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I. FOUR PHOTOS AND A LAWSUIT

“Progress.” “Hope.” Shepard Fairey used these words as part of the now-familiar posters he created for President Barack Obama’s groundbreaking 2008 presidential campaign.² But Fairey used more than words: the iconic posters include an image of then-Senator Obama’s face stylized, like the rest of the posters, in red, white, and blue tones. Images of the posters, taken from Fairey’s recent declaratory judgment complaint against the Associated Press,³ appear below.



Fairey had long said he began creating the works with a photo, found through a Google search, as a visual reference: “Fairey begins with a news photograph of Obama, grabbed from Google images. He wants his Obama ‘wise but not intimidating.’”⁴ It was not clear, however, *which* particular photo Fairey had used.

invigorating chatloquium in February 2008; to Christian Turner for many lively conversations; to Mike Madison, Oskar Liivak, Bob Brauneis, and Tim Holbrook for cutting through an early draft’s clutter with sharp questions; to Graeme Dinwoodie and others at the Spring 2009 Chicago IP Colloquium at Kent Law School for a forceful, friendly debate; and to Jim Gibson, Bobbi Kwall, and Justin Hughes for a challenging online symposium hosted by the University of Richmond Law School’s Intellectual Property Institute (available at <http://blog.richmond.edu/ipi/article-1/>).

** This word cloud was produced using a function available at <http://www.wordle.net/>.

¹ Diane Leenheer Zimmerman, *It’s an Original!(!): In Pursuit of Copyright’s Elusive Essence*, 28 COLUM. J.L. & ARTS 187 (2005).

² Complaint for Declaratory Judgment and Injunctive Relief ¶¶ 16-17, *Fairey v. Associated Press*, No. 09-01123 (S.D.N.Y. filed Feb. 9, 2009), available at <http://cyberlaw.stanford.edu/node/6061> (follow “Read the full complaint here” hyperlink).

³ *Id.* at Exs. B (“Obama Progress”), C (“Obama Hope”).

⁴ William Booth, *Street Artist Fairey Gives Obama a Line of Cred*, WASHINGTONPOST.COM, May 18, 2008, <http://www.washingtonpost.com/wp-srv/artsandliving/style/features/2008/obama-poster-051808/graphic.html>.

James Danziger, a former photography director for the *London Sunday Times Magazine*, reported his take on the mystery on January 19, 2009, the day before President Obama's inauguration. Writing in the online magazine *The Daily Beast*, Danziger first described his own curiosity about the photo Fairey referenced:

My search began last fall, when I recognized that Fairey's prints were becoming the definitive visual of the campaign, and I began asking everyone from Amanda Fairey, the artist's wife, to Holly Hughes, the editor of Photo District News, if they knew who took the original photo. No one could seem to pin it down. Shepard Fairey was on record as saying it came from a Google Image search, but couldn't (or wouldn't) track it back to the source.⁵

Danziger then reported that, by posting an inquiry on his blog, *The Year in Pictures*,⁶ he had learned from "a computer programmer named Mike Cramer" that—according to Cramer—Fairey's posters referenced a photo from a 2007 story at *Time.com*.⁷ Danziger, digging further, discovered that *Time.com* had miscredited the 2007 photo; eventually, however, Danziger tracked the photo on which Cramer had relied to Reuters photographer Jim Young.⁸ Here it is:



The story does not end there, however, because Young's photo is *not* the one Fairey referenced.

⁵ James Danziger, *The Obama HOPE Photo Mystery Continues!*, DAILY BEAST, Jan. 19, 2009, <http://www.thedailybeast.com/blogs-and-stories/2009-01-19/who-took-the-presidential-campaigns-most-famous-photo/full/>.

⁶ See *The Year in Pictures*, Will the Photographer Who Took the Image This Illustration Is Based on Please Stand Up?, <http://pictureyear.blogspot.com/2009/01/will-photographer-who-took-image-this.html> (Jan. 14, 2009, 8:51 AM).

⁷ Danziger, *supra* note 5. Cramer posted his visual explanation for his deduction on Flickr, the photo-sharing web site. See Flickr, Obama "Hope" Source, <http://www.flickr.com/photos/mikewebkist/3197414552/> (Jan. 14, 2009).

⁸ Danziger, *supra* note 5. Young took the photo at a Senate confirmation hearing. *Id.*

Tom Gralish, a general assignment photographer for the *Philadelphia Inquirer*, continued the story in a series of posts on his blog, *Scene on the Road*.⁹ Gralish first reported that, according to commenter Steve Simula, an Associated Press photo from 2006 was a much closer source for the Fairey posters than Jim Young's photo for Reuters.¹⁰ Hours later, Gralish reported finding the precise AP photo that Simula had identified—a photo credited to Mannie Garcia and to the AP, which Garcia had taken at an April 2006 National Press Club event about Darfur.¹¹ Gralish also included another photo Garcia had taken at the Press Club event, this one including actor George Clooney seated to then-Senator Obama's right.¹² Here they are, taken from the AP's recently filed answer and counterclaims against Fairey, including the labels the AP gave them in that pleading¹³:



Clooney Photo



Obama Photo

News reports in early February 2009 suggested that the AP and Fairey were talking about the legal upshot, if any, of these events.¹⁴

⁹ See *Scene on the Road*, <http://www.philly.com/philly/blogs/inq-on-the-road/>. At the time Gralish wrote about the Fairey posters, his blog had a different URL: <http://blogs.phillynews.com/inquirer/sceneonroad/>.

¹⁰ *Scene on the Road*, *Another (Better?) Obama Poster Source Photo*, http://blogs.phillynews.com/inquirer/sceneonroad/2009/01/new_obamashepard_fairey_source_1.html (Jan. 20, 2009, 8:47 PM). Simula, like Cramer, posted his visual explanation for his deduction on a Flickr page. See *Flickr, Fairey Poster Photo Source?*, <http://www.flickr.com/photos/25105505@N07/3212113517/> (Jan. 20, 2009). Simula's work is brilliant; please visit it.

¹¹ *Scene on the Road*, *Found—AGAIN—The Poster Source Photo*, http://blogs.phillynews.com/inquirer/sceneonroad/2009/01/found_again_the_poster_source.html (Jan. 21, 2009, 3:24 AM).

¹² *Id.*

¹³ Answer ¶¶ 54, 142, *Fairey v. Associated Press*, No. 09-01123 (S.D.N.Y. filed Mar. 11, 2009), available at http://www.ap.org/iprights/Answer_and_Counterclaims_of_Associated_Press.pdf.

¹⁴ National Public Radio, *Fair Use or Infringement? Obama Image in Spat*, <http://www.npr.org/templates/story/story.php?storyId=100301384> (Feb. 5, 2009).

Talks, it appears, failed: Fairey filed a declaratory judgment suit against the AP on February 9, alleging noninfringement. On March 11, the AP filed counterclaims. Fairey contended that he used, as his point of departure for the posters, the Garcia photo containing both Obama and Clooney.¹⁵ The AP contended that Fairey used the Garcia photo containing Obama alone.¹⁶ More recently, Fairey has conceded that, just as the AP maintained, he used the Garcia photo of Obama alone as his reference.¹⁷

The central thrust of Fairey's noninfringement claim is fair use,¹⁸ a longstanding defense codified in the Copyright Act.¹⁹ Internet commentary on the dispute has also focused on the fair use doctrine.²⁰ Indeed, Danziger's *Daily Beast* story highlighted the concept: "Like it or not, Fairey's use of the picture is well within the parameters of what's considered 'fair use.'"²¹ One need not reach the fair use question at all, however, if the expression Fairey copied from Garcia's photo is not protected by copyright.

How could that be? "To establish infringement, two elements must be proven: (1) ownership of a valid copyright, and (2) copying of

¹⁵ Complaint, *supra* note 2, ¶¶ 14, 18.

¹⁶ Answer, *supra* note 13, ¶¶ 142-143, 164.

¹⁷ Motion to Amend Pleadings at 3, *Fairey v. Associated Press*, No. 09-01123 (S.D.N.Y. filed Oct. 16, 2009), available at <http://www.ap.org/iprights/fairey.html> (follow "Fairey Motion to Amend Pleadings" hyperlink) ("On October 2, 2009, counsel for Plaintiffs learned new information revealing that Plaintiffs' assertions were incorrect. Mr. Fairey was apparently mistaken about the photograph he used when his original complaint for declaratory relief was filed on February 9, 2009. After the original complaint was filed, Mr. Fairey realized his mistake. Instead of acknowledging that mistake, Mr. Fairey attempted to delete the electronic files he had used in creating the illustration at issue. He also created, and delivered to his counsel for production, new documents to make it appear as though he had used the Clooney photograph as his reference.").

¹⁸ Complaint, *supra* note 2, ¶¶ 44-50; see also Shepard Fairey, *The AP, Obama, and Referencing*, HUFFINGTON POST, Mar. 26, 2009, http://www.huffingtonpost.com/shepard-fairey/the-ap-obama-referencing_b_179562.html ("But the photograph is just a starting point. The illustration transforms it aesthetically in its stylization and idealization, and the poster has an altogether different purpose than the photograph does. . . . My Obama poster variations of 'HOPE' and 'PROGRESS' were obviously not intended to report the news. I created them to generate support for Obama; the point was to capture and synthesize the qualities that made him a leader. The point of the poster is to convince and inspire. It's a political statement. My Obama poster does not compete with the intent of, or the market for the reference photo.").

¹⁹ 17 U.S.C. § 107 (2006). See generally Michael J. Madison, *A Pattern-Oriented Approach to Fair Use*, 45 WM. & MARY L. REV. 1525 (2004).

²⁰ See, e.g., Mike Madison, *Fairey, Obama, and Fair Use*, MADISONIAN.net, Jan. 21, 2009, <http://madisonian.net/2009/01/21/fairey-obama-and-fair-use/>; Erick Schonfeld, *Once Again, the AP Tries to Redefine Fair Use; Goes After Shepard Fairey for Obama Poster*, TECHCRUNCH, Feb. 5, 2009, <http://www.techcrunch.com/2009/02/05/once-again-the-ap-tries-to-redefine-fair-use-goes-after-shepard-fairey-for-obama-poster/>; Daniel Solove, *Is the Obama Poster a Copyright Violation?*, CONCURRING OPINIONS, Feb. 5, 2009, http://www.concurringopinions.com/archives/2009/02/is_the_obama_po.html. I suspect I could list a great many more such examples.

²¹ Danziger, *supra* note 5.

constituent elements of the work that are original.”²² And the conventional copyright view is that photographs are copyrightable,²³ due in part to how low copyright’s originality threshold is taken to be.²⁴ What I am struck by, however, is how conventional—how uncreative—the Garcia photos of the Press Club event are. I find them pleasing, to be sure, and they seem well-composed and clear; anyone who uses them should, I think, credit Garcia with having taken them. They accurately convey a moment that took place at the press event they record. Photojournalism’s high professional standards doubtless encourage just this type of accurate, anodyne, conventional presentation.²⁵ But “original”? If conventional copyright doctrine tells us these photos are sufficiently original to earn the strong exclusion rights that copyright provides, so much the worse—in my view—for copyright law.

Inauguration Day events brought another, more whimsical photographic comparison. On the parade route back to the White House, the President and the First Lady spent some of their time walking along the route, free of the limousine cocoon. Doug Mills, a *New York Times* photographer, snapped a cheerful photo of the Obamas as they walked in the parade. Hendrik Hertzberg, a senior editor at the *New Yorker* magazine, recalled the Mills photo’s similarity to another photo—this one, an album cover from forty-six years earlier. Happily for Hertzberg, and his blog readers, both the album cover image and the Mills photo were readily available online. Here is Hertzberg’s blog entry from January 22, 2009²⁶:

²² *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991) (concluding that a copier was not liable for copyright infringement because the material it copied—a set of white pages phone number listings—did not meet the constitutionally-required minimum level of originality).

²³ *Ets-Hokin v. Skyy Spirits, Inc.*, 225 F.3d 1068, 1073-77 (9th Cir. 2000); *Rogers v. Koons*, 960 F.2d 301, 306-07 (2d Cir. 1992); *SHL Imaging, Inc. v. Artisan House, Inc.*, 117 F. Supp. 2d 301, 306-11 (S.D.N.Y. 2000); see also 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 2.08(E)(1), at 2-129 (2009) (“[A]ny (or . . . almost any) photograph may claim the necessary originality to support a copyright merely by virtue of the photographers’ personal choice of subject matter, angle of photograph, lighting, and determination of the precise time when the photograph is to be taken.”).

²⁴ See *Ets-Hokin*, 225 F.3d at 1076 (“[T]o overcome the presumption of validity, defendants must demonstrate why the photographs are not copyrightable. This they have failed to do, primarily because the degree of originality required for copyrightability is minimal.”); *Rogers*, 960 F.2d at 307 (“But the quantity of originality that need be shown is modest—only a dash of it will do.”).

²⁵ See, e.g., BRIAN HORTON, THE ASSOCIATED PRESS PHOTOJOURNALISM STYLEBOOK (1990); MARTIN KEENE, PRACTICAL PHOTOJOURNALISM: A PROFESSIONAL GUIDE (2d ed. 1995); KENNETH KOBRE, PHOTOJOURNALISM: THE PROFESSIONALS’ APPROACH (2d ed. 1991).

²⁶ See Henrik Hertzberg, *Positively Pennsylvania Avenue*, NEW YORKER, Jan. 22, 2009, available at <http://www.newyorker.com/online/blogs/hendrikhertzberg/2009/01/positively-penn.html>.

JANUARY 22, 2009

POSITIVELY PENNSYLVANIA AVENUE



(Left: Bob Dylan and Suze Rotolo, photographed in 1963 by Don Hunstein/CBS; right: Barack and Michelle Obama, photographed in 2009 by Doug Mills/The New York Times)

KEYWORDS Barack Obama; Bob Dylan; Freewheelin'; Michelle Obama; Suze Rotolo; photographs; the Obama.

POSTED BY HENDRIK HERTZBERG IN OBAMA

I cannot help but wonder: Did Doug Mills ever see the Dylan album cover? If he did, was he copying the photo of Dylan when he snapped the photo of the Obamas? Indeed, if Mills *had* seen the album cover, how could he prove he *wasn't* copying it when he took that photo of the Obamas? The mind reels.

II. A HIGHER THRESHOLD

[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.²⁷

With greater rights come more stringent requirements for obtaining the rights.²⁸

Copyright is everywhere. So is infringement. Indeed, we are an “infringement nation,”²⁹ covered in a billowing white goo of copyright

²⁷ David Nimmer, *Copyright in the Dead Sea Scrolls: Authorship and Originality*, 38 HOUS. L. REV. 1, 185 (2001).

²⁸ John F. Duffy, *Inventing Invention: A Case Study of Legal Innovation*, 86 TEX. L. REV. 1, 10 (2007).

²⁹ 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) (“Copyrighted works are today

entanglements.³⁰ Are we well served, today, by the conventional view³¹ that copyright's statutory originality threshold is extremely low? The antebellum federal courts appear, at least on occasion, to have viewed copyright's creativity threshold as akin to that of patent law.³² In this essay, I urge we return to something closer to that state of affairs.

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.³³ 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,"³⁴ without any need to first comply with a notice requirement or other formality.³⁵ The legal wrong at the heart of copyright—unauthorized copying—is easier to prove than one might imagine: *unconscious*

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." (footnote omitted).

³⁰ 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.").

³¹ See, e.g., *Yurman Designs, Inc. v. PAJ, Inc.*, 262 F.3d 101, 109 (2d Cir. 2001).

³² *Compare Jollie v. Jacque*, 13 F. Cas. 910, 913 (C.C.S.D.N.Y. 1850) (No. 7437) (Nelson, J.) ("The original air requires genius for its construction; but a mere mechanic in music, it is said, can make the adaptation or accompaniment."), with *Hotchkiss v. Greenwood*, 52 U.S. (11 How.) 248, 267 (1850) (Nelson, J.) ("[U]nless more ingenuity and skill in applying the old method of fastening the shank and the knob were required in the application of it to the clay or porcelain knob than were possessed by an ordinary mechanic acquainted with the business, there was an absence of that degree of skill and ingenuity which constitute essential elements of every invention."). See also *The Trade-Mark Cases*, 100 U.S. 82, 94 (1879) (stating that "originality is required" to earn protection both for patentable inventions and for copyrightable writings); *Bullinger v. Mackey*, 4 F. Cas. 649, 653 (C.C.E.D.N.Y. 1879) (No. 2,127) (stating that a plaintiff asserting copyright in a compilation's arrangement of material "must make it appear that his book exhibits a substantially new and original system of arranging material of that character, which system was his own invention").

³³ In addition to Tehranian, *supra* note 29; Wu, *supra* note 29; and Litman, *supra* note 30; 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; and Jessica Litman, *Lawful Personal Use*, 85 TEX. L. REV. 1871 (2007).

³⁴ 17 U.S.C. § 102(a) (2006).

³⁵ 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, 177-85 (2001) (using a series of telescoped pyramid figures to canvass copyright's expansive scope).

copying is actionable,³⁶ and ubiquitous network connectivity can make it easier than ever to show—relying on the fact of widespread dissemination³⁷—that an accused infringer had access to a given copyrighted work.³⁸ 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.³⁹

Numerous scholars have proposed legal changes to restrain, or better manage, copyright's now-daunting scope. Some have proposed new approaches to copyright's infringement doctrines, urging that we tighten or refocus the "substantial similarity" inquiry;⁴⁰ better sensitize the fair use inquiry to key incentives and market conditions;⁴¹ trim the

³⁶ *Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 483-84 (9th Cir. 2000); *ABKCO Music, Inc. v. Harrisongs Music, Ltd.*, 722 F.2d 988, 997-98 (2d Cir. 1983); *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).

³⁷ 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.").

³⁸ 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.").

³⁹ See James Gibson, *Once and Future Copyright*, 81 NOTRE DAME L. REV. 167, 214-15 (2005) ("[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 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." (footnotes omitted)); see also BOYLE, *supra* note 33, at 51; JESSICA LITMAN, *DIGITAL COPYRIGHT* 178 (2001).

⁴⁰ See Bartow, *supra* note 38, at 92-102; Lydia Pallas Loren, *The Pope's Copyright? Aligning Incentives With Reality By Using Creative Motivation to Shape Copyright Protection*, 69 LA. L. REV. 1, 36-38 (2008).

⁴¹ See Christina Bohannon, *Copyright Harm, Foreseeability, and Fair Use*, 85 WASH. U. L.R. 969 (2007); Justin Hughes, *Copyright and Incomplete Historiographies: Of Piracy, Propertization, and Thomas Jefferson*, 79 S. CAL. L. REV. 993, 1076-82 (2006); Loren, *supra*

copyright owner's right to control the preparation of derivative works;⁴² or profoundly restructure copyright as an unfair competition regime.⁴³ These proposals, with their enforcement focus, do not reduce the sheer number of copyrighted works. Other scholars tackle the question at the front end, proposing that we restore formalities that would forestall copyright rights from attaching in the first place,⁴⁴ or develop an explicit, minimum-size principle that defines a copyrightable "work,"⁴⁵ the statutory unit of protection.⁴⁶ Still others—most notably, the Creative Commons project and the Free Software Foundation's General Public License—create tools that enable authors to signal clearly to others that they have a more modest set of enforcement intentions than copyright's defaults provide.⁴⁷

It is interesting, however, that no one has explored in detail using copyright's central *sine qua non*, originality,⁴⁸ as a policy lever with which to slow the accumulation of copyrighted works by raising the originality hurdle. 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 Publications, Inc. v. Rural Telephone Service Co.* (reasserting a creativity component to

note 40, at 38-40; Gideon Parchomovsky & Kevin A. Goldman, *Fair Use Harbors*, 93 VA. L. REV. 1483 (2007); Wu, *supra* note 29, at 630-33.

⁴² 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 29, at 630-33.

⁴³ 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, 927-42 (2007). In a sense, Professor Bohannan's "copyright harm" approach to fair use partakes of this unfair competition spirit as well. See Bohannan, *supra* note 41.

⁴⁴ See Gibson, *supra* note 39, at 221-29; Chris Sprigman, *Reform(Aliz)ing Copyright*, 57 STAN. L. REV. 485 (2004).

⁴⁵ Justin Hughes, *Size Matters (or Should) in Copyright Law*, 74 FORDHAM L. REV. 575 (2005).

⁴⁶ 17 U.S.C. § 102(a) (2006).

⁴⁷ On the Creative Commons, see BOYLE, *supra* note 33, at ch. 8 (describing the Creative Commons project). Boyle was a founding member of the Creative Commons and was on the board until April 2009. *Id.* at ix; James Boyle—CC Network, <https://creativecommons.net/jdaboyle> (last visited Oct. 11, 2009). 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).

⁴⁸ Statements of originality's core status 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 FED. JUDICIAL CTR., *JUDGES OF THE U.S. COURTS*, <http://www.fjc.gov/servlet/GetInfo?jid=2670> (last visited Sept. 14, 2009).

originality),⁴⁹ many courts continue to treat the *statutory* originality requirement as decidedly low.⁵⁰ The two need not be the same, and there is certainly ample room to 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.⁵¹ 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 crisply⁵²: "[T]he 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."⁵³ This pre-*Feist* fog can obscure the idea that once "originality" also demands creativity the courts can (if appropriate) construe statutory originality to require *more* creativity,⁵⁴ even as the constitutionally necessary creativity minimum remains "extremely low."⁵⁵

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 v. Donaldson*

⁴⁹ In *Feist Publications, Inc. v. Rural Telephone Service 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 (emphasis added).

⁵⁰ See, e.g., *Situation Mgmt. Sys., Inc. v. ASP Consulting LLC*, 560 F.3d 53, 60 (1st Cir. 2009) ("The originality requirement for copyright is not particularly rigorous."); *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."); *CCC Info. Servs. v. Maclean Hunter Mkt. 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 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.").

⁵¹ 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.").

⁵² Litman, *supra* note 51, at 975, 1000-12.

⁵³ *Id.* at 966.

⁵⁴ Cf. 1 WILLIAM F. PATRY, *PATRY ON COPYRIGHT* § 2:8, at 2-15 (2008) ("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)].").

⁵⁵ *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991); 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.").

Litographing Co. circus poster case⁵⁶—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's, at all. The judiciary's flight from aesthetic line-drawing endures,⁵⁷ and some would chase out all reference to creativity as a needless temptation to subjectivism.⁵⁸

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—nonobviousness⁵⁹—is framed as the degree of 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?⁶⁰ 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 elevating the minimum originality statutorily required as a means to stem the copyright flood ends with this Article. I do not suggest that the literature lacks for robust discussions of copyright's originality requirement, including its creativity component; there are many,⁶¹ and

⁵⁶ *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).

⁵⁷ See *Situation Mgmt. Sys., Inc. v. ASP Consulting LLC*, 560 F.3d 53, 60 (1st Cir. 2009) (“[A] work's entitlement to copyright protection does not depend in any way upon the court's subjective assessment of its creative worth.”); *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 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.”).

⁵⁸ See Russ VerSteeg, *Originality and Creativity in Copyright Law*, in 1 INTELLECTUAL PROPERTY AND INFORMATION WEALTH: ISSUES AND PRACTICES IN THE DIGITAL AGE 1, 20 (Peter K. 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.’”).

⁵⁹ 35 U.S.C. § 103 (2006).

⁶⁰ See generally *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) (invalidating an adjustable gas pedal patent on the ground that the claimed invention would have been obvious).

⁶¹ 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*

each has taught me a great deal. What existing commentary has yet to explore, and what I explore 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 orthodox aesthetics that Holmes posed in *Bleistein*.⁶² Specifically, we can focus copyright protection on encouraging those who experiment

Progressive-Era Debate over Copyright in News (George Washington Univ. Law Sch. Pub. Law & Legal Theory, Working Paper No. 463, 2009), available at <http://ssrn.com/abstract=1365366>; Alan L. Durham, *The Random Muse: Authorship and Indeterminacy*, 44 WM. & MARY L. REV. 569 (2002); Gorman, *supra* note 56; 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) [hereinafter Heald, *Reviving the Rhetoric*]; Paul J. Heald, *The Vices of Originality*, 1991 SUP. CT. REV. 143 [hereinafter Heald, *Vices*]; 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; Dane E. Johnson, *Statute of Anne-imals: Should Copyright Protect Sentient Nonhuman Creators?*, 15 ANIMAL L. 15, 29-34 (2008); Roberta Rosenthal Kwall, *Inspiration and Innovation: The Intrinsic Dimension of the Artistic Soul*, 81 NOTRE DAME L. REV. 1945, 1998-2002 (2006) [hereinafter Kwall, *Inspiration and Innovation*]; Roberta Rosenthal Kwall, *Originality in Context*, 44 HOUS. L. REV. 871 (2007) [hereinafter Kwall, *Originality in Context*]; 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 35; Dale P. Olson, *Copyright Originality*, 48 MO. L. REV. 29 (1983); Gideon Parchomovsky & Alex Stein, *Originality*, 95 VA. L. REV. (forthcoming Oct. 2009); 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); Zimmerman, *supra* note 1.

⁶² 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 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 infringing plaintiff. *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 353-54, 361 (1991).

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 a focus for copyright makes sense within our utilitarian framework, given that unorthodox creative expression has greater need of protection against purely imitative copying: when it sparks a strong positive response from the public, unconventional expression 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 *KSR International Co. v. Teleflex, Inc.*,⁶³ the Supreme Court fundamentally reexamined the workings of the nonobviousness inquiry for the first time since 1976.⁶⁴ Exploring *KSR* alongside *Feist* 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 & Co. v. Catalda Fine Arts, Inc.*,⁶⁵ 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 requirement's 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 the prevailing conventions of its form—allows one to demand more creativity without ushering in a stifling orthodoxy. This approach also provides a common theoretical ground for seemingly disparate exclusions from copyright coverage, such as *scènes à faire*; conventional musical arrangements; modestly varied derivative works; and works in which, to paraphrase the *Matthew Bender & Co. v. West Publishing Co.* court reports case,⁶⁶ faithful depiction of an item external to the work is the work's central expressive value.⁶⁷

⁶³ 550 U.S. 398 (2007).

⁶⁴ In the October 1975 Term, the Court decided two nonobviousness cases: *Dann v. Johnston*, 425 U.S. 219 (1976), and *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273 (1976).

⁶⁵ 191 F.2d 99 (2d Cir. 1951).

⁶⁶ 158 F.3d 674, 688 (2d Cir. 1998).

⁶⁷ See *Meshwerks, Inc. v. Toyota Motor Sales U.S.A., Inc.*, 528 F.3d 1258, 1264-68 (10th Cir. 2008).

A. *Stronger Exclusion Rights Need Higher Thresholds*

Both originality (in copyright) and nonobviousness (in patent) are creativity thresholds. Each serves the same basic function, from the perspective of designing an innovation incentive system based on awarding exclusion rights. By deciding how to award exclusion rights, we (a) establish the outcomes we prefer, and (b) avoid the categorization errors we disfavor, while also (c) preserving a reservoir of raw materials on which additional creative projects can draw. The creativity threshold is a key lever for focusing rewards on preferred outcomes and avoiding the more socially costly categorization error.

We can see the creativity lever's role most easily when we consider the gap that may exist in answering the companion questions: Is, in truth, an exclusion right *needed* to get creation *here*?; and, Is an exclusion right *awarded* here? Creating a two-way table that links these questions, we see there are two hits (true positives and negatives) and two misses (false positives and negatives). Common sense suggests we should award exclusion rights using standards that achieve an acceptable ratio of hits to misses.

<i>Which error is worse?</i>		<i>Is an exclusion right needed to get creation?</i>	
		YES	NO
<i>Is an exclusion right awarded?</i>	YES	True positive	False positive
	NO	False negative	True negative

The balance of errors matters, too. (Hence the question posed in my table's upper left corner.) If false negatives are more socially costly than false positives, for example, we should grant exclusion rights relatively freely. What the table doesn't tell us, of course, is which error *is* more socially costly—false negatives (denying an exclusion right where it is actually needed to incent creation) or false positives (granting an exclusion right where it is not actually needed to incent creation)—in a given set of conditions. For example, patent law's strong-exclusion right, which does not require proof of copying (or even awareness of the patent), could function as a counterproductive tax on those who solve practical problems by conventional means without having learned anything from a would-be claimant's invention. What prevents that from happening is a high creativity threshold for patent

law that denies an exclusion right where the claimed invention reflects merely the conventional, predictable means for solving a problem.⁶⁸

The more costly error in a given regime can, moreover, flip over time. Copyright's recent conquest of daily life, rooted in both legal and technological change, when combined with widespread access to low-cost means for producing and globally disseminating creative works, makes the social cost of wrongful grants significantly higher than it was even thirty years ago.⁶⁹ That 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? It seems quite plausible to think so. 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 creations, 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 less-than-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). Copyright has moved toward the stronger-rights pole, as it becomes technologically easier both to generate copyrighted material and to (unconsciously) "copy" it. An upward adjustment in originality's demand seems due.

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

⁶⁸ See Joseph Scott Miller, *Nonobviousness: Looking Back and Looking Ahead*, in 2 INTELLECTUAL PROPERTY AND INFORMATION WEALTH: ISSUES AND PRACTICES IN THE DIGITAL AGE, *supra* note 58, at 1, 2-3.

⁶⁹ See *supra* notes 25-35 and accompanying text.

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.⁷⁰

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. This is not to say that a copyright cannot be valuable, but what is protected by copyright is sufficiently narrow 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.⁷¹

Today—more than twenty-five 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 law commentary makes the same strength/justification 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. The relative power of this exclusion right highlights the need to take special pains to reserve it for instances where the advance it protects would not have happened but for the promised right to exclude, i.e., to avoid wrongful grants more avidly than wrongful denials. As Duffy explains:

The 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

⁷⁰ 1 GOLDSTEIN, *supra* note 51, § 2.2.1, at 63-64.

⁷¹ Olson, *supra* note 61, at 34.

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.⁷²

In our own time, it is copyright that has grown stronger over time, not patent law that has grown weaker.

I concede that, 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.⁷³ 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 party-driven, case-based elaboration of the statutory originality standard to nudge copyright law in patent law's direction. Indeed, courts have adjusted originality once before—in the early 1900s—when adapting the standard to changing news distribution technologies.⁷⁴ To be clear, I do *not* think that copyright's originality should demand as robust a creativity showing as patent's nonobviousness. Patent law's focus on practical problem-solving under physical constraints that all actors face in common, and the patent racing and opportunism that this focus engenders, justify quite a high creativity threshold as to useful inventions.⁷⁵ Copyright law can, however, demand more creativity—keeping the originality standard responsive to legal and technological changes over the past thirty years—and still impose a requirement more modest than patent law's.

⁷² John F. Duffy, *Inventing Invention: A Case Study of Legal Innovation*, 86 TEX. L. REV. 1, 9-10 (2007).

⁷³ See Bartow, *supra* note 38, at 83-84.

⁷⁴ See Brauneis, *supra* note 61, at 23-32.

⁷⁵ See Duffy, *supra* note 72, at 12-16.

B. Copyright's Creativity Demand

The road to the Supreme Court's 1991 decision in *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*.

1. Early Rumbblings

The Supreme Court did not decide a case that turned squarely on copyright's creativity threshold until 1884 (in the *Burrow-Giles Lithographic Co v. Sarony* case),⁷⁶ almost a century after Congress enacted our first copyright statute.⁷⁷ 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*.⁷⁸ Justice Story, riding circuit, judged Charles Davies' arithmetic book to infringe Frederick Emerson's copyright in his own arithmetic book.⁷⁹ Justice Story turned first to the question whether Emerson's "book contain[ed] any thing new and original, entitling him to a copy-right."⁸⁰ Justice 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.⁸¹

Justice 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

⁷⁶ *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884).

⁷⁷ Act of May 31, 1790, ch. 15, 1 Stat. 124.

⁷⁸ 8 F. Cas. 615 (C.C.D. Mass. 1845) (No. 4,436) (Story, J.).

⁷⁹ *Id.* at 625.

⁸⁰ *Id.* at 618.

⁸¹ *Id.* at 619.

has some resulting similarity, to other expressive works. According to Justice Story:

[I]n 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.⁸²

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.”⁸³ The absence of copying that Justice Story stressed remains one of originality’s two core components.⁸⁴

The second case of note here, decided five years after *Emerson*, is *Jollie v. Jacque*.⁸⁵ 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.⁸⁶ 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.”⁸⁷ 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

⁸² *Id.* at 619.

⁸³ Zimmerman, *supra* note 1, at 200.

⁸⁴ See *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991) (“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.”).

⁸⁵ 13 F. Cas. 910 (C.C.S.D.N.Y. 1850) (No. 7437) (Nelson, J.).

⁸⁶ *Id.* at 913.

⁸⁷ *Id.*

degree of skill, and can be readily accomplished by any person practised in the transfer of music.”⁸⁸

Justice Nelson concluded that he could not determine the copyrightability of Loder’s arrangement on the papers, and so set the matter over for trial. 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”: “[T]he original air [i.e., melody] requires genius for its construction; but a mere mechanic in music, it is said, can make the adaptation or accompaniment.”⁸⁹ Next, building on the distinction between “genius” and the work of “a mere mechanic,” Justice 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.⁹⁰

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”⁹¹—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*,⁹² 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*.⁹³ The contemporary taboo against comparing originality to nonobviousness is just that—contemporary.

⁸⁸ *Id.*

⁸⁹ *Id.*

⁹⁰ *Id.* at 913-14 (emphasis added).

⁹¹ *Id.*

⁹² 52 U.S. (11 How.) 248 (1851).

⁹³ 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. See Audio and video podcasts: Intellectual Property Scholars Conference, held by the Benjamin N. Cardozo School of Law, the DePaul University Center for Intellectual Property Law & Information Technology, the Berkeley Center for Law & Technology, and the Stanford Program in Law, Science & Technology (Aug. 9-10, 2007), available at <http://www.law.depaul.edu/centers%5FInstitutes/ciplit/ipsc/schedule.asp>. Their talk, entitled “The Curious Divergence of Patent and Copyright Law,” inspired this project. I thank them for it.

2. 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 for copyright. Justice Miller wrote both unanimous opinions.

In *The Trade-Mark Cases*,⁹⁴ the Court overturned three convictions under the then-current federal trademark statute, concluding that Congress had overstepped its powers under the Progress Clause⁹⁵ and the Commerce Clause.⁹⁶ The case did not turn on copyright validity. The Court did, however, differentiate protectible trademark use from the achievements rewarded by patent and copyright. Establishing 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.⁹⁷ 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

⁹⁴ 100 U.S. 82 (1879).

⁹⁵ 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”). Naming this clause presents a bit of a value choice. Some call it the Copyright & Patent Clause, although neither of these terms appears in it. Others call it the Intellectual Property Clause, although, again, the phrase does not appear there, and the word “property,” which *is* used elsewhere in the Constitution (but *not* here), is rich with connotations. Still others call it the Exclusive Rights Clause, which at least has the virtue of textual connection; but that name focuses on the means Congress is empowered to use, rather than on the end it is empowered to pursue. I prefer to call it the Progress Clause.

⁹⁶ 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”).

⁹⁷ *The Trade-Mark Cases*, 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.

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.⁹⁸

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 that trademark is 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, [etc.], 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.⁹⁹

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*.”¹⁰⁰

Five years after *The Trade-Mark Cases*, in *Burrow-Giles Lithographing Co. v. Sarony*,¹⁰¹ the Court upheld the copyrightability of a posed portrait photograph. Napoleon Sarony, the famed portrait photographer,¹⁰² had taken a series of photographs of Oscar Wilde.¹⁰³ In Sarony’s infringement suit, the central issue was whether Congress had exceeded its Progress Clause power in extending copyright protection to photographs.¹⁰⁴ The Court considered 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.¹⁰⁵ The Court construed the key constitutional term, “writings,” to mean “literary productions . . . includ[ing] all forms of

⁹⁸ *The Trade-Mark Cases*, 100 U.S. at 94.

⁹⁹ *Id.* (emphases added).

¹⁰⁰ *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 346 (1991) (emphasis added).

¹⁰¹ 111 U.S. 53 (1884).

¹⁰² “By 1864, [Sarony] had established his studio in New York City, where he made a fortune taking portraits of the leading actors and literary figures of the period.” WAYNE CRAVEN, *AMERICAN ART: HISTORY AND CULTURE* 373 (2003).

¹⁰³ The photos are at Sarony Photographs of Wilde, <http://www.humnet.ucla.edu/humnet/clarklib/wildphot/sarony.htm> (last visited Oct. 30, 2009). The photo at issue in *Burrow-Giles*, Sarony’s Wilde #18, is the sixth image on this web page.

¹⁰⁴ *Burrow-Giles*, 111 U.S. at 56.

¹⁰⁵ *Id.* at 56-57.

writing, printing, engraving, etching, [etc.], by which *the ideas in the mind of the author are given visible expression.*"¹⁰⁶ Photographs plainly met this standard, at least "so far as they are representatives of original intellectual conceptions of the author."¹⁰⁷ And Sarony's photograph of Wilde, the Court concluded, was "an original work of art, the product of [Sarony's] intellectual invention."¹⁰⁸ 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."¹⁰⁹

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 a desired effect."¹¹⁰ Given Sarony's creative and graceful work, copyright attached.

Two things emerge from this brief survey. First, patent and copyright were not sharply disparate regimes with wholly separate vocabularies. 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

¹⁰⁶ *Id.* at 58 (emphasis added).

¹⁰⁷ *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 61, 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 61.

¹⁰⁸ *Burrow-Giles*, 111 U.S. 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.

¹⁰⁹ *Id.* at 60.

¹¹⁰ Zimmerman, *supra* note 1, at 201.

kinds of work that also exhibited some fairly high level of human imagination or intellectual input.”¹¹¹ Then came Justice Holmes.

3. Abandoning Creativity Review

In *Bleistein v. Donaldson Lithographing Co.*,¹¹² the Court once again confronted the question whether copyright protected particular works—in this case, color posters used to advertise a circus.¹¹³ The Sixth Circuit had denied copyright protection to the posters, extending a Supreme Court decision denying copyright protection to an ink bottle label¹¹⁴ 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.”¹¹⁵ 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*.¹¹⁶ 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 *Sarony* 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,”¹¹⁷ until the Supreme Court renewed the effort in *Feist*.

Justice 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.”¹¹⁸ More important, he reoriented the originality inquiry from a work-centered creativity

¹¹¹ *Id.*

¹¹² 188 U.S. 239 (1902).

¹¹³ At Princeton Univ. Library, Circus Posters, http://libweb5.princeton.edu/visual_materials/Circus/TC093.html (last visited Oct. 30, 2009), 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.

¹¹⁴ *Higgins v. Keuffel*, 140 U.S. 428, 431 (1891).

¹¹⁵ 104 F. 993, 996 (6th Cir. 1900).

¹¹⁶ See PAUL GOLDSTEIN, COPYRIGHT’S HIGHWAY: FROM GUTENBERG TO THE CELESTIAL JUKEBOX 49 (Stanford Univ. Press 2003) (1994) (“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.”).

¹¹⁷ Zimmerman, *supra* note 1, at 203-04.

¹¹⁸ *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1902). Judge Learned Hand echoed Holmes when, as a trial judge, Hand opined that “no photograph, however simple, can be unaffected by the personal influence of the author, and no two will be absolutely alike.” *Jewelers’ Circular Pub. Co. v. Keystone Pub. Co.*, 274 F. 932, 934 (S.D.N.Y. 1921).

assessment (of the type used in *Sarony* and, before it, in *Jollie*) to an author-centered effort assessment (of the type Justice Story had 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,¹¹⁹ 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.¹²⁰

The focus is, again, not on "the quality or quantity of authorial input,"¹²¹ 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. And the merit of protecting 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."¹²²

Why shift away from an external, more demanding measure of creativity toward an easily-met effort standard? Here Justice 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

¹¹⁹ *Bleistein*, 188 U.S. at 249.

¹²⁰ *Id.* at 250.

¹²¹ Zimmerman, *supra* note 1, at 202.

¹²² *Bleistein*, 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 61, at 483 (footnote omitted).

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.¹²³

The doleful regime Justice Holmes imagines, 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, entails judging works based on one’s own 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 also assess 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 Justice 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.

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.*¹²⁴

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 reproductions¹²⁵ of eight

¹²³ *Bleistein*, 188 U.S. at 251. This is known as the aesthetic nondiscrimination principle. See *supra* note 56.

¹²⁴ 191 F.2d 99 (2d Cir. 1951). On *Bell*’s absurdity, see Jaszi, *supra* note 61, 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.*”

¹²⁵ To learn about mezzotint engraving, with examples, consult the Metropolitan Museum of Art’s “Heilbrunn Timeline of Art History.” Among its many “Thematic Essays” is one called “The Printed Image in the West: Mezzotint.” Elizabeth E. Barker, *The Printed Image in the West: Mezzotint*, in METRO. MUSEUM OF ART, HEILBRUNN TIMELINE OF ART HISTORY (2003), http://www.metmuseum.org/toah/hd/mztn/hd_mztn.htm.

famous paintings.¹²⁶ 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."¹²⁷ 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.¹²⁸

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.¹²⁹ The Second Circuit agreed.¹³⁰

Given *Bleistein*'s originality standard, and the trial court's findings about the inherent idiosyncrasies of each engraver's mezzotint reproduction, in the copper plate medium, of a painting on canvas, one is hardly surprised that 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, Judge Frank, writing for 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.¹³¹

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

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

¹²⁷ *Id.*

¹²⁸ *Id.*

¹²⁹ *Id.* at 975 & n.3.

¹³⁰ 191 F.2d 99, 102-05 (2d Cir. 1951).

¹³¹ *Id.* at 102-03 (internal quotations, footnotes, and citations omitted).

distinguishable variations. Having hit upon such a variation unintentionally, the “author” may adopt it as his and copyright it.¹³²

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.”¹³³

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, demanding acid test of creativity, *Bell*’s thunderclap theory is a *reductio ad absurdum* that condemns *Bleistein*’s personality-based approach.

4. 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.*¹³⁴ *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.¹³⁵ *Feist* re-orientes the creativity inquiry, restoring *Sarony*’s focus on the work’s objective character (and displacing *Bleistein*’s mere 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,¹³⁶ we have the flexibility to pursue the patent law comparison on statutory grounds.¹³⁷

¹³² *Id.* at 104-05 (footnotes omitted).

¹³³ *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884).

¹³⁴ 499 U.S. 340 (1991).

¹³⁵ *Id.* at 346-47 (discussing the constitutionally mandated nature of the creativity requirement); *id.* at 362-64 (holding that *Rural*’s listings book falls below the constitutionally required minimum).

¹³⁶ It is settled that *Feist* provides a constitutional, not a statutory, creativity minimum. *See, e.g., Samuelson, supra* note 61, 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

Justice O'Connor begins the Court's analysis in *Feist* by reaffirming that "[t]he *sine qua non* of copyright is originality."¹³⁸ Originality, in turn, requires creativity: "The originality requirement articulated in *The Trade-Mark Cases* and [*Sarony*] remains the touchstone of copyright protection today."¹³⁹ 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."¹⁴⁰ After a thorough critique of the "sweat of the brow" theory of copyright¹⁴¹—according to which one obtains copyright protection for a fact compilation by virtue of the labor one put into gathering the facts it contains¹⁴²—Justice 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."¹⁴³ Like works generally, many compilation works will easily clear this constitutional minimum, "but not all will."¹⁴⁴ 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."¹⁴⁵ 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

unable to pass a creativity-based originality standard."). Most pass over the distinction, but it is real.

¹³⁷ The Copyright Act's signal requirement—"original works of authorship," 17 U.S.C. § 102(a) (2006) (emphasis added)—leaves "original" undefined. The Act's legislative history pegs the term "original" to then-extant caselaw, at least some of which embraced a creativity standard. See 2 PATRY, *supra* note 54, at § 3:26, at 3-75 to -78 (2007) (reviewing 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, 579-85 (1995) (same). Importantly, "[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."

¹³⁸ *Feist*, 499 U.S. at 345.

¹³⁹ *Id.* at 347.

¹⁴⁰ *Id.* at 345 (quoting 1 M. NIMMER & D. NIMMER, COPYRIGHT §§ 2.01(A), (B) (1990)).

¹⁴¹ *Id.* at 351-58, 360-61.

¹⁴² *Id.* at 352.

¹⁴³ *Id.* at 358.

¹⁴⁴ *Id.* at 359.

¹⁴⁵ *Id.*

creativity. As others have noted,¹⁴⁶ the Court's language rings with patent-law overtones. Although originality "does not require that facts 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."¹⁴⁷ Patent law, too, contrasts the nonobvious from the merely routine or mechanical. Rural's listing book does not pass muster, as the Court explains in a passage that repeatedly uses patent law language:

The selection, coordination, and arrangement of Rural's white pages do not satisfy the minimum constitutional standards 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.¹⁴⁸

The Court's analysis is, admittedly, more a negative statement than an affirmative one, more a description of how Rural fell short than a description of how much creativity it takes to clear the constitutional minimum. "*Feist* itself does not promulgate a definition or a test for

¹⁴⁶ 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).

¹⁴⁷ 499 U.S. at 362.

¹⁴⁸ *Id.* at 362-63 (emphases added and citation omitted).

determining creativity.”¹⁴⁹ And yet, the Court’s descriptors paint a picture: a fatally 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 requirement that I now turn.

C. Patent’s Nonobviousness Demand

Nonobviousness doctrine in the United States has a long, complex history. I have summarized that history elsewhere,¹⁵⁰ and Professor Duffy explores it at great length in his important *Inventing Invention* piece.¹⁵¹ For the current discussion, however, 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*.¹⁵² Its author, Justice Nelson, had rendered the copyright decision in *Jollie v. Jaque* the year before.¹⁵³ The contrast in *Jollie*, recall, was between the copyrightable composition that reflects “genius” and the uncopyrightable work of a “mere mechanic in music.”¹⁵⁴ Justice Nelson drew 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.¹⁵⁵ 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.¹⁵⁶ 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.”¹⁵⁷ Nevertheless, it held the new configuration to be unpatentable.

¹⁴⁹ Abrams, *supra* note 61, at 15.

¹⁵⁰ See Miller, *supra* note 68.

¹⁵¹ Duffy, *supra* note 72.

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

¹⁵³ 13 F. Cas. 910 (C.C.S.D.N.Y. 1850) (No. 7,437) (Nelson, J.); see *supra* notes 85-93 and accompanying text.

¹⁵⁴ *Jollie*, 13 F. Cas. at 913.

¹⁵⁵ *Hotchkiss*, 52 U.S. at 266-67.

¹⁵⁶ *Id.* at 265.

¹⁵⁷ *Id.* at 266.

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.”¹⁵⁸ Justice Nelson contrasted “the work of the skillful mechanic” with “that of the inventor,”¹⁵⁹ 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.¹⁶⁰ 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.”¹⁶¹ 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 prevent the nonobviousness inquiry from falling prey to the distortions of hindsight bias, made nonobviousness tantamount to “not directly suggested.”¹⁶² As I have discussed 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.¹⁶³ Some of those new solutions—the obvious ones—are insufficiently creative to merit patent protection. To equate “obvious” only with “directly suggested” comes close to collapsing the nonobviousness requirement into a mere supernovelty test (i.e., a

¹⁵⁸ *Id.* at 267.

¹⁵⁹ *Id.*

¹⁶⁰ See *Graham v. John Deere Co.*, 383 U.S. 1, 12-17 (1966) (describing the codification of *Hotchkiss* in 35 U.S.C. § 103).

¹⁶¹ *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) (2006).

¹⁶² In 2001, Professor Vermont described the prevailing approach to patent law’s creativity threshold this way: “[A]ny 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).

¹⁶³ Joseph Scott Miller, *Remixing Obviousness*, 16 TEX. INTELL. PROP. L.J. 237, 239, 244-50 (2007).

novelty test applied over multiple pieces of prior art, rather than with a single prior art reference).¹⁶⁴ That is a recipe for avoiding wrongful denials at the expense of far too many wrongful grants.

In *KSR International Co. v. Teleflex Inc.*,¹⁶⁵ 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.”¹⁶⁶ But 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.¹⁶⁷ 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 no more than yield predictable results.”¹⁶⁸
- “[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.”¹⁶⁹
- “[W]hen the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.”¹⁷⁰
- “[A] court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.”¹⁷¹

When we place *KSR*'s teachings alongside *Feist*'s, 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 unpredicted, and the

¹⁶⁴ See Miller, *supra* note 68, at 12; John H. Barton, *Non-Obviousness*, 43 IDEA 475, 496 (2003).

¹⁶⁵ 550 U.S. 398 (2007).

¹⁶⁶ *Id.* at 421; see also *id.* at 420 (“[I]n many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.”).

¹⁶⁷ *Id.* at 419.

¹⁶⁸ *Id.* at 416.

¹⁶⁹ *Id.*

¹⁷⁰ *Id.*

¹⁷¹ *Id.* at 417. The examination guidelines the Patent & Trademark Office issued in response to *KSR* stress, throughout, the need to reject patent claims on inventions that reflect nothing more than predictable, conventional solutions to problems. See Examination Guidelines for Determining Obviousness Under 35 U.S.C. § 103 in View of the Supreme Court Decision in *KSR International v. Teleflex Inc.*, 72 Fed. Reg. 57,526 (Oct. 10, 2007).

unorthodox. By extending protection to creations in this wilder terrain, the patent and copyright regimes offer greater rewards to those who take greater risks. By demanding more, rather than less, creativity as the price for exclusive rights, these regimes avoid the costlier error of wrongful grants (rather than fretting too much over wrongful denials). And by limiting rights-rewards to the unorthodox, these regimes do not trap us in a straightjacket of convention—aesthetic or otherwise—but help free us from such restraints.

D. *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 offered 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 provocative exploration of originality in the context of music composition and arrangement, “[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.”¹⁷²

Teachers in writing, painting, music, sculpture, photography, computer science, pottery, journalism, and film classes (and others besides)¹⁷³ tutor their students daily in mastering the basic, routine expressive moves of their chosen medium. Every domain of expression thus involves a large stock of conventional expressive moves. Moreover, people respond to situations more uniformly than a typically personality-centered view of human behavior would suggest.¹⁷⁴ This

¹⁷² Heald, *Reviving the Rhetoric*, *supra* note 61, at 260; *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.”).

¹⁷³ For example, in working on this project, I happened upon a website that teaches, with supporting drawings, the “grammatical and aesthetic traditions” for comic book lettering. Nate Piekos, *Comics Grammar & Tradition*, BLAMBOT, <http://www.blambot.com/grammar.shtml> (last visited Oct. 30, 2009).

¹⁷⁴ *See* SCOTT PLOUS, *THE PSYCHOLOGY OF JUDGMENT AND DECISION MAKING* 174-88 (1993) (explaining the fundamental attribution error, according to which people tend to overestimate the power of personality, and underestimate the power of situation, in explaining human behavior). The most famous examples of the phenomenon at work, within experimental psychology, are the Milgrim shock-administration experiments and the Zimbardo prison role-

strong influence of situation on behavior extends to expressive behavior, as even a few minutes at the web site Photo Clichés amply demonstrates.¹⁷⁵ Stock 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.¹⁷⁶ And, despite how routinely individuals deploy these expressive moves, many of them surely embody more creativity than the constitutional minimum set forth in *Feist*. As a result, our copyright system—the exclusion rights of which have greatly expanded both legally and technologically over the past thirty years—threatens to trigger infringement liability far too readily.

Imagine, then, applying a more demanding statutory originality requirement for copyright: in this alternate world, copyright protects a work insofar as the author can show that the work departed from routine, typical, or 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; the accused infringer thus cannot negate the work's originality merely by showing that someone else produced the same expressive work at some point in the past (as one can in patent law). The expression must, however, be demonstrably atypical or unconventional in some respect, compared to common expression that dominated the genre when the author authored the work. Only expression that is original in this sense is copyrightable on this new view.

Copyright law, like patent law, can establish this higher creativity threshold primarily through case law development.¹⁷⁷ The statutory term “original” is not expressly defined, and is thus open to upward adjustment in light of profoundly changed technological environments, consistent with the remainder of the Copyright Act's text and purpose.¹⁷⁸ Nothing in our copyright treaty obligations prevents U.S. courts from making the adjustment.¹⁷⁹ Accused infringers should thus

playing experiments. *See generally* PHILIP ZIMBARDO, *THE LUCIFER EFFECT: UNDERSTANDING HOW GOOD PEOPLE TURN EVIL* (2007).

¹⁷⁵ Photo Clichés, <http://www.photocliches.com/> (last visited Oct. 30, 2009). The site describes its mission this way: “Collecting pictures of people being uniquely hilarious, just like all the other people who took the same photo.” *Id.*

¹⁷⁶ *See generally* Litman, *supra* note 51.

¹⁷⁷ *See* Duffy, *supra* note 72 (recounting the historical development of nonobviousness law). The Copyright Office, unlike the Patent Office, does not engage in substantive examination of a registrant's underlying exclusion claim. Given the low expected value of any given copyrightable work, and the high volume of copyrightable works being produced, it seems that an enforcement suit, rather than an elaborate administrative review, is the better forum for assessing originality. *Cf.* Mark A. Lemley, *Rational Ignorance at the Patent Office*, 95 NW. U. L. REV. 1495 (2001).

¹⁷⁸ *See supra* note 137.

¹⁷⁹ The Berne Convention does not define the originality or creativity required for copyright, and certainly does not cap it at a particular level. Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, 102 Stat. 2853, 1161 U.N.T.S. 31 [hereinafter Berne

use *Feist* to frame a lack-of-originality defense. Importantly, such a defense is more likely to prevail where the purported infringer provides a rich factual record that strongly demonstrates the defense's central premise—the purported copyright owner's expression is so utterly pedestrian, conventional, and obvious for its genre and time that, much like the white pages, it is fatally unoriginal.¹⁸⁰ Courts will often benefit, no doubt, from expert testimony about routine, conventional expression embodied in publicly available works¹⁸¹ in the genre at a given time, and how the purportedly protectable work departs from those conventions. With the parties' help, courts can meaningfully assess a target work's creative distance from its genre's typical work by asking tough questions on a thick fact record.¹⁸²

Convention]; see DANIEL C.K. CHOW & EDWARD LEE, INTERNATIONAL INTELLECTUAL PROPERTY: PROBLEMS, CASES, AND MATERIALS 130 (2006) ("Originality is often thought to be the touchstone of copyright requirements, although curiously it is not expressly mentioned in either TRIPs or the Berne Convention."). Berne does refer to "literary and artistic works," Berne Convention, *supra*, at art. 2(1), 1161 U.N.T.S. at 31, and "it is generally accepted that a work must be classified as fulfilling the criterion of originality or creativity in order to fall within the categories of production which are within the scope of the Convention." J.A.L. STERLING, WORLD COPYRIGHT LAW § 7.06, at 337 (3d ed. 2008). Berne also states that compilations are protectable, so long as they "constitute intellectual creations" "by reason of the selection and arrangement of their contents." Berne Convention, *supra*, at art. 2(5), 1161 U.N.T.S. at 34. Indeed, at most Berne rules out the use of a "sweat of the brow" test for protection, the very standard the Supreme Court rejected in *Feist*. See Daniel J. Gervais, *The Compatibility of the "Skill and Labour" Originality Standard with the Berne Convention and the TRIPs Agreement*, 26 EUR. INTEL. PROP. REV. 75, 80 (2004) ("[T]he text and drafting history of the Berne Convention unequivocally demonstrate that the property test of originality is that the work must embody an author's creative input."). My suggestion that we demand more creativity is, of course, plainly in keeping with the idea that we demand some creativity (rather than none)—as *Feist* holds, and Berne article 2(5) implies. Like Berne, the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPs) provides no definition of originality or creativity for determining copyright eligibility. Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 108 Stat. 4809, 1869 U.N.T.S. 299. TRIPs article 10(2), on compilations, simply incorporates Berne article 2(5). *Id.* art. 10(2), 1869 U.N.T.S. at 304. (Ditto for article 5 of the World Intellectual Property Organization Copyright Treaty, Apr. 12, 1997, S. Treaty Doc. No. 105-17, 2186 U.N.T.S. 152.) More generally, TRIPs article 9(1) incorporates Berne articles 1-21 wholesale. Agreement on Trade-Related Aspects of Intellectual Property Rights, *supra*, at art. 9(1), 1869 U.N.T.S. at 304.

¹⁸⁰ Common experience in the phone-book world of 1991 helped the Justices see the originality problem in the *Feist* case more readily; in most domains, the accused infringer will face a much steeper factual climb to demonstrate fatal unoriginality to a busy judge unfamiliar with the genre in question.

¹⁸¹ *Cf.* 35 U.S.C. § 102 (2006) (establishing categories of prior art that are used to establish a baseline state of the art for purposes of the nonobviousness inquiry prescribed in § 103).

¹⁸² Professor Madison's pattern-oriented approach to fair use strikes the same note:

There is skepticism in some quarters about the competence of the judiciary to identify and interpret social practices meaningfully. Courts certainly could do a better job of this than they have done in the past. But the admonition that this is not a judicial function is off the mark; weakness in decision making arises not because judges are institutionally incapable of identifying and interpreting social practices, and in any event, judges ordinarily ought not to be asked to do so without help. The investigation

Hoisting copyright's originality standard in the patent law direction has a benefit beyond helping us avoid now-costlier wasteful grants. A more demanding originality standard, based on departure from the routine and conventional, also provides a common explanatory grounding for disparate strands of copyright doctrine that likewise deny protection to that which is conventional, routine, or dictated by circumstance. For example, under the *scènes à faire* doctrine, "expressions indispensable and naturally associated with the treatment of a given idea 'are treated like ideas and are therefore not protected by copyright.'"¹⁸³ If one author could protect such stock expressions, "the net of liability would be cast too wide; authors would find it impossible to write without obtaining a myriad of copyright permissions."¹⁸⁴ On my approach to originality, this doctrine deals with a limiting case of plainly unprotectable, highly conventional material. Similarly, the music copyright cases denying protection to common harmonic progressions¹⁸⁵ or conventional arrangements¹⁸⁶ are music-specific applications of a more general standard. And cases applying the merger doctrine—under which "even expression is not protected in those instances where there is only one or so few ways of expressing an idea that protection of the expression would effectively accord protection to the idea itself"¹⁸⁷—are instances where the range of intelligible conventional expression is especially narrow. Cases in which faithful

that I suggest be pursued ought, in the first instance, to be the task of the parties. Judges rarely need to be anthropologists. Lawyers do, and they do so all the time. Creating a proper record is, among other things, an anthropological or archaeological exercise. A proper record goes a long way to good judicial decision making, and having a coherent set of questions to ask goes a long way toward making a proper record.

Madison, *supra* note 19, at 1640-41 (footnotes omitted). I am grateful he highlighted the point for me.

¹⁸³ Rice v. Fox Broad. Co., 330 F.3d 1170, 1175 (9th Cir. 2003) (quoting Apple Computer, Inc. v. Microsoft Corp., 35 F.3d 1435, 1444 (9th Cir. 1994)); see also Walker v. Time Life Films, Inc., 784 F.2d 44, 50 (2d Cir. 1986) ("Elements such as drunks, prostitutes, vermin and derelict cars would appear in any realistic work about the work of policemen in the South Bronx. These similarities therefore are unprotectible as 'scenes a faire,' that is, scenes that necessarily result from the choice of a setting or situation.")

¹⁸⁴ Gaiman v. McFarlane, 360 F.3d 644, 659 (7th Cir. 2004) (Posner, J.).

¹⁸⁵ Johnson v. Gordon, 409 F.3d 12, 23 (1st Cir. 2005) (collecting cases) ("The plaintiff has not presented any evidence contradicting his own expert's assessment of the ubiquity of the III, II harmonic progression. Virtually by definition, expressions that are common are also unoriginal. So it is here: this harmonic progression, which is a stereotypical building block of musical composition, lacks originality. Accordingly, it is unprotectable." (internal citations omitted)).

¹⁸⁶ Woods v. Bourne Co., 841 F. Supp. 118, 121 (S.D.N.Y. 1994), *aff'd in relevant part*, 60 F.3d 978, 991-93 (2d Cir. 1995); Smith v. George E. Muehlenbach Brewing Co., 140 F. Supp. 729, 731 (W.D. Mo. 1956).

¹⁸⁷ Kregos v. Assoc. Press, 937 F.2d 700, 705 (2d Cir. 1991); see, e.g., New York Mercantile Exch. Inc. v. IntercontinentalExchange, Inc., 497 F.3d 109, 116-18 (2d Cir. 2007); Allen v. Academic Games League of America, Inc., 89 F.3d 614, 617-18 (9th Cir. 1996).

depiction of an external item is the central expressive value involve that narrowest range of conventional expression.¹⁸⁸

Hoisting originality also embraces the insight, pioneered in the derivative works context, that copyright protection presupposes a material difference between the work for which an exclusion right is sought and public domain material.¹⁸⁹ The public domain includes conventional, pedestrian expression for the genre (this is *Feist*'s central insight), and a too-low statutory originality standard sweeps in too much of this material by assuming that the problem of creative distance is limited to derivative works. The problem is not limited to derivative works, as, for example, the Seventh Circuit has recently suggested.¹⁹⁰

The best example of the analysis I propose would comprise a thick factual record of contemporaneous expression in a target genre for assessing a given work. I have not yet developed a comprehensive case study of this type. Instead, I can offer here three illustrative items: a trial court case that hints at an analysis along the lines I suggest, an appellate case that passes up a seemingly promising chance to conduct such an analysis, and a recent story about a photographer who makes computed tomography (CT) scan images of common objects.

In *Oriental Art Printing, Inc. v. Goldstar Printing Corp.*,¹⁹¹ a printing company that specialized in printing Chinese restaurant menus sued another printing company for copyright infringement. The plaintiffs asserted copyrights in, among other things, "photographs of several common, but unlabeled, Chinese food dishes."¹⁹² Acknowledging that under current originality doctrine "[t]he required creativity is small,"¹⁹³ the district court concluded that the food photos were fatally uncreative. Specifically, "as the president of both plaintiff companies . . . concedes, [the photos] depict the 'most common Chinese

¹⁸⁸ See *Meshwerks, Inc. v. Toyota Motor Sales U.S.A., Inc.*, 528 F.3d 1258, 1264-68 (10th Cir. 2008); *Matthew Bender & Co. v. West Publ'g Co.*, 158 F.3d 674, 688 (2d Cir. 1998).

¹⁸⁹ *Entm't Research Group v. Genesis Creative Group*, 122 F.3d 1211, 1220 (9th Cir. 1997); *Gracen v. Bradford Exch.*, 698 F.2d 300, 304-05 (7th Cir. 1983) (Posner, J.) ("[T]he purpose of the term ['original'] in copyright law is not to guide aesthetic judgments but to assure a sufficiently gross difference between the underlying and the derivative work to avoid entangling subsequent artists depicting the underlying work in copyright problems."); *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 491 (2d Cir. 1976) ("We do follow the school of cases in this circuit and elsewhere supporting the proposition that to support a copyright there must be at least some substantial variation, not merely a trivial variation such as might occur in the translation to a different medium.").

¹⁹⁰ *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. In fact, it requires only enough originality to enable a work to be distinguished from similar works that are in the public domain, since without some discernible distinction it would be impossible to determine whether a subsequent work was copying a copyrighted work or a public-domain work." (citations omitted)).

¹⁹¹ 175 F. Supp. 2d 542 (S.D.N.Y. 2001), *aff'd in part*, 34 Fed. Appx. 401 (2d Cir. 2002).

¹⁹² *Id.* at 544.

¹⁹³ *Id.* at 546.

dishes used in take-out menu [sic].”¹⁹⁴ These “direct depictions of the most common Chinese food dishes as they appear on the plates served to customers at restaurants,” the district court found, “lack any artistic quality, and neither the nature and content of such photographs, nor plaintiffs’ description of their preparation, give the Court any reason to believe that any ‘creative spark’ was required to produce them.”¹⁹⁵ The analysis in this case is on the right track, because it links creativity with a departure from convention. Finding none, it rejects the claim to copyrightability. It would, I think, have been better to ensure, with example photographs from the Chinese menu item genre, that the plaintiff’s photos were as conventional as the trial judge supposed. But that shortcoming is evidentiary, rather than analytical.

In a more recent dispute between two management consulting companies,¹⁹⁶ the First Circuit missed a good opportunity to conduct a more searching creativity inquiry about the originality of the plaintiff’s management training workbooks on communication and negotiation—an inquiry the district court had conducted, albeit awkwardly, below. As was the case with *Oriental Art Printing*, one concern I have about the state of the record in this dispute is the seeming lack of evidence about exemplars in the genre against which to assess the asserted copyrights. The most troubling aspect of the case, however, is the successful use of (from my vantage point) a highly suspect copyright claim to bankrupt a new competitor¹⁹⁷ started by departed former employees after their noncompetition agreements *had expired*.¹⁹⁸ The district court described plaintiff Situation Management Systems, Inc.’s (SMS) training workbooks, the three copyrighted works in suit, this way:

These works exemplify the sorts of training programs that serve as fodder for sardonic workplace humor that has given rise to the popular television show *The Office* and the movie *Office Space*. They are aggressively vapid—hundreds of pages filled with generalizations, platitudes, and observations of the obvious.¹⁹⁹

Further: “At their creative zenith, these works translate common-sense communication skills into platitudinal business speak.”²⁰⁰ One can, if one chooses, fairly read the district court’s rationale for concluding that

¹⁹⁴ *Id.* (quoting a witness declaration).

¹⁹⁵ *Id.*

¹⁹⁶ *Situation Mgmt. Sys. v. ASP Consulting Group*, 535 F. Supp. 2d 231 (D. Mass. 2008), *rev’d*, 560 F.3d 53 (1st Cir. 2009).

¹⁹⁷ *See* 560 F.3d at 58 (“The cost of defending this suit, ASP represents, has rendered it insolvent.”).

¹⁹⁸ *Id.* at 56 (describing defendant ASP’s formation and competitor status).

¹⁹⁹ 535 F. Supp. 2d at 239 (footnote omitted).

²⁰⁰ *Id.* at 241.

the workbooks were fatally unoriginal as one, like *Feist*, focused on the utter banality and conventionality of the works.

The First Circuit, for its part, rejected the district court's analysis as erroneous self-indulgence in personal aesthetics and improper reliance on patent law concepts. According to the First Circuit, the trial judge,

erroneously treated copyright law's originality requirement as functionally equivalent to a novelty standard. . . . Moreover, the district court's originality analysis was obviously tainted by its own subjective assessment of the works' creative worth. Its assessment of originality displayed nothing but pejorative disdain for the value of SMS's works. . . . Yet neither the works' absolute novelty nor their creative value determines whether they are original for purposes of copyright protection.²⁰¹

"Pejorative disdain" would, of course, be cause for concern. But I see no more disdain in the trial court's rejection of banal workbooks than in the Supreme Court's rejection of banal white pages. The First Circuit, though, is devoted to a low statutory originality standard: "SMS's works *easily* satisfy the originality requirement for copyright protection."²⁰² This is a missed opportunity. The district court's intuition, from first hand review of the workbooks, certainly warranted greater analysis based on comparisons to other workbooks of the type from the relevant time period. I concede, though, that it is not clear that the resources existed to improve the evidentiary record on remand, given that SMS had successfully driven defendant ASP Consulting Group into bankruptcy.

A final example: Consider the below photograph of a common object. It strikes me, at the outset, as unconventional expression (in great contrast to Mr. Garcia's photo of then-Senator Obama). The *New York Times* wrote about the photographer, "an artist-turned-medical-student" Satre Stuelke, in March 2009.²⁰³ This particular work is Stuelke's CT scan photo of a rubber duck squeak toy; Stuelke has called it "radiology art."²⁰⁴ According to the *Times* story, Stuelke manipulates the CT scanner's "200 to 500 image slices" with "a computer program that allows him to assign different colors to areas of different density."²⁰⁵ My admittedly untutored view is that these photos are unconventionally creatively expressive for a posed pop photo genre (if that *is* the right genre, which it may not be). The ultimate assessment

²⁰¹ 560 F.3d at 60.

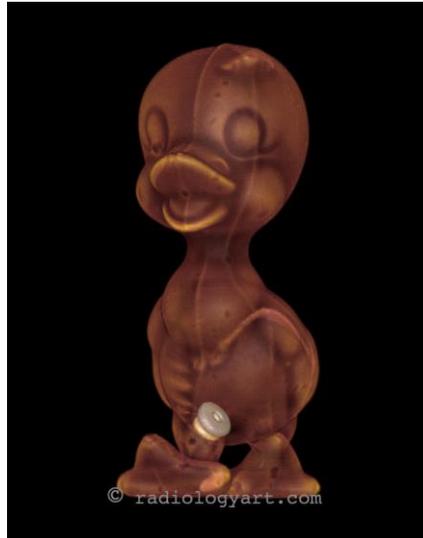
²⁰² *Id.* (emphasis added).

²⁰³ Amanda Schaffer, *The Inner Beauty of a McNugget: A Cultural Scan*, N.Y. TIMES, Mar. 23, 2009, at D4, available at <http://www.nytimes.com/2009/03/24/science/24scan.html>.

²⁰⁴ See Radiology Art, <http://www.radiologyart.com> (last visited Oct. 30, 2009).

²⁰⁵ Schaffer, *supra* note 203.

turns on a properly developed set of facts, but I think Stuelke's photos offer a helpful pointer toward what I suggest.



Satre Stuelke, Aug. 2008

Admittedly, the prevailing “tiniest dash will do” approach to originality has become quite ingrained in the copyright system.²⁰⁶ Hoisting originality will be hard, if it happens at all. Another factor that, I suspect, adds to the difficulty, pulling down on copyright’s creativity threshold, is the lack of a creator’s attribution right in U.S. law.²⁰⁷ The desire to honor a creator’s effort with credit is, in our cultural tradition, readily felt: “[F]ew interests seem as fundamentally intuitive as that authorship credit should be given where credit is due.”²⁰⁸ Authors, for their part, may create with a moral right to credit very much in mind. From my own experience, I agree with Professor Lastowka’s recent suggestion that “[p]romoting personal reputation within a particular community is certainly not the sole motivator for open copyright production, but I would wager that it is among the top

²⁰⁶ See, e.g., *Ets-Hokin v. Skyy Spirits, Inc.*, 225 F.3d 1068, 1076 (9th Cir. 2000) (“When this articulation of the minimal threshold for copyright protection [in *Feist*] is combined with the minimal standard of originality required for photographic works, the result is that even the slightest artistic touch will meet the originality test for a photograph.”).

²⁰⁷ Jane C. Ginsburg, *The Right to Claim Authorship in U.S. Copyright and Trademarks Law*, 41 HOUS. L. REV. 263, 266 (2004) (“[I]n the United States neither the copyright nor the trademarks laws establish a right of attribution generally applicable to all creators of all types of works of authorship.”).

²⁰⁸ *Id.* at 264. See generally Catherine L. Fisk, *Credit Where It’s Due: The Law and Norms of Attribution*, 95 GEO. L.J. 49 (2006).

two.”²⁰⁹ Importantly, as Professor Heymann describes, copyright owners—and the courts that, understandably, sympathize with them—have used copyright’s exclusion power to achieve attribution-related ends, lacking an attribution right for achieving those ends directly.²¹⁰ Copyright’s now-low statutory originality standard and the felt moral claims of authors have thus become a bit entangled.

Separating attribution and originality assessments is important, both for itself and—in my view—for removing the downward pressure that attribution-recognition-desire puts on originality. As Professor Kwall has explained with great clarity, an author’s moral claim to attribution and integrity comes from authorship itself, not from the resulting work’s creative distance from, or similarity to, other works in the genre:

Although authors freely borrow from the landscape of existing cultural production, a work of creative authorship nonetheless manifests the author’s individual process of creativity and artistic autonomy. Indeed, the very act of authorship entails an infusion of the creator’s mind, heart, and soul into her work.²¹¹

Providing independent legal protection for attribution and integrity claims²¹² thus “reaffirm[s] the author’s work as a reflection of its creator and a testament to the author’s autonomy and dignity.”²¹³ We can reaffirm an author’s sound moral claim to credit without reaching a conclusion, one way or the other, about the work’s compliance with the statutory originality standard; the questions are analytically distinct.

Professor Kwall has argued that, in a framework with a low originality standard (as we now have), “only those works satisfying a heightened standard of originality should qualify for [moral rights] protection”²¹⁴:

[A] perspective of creativity grounded in inspirational or spiritual motivations emphasizes the intrinsic dimension of the creative process. The focus of this perspective is on the author’s relationship to his work and his sense of personal satisfaction or fulfillment

²⁰⁹ Greg Lastowka, *Digital Attribution: Copyright and the Right to Credit*, 87 B.U. L. REV. 41, 58 (2007); see also *id.* at 58 n.95 (“With regard to the other contender, my personal intuition is that the intrinsic enjoyment of creative production has always produced and will always produce the majority of the material that copyright protects.”).

²¹⁰ Laura A. Heymann, *The Trademark/Copyright Divide*, 60 SMU L. REV. 55 (2007).

²¹¹ Kwall, *Originality in Context*, *supra* note 61, at 873.

²¹² See Kwall, *Inspiration and Innovation*, *supra* note 61, at 1972 (“The most prominent components of moral rights laws are the right of attribution and the right of integrity. The right of attribution safeguards the author’s right to be recognized as the creator of her work and prevents others from being falsely designated as the author. The right of integrity guarantees that the author’s work truly represents her creative personality and is free of distortions that misrepresent her creative expression.”).

²¹³ Kwall, *Originality in Context*, *supra* note 61, at 873.

²¹⁴ Kwall, *Inspiration and Innovation*, *supra* note 61, at 1998.

resulting from the act of creativity itself. . . . Moral rights protections are designed to recognize this intrinsic dimension of creativity. In light of these considerations, the legislative standard for moral rights should require “substantial” creativity in lieu of *Feist*’s “modicum of creativity.”²¹⁵

On this approach, she would leave the originality standard where it is and provide moral rights to more highly creative works. My own intuition is the reverse: attribution and integrity rights are better directed to protecting authors whose works fall *below* an appropriately more demanding statutory originality standard for copyright protection. Even as we raise the originality standard, we should consider providing attribution rights to admittedly less creative, but nonetheless personally authored, works. In any event, if courts hoist statutory originality, the pressure to recognize counterbalancing attribution rights will surely rise.²¹⁶

CONCLUSION

Legal and technological changes have rendered copyright creation and infringement pervasive. Originality, the gateway to copyright’s exclusion power, needs hoisting to avert what is now the more socially costly error—copyright grants that are not needed to incent creation. We can hoist originality by analogy to nonobviousness, protecting an expressive work insofar as the author can show that the work departed from routine, typical, or conventional expression in the pertinent genre at the time he or she authored the work. And by doing so, we focus copyright’s protection on those who succeed by taking the greater risk of investing in unconventional, unorthodox expression. These boundary-breaking creators, dissenters of a sort, do more to foster progress.²¹⁷ Having succeeded where others feared, or simply failed, to

²¹⁵ *Id.* at 2001-02; see also Kwall, *Originality in Context*, *supra* note 61, at 874-75, 883-98.

²¹⁶ Professor Loren notes a similar dynamic in connection with her proposal to modulate the scope of copyright protection according to whether “the driving motivation for the creation of [the] works is unrelated to copyright protection.” Loren, *supra* note 40, at 2, 3, 11-12.

²¹⁷ See generally CASS R. SUNSTEIN, *WHY SOCIETIES NEED DISSENT* (2003). Defending the need for freedom of opinion and freedom of expression, Mill observed that, “since the general or prevailing opinion on any subject is rarely or never the whole truth, it is only by the collision of adverse opinions that the remainder of the truth has any chance of being supplied.” JOHN STUART MILL, *ON LIBERTY* 64 (Macmillan Pub. Co. 1956) (1859). If we focus originality on unorthodox expression, we better align copyright with free expression values. Late in his life, Justice Douglas offered a First Amendment meditation congenial to my project:

The struggle of man to be unafraid of ideas has marked human history. The conventional has always plagued us; it has conditioned us to one way of thinking. Our prejudices become rooted in folklore.

The curious man—the dissenter—the innovator—the one who taunts and teases or makes a caricature of our prejudices is often our salvation. Yet throughout history he

go, they are more likely to inspire destructively imitative competition. They are the worthier claimants to copyright's protective power.

has been burned or booed, hanged or exiled, imprisoned or tortured, for pricking the bubble of contemporary dogma.

The writer and the thinker are the ones who frequently show that a current attitude is little more than witchcraft. They may do in art, in business, in literature, in human relations, in political theory what Darwin did with biology, Freud and Jung with the subconscious, Einstein and Rutherford with physics. This folklore or mythology by which we all live needs challengers, doubters, and dissenters lest we become prisoners of it. We need those who provoke us so that we may be warned of the fate that our prejudices or ignorance or wishful thinking may hold in store for us. It was Keynes, I believe, who said that "the difficulty lies, not in the new ideas, but in escaping from the old ones."

WILLIAM O. DOUGLAS, *FREEDOM OF THE MIND* 32 (1964). The conventions of expression, no less than the ideas expressed, can only benefit from the challenges that transgressions from them offer.