industry’s view of consumers as ‘helpless and irrational’ and to its reliance on image and emotional appeal, often playing to people’s fears and insecurities. Instead, the consumer advocates wanted advertising that provided only legitimate product information, such as that required by any business or government purchaser. Because it failed to provide that, they believed that advertising ‘was not just flawed . . . it was antidemocratic.’³⁰²

As Professor Inger Stole has written, the consumers lost this battle.³⁰³ Presumably, then, the proliferation of advertising and its lowest common denominator—the trademark—has rendered

²⁹⁶ See Search and Persuasion, supra note __ at 2041-42 (citing scholarship that rails against the “befuddled” consumer and supports the image of the sophisticated consumer).

²⁹⁷ T.J. Jackson Lears, *Fables of Abundance: A Cultural History of Advertising in America* 10 (1994).

²⁹⁸ *Id.*

²⁹⁹ Ralph S. Brown, Jr. *Advertising and the Public Interest*, 57 *Yale L.J.* 1165 (1948). See also Barton Beebe, *Search and Persuasion*, supra note __ at 2057 (describing the debate in trademark law about authentic and inauthentic desires of consumers).

³⁰⁰ *Search and Persuasion*, supra note __ at 2023.

³⁰¹ Inger Stole, *Advertising on Trial: Consumer Activism and Corporate Public Relations in the 1930s* (2006).

³⁰² Craig Chamberlain, “Advertising and its methods put ‘on trial,’ Author Says,” in *News Bureau*, University of Illinois, Champagne-Urbana, Jun. 6, 2006 at <http://www.news.uiuc.edu/news/06/0626advertising.html>.

consumers at least partially “helpless and irrational,”³⁰⁴ even while our national narrative is one based on an “individualistic model of controlled, unified selfhood.”³⁰⁵ This tension is by no means unexamined in trademark law and advertising,³⁰⁶ but its collaboration with the origin myth of trademarks is new to the story. The narrative of consent conceals the counter-narrative of control. Whereas law might protect trademarks to facilitate choice and enhance quality with the concomitant benefit of promoting self-expression, the political origin myth of trademarks, once exposed as myth, reveals the power of branding to shape consumers’ desires and identity and to mask the commonality between goods beneath a façade of difference.³⁰⁷ This is deeply “anti-democratic.”³⁰⁸ Indeed, at one extreme, the origin story of trademarks could do exactly what political origin myths are said to do: hide the violence (or forestall its eventuality) that twenty-first century capitalism proliferates in the form of environmental dangers and intensified class distinctions.³⁰⁹

This origin story of how protecting source-designators facilitates a healthy market of

³⁰³ Stole, *supra* note __ at viii.

³⁰⁴ Chamberlin, *supra* note __.

³⁰⁵ Lears, *supra* note __ at 2.

³⁰⁶ Search and Persuasion, *supra* note __ at 205 (“expos[ing] and analyz[ing] the inconsistent uses that have been made of the sovereign and the fool in trademark advocacy”). See also Lears, *supra* note __ at 9 (examining “reoccurring tensions in commercial culture: between the deceptions of the confidence man and the plain speech of the self-made man, between the spontaneous force of consumer desire and the managerial drive for predictability and control”).

³⁰⁷ See Gregory S. Carpenter et al., Meaningful Brands from Meaningless Differentiation: The Dependence on Irrelevant Attributes, 31 *J. Marketing Res.* 339 (1994). The authors explain:

“Our results show that meaningless differentiation [i.e., differentiation on an irrelevant attribute] is valued by consumers in a surprising number of situations. For example, meaningless differentiation is valued even if the differentiated brand is priced above all others and, more surprisingly, in some cases increasing price actually can increase preference for the differentiated brand. Furthermore, the competitive advantage created by adding an irrelevant attribute can be sustained even if consumers acknowledge the differentiating attribute is irrelevant.” *Id.* at 340.

The authors note that “[o]ur results are somewhat disquieting for the model of rational choice.” *Id.* at 348.

³⁰⁸ Chamberlin, *supra* note __.

³⁰⁹ See, e.g., Nicholas Bayard, Valuing Nature in Environmental Education, *Green Teacher*, July 1, 2006, 2006 WLNR 15517646 (“The goal of the activity is to demonstrate the catastrophes (both environmental and economic) that can arise when individuals pursue their own economic self-interest without regard for natural cycles and limits and without controls to mitigate their impact on the environment . Ironically, this is the very system on which

goods naturalizes what is otherwise a contingent system of power relations among market actors. As criticism of anti-dilution law and the merchandizing right explains,³¹⁰ the rational faculty of the consumer is a helpful fiction, potentially frustrating a healthy market of goods and instead enabling the “commodification of . . . sign[s]” themselves.³¹¹ Here, trademarks circulate not for their source-designating function (i.e., not because we want to buy the same product for its quality and experience) but for their own sake, as status symbols or expressive gestures. Indeed, the source-designating function of trademarks has shrunk substantially as the actual source of products either proliferates or is unidentifiable in the globalized economy. What Barton Beebe has called the “rise of the sovereign trademark” is one culmination of this origin story, where people are consumers for the sake of consuming but nonetheless consider themselves freer than ever from the constraints of the marketplace to shape and mold themselves around it.³¹² The origin story of trademarks makes us think we are co-equal actors with the producers and manufacturers in a marketplace of choice. It perpetuates the notion of the consumer both freely engaged in and gratefully protected by transparent commercial relations.³¹³

capitalism is predicated: free markets and competition in the pursuit of individual self-interest.”).

³¹⁰ For criticism of the merchandizing right, see, e.g., Stacey L. Dogan & Mark A. Lemley, *The Merchandising Right: Fragile Theory of Fait Accompli?* 54 *Emory L. J.* 461, 465 (2005). For criticism of the expansion of dilution law, see, e.g., Christine Haight Farley, *Why We Are Confused About Trademark Dilution Law*, 16 *Fordham Intell. Prop. Media & Ent. L.J.* 1175 (2006). Neither the merchandizing right nor dilution law are clearly premised on the protection of trademarks as source designators but on expressions of affiliation and rights in gross, respectively.

³¹¹ Barton Beebe, *Semiotic Analysis of Trademark Law*, 51 *UCLA L. Rev.* 621, 656 (2004).

³¹² *Search and Persuasion*, supra note __ at 2069.

³¹³ Indeed, Douglas Kysar has argued that producers, manufacturers and legislators may underestimate the important intersection between consumer preferences for certain products and the ways in which consumer-citizens shape civil society through their purchasing choices.

“[T]he already heroic conceptual role of the consumer within market liberalism seems poised to become even more heroic. Long expected to help raise collective welfare through constant material accumulation, consumers also now are being charged with determining the outcome of important policy disputes by revealing--again through private market behavior--their true level of support for human safety, the environment, and a host of other public goods. Although proponents of this valuation methodology expect market choices to reveal purely private preferences, individuals acting on process preferences instead seem to regard consumption at least partially as an act of public significance.” Douglas Kysar, *Preferences for Process: The Process/Product Distinction and the Regulation of Consumer Choice*, 118 *Harv. L. R.* 525, 533 (2004).

B. *Trademark Stories*

By now, the case of *Dastar Corporation v. Twentieth Century Fox Film Corporation* is well known.³¹⁴ Scholars have hailed it both as a triumph for the public domain and criticized it as withholding necessary trademark protection.³¹⁵ The case's mobilization of the trademark origin story, which exposes discordant notions of the consumer and the market, explains the inconsistent responses to the case.

Fox produced a television series, entitled *Crusade in Europe*, based on the popular book of the same name by General Dwight D. Eisenhower describing his experience in World War II.³¹⁶ Fox had exclusive television rights to the book and owned the copyright to the television series.³¹⁷ Fox failed to renew the copyright in the original television series that it broadcasted in 1949 and, in 1977, the television series passed into the public domain.³¹⁸ In 1995, in celebration of the 50th anniversary of the end of World War II, Dastar Corporation released a video set called *World War II Campaigns in Europe*, which is, by fair approximation, a bodily appropriation of *Crusade in Europe*.³¹⁹ Dastar purchased a copy of the original version of the Fox television series, edited it slightly, and reproduced it under the Dastar name. Dastar's version makes no mention of Fox's original television series.³²⁰ Fox sued Dastar for "false designation of origin" under section 43(a) of the Lanham Act, among other claims.³²¹

The debate around the *Dastar* case concerns the Supreme Court's evisceration of the "right of attribution," which, until *Dastar*, had a somewhat vulnerable but long-standing

³¹⁴ *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003).

³¹⁵ Lastowka, *supra* note __ at 1205-06 (citing articles and commentary).

³¹⁶ *Id.* at 23, 25-26.

³¹⁷ *Id.*

³¹⁸ *Id.* The copyright in the book was renewed by Doubleday in 1975. *Id.* at 23.

³¹⁹ *Id.* at 26-27.

existence in trademark law under section 43(a)(1)(A) of the Lanham Act. Section 43(a)(1)(A) protects both consumers and producers from false attribution, a broader cause of action than an infringement suit brought under section 32.³²² In relevant part, section 43(a)(1)(A) prohibits a person

in connection with any goods or services, . . . [from] us[ing] in commerce any word, term, name or symbol . . . or any false designation of origin, false or misleading description of fact, . . . which is likely to cause confusion, . . . or to deceive as to affiliation, connection, or association . . . as to the origin, sponsorship, or approval of his or her goods, services or commercial activities . . .

³²³

Plaintiffs have successfully applied this section against defendants who appropriate the likeness of a person (e.g., a celebrity) or expression (e.g., a film or novel) and repackage and redistribute it under conditions that the person or originator of the expression consider to create a false impression of their “endorsement, sponsorship or affiliation.”³²⁴ For example, the novelist Ken Follett successfully sued a publisher under section 43(a)(1)(A) for publishing a book indicating that Follett was its author when Follett contended he had no authorship stake in the book.³²⁵ In a case of “reverse passing off,”³²⁶ an actor successfully sued a film company for failing to credit him with a film role and crediting another actor instead.³²⁷ These are trademark cases under the theory that the author and the actor have developed a brand in their name or

³²⁰ Id.

³²¹ TK-footnote May as well add a pincite to this as well.

³²² Compare 15 U.S.C. § 1114 with 15 U.S.C. § 1125(a)(1)(A).

³²³ 15 U.S.C. § 1125(a)(1)(A).

³²⁴ 15 U.S.C. § 1125(a)(1)(A).

³²⁵ *Follett v. Arbor House Pub. Co.*, 497 F. Supp. 304 (S.D.N.Y. 1980).

³²⁶ “Reverse passing off” occurs when a party sells someone else’s wares without proper attribution, either as his own or someone else’s but who is not the originator of the goods or services – if, for example, Tiffany lamps were on sale at the local lamp shop labeled “made here, our own creations.” See 4 Thomas J. McCarthy, *McCarthy on Trademarks and Unfair Competition* § 25:6 (4th ed. 1996 & Supp. 2004). Passing off, the more common trademark violation, involves an entity selling their own wares as someone else’s – if, for example, the local lamp shop sold its own lamps and labeled them “Tiffany lamps.”

³²⁷ *Smith v. Montoro*, 648 F.2d 602 (9th Cir. 1981).

image, such that branding the book with KEN FOLLETT when he was not the source of the book, or passing off the film role as originating with some actor other than the correct one, misleads the consumer. These trademark violations also harm the plaintiff by misappropriating their brand (reaping where one has not sown³²⁸) and potentially damaging the reputation of the brand in which the plaintiff (here, the author or actor) has made considerable investment and over which he should have exclusive control.

The scope of section 43(a)(1)(A) as defined by the above-mentioned cases is vulnerable, in part, because the so-called “right of attribution” does not exist at all.³²⁹ It doesn’t exist under copyright law,³³⁰ and under trademark law the intellectual property right protects against false attribution, it does not create the right to attribution per se.³³¹ In *Dastar*, the Supreme Court affirmed this parsimonious reading of section 43(a)(1)(A) but not by relying on a difference between the lack of attribution and false attribution. Instead, it decided the case by interpreting the word “origin” and “origin of goods” to mean the manufacturer and producer rather than the creator of the underlying expression.³³² Here begins the thread of our origin myth. Whereas Fox claimed that Dastar violated section 43(a) by failing to credit Fox as the originator of the television series now marketed as the video *Campaigns in Europe*, the Court held that “origin of goods” means the “producer of the tangible product sold in the marketplace,” which is *Dastar*.³³³

³²⁸ *Int’l News Svc. V. Assoc. Press*, 248 U.S. 215, 239 (1918).

³²⁹ It is also vulnerable because it is not clear that “Ken Follett” is a brand in the way protectible trademarks are.

³³⁰ Jonathan Band & Matt Schruers, *Dastar, Attribution, and Plagiarism*, 33 *AIPLA Q.J.* 1, 4 (2005) (“copyright does not concern itself with non-attribution”). See also Greg Lastowka, 85 *B.U. L. Rev.* 1171, 1211 (2005) (“there is actually no [copyright] law prohibiting plagiarism and misattribution generally”). Cf. 17 U.S.C. § 106A(a)(1)(A) (amending the copyright act with the Visual Artists Rights Act of 1990, §603(a), 104 Stat. 5128, providing that the author of only specific works of visual art “shall have the right . . . to claim authorship of that work”).

³³¹ See 15 U.S.C. § 1114 (prohibiting confusion and deception with regard to affirmative use of marks); 15 U.S.C. 1125(a).

³³² *Dastar*, 539 U.S. at 24.

³³³ *Dastar*, 539 U.S. at 24.

Dastar produced, marketed, and sold the repackaged series on video.³³⁴ In other words, the meaning of “origin” in trademark law lay at the heart of the matter of the case.

According to the false designation of origin cases that had come before, Fox has a straight-faced argument for misappropriation. Dastar, a small Oregon company, took a well-known television series based on a popular book, edited, and repackaged it, and sold it as Dastar’s own for half the price that Fox charged for essentially the same product.³³⁵ A trademark violation requires, however, that Fox have a trademark-like property interest in the title or embodiment of the television series (i.e., that *Crusade in Europe* or some part of it served as a source-designator for Fox or its affiliates). To be sure, for Dastar to reap the value of the investment and reputation that Fox developed over time in the well-received program *Crusade in Europe* seems grossly unfair. If consumers saw what looked like *Crusade in Europe* but were disappointed, or misled, by Dastar’s version thinking it originated from Fox, Fox might have a trademark claim. But this is not what the Supreme Court said.

Instead, the Supreme Court conceived of the trademark dispute (or lack thereof) as follows:

[Fox’s] claim would undoubtedly be sustained if Dastar had bought some of New Line’s *Crusade* videotapes and merely repackaged them as its own. Dastar’s alleged wrongdoing, however, is vastly different: it took a creative work in the public domain—the *Crusade* television series—copied it, made modifications (arguably minor), and produced its very own series of videotapes. If ‘origin’ refers only to the manufacturer or producer of the physical ‘goods’ that are made available to the public (in this case the videotapes), Dastar was the origin.³³⁶

In the face of an expanding trademark cause of action, where trademarks are protected for their

³³⁴ Id.

³³⁵ Greg Lastowka, *The Trademark Function of Authorship*, 85 B.U.L. Rev. 1171, 1202 (2005).

³³⁶ Dastar, 539 U.S. at 31.

expressive as well as source-designating function,³³⁷ *Dastar* emasculates the former claim and endorses trademark law’s more traditional or, as the Supreme Court said, its “natural”³³⁸ foundations rooted in the political origin myth that structures trademark protection. It does so by reaffirming a conventional notion of “source” or “origin” and by imagining the consumer as someone narrowly focused on that origin (and its significance for the value of their purchase) and on little else.

The most natural understanding of the ‘origin’ of ‘goods’—the source of wares—is the producer of the tangible product sold in the marketplace, in this case the physical Campaigns videotape sold by Dastar. . . . [T]he phrase ‘origin of goods’ is . . . incapable of connoting the person or entity that originated the ideas or communication that ‘goods’ embody or contain. . . . [This is because] [t]he consumer who buys a branded product does not automatically assume that the brand-name company is the same entity that came up with the idea for the product, or designed the product—and typically does not care whether it is. The words of the Lanham Act should not be stretched to cover matters that are typically of no consequence to purchasers.³³⁹

The Court did not disregard the difference in consumer expectations of the branding functions between, say, bottled soda and a novel,³⁴⁰ but it concluded that protecting the author of a novel the same way we protect brands on soda cans impermissibly conflicts with copyright law and the bargain it crafts between the incentive to create and a flourishing public domain.³⁴¹ In any case, trademark law “has no necessary relation to invention or discovery but rather, by preventing competitors from copying a source-identifying mark, reduces the customer’s costs of shopping and making purchasing decisions and helps a producer that it (and not an imitating competitor)

³³⁷ See supra pages ___ and accompanying notes (discussing merchandizing right as an example).

³³⁸ *Dastar*, 539 U.S. at .

³³⁹ *Id.* at 31.

³⁴⁰ *Id.* at 33 (“The purchaser of a novel is interested not merely, if at all, in the identity of the producer of the physical tome (the publisher), but also, ,and indeed primarily, in the identity of the creator of the story it conveys (the author).”).

³⁴¹ *Id.* at 33-34.

will reap the financial, reputation-related rewards associated with a desirable product.”³⁴²

Theories of the market, of branding, and of the consumer who choreographs both, controlled the outcome of the *Dastar* decision.

In the Supreme Court’s opinion, according to well-established trademark cases, the rational consumer of *Campaigns of Europe* experiences no actionable confusion or deception when it purchases Dastar’s version of Fox’s original television series. This consumer recognizes Dastar as the originator of the video, not its author. Indeed, if this consumer optimizes her purchasing decisions in the way the Supreme Court imagines trademark law facilitates, this consumer would recognize that denying Fox a trademark cause of action in this case multiplies her opportunity to view some version of the World War II documentary. She could purchase Dastar’s version, Fox’s version, the Doubleday book version, or any of the other versions that will likely become available now that the Supreme Court designated Fox’s 1949 television series free for all. This choice not only facilitates diversity of goods and prices in the market place, the argument goes, but it enriches the consumer herself. By separating the author function from the trademark function (regimes that the Supreme Court said in *Dastar* protects different kinds of origin), *Dastar* insures that the marketplace abounds with goods that are only marginally different (trademarked products such as Dastar’s and Fox’s videos), whose small differences are nonetheless alleged to be signs of rich and “innumerable cultural influences”³⁴³ that popular our diverse society (copyright protected works, whether now or in the past).

In this vein, many have applauded *Dastar* as reinvigorating the public domain.³⁴⁴ The facts of the case certainly support that view, given the relative obscurity of Dastar, the

³⁴² Id. at 34 (internal quotations and citations omitted).

³⁴³ Heymann, supra note __ at 1442.

³⁴⁴ Lastowka, supra note __ at 1205-06 (citing articles and commentary).

dominance of Twentieth Century Fox and the triumph of Dastar to produce a similar product for consumers at half the price. Here, *Dastar* tells a story of interconnectedness of competition for consumers, a rich public domain, and the little guy having a chance to best the big guy. This is the stuff of Classical Hollywood films as well trademark law.³⁴⁵ The story exemplifies what we hear repeatedly about the promise and power of the American dream for all those who seek to attain it.³⁴⁶

But there is another aspect of the origin story in *Dastar* that explains its narrowing of trademark protection, which speaks less to the ability of each individual to shape his or her own destiny and more to the process of legitimizing unequal (and potentially unfair) power and property relationships among individuals, a central function of origin myths. It is a story of opportunity and just deserts that the Supreme Court leaves for the end. “The original film footage used in the Crusade television series could have been copyrighted, . . . as was copyrighted (as a compilation) the Crusade television series, even though it included material from the public domain, see §103(a). Had Fox renewed the copyright in the Crusade television series, it would have had an easy claim of copyright infringement.”³⁴⁷ Here, the Supreme Court highlights that Fox sat on its rights and therefore relinquished them. Dastar seized an opportunity where it arguably had a legal right to do so and ran with it. Opportunistic, go-getter Dastar deserves this victory. Fox does not.

Note, however, that nothing in this decision prevents flipping the identities of the parties, such that the opportunist is the multi-billion dollar company and the idle or ignorant party the

³⁴⁵ Jessica Silbey, Patterns of Courtroom Justice, 28 J.L. Soc’y 97 (2001) (mapping the genre of trial films and its central theme of the liberal legal subject, the individual who comes before the law apparently free and determined to exact justice based on his own will and unique capacity).

³⁴⁶ See supra note __ [Herbert Hoover quote].

³⁴⁷ Dastar, 539 U.S. at 37-38.

small-time entrepreneur. Consider how often this is the case, in part because of the high cost of litigation, the expense of good legal advice, and the lack of understanding of intellectual property rights generally.³⁴⁸ In fact, since *Dastar*, the decisions applying the definition of origin as the “tangible goods offered for sale” rather than as the originator of the expressive or communicative product have ruled consistently against the misattributed or non-attributed author/creator and for the film company, the publishing house, or music company.³⁴⁹ In this light, *Dastar* is not necessarily a victory for the public domain, and the general public, but a victory for the property owners with sufficient capital to protect their investment who manage to get to the desired property first. Moreover, because little in *Dastar* limits its holding to public domain works, lower courts have applied *Dastar* as a bar to a misattribution claim of copyright-protected works as well.³⁵⁰ This means the first in time to capture *any* expressive work or communicative product and use it in a non-copyright-infringing way wins.³⁵¹ The message to those who follow the *Dastar* creed: conquer and vanquish if you can.³⁵²

³⁴⁸ On the problem of unequal resources and repeat players, generally, see Marc Galanter, *Why the "Haves" Come Out Ahead: Speculations on the Limits of Legal Change*, 9 *Law & Soc'y Rev.* 95 (1974). On this problem in internet law, see Michael Rustad & Thomas Koenig, *Rebooting Cybertort Law*, 80 *Wash. L. Rev.* 335, 349 (2005).

³⁴⁹ See, e.g., *Smith v. New Line Cinema*, No. 03 Civ. 5274(DC), 2004 WL 2049232 (S.D.N.Y. 2004) (screenplay writer's 43(a) action for lack of attribution against film company foreclosed by *Dastar*); *Williams v. UMG Recordings*, 281 F. Supp. 2d 1177, 1183 (C.D. Cal. 2003) (author's claim for attribution in connection with “story/screenplay” denied); *Zyla v. Wadsworth, Div. of Thomson Corp.*, 360 F.3d 243, 252 (1st Cir. 2004) (contributing author to text book has 43(a) claim for lack of attribution barred by *Dastar*); *Borrego v. BMG U.S. Latin*, No. 03-55430, 2004 U.S. App. LEXIS 6568, at **2-3 (9th Cir. 2004) (no reverse passing off claim for misattribution of songwriter's copyrighted songs).

³⁵⁰ See Michael Landau, *Dastar v. Twentieth Century Fox: The Need for Stronger Protection of Attribution Rights in the United States*, 61 *N.Y.U. Ann. Surv. Am. L.* 273, 305 (2005). Cf. Jane Ginsburg, *The Right to Claim Authorship in U.S. Copyright and Trademark Law*, 41 *Hous. L. Rev.* 263, 269 (2004) (describing the application of *Dastar* by lower courts to copyrighted works as “unflinching” but disagreeing with this trend).

³⁵¹ See Abraham Drassinower, *Capturing Ideas: Copyright and the Law of First Possession*, 54 *Clev. St. L. Rev.* 191 (2006) (comparing the theoretical basis of *Pierson v. Post*—the origin of the doctrine of “first possession”—and copyright protection). Compare Robert Williams, *The American Indian in Western Legal Thought* 315 (1990) (describing how discourses of origin in property law parallel discourses of colonialism, drawing examples from the “doctrine of discovery,” and the Law of Nations that gave “discovering” nations exclusive right to extinguish Indian title of occupancy).

³⁵² This does not mean, of course, that the first in time will necessarily have the right to exclusive use (noninfringing uses are available to all). But for all intents and purposes, the entity who gets to the desired property first,

This might not seem so terrible. The first to establish secondary meaning in a word, sign, or logo and use it in commerce, to conceive or reduce to practice an invention, or to express a work in a tangible medium, is the owner of that property and can exercise all the related statutory rights of exclusion under the United States intellectual property regimes. Nevertheless, *Dastar*'s rigid reliance on the meaning of "origin" in trademark law leaves a central goal of trademark law (i.e., protecting the public from confusion) unguarded. The Court's foray into "amateur psychology"³⁵³ to determine what consumers do and do not care about and its deficient reliance on copyright law for authorial attribution³⁵⁴ combine to leave the consumer guessing or misguided as to who is responsible for the representation on the film and of the film itself. Misattribution or non-attribution is a valuable business. "Misattribution . . . is valuable to those who engage in it precisely because it deceives the public."³⁵⁵ Unless the plaintiff can make out a false advertising claim under section 43(a)(1)(B),³⁵⁶ which is the only door the Court left explicitly open in its *Dastar* decision,³⁵⁷ the confused public loses out.³⁵⁸ Trademark law is said to strike a balance between the sovereign consumer and the fool,³⁵⁹ and yet *Dastar* obliterates

sufficiently captures consumer attention and stakes a claim (be it merely in name rather than by law) will be the entity with maximum capital and mobility and thus will "win" from the point of view of profit and reputation. For an eloquent essay on the "first in time" principle as applied to real property that mobilizes this origin story, see Carol Rose, *Property and Persuasion* 20 (1994) ("The common law gives preference to those who convince the world that they can catch the fish and hold it fast. This may be a reward to useful labor, but it is more precisely the articulation of a specific vocabulary within a structure of symbols understood by a commercial people. It is this commonly understood and shared set of symbols that gives significance and form to what might seem the quintessentially individualistic act: the claim that one has, by "possession" separated for one's self property from the great commons of unowned things.").

³⁵³ Lastowka, *supra* note __ at 1206.

³⁵⁴ *Id.* at 1213; Landau, *supra* note __ at 299-300.

³⁵⁵ Lastowka, *supra* note __ at 1227.

³⁵⁶ *Dastar*, 539 U.S. at 38.

³⁵⁷ Lastowka, *supra* note __ at 1208.

³⁵⁸ This, of course, presumes a confused or misled public in *Dastar* in the first place. See 15 U.S.C. § 1125(a)(1)(A) (requiring "false designation of origin, false or misleading description of fact . . . which is likely to cause confusion . . . as to the affiliation . . . or origin . . . of goods"). It is unclear from the facts of *Dastar* (or from one's sense of ordinary consumer behavior) whether consumers were or would be confused by the *Dastar* designation on the *Crusade* video.

³⁵⁹ Beebe, *supra* note __ at 2023-24.

trademark's weaker half—those of us who are sufficiently foolish to think (mis)attribution matters to the meaning, experience, and quality of the work, service, or good.³⁶⁰ *Dastar* instantiates the origin myth of trademark law by relying on its bygone roots in merchant guilds,³⁶¹ assuming the consumer is that efficient and disciplined agent in a market culture driven by demand for high quality and meaningful choices.

V. THE MYTH OF ORIGINS

One goal of this Article was to examine how intellectual property protection in the United States is structured around political origin myths. These origin myths justify certain hierarchies and power relations that might otherwise be considered problematic with appeals to authenticity and consent. They are also persuasive and attractive narratives because they explain particular property arrangements by relying on broader, affirmative themes of the American citizen and nation.

In the end, of course, it is not enough to say that origin stories structure United States intellectual property regimes. Understanding how these narratives work might be helpful to explain why certain cases come out as they do (or to encourage a certain outcome). This understanding might also help us become more critical of our intellectual property laws, insofar

³⁶⁰ The articles written on the importance of attribution rights are too numerous to list here. Examples include: Ginsburg, *supra* note __; Landau, *supra* note __; Kwall, *supra* note __; Catherine Fisk, *Credit Where Credit is Due*, 95 *Geo. L. J.* 49 (2006); Laura Heymann, *The Birth of the Authonym: Authorship, Pseudonymity, and Trademark Law*, 90 *Notre D. L. R.* 1377 (2005). Suffice it to say that misattribution matters when the author is publicly known (whether presently or historically) such that the work's value and meaning are authorized by the reputation of the author. If this is the case, under *Dastar*, a claim may be brought under 43(a)(1)(B) for false advertising which requires that the misrepresentation be material to consumers (we are buying the book because it originates from this well-known author). This cause of action is likely not available to authors who are less known and whose name does not serve a trademark or branding function and therefore whose absence from the marketing of the product does not matter to the purchasing public.

³⁶¹ Mark McKenna, *The Normative Foundations of Trademark Law*, 80 *Notre D. L. Rev.* 1839,1851 (2007) (discussing the history of trademark law as based on unfair competition with clearer source-designating properties

as we believe that our laws and legal adjudication should be driven by more than the allure of a shared narrative (especially when the shared nature of the narrative and its historical basis may be contested).

Moreover, origin myths are unstable, as are all narratives.³⁶² Indeed, the political origin myths animating our nation's intellectual property regimes appear dialectical.³⁶³ Origin myths tend to embrace beginnings as a legitimate status quo. But societies must inevitably change and grow. The above described origin myths are at once a manifestation of our culture's preoccupation with origins (and their beginnings as authentic and consensual) as well as examples of our ambivalence toward and struggle over these origins. Embedded in the political origin stories of innovation, creation, and identity is the diverging matter of how to advance and mature as a society. And the proliferation of intellectual property, ironically enough, is one way in which society evolves or so the story goes. Thus, the origin stories justifying intellectual property protection venerate mythic beginnings as well as defy them in the inevitable development of "new" origins or alternative sources of value. This dialectic exposes the myth of origins.³⁶⁴

By way of brief examples, consider a few recent developments in intellectual property

than exist today).

³⁶² The instability of language and narrative is what Roland Barthes called "readability" and what Jacques Derrida labeled a function of "difference" (*différance*). ROLAND BARTHES, *S/Z* 89 (Richard Miller trans., 1974). JACQUES DERRIDA, *WRITING AND DIFFERENCE* 280 (Alan Bass trans. 1978). "Readerly texts claim the power to produce new meanings in every new circumstance . . . , but at the same time they are concerned, if not to claim a single univocal sense as central to their meaning, then at least to define the range of possible meanings that they can admit, to the exclusion of other possible meanings and relevances." ROSS CHAMBERS, *STORY AND SITUATION: NARRATIVE SEDUCTION AND THE POWER OF FICTION* 26 (1984).

³⁶³ I mean to refer here to the structure of a dialectic — thesis, antithesis and synthesis — which almost always leads to change, revolutionary or otherwise.

³⁶⁴ To be sure, most litigated cases expose competing origin stories, as the above stories of *QLT v. MEEI* and *Veck v. SBCCI* demonstrate. Litigators spar over whose story will dominate. The fact that two different origin stories can be told about the same intellectual property suggests that there is no true origin, just stories. But this should not be surprising given the socially constructed nature of legal protection in the first place.

law that appear to move away from the protection of origins as the above origin myths describe them. The pending Patent Reform Act of 2007 proposes to change the “first to invent” standard into a “first to file” standard.³⁶⁵ Under this new law, the inventor would not be the person who first conceived of the invention and reduced it to practice, but instead the person who first filed the patent describing the invention with the United States Patent Office. Criticism of this change abounds, from its unconstitutionality to its inefficiency.³⁶⁶ Some say, however, that the United States should give up its ideals of individualized rewards and move toward a “centralized innovation reward system” that the first-to-file would provide,³⁶⁷ thus harmonizing its patent system with Europe and Japan.

Copyright has its proposed revolutions too. The Open Access movement offers alternative structures for protecting and encouraging the creation of scholarship.³⁶⁸ Increasingly, copyright holders are participating in the Open Access movement by relinquishing some of the sticks in their bundle of copyright in exchange for other rights they would rather have. For example, through the use of a Creative Commons license, which grants a royalty-free non-exclusive license to copy, transmit, and distribute the work in exchange for a promise of attribution to the author, copyright holders are asserting attribution rights, which the Copyright Act lacks, over the right to exclude.³⁶⁹

³⁶⁵ Patent Reform Act of 2007, H.R. 1908, S. 1145, 110th Cong.

³⁶⁶ David L. Simon, *The First-to-File Provisions of the Patent Reform Act of 2005 Violate the Constitution’s Intellectual Property Clause*, available at http://papers.ssrn.com/sol3/papers.cfm?abstract_id=841404. Brad Pederson & Vadim Braginsky, *The Rush to a First-to-File Patent System in the United States: Is a Globally Standardized Patent Reward System Really Beneficial to Patent Quality and Administrative Efficiency?*, 7 *Minn. J. L. Sci & Tech.* 757 (2006).

³⁶⁷ Pederson & Braginsky, *supra* note __ at 762.

³⁶⁸ Nicholas Bramble, *Preparing Academic Scholarship for an Open Access World*, 20 *Harv. J.L. & Tech.* 209 (2006).

³⁶⁹ For an example of a typical Creative Commons license, see <http://creativecommons.org/licenses/by/2.5/>. Other changes in copyright law, although not as recent, suggest a shift away from the mystical author-function as originating source of the creative expression (and therefore the justification for copyright protection). For example, Joseph Liu discusses how the 1976 Copyright Act (and later amendments) incorporated highly complex industry-

Trademark law is undergoing its own transformations. The Federal Trademark Dilution Act of 1995, which added section 43(c) to the Lanham Act,³⁷⁰ has caused much skirmishing among the legislative and judicial branches, academics, and corporations. When congress expanded the bundle of rights that trademark law protects by codifying into federal law an anti-dilution right which had previously only existed in state law, the Supreme Court responded by narrowly circumscribing that right requiring strict proof requirements to prevail.³⁷¹ Congress responded three years later with the Trademark Dilution Revision Act of 2006 to reverse the Supreme Court's reading of the Lanham Act.³⁷² This debate over dilution revolves around the scope of trademark protection: whether trademark law protects the source-designating function of the mark (the relationship between the mark and the manufacturer in the marketplace) or whether the mark itself is a "right in gross" such that a trademark owner can exclude another from using a famous mark even in the absence of consumer confusion over source.³⁷³

How do these changes to patent, copyright, and trademark law speak to the origin myths each intellectual property regime instantiates? Do they signal a different narrative, a movement

specific exemptions and compulsory licensing provisions in response to industry practices and heavy lobbying efforts. Moving away from "the traditional property rights" model of copyright to "regulatory copyright" shifts the discourse from authors as sources to be protected and incentivized to specific industries (and complex business organizations) as sources to be both safeguarded and managed. See Joseph Liu, *Regulatory Copyright*, 83 North Carolina L. R. 87, 127-133 (2004).

³⁷⁰ 15 U.S.C. § 1125(c).

³⁷¹ *Moseley v. Victoria Secret Catalogue, Inc.*, 537 U.S. 418, 433 (2003).

³⁷² Trademark Dilution Revision Act of 2006, H.R. 683, 109th Cong. (2006). Cf. Barton Beebe, *A Defense of the New Federal Trademark Antidilution Law*, 16 Fordham Intell. Prop. Media & Ent. L.J. 1143 (2006).

³⁷³ Brian Landry, *From Book Covers to Domain Names: Searching for the True Meaning of the Cliffs Notes Temporal Test for Parody*, 7 J. High Tech. L. 19 (2007); Graeme B. Dinwoodie, *The Rational Limits of Trademark Law in U.S. Intellectual Property: Law and Policy* 59, 73 (2006); Monica Hof Wallace, *Using the Past to Predict the Future: Refocusing the Analysis of a Federal Dilution Claim*, 73 U. Cin. L. Rev. 945, 988 (2005). See also *Avery Dennison Corp. v. Sumpton*, 189 F.3d 868, 875 (9th Cir. 1999) (noting dilution actions "tread very close to granting 'rights in gross'" in trademarks).

Other skirmishes in trademark law involve the scope of trade dress protection, on which the Supreme Court has opined several times over the past decade years interpreting the Lanham Act to narrowly circumscribe the scope of trade dress protection in light of the functionality doctrine. See *Qualitex Co. v. Jacobson Prods.*, 514 U.S. 159 (1995); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992); *Wal-mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 213-215 (2000). See also Dinwoodie, *supra* at 60-68.

away from the veneration of mystical beginnings? The patent reform still protects “firsts” but of a different kind, less the mad scientist and more the entity with the wherewithal to get to PTO ahead of everyone else. The Creative Commons license appears to venerate the romantic author, protecting her name and reputation rather than her pocketbook. And the amendments to the Lanham Act, that broaden the scope of trademark protection beyond that which concerns consumers in their search for goods, still signal an origin, except not one that is located among consumer relations in the marketplace but one that is the chattel that the mark has become. Do these changes reflect competing notions of “origin” worthy of protection under the law, or contrasting notions of value, or more of the same? We cannot know until we investigate the values these changes protect in light of the stories they tell, the entities they benefit, and the heroes they glorify.

What we do know from the above analysis is that while political origin myths may structure and explain the current statutory intellectual property regimes in the United States, their stories of innovation, creativity, and identity (engines of change and transformation) also manifest a dialectic that exposes the inevitability of competing origin stories in law and culture.³⁷⁴ Assuming that one basis of intellectual property protection is to encourage innovation, creativity, and the technological and economic development of our society, the more intellectual property proliferates and affects our culture, the farther it travels from its origins, and the farther we travel from ours. In other words, the seductively powerful but unstable influence of narrative reasoning explains how current intellectual property regimes communicate their stated goals of

³⁷⁴ See, e.g., Robert Merges, *Locke Remixed* ;-), 40 U.C. Dav. L. R. 1259, 1269 (2006) for an example of putting competing narratives to use to justify copyright protection over original expressive content that is used as the basis of a remix. See also Michael Madison, *Comment: Where Does Creativity Come From? And Other Stories of Copyright*, 53 Case W. L. R. 747, 769 (2003) for a rich example of how varied narratives about authorship and the incentive to create structure copyright disputes.

economic and social development while simultaneously protecting and venerating origins of human endeavor (inventions, creative expression and a market for commercial goods). In this way, the origin stories of intellectual property are the mechanisms by which one area of law works to both embrace its founding and overcome its limitations to move forward. When spun to their conclusions, the origin myths of intellectual property law expose the myth of origins.