

HOISTING ORIGINALITY*Joseph Scott Miller**

“[I]t goes a bit far to deny that genius ever exists. Artists do, at times, exceed conventions, and new things occasionally arise. Yet, the point here is that copyright law does not require genius as the foundation for protection.” David Nimmer, *Copyright in the Dead Sea Scrolls: Authorship and Originality*, 38 HOUS. L. REV. 1, 185 (2001).

“What looms behind the door marked ‘originality’ is a question that is rarely acknowledged by courts and never definitively answered: what exactly is the purpose of copyright law? What values are we protecting and why?” Diane L. Zimmerman, *It’s an Original!(!): In Pursuit of Copyright’s Elusive Essence*, 28 COLUM. J.L. & ARTS 187 (2005).

“With greater rights come more stringent requirements for obtaining the rights.” John F. Duffy, *Inventing Invention: A Case Study of Legal Innovation*, 86 TEX. L. REV. 1 (2007).

Copyright is everywhere. So is infringement. Indeed, we are an infringement nation,¹ covered in a billowing white goo of copyright entanglements.² I am moved to ask: Are we well served, today, by the conventional view³ that copyright’s statutory originality threshold is extremely low?

Copyright did not always permeate our daily lives so thoroughly. Copyright’s current sweep results from at least three decades of significant expansion along both legal and technological dimensions, as a number of scholars have described in detail.⁴ Copyright laws now seem designed to catch up as much expressive material as possible, no matter how trivial or pedestrian: copyright attaches at the moment “original” expression is “fixed in any tangible medium of expression,”⁵ without any

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¹ John Tehranian, *Infringement Nation: Copyright Reform and the Law/Norm Gap*, 2007 Utah L. Rev. 537, 543 : “We are, technically speaking, a nation of constant infringers.” See also Tim Wu, *Tolerated Use*, 31 COLUM. J.L. & ARTS 617, 617 (2008) (footnote omitted): “Copyrighted works are today used in many ways they once were not. There is a giant ‘grey zone’ in copyright, consisting of millions of usages that do not fall into a clear category but are often infringing. These usages run the gauntlet, from powerpoint presentations, personal web sites, social networking sites, church services, and much of wikipedia’s content to well-known fan guides.”

² Jessica Litman, *Billowing White Goo*, 31 COLUM. J.L. & ARTS 587, 596 (2008): “Bounded copyright rights have flowed out all over the place like so much frozen yogurt until the terrain is completely covered by billowing white goo. What used to be five or six discrete exclusive rights is morphing into an all-purpose general use right, and our understanding of copyright is evolving into the view that any use of a copyrighted work that is not authorized by the copyright owner or the statute is infringement.”

³ See, e.g., *Yurman Designs, Inc. v. PAJ, Inc.*, 262 F.3d 101, 109 (2d Cir. 2001).

⁴ In addition to Tehranian, Wu, and Litman, *supra* notes 1 and 2, see JAMES BOYLE, *THE PUBLIC DOMAIN: ENCLOSING THE COMMONS OF THE MIND* (2008) (especially chapter 3); NEIL WEINSTOCK NETANEL, *COPYRIGHT’S PARADOX* (2008) (especially chapter 4).

⁵ 17 U.S.C. § 102(a).

need to first comply with a notice requirement or other formality.⁶ And the legal wrong at the heart of copyright – unauthorized copying – is easier to prove than one might imagine: *unconscious* copying is actionable,⁷ and ubiquitous network connectivity can make it easier than ever to show – relying on the fact of widespread dissemination⁸ – that an accused infringer had access to a given copyrighted work.⁹ Indeed, technological change is as much a part of copyright’s conquest of daily life as any legal rule. Low-cost computers (with word processing, e-mail, photo, music, drawing, and browsing applications) linked to a global, high-speed communications network routinely transform us into gushing copyright and infringement fountains.¹⁰

Numerous scholars have proposed legal changes to restrain, or better manage, copyright’s now-daunting scope. Many have proposed new approaches to copyright’s infringement doctrines, urging that we tighten or refocus the “substantial similarity” inquiry;¹¹ better sensitize the fair use inquiry to key incentive or market

⁶ David Nimmer lucidly details this expansive range of copyright coverage, with “protection [that] applies equally to works of ‘high authorship’ and to works of emphatically ‘low authorship.’” David Nimmer, *Copyright in the Dead Sea Scrolls: Authorship and Originality*, 38 HOUS. L. REV. 1, 177, 177-185 (2001) (using series of telescoped pyramid figures to canvass copyright’s expansive scope).

⁷ *ABKCO Music, Inc. v. Harrisongs Music, Ltd.*, 722 F.2d 988, 997-98 (2d Cir.1983); *Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 483-484 (9th Cir. 2000); *Fred Fisher, Inc. v. Dillingham*, 298 F. 145, 147-48 (S.D.N.Y. 1924) (Hand, L.). For a spirited analysis of the unconscious copying doctrine, see Christopher Brett Jaeger, Note, “*Does That Sound Familiar??: Creators’ Liability for Unconscious Copyright Infringement*,” 61 VAND. L. REV. 1903 (2008).

⁸ See, e.g., *Boisson v. Banian, Ltd.*, 273 F.3d 262, 270 (2d Cir. 2001) (“Access may be established directly or inferred from the fact that a work was widely disseminated or that a party had a reasonable possibility of viewing the prior work.”); *Three Boys Music*, 212 F.3d at 482 (“Circumstantial evidence of reasonable access is proven in one of two ways: (1) a particular chain of events is established between the plaintiff’s work and the defendant’s access to that work (such as through dealings with a publisher or record company), or (2) the plaintiff’s work has been widely disseminated.”).

⁹ See Ann Bartow, *Copyrights and Creative Copying*, 1 U. OTTAWA L. & TECH. J. 75, 83-84 (2003-04): “[T]he interests of creative people are somewhat compromised by the voluminous flow of information facilitated by the internet. This is because if access to a work is proven or demonstrably likely, the degree of similarity required to constitute copyright infringement is lessened, and the internet often provides excellent access.”

¹⁰ See James Gibson, *Once and Future Copyright*, 81 NOTRE DAME L. REV. 167, 214-15 (2005) (footnotes omitted): “[T]he everyday use of computer technology routinely results in unauthorized reproduction, adaptation, distribution, performance, and display of digitized content. Several courts have held, for example, that loading a program or file into a computer’s active RAM memory constitutes copying for the purposes of copyright law, despite legislative history that seems to support a contrary result and vociferous dissent from copyright commentators. Under these holdings, every time a copyrighted work is so much as viewed on a computer screen, the viewer needs either the permission of the copyright holder or the protection of a privilege—even if the disk or file from which the image is summoned was made with the copyright owner’s permission and was lawfully purchased. Even if RAM copies do not implicate copyright’s exclusive rights, a host of other common computer activity does, from forwarding e-mail, backing up data, and printing a hard copy of an online document to caching frequently accessed files, cataloging Internet sites, and webcasting one’s travels.” See also BOYLE, *supra* note 4, at 51; JESSICA LITMAN, *DIGITAL COPYRIGHT* 178 (2001)

¹¹ See Bartow, *Creative Copying*, *supra* note 9, at 92-102; Lydia Pallas Loren, *The Pope’s Copyright? Aligning Incentives With Reality By Using Creative Motivation to Shape Copyright Protection*, 69 LA.

conditions;¹² trim the copyright owner’s right to control the preparation of derivative works;¹³ or profoundly restructure copyright as an unfair competition regime.¹⁴ These proposals, with their enforcement focus, do not reduce the sheer number of copyrighted works. Others scholars tackle the question at the front end, proposing that we restore formalities that would forestall copyright rights from attaching in the first place,¹⁵ or develop an explicit minimum-size principle that defines a copyrightable “work,”¹⁶ the statutory unit of protection.¹⁷ Still others – most notably, the Creative Commons project and the Free Software Foundation’s General Public License – create tools that enable authors to signal others clearly that they have a more modest set of enforcement intentions than copyright’s defaults provide.¹⁸

It is interesting, however, that no one has seriously explored using copyright’s central *sine qua non* – originality¹⁹ – as a policy lever with which to slow the accumulation of copyrighted works. This gap in copyright commentary is all the more curious because, even after the Supreme Court’s definitive tug upward on originality’s *constitutional* minimum in *Feist* (reasserting a creativity component to originality),²⁰ many courts continue to treat the *statutory* originality requirement as decidedly low.²¹ The two need not be the same, and there is certainly ample room to

L. REV. 1, 36-38 (2008).

¹² See Loren, *supra* note 11, at 38-40; Justin Hughes, *Copyright and Incomplete Historiographies: Of Piracy, Propertization, and Thomas Jefferson*, 79 S. CAL. L. REV. 993, 1076-82 (2006); Gideon Parchomovsky & Kevin A. Goldman, *Fair Use Harbors*, 93 VA. L. REV. 1483 (2007); Wu, *supra* note 1, at 630-33.

¹³ See Lydia Pallas Loren, *The Changing Nature of Derivative Works in the Face of New Technologies*, 4 J. SMALL & EMERGING BUS. L. 57, 76-92 (2000); Wu, *supra* note 1, at 630-33.

¹⁴ Jessica Litman, *Revising Copyright Law for the Information Age*, 75 OR. L. REV. 19, 41 (1996) (proposing “recasting copyright as an exclusive right of commercial exploitation,” such that “[m]aking money (or trying to) from someone else’s work without permission would be infringement, as would large scale interference with the copyright holders’ opportunities to do so”); Sara K. Stadler, *Copyright as Trade Regulation*, 155 U. PA. L. REV. 899, 927-942 (2007).

¹⁵ See Gibson, *supra* note 10, at 221-29; Chris Sprigman, *Reform(Aliz)ing Copyright*, 57 STAN. L. REV. 485 (2004).

¹⁶ Justin Hughes, *Size Matters (or Should) in Copyright Law*, 74 FORDHAM L. REV. 575 (2005).

¹⁷ 17 U.S.C. § 102(a).

¹⁸ On the Creative Commons, see BOYLE, *supra* note 4, at ch. 8 (describing the Creative Commons project). Boyle is currently a member of the Creative Commons board. *Id.* at ix. On the General Public License, and free and open source software more generally, see YOCHAI BENKLER, *THE WEALTH OF NETWORKS: HOW SOCIAL PRODUCTION TRANSFORMS MARKETS AND FREEDOM* ch. 3 (2006).

¹⁹ Citations for the point are legion. For a concise example, see Leon R. Yankwich, *Originality in the Law of Intellectual Property (Its Meaning from a Legal and Literary Standpoint)*, 11 F.R.D. 457, 457 (1951): “[O]riginality is at the basis of the recognition of the rights of the author. It is the measure and boundary of protection.” According to his Federal Judicial Center biography, Judge Yankwich served as a U.S. District Court judge from 1935 to 1975. See <http://www.fjc.gov/history/home.nsf>.

²⁰ In *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991), the Supreme Court pruned off the line of circuit court cases holding that the Constitution’s originality requirement contained *no* creativity component: “Original, as the term is used in copyright, means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity.” *Id.* at 345.

²¹ See, e.g., *CCC Info. Servs. v. Maclean Hunter Market Reports*, 44 F.3d 61, 66 (2d Cir. 1994) (Leval, J.): “The thrust of the Supreme Court’s ruling in *Feist* was not to erect a high barrier of originality

hoist statutory originality’s creativity requirement higher.

Perhaps a fog remains of the widespread pre-*Feist* belief that originality meant only the absence of copying from another.²² As Professor Litman showed, when originality means *only* “not copied from someone else,” it is difficult to take the notion seriously, much less expect it to mark the copyrightability boundary crisply²³: “the very act of authorship in *any* medium is more akin to translation and recombination than it is to creating Aphrodite from the foam of the sea.”²⁴ That pre-*Feist* fog can obscure the idea that, once “originality” embraces creativity, the courts can (if appropriate) construe statutory originality to require more creativity,²⁵ even as the constitutionally necessary creativity minimum remains “extremely low.”²⁶

Perhaps, in addition, well-justified alarm at the prospect of a judicially imposed aesthetic orthodoxy – which Justice Holmes deployed to such powerful effect in the *Bleistein* circus poster case²⁷ – deters us from exploring whether we should demand more creativity as a condition for copyright protection. It makes little sense to consider demanding more creativity when we shouldn’t be measuring it, or comparing one work’s creativity to another, at all. The judiciary’s flight from aesthetic line-drawing endures,²⁸ and some would chase out all reference to creativity as a

requirement. It was rather to specify, rejecting the strain of lower court rulings that sought to base protection on the ‘sweat of the brow,’ that *some* originality is essential to protection of authorship, and that the protection afforded extends only to those original elements.”; Assessment Techs. of WI, LLC v. WIREdata, Inc., 350 F.3d 640, 643 (7th Cir. 2003) (Posner, J.): “Copyright law unlike patent law does not require substantial originality.”; Ets-Hokin v. Skyy Spirits, Inc., 225 F.3d 1068, 1073 (9th Cir. 2000): “The essence of copyrightability is originality of artistic, creative expression. Given the low threshold for originality under the Copyright Act, as well as the longstanding and consistent body of case law holding that photographs generally satisfy this minimal standard, we conclude that Ets-Hokin’s product shots of the Skyy vodka bottle are original works of authorship entitled to copyright protection.”

²² See, e.g., 1 PAUL GOLDSTEIN, COPYRIGHT: PRINCIPLES, LAW AND PRACTICE § 2.2.1, at 62 (1989): “For purposes of copyright protection, a work is original if, and to the extent that, it has not been copied from another source.”; Jessica Litman, *The Public Domain*, 39 EMORY L.J. 965, 1000 (1990): “Copyright’s threshold requirement of originality is quite modest. It requires neither newness nor creativity, but merely creation without any copying.”

²³ Litman, *supra* note 22, at 975, 1000-12.

²⁴ *Id.* at 966.

²⁵ Cf. 1 WILLIAM F. PATRY, PATRY ON COPYRIGHT § 2:8, at 2-13 (2007): “Critical elements of the statute are of the delegating type. These include the meaning of ... ‘original work of authorship’” in 17 U.S.C. § 102(a).

²⁶ *Feist*, 499 U.S. at 345; see also *id.* (“[E]ven a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, ‘no matter how crude, humble or obvious’ it might be.”).

²⁷ *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251-52 (1903). Professor Gorman called Holmes’ aesthetic nondiscrimination principle in *Bleistein* “[o]ne of the more enduring observations in all of copyright.” Robert A. Gorman, *Copyright Courts and Aesthetic Judgments: Abuse or Necessity?*, 25 COLUM. J.L. & ARTS 1, 1 (2001).

²⁸ See *Bucklew v. Hawkins, Ash, Baptie & Co.*, 329 F.3d 923, 929 (7th Cir. 2003) (Posner, J.): “That undemanding [originality] requirement is satisfied in this case; any more demanding requirement would be burdensome to enforce and would involve judges in making aesthetic judgments, which few judges are competent to make.”; *Esquire, Inc. v. Ringer*, 591 F.2d 796, 805 (D.C. Cir. 1978): “Neither the Constitution nor the Copyright Act authorizes the Copyright Office or the federal judiciary to

needless temptation to subjectivism.²⁹

But why assume that the only alternative to a minimalist creativity inquiry is a stifling aesthetic orthodoxy? Especially given that patent law's creativity threshold – nonobviousness³⁰ – is framed as the degree of the departure from orthodoxy, *i.e.*, what would have been obvious to the person having ordinary skill in the pertinent art at the time the invention was made?³¹ If we approach creativity *not* as “the degree to which this work shows good (*i.e.*, my) taste,” but rather as “the degree to which this work moves away from conventional expression for this genre at the time the author authors it,” a demand for more creativity would undermine aesthetic orthodoxy, not support it.

Whatever the reason for it, the apparent neglect of statutory originality as a policy lever for stemming the copyright flood ends with this essay. I do not suggest that the literature lacks for robust discussions of copyright's originality requirement, including its creativity component; there are many,³² and each has taught me a great deal. What existing commentary has yet to explore – and what I explore

serve as arbiters of national taste. These officials have no particular competence to assess the merits of one genre of art relative to another. And to allow them to assume such authority would be to risk stultifying the creativity and originality the copyright laws were expressly designed to encourage.”

²⁹ See Russ VerSteeg, *Originality and Creativity in Copyright Law*, in 1 INTELLECTUAL PROPERTY & INFORMATION WEALTH: ISSUES & PRACTICES IN THE DIGITAL AGE 1, 20 (Peter Yu ed., 2007): “Preferably, the federal judiciary will completely drop the term ‘creativity’ from its copyright vocabulary and replace it with an alternative term such as ‘material variation’ This interpretation is essential to avoid the uncertainty and chaos that will continue if federal judges persist in inventing their own vague, subjective, and amorphous definitions of ‘creativity.’”

³⁰ 35 U.S.C. § 103.

³¹ See generally *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007) (invalidating an adjustable gas pedal patent on the ground that the claimed invention would have been obvious).

³² See, e.g., Howard B. Abrams, *Originality and Creativity in Copyright Law*, 55 LAW & CONTEMP. PROBS. 3 (1992); Robert Brauneis, *The Transformation of Originality in the Progressive-Era Debate Over Copyright in News* (2008) (manuscript); Alan L. Durham, *The Random Muse: Authorship and Indeterminacy*, 44 WM. & MARY L. REV. 569 (2002); Gorman, *Aesthetic Judgments*, *supra* note 27; Jeffrey L. Harrison, *Rationalizing the Allocative/Distributive Relationship in Copyright*, 32 HOFSTRA L. REV. 853 (2004); Paul J. Heald, *Reviving the Rhetoric of the Public Interest: Choir Directors, Copy Machines, and New Arrangements of Public Domain Music*, 46 DUKE L.J. 241 (1996); Paul J. Heald, *The Vices of Originality*, 1991 SUP. CT. REV. 143; Justin Hughes, *The Personality Interest of Artists and Inventors in Intellectual Property*, 16 CARDOZO ARTS & ENT. L.J. 81 (1998); Peter Jaszi, *Toward a Theory of Copyright: The Metamorphoses of “Authorship,”* 1991 DUKE L.J. 455; Roberta Rosenthal Kwall, *Originality in Context*, 44 HOUS. L. REV. 871 (2007); Douglas Lichtman, *Copyright as a Rule of Evidence*, 52 DUKE L.J. 683 (2003); Michael D. Murray, *Copyright, Originality, and the End of the Scènes à Faire and Merger Doctrines for Visual Works*, 58 BAYLOR L. REV. 779 (2006); Nimmer, *supra* note 6; Dale P. Olson, *Copyright Originality*, 48 MO. L. REV. 29 (1983); Pamela Samuelson, *The Originality Standard for Literary Works Under U.S. Copyright Law*, 42 AM. J. COMP. L. SUPP. 393 (1994); David E. Shipley, *Thin But Not Anorexic: Copyright Protection for Compilations and Other Fact Works*, 15 J. INTELL. PROP. L. 91 (2007); Russ VerSteeg, *Rethinking Originality*, 34 WM. & MARY L. REV. 801 (1993); Mary Campbell Wojcik, *The Antithesis of Originality: Bridgeman, Image Licensors, and the Public Domain*, 30 HASTINGS COMM. & ENT. L.J. 257 (2008); Alfred C. Yen, *The Legacy of Feist: Consequences of the Weak Connection Between Copyright and the Economics of Public Goods*, 52 OHIO ST. L.J. 1343 (1991); Diane Zimmerman, *It's an Original!(!): In Pursuit of Copyright's Elusive Essence*, 28 COLUM. J.L. & ARTS 187 (2005).

here – is the way we can draw on patent law’s nonobviousness requirement, with its focus on departure from conventional wisdom as the mark of a protectable invention, to dissolve the sterile dichotomy between near-total abdication and oppressive aesthetics that Holmes posed in *Bleistein*.³³ Specifically, we can focus copyright protection on encouraging those who experiment with expression to push against, and even break past, the norms and conventions of routine expression that dominate a given genre at a given time. Such creative experimentation has greater need of protection against purely imitative copying: when it sparks a strong positive response from the public, it makes a highly salient, attractive target for predatory imitation. We also receive a greater benefit from inducing investment in unconventional expression: such expression does more to advance knowledge and learning than does pedestrian, convention-bound expression.

It is a good time for copyright to take inspiration from patent’s nonobviousness doctrine. Just two years ago, in the *KSR* case, the Supreme Court fundamentally re-examined the workings of the nonobviousness inquiry for the first time since 1976.³⁴ Considering *KSR* alongside *Feist*, as I do here, proves fruitful. First, I consider the basic justification for hoisting originality to a more demanding level. The dynamic is straightforward: the stronger the exclusion right, the harder it should be to obtain. Copyright has grown stronger, and should be harder to obtain. Second, I recount key judicial events in the history of copyright’s demand for creativity as a condition of protection, including its sharp downturn in *Bleistein*, *Bleistein*’s nadir in *Alfred Bell*, and creativity’s revival in *Feist*. Third, I turn to two key judicial events in the history of patent law’s demand for creativity as a condition of protection: the creation of the nonobviousness requirement in 1851 (and its striking similarity to copyright doctrine of the day); and the requirements renewal in *KSR*. Finally, I consider how a patent-inspired approach to copyright’s creativity requirement – one focused on the degree to which the work in question departs from

³³ Littrell argues that the courts should impose a higher originality standard. Ryan Littrell, Note, *Toward a Stricter Originality Standard for Copyright Law*, 43 B.C. L. REV. 193 (2001). The only affirmative statement he offers for *how* to raise the originality standard is as follows: “Judges, then, should employ aesthetic pragmatism in originality cases.” *Id.* at 225. Moreover, the piece does not analogize copyright’s originality to patent’s nonobviousness.

In a pre-*Feist* piece, Professor Wiley *does* analogize originality to nonobviousness, and in a provocative way. John Shepard Wiley Jr., *Copyright at the School of Patent*, 58 U. CHI. L. REV. 119 (1991). Though I agree with Wiley that exploring the comparison has great value, I differ with him on some key particulars. First, he urges that trial testimony about originality focus on the question of the adequacy of the incentive to create with, or without, copyright. *Id.* at 148-49. This is sensible, he contends, because the core question *is* one of incentives: “Copyright courts, then, should define as original any work whose creation requires enough effort to deter the creative act absent the copyright’s exclusive promise.” *Id.* at 148. Second, he argues that the accused infringer, not the copyright plaintiff, should bear the burden of proof on the question of originality, *id.* at 151, and, relatedly, that “[c]ourts should be modest ... about their ability to second-guess an author’s willingness to create without the promise of copyright,” *id.* at 150 I cannot square his conclusions with the Supreme Court’s decision in *Feist*. *Feist* both expressly condemns an effort-focused approach to originality and puts the burden to prove originality on the infringement plaintiff. 499 U.S. at 353-54, 361.

³⁴ In the October 1975 Term, the Court decide two nonobviousness cases, *Dann v. Johnston*, 425 U.S. 219 (1976), and *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273 (1976).

the prevailing conventions of its form – allows one to demand more creativity without ushering in a stifling orthodoxy. This approach also unites seemingly disparate exclusions from copyright coverage, such as *scènes à faire*; utility-driven design choices in what would otherwise be protectible pictorial, graphic, or sculptural works; conventional musical arrangements; and works in which, to paraphrase the *Bender* case, faithful depiction of an item external to the work is the work’s central expressive value.³⁵

I. STRONGER EXCLUSION RIGHTS NEED HIGHER THRESHOLDS

Copyright’s conquest of daily life, rooted in both legal and technological change, invites the question: Should we raise the statutory originality standard higher, above the “extremely low” creativity minimum that *Feist* requires? Assume, for the moment, we can find a way to determine whether a work embodies more than a bare modicum of creativity *without* converting copyright into an elite taste code. Is it advisable to do so, as a matter of fitting means to ends?

In the Anglo-American tradition’s utilitarian approach to these matters, intellectual property rights to exclude reduce access today in the hope of more products of the mind tomorrow. In addition, because tomorrow’s creations are built, in part, from today’s and yesterday’s, perfect exclusion would block too much of the work of others and thus be self-defeating. (Put another way, behind the veil of ignorance about whether we will be net creators or net consumers of products of the mind, we would choose less-than-perfect control.) A key sign that we embrace far-from-perfect control is the settled idea that society generally should demand more pronounced creative acts in exchange for stronger exclusion rights (or, contrariwise, demand less pronounced creative acts in exchange for weaker exclusion rights).

Many have noted the strength/justification link. Professor Goldstein, from his vantage point in 1989 – pre-*Feist*, pre-web, pre-ubiquitous-laptops, and pre-high-speed-connectivity – expressly linked copyright’s *lower* originality standard (defined merely as the absence of copying) to copyright’s *less powerful* exclusion rights. According to Goldstein,

One purpose of copyright is to encourage the production of the / widest possible variety of literary, musical and artistic expression. The originality requirement helps to achieve this purpose by allowing protection for works that differ only minimally from earlier works. Copyright law’s originality standard is thus far less exacting than patent law’s counterpart standards of novelty and nonobviousness The aim of copyright law is to direct investment toward the production of abundant information, while the aim of patent law is to direct investment toward the production of efficient information. The relatively lax originality standard aims at the first object, while patent law’s novelty and nonobviousness requirements aim at the second.³⁶

Similarly, Professor Olson, from a still-earlier vantage point in 1983, called out the same relationship between lower creativity threshold and lesser exclusion power:

Copyright is a severely limited form of protection. That is not to say that a copyright cannot be valuable, but what is protected by copyright is sufficiently narrow

³⁵ See *Matthew Bender & Co. v. West Publ’g Co.*, 158 F.3d 674, 688 (2d Cir. 1998).

³⁶ GOLDSTEIN, *supra* note 21, § 2.2.1 at 63-64.

that in assessing the originality standards to be applied in determining whether copyright should be granted it is important not to lose sight of the nature of copyright protection. The limited nature of copyright protection also requires an emphatic rejection of any comparison with patents, either in the standards to be applied in protecting works in which copyright is claimed or in identifying the parameters of copyright protection.³⁷

Today – more than 25 years later – copyright is no longer the “narrow” exclusion right Olson described. Comparison to patent law’s nonobviousness standard no longer seems out of place.

Patent commentary makes the same link. In his illuminating study of the nonobviousness doctrine’s history, Professor Duffy examines the exclusion/threshold relationship at some length. Patent law forbids reproducing the claimed invention without regard to independent creation (or not); and it protects the claimed practical idea across differing embodiments of that idea, not merely a particular expression of the idea. These *stronger* exclusion rights warrant *more exacting* threshold requirements. As Duffy explains,

[t]he differences in scope of patents and copyrights have long been thought to justify requiring very different levels of creativity to obtain the rights. Because patents preclude more than just copying, patent law has always required novelty as a substantial element of the creative standard that must be met. ... The broader scope of patent rights may also seem to provide an easy justification for the nonobviousness doctrine. The intuition is that compared to copyrights, patent rights place much greater restrictions on the freedom of others, and thus, more is demanded from the inventor than from the author. With greater rights come more stringent requirements for obtaining the rights. This justification suggests that if patent law granted narrower rights and allowed independent creation as a defense, the standard of creativity could sensibly be set lower.³⁸

It is copyright that has grown stronger over time, not patent law that has grown weaker.

In theory, copyright prohibits only the copying of a protected work, not the independent creation of the same or a similar work. But the unconscious copying doctrine, combined with widespread access to pervasive networked content, has hollowed out the independent creation defense.³⁹ The ease with which we can generate conventional expression only compounds the exclusion power of readily proved access and the theory of unconscious copying. Nor is it much of an answer to say that the high cost of litigation keeps the worst erroneous (or predatory) infringement claims at bay. Expression deterred by (perhaps unfounded) worry over wrongful claims, and saber-rattling letters from lawyers, fly under the radar.

Doctrinal and technological changes thus point toward a higher creativity threshold for copyright. Assuming we can both hoist originality and avoid a deadening aesthetics code, we should use case-based elaboration of the statutory standard

³⁷ Olson, *supra* note 31, at 34.

³⁸ John F. Duffy, *Inventing Invention: A Case Study of Legal Innovation*, 86 TEX. L. REV. 1, 9-10 (2007).

³⁹ See Bartow, *supra* note 9, at 83-84.

to move copyright law in patent law's direction. Indeed, courts did so in adapting copyright to changing news technologies, in the early 1900s.⁴⁰ To be clear, I do *not* think that copyright's originality should demand as strong a creativity showing as patent's nonobviousness. Patent law's focus on practical problem-solving, and the patent racing and opportunism this focus engenders, justify a high creativity threshold indeed.⁴¹ Copyright law can, however, demand more creativity – keeping the originality standard responsive to legal and technological changes over the past 30 years – and still impose a requirement more modest than patent law's.

II. COPYRIGHT'S CREATIVITY DEMAND

The road to *Feist* is long. With hundreds of originality cases on which to ground discussion, any selected history rightly provokes at least a little skepticism. Many cases and commentaries, however, reflect that the cases I discuss here are the landmarks along the road to *Feist*.

A. *Early Rumbblings*

The Supreme Court did not decide a case that turned squarely on copyright's creativity threshold until 1884 (in the *Sarony* case⁴²), almost a century after Congress enacted our first copyright statute.⁴³ The lower courts, however, heard copyright cases turning on what we now know as the originality requirement. Two decisions from that era are noteworthy here.

The first of these is *Emerson v. Davies*.⁴⁴ Justice Story, riding circuit, judged Charles Davies' arithmetic book to infringe Frederick Emerson's copyright in his own arithmetic book.⁴⁵ Story turned first to the question whether Emerson's "book contain[ed] any thing new and original, entitling him to a copy-right."⁴⁶ Story concluded that Emerson's book was original, for copyright purposes, because it was clear that Emerson had not wholly copied his work from a pre-existing arithmetic book:

He, in short, who by his own skill, judgment and labor, writes a new work, and does not merely copy that of another, is entitled to a copy-right therein; if the variations are not merely formal and shadowy, from existing works. He, who constructs by a new plan, and arrangement, and combination of old materials, in a book designed for instruction, either of the young, or the old, has a title to a copy-right, which cannot be displaced by showing that some part of his plan, or arrangement or combination, has been used before.⁴⁷

Story thus stressed the presence of the copyright owner's independent labor, and the absence of copying from another, in upholding Emerson's claim. He relied on independent labor, he explained, because every expressive work owes a debt of influence, and has some resulting similarity, to other expressive works. According to

⁴⁰ See Brauneis, *supra* note 32, at 23-32.

⁴¹ See Duffy, *supra* note 38, at 12-16.

⁴² *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884).

⁴³ Act of May 31, 1790, 1 Stat. 124.

⁴⁴ 8 F. Cas. 615 (C.C.D. Mass. 1845) (No. 4436) (Story, J.).

⁴⁵ *Id.* at 625.

⁴⁶ *Id.* at 618.

⁴⁷ *Id.* at 619.

Story,

in literature, in science and in art, there are, and can be, few, if any, things, which, in an abstract sense, are strictly new and original throughout. Every book in literature, science and art, borrows, and must necessarily borrow, and use much which was well known and used before. . . . No man writes exclusively from his own thoughts, unaided and uninstructed by the thoughts of others. The thoughts of every man are, more or less, a combination of what other men have thought and expressed, although they may be modified, exalted, or improved by his own genius or reflection. If no book could be the subject of copy-right which was not new and original in the elements of which it is composed, there could be no ground for any copy-right in modern times, and we should be obliged to ascend very high, even in antiquity, to find a work entitled to such eminence.⁴⁸

Copyright could not succeed widely if it required the utterly-and-wholly-new, for such expression only rarely occurs. As Professor Zimmerman put it, “[w]hat Story seemed to mean by originality was something quite simple and straightforward: an original work could not be copied and must be created by relying on one’s own labor, skill and financial resources.”⁴⁹ The absence of copying that Story stressed remains one of originality’s two core components.⁵⁰

The second case of note here, decided five years after *Emerson*, is *Jollie v. Jacque*.⁵¹ Justice Nelson, riding circuit, denied an injunction on a musical composition copyright. Loder, the composition’s author, began with a musical work published in Germany and “expended much labor, time, and musical knowledge and skill, in preparing and producing” a much-improved work for use in a musical theater production.⁵² The Jacques denied infringing Loder’s rights, insisting that “the only similarity” between their work and Loder’s “consist[ed] in the melody, which, in both publications, was taken from a German composition, called ‘The Roschen Polka,’ which was well known and had been played by various bands in the city.”⁵³ An expert witness, noting that Loder’s work had been arranged for the piano and *Roschen Polka* was arranged for the clarinet, opined “that the adaptation to one instrument of the music composed for another, requires but an inferior degree of skill, and can be readily accomplished by any person practised in the transfer of music.”⁵⁴

Nelson concluded that he could not determine the copyrightability of Loder’s arrangement on the papers, and so set the matter over for a trial at law. First, he contrasted the copyrightable creativity that a new melody embodies from the lesser creativity embodied in “the adaptation of it, either by changing it to a dance, or by transferring it from one instrument to another”: “the original air [*i.e.*, melody] requires genius for its construction; but a mere mechanic in music, it is said, can

⁴⁸ *Id.* at 619.

⁴⁹ Zimmerman, *supra* note 32, at 200.

⁵⁰ See *Feist*, 499 U.S. at 345: “Original, as the term is used in copyright, means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity.”

⁵¹ 13 F. Cas. 910 (C.C.S.D.N.Y. 1850) (No. 7,437) (Nelson, J.).

⁵² *Id.* at 913.

⁵³ *Id.*

⁵⁴ *Id.*

make the adaptation or accompaniment.”⁵⁵ Next, building on the distinction between “genius” and the work of “a mere mechanic,” Nelson framed the originality question in the case this way:

The musical composition contemplated by the statute must, doubtless, be substantially a new and original work; and *not* a copy of a piece already produced, with *additions and variations, which a writer of music with experience and skill might readily make*. Any other construction of the act would fail to afford the protection intended to the original piece from which the [melody] is appropriated.⁵⁶

Although he lacked the expertise to determine whether Loder’s arrangement was the work of “a mere mechanic in music” and thus unprotectable – “[p]ersons of skill and experience in the art must be called in to assist in the determination of th[at] question”⁵⁷ – Justice Nelson plainly did not think Loder’s independent labor was enough, by itself, to earn copyright protection. Sufficient creativity, surpassing that of a mere mechanic, was also required.

A year after *Jollie*, Justice Nelson wrote another opinion that is central to my comparison of copyright to patent. I take up that patent law decision, *Hotchkiss v. Greenwood*,⁵⁸ below. Suffice it to say, for the moment, that Justice Nelson described patent law’s creativity threshold in the same terms he used in *Jollie*.⁵⁹ Our modern taboo against comparing originality to nonobviousness is just that – modern.

B. A High Bar

The *Emerson* and *Jollie* cases give us two strands for originality: independent effort (not mere copying), and an adequate amount of creativity. Two other cases from the 1800s – this time, Supreme Court cases – considered the kind of creative expression a work must embody to merit copyright protection. The first, like *Jollie*, suggests that patent and copyright require a similar type, if not the same amount, of creativity. The second involved a work that the Court put well above the minimum required level of creativity. Justice Miller wrote both unanimous opinions.

In *The Trade-Mark Cases*,⁶⁰ the Court overturned three convictions under the then-current federal trademark statute, concluding that Congress had overstepped its powers under the Progress Clause⁶¹ and the Commerce Clause.⁶² The case did not turn on copyright validity. The Court did, however, differentiate protectible trademark use from the achievements rewarded by patent and copyright. Establish-

⁵⁵ *Id.*

⁵⁶ *Id.* at 913-14 (emphasis added).

⁵⁷ *Id.* at 914.

⁵⁸ 52 U.S. 248 (1851). [for date, 13 L.Ed. 683]

⁵⁹ I learned of Justice Nelson’s decision in *Jollie*, and its similarity to *Hotchkiss*, at a talk Professors Brauneis and Duffy gave at DePaul Law School on August 10, 2007. Their talk, entitled *The Curious Divergence of Patent and Copyright Law*, directly inspired my project here, and I thank them for it. You can hear the talk at <http://www.law.depaul.edu/centers%5Finstitutes/ciplit/ipsc/schedule.asp>.

⁶⁰ 100 U.S. 82 (1879).

⁶¹ U.S. Const., Art. I, § 8, cl. 8 (empowering Congress “[t]o promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries . . .”).

⁶² U.S. Const., Art. I, § 8, cl. 3 (empowering Congress “[t]o regulate commerce with foreign nations, and among the several states, and with the Indian tribes . . .”).

ing a valid mark, the Court observed, “requires no fancy or imagination, no genius, no laborious thought. It is simply founded on priority of appropriation,” by use in commerce.⁶³ The trademark system’s frequent reliance on long-known words as marks is quite different from the patent system’s demand for an inventive product or process:

The ordinary trade-mark has no necessary relation to invention or discovery. The trade-mark recognized by the common law is generally the growth of a considerable period of use, rather than a sudden invention. It is often the result of accident rather than design, and when under the act of Congress it is sought to establish it by registration, neither originality, invention, discovery, science, nor art is in any way essential to the right conferred by that act.⁶⁴

Note that the Court both denied that “invention” is a necessary feature of a valid mark, and used the word “originality” – which we now associate so strongly with copyright – on a par with “invention,” the more patent-related term to the modern ear. The Court then found trademark as distant from copyright as it is from patent:

If we should endeavor to classify it under the head of writings of authors, the objections are equally strong. *In this, as in regard to inventions, originality is required.* And while the word *writings* may be liberally construed, as it has been, to include original designs for engravings, prints, &c., it is only such as are *original*, and are founded in the creative powers of the mind. The writings which are to be protected are *the fruits of intellectual labor*, embodied in the form of books, prints, engravings, and the like.⁶⁵

Once again, the Court used “originality” to denote creativity, in both copyright and patent. A century later, in *Feist*, the Court expressly relied on this portion of *The Trade-Mark Cases* to explain its conclusion that “originality requires independent creation *plus a modicum of creativity*.”⁶⁶

Five years after *The Trade-Mark Cases*, in *Burrow-Giles Lithographing Co. v. Sarony*,⁶⁷ the Court upheld the copyrightability of a photograph. Napoleon Sarony, the photographer, had taken a series of photographs of Oscar Wilde.⁶⁸ In Sarony’s infringement suit, the central issue was whether Congress had exceeded its Progress Clause power in extending copyright protection to photographs.⁶⁹ The Court consid-

⁶³ 100 U.S. at 94. In the same vein, the Court noted that “[t]he trade-mark may be, and generally is, the adoption of something already in existence as the distinctive symbol of the party using it.” *Id.* This remains true today. One type of mark – a fanciful mark – is a word fabricated especially for use as a mark, such as Kodak or Exxon. Coining such a mark takes some creativity, to be sure. But marks comprising well known words or symbols are also valid, so long as they are capable of distinguishing the mark owner’s good or service from the offerings of others. *See* 15 U.S.C. § 1127 (defining “trademark”). APPLE for computers (an arbitrary mark), TIDE for detergent (a suggestive mark), and COCA-COLA for soft drinks (a descriptive mark), all comprise words that existed long before the development of the products for which they serve as trademarks.

⁶⁴ 100 U.S. at 94.

⁶⁵ *Id.* (first emphasis added).

⁶⁶ 499 U.S. at 346 (emphasis added).

⁶⁷ 111 U.S. 53 (1884).

⁶⁸ You can see the photos at <http://www.humnet.ucla.edu/humnet/clarklib/wildphot/sarony.htm>; the photo at issue in *Burrow-Giles*, Sarony’s Wilde #18, is the sixth image on this web page.

⁶⁹ 111 U.S. at 56.

ered the expansion of federal copyright protection from its humbler beginnings in 1790 (covering maps, charts, and books) to its then-current embrace of photographs, dramatic or musical compositions, engravings, paintings, statues, and more.⁷⁰ The Court construed the key constitutional term, “writings,” to mean “literary productions . . . includ[ing] all forms of writing, printing, engraving, etching, &c., by which *the ideas in the mind of the author are given visible expression.*”⁷¹ Photographs plainly met this standard, at least “so far as they are representatives of original intellectual conceptions of the author.”⁷² And Sarony’s photograph of Wilde, the Court concluded, was “an original work of art, the product of [Sarony’s] intellectual invention.”⁷³ Specifically,

[t]he third finding of facts says, in regard to the photograph in question, that it is a “useful, new, harmonious, characteristic, and graceful picture, and that plaintiff made the same * * * entirely from his own original mental conception, to which he gave visible form by posing the said Oscar Wilde in front of the camera, selecting and arranging the costume, draperies, and other various accessories in said photograph, arranging the subject so as to present graceful outlines, arranging and disposing the light and shade, suggesting and evoking the desired expression, and from such disposition, arrangement, or representation, made entirely by plaintiff, he produced the picture in suit.”⁷⁴

In other words, “[t]he photograph by Sarony was one in which the author did not merely reproduce reality mechanically, but one where he manipulated it to achieve the desired effect.”⁷⁵ Given Sarony’s creative and graceful work, copyright attached.

Two things are clear from this brief survey. First, patent and copyright were not sharply disparate regimes. Both required creativity as a condition for protection, and words we now think of as contrasting terms of art – originality, and invention – served equally well for one another in the Court’s cases. Second, as Professor Zimmerman concluded from her survey of these and other cases, “they might well have suggested that, at the close of the nineteenth century, copyright was intended to promote socially valuable kinds of work that also exhibited some fairly high level of human imagination or intellectual input.”⁷⁶ Then came Holmes.

⁷⁰ *Id.* at 56-57.

⁷¹ *Id.* at 58 (emphasis added).

⁷² *Id.* The Court expressly reserved judgment on the question whether copyright could protect what it called “the ordinary production of a photograph,” *i.e.*, “the manual operation . . . of transferring to the [photographic] plate the visible representation of some existing object, the accuracy of this representation being its highest merit.” *Id.* at 59. As Professor Heald notes, *Sarony* “therefore provided no minimum baseline for its requirement of ‘original intellectual conception’ and clearly passed on the opportunity to declare purely mimetic works of image reproduction unoriginal and uncopyrightable.” Heald, *Vices, supra* note 32, at 148. More recently, a district court *did* hold such an art reproduction photograph unoriginal. *See Bridgeman Art Library, Ltd. v. Corel Corp.*, 36 F.Supp.2d 191 (S.D.N.Y. 1999); Wojcik, *supra* note 32.

⁷³ *Id.* at 60. The opinion equates “originality” and “invention” throughout this analysis, *id.* at 59-60, showing none of the modern fussiness at separating copyright from patent terminology as it repeatedly uses both words to refer interchangeably to copyright and patent requirements.

⁷⁴ *Id.* at 60.

⁷⁵ Zimmerman, *supra* note 32, at 201.

⁷⁶ *Id.*

C. *Departing the Field*

In *Bleistein v. Donaldson Lithographing Co.*,⁷⁷ the Court once again confronted the question whether copyright protected particular works – in this case, color posters used to advertise a circus.⁷⁸ The Sixth Circuit had denied copyright protection to the posters, extending a Supreme Court decision denying copyright protection to an ink bottle label⁷⁹ to preclude copyright protection for posters that “ha[ve] no other use than that of a mere advertisement, and no value aside from this function.”⁸⁰ The Supreme Court, Justice Holmes writing for seven, reversed.

There can be little doubt, after looking at the fanciful, florid circus posters from this era, that the posters in *Bleistein* readily met the creativity standard the Court expressed in *Sarony*.⁸¹ The posters are no less graceful and creative, in their own way, than *Sarony*’s photo of Wilde. Justice Holmes, however, sought to change the standard, rather than to apply it. Indeed, *Bleistein*’s “exceedingly low standard” of creativity “was the end of any effort to impose a meaningful threshold requirement for originality”⁸² until the Supreme Court renewed the effort in *Feist*.

Holmes made short work of the Sixth Circuit’s reasoning: “A picture is none the less a picture and none the less a subject of copyright that it is used for an advertisement.”⁸³ More important, he reoriented the originality inquiry from a work-centered creativity assessment (of the type used in *Sarony*) to an author-centered effort assessment (of the type used in *Emerson*). Beginning from the premise that multiple artists could each claim a valid copyright in their respective drawings of the same actual face,⁸⁴ he grounded copyright in the individual artist’s effort:

The copy [*i.e.*, the work] is the personal reaction of an individual upon nature. Personality always contains something unique. It expresses its singularity even in handwriting, and a very modest grade of art has in it something irreducible, which is one man’s alone. That something he may copyright unless there is a restriction in the words of the act.⁸⁵

The focus is, again, not on “the quality or quantity of authorial input,”⁸⁶ but on whether the work shows the author’s “personal reaction” – “something unique,” “something irreducible” – rather than a self-concealing imitation of another’s work.

⁷⁷ 188 U.S. 239 (1902).

⁷⁸ At http://libweb5.princeton.edu/visual_materials/Circus/TC093.html, you can see images of color circus posters from the late 1800s and early 1900s. Sadly, the site does not have images of Wallace Show posters. However, a search for “Great Wallace Shows” on Google’s image search page will usually turn up images of the sorts of posters at issue in the Supreme Court case.

⁷⁹ *Higgins v. Keuffel*, 140 U.S. 428, 431 (1891).

⁸⁰ 104 F. 993, 996 (6th Cir. 1900).

⁸¹ See PAUL GOLDSTEIN, *COPYRIGHT’S HIGHWAY: FROM GUTENBERG TO THE CELESTIAL JUKEBOX* 49 (rev. ed. 2003): “The creativity criterion that the Supreme Court had adopted in the *Oscar Wilde* case offered a tempting dividing line between copyrightable and uncopyrightable subject matter, and would certainly have sustained copyright in the elaborate circus posters.”

⁸² Zimmerman, *supra* note 32, at 203, 204.

⁸³ 188 U.S. at 251.

⁸⁴ *Id.* at 249.

⁸⁵ *Id.* at 250.

⁸⁶ Zimmerman, *supra* note 32, at 202.

And the merit of protection the author’s effort, in a case such as this, is only underscored by the accused infringer’s desire to make unauthorized copies of the work: “That these pictures had their worth and their success is sufficiently shown by the desire to reproduce them without regard to the plaintiffs’ rights.”⁸⁷

Why shift away from an external, more demanding measure of creativity toward an easily-met effort standard, as in *Emerson*? Here Holmes raised the spectre of stifling judicial aesthetic edicts distorting the copyright field. The argument reverberates even now, because it is quite compelling:

It 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 the one extreme, some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke. It may be more than doubted, for instance, whether the etchings of Goya or the paintings of Manet would have been sure of protection when seen for the first time. At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge. Yet if they command the interest of any public, they have a commercial value – it would be bold to say that they have not an aesthetic and educational value – and the taste of any public is not to be treated with contempt.⁸⁸

The doleful regime Holmes constructs, and then deflects, rests on an important premise – namely, that judging creativity, beyond a minimal check for an author’s “personal reaction” in the work, necessarily means judging works based on one’s aesthetic taste. Some works will be “repulsive,” and they are “sure to miss appreciation.” He describes a reaction from personal taste. Other works will be thought vulgar, “appeal[ing] to a public less educated than the judge.” Again, he describes a legal judgment founded on a judicial reaction from taste.

But is the premise accurate? Is taste the only measure of creativity, if we venture past an inspection for a sign – however minimal – of the author’s personality? Our experience with patent law’s nonobviousness requirement suggests that taste is not the only measure of creativity. We can measure creativity as a departure from that which is conventional, routine, or pedestrian. Rather than judge a work based solely on our own taste, we can judge a work by the ways in which the author’s individual voice stands apart from conventional expression. In a way, this alternative dissolves Holmes’ fear by charging right at it: don’t *dis* Manet because he paints unconventionally, *reward* him precisely *because* he does so. Perhaps one can avoid imposing an orthodoxy by rewarding what is, for its time and type, unorthodox.

⁸⁷ 188 U.S. at 252. Professor Jaszi, in his analysis of *Bleistein*, highlights this connection between a minimalist originality standard and a commodities-based view of expression:

The *Bleistein* opinion, with its emphasis on the “work” and its abdication of a judicial role as aesthetic arbiter, both effaces and generalizes “authorship,” leaving this category with little or no meaningful content and none of its traditional associations. In so doing, the opinion rationalizes a significant expansion of copyright protection. In effect, the revision of “authorship” in *Bleistein* was instrumental in broadening and generalizing the category of works that could be considered as copyrightable commodities.

Jaszi, *supra* note 32, at 483 (footnote omitted).

⁸⁸ 188 U.S. at 251. This is known as the aesthetic nondiscrimination principle, *supra* note 27.

thodox.

I return to this alternative creativity inquiry after reviewing both *Feist*'s turn away from *Bleistein*'s minimalism and key features of the nonobviousness doctrine. Before discussing *Feist*, however, it is instructive to consider the absurd nadir of *Bleistein*'s "personal reaction" inquiry, *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*⁸⁹

In *Alfred Bell*, the Second Circuit upheld a copyright infringement judgment that Alfred Bell & Co. had secured against Catalda Fine Arts. Alfred Bell had made mezzotint engraving reproductions⁹⁰ of eight famous paintings.⁹¹ Catalda Fine Arts made lithographs from Alfred Bell's engravings. As the trial court explained, "[t]he artists employed to produce these mezzotint engravings in suit attempted faithfully to reproduce paintings in the mezzotint medium so that the basic idea, arrangement, and color scheme of each painting are those of the original artist."⁹² At the same time, however, "[t]he work of the engraver upon the plate requires the individual conception, judgment and execution by the engraver on the depth and shape of the depressions in the plate to be made by the scraping process in order to produce in this other medium the engraver's concept of the effect of the oil painting. No two engravers can produce identical interpretations of the same oil painting."⁹³ The trial court concluded that the engraver's personal interpretation, varied as it was from that of other engravers and from the underlying painting, met the *Bleistein* originality threshold.⁹⁴ The Second Circuit agreed.⁹⁵

Given *Bleistein*'s originality standard, and the trial court's findings about the inherent idiosyncracies of each engraver's mezzotint reproduction, in the copper plate medium, of a painting on canvas, one is hardly surprised the Second Circuit upheld the trial court's originality judgment here. What *is* surprising is the extreme to which the Second Circuit took *Bleistein*'s "personal reaction" theory of originality. At first, the court hewed closely to *Bleistein*:

All that is needed to satisfy both the Constitution and the statute is that the author contributed something more than a merely trivial variation, something recognizably his own. Originality in this context means little more than a prohibition of actual copying. No matter how poor artistically the author's addition, it is enough if it be his own.⁹⁶

But then the court veered off into the absurd, and to a point that is not necessary to decide the copyrightability of the mezzotints in suit. Its leaping-off point was the

⁸⁹ 191 F.2d 99 (2d Cir. 1951). On *Bell*'s absurdity, see Jaszi, *supra* note 32, at 483: "The disassociation of 'authorship' from 'genius,' and its reassociation with the meanest levels of creative activity, continued apace in copyright cases after *Bleistein*. Perhaps the most striking example of this tendency is the noted decision in *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*"

⁹⁰ To learn about mezzotint engraving, and see examples, consult the Metropolitan Museum of Art's "Heilbrunn Timeline of Art History." Among its many "Thematic Essays" is one entitled "The Printed Image in the West: Mezzotint," available at http://www.metmuseum.org/toah/hd/mztn/hd_mztn.htm.

⁹¹ 74 F. Supp. 973, 975 (S.D.N.Y. 1947).

⁹² *Id.*

⁹³ *Id.*

⁹⁴ *Id.* at 975 & n.3.

⁹⁵ 191 F.2d at 102-05.

⁹⁶ *Id.* at 102-03 (internal quotations and footnotes omitted).

basic fact that a mezzotint is not a precise, exacting imitation of a painting:

There is evidence that they were not intended to, and did not, imitate the paintings they reproduced. But even if their substantial departures from the paintings were inadvertent, the copyrights would be valid. A copyist's bad eyesight or defective musculature, or a shock caused by a clap of thunder, may yield sufficiently distinguishable variations. Having hit upon such a variation unintentionally, the 'author' may adopt it as his and copyright it.⁹⁷

This thunderclap theory of originality sinks below even *Bleistein's* "personal reaction" theory because it severs the link between expression and volition. And we are far removed, indeed, from the *Sarony* court's equation of creativity with an author's thoughtful, considered engagement with the stuff of expression, whereby "the ideas in the mind of the author are given visible expression."⁹⁸

In a way, Judge Frank's conclusion about *Bleistein's* logical end point is hard to fault. Having turned the creativity inquiry in on itself, by focusing on the author's effort (rather than on the nature of her creative achievement in the work), how can one reject the conclusion that a spasm from loud noise is uniquely that author's spasm. By adopting the spasm's effect, rather than rejecting it, the author renders it a copyrightable personal reaction. To one who, like me, thinks copyright's originality standard needs a more, not less, vigorous acid test of creativity, *Bell's* thunderclap theory is a *reductio ad absurdum* that condemns *Bleistein's* personality-based approach to creativity.

D. Restoring a Constitutional Creativity Minimum

The Supreme Court did not return to the question of copyright's creativity threshold until 1991, in *Feist Publications, Inc. v. Rural Telephone Service Co.*⁹⁹ *Feist* holds that a "white pages" book of residential phone numbers, listed alphabetically by surname, is uncopyrightable because it falls below the constitutionally mandated minimum creativity level that copyright requires.¹⁰⁰ *Feist* re-reorients the creativity inquiry, restoring *Sarony's* focus on the work's objective character (and displacing *Bleistein's* search for signs of the author's personal reaction). *Feist* also, like *Jollie*, *The Trade-mark Cases*, and *Sarony*, casts copyright's creativity talk in patent-like language. Because *Feist* sets a constitutional floor, rather than a statutory ceiling,¹⁰¹ we have the flexibility to pursue the patent law comparison on statutory grounds.¹⁰²

⁹⁷ *Id.* at 104-05 (footnotes omitted).

⁹⁸ 111 U.S. at 58.

⁹⁹ 499 U.S. 340 (1991).

¹⁰⁰ *Id.* at 346-47 (discussing constitutionally mandated nature of the creativity requirement), 362-64 (holding that Rural's listings book falls below the constitutionally required minimum).

¹⁰¹ It seems well-settled that *Feist* provides a constitutional, not a statutory, creativity minimum. See, e.g., Samuelson, *supra* note 32, at 395: "Even though there was a perfectly adequate statutory ground for the decision, the Court – not once, but numerous times – indicated that it believed that Congress lacks power to amend the copyright statute to provide protection to data compilations unable to pass a creativity-based originality standard." Most pass over the distinction, but it is there.

¹⁰² The Copyright Act's signal requirement – "original works of authorship," 17 U.S.C. § 102(a) – leaves "original" undefined. The Act's legislative history pegs the term "original" to then-extant case-law, at least some of which embraced a creativity standard. See PATRY, *supra* note 25, at § 3:26 (re-

Justice O'Connor begins by reaffirming that “[t]he *sine qua non* of copyright is originality.”¹⁰³ Originality, in turn, requires creativity: “The originality requirement articulated in *The Trade-Mark Cases* and *Burrow-Giles* remains the touchstone of copyright protection today.”¹⁰⁴ At the same time, the creativity the Constitution demands is modest: “To be sure, the requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, ‘no matter how crude, humble or obvious’ it might be.”¹⁰⁵ After a thorough critique of the “sweat of the brow” theory of copyright¹⁰⁶ – according to which one obtains copyright protection for a fact compilation by virtue of the labor one put into gathering the facts it contains¹⁰⁷ – O'Connor concludes that a fact compilation's copyright, if it exists at all, rests on whether the author's “selection, coordination, and arrangement [of the data] are sufficiently original to merit protection.”¹⁰⁸ Like works generally, many compilation works will easily clear this constitutional minimum, “but not all will.”¹⁰⁹ Specifically, “[t]here remains a narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent.”¹¹⁰ Rural's alphabetically arranged phone number list falls into this latter, uncopyrightable category.

What is striking, beyond the Court's conclusion that a “white pages” book is too uncreative to pass constitutional muster, is the language Justice O'Connor uses to describe the book's lack of creativity. As others have noted,¹¹¹ the Court's language rings with patent-law overtones. Although originality “does not require the facts to be presented in an innovative or surprising way,” “the selection and arrangement of facts cannot be so mechanical or routine as to require no creativity whatsoever.”¹¹² Patent law, too, contrasts the nonobvious from the merely routine or mechanical. Rural's listing book does not pass muster:

The selection, coordination, and arrangement of Rural's white pages do not

viewing the relevant legislative history); Russ VerSteeg, *Sparks in the Tinderbox: Feist, “Creativity,” and the Legislative History of the 1976 Copyright Act*, 56 U. Pitt. L. Rev. 549 (1995) (same). Importantly, however, “[t]he *Feist* Court did not strip Congress of its voice on all originality issues; instead, the Court only set a threshold standard. Congress is free to set a higher standard, or, in protecting particular types of works, to declare how the originality requirement must be satisfied.” William Patry, *The Enumerated Powers Doctrine and Intellectual Property: An Imminent Constitutional Collision*, 67 GEO. WASH. L. REV. 359, 377 n.104 (1999). My approach is, in effect, to explore the flexibility Congress has provided to the courts, for case-by-case development, in the statutory term “original.”

¹⁰³ 499 U.S. at 345.

¹⁰⁴ *Id.* at 347.

¹⁰⁵ *Id.* at 345 (quoting 1 M. NIMMER & D. NIMMER, COPYRIGHT §§ 2.01[A], [B] (1990)).

¹⁰⁶ *Id.* at 351-58, 60-61.

¹⁰⁷ *Id.* at 352.

¹⁰⁸ *Id.* at 358.

¹⁰⁹ *Id.* at 359.

¹¹⁰ *Id.*

¹¹¹ See, e.g., EDWARD C. WALTERSCHEID, THE NATURE OF THE INTELLECTUAL PROPERTY CLAUSE: A STUDY IN HISTORICAL PERSPECTIVE 398-400 (2002); Russ VerSteeg & Paul K. Harrington, *Nonobviousness as an Element of Copyrightability? (Or, Is the Jewel in the Lotus a Cubic Zirconia?)*, 25 U.C. DAVIS L. REV. 331, 379-81 (1992).

¹¹² 499 U.S. at 362.

satisfy the minimum constitutional standard for copyright protection. As mentioned at the outset, Rural’s white pages are *entirely typical*. Persons desiring telephone service in Rural’s service area fill out an application and Rural issues them a telephone number. In preparing its white pages, Rural simply takes the data provided by its subscribers and lists it alphabetically by surname. The end product is a *garden-variety* white pages directory, *devoid of even the slightest trace of creativity*.

Rural’s selection of listings *could not be more obvious*: It publishes the most basic information—name, town, and telephone number—about each person who applies to it for telephone service. This is “selection” of a sort, but it lacks the modicum of creativity necessary to transform mere selection into copyrightable expression. Rural expended sufficient effort to make the white pages directory useful, but insufficient creativity to make it original

....

Nor can Rural claim originality in its coordination and arrangement of facts. The white pages do nothing more than list Rural’s subscribers in alphabetical order. This arrangement may, technically speaking, owe its origin to Rural; no one disputes that Rural undertook the task of alphabetizing the names itself. But there is *nothing remotely creative* about arranging names alphabetically in a white pages directory. It is *an age-old practice*, firmly *rooted in tradition* and so *commonplace* that it has come to be *expected as a matter of course*. It is not only unoriginal, it is *practically inevitable*. This time-honored tradition does not possess the minimal creative spark required by the Copyright Act and the Constitution.¹¹³

The Court’s analysis is, admittedly, more a negative statement than an affirmative one, more description of how Rural fell short than description of how much creativity it takes to clear the constitutional minimum. “*Feist* itself does not promulgate a definition or a test for determining creativity.”¹¹⁴ And yet, the Court’s descriptors paint a picture. An uncreative expressive work is typical, garden-variety, obvious, an age-old practice, traditional, commonplace, expected as a matter of course, practically inevitable. All the same could just as easily be said of an obvious, and thus unpatentable, invention.

It is to patent law’s nonobviousness doctrine that I now turn.

III. PATENT’S NONOBVIOUSNESS DEMAND

Nonobviousness doctrine in the United States has a long, complex history. I have summarized that history elsewhere,¹¹⁵ and Professor Duffy explores it at great length in his important *Inventing Invention* piece.¹¹⁶ For the current discussion, I need only highlight its Supreme Court endpoints – the first nonobviousness case, and the most recent (as of this writing).

The modern nonobviousness requirement entered U.S. law with the Supreme Court’s unanimous 1851 decision in *Hotchkiss v. Greenwood*.¹¹⁷ Its author, Justice

¹¹³ *Id.* at 362-63 (emphasis added and citation omitted).

¹¹⁴ Abrams, *supra* note 32, at 15.

¹¹⁵ Joseph Scott Miller, *Nonobviousness: Looking Back and Looking Ahead*, in 2 INTELLECTUAL PROPERTY & INFORMATION WEALTH: ISSUES & PRACTICES IN THE DIGITAL AGE 1 (Peter Yu ed., 2007).

¹¹⁶ Duffy, *Inventing Invention*, *supra* note 38.

¹¹⁷ 52 U.S. (11 How.) 248 (1851). For an engaging discussion of *Hotchkiss* and its place in the history

Nelson, had rendered the decision *Jollie v. Jaque* the year before.¹¹⁸ The contrast in *Jollie*, recall, was between the copyrightable composition that reflects “genius” and the uncopyrightable work of a “mere mechanic in music.”¹¹⁹ Nelson draws a strikingly similar contrast in *Hotchkiss*.

In *Hotchkiss*, the Court struck down a patent claim to a clay doorknob on the ground that the new doorknob configuration was too small an improvement to merit protection.¹²⁰ The new configuration included a clay knob around a dovetail-based metal rod; the prior art included clay knobs with straight rods and metal or wood knobs with dovetail rods.¹²¹ The Court assumed, for purposes of argument, “that, by connecting the clay or porcelain knob with the metallic shank in this well-known [dovetail] mode, an article is produced better and cheaper than in the case of the metallic or wood knob.”¹²² Nevertheless, it held the new configuration to be unpatentable.

According to Justice Nelson, an invention is not patentable unless its achievement is marked by “more ingenuity and skill . . . than were possessed by an ordinary mechanic acquainted with the business.”¹²³ Nelson contrasted “the work of the skillful mechanic” with “that of the inventor,”¹²⁴ whose more creative response to the problem at hand surpasses that which any ordinary mechanic would offer when confronted with the same problem. Save for the problem-solving setting, Justice Nelson approached the question of patent law’s requisite creativity in much the same way he approached copyright law’s requisite creativity a year earlier.

Congress first codified this nonobviousness requirement in 1952, as part of a larger overhaul of our patent statutes.¹²⁵ The statute continues the “functional approach” of *Hotchkiss*, mandating the same “comparison between the subject matter of the patent, or patent application, and the background skill of the calling.”¹²⁶ In 2007, the Supreme Court – for the first time in more than a generation – reconsidered the fundamentals of nonobviousness. The Court was prompted to do so by the long period during which the Federal Circuit had, in an understandable effort to

of nonobviousness law, see Edward C. Walterscheid, *The Hotchkiss Unobviousness Standard: Early Judicial Activism in the Patent Law*, 13 J. INTELL. PROP. L. 103 (2005).

¹¹⁸ See *supra* notes 51-59 and accompanying text.

¹¹⁹ 13 F. Cas. at 913.

¹²⁰ 52 U.S. at 266-67.

¹²¹ *Id.* at 265.

¹²² *Id.* at 266.

¹²³ *Id.* at 267.

¹²⁴ *Id.*

¹²⁵ See *Graham v. John Deere Co.*, 383 U.S. 1, 12-17 (1966) (describing the codification of *Hotchkiss* in 35 U.S.C. § 103).

¹²⁶ *Id.* at 12. Specifically, the statute provides as follows:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

35 U.S.C. § 103(a).

prevent the nonobviousness inquiry from falling prey to the distortions of the hindsight bias, made nonobviousness tantamount to “not directly suggested.”¹²⁷ As I have discussed at length elsewhere, the flaw in this approach – from the Supreme Court’s perspective – is that it assumed away too much of the ordinary artisan’s capacity to generate new solutions when confronted with a problem.¹²⁸ Some of those new solutions – the obvious ones – are insufficiently creative. To equate “obvious” only with “directly suggested” comes close to collapsing the nonobviousness requirement into a mere supernovelty test (*i.e.*, a novelty test applied over multiple pieces of prior art, rather than with a single prior art reference).¹²⁹

In *KSR International Co. v. Teleflex Inc.*,¹³⁰ the Supreme Court struck down a patent claim directed to the combination of two prior art technologies – an adjustable gas pedal, and a pedal-mounted electronic sensor to link the pedal to a computer-controlled throttle. Along the way, the Court emphasized its recognition that inventing solutions, even unpatentable ones, involves creative ability: “A person of ordinary skill is also a person of ordinary creativity, not an automaton.”¹³¹ It cautioned, too, that “[g]ranting patent protection to advances that would occur in the ordinary course without real innovation retards progress,” rather than promoting it.¹³² What, then, separates the nonobvious wheat from the obvious chaff? In a word, unconventionality. Or, in another, unpredictability. As Justice Kennedy explains:

- ◆ “The combination of familiar elements according to known methods is likely to be obvious when it does not more than yield predictable results.”¹³³
- ◆ “[W]hen a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result.”¹³⁴
- ◆ “[W]hen the prior teaches away from combining certain known elements, the discovery of a successful means of combining them is more likely to be nonobvious.”¹³⁵
- ◆ “[A] court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.”¹³⁶

¹²⁷ In 2001, Professor Vermont described the prevailing approach to patent law’s creativity threshold this way: “any independent thought overcomes the obviousness bar. If a mediocre artisan has to do more than read the prior art and myopically follow its suggestions, the invention is not obvious.” Samson Vermont, *A New Way to Determine Obviousness: Applying the Pioneer Doctrine to 35 U.S.C. § 103(a)*, 29 AIPLA Q.J. 375, 389 n.22 (2001).

¹²⁸ Joseph Scott Miller, *Remixing Obviousness*, 16 Tex. Int. Prop. L.J. 237, 239, 244-50 (2007).

¹²⁹ See Miller, *Looking Back*, *supra* note 115, at 12; John H. Barton, *Non-Obviousness*, 43 IDEA 475, 496 (2003).

¹³⁰ 127 S. Ct. 1727 (2007).

¹³¹ *Id.* at 1742; see also *id.* (“in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle”).

¹³² *Id.* at 1741.

¹³³ *Id.* at 1739.

¹³⁴ *Id.* at 1740.

¹³⁵ *Id.*

¹³⁶ *Id.*

When we place *KSR* alongside *Feist*, the similarity is plain. Both indicate that protectable creativity consists not of the typical, the obvious, the predictable, or the practically inevitable, but consists rather of the unconventional, the unpredictable, the unorthodox. By extending protection to creations in this wilder terrain, the patent and copyright regimes offer greater rewards to those who take greater risks. And by rewarding the unorthodox, these regimes don't put us in a straight-jacket – aesthetic or otherwise – but help free us from such restraints.

IV. CREATIVITY'S DEPARTURE FROM THE CONVENTIONAL

In *Feist* and *KSR*, the Supreme Court grappled with, and rejected, two claims to protection under the intellectual property laws – one under copyright, the other under patent. In both cases, the Court offer guidance on the creativity necessary to obtain copyright or patent protection. There are differences between the systems, to be sure. But I am struck by the similarity in the Court's approach to these two similar questions about the creativity threshold for protection. As Professor Heald observes in his exploration of originality in a music context, “[b]oth the copyright law originality requirement and the patent law non-obviousness requirement focus on whether the derivative work is the result of conventions familiar to creators working in the relevant culture.”¹³⁷

Every domain of expression involves a large stock of conventional expressive moves. These expressive moves are part of the public domain, in the sense that they need to be kept freely available to support a robust expressive ecology.¹³⁸ And although these moves embody more creativity than the constitutional minimum of *Feist* requires, they are sufficiently routine that our copyright system, greatly expanded both legally and technologically, threatens to trigger liability too readily. Imagine, then, a higher statutory originality requirement for copyright. Copyright protects a work insofar as the author can show that the work departed from routine, typical, and conventional expression in the pertinent genre at the time he or she authored the work. The expression need not be novel in the patent law sense, *i.e.*, the author need not show that the expression is unprecedented, and the accused infringer cannot defeat the copyright by showing that someone else produced the same expressive work at some point in the past. The expression must, however, be demonstrably unconventional in some respect, compared to common expression that dominated the genre when the author authored the work. To prove this measure of creativity, an author must identify the genre that serves as a point of comparison. In many genres, the court will benefit from expert testimony about routine, conventional expression in the genre at a given time, and how the purportedly protectable work departs from those conventions. Only after this copyrightability analysis would the court then proceed to determine whether the accused infringer appropri-

¹³⁷ Paul J. Heald, *Reviving the Rhetoric of the Public Interest: Choir Directors, Copy Machines, and New Arrangements of Public Domain Music*, 46 DUKE L.J. 241, 260 (1996). *See also id.* at 262-63: “[A]fter *Feist*, the question is . . . were these musicians of ‘reasonable talent’ guided in writing similar alto lines by existing musical conventions? A line dictated by accepted rules of composition would not be original, but if the rules permitted numerous harmonic possibilities or if the new alto part broke significantly from convention, then it would be original.”

¹³⁸ *See generally* Jessica Litman, *The Public Domain*, 39 EMORY L.J. 965 (1990).

ated the original – that is, the unconventional – aspects of the author’s work.

We should focus copyright’s protection on those who succeed by taking the greater risk of investing in unconventional, unorthodox expression. They have done more, comparatively, to foster progress, and – having succeeded where others feared to go – they are more likely to inspire purely imitative competition.

[Hoisting originality pulls together several strands of copyright doctrine that, like this general approach, deny protection to that which is conventional, routine, or inevitably dictated by function, *e.g.*, the *Brandir* approach to conceptual separability in the useful articles cases; merger; scènes à fair; routine new musical arrangements based on public domain works. It also demonstrates that derivative work decisions such as *Gracen* and *Batlin* are simply illustrations of a general principle about the need to ensure adequate creative distance from other expressive works, given the how pervasive the large stock of conventional expressive moves really is.]

[Supporting threads . . .

(a) The design patent statute, 35 U.S.C. § 171, limits protection to “any new, *original* and ornamental design for an article of manufacture.” The term “original” has been in the design patent statute since its first enactment in 1842 (Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543, 543) well before all the cases discussed above. Although originality has dropped of design patent’s doctrinal radar, late 19th century treatises suggest that it was a creativity-based standard. *See, e.g.*, HECTOR T. FENTON, *THE LAW OF PATENTS FOR DESIGNS* § 18, at 15 (1889): “It is now tolerably well settled that design patents stand on as high a plane as other patents, in that they require to support them the exercise of the inventive or originative faculty in as high a degree.” Design patent cases from the era are to like effect. *See Smith v. Whitman Saddle Co.*, 148 U.S. 674, 679 (1893): “The exercise of the inventive or originative faculty is required, and a person cannot be permitted to select an existing form, and simply put it to a new use, any more than he can be permitted to take a patent for the mere double use of a machine. If, however, the selection and adaptation of an existing form is more than the exercise of the imitative faculty, and the result is in effect a new creation, the design may be patentable.”; *Cahoone Barnet Mfg. Co. v. Rubber & Celluloid Harness Co.*, 45 F. 582, 585 (C.C.D.N.J. 1891): “I think it may be taken as settled that, to sustain a design patent, there must be exhibited in the production of the design an exercise of the inventive or original faculty as clear and of as high degree as is called for in patents for inventions or discoveries. In the latter class there must be novelty and utility; in the former, beauty and originality. In both, the final production must have been engendered by the exercise of brain power, and to such an extent that it may be said to be born of genius.”; *Northrup v. Adams*, 18 Fed. Cases 374, 374 (C.C.E.D. Mich. 1877) (No. 10,328): “The same general principles of construction extend to both [utility and design patents]. To entitle a party to the benefit of the act, in either case there must be originality and the exercise of the inventive faculty. In the one, there must be novelty and utility, in the other, originality and beauty. Mere mechanical skill is insufficient. There must be something akin to genius—an effort of the brain as well as

the hand. The adaptation of old devices or forms to new purposes, however convenient, useful or beautiful they may be in their new role, is not invention.”; Ex parte Parkinson, 1871 C.D. 251, 252: “The inventor in this line must not merely change the form or the color, but he must produce a new aesthetic effect. He must, by the exercise of industry and genius, invent or produce, not only a new, but an original design. . . . Creative genius is demanded in giving existence to a new and original design.” Originality has been a creativity concept in patent law since 1842. Surely nonobviousness, modified appropriately, can be a helpful concept in copyright law.

(b) The Supreme Court has borrowed secondary liability rules for copyright law directly from the Patent Act. See *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 441-42 (1984); *Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd.*, 545 U.S. 913, 935-37 (2005). This suggests that, so long as the borrowing is done with care, we benefit from drawing on the best in one area to strengthen the other.]

CONCLUSION

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CODA 1: Is there a First Amendment problem with hoisting originality to reward unconventional expression, preferentially, with copyright protection?

It is a content-based distinction, and providing copyright protection is state action.

On the other hand, withholding copyright protection does not suppress speech, so much as it allocates more state support for some speech over other speech. Although I am just beginning to explore the First Amendment cases and commentary, it appears that the government can fund selectively the speech it favors (e.g., school curriculum, public service announcements).

An unconventionality test for originality is also analogous, in respect of the First Amendment, with the constitutionality of the scandalous matter exclusion from Lanham Act registration. Of course, given that the denial of trademark registration does not preclude one from suing under the Lanham Act’s provision for unregistered marks, the argument is tougher in the copyright context, where the federal right to exclude simply wouldn’t exist and state protection would be preempted, much in the way that state para-patent is preempted (e.g., *Bonito Boats*).

It’s also important to appreciate that, to the degree that a higher originality standard opens up more expressive space by preventing copyright claims for pedestrian, conventional materials, the First Amendment interest in fostering more expression is served.

Key source for continued analysis: NEIL WEINSTOCK NETANEL, *COPYRIGHT’S PARADOX* (2008), especially chs. 5-9.

Professor Zimmerman offered this impressionistic take on the First Amendment impact of a higher originality standard: “Public libraries do not infringe freedom of speech by failing to buy every book that is published, or by disposing of old volumes without replacing them. They can be selective, as long as their criteria are not invidious. The National Endowment for the Arts is not required to give money to every applicant, or to draw names out of a hat. The

organization can make grants based on its judgment and on legitimate criteria chosen to serve the government's objectives in operating the program. In copyright, too, where Congress and the courts are bestowing benefits and encouraging speech, strict neutrality is not a requirement. The government is not acting wrongly in deciding which writings further the goal of 'promoting science,' and which do not." Zimmerman, *supra* note 32, at 212.