

# Uncreative Intellectual Property Law

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## *Table of Contents*

I. The Creativity Mythos in Intellectual Property Law.....	52
II. Creativity in Intellectual Property Doctrine.....	56
A. Originality: The Copyright Standard.....	57
1. The Original Originality .....	57
2. Originality in the 1976 Copyright Act.....	60
3. Feist and the Creativity Threshold.....	63
B. Nonobviousness: The Patent Law Standard.....	69
1. Invention: The Judicial Standard of Patentability.....	70
2. Nonobviousness: The Statutory Standard.....	71
C. Distinctiveness: The Trademark Law Standard .....	75
1. Categories of Distinctiveness.....	76
2. Is Creativity Fundamental to Trademark Law? .....	78
3. The Epiphenomenal Role of Creativity in Trademark.....	80
III. The Multifaceted Goals of Intellectual Property .....	83
A. The Uncreative Goals of Copyright Law .....	83
B. The Uncreative Goals of Patent Law .....	86
C. The Uncreative Goals of Trademark Law .....	87
IV. The Reward Mythos .....	89
A. The Negative Functioning of Intellectual Property Law .....	91
B. The Rewards of Not Referring to Reward.....	96
V. Conclusion .....	99

*An insidious myth has begun pervading intellectual property (IP) law and scholarship. Courts and academics commonly assume that the purposes of copyright law, patent law, and even in some cases trademark law are to reward creativity. The belief has been encouraged by opinions of the Supreme Court and influential lower courts and has become so embedded in IP law discourse that many scholars now dispute the effectiveness or relevance of copyright law and patent law in light of their understandings of psychological research showing that creativity is primarily intrinsically motivated. This article challenges the assumption on which these arguments are based by denying that any branch of IP law—copyright, patent, or*

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*trademark—is primarily designed to promote creativity. Although creativity is relevant in some ways to each field, it is not an indispensable or even a central goal of any of them. The article further explains why the related claim that IP laws “reward” or “incentivize” the desired behavior misrepresents the functioning of IP law. The article concludes by explaining how each field of IP law attempts to accomplish more complex (and, in each field, different) goals using more subtle and variable means.*

### I. The Creativity Mythos in Intellectual Property Law

If you ask an intellectual property lawyer why the Constitution empowers Congress to authorize copyrights and patents, you will probably be told it is to motivate creativity. At first glance, the answer seems plausible. The very name “intellectual property” implies a focus on mental activity, and what form of thought does the public value more than creativity? There are creativity awards in most professional fields, including writing, the visual arts, advertising, music, computer programming, and every branch of science.<sup>1</sup> Seminars,<sup>2</sup> books,<sup>3</sup> and websites<sup>4</sup> promote methods of increasing your creativity. Everyone seems to agree that more creativity is better.<sup>5</sup>

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<sup>1</sup> A few examples: the Tetrahedron Prize for Creativity in Organic Chemistry; the MacArthur Foundation Award for Creative and Effective Institutions; the AAG Stanley Brunn Award for Creativity in Geography; the International Society for Applied Ethology Creativity Award; the American College of Psychiatrists Award of Creativity in Psychiatric Education.

<sup>2</sup> *E.g.*, *Creative Thinking in Business, Classroom Seminar #2208*, AM. MGMT. ASS’N, <http://www.amanet.org/training/seminars/creativity-and-innovation-unleash-your-potential-for-greater-success.aspx> (last visited Jan. 5, 2018); *23 Hacks to Boost Your Creativity Instantly: FREE Webinar*, SKIP PRICHARD, <https://www.skipprichard.com/boost-your-creativity/> (last visited Jan. 5, 2018).

<sup>3</sup> *E.g.*, JAMES SEALS, *CREATIVITY: CREATIVE THINKING TO IMPROVE MEMORY, INCREASE SUCCESS AND LIVE A HEALTHY LIFE* (2015); SETH COHEN, *UNLEASH YOUR INNER CREATIVITY: HOW TO INCREASE YOUR CREATIVE CONFIDENCE AND CHANGE YOUR LIFE* (2015); ED CATMULL & AMY WALLACE, *CREATIVITY, INC.: OVERCOMING THE UNSEEN FORCES THAT STAND IN THE WAY OF TRUE INSPIRATION* (2014).

<sup>4</sup> *E.g.*, Oren Shapira & Nira Liberman, *An Easy Way to Increase Creativity*, *SCI. AM.* (July 21, 2009), <https://www.scientificamerican.com/article/an-easy-way-to-increase-c/>; Belle Beth Cooper, *10 Surprising Ways to Transform Your Creative Thinking*, *FAST CO.* (Apr. 2, 2014), <https://www.fastcompany.com/3028465/10-surprising-ways-to-transform-your-creative-thinking>; Heather Markel, *8 Ways to Boost Your Creativity*, *ENTREPRENEUR* (Apr. 13, 2017), <https://www.entrepreneur.com/article/290311>; Deep Patel, *6 Proven Ways to Increase Your Creativity*, *FORBES* (July 30, 2017), <https://www.forbes.com/sites/deeppatel/2017/07/30/6-proven-ways-to-increase-your-creativity/#4f5ca1ac4295>.

<sup>5</sup> *Cf.*, *e.g.*, *CREATIVITY AND LEADERSHIP IN SCIENCE, TECHNOLOGY, AND INNOVATION* 287 (Sven Hemlin et al eds., 2013) (arguing that a primary function in research leadership should be fostering creativity); Kathleen Free & Linda Stone Stern, *Conditions for Creativity*, 9 *ARTS PSYCHOTHERAPY* 113, 113 (1982) (“Man’s creativity is responsible for the quality of his existence; without it, he would still be naked, foraging the land.”); Richard Florida, *America’s Looming Creativity Crisis*, *HARV. BUS. REV.*, Oct. 2004, at 124, 134, <https://hbr.org/2004/10/americas-looming-creativity-crisis> (“In today’s economy, creativity and competitiveness go hand in hand. . . . The United States must invest generously in its creative infrastructure.”); Vishal Gupta, *Creativity in Research and Development Laboratories: A New Scale for Leaders’ Behaviours*, 25 *IIMB MGMT. REV.* 83, 83 (2013) (“Employee creativity, typically defined as the production of novel and useful ideas for

Trade groups and business firms are not alone in valuing creativity. It is widely believed that the Framers themselves sought to promote creativity by incorporating an Intellectual Property Clause into the Constitution,<sup>6</sup> and that Congress pursued that policy by adopting the 1952 Patent Act and 1976 Copyright Act in force today. Substantial legal authority supports the idea that copyrights and patents are granted specifically for that purpose. The U.S. Supreme Court has several times held that copyright and patent law are “intended to motivate the creative activity of authors and inventors”<sup>7</sup> or to “encourage the creativity of ‘Authors and Inventors.’”<sup>8</sup> In 1991, the Court made explicit the supposed connection between the Constitution and creativity, holding the Intellectual Property Clause to condition copyright protection on a finding of creativity.<sup>9</sup> Courts now routinely premise their analyses of intellectual property law on the basis of their supposed creativity-inducing purpose.<sup>10</sup> Intellectual property scholarship has largely adopted these assumptions and frequently bases its analyses

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organisational products, services, or processes . . . has become one of the key drivers of growth, performance, and valuation in organisations today.”); David Brooks, *The Creative Monopoly*, N.Y. TIMES (Apr. 23, 2012), <http://www.nytimes.com/2012/04/24/opinion/brooks-the-creative-monopoly.html> (arguing that U.S. society overvalues competitiveness and should focus more on fostering creativity).

<sup>6</sup> U.S. CONST., art. I, sec. 8, cl. 8.

<sup>7</sup> *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984).

<sup>8</sup> *Eldred v. Ashcroft*, 537 U.S. 186, 223 (2003); *see also Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975) (The “ultimate aim” of copyright law is “to stimulate artistic creativity for the general public good.”); *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 37 (2003) (stating that the copyright and patent laws were “designed to protect originality or creativity”); *Sony*, 464 U.S. at 432 (“[T]he ultimate aim [of the Copyright Act] is . . . to stimulate artistic creativity for the general public good.”); *id.* at 450 (“The purpose of copyright is to create incentives for creative effort.”); *Hollister v. Benedict & Burnham Mfg. Co.*, 113 U.S. 59, 73 (1885) (rejecting a patent on the invention before the Court because, in the Court’s view, it “is in no sense the creative work of that inventive faculty which it is the purpose of the constitution and the patent laws to encourage and reward”).

<sup>9</sup> *Feist Pubs., Inc. v. Rural Tele. Serv. Co.*, 499 U.S. 340, 345 (1991). Technically, the Court wrote: “Originality is a constitutional requirement.” *Id.* However, the Court then went on to hold that originality must “entail a minimal degree of creativity,” at least in the context of factual compilations. *Id.* at 348.

<sup>10</sup> *See, e.g., Biotechnology Indus. Org. v. District of Columbia*, 496 F.3d 1362, 1372 (Fed. Cir. 2007) (“Inventors are impelled to invest in creative efforts by the expectation that, through procurement of a patent, they will obtain a federally protected ‘exclusive right’ . . . .”); *Kelly v. Arriba Soft Corp.*, 336 F.3d 811, 829 (9th Cir. 2003) (“The Copyright Act was intended to promote creativity, thereby benefiting the artist and the public alike.”); *Warner Bros. Inc. v. Am. Broad. Co.*, 720 F.2d 231, 240 (2d Cir. 1983) (“It is a fundamental objective of the copyright law to foster creativity.”); *Video Pipeline, Inc. v. Buena Vista Home Entm’t, Inc.*, 342 F.3d 191, 198 (3d Cir. 2003) (espousing “copyright’s goal of encouraging creativity”); *SmithKline Beecham Consumer Healthcare, L.P. v. Watson Pharm., Inc.*, 211 F.3d 21, 29 (2d Cir. 2000) (“The pertinent purpose of the copyright laws—to encourage the production of creative works by according authors a property right in their works . . . .”); *Pleatmaster, Inc. v. J.L. Golding Mfg. Co.*, 240 F.2d 894, 898 (7th Cir. 1957) (quoting *Hollister*, 113 U.S. at 73); *Mott Corp. v. Sunflower Indus., Inc.*, 314 F.2d 872, 879 (10th Cir. 1963) (quoting *Richards & Conover Co. v. Leishman*, 172 F.2d 365, 369 (10th Cir. 1948)); *cf., e.g., Princeton Univ. Press v. Michigan Doc. Servs., Inc.*, 99 F.3d 1381, 1384 (6th Cir. 1996) (en banc) (holding that the fair use doctrine is intended to avoid stifling “the very creativity which [the Copyright Act] is designed to foster.”).

and arguments on the basis that the purpose of intellectual property laws is to promote creativity.<sup>11</sup> For example:

“[T]he primary goal of patent and copyright law is to stimulate creativity valuable to society in their respective spheres.”<sup>12</sup>

“The idea that the purpose of copyright law is to provide incentives for creativity is among the most established ideas in North American copyright discourse.”<sup>13</sup>

“On the standard account, copyright protections exist primarily in order to promote creativity.”<sup>14</sup>

“Patent law is intended to promote the creativity of scientists and engineers. . . . Creativity represents the constitutional, theoretical and doctrinal heart of patent law.”<sup>15</sup>

“IP law’s utilitarian theory requires that the law provide people with the incentive to act creatively, thereby producing something of value to society. Accordingly, determining the optimal form and level of incentives to spur creativity is a central issue in IP.”<sup>16</sup>

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<sup>11</sup> E.g., PETER DRAHOS & JOHN BRAITHWAITE, INFORMATION FEUDALISM 210–11 (2002); Christopher Jon Sprigman, *Copyright and Creative Incentives: What We Know (and Don’t)*, 55 HOUSTON L. REV. 451, 454 (2017); Clark D. Asay, *Intellectual Property Law Hybridization*, 87 U. COLO. L. REV. 65, 68, 95–96 (2016); David W. Barnes, *The Incentives/Access Tradeoff*, 9 NW. J. TECH. & INTELL. PROP. 96, 96 (2010); Thomas M. Byron, A la recherche du “sens” perdu: *Copyrightable Creativity Deconstructed*, 36 PACE L. REV. 800, 802 (2016); Julie Cohen, *Creativity and Culture in Copyright Theory*, 40 U.C. DAVIS L. REV. 1151, 1152 (2007); William Fisher, *Theories of Intellectual Property*, in NEW ESSAYS IN THE LEGAL AND POLITICAL THEORY OF PROPERTY 168, 169–73 (Stephen R. Munzer ed., 2001); Jeanne C. Fromer, *The Role of Creativity in Trademark Law*, 86 NOTRE DAME L. REV. 1885, 1902–03, 1916 (2011); Marta Iljadica, *Painting on Walls: Street Art Without Copyright?*, in CREATIVITY WITHOUT LAW 118, 118 (Kate Darling & Aaron Perzanowski eds., 2017); Dennis S. Karjala, *Copyright and Creativity*, 15 UCLA ENT. L. REV. 169, 173 (2008); Roberta Kwall, *Inspiration and Innovation: The Intrinsic Dimension of the Artistic Soul*, 81 NOTRE DAME L. REV. 1945, 1946 (2006); Amy L. Landers, *Ordinary Creativity in Patent Law: The Artist within the Scientist*, 74 MO. L. REV. 1, 5 (2010); Doris Estelle Long, *Dissonant Harmonization: Limitation on “Cash n’ Carry” Creativity*, 70 ALB. L. REV. 1163, 1163, 1168, 1176–82 (2007); Gregory N. Mandel, *Left-Brain versus Right-Brain: Competing Conceptions of Creativity in Intellectual Property Law*, 44 U.C. DAVIS L. REV. 283, 286, 332 (2010); Gregory N. Mandel, *To Promote the Creative Process: Intellectual Property Law and the Psychology of Creativity*, 86 NOTRE DAME L. REV. 1999, 1999 (2011); Andrew Sawicki, *Risky IP*, 48 LOY. U. CHI. L.J. 81, 84, 100 (2016); Bradford S. Simon, *Intellectual Property and Traditional Knowledge: A Psychological Approach to Conflicting Claims of Creativity in International Law*, 20 BERKELEY. TECH. L.J. 1613, 1613–14, 1617 (2005); Molly Shaffer Van Houweling, *Distributive Values in Copyright*, 83 TEXAS. L. REV. 1535, 1537 (2005).

<sup>12</sup> Jeanne Fromer, *A Psychology of Intellectual Property*, 104 NW. U. L. REV. 1441, 1445 (2010).

<sup>13</sup> Abraham Drassinower, *A Note on Incentives, Rights, and the Public Domain in Copyright Law*, 86 NOTRE DAME L. REV. 1869, 1869 (2011).

<sup>14</sup> Joseph P. Fishman, *Creating Around Copyright*, 128 HARV. L. REV. 1333, 1335 (2015).

<sup>15</sup> Landers, *supra* note 11, at 1, 5.

<sup>16</sup> Christopher Buccafusco, Zachary C. Burns, Jeanne C. Fromer & Christopher Jon Sprigman, *Experimental Tests of Intellectual Property Creativity Thresholds*, 92 TEXAS L. REV. 1921, 1931 (2014).

The belief that intellectual property law exists to encourage creativity is so entrenched that it has led more than a few writers to conclude that intellectual property law is unnecessary or even counterproductive.<sup>17</sup> They claim that psychological research and lay interviews show that human creativity flows primarily from an internal drive, and that monetary incentives reduce enjoyment of and motivation to perform creative tasks.<sup>18</sup> If this interpretation of the psychology research were correct, and if, as they believe, intellectual property law offered an extrinsic reward for creativity, then it would seem to follow that patents and copyrights should be drastically narrowed in scope, if not abolished altogether.

The trouble is, none of these premises are true. The widespread belief that intellectual property law exists primarily to promote creativity is a myth. A nuanced examination of the relevant statutes, and of the long history of jurisprudence interpreting them, leads to the conclusion that creativity is not really at the core of intellectual property law at all. The preoccupation with creativity has led courts and scholars alike to ask the wrong questions about how well intellectual property laws perform their supposed function,<sup>19</sup> and to make recommendations for reforming the laws based on a fundamental misconception about what the laws are designed to do.<sup>20</sup>

The purpose of this article is to realign the debate about the purposes of intellectual property law by debunking the belief that its purpose is to “incentivize creativity.” As I will argue, this entrenched belief is based on misconceptions about both copyright and patent law. While creativity is not irrelevant to these bodies of law, the popular claim that promoting creativity is the sole or primary purpose of either copyright or patent law is misconceived. This observation applies *a fortiori* to trademark law, which one scholar has argued puts creativity at its core as well.<sup>21</sup> Indeed, as this article will explain, not only are these bodies of law not about creativity, it is not even accurate to speak of them as “incentivizing” in the first place.

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<sup>17</sup> See, e.g., Julie E. Cohen, *Copyright as Property in the Post-Industrial Economy: A Research Agenda*, 2011 WIS. L. REV. 141, 143; Eric E. Johnson, *Intellectual Property and the Incentive Fallacy*, 39 FLA. ST. UNIV. L. REV. 623, 640 (2012); Eric E. Johnson, *The Economics and Sociality of Sharing Intellectual Property Rights*, 94 B.U. L. REV. 1935, 1938 (2014); Kwall, *supra* note 11, at 1970; Long, *supra* note 11, at 1182–84; Mandel, *supra* note 11, at 2008; Rebecca Tushnet, *Economies of Desire: Fair Use and Marketplace Assumptions*, 51 WM. & MARY L. REV. 513, 525 (2009). Another writer makes similar but more nuanced claim, also on the basis of research psychology, that copyright does not necessarily deter creativity, because constraints introduced through prior protected work may actually stimulate creativity under certain conditions. Fishman, *supra* note 14, at 1349, 1359–69. However, he shares the premise that copyright law should be adjusted better to incentivize creativity.

<sup>18</sup> For a detailed explanation of why this claim misinterprets the psychology literature, relies on invalid research, and ignores the real-world functioning of the intellectual property system, see LINDA J. DEMAINE & AARON X. FELLMETH, *THE PSYCHOLOGY OF INTELLECTUAL PROPERTY LAW* (N.Y. Univ. Press, forthcoming 2019).

<sup>19</sup> See, e.g., Long, *supra* note 11, at 1168 (“Is authorship a value to be cherished and encouraged because it represents some fount of creativity? If so, is creativity encouraged through economic exploitation rights alone?”).

<sup>20</sup> See, e.g., sources cited *supra* notes 11–17.

<sup>21</sup> See, e.g., Jeanne C. Fromer, *The Role of Creativity in Trademark Law*, 86 NOTRE DAME L. REV. 1885 (2011).

Part II of this Article begins the analysis by dividing intellectual property law into its main constituent fields—copyright, patent, and trademark—and discussing how each body of law defines and deals with creativity. It will show in Part II.A that copyright law’s requirement of originality has been erroneously equated to creativity, and that creativity’s role in copyright law is in fact minimal. Part II.B explains how the patent law’s requirement of nonobviousness both reflects and differs from the notion of creativity. Part II.C will address the argument that promoting creativity lies at the heart of trademark law and will show how the role of creativity is actually coincidental.

Part III of the article corrects a related misconception, not only that intellectual property laws focus on creativity, but that they “reward” or “incentivize” it. Part III.A explains the mechanisms by which intellectual property laws try to achieve their goals, and Part III.B elaborates on why language referring to rewards or incentives can lead to erroneous conclusions about the effectiveness of intellectual property law at attaining those goals.

Part IV clarifies what those goals really are in copyright law (IV.A), patent law (IV.B), and trademark law (IV.C), and shows how these goals differ from the common belief in the centrality of creativity. Finally, Part IV.D concludes by summarizing the argument, explaining the role that creativity does play in intellectual property law, and distinguishing between normative and descriptive arguments about the role of creativity in intellectual property law, as the system is currently structured.

## II. Creativity in Intellectual Property Doctrine

The Constitution empowers Congress to “promote the progress of science and the useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.”<sup>22</sup> It is a commonplace that, by a literal reading, the Intellectual Property Clause ties the grant of exclusionary rights for expressive works and useful inventions to the instrumental goals of advancing knowledge and industry. The Constitution offers no precise guidance about what measures would best achieve the desired efflorescence, however. Accordingly, Congress has relatively free rein to craft regulatory regimes that achieve the constitutional purpose.<sup>23</sup>

Congress chose to adopt a system of exclusionary rights to expressive works and inventions, respectively, in its first acts relating to intellectual property, both adopted

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<sup>22</sup> U.S. CONST. art. I, § 8, cl. 8.

<sup>23</sup> The Supreme Court has several times held that Congress has broad discretion to interpret how best to promote science and the useful arts. *See, e.g., Eldred v. Ashcroft*, 537 U.S. 769, 795 (2003) (“[I]t is generally for Congress, not the courts, to decide how best to pursue the Copyright Clause’s objectives.”); *Sony Corp. of Am. v. Universal City Studios*, 464 U.S. 417, 429 (1984) (“[I]t is Congress that has been assigned the task of defining the scope of [rights] that should be granted to authors or to inventors in order to give the public appropriate access to their work product.”); *see also Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 168 (1989) (asserting that “[i]t is for Congress to determine if the present system” of intellectual property protection is effectual at promoting progress in science and industry).

in 1790.<sup>24</sup> In those laws, patents were granted with respect to “any useful art, manufacture, engine, machine, or device, or any improvement therein not before known or used.”<sup>25</sup> In the case of copyright law, the protected works were simply “maps, charts, or books,” with no descriptive qualifications.<sup>26</sup> In the ensuing decades, intellectual property legislation evolved much more explicit criteria to identify which inventions and expressive works qualify for federal protection. Each body of intellectual property law has its own standards of protectable subject matter. Although courts and scholars have read creativity into each body, the language and purpose of each statute differs, and any legal analysis must accordingly evaluate each body of law separately.

#### A. Originality: The Copyright Standard

Since 1790, copyright law has come to include more explicit conditions for the grant of exclusionary rights. The 1976 Copyright Act now in force authorizes the grant of a copyright only for “original” works of authorship.<sup>27</sup> Since the inclusion of that qualification, the Supreme Court has put great emphasis on the adjective. “[T]he *sine qua non* of copyright is originality,” the Court has written; it is “the touchstone of copyright protection today.”<sup>28</sup> The problem—and it is one of several core problems of contemporary copyright law—is that the meaning of originality remains contested well over a century after the Supreme Court first characterized it as a constitutional requirement of copyright. To the extent that original means “creative,” is the Copyright Act designed solely or primarily to promote creativity, as many believe?

##### 1. *The Original Originality*

The Court first described copyrightable works using the term “creative” in *The Trade-Mark Cases* of 1879,<sup>29</sup> where it wrote in dicta that writings protected by copyright must be “*original*, and are founded in the creative powers of the mind.”<sup>30</sup> This language came from the Court itself; the Copyright Act of 1790 was still in force at the time and had not yet been amended to include the terms “original” or “creative.” Yet, some interpret the Court’s phrasing to equate creativity with originality and to establish a new creativity requirement in copyright law.<sup>31</sup> Admittedly, some relatively recent jurisprudence seems to confirm that interpretation.<sup>32</sup> If so, in *The Trade-Mark Cases*, the Court would have established a new doctrinal requirement after nine decades of copyright jurisprudence.

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<sup>24</sup> Patent Act of 1790, ch. 7, 1 Stat. 109 (1790); Copyright Act of 1790, 1 Stat. 124 (1790).

<sup>25</sup> Patent Act of 1790 § 1.

<sup>26</sup> Copyright Act of 1790 § 1.

<sup>27</sup> 17 U.S.C. § 102(a) (2012).

<sup>28</sup> *Feist Publ’ns, Inc. v. Rural Tele. Serv. Co.*, 499 U.S. 340, 345, 347 (1991).

<sup>29</sup> 100 U.S. 82 (1879).

<sup>30</sup> *Id.* at 94 (emphasis in original).

<sup>31</sup> *See, e.g., Russ VerSteeg, Sparks in the Tinderbox: Feist, “Creativity,” and the Legislative History of the 1976 Copyright Act*, 56 U. PITT. L. REV. 549, 583–84 (1995).

<sup>32</sup> *See infra* Section II.A.3.

Yet, this interpretation seems far-fetched. In the *Trade-Mark Cases*, the creativity *vel non* of a potentially copyrightable work was not before the Court. That the Court would establish a new and consequential precondition for a copyright grant in *dicta* is very unlikely. Geographical maps, for example, had been copyrightable in the United States since 1790,<sup>33</sup> and at least in their primary function of depicting real geographical features, the less imagination used in the map's preparation, the better. The Court apparently had no intention of imposing a creativity requirement for the copyrightability of maps, because no subsequent case rejected or invalidated the copyright on literal maps.

It is much more likely that the Court used the term "creative powers" to denote nothing more exceptional than any mental process resulting in some expressive output. As the Court made clear in the (less often quoted) sentence following the "creative powers" language, what copyright protects is "*the fruits of intellectual labor*, embodied in the form of books, prints, engravings, and the like."<sup>34</sup> Because intellectual labor need not be creative in the sense of "imaginative" or "ingenious," the Court's language suggests that it was referring to any kind of mental work that resulted in a book, picture, or other written expression. Original writings could proceed from the creative powers of the mind, in this sense, and yet totally lack an imaginative spark. Indeed, the Court's decisions soon afterward dealt with originality as requiring expressive works to be "original intellectual conceptions of the author,"<sup>35</sup> as opposed to conceptions copied from another author. Accordingly, no subsequent decision of the Court, or of any circuit court, nullified a copyright based on a lack of creativity for nearly a century after *The Trade-Mark Cases*.<sup>36</sup>

Further support can be found in the way the Supreme Court came to link originality to a rejection of any requirement of aesthetic quality or merit. In the 1903 case *Bleistein v. Donaldson Lithographing Co.*,<sup>37</sup> the defendant had copied the plaintiff's illustrated chromolithograph advertising a circus. In response to the argument that the lithographs could not be original because they merely depicted real scenes from the circus or faces of actual persons, the Court rejected the relevance of the fact that a work attempts to reproduce the appearance of a physical reality. "The least pretentious picture has more originality in it than directories and the like, which may be copyrighted," Justice Holmes observed.<sup>38</sup> Nor are courts qualified to inquire into the aesthetic appeal of the work:

It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial

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<sup>33</sup> Copyright Act of 1790 § 1, 1 Stat. 124 (1790).

<sup>34</sup> *The Trade-Mark Cases*, 100 U.S. 82, 94 (1879) (emphasis in original).

<sup>35</sup> *Burrow-Giles Lithographic Co. v. Saroni*, 111 U.S. 53, 58 (1884).

<sup>36</sup> See Ralph D. Clifford, *Random Numbers, Chaos Theory, and Cognition: A Search for the Minimal Creativity Standard in Copyright Law*, 82 DENV. U.L. REV. 259, 260–61 (2004). Clifford identifies some cases that use terms like "creative," but, as with *The Trade-Mark Cases*, these were plainly intended not to establish a creativity requirement, but rather an "intellectual labor" requirement.

<sup>37</sup> 188 U.S. 239 (1903).

<sup>38</sup> *Id.* at 250.

illustrations, outside of the narrowest and most obvious limits. At the one extreme, some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke. It may be more than doubted, for instance, whether the etchings of Goya or the paintings of Manet would have been sure of protection when seen for the first time. At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge. Yet if they command the interest of any public, they have a commercial value,—it would be bold to say that they have not an aesthetic and educational value,—and the taste of any public is not to be treated with contempt.<sup>39</sup>

To say that copyright law takes no notice of the level of skill used in the creation of the work, the relationship of the work to real life objects or persons, or the aesthetic merit of the work, is not far from saying that the law requires no showing of creativity for the work to qualify for copyright protection. Although creativity is conceptually distinct from each of these considerations, they are closely related. The apogee of creativity is commonly thought to be a work depicting or describing scenes, events, persons, or objects existing nowhere outside the creator's imagination,<sup>40</sup> and therefore having little correlation to the "visible things"<sup>41</sup> one encounters in real life. The Court established in *Bleistein* that such considerations are irrelevant to copyrightability. *Bleistein* thus set the tone for later cases that treated "originality" as an assurance that the work was not plagiarized, a mere mechanical reproduction of another person's work.<sup>42</sup> As the Second Circuit, sitting *en banc*, put it in 1976: "Originality means that the work owes its creation to the author and this in turn means that the work must not

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<sup>39</sup> *Id.* at 251–52.

<sup>40</sup> See ROBERT E. FRANKEN, HUMAN MOTIVATION 394 (3d ed. 1993) (stating that the ability to "view things in new ways or from a different perspective" is a precondition of creativity); MIHALY CSIKSZENTMIHALYI, CREATIVITY: FLOW AND THE PSYCHOLOGY OF DISCOVERY AND INVENTION 25–26 (2009) (defining creativity as expressing unusual thoughts, experiencing the world in novel and original ways, or making culture-changing contributions); Michael Wreen, *Creativity*, 43 PHILOSOPHIA 891, 894 (2015) (arguing that creativity is characterized by the unexpected or surprising).

<sup>41</sup> *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 249 (1903).

<sup>42</sup> Although a small handful of lower courts mentioned "creative work" or some synonymous phrase in subsequent years, in each case they were referring to independent work rather than imagination or inventiveness. For example, in *Amsterdam v. Triangle Publications, Inc.*, 189 F.2d 104, 106 (3d Cir. 1951), the Third Circuit held that a literal map lacked the "modicum of creative work" required by the 1909 Copyright Act and was therefore not original. However, if the *Amsterdam* court meant "creative work" in the sense of "imaginative work," the statement was dicta, because what was lacking in that case was originality in the sense of independent work. All information for the preparation of the map at issue was taken from other maps already in existence, with no physical research performed by the author. Moreover, if that were the court's meaning, it would be misinterpreting the sole authority on which it relied, a New York district court case, *Andrews v. Guenther Publishing Co.*, 60 F.2d 555, 557 (S.D.N.Y. 1932). In *Andrews*, the trial court had held that the 1909 Copyright Act required a "modicum of creative work," but it plainly meant that what was required is not the exercise of imagination, but rather originality "as distinguished from mere copying." *Id.*

consist of actual copying.”<sup>43</sup> The trend of jurisprudence toward a conservative interpretation or originality proved temporary, however.

## 2. *Originality in the 1976 Copyright Act*

The Copyright Act of 1790 was replaced by another in 1909, which added nothing regarding originality or creativity. The 1909 Act, in turn, was replaced in 1976. It was in the legislative history of the 1976 Copyright Act that the term “creativity” began to appear in discussions of copyright law.

The drafting process of the 1976 Act began with the House Judiciary Committee calling on the Register of Copyrights<sup>44</sup> to prepare and submit a report on revision of the Act to account for new communications technologies.<sup>45</sup> In its report, submitted to Congress in 1961, the Register stated that “original creative authorship” was a fundamental criterion of copyright protection,<sup>46</sup> and that a work “must represent an appreciable amount of creative authorship” to qualify for such protection.<sup>47</sup> Witnesses objected to the Register’s use of the word “creative,” arguing that it “might lead courts to establish a higher standard of copyrightability than [the standard] now existing under the [judicial] decisions.”<sup>48</sup> The 1965 draft and all subsequent drafts consequently omitted the term “creative,” and terms such as “creativity” and “ingenuity,” from the provisions relating to copyrightable subject matter.

Instead, in adopting the 1976 Act, Congress incorporated the “originality” requirement from the Supreme Court’s jurisprudence. Only “original works of authorship” would qualify for copyrights under the 1976 Act.<sup>49</sup> The drafting reports of the House of Representatives specified that the term “original” was “purposely left undefined”; it was

intended to incorporate without change the standard of originality established by the courts under the present [1909] copyright statute. This standard does not include requirements of novelty, ingenuity, or esthetic merit, and there is no intention to enlarge the standard of copyright protection to require them.<sup>50</sup>

The legislative history thus repudiates the idea that only those expressive works that

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<sup>43</sup> *L. Baitlin & Son, Inc. v. Snyder*, 536 F.2d 486, 490 (2d Cir. 1976) (en banc); *see also, e.g., Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102–03 (2d Cir. 1951).

<sup>44</sup> The Register of Copyrights directs the U.S. Copyright Office, in the Library of Congress. 17 U.S.C. § 701 (2012).

<sup>45</sup> Jessica D. Litman, *Copyright, Compromise, and Legislative History*, 72 CORNELL L. REV. 857, 858 (1987).

<sup>46</sup> Staff of H. Comm. on the Judiciary, 87th Cong., 1st Sess., *Copyright Law Revision: Rep. of the Reg. of Copyrights on the General Revision of the U.S. Copyright Law* (Comm. Print 1961).

<sup>47</sup> *Id.* at 9.

<sup>48</sup> Staff of H. Comm. on the Judiciary, 89th Cong., 1st Sess., *Copyright Law Revision Part 6: Supp. Rep. of the Reg. of Copyrights on the General Revision of the U.S. Copyright Law: 1965 Revision B.*, at 3 (Comm. Print 1965) [hereinafter *House Report Part 6*]. For a discussion of the private witness statements arguing against use of the term “creative,” *see VerSteeg, supra* note 31, at 562–69.

<sup>49</sup> Pub. L. 94-533, tit. I, § 101, 90 Stat. 2544 (1976) (codified as amended at 17 U.S.C. § 102 (2012)).

<sup>50</sup> H.R. Rep. No. 94-1476, at 51 (1976), *as reprinted in* 1976 U.S.S.C.A.N. 5659, 5664.

could be characterized as creative would qualify for copyright protection.

Nonetheless, some statements made in the congressional hearings and reports reintroduced the words “creativity” and “creative.” In fact, in introducing the bill, the sponsor, Senator McClellan of Arkansas, specifically stated that his objective “was to devise a modern copyright statute that would encourage creativity and protect the interests which the public has in in the subject matter of this legislation.”<sup>51</sup> In a similar vein, the House and Senate Judiciary Committee reports included statements seeming to endorse promoting creativity as the basis of copyright:

The history of copyright law has been one of gradual expansion in the types of works accorded protection, and the subject matter affected by this expansion has fallen into two general categories. In the first, scientific discoveries and technological developments have made possible new forms of creative expression that never existed before. . . .

The historic expansion of copyright has also applied to forms of expression which, although in existence for generations or centuries, have only gradually come to be recognized as creative and worthy of protection.<sup>52</sup>

The Register of Copyrights, for her part, continued to assume that creativity was a component of copyright protection during the hearings on the 1976 Act.<sup>53</sup> And she was not the only speaker to emphasize the importance of creativity; the word rolled off the tongues of numerous witnesses during the hearings. Witness statements themselves have no inherent value in statutory interpretation, and in any case these advocates overwhelmingly represented the content industries. They were evidently offering opinions about the bill in an effort to exalt the role of music and movie studios, book publishers, and television broadcasters in the U.S. economy and culture. Nonetheless, a few legislators did echo their sentiments. One representative, speaking in support of the bill, stated: “Copyright has to do with the craft of the author, the craft of the composer and the craft of the artist. The purpose of copyright is to stimulate creativity and by so doing benefit the public.”<sup>54</sup> Another stated: “[T]he whole point of the copyright law, as I understand it, is to enhance creativity, to reward the author or the composer.”<sup>55</sup>

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<sup>51</sup> 122 CONG. REC. 33813 (1976) (statement of Sen. McClellan).

<sup>52</sup> H.R. Rep. No. 94-1476, at 51 (1976); S. Rep. No. 93-983, at 103-04 (1974); S. Rep. No. 94-473, at 50-51 (1975).

<sup>53</sup> See *Performance Royalty Hearings on S. 1111 Before the Subcomm. on Patents, Trademarks, and Copyrights of the S. Comm. on the Judiciary*, 94th Cong., 1st Sess. 10 (1975) (“Sound recordings are, in my opinion, just as creative and worthy of protection as musical compositions. . . . This is an inequity that in keeping with the constitutional aim of encouraging and recognizing creative endeavor, Congress should redress without delay.”); see also *id.* at 11-15 (repeatedly referring to creativity as the key to copyright protection).

<sup>54</sup> 122 CONG. REC. 31983 (1976) (statement of Rep. Railsback).

<sup>55</sup> *Copyright Law Revision: Hearing on H.R. 2223 Before the Subcomm. on Courts, Civil Liberties, & the Admin. of Justice of the H. Comm. on the Judiciary*, 94th Cong., 1st Sess., Ser. No. 36, Pt. 2, at

Most legislators did not refer to creativity, however, except in an offhand way, throughout the weeks of debates and redrafting. A few mentioned “creative works,” “creative efforts,” “creative talents,” and similar terms during the hearings<sup>56</sup> but it appears that they were using the adjective “creative” as shorthand for expressive or original (or both), either because the witnesses themselves so frequently referred to creativity in their testimony, or simply through unfamiliarity with copyright law.<sup>57</sup>

Although the evidence seems mixed, the most telling fact is the deliberate omission of the term “creativity” from Section 102 of the 1976 Copyright Act as adopted, despite the Register’s early effort to include it.<sup>58</sup> The sole references to creativity in the Copyright Act as adopted are found in scattered sections without relevance to the scope or purpose of copyright. The references all relate to the calculation of royalties by copyright royalty judges, who are enjoined account for several objectives relating to “creative works,” “creative expressions,” and “creative contributions.”<sup>59</sup> However, even here, the Act uses the term “creative” as a substitute for “expressive” and does not establish a new requirement for protection.

In summary, although a few members of Congress considered expressive works “creative” in some sense, and the sponsor in the Senate plainly considered copyrights important for promoting creativity, Congress expressly dismissed the suggestion to incorporate any creativity requirement in the 1976 Copyright Act. Instead, it appears to have intended to incorporate the existing jurisprudence defining “originality” as meaning simply “not copied.”<sup>60</sup>

### 3. *Feist and the Creativity Threshold*

Nonetheless, just as the 1976 Act was being adopted, copyright jurisprudence began shifting toward adding the very creativity requirement that Congress was in the process of rejecting. In *Twentieth Century Music Corp. v. Aiken*, decided the year before the vote on the new Act, the Supreme Court for the first time stated

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1879 (1976) [hereinafter *House Hearings Pt. 2*] (statement of Rep. Drinan).

<sup>56</sup> See, e.g., *id.* at 96 (statement of Rep. Kastenmeier); 122 CONG. REC. 31985 (1976) (statement of Rep. Drinan); 122 CONG. REC. 3145 (1976) (statement of Sen. Hartke); 122 CONG. REC. 3832 (1976) (statement of Sen. Scott).

<sup>57</sup> For example, Rep. Kastenmeier, who led the bill through the House of Representatives, asked a witness at the hearings whether he agreed that the work of music performers is “creative, creative within the meaning of the copyright law?” *House Hearings Pt. 2, supra* note 54, at 1377. Plainly, Rep. Kastenmeier was inexperienced in the copyright law of the time. The word “creative” appeared nowhere in the 1909 Copyright Act, Pub. L. 60-349, 35 Stat. 1075 (1909); was not a requirement for protection in the bill then under consideration; and, as noted, was not a criterion for protection in the copyright case law at the time.

<sup>58</sup> General Revision of the Copyright Law, Title 17 of the United States Code, H.R. Rep. 94-1733 (1976).

<sup>59</sup> 17 U.S.C. § 801 (2012); see also *id.* §§ 112, 114 (same, relating to ephemeral recordings and sound recordings); *Copyright Law Revision: Hearing on S. 597 Before the Subcomm. on Patents, Trademarks, and Copyrights of the S. Committee on the Judiciary*, 90th Cong., 1st Sess., Pt. 1, at 96 (1967) (statement of Rep. Reinecke).

<sup>60</sup> See VerSteeg, *supra* note 31, *passim*.

unequivocally that the purpose of copyright law was to promote “creativity.”<sup>61</sup> This was not merely the purpose of the 1909 Act, according to the Court, but of the constitutional grant of authority. The Constitution’s Intellectual Property Clause, the Court wrote, has as its purpose encouraging and rewarding “[c]reative work.”<sup>62</sup> It continued that the copyright law’s “incentive” had as its “ultimate aim . . . to stimulate artistic creativity for the general public good.”<sup>63</sup> However, this language was mere dicta in the context of the case. At issue in *Twentieth Century Music v. Aiken* was whether a restaurant that played copyrighted songs on the radio was engaged in an infringing public “performance” of the protected works. The originality, much less the creativity, of the songs formed no part of the controversy.

That dicta was nevertheless echoed by the Second Circuit the following year, apparently through happenstance. Relying entirely on a statement in a popular treatise, and not citing *Aiken*,<sup>64</sup> the Second Circuit held in *L. Batlin & Son, Inc. v. Snyder* that creativity is indeed part of originality. In *Batlin*, at issue was whether a plastic toy bank could obtain a copyright, despite the fact that it was a close reproduction of an older, public domain cast iron toy bank. In finding the reproduction insusceptible to copyright, the Second Circuit held *en banc* that an expressive work does indeed need a “minimal element of creativity over and above the requirement of independent effort.”<sup>65</sup> The plastic toy and iron toy exhibited minor differences, so that it was not an exact copy. In finding that the “trivial” differences<sup>66</sup> between the two did not render the reproduction copyrightable, the Second Circuit held for the first time that some creativity in the sense of imagination or inventiveness was necessary for a work to qualify for a copyright. That fateful decision set the stage for the establishment of a new creativity standard in copyright law by the Supreme Court.

Within a decade, the Court itself endorsed the *Batlin* holding, again in dicta. In *Sony Corporation of America v. Universal City Studios*, the Court wrote that “[t]he purpose of copyright is to create incentives for creative effort,”<sup>67</sup> and again, “the ultimate aim [of the Copyright Act] is . . . to stimulate artistic creativity for the general public good.”<sup>68</sup> Artistic creativity is quite different from mental effort; the former seems to relate to the very aesthetic value that the Court had earlier rejected as relevant to originality analysis. Because the point was not necessary for its holding, the Court did not delve in depth into the authority for or reasoning underlying

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<sup>61</sup> 422 U.S. 151, 156 (1975).

<sup>62</sup> *Id.*

<sup>63</sup> *Id.*

<sup>64</sup> The Second Circuit also cited one of its own precedents, *Herbert Rosenthal Jewelry Corp. v. Grossbardt*, 436 F.2d 315, 316 (2d Cir. 1970), the citation is plainly in error. That case deals not at all with creativity; it was decided entirely on grounds of statutory notice.

<sup>65</sup> *L. Batlin & Son., Inc. v. Snyder*, 536 F.2d 486, 490 (2d Cir. 1976).

<sup>66</sup> *Id.* at 487.

<sup>67</sup> 464 U.S. 417, 450 (1984).

<sup>68</sup> *Id.* at 436.

these statements. But it did provide a rhetorical precedent for a major change in its jurisprudence.

The Court took the final leap, incorporating creativity into a binding precedent, in *Feist Publications v. Rural Telephone Services*.<sup>69</sup> At issue in *Feist* was whether a telephone directory, comprising a complete, alphabetically organized list of the names, telephone numbers, and townships of all subscribers in a region, was copyrightable subject matter. The Court held the work ineligible for copyright protection. In rejecting the copyright on the directory, the Court held that that a compilation of facts, such as names and telephone numbers, lacks originality unless the compilation “possesses at least some minimal degree of creativity.”<sup>70</sup> As in *Twentieth Century Music*, the Court held this to be a constitutional requirement, implicit in the use of the word “authors” in the Intellectual Property Clause.<sup>71</sup> Apparently, the Court believed a person cannot be an “author” without some modicum of artistic creativity. Because an alphabetically list of all telephone subscribers entirely lacks such creativity, the Court found it not to be copyrightable subject matter.

To justify holding that the Copyright Act requires creativity, the Court relied on two nineteenth century precedents, *The Trade-Mark Cases* and *Burrow-Giles Lithographic Co. v. Sarony*.<sup>72</sup> As discussed, *The Trade-Mark Cases* in no way supports the introduction of a creativity requirement into copyright law; the Court in that case was simply referring to “intellectual labor,” which need not be artistically creative.<sup>73</sup> As for *Burrow-Giles*, that case supported a creativity requirement still less. The Court there held that the Constitution limits the availability of copyrights to the original writings of authors, which it defined as “he to whom anything owes its origin; originator; maker.”<sup>74</sup> It would be difficult to formulate a clearer definition of originality as “not plagiarized.” As with *The Trade-Mark Cases*, the Court derived the creativity component from the *Burrow-Giles* Court’s reference to the author’s “intellectual conceptions.”<sup>75</sup> But to equate intellectual conceptions with creativity (which, for that matter, was not at issue in *Burrow-Giles*) implies that creativity means nothing more than something thought up by its creator. Nothing about an original intellectual conception requires it to be anything but pedestrian, as long as it is not copied from someone else. The directory was an intellectual conception, in the sense that the plaintiffs were the first to perform the mental labor necessary to create

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<sup>69</sup> *Feist Publ’ns, Inc. v. Rural Tele. Serv. Co.*, 499 U.S. 340 (1991).

<sup>70</sup> *Id.* at 345.

<sup>71</sup> *Id.* at 346, 348–49.

<sup>72</sup> 111 U.S. 53 (1884).

<sup>73</sup> The claim that researching and compiling a complete directory of all telephone subscribers requires no intellectual labor would be hard to support, but my point here is not to emphasize the debility of the Court’s application of the law to the facts before it. It is instead that the Court was misinterpreting the law in the service of inventing a new creativity requirement.

<sup>74</sup> *Id.* at 58.

<sup>75</sup> *Feist*, 499 U.S. at 346.

the compilation. The result was, of course, very practical and unimaginative, but that it was the result of intellectual labor is beyond dispute.

Ultimately, *Feist* is best viewed as an innovation to resolve the tension between the idea/expression dichotomy. Under existing copyright jurisprudence, facts and ideas themselves are ineligible for copyright protection,<sup>76</sup> while compilations of facts, such as historical timelines, may be copyrightable.<sup>77</sup> To the extent that facts may be selected and arranged in an effectively infinite variety of equally useful or entertaining configurations, there is no reason to deny a copyright on the author's specific choice. But the Court may have intuited that, when the selection and arrangement is inherently useful, a copyright on the compilation could have two serious, negative consequences. First, the copyright would empower the owner to limit important modalities of communication by others, in derogation of the principles of freedom of expression protected by the First Amendment.<sup>78</sup> A person may be the first to write a list of U.S. states in order of population or admission to the union. That makes the recitation original to the writer. But allowing a copyright for such a routine and unadorned catalog of facts would close off a fundamental avenue of expression and, by extension, thought. The objection is not that the compilation is uncreative; it is that granting a copyright would allow the owner to control an important form of communication for which there is no easy substitute.

Second and relatedly, the compilation, if useful, encroaches on the patent law, because useful configurations of facts fall within the purview of patent, not copyright.<sup>79</sup> The fundamental purpose of the utility patent law is to protect practical inventions, whereas the purpose of copyright law is to protect expressive works whose sole function is informational or aesthetic.<sup>80</sup> When a novel procedure or tool has a commercial or industrial function, patent and not copyright is the appropriate mechanism of protection.

Unfortunately, both of these observations are absent from the majority opinion in *Feist*, and it is perhaps because Justice O'Connor failed to perceive the nuances of the underlying reason for limiting copyright on certain compilations of facts that she felt it necessary to invent a new creativity requirement as a limiting principle.<sup>81</sup> Whatever the reason for the broad new requirement, *Feist* decisively established creativity as a component of copyright law under the rubric of originality. After *Feist*,

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<sup>76</sup> *Mazer v. Stein*, 347 U.S. 201, 217 (1954); *Harper & Row Pubs., Inc. v. Nation Enters.*, 471 U.S. 539, 556 (1985); see 17 U.S.C. § 102(b) (2012) (“In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.”).

<sup>77</sup> *Feist*, 499 U.S. at 345.

<sup>78</sup> *Id.* at 362.

<sup>79</sup> See *Baker v. Selden*, 101 U.S. 99, 105 (1879).

<sup>80</sup> See Dennis S. Karjala, *The Relative Roles of Patent and Copyright in the Protection of Computer Programs*, 17 J. MARSHALL J. COMPUTER & INFO. L. 41, 48 (1998).

<sup>81</sup> It is ironic that the Court purported to locate the creativity requirement in precedential references to “intellectual labor,” *Feist*, 499 U.S. at 353, while actually rejecting “intellectual labor,” or “sweat of the brow” as it wrote, as a sufficient qualification for copyrightability.

an expressive work<sup>82</sup> must evidence some quantum of mental activity so that the work is more than a slavish copy of a prior work or a trivial variation on it.<sup>83</sup>

In the end, *Feist* created more problems than it solved. The *Feist* opinion never did define “creativity,” or specify precisely how much was needed. Instead, aside from observing that the creativity must be “more than *de minimis*,”<sup>84</sup> it primarily defined creativity in the negative, throwing out scattered hints about what creativity is not. A compilation of facts selected and arranged in a “mechanical or routine” way would be insufficiently creative, for example.<sup>85</sup> The Court also criticized the plaintiff for not arranging the facts in the directory in an “innovative or surprising way.”<sup>86</sup> The arrangement was “entirely typical,” “garden-variety,” maximally “obvious,”<sup>87</sup> “unoriginal,” and “firmly rooted in tradition and so commonplace that it has come to be expected as a matter of course.”<sup>88</sup> Apparently, such productions did not exhibit sufficient creativity. The adjectives chosen by the Court, especially “innovative” and “surprising,” are broadly consistent with the common dictionary definition of “creativity”: “the use of imagination or original ideas to create something; inventiveness.”<sup>89</sup> The emphasis on the innovative and unusual suggests that the Court considered creativity something more than the obvious or quotidian.

In terms of the quantum of creativity necessary, the Court repeatedly emphasized that the threshold is “minimal”: “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.”<sup>90</sup> Elsewhere, the Court characterized the creativity threshold as a “modicum,”<sup>91</sup> “not particularly stringent,” and posing no obstacle to “the vast majority of compilations.”<sup>92</sup> An insufficiently creative work

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<sup>82</sup> The *Feist* decision is technically limited to requiring some creativity in the selection, coordination or arrangement of compilations of data. It had no application to original theatrical works, motion pictures, novels, stories, poems, paintings, sculptures, photographs, or any other copyrightable subject matter that did not involve the assembly of preexisting facts. To the extent that the Court purported to decide more, that part of the opinion is dicta. Nonetheless, courts have sometimes evaluated the creativity of non-compilations such as sculptures and paintings, *See* Howard B. Abrams, *Originality and Creativity in Copyright Law*, 55 LAW & CONTEMPORARY PROBLEMS 1, 32–33 (1992).

<sup>83</sup> *Feist*, 499 U.S. at 346.

<sup>84</sup> *Id.* at 363.

<sup>85</sup> *Id.* at 362.

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

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

<sup>88</sup> *Id.* at 363.

<sup>89</sup> *Creativity*, OXFORD DICTIONARY OF ENGLISH (3d ed. 2010)

<sup>90</sup> *Feist*, 499 U.S. at 345 (citation omitted). The Court later repeats that, to qualify for copyright protection, factual compilations must “entail a minimal degree of creativity.” *Id.* at 348; *see also id.* at 358. It seems likely that Justice O’Connor confused “minimal” with “minimum” in that statement; otherwise, the opinion would disqualify from copyright protection any compilation displaying greater than minimal creativity.

<sup>91</sup> *Id.* at 346, 362.

<sup>92</sup> *Id.* at 358–59; *see also id.* at 362 (reemphasizing the non-stringency of the standard).

would only be one “in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent.”<sup>93</sup>

What can be inferred from this hodgepodge is that the creativity required by the Copyright Act involves imagination or at least innovation, but no more than a “minimal” or a “non-trivial” amount. Beyond that, little guidance can be gleaned. The Court put in such sparse effort to maintain consistency of terminology that it failed to maintain even consistency of logic. How can copyright law require a work to be “innovative or surprising,” even while its creative spark is “obvious?” The terms are antonyms. Focusing on the apparent intention of the Court rather than its specific wording, the “creativity” that the Copyright Act seems intended promote probably does not quite require an exercise of imagination. Instead, it seems to require what the Supreme Court of Canada has characterized as an exercise of some “skill and judgment.”<sup>94</sup> If that is an accurate reading, works of rigorous and methodical historical nonfiction, geographical maps, and other such works are entitled to copyright protection because they ineluctably involve some idiosyncratic choices, some skill or judgment, by the creator, even if the choice of describing historical events in discrete episodes or designing topographical data on a map by an unusual choice of colors or lines might not be considered creative in the sense of imaginative or ingenious.

Subsequent cases have confirmed the development of copyright jurisprudence along the lines outlined in *Feist*. The standard of originality is interpreted with notable consistency to require very modest creative input. For example, in *Greene v. Ablon*, the First Circuit held that a self-help book author’s metaphor, characterizing the parent of a deeply troubled child as a “tour guide” through the child’s emotional journey, “easily passes the threshold of creativity the law requires.”<sup>95</sup> Similarly, in *Kregos v. Associated Press*, the Second Circuit held that a form displaying factual information about the past performance of different baseball pitchers, such as win/loss records, earned run averages, and men on base averages, was sufficiently original to merit copyright protection.<sup>96</sup> The tour guide metaphor in *Greene* and the pitching guide in *Kregos* might both be novel and appropriate, but neither the equation of parental guidance with tour guidance, nor the compilation of data about a baseball player’s past performance, could be considered a monument to the powers of human imagination. Courts have limited the originality jurisprudence to denying copyright

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<sup>93</sup> *Id.* at 358–59.

<sup>94</sup> *CCH Canadian Ltd. v. Law Soc’y of Upper Can.*, 2004 SCC 13, [2004] 1 S.C.R. 339, paras. 15–16 (Can.). The Court went on to elaborate: “By skill, I mean the use of one’s knowledge, developed aptitude or practised ability in producing the work. By judgment, I mean the use of one’s capacity for discernment or ability to form an opinion or evaluation by comparing different possible options in producing the work.” *Id.* para.16.

<sup>95</sup> 794 F.3d 133, 160 (1st Cir. 2015).

<sup>96</sup> 937 F.2d 700, 704–09 (2d Cir. 1991).

protection almost exclusively to routine combinations of facts,<sup>97</sup> and platitudes such as stock phrases (“Let’s go, Cubs!”).<sup>98</sup>

*Feist* is now established jurisprudence. Indeed, Congress has since taken a step that could be construed as approving the Court’s interpretation of the Copyright Act. In the Digital Millennium Copyright Act of 1998,<sup>99</sup> Congress extended statutory copyright protection to industrial designs. That section applies only to “original designs,” which it specifically defines as a design that is “the result of the designer’s creative endeavor that provides a distinguishable variation over prior work pertaining to similar articles which is more than merely trivial and has not been copied from another source.”<sup>100</sup> Section 1301 defines originality as having two aspects, then: no plagiarism and a nontrivial variation from prior works.<sup>101</sup> Although this provision applies only to original designs of useful articles and not to copyright in general, it uses the same term found in section 102 (original) and clearly requires more than non-plagiarism. This suggests, at least indirectly, that Congress approves of both the incorporation of a creativity requirement and an exceedingly low standard for that requirement.

Does the foregoing analysis establish that copyright law’s purpose is to foster creativity? Far from it. It shows that modern copyright jurisprudence has evolved to require a very small amount of skill or judgment as a precondition to copyright protection. It follows only that copyright law is not designed to promote the production of entirely uncreative works. This may seem like a six-of-one-and-a-half-dozen-of-the-other situation, but it is far from it. Copyright law could hardly be designed to foster creativity if any obvious variation on preexisting works, barely more than trivial, qualifies for protection. If the purpose of copyright law were to foster creativity, it would either require a significant standard of creativity as a precondition to copyright, or it would provide some metric for the creativity of expressive works and scale the protection to that metric. It does neither. Once a court has determined that the modicum of creativity exists, it makes no effort to evaluate the level of imagination in the protected work.<sup>102</sup>

Finally, there is supportive evidence that promoting creativity is not at the center of copyright law. Independent creation is a defense to a claim of copyright infringement and a basis for protection.<sup>103</sup> If a junior author creates a work

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<sup>97</sup> See, e.g., *Matthew Bender & Co. v. Kluwer Law Book Publishers, Inc.*, 672 F. Supp. 107, 110 (S.D.N.Y. 1987).

<sup>98</sup> See, e.g., *Syrus v. Bennett*, 455 F. App’x 806, 808–09 (10th Cir. 2011).

<sup>99</sup> Pub. L. 105-304, tit. V, sec. 502, Oct. 28, 1998, 112 Stat. 2860 (codified as amended at 17 U.S.C. § 1301 (2012)).

<sup>100</sup> 17 U.S.C. § 1301(a)(1), (b)(1) (2012).

<sup>101</sup> 17 U.S.C. § 1301(b)(1) (2012).

<sup>102</sup> In this, courts use the doctrine of avoidance, first announced in *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903) (“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.”). See generally Christine Haight Farley, *Judging Art*, 79 TUL. L. REV. 805 (2005).

<sup>103</sup> *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 54 (2d Cir. 1936).

remarkably similar or even identical to a senior author's work, without having copied the senior work, then the junior author's work is equally entitled to copyright protection. If copyright were all about creativity for the public benefit, an independent creation defense result would be anomalous. The public derives no creative benefit from multiple identical books, films, songs or paintings. Of course, one could answer that copyright law promotes the *efforts* of authors to be creative, but that cannot be quite right either. An expressive work will be denied copyright protection regardless of how hard its creator *tried* to be innovative or imaginative if the resulting work displays no more than trivial creativity. Copyright law, then, cannot be primarily about promoting creativity after all. What it is actually about will be discussed in Part III, below.

### B. Nonobviousness: The Patent Law Standard

The belief that patents are designed to promote creativity is as widespread as the same belief with respect to copyrights. Although the term "creativity" was never used in the legislative drafting of the 1952 Patent Act, the term and analogous terms have long appeared in patent jurisprudence. The belief that patent law is designed to promote creativity, then, does not appear immediately implausible.

Indeed, at least some members of Congress seem to believe creativity lies at the very center of patent law. In debating the America Invents Act of 2012 (AIA) and its numerous predecessor patent-reform bills, several representatives and senators asserted that creativity in the United States is promoted by or attributable to patent law. Senator Leahy announced, for example, that, "if we are to continue to enjoy the fruits of the most creative citizens, then we must have a patent system that produces high quality patents . . . ."<sup>104</sup> Senator Risch, a co-sponsor of the AIA, thought the bill was important because "creativity [is] on the line."<sup>105</sup> Representative Goodlatte viewed the constitutional patent power as reflecting "the incredible foresight" of the Framers "to realize that this type of incentive was crucial to ensure that America would become the world's leader in innovation and creativity."<sup>106</sup> Representative Smith asserted that the patent laws "provide a time-limited monopoly to inventors in exchange for their creative talent," something necessary "to foster future creativity."<sup>107</sup> Representative Schumer added: "By rewarding innovators for inventing newer and better products, we keep America's creative and therefore economic core healthy."<sup>108</sup> The belief in patent law's incentive for creativity is

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<sup>104</sup> 157 CONG. REC. S1350 (daily ed. Mar. 8, 2011).

<sup>105</sup> 157 CONG. REC. S1181 (daily ed. Mar. 3, 2011).

<sup>106</sup> *Amendment in the Nature of a Substitute to H.R. 2795, The "Patent Act of 2005": Hearing before the Subcomm. on Courts, the Internet, and Intellectual Property of the Comm. on the Judiciary, H.R.*, 109th Cong. 60 (2005).

<sup>107</sup> *America Invents Act, Hearing Before the Subcomm. on Intellectual Property, Competition, and the Internet of the Comm. on the Judiciary, H.R.*, 112th Cong. 42 (2011); *see also* 157 CONG. REC. H4423-24 (daily ed. June 22, 2011).

<sup>108</sup> 157 CONG. REC. S5409 (daily Sept. 8, 2011); *see also, e.g.*, 157 CONG. REC. S1108 (daily ed. Mar. 2, 2011) (statement of Sen. Durbin) (criticizing the U.S. patent system for not "keeping pace with the creativity of our country"); 157 CONG. REC. S221-22 (daily ed. Jan. 25, 2011) (statement of Sen.

apparently widespread in Congress. But whether the belief is accurate is another question.

### 1. *Invention: The Judicial Standard of Patentability*

The belief that patents encourage creativity has a considerably stronger foundation than the same belief about copyrights. Patent jurisprudence has long recognized that not everything technically novel qualifies for a patent; some additional mental achievement is necessary. Although judicial language describing the additional requirement has varied over time, something akin to creativity has been considered implicit in the very concept of invention since *Hotchkiss v. Greenwood* in 1850.<sup>109</sup> Improvements insufficiently different from existing technologies were said to “lack . . . invention” and therefore did not qualify for a patent.<sup>110</sup>

That the function of patent law is to encourage creativity seems to follow from this requirement of “invention.” An invention must perforce be inventive. “Inventive” is a common synonym of “creative,”<sup>111</sup> and so deducing that patents encourage creativity seems logical. The patent jurisprudence has accordingly long described the function of patent law as promoting creativity<sup>112</sup> or some approximate synonym<sup>113</sup> such as “ingenuity,”<sup>114</sup> “creative genius,”<sup>115</sup> or “inventive genius.”<sup>116</sup>

Baucus) (“I strongly believe in the importance of patents. America is a land that fosters innovation and competitiveness by allowing inventors to benefit from their creative ideas.”); 153 CONG. REC. 23927 (2007) (statement of Rep. Conyers) (calling patents “the driving force for American competition, creativity, inventiveness, and a prosperous economy.”).

<sup>109</sup> 52 U.S. 248 (1850).

<sup>110</sup> Cf. S. Rep. No. 82-1979, at 15 (1952), as reprinted in 1952 U.S.C.C.A.N. 2394, 2411.

<sup>111</sup> PETER MARK ROGET, ROGET’S THESAURUS OF ENGLISH WORDS AND PHRASES 296 (Robert A. Dutch ed., 1965).

<sup>112</sup> See, e.g., *Hammond Buckle Co. v. Goodyear Rubber Co.*, 58 F. 411, 413–14 (2d Cir. 1893); *Nat’l Safety Lift Co. v. Anderson*, 276 F. 696, 698 (1st Cir. 1921) (“In order to be an invention, a thing must be a discovery, a work of the inventive and creative faculty, and not merely the exercise of reason and experience, or the act of a mechanic skilled in the art.”); *Comm’r of Internal Revenue v. Affiliated Enters.*, 123 F.2d 665, 667 (10th Cir. 1941) (“A patent simply grants the exclusive right to the use of the creative idea.”); *Intercontinental Great Brands LLC v. Kellogg N. Am. Co.*, 869 F.3d 1336, 1346 (Fed. Cir. 2017) (referring to nonobviousness as requiring the exercise of more than “ordinary creativity”); *Ryko Mfg. Co. v. Nu-Star, Inc.*, 18 U.S.P.Q.2d 1047, Civ. No. 4-89-669, 1990 WL 290148, at \*5 (D. Minn. 1990) (“[T]he purposes of the patent laws [are] to protect and facilitate creativity and inventiveness.”).

<sup>113</sup> See ROGET, *supra* note 111, at 296.

<sup>114</sup> E.g., *Hotchkiss v. Greenwood*, 52 U.S. 248, 253 (1850); *Cuno Eng’g Corp. v. Automatic Devices Corp.*, 314 U.S. 84, 90 (1941) (“Since *Hotchkiss v. Greenwood*, . . . it has been recognized that if an improvement is to obtain the privileged position of a patent more ingenuity must be involved than the work of a mechanic skilled in the art.”); *Application of Sprock*, 301 F.2d 686, 689 (C.C.P.A. 1962); *Plax Corp. v. Precision Extruders, Inc.*, 239 F.2d 792, 794 (3d Cir. 1957); *Blish, Mize and Silliman Hdwe. Co. v. Time Saver Tools, Inc.*, 236 F.2d 913, 914–15 (10th Cir. 1956); see also *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 11 (1966) (“*Hotchkiss*, by positing the condition that a patentable invention evidence more ingenuity and skill than that possessed by an ordinary mechanic acquainted with the business, merely distinguished between new and useful innovations that were capable of sustaining a patent and those that were not.”).

<sup>115</sup> E.g., *Cuno Eng’g Corp.*, 314 U.S. at 91.

<sup>116</sup> E.g., *Time Saver Tools*, 236 F.2d at 915.

The variation in terminology arose from the absence of any definition of “invention” in the patent statutes prior to 1952. Relying primarily on intuition and a gradually accreting series of *ad hoc* doctrines, courts adopted and applied a standard of inventiveness that, in practice, varied from case to case. For example, before 1952, the Supreme Court had developed reasonably firm rules that the mere dilution, concentration, or purification of a preexisting chemical<sup>117</sup>; or the mere substitution of one known material for another in a mechanical device with predictable effects;<sup>118</sup> or the combination of known elements without changing the function of any of the combined elements;<sup>119</sup> could not be inventive. But these were piecemeal doctrines that remained undertheorized and gave no guidance in non-analogous situations. In adopting the 1952 Patent Act, Congress redefined the concept of invention for the first time, and it did so in new terminology.

## 2. *Nonobviousness: The Statutory Standard*

The term Congress chose for the 1952 Act was “obviousness,” terminology similar to that used in a few prior judicial decisions.<sup>120</sup> The first draft patent bill introduced the term “obvious” as a newly codified disqualification of patentability, and it further provided that the relevant consideration was the “nature of the contribution to the advancement of the art” and not “the nature of the mental processes by which such contribution may have been accomplished.”<sup>121</sup> The wording of the latter provision was modified in a new bill that ultimately became the 1952 Patent Act. Section 103 of that Act now provides:

A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed [in the prior art], if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.<sup>122</sup>

Although the drafters of the 1952 Act represented the bill as a mere codification of then-existing patent laws,<sup>123</sup> in fact this definition was considered one of the bill’s main innovations.<sup>124</sup> It was hoped by the drafters that the new language “would

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<sup>117</sup> See, e.g., *Cochrane v. Badische Anilin & Soda Fabrik Co.*, 111 U.S. 293, 311–12 (1884); *Am. Wood-Paper Co. v. Fibre Disintegrating Co.*, 90 U.S. (23 Wall) 566, 593–94 (1874).

<sup>118</sup> See, e.g., *Hotchkiss v. Greenwood*, 52 U.S. (11 How.) 248, 265–67 (1850).

<sup>119</sup> See, e.g., *Funk Bros. Seed Co. v. Kalo Inoculant Co.*, 333 U.S. 127, 129–30 (1948).

<sup>120</sup> See S. Rep. No. 82-1979 (1952), reprinted in 1952 U.S.C.C.A.N. 2394, 2397–99.

<sup>121</sup> Staff of S. Subcomm. on Patents, Trademarks, and Copyrights of the Comm. on the Judiciary, 85th Cong., *Efforts to Establish a Statutory Standard of Invention* 10 (Comm. Print 1958).

<sup>122</sup> Pub. L. No. 82-593, 66 Stat. 792, 798 (codified as amended at 35 U.S.C. § 103 (2015)).

<sup>123</sup> See Linda Demaine & Aaron Fellmeth, *Reinventing the Double Helix: A Novel and Nonobvious Reconceptualization of the Biotechnology Patent*, 55 STAN. L. REV. 303, 366–67 (2002).

<sup>124</sup> STAFF OF COMM. OF THE JUDICIARY, H.R., 82D CONG., *Revision of Title 35, United States Code: “Patents”*, H.R. Rep. No. 82-1923, at 5 [hereinafter House Judiciary Committee Patent Bill Report].

introduce more definiteness and have some stabilizing effect” on the jurisprudence relating to the invention requirement.<sup>125</sup> In particular, the last sentence was intended to correct certain case law that, the drafters thought, put too much emphasis on the manner by which an invention was achieved and not enough on the merits of the invention itself.<sup>126</sup>

What reframing the concept accomplished is twofold. First, it explicitly identifies the relevant perspective as being the “person of ordinary skill in the art to which the claimed invention pertains” or “POSITA.”<sup>127</sup> The idea underlying this addition to the Act is that different persons have different standards of what seems obvious, depending on their education, training, and experience. What might appear an extremely surprising variation on existing technology to a person with no relevant training or experience might seem entirely predictable to a technician of average training and experience at the time of the invention<sup>128</sup> (or, after the AIA, filing of the patent application). Judges and juries are not persons of ordinary skill in any field of science or engineering. The factfinders are consequently directed to consider the evidence about the facts and inferences available to an expert in the relevant field rather than relying on their own, personal guesswork and assumptions.

The second innovation of the 1952 Act’s Section 103 was the substitution of the concept of obviousness for the concepts of inventiveness or ingenuity, and the accompanying negation of the relevance of the means of discovery of the invention. The term “obvious” is not defined in the Act, and the concept of obviousness is no more semantically self-defining than are the concepts of ingenuity or inventiveness.<sup>129</sup> However, the Oxford English Dictionary definition does suggest that an innovation is obvious when it is easily perceived by the mind or is highly predictable.<sup>130</sup> Given this common understanding, an invention discovered by accident or thorough research could be as unpredictable, and therefore as

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<sup>125</sup> *Patent Law Codification and Revision: Hearing on H.R. 3760 Before the H.R. Subcomm. No. 3 of the Comm. on the Judiciary*, 82d Cong. 38 (1951) (statement of P.J. Federico, U.S. PTO Examiner in Chief) [hereinafter *Patent Law Codification Hearings, June 13, 1951*]; see also House Judiciary Committee Patent Bill Report, *supra* note 124, at 7 (“[Section 103] is added to the statute for uniformity and definiteness. This section should have a stabilizing effect and minimize great departures which have appeared in some cases.”); S. Rep. No. 82-1979 (1952) (repeating the House Report).

<sup>126</sup> See *Patent Law Codification Hearings, June 13, 1951, supra* note 125, at 45 (statement of the American Patent Law Association); *E.J. Brooks Co. v. Stoffel Seals Corp.*, 266 F.2d 841, 846 (2d Cir. 1959) (“The establishment of a more liberal standard than the ‘flash of creative genius’ doctrine enunciated in the *Cuno* case was apparently one of the principal reasons why Congress passed the 1952 Patent Act . . .”).

<sup>127</sup> Pub. L. No. 82-593, 66 Stat. 792, 798.

<sup>128</sup> The Supreme Court first held that the level of expertise of the POSITA was a relevant consideration in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966).

<sup>129</sup> This was the position taken by the head of the Department of Justice’s Patent Litigation Unit at the time of drafting. See *Patent Law Codification Hearings, June 13, 1951, supra* note 125, at 95 (statement of T. Hayward Brown).

<sup>130</sup> *Obvious*, OXFORD DICTIONARY OF ENGLISH (3d ed. 2010).

“nonobvious,” as an invention discovered through a flash of exceptional insight.<sup>131</sup> With the new Section 103, the House Judiciary Committee wrote in its report on the bill that “it is immaterial whether [the invention] resulted from long toil and experimentation or from a flash of genius.”<sup>132</sup> According to Giles Rich, one of the Act’s many drafters<sup>133</sup>:

There is a vast difference between basing a decision on exercise of the inventive or creative faculty, or genius, ingenuity, patentable novelty, flashes, surprises and excitement, on the one hand, and basing it on unobviousness to one of ordinary skill in the art on the other.<sup>134</sup>

Or, as one court put it, “Today, one may have a patent if he just ‘stumbled’ upon his invention or it might have even been the result of an accident.”<sup>135</sup>

An example of an accidental invention is the adhesive used in 3M’s Post-it® note.<sup>136</sup> The Post-it originated with Dr. Spencer Silver, who was researching “stronger, tougher adhesives.” One of Silver’s failed experiment resulted in a chemical that had adhesive properties remarkably weak, but capable of re-adhering after removal (“inherently tacky”). Silver predicted that such an adhesive could have a marketable use, but, after several years, he failed to think of one. Eventually, a co-worker named Art Fry remembered Silver’s invention when trying to think of a way to keep scraps of paper marking hymns sung in his church choir from falling out of the hymnal. Fry subsequently developed the Post-it, an adhesive note that will not damage the adhered-to surface and can be removed and reapplied freely.<sup>137</sup>

Similarly, an accident does not result from the discoverer’s “creativity” by definition, because no mental labor or skill is involved in the relevant production. On the contrary, the accident results from a failure of labor or skill. Where mental work comes in is the discoverer’s *appreciation* of the accident’s value as a useful product or process. In the case of the Post-it note, Fry’s appreciation of the utility of the adhesive resulted from an insight, arrived at by combining his need for adhesive paper scraps that would not damage his hymnal and his recollection of the tacky glue discovered by Silver. To call such an insight “creative” robs the term of its specific meaning. By the same logic, it would be “creative” for someone lacking a hammer to realize that a flat rock could drive in the nail almost as well. Such insights are not creative, they are perceptive. The point is, an accident with unexpected effects can

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<sup>131</sup> S. REP. NO. 82-1797, *reprinted in* 1952 U.S.C.C.A.N. 2394, 2411.

<sup>132</sup> House Judiciary Committee Patent Bill Report, *supra* note 124, at 18; S. Rep. No. 82-1979, at 16 (1952), *as reprinted in* 1952 U.S.C.C.A.N. 2394, 2411.

<sup>133</sup> *See* House Judiciary Committee Patent Bill Report, *supra* note 124, at 3.

<sup>134</sup> Giles S. Rich, *The Principles of Patentability*, 42 J. PAT. OFF. SOC’Y 75, 89–90 (1960).

<sup>135</sup> *Gagnier Fibre Prods. Co. v. Fourslides, Inc.*, 112 F. Supp. 926, 929 (E.D. Mich. 1953).

<sup>136</sup> U.S. Patent No. 3,691,140 (filed Sept. 12, 1972).

<sup>137</sup> U.S. Patent No. 5,194,299 (filed Mar. 16, 1993). *See* Nick Glass & Tim Hume, *The “Hallelujah Moment” Behind the Invention of the Post-it Note*, CNN (Apr. 4, 2013), <https://www.cnn.com/2013/04/04/tech/post-it-note-history/index.html>.

be converted into an invention through insight or perceptiveness; no creative thought process is required.

The same is true *a fortiori* in the case of inventions arrived at through painstaking, repetitive, and mechanical research, with no particular insight at all. Under Section 103, these qualify for a patent as well, if the resulting invention (or its function) is sufficiently nonobvious. The classic example of such an invention is Thomas Edison's revolutionary discovery of a reliable filament for the incandescent lamp. Prior to Edison's discovery, platinum and carbon were the most common experimental filament materials, but ordinary carbon burned too easily and platinum was extremely expensive.<sup>138</sup> In search of a material that could be heated to incandescence without destroying it, Edison's laboratory workers systematically tested an astonishing array of random materials.<sup>139</sup> One researcher on filament coatings has been described as "willing to try anything once,"<sup>140</sup> and another experimented on such inexplicable choices as leather, flour paste, macaroni, and sassafras.<sup>141</sup> Edison's ultimate success in identifying Japanese bamboo as the best base material for the filament<sup>142</sup> is primarily attributable, not to creative thinking directed by informed theories, but rather to his large staff and very substantial financial backing, which allowed him to obtain a wider variety of materials and conduct research on them more thoroughly than his competitors.<sup>143</sup> Edison and his research team eventually perceived the patterns of increasing success, which allowed them gradually to narrow the material choices to more and more likely candidates. But it was painstaking and mechanical experimentation that drove those perceptions, not imagination.<sup>144</sup>

Indeed, it follows from the last sentence of Section 103 that no actual creativity (in the sense of imagination or ingenuity) is required to entitle an inventor to a patent. Patient and routine experimentation using exhaustive methods to solve a technical

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<sup>138</sup> ROBERT FRIEDEL & PAUL ISRAEL, *EDISON'S ELECTRIC LIGHT: THE ART OF INVENTION* 7 (2010).

<sup>139</sup> See FRIEDEL & ISRAEL, *supra* note 138, at 11–12 (iridium, ruthenium, chromium, aluminum, silicon, tungsten, molybdenum, palladium, boron, titanium, and manganese), 36 (gold, rhodium, iridosmine, and nickel), 60 (iron), 63 (acetate of magnesia, acetate of silica, cerium oxide, barium nitrate, zirconium compounds, etc.), 67–68 (tissue paper coated with lampblack and tar, wood slivers, and broom corn), 78 (fish line, vulcanized fiber, soft paper, cardboard, cotton soaked in tar, etc.), 79–80 (carbonized celluloid, shavings from a variety of woods, cork, flax, coconut fiber, coconut shell, etc.), 107–08 (leather, pith, various plant parts and wood fibers), 128 (willow, palm leaf, palmetto, bamboo and bast).

<sup>140</sup> *Id.* at 63.

<sup>141</sup> *Id.* at 107–08.

<sup>142</sup> *Id.* at 129–30.

<sup>143</sup> *Id.* at 24, 34, 87 ("several million dollars of capital"), 118 (sixty-four workers researching the electric light for most of the period), 198.

<sup>144</sup> Friedel and Israel, after reciting in detail the history of the haphazard search for a reliable filament material, conclude that the electric light was "above all a product of creativity" and the product of "an extraordinary feat of creativity." *Id.* at 195, 199. This conclusion undoubtedly relates to the entire system (from the power generator designed by Edison's team to design of a new vacuum to void the bulb, to the shape of the filament). Their own history abundantly proves the opposite specifically with regard to choice of filament material.

problem, such as arbitrarily substituting one material after another to identify the most effective option, can result in a patent if the labor resulted in a novel invention that would not have been obvious to a person of ordinary skill in the art at the time of patent filing. Highly methodical but mechanical experimentation by known methods is the polar opposite of creative. It is routine and methodologically predictable, even if the result of the research is not. Creative thinking is, therefore, one path to satisfying Section 103. But it is not the only one.

If patent law does not actually require creativity as condition for the invention's patent, it makes little sense to assert that patent law's function is to encourage creativity. If that were its function, it would be easy enough to draft a Patent Act requiring creativity as a precondition to the patent grant. Instead, what the Act requires is a showing of nonobviousness. As the discussion of the legislative history above shows, this is no accident. In adopting a standard of nonobviousness, Congress made clear that patentability should not depend on the mental state of the inventor himself or herself. Notwithstanding the common references in judicial opinions and patent scholarship to the creative goals of patent law, creativity is not central to patentability.

### C. Distinctiveness: The Trademark Law Standard

No court calls creativity or ingenuity the touchstone of trademark, as many have done with both copyright and patent. On the contrary, the Supreme Court has specifically written that the common law foundations of trademark law “were *not* designed to protect originality or creativity.”<sup>145</sup> That sentiment resounds throughout trademark jurisprudence.<sup>146</sup> Instead, touchstone of trademark law has been consumer confusion that results in trade diversion, at least until recently.

Trademark infringement is statutorily defined as any unauthorized commercial use of a trademark on or in connection with goods or services that is likely to cause confusion, deception, or mistake about the source of the goods or services.<sup>147</sup> Over time, U.S. trademark law has shifted away from consumer protection and toward preserving brand value,<sup>148</sup> but trademarks are still viewed primarily as a device to facilitate consumer recognition of products originating from an identifiable source. Infringement requires a showing of likely consumer confusion, mistake, or deception caused by a commercial imitation of a registered mark.<sup>149</sup> The consumer's ability to

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<sup>145</sup> *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 37 (2003) (emphasis in original); *see also* *The Trade-Mark Cases*, 100 U.S. 82, 94 (1879) (holding that, unlike copyright law, trademark rights “grow[] out of . . . use” and do not “depend upon novelty, invention, discovery, or any work of the brain.”).

<sup>146</sup> *See, e.g.*, *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206, 224 n.20 (2d Cir. 2012); *EMI Catalog Partnership v. Hill, Holliday, Connors, Cosmopolos Inc.*, 228 F.3d 56, 63 (2d Cir. 2000); *Ward v. Andrews McMeel Pub., LLC*, 963 F.Supp.2d 222, 235 (S.D.N.Y. 2013).

<sup>147</sup> 15 U.S.C. § 1125(a)(1).

<sup>148</sup> *See* Mark McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1915–16 (2007).

<sup>149</sup> 15 U.S.C. § 1114.

recognize the connection between the mark and its source is, therefore, a logical precondition to trademark protection.

### *1. Categories of Distinctiveness*

Courts have developed a jurisprudence for assessing the likelihood of confusion about a product's source based on a list of factors, one of which is the source distinctiveness of the registered trademark. Marks are conventionally divided into four categories of ascending inherent distinctiveness. Generic terms refer to the "genus of which the . . . product is a species."<sup>150</sup> By definition, generic terms lack distinctiveness and can never be entitled to trademark protection for the goods or services they describe.<sup>151</sup>

Similarly, marks that merely describe the goods or services, or one of their common characteristics, cannot initially be entered on the principal trademark register.<sup>152</sup> Such marks are deemed descriptive. They cannot be inherently distinctive for the same reason generic marks cannot be distinctive; consumers will tend to see a descriptive term as relating to a quality of the marked goods and not designating a specific source for the goods.

Unlike a generic mark, however, a descriptive mark may become protectible. Language is organic and can change. Over time, a descriptive term such as BEST BUY or INTERNATIONAL BUSINESS MACHINES can become distinctive in consumer minds, forging a link between the mark and a specific source (in these examples, a chain store and a computer manufacturer). If a merchant can convincingly show that a descriptive term has acquired distinctiveness in the public mind apart from its merely descriptive function, the term can function as a trademark and be entered on the principal register.<sup>153</sup>

The third category is known as suggestive marks. Marks that merely imply the qualities of the product may be entered on the principal register and protected without any showing of secondary meaning. Suggestive marks are those terms that are not immediately descriptive, but are thought to require "imagination, thought and perception to reach a conclusion as to the nature of goods,"<sup>154</sup> or that describe an attribute of the product but "could plausibly describe a wide variety of products."<sup>155</sup> The final category, arbitrary and fanciful marks, are equally entitled to immediate registration. Arbitrary marks have no evident relationship to the goods or services offered under them, such as APPLE for electronics or AMAZON for an online bookstore. Fanciful marks are invented terms not previously existing in the lexicon, such as EXXON or ACURA. Although arbitrary and fanciful marks are considered

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<sup>150</sup> Park 'N Fly, Inc. v. Dollar Park & Fly, Inc., 469 U.S. 189, 194 (1985), *citing* Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4 (2d Cir. 1976).

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

<sup>152</sup> *See* Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 769 (1992).

<sup>153</sup> 15 U.S.C. § 1052(e)-(f).

<sup>154</sup> *E.g.*, DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd., 695 F.3d 1247, 1251–52 (Fed. Cir. 2012) (internal quotation marks omitted); *Abercrombie & Fitch Co.*, 537 F.2d at 11.

<sup>155</sup> Playtex Prods., Inc. v. Ga.–Pac. Corp., 390 F.3d 158, 164 (2d Cir. 2004).

the most inherently distinctive form of marks, they receive no greater priority in registration than suggestive marks, because any term that is neither generic nor descriptive is immediately registrable.<sup>156</sup>

Here, it will be helpful to recategorize trademarks into three registration classes: (1) non-registrable generic or descriptive terms, (2) registrable descriptive marks that have acquired distinctiveness, and (3) registrable inherently distinctive (suggestive, arbitrary, or fanciful) marks. The first category encompasses all terms lacking distinctiveness, while the second and third encompass the universe of distinctive marks that are entitled to registration regardless of whether the distinctiveness is inherent or acquired through consumer exposure to the mark. For purposes of registration, the second and third categories are equivalent in terms of the protection offered.

At the infringement stage, the analysis is slightly different. To prove infringement, the plaintiff must show a likelihood that relevant consumers will confuse the source of the allegedly infringing mark with that of the registered mark. All circuit courts employ a multifactor test to determine likelihood of confusion. Although the factors used in different circuits vary somewhat, every circuit evaluates the distinctiveness of the mark as part of its test.<sup>157</sup> The formal doctrine provides that, the more distinctive a trademark is, the more likely consumers are to confuse the mark with a similar term.<sup>158</sup> Therefore, doctrinally, greater distinctiveness provides the potential for slightly greater protection in an action for trademark infringement. Whether greater distinctiveness equates to greater protection in practice is another matter.

## 2. *Is Creativity Fundamental to Trademark Law?*

Distinctiveness is not creativity, but the two concepts intersect. Generic terms are necessarily uncreative, because they represent the most common and obvious labels for the attached goods or services. Descriptive marks tend to be minimally creative at best, because they merely recite what the product is, or a characteristic that the merchant wishes consumers to believe the product has. In contrast, fanciful marks are products of imagination, and therefore they can be considered “creative” in a general sense. In addition, many suggestive marks are quite creative, invoking or riffing on ideas or concepts tangential to the qualities or nature of the marked product or service without directly describing them. For example, the suggestive mark TREK for mountain bicycles is arguably creative because it does not describe any aspect of the goods, yet it implies that the marked products are suitable for challenging long-

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<sup>156</sup> See 15 U.S.C. § 1052(e).

<sup>157</sup> See Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 94 CAL. L. REV. 1581, 1587–91 (2006).

<sup>158</sup> *Blinded Veterans Ass’n v. Blinded Am. Veterans Found.*, 872 F.2d 1035, 1039 (D.C. Cir. 1989); *Sara Lee Corp. v. Kayser-Roth Corp.*, 81 F.3d 455, 464 (4th Cir. 1996); *Brookfield Commun., Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1053 (9th Cir. 1999). However, one study suggests that courts tend to weigh a few factors far more than others, and distinctiveness is rarely one of the influential factors in practice. See Beebe, *supra* note 157 at 1623.

distance journeys. While not all suggestive marks are creative in the sense of imaginative, many are.

In *The Role of Creativity in Trademark Law*, Jeanne Fromer advances a stronger claim. Fromer argues that there is “a strong emphasis in trademark law on rewarding creators” of creative marks.<sup>159</sup> Fromer builds her case on two claims. First, she observes that the *sine qua non* of trademark protection is a link between the trademark itself and the business that supplies the marked goods or services. A new link is created by the actions of the merchant and market, associating the term with the commercial enterprise. “[E]stablishing that link,” she concludes, “is . . . an exercise of creativity.”<sup>160</sup> It follows that all trademarks are creative, because all trademarks, including merely descriptive marks that develop a secondary meaning over time, create “a link between a mark and goods and services that has not previously existed.”<sup>161</sup>

Fromer’s second claim is that trademark law “gives an incentive to be ever creative in choosing trademarks that are inherently distinctive” by offering “the incentive of easier protection by choosing a suggestive, arbitrary, or fanciful term.”<sup>162</sup> The incentive occurs, she claims, at both the registration and infringement phases of trademark protection.<sup>163</sup> At the registration phase, as noted, descriptive marks cannot be registered on the Principal Register without evidence of secondary meaning, while suggestive, arbitrary and fanciful marks are all registrable.<sup>164</sup> However, Fromer also argues that trademark applicants “would typically prefer to avoid suggestive marks entirely instead using arbitrary or fanciful marks,” because the line between (presumptively unregistrable) descriptive marks and (registrable) suggestive marks is difficult to draw.<sup>165</sup> Fromer concludes from this that trademark law thereby encourages the use of more creative marks, which she appears to equate to arbitrary or fanciful marks.<sup>166</sup>

At the infringement stage, Fromer observes that the formal trademark doctrine theoretically grants greater protection to more distinctive marks.<sup>167</sup> If distinctiveness is correlated to creativity, then the increased protection for more distinctive marks rewards a creative choice of trademarks. Moreover, Fromer points out that courts typically factor into likelihood of confusion analysis any bad intent of the defendant in using the mark.<sup>168</sup> The theory is that a defendant who mimics a registered

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<sup>159</sup> Jeanne C. Fromer, *The Role of Creativity in Trademark Law*, 86 NOTRE DAME L. REV. 1885, 1900 (2011).

<sup>160</sup> *Id.* at 1905; *see id.* at 1920.

<sup>161</sup> *Id.* at 1905.

<sup>162</sup> *Id.* at 1908.

<sup>163</sup> *Id.* at 1909.

<sup>164</sup> Jeanne C. Fromer, *The Role of Creativity in Trademark Law*, 86 NOTRE DAME L. REV. 1885, 1888 (2011).

<sup>165</sup> *Id.* at 1912–13.

<sup>166</sup> *Id.* at 1920.

<sup>167</sup> *Id.* at 1907, 1909–10.

<sup>168</sup> *Id.* at 1911.

trademark specifically to confuse consumers and divert business to himself is more likely to succeed in sowing confusion than is a defendant whose mark is accidentally similar to another's.<sup>169</sup> Fromer argues that it is more likely that a merchant acting in good faith would accidentally use a mark similar to a less distinctive mark than to a more distinctive mark.<sup>170</sup> From this, she infers that the case law protects highly distinctive/creative marks more vigorously than less distinctive/creative marks.<sup>171</sup> Fromer concludes with the claim that "encouraging creativity lies at the heart of trademark law and theory."<sup>172</sup> Indeed, notwithstanding her recognition of the decisive judicial rejection of the relevance of creativity to trademark law, she insists that "promoting creativity" is "trademark law's fundamental purpose[]." <sup>173</sup>

### 3. *The Epiphenomenal Role of Creativity in Trademark*

Fromer makes an interesting but ultimately unsuccessful argument. Her conclusion that trademark law has a "drive to reward creativity"<sup>174</sup> is not much different than saying that conferring windfalls on victorious plaintiffs drives tort law and theory, because such windfalls are one possible result of a punitive damages award. In both cases, the effect is inconsistent and, in any case, an incidental byproduct of the law's real policy purpose. Not all successful tort actions result in punitive damages windfalls to the plaintiff and, when they do, the intended goal of punitive damages is actually deterrence of socially harmful behavior by the tortfeasor, not the arbitrary redistribution of wealth. Overcompensating the plaintiff is merely a means to motivate the plaintiff to incur the expense and risk of instigating the action. Similarly, in trademark law and theory, the intended goal of conferring trademark protection on some categories of marks and not others is protecting the value of the mark, maintaining legitimate consumer expectations, and avoiding consumer confusion.

That creativity is peripheral to trademark law is evident from several of the doctrine's important characteristics. Most obviously, creativity is neither necessary nor sufficient for protection. It is insufficient, because a creative mark is not entitled to registration unless it satisfies other requirements of the Lanham Act, such as use in commerce or the absence of likelihood of confusion with another mark. For example, a photograph of a celebrity will generally be sufficiently creative to qualify for copyright protection. However, the Sixth Circuit rejected an attempt to trademark such an image, holding that the appropriate test was distinctiveness and not originality.<sup>175</sup> As for its necessity, any analysis must begin with the criteria for the trademark grant. There is nothing creative *per se* about a descriptive term, and

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<sup>169</sup> Cf. *Bandag, Inc. v. Al Boser's Tire Stores, Inc.*, 750 F.2d 903, 915 (Fed. Cir. 1984) ("When an alleged infringer knowingly adopts the mark of another, courts presume that it can accomplish its purpose of deceiving the public."); *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 354 (9th Cir. 1979).

<sup>170</sup> Fromer, *supra* note 11, at 1911.

<sup>171</sup> *Id.* at 1911–12.

<sup>172</sup> *Id.* at 1902.

<sup>173</sup> *Id.* at 1916.

<sup>174</sup> *Id.* at 1887.

<sup>175</sup> *ETW Corp. v. Jireh Publishing, Inc.*, 332 F.3d 915, 922 (6th Cir. 2003).

descriptive terms are accordingly not entitled to automatic trademark protection. As noted, descriptive terms do become entitled to protection upon a showing of secondary meaning. Yet, descriptive terms themselves do not become a “creative” when linked to a business in the minds of consumers. The nature of the mark as unimaginative remains. What has occurred is that, either through the merchant’s marketing efforts or the natural functioning of the market itself, the term has acquired an additional denotation in the minds of consumers. The term now signifies not only its traditional lexical meaning, but in addition, a specific source of goods or services. Depending on the context, consumers now tend to interpret “best buy” as meaning either that a product is offered at the lowest price (the descriptive term) or as designating a specific chain of electronics stores (the new meaning, the trademark). There is nothing creative about the process of developing secondary meaning.

When Fromer characterizes that process as “creative,” it becomes apparent that she is using two entirely different definitions for the term in the same argument. To characterize that new link as “creative” suggests that the phenomenon Fromer discusses is extremely broad—not imaginative or inventive, but merely generative. Something exists that did not exist before. Therefore, Fromer concludes that “creativity” has happened. Defined in that manner, the term loses all analytical use. The creation of anything new, or even the reproduction of existing things, qualifies as “creativity” under this definition, and every variation on or reproduction of the familiar is creative, no matter how trivial. The first merchant to label a beer as “lite” instead of “light” is creative in this sense, because it “build[s] something new” by introducing an alternative spelling.<sup>176</sup> In fact, simply persuading a person to believe something, such as that the sun is more massive than the Earth, is “creative” in the same sense, insofar as the persuader has created a belief in someone’s mind that did not previously exist. In short, this aspect of Fromer’s argument treats creativity as coextensive with any creation.

In treating more distinctive marks as more creative, Fromer also seems to be using a different and more accepted definition of creativity, limited to acts of creation that are more than usually imaginative or inventive. She does not argue that imagination is necessary for trademark protection, but rather that more imaginative marks are entitled to greater protection. In using this second, narrower definition, Fromer is on firmer ground in tying creativity to trademark protection.

Even here, though, her argument claims far too much. Her link between distinctiveness and imaginative creativity is weak at best. Distinctiveness means “tending to indicate origin,”<sup>177</sup> which is a concept very different from creativity. Suggestive marks, which are more distinctive than descriptive marks, may or may not display greater imagination. Suggestive marks run along a spectrum between borderline descriptive and ingeniously oblique or witty. On the latter end of the spectrum are suggestive marks that do show undoubted creativity. BREWED

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<sup>176</sup> Fromer, *supra* note 11, at 1903.

<sup>177</sup> *Prone v. MacMillan, Inc.*, 894 F.2d 579, 583 (2d Cir. 1990).

AWAKENING for coffee shops<sup>178</sup> and SPEX IN THE CITY<sup>179</sup> for urban opticians are suggestive marks that could be described as highly creative. Yet, other suggestive marks show relatively little ingenuity. For example, SHARP for display monitors<sup>180</sup> or GREYHOUND for autobus transportation<sup>181</sup> are both suggestive marks, but they forcefully imply that the monitor crisply defines its picture and the buses are fast. Little creativity is needed to associate either term with its respective product or service, and no great creativity is evident in the choice of the mark in the first place:

“We should associate our bus service with something fast that people like.”

“Cheetah?”

“Not bad, but it sounds too much like ‘cheater,’ which has negative connotations.”

“Roadrunner?”

“Too descriptive. Buses travel on roads, if we’re doing our job right.”

“Rocket?”

“They frequently explode.”

“People like dogs. What’s the fastest dog? Greyhound?”

“Perfect.”

Fanciful marks such as PEPSI or CORIAN are at least a little bit creative by almost any definition, because they require the invention of a new term or phrase without the merchant being able to draw on an existing lexicon. However, part of Fromer’s argument assumes that arbitrary marks are inherently more creative than suggestive marks. They are not. Arbitrary marks may be highly distinctive, but they are not necessarily creative. It requires virtually no imagination to attach a random term to a product or service, such as labeling computer software LOTUS<sup>182</sup> or drive-in restaurants SONIC.<sup>183</sup> In fact, even by Fromer’s own broader definition of creativity, arbitrary marks are no more generative of new connections than are those descriptive marks having secondary meaning. In both cases, a new link between an existing word and a new product or service is forged in the minds of consumers.<sup>184</sup>

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<sup>178</sup> BREWED AWAKENINGS, <http://brewedawakenings.us/>.

<sup>179</sup> SPEX IN THE CITY, <https://spexinthecity.com/>.

<sup>180</sup> U.S. Trademark No. 86470179 (July 7, 2015).

<sup>181</sup> U.S. Trademark No. 71530196 (Aug. 1, 1947).

<sup>182</sup> U.S. Trademark No. 73718880 (Mar. 28, 1988).

<sup>183</sup> U.S. Trademark No. 72176119 (Aug. 30, 1963).

<sup>184</sup> Even if Fromer’s premise were analytically accurate, her conclusion that trademark law creates adequate incentives for merchants to seek more inherently distinctive marks is unsupported. She offers no evidence that descriptive or suggestive marks, which are fairly ubiquitous, outnumber arbitrary or fanciful marks either on the Principal Trademark Register or in actual commercial use.

There is, moreover, no reason to believe fanciful marks are necessarily more creative than suggestive marks. Which is more creative: to invent a neologism such as PEPSI or TYLENOL, or to find an indirect association between a word or words and the product or service, such as ANTHROPOLOGIE for home furnishings and women's clothing, or COPPERTONE for suntan lotion? There is simply no basis for concluding that fanciful marks as a class are more creative than suggestive marks as a class.

The unanimous Supreme Court, writing over a century ago in the *Trade-Mark Cases*, is worth quoting at length on this point:

The ordinary trade-mark has no necessary relation to invention or discovery. The trade-mark recognized by the common law is generally the growth of a considerable period of use, rather than a sudden invention. It is often the result of accident rather than design, and when under the act of Congress it is sought to establish it by registration, neither originality, invention, discovery, science, nor art is in any way essential to the right conferred by that act. . . . The trade-mark may be, and generally is, the adoption of something already in existence as the distinctive symbol of the party using it. At common law the exclusive right to it grows out of its use, and not its mere adoption. By the act of Congress this exclusive right attaches upon registration. But in neither case does it depend upon novelty, invention, discovery, or any work of the brain. It requires no fancy or imagination, no genius, no laborious thought. It is simply founded on priority of appropriation.<sup>185</sup>

That opinion remains controlling law today.<sup>186</sup> Although distinctiveness is loosely and inconsistently correlated to creativity, there is no basis for arguing that creativity is important to trademark law. Even if the two concepts were more closely correlated, the marginal additional weight theoretically given to more distinctive marks in likelihood of confusion analysis would not justify treating the promotion of creativity as a goal of trademark law, much less its “fundamental purpose.”

In summary, trademark doctrine neither requires creativity (as generally understood) nor significantly correlates greater rewards for more creative marks. All inherently distinctive marks are entitled to the same protection by registration, regardless of the presence or degree of creativity of the mark. In likelihood of confusion analysis, a mark that matches a random term with a random product or service is less creative than an ingenious suggestive mark, but the uncreative arbitrary or fanciful mark is still doctrinally entitled to a greater scope of protection than a creative suggestive mark. It is true that the Lanham Act encourages creative

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<sup>185</sup> The Trade-Mark Cases, 100 U.S. 82, 94 (1879).

<sup>186</sup> See *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 34 (2003); see also *Phoenix Enter. Partners v. Rumsey*, 829 F.3d 817, 825 (7th Cir. 2016) (“Trademark . . . is aimed not at promoting creativity and invention but rather at fostering fair competition.”).

trademarks to the extent that merely descriptive (and therefore uncreative) marks do not qualify for immediate protection. But, as noted, suggestive or arbitrary need not be creative in any meaningful sense, nor does the invention of fanciful marks require exceptional creativity (any random assortment of letters will do). Moreover, even utterly uncreative descriptive terms attached to commercial goods will qualify for protection once the public has come to associate the term with a specific source of the goods. Not only is promoting creativity, as that term is generally understood, not a basic goal of trademark law; creativity is essentially epiphenomenal.

### III. The Multifaceted Goals of Intellectual Property

By incorporating into the Constitution a congressional power to grant exclusionary rights for writings and inventions, the Framers overcame their concerns about statutory monopolies in the service of “promot[ing] the progress” of knowledge and industry.<sup>187</sup> The “[t]o promote . . . by securing” language indicates an intended cause-and-effect relationship between the grant of exclusionary rights, on one hand, and a public benefit in the form of increased production and distribution of scientific and expressive works on the other. The first Congress chose to keep the intellectual property acts dealing with copyright and patent separate, and that statutory separation continues today. Congress did not create a federal trademark regime until 1870; its progeny were kept separate from the other federal intellectual property statutes as well.<sup>188</sup> The means of protection employed by these statutes differ, as do their ultimate purposes. As the preceding argument has explained, they do share a common attribute: none of them exist solely or even primarily to promote creativity. In this part, I will explain more specifically the uncreative goals of each field of intellectual property law and how each field seeks to achieve its respective goal.

#### A. The Uncreative Goals of Copyright Law

The natural starting place for analyzing the 1976 Copyright Act’s goals are the statutory conditions for protection. Section 102 of the Act grants a limited exclusionary right for “original works of authorship fixed in any tangible medium of expression . . . from which they can be perceived, reproduced, or otherwise communicated. . . .”<sup>189</sup> The fixation can mean recording the work on paper or tape, saving it to stable digital storage, or anything comparable. Section 102 then identifies eight categories of works of authorship (literary works, musical works, etc.) and clarifies that copyright protection does not extend to ideas, processes, methods of operation, discoveries, or the like.<sup>190</sup>

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<sup>187</sup> See Dotan Oliar, *Making Sense of the Intellectual Property Clause: Promotion of Progress as a Limitation on Congress’s Intellectual Property Power*, 94 GEO. L.J. 1771, 1803–05 (2006).

<sup>188</sup> Patent Act of July 20, 1870, 16 Stat. 198. The *Trade-Mark Cases*, 100 U.S. 82 (1879), discussed above, found that act unconstitutional, and Congress later enacted another statute based on its Commerce Clause power that withstood constitutional challenge. See generally Sondra Levine, *The Origins of the Lanham Act*, 19 J. CONTEMP. LEG. ISSUES 22 (2010).

<sup>189</sup> 17 U.S.C. § 102.

<sup>190</sup> *Id.* § 102(b).

The logical deduction from this statutory language is that the purpose of copyright law is to facilitate an author's exclusive control over the distribution, performance, and display of his own recorded expressive work. True, the Act does require the expressive work to be "original," and the Supreme Court has interpreted "original" to include a modicum of creativity. But there is a difference between a condition of copyright and the purpose of copyright. Registration of the work with the U.S. Copyright Office is a condition for enforcing a copyright in court,<sup>191</sup> but it would be absurd to argue that the main purpose of copyright law is to ensure expressive works are registered.

Of course, making creativity a condition of copyright hardly *disproves* the notion that promoting creativity is the aim of copyright law. What does disprove that claim is the fact that the amount of creativity necessary to secure a copyright is minimal. It would be logical for a system of law designed to encourage creativity to deny copyright to any work that is not notably creative. But *Feist* does the precise opposite, requiring only that the creativity not be "utterly lacking or so trivial as to be virtually nonexistent."<sup>192</sup> Such unimaginative works as an instruction manual for assembling or using a product, a boilerplate spy or romance novel, a television sitcom regurgitating pseudo-comical platitudes, or a variation on topographical maps, all rate copyright protection. Indeed, subsequent to *Feist*, courts have not consistently required even a minimal showing of creativity for compilations.<sup>193</sup> Saying that a body of law that requires only a nontrivial amount of creativity exists solely or primarily to promote creativity is like saying that a body of law has as its purpose ensuring taxpayers file their annual income tax returns by requiring them to file returns no less than once per decade.

It is also notable that the benefits of a copyright do not scale in proportion to the creativity of the work. A well-crafted creativity law would make the benefits granted commensurate with the production of the thing desired, or at least make some attempt at that policy. The more creative a work is, the greater the rights of the copyright owner would be. But copyright law only scales in the limited case of works of minimal creativity, which may be entitled to no more than "thin" copyright protection in some circuits. Thin copyright entitles the work to protection from literal copying, but no more.<sup>194</sup> Works of very great creativity are entitled to no more protection than are works of low creativity, however. If copyright law were designed to encourage creativity, greater creativity would correspond to greater benefits.

If copyright does not aim at creativity, then, at what does it aim? The scope of copyright protection corresponds primarily to the scope and number of the original expressive works themselves. Bob Seger's *Still the Same* lasts 3:22 minutes, while Rush's *The Camera Eye* lasts 10:56 minutes. Truman Capote's *Breakfast at Tiffany's*

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<sup>191</sup> 17 U.S.C. § 411.

<sup>192</sup> *Feist Pubs. v. Rural Tele. Serv. Co.*, 499 U.S. 340, 358–59 (1991). See *supra* Part II.A.3.

<sup>193</sup> See *Abrams*, *supra* note 82, at 28.

<sup>194</sup> See, e.g., *Ets-Hokin v. Sky Spirits, Inc.*, 225 F.3d 1068 (9th Cir. 2000); *Satava v. Lowry*, 323 F.3d 805 (9th Cir. 2003).

is 160 pages long, while Norman Mailer's *Harlot's Ghost* runs to 1191 pages. Dalton Trumbo has only one motion picture to his credit, *Johnny Got His Gun*, but John Ford produced over 140 in his lifetime. *The Camera Eye* and *Harlot's Ghost* have more protected content (beat lines, tunes, lyrics, etc. for the former; phrases, subplots, characters, for the latter) than Seger's tune and Capote's novella. John Ford can use his copyrights to control far more content (scenes, images, etc.) than can Dalton Trumbo. Because copyright protects all original content, more content means more protection. What copyright facilitates is not creativity, but productivity and recordation. Specifically, the goal of copyright law is to facilitate productivity in expressive works and their fixation in a tangible medium. The concern is with securing a sufficient quantity of expressive works for the public benefit, with no very significant interest in the quality of the resulting works.

Here it may be helpful to illuminate a common source of misunderstanding about creativity. As mentioned above,<sup>195</sup> the term has multiple meanings, some more commonly used than others. In its normal lay usage,<sup>196</sup> creativity requires the use of imagination or production of unique ideas.<sup>197</sup> But, as Jeanne Fromer's argument illustrates, creativity has also sometimes been used by courts and scholars to denote something quite different: productivity.<sup>198</sup> A writer is "creative" in this atypical sense if he is prolific, despite an evident lack of imagination. Before *Feist*, at least some of the confusion about whether copyright law is intended to promote "creativity" arose from courts using the term in its second meaning (productivity) and later courts interpreting the precedent to refer to the first meaning (creativity in the sense of imaginativeness or ingenuity). Many scholars have since made the same error, writing about creativity when they mean to say productivity.<sup>199</sup> Others have simply erred in attributing creativity proper as the domain and function of copyright law. The point is that the function of copyright law is not rewarding creativity, but rather removing a disincentive to expressive productivity and fixation.

In modern copyright practice, we may even to some extent eliminate the "fixation" part. Amendments to the Copyright Act beginning in the 1990s, pursuant first to the TRIPS Agreement<sup>200</sup> and later to the WIPO Performances and Phonograms

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<sup>195</sup> See *supra* Part II.C.3.

<sup>196</sup> Lay usage is the only relevant usage here. As noted, "creativity" is not a term of art used in the Copyright Act (or, for that matter, the Patent Act or Lanham Trademarks Act).

<sup>197</sup> OXFORD DICTIONARY OF ENGLISH 408 (3d ed. 2010).

<sup>198</sup> Although this definition is not found in the OED, it is the third and last definition of "creative" in WEBSTER'S ENCYCLOPEDIA UNABRIDGED DICTIONARY OF THE ENGLISH LANGUAGE 341 (1983).

<sup>199</sup> For example, Doris Long: "When you think about copyright, it really is supposed to be about promoting creativity. Not innovation, but creativity." Doris Estelle Long, *When Worlds Collide: The Uneasy Convergence of Creativity and Innovation*, 25 J. MARSHALL J. COMPUTER & INFO. L. 653, 657 (2009). Although she wrote several times that copyright "is supposed to be about creativity," *id.* at 665, I interpret Long as trying to say that copyright is *not* supposed to be about creativity at all, but about creation, and specifically creation of expressive works having no practical function. I do not agree with Long's view (if I'm interpreting it correctly) that the relevant distinction is between creation and innovation, but she is certainly correct if she interprets copyright as being about creation in the broad sense.

<sup>200</sup> Agreement on Trade-Related Aspects of Intellectual Property Rights art. 14, Apr. 15, 1994, 1869

Treaty,<sup>201</sup> prohibited the unauthorized recording of live musical performances even though the performance itself could not be protected by copyright.<sup>202</sup> The modern focus, then, appears to be primarily on *the production of expressive works* rather than promoting creativity.

#### B. The Uncreative Goals of Patent Law

In contemporary utility patent law, as noted, the statutory criteria for protection are novelty (section 102) and nonobviousness (section 103). The nonobviousness criterion exists because nonobvious innovations are deemed the most valuable and in need of protection from unauthorized copying.

We must resist the temptation to equate the nonobviousness requirement to a creativity condition, however. A nonobvious invention may be discovered in several ways, of which creativity in the sense of imagination or ingenuity is only one. Patents are granted on inventions meeting the statutory criteria even if no creativity was involved. A product or process resulting from an accident, the utility of which was perceived by the discoverer, is entitled to a patent precisely as much as a product or process invented by the ingenuity or imagination of the inventor. Similarly, an invention discovered through painstaking but mechanical research—“sweat of the brow”—with neither creativity nor fortuitous accident, is equally entitled to a patent. In adopting Section 103 of the 1952 Patent Act, Congress made every effort to clarify that the absence of ingenuity, imagination or genius must not negate a patent. The main purpose of patent law cannot, therefore, relate to creativity.

Instead, nonobviousness is closely tied to the concept of unpredictability. Of course, it would be nonsensical to describe patent law as promoting unpredictable research results. Inventors do not seek unpredictable results, they seek practical solutions to technological problems. But by limiting protection to those solutions that “nonobvious,” and treating these as the sole patentable inventions, it would be accurate to say that patent law seeks to facilitate *productivity of unpredictable technological advances* rather than creativity. Unpredictability does not require creativity or inspiration or luck, or even hard work.

Any one of those will do, but they must be tied to something else, which I have called “insight.” Insight in this sense is the perception that one’s potential invention is new and useful. The role of insight in a creative invention is plain because the insightful idea usually precedes development of the invention; the inventor uses his or her insight to envision a creative solution to the problem presented. In the case of accident, however, insight is *post hoc*. It comes into play through the appreciation that the result of accident might be new and useful, and the ability to recreate or

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U.N.T.S. 299.

<sup>201</sup> WIPO Performances and Phonograms Treaty, May 20, 2002, WIPO No. TRT/WPPT/001, 2186 U.N.T.S. 203. The United States ratified the WPPT on Sept. 14, 1999. *See also* Beijing Treaty on Audiovisual Performances art. 6, June 24, 2012, WIPO No. TRT/BEIJING/001, 51 I.L.M. 1211. The United States signed the Beijing Treaty in 2012, but has not yet ratified it.

<sup>202</sup> *See* Pub. L. 103-465, tit. V, § 512(a), Dec. 8, 1994, 108 Stat. 4974, *codified as amended at* 17 U.S.C. § 1101.

describe with sufficient precision the manner of making and using it. These require at least some form of mental preparation and perceptiveness. Similarly, new technologies produced by rigorous and methodical research will not be recognized as adequate solutions to the problems the inventor is addressing without insight. At least some basic insight must guide the research by eliminating fruitless paths of experimentation and pursuing paths that show promise. The inventor must perceive the difference between the two and recognize when the research has achieved adequate success. Inventive productivity, then, always requires some kind of insight, creative or uncreative.

It is worth noting that patent law has another core goal unrelated to the qualities of the invention or the process of its discovery. Section 112 of the Patent Act requires the applicant to describe in detail the invention claimed, as well as the process of making and using it, in a manner that would enable a person of ordinary skill in the relevant art to reproduce and use the invention.<sup>203</sup> This disclosure is often considered part of the core bargain of the patent law, as the Supreme Court wrote in *Graham v. John Deere Co.*: “The inherent problem [of patent law is] to develop some means of weeding out those inventions which would not be disclosed or devised but for the inducement of a patent.”<sup>204</sup> With the adoption of the America Invents Act, the Patent Act has shifted even more strongly toward encouraging prompt disclosure by granting priority to the first inventor to disclose his or her invention publicly, as long as he or she submitted the patent application within one year after the disclosure.<sup>205</sup> Whatever the social value of patent disclosure, disclosing the invention publicly before filing the patent application confers a potential priority advantage on the inventor. It would be most accurate, then, to say that patent law facilitates inventive productivity in combination with an adequate public disclosure in the patent application. Here, too, then, *productivity* rather than *creativity* is the primary purpose of intellectual property law, the main difference being the subject matter—unpredictable technological advances instead of original expressive works.

### C. The Uncreative Goals of Trademark Law

Trademark law parallels copyright and patent laws in addressing a market failure caused by the nature of the marks as public goods. Like other public goods, trademarks are non-excludable and non-rivalrous, and so it may seem that the function of the exclusionary rights should be identical to those of copyright and patent. But the parallel ends here. The market failure copyright and patent law counters is caused by disincentives to investment in inventions and expressive works. Free riders undermine the expressive and inventive productivity (and disclosure)

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<sup>203</sup> 35 U.S.C. § 112.

<sup>204</sup> 383 U.S. 1, 11 (1966); *accord* *Eldred v. Ashcroft*, 537 U.S. 186, 224 (2003) (Stevens, J., dissenting) (“Complete disclosure as a precondition to the issuance of a patent is part of the *quid pro quo* that justifies the limited monopoly for the inventor as consideration for full and immediate access by the public when the limited time expires.”). *See also* Colleen V. Chien, *Contextualizing Patent Disclosure*, 69 VAND. L. REV. 1849, 1950–51 (2016); Jeanne C. Fromer, *Patent Disclosure*, 94 IOWA L. REV. 539, 541 (2009).

<sup>205</sup> 35 U.S.C. § 102 (2017).

sought by the respective bodies of law. But trademark law does quite not aim at the production of ever more trademarked goods or services; it aims at the preservation of the source-identifying function of existing trademarks. “Existing” in this sense means marks that already do or have the present potential to serve a source-identifying function.

Trademark law is founded in state common law, in the broad category of unfair competition regulation.<sup>206</sup> Unfair competition law was developed to protect merchants from certain dishonest or manipulative business practices of their competitors.<sup>207</sup> The goal of this body of law is to channel advertising, product marking, and sales tactics toward increasing the accurate information available to consumers and decreasing deception and unfair manipulation in the market. Trademark law does so by protecting those marks that are likely to assist consumers in maintaining the mental connection between the brand and its source, and deterring attempts to coopt terms already in public use for the business owner’s private use, to the confusion of consumers and detriment of the general public. The ultimate purpose of both unfair competition and trademark law is to prevent the illegitimate diversion of trade from one merchant to another through the impugned practices. Modern trademark law has shifted the policy somewhat toward protecting consumers from confusion rather than just protecting merchants from trade diversion. The specific market failure federal trademark law is intended to counter is source confusion among consumers in the marketplace caused by conflicting information. It achieves this aim by preserving the utility and value of brand names, logos, and other identifiers for designating the source of their associated goods or services. “The essence of a trademark is a designation in the form of a distinguishing name, symbol or device which is used to identify a person’s goods and distinguish them from the goods of another.”<sup>208</sup> That designation must create “a separate and distinct commercial impression, which . . . performs the trademark function of identifying the source of the merchandise to the customers.”<sup>209</sup>

What trademark protects against, then, is “a likelihood that the defendant’s designation will be confused with the plaintiff’s trademark, such that consumers are mistakenly led to believe that the defendant’s goods are produced or sponsored by the plaintiff.”<sup>210</sup> Put another way, “the touchstone of a traditional trademark infringement analysis is whether one person’s use of another’s mark ‘is likely to cause confusion, or to cause mistake, or to deceive.’”<sup>211</sup> This is the main reason why the

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<sup>206</sup> See Oliver R. Mitchell, *Unfair Competition*, 10 HARV. L. REV. 275 (1896); G. & C. Merriam Co. v. Saalfeld, 198 F. 369, 373 (6th Cir. 1912); Moseley v. V Secret Catalogue, Inc., 537 U.S. 418, 428 (2003).

<sup>207</sup> See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 1 (2009).

<sup>208</sup> ETW Corp. v. Jireh Publishing, Inc., 332 F.3d 915, 921 (6th Cir. 2003).

<sup>209</sup> *In re Chem. Dynamics, Inc.*, 839 F.2d 1569, 1571 (Fed. Cir. 1988); *accord* Star Fin. Servs., Inc. v. AASTAR Mortgage Corp., 89 F.3d 5, 9 (1st Cir. 1996).

<sup>210</sup> Rock & Roll Hall of Fame & Museum, Inc. v. Gentile Prods., 134 F.3d 749, 753–54 (6th Cir. 1998).

<sup>211</sup> *Syrus v. Bennett*, 455 Fed. App’x. 806, 810 (10th Cir. 2011) (quoting Lanham Act § 43, 15 U.S.C. § 1125(a)(1)).

duration of patents and copyrights is limited, and that of trademark is not.<sup>212</sup> Copyrights and patents give exclusionary rights only for the period of time Congress considers necessary “to promote the progress of science and the useful arts.”<sup>213</sup> Trademarks, in contrast, may last in perpetuity, as long as the mark is used in commerce in relation to the relevant goods or services, and it has not degraded into a generic term.<sup>214</sup> The point, then, is to maintain an ongoing resource for consumers, not to populate the world with trademarks or even trademarked goods. The fundamental value of trademark law is not promoting content, creative or otherwise.

To the extent that a creative mark is more distinctive than an uncreative mark, and thereby increases the likelihood of consumer confusion when a similar mark is offered to the public, stronger protection to the creative mark serves trademark law’s goals. To a degree, the effect of the doctrine is indeed to encourage the use of distinctive marks, and thus to promote creative branding. But the effect is far from uniform and, even when it applies, the stronger protection is indirect and merely coincidental to, not a core function of, the trademark law. Hence, the accuracy of the Second Circuit’s analysis in *Christian Louboutin v. YSL*: “The trademark system, unlike the copyright system, aims to prevent consumer confusion even at the expense of a manufacturer’s creativity: in trademark, if a branding specialist [independently] produces a [creative] mark that is identical to one already trademarked by another individual or corporation, he must ‘go back to the drawing board.’”<sup>215</sup> Creativity has very little to do with that.

#### IV. The Reward Mythos

A related belief that commonly underlies intellectual property doctrine, similarly fostered by the Supreme Court, is that copyright and patent law “incentivize” or “reward” authors and inventors. The statement is typically made in the course of describing these bodies of law as rewarding creativity specifically. According to the Court, the purpose of the Intellectual Property Clause of the Constitution and of the patent laws is “to encourage and reward” the “creative work” of the “inventive faculty.”<sup>216</sup> Similarly and more recently, the Supreme Court in *Twentieth Century Music Corp. v. Aiken*:

The limited scope of the copyright holder’s statutory monopoly, like the limited copyright duration required by the Constitution, reflects a balance of competing claims upon the public interest: Creative work is to be encouraged and rewarded, but private

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<sup>212</sup> 17 U.S.C. § 302(a) (copyrights last 70 years after the death of the author, subject to some exceptions); 35 U.S.C. § 154(a)(2) (patents last 20 years from the application date, subject to some exceptions).

<sup>213</sup> U.S. CONST. art. I, § 8, cl. 8.

<sup>214</sup> *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995).

<sup>215</sup> *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206, 224 n.20 (2d Cir. 2012), (citing *Blendco, Inc. v. Conagra Foods, Inc.*, 132 F. App’x 520, 523 (5th Cir. 2005) and *Tuccillo v. Geisha NYC, LLC*, 635 F. Supp. 2d 227 (E.D.N.Y. 2009)).

<sup>216</sup> *Hollister v. Benedict & Burnham Mfg. Co.*, 113 U.S. 59, 73 (1885).

motivation must ultimately serve the cause of promoting broad public availability of literature, music, and the other arts.

The immediate effect of our copyright law is to secure a fair return for an ‘author’s’ creative labor. But the ultimate aim is, by this incentive, to stimulate artistic creativity for the general public good.<sup>217</sup>

Or, more directly: “The purpose of copyright is to create incentives for creative effort.”<sup>218</sup> and “[C]opyright law serves public ends by providing individuals with an incentive to pursue private ones.”<sup>219</sup> The Court has written the same of patent law.<sup>220</sup> The Court once even speculated that “the value of incentives” provided by Congress for intellectual production is “undeniably true.”<sup>221</sup>

Circuit courts,<sup>222</sup> scholars<sup>223</sup> and even members of Congress<sup>224</sup> have followed suit, characterizing patent law and copyright law as if they dangled a “reward” or “incentive” for creativity, expression, invention, and so forth before the eyes of hopeful authors and inventors. Some have even written that trademark law “rewards” merchants by giving them exclusionary rights.<sup>225</sup>

It is probable that the notion that IP laws reward or incentivize certain behavior originates in the language of the Constitution’s Intellectual Property Clause itself. That provision authorizes Congress to grant “exclusive rights” to inventions and writings specifically in order “to promote” the progress of science and the useful arts.<sup>226</sup> It does not require a huge leap of logic to conclude that, in order to promote

<sup>217</sup> Twentieth Century Music Corp. v. Aiken, 422 U.S. 151, 156 (1975) (footnotes omitted).

<sup>218</sup> Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417, 450 (1984).

<sup>219</sup> Eldred v. Ashcroft, 537 U.S. 186, 254 (2003).

<sup>220</sup> Traffix Devices, Inc. v. Mktg. Displays, Inc., 532 U.S. 23, 35 (2001) (“The Lanham Act does not exist to *reward* manufacturers for their innovation in creating a particular device; *that is the purpose of the patent law* and its period of exclusivity.”) (emphasis added).

<sup>221</sup> Eldred, 537 U.S. at 207 n.15.

<sup>222</sup> E.g., Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc., 696 F.3d 206, 224 n.20 (2d Cir. 2012) (“Copyright, unlike trademark, rewards creativity and originality even if they interfere with the rights of an existing copyright holder.”); Nash v. CBS, Inc., 899 F.2d 1537, 1541 (7th Cir. 1990) (“The prospect of reward is an important stimulus for thinking and writing, especially for persons such as Nash who are full-time authors.”).

<sup>223</sup> E.g., Clark D. Asay, *Intellectual Property Law Hybridization*, 87 U. COLO. L. REV. 65, 65 (2016); Fishman, *supra* note 14, at 1334; Gideon Parchomovsky & Alex Stein, *Originality*, 95 VA. L. REV. 1505, 1506 (2009); Lydia Pallas Loren, *The Pope’s Copyright? Aligning Incentives with Reality by Using Creative Motivation to Shape Copyright Protection*, 69 LA. L. REV. 1, 10 (2008) (“A market-based approach to copyright law assumes that all individuals are motivated by monetary reward.”); Mandel, *supra* note 11, at 2000, 2008, 2013; Diane Leenheer Zimmerman, *Copyrights as Incentives: Did We Just Imagine That?*, 12 THEORETICAL INJ. IN L. 29, 30 (2011).

<sup>224</sup> E.g., CONG. REC. S5409 (Sept. 8, 2011) (statement of Rep. Schumer) (“By rewarding innovators for inventing newer and better products, we keep America’s creative and therefore economic core healthy.”).

<sup>225</sup> E.g., Fromer, *supra* note 11, at 1445; Graeme W. Austin, *Trademarks and the Burdened Imagination*, 69 BROOK. L. REV. 827, 851 (2004) (characterizing a trademark in passing as a “reward[]” of federal protection).

<sup>226</sup> U.S. CONST. art. I, § 8, cl. 8.

the spread of knowledge and new inventions, incentives or rewards should be offered for behavior tending toward those goals.

The claim that IP laws “incentivize” or “reward” the relevant behavior, however, is deceptive in some important ways. Many infer from the Intellectual Property Clause and associated jurisprudence that copyright and patent laws somehow provide a direct incentive to authors and inventors. Quite a few scholars have written as if IP laws offer immediate financial rewards to authors and inventors in exchange for their works and inventions.<sup>227</sup> That belief is not accurate. The exclusionary rights granted by copyright and patent law are negative rights. They do not in themselves give any reward or incentive to the owner, but rather empower the owner to prevent other persons from doing certain things with the patented invention or copyrighted expression without the owner’s authorization. That is very different from a reward, for reasons that will be explained in this part.

#### A. The Negative Functioning of Intellectual Property Law

In pursuit of its constitutional objective, Congress could have granted direct incentives for the production of expressive works and inventions by awards or prizes in the form of grants and accolades. Legislation has sometimes done just that to foster creativity, but not through intellectual property laws. In 1950, Congress created the National Science Foundation (NSF)<sup>228</sup> “to initiate and support” scientific research by awarding scholarships, fellowships, and grants in the social and natural sciences and engineering.<sup>229</sup> NSF awards some 11,000 grants for such research every year.<sup>230</sup> Congress similarly established the National Endowment for the Arts and National Endowment for Humanities in 1965 for “the encouragement and support of national progress and scholarship” in the arts and humanities,<sup>231</sup> *inter alia* to “to provide or support . . . projects and productions which have substantial national or international artistic and cultural significance, giving emphasis to American creativity and cultural diversity and to the maintenance and encouragement of professional excellence.”<sup>232</sup> The agencies have taken as their missions to “strengthen the creative capacity”<sup>233</sup> of the United States by awarding thousands of grants and fellowships to educational institutions, charitable foundations, and individuals annually to learn about, develop skills in, produce, and preserve the arts and humanities.<sup>234</sup> In addition, each of these agencies awards honors to individual artists, scientists and inventors as well, such as

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<sup>227</sup> *E.g.*, Loren, *supra* note 223, at 10 (“A market-based approach to copyright law assumes that all individuals are motivated by monetary reward.”).

<sup>228</sup> Act of May 10, 1950, ch. 171, § 2, 64 Stat. 149, *codified as amended at* 42 U.S.C. §§ 1861–87.

<sup>229</sup> 42 U.S.C. § 1862(a)(1).

<sup>230</sup> National Science Foundation, ABOUT FUNDING, <https://www.nsf.gov/funding/aboutfunding.jsp> (last visited Nov. 1, 2018).

<sup>231</sup> Pub. L. 89-209, § 2 (Sept. 29, 1965), 79 Stat. 845, *codified as amended at* 20 U.S.C. § 951.

<sup>232</sup> 20 U.S.C. § 954(c)(1).

<sup>233</sup> National Endowment for the Arts, 2018 Guide, at 2, [https://www.arts.gov/sites/default/files/2018\\_NEA\\_Guide.pdf](https://www.arts.gov/sites/default/files/2018_NEA_Guide.pdf).

<sup>234</sup> *See* National Endowment for the Arts, 2016 Annual Report, <https://www.arts.gov/sites/default/files/2016%20Annual%20Report%20FINAL.pdf>.

the National Medal of Arts, the National Humanities Medal, the National Medal of Science, and the Presidential Early Career Award for Scientists and Engineers.

The intellectual property statutes do not rely on grants, awards, prizes, or medals to encourage expressive or inventive productivity. Their methods are more subtle and complex in structure and function. A copyright grants the owner the right to exclude others from reproducing the work, distributing it to the public by sale or rental, preparing derivative works, or publicly performing or displaying the work during the term of the copyright.<sup>235</sup> These rights are subject to some important exceptions, such as fair use rights<sup>236</sup> and various secondary transmission rights. Copyright also gives the author other forms of control under some circumstances, such as rights of attribution and integrity in visual artworks.<sup>237</sup> Similarly, a patent grants the owner the right to exclude others from making, using, selling, offering to sell, or importing the patented invention during the term of the patent.<sup>238</sup> As for trademark, it does not even grant a general exclusionary right to the owner, much less a “reward” or “incentive” of any kind. It merely prevents any use in commerce of the mark by other merchants in a manner likely to deceive or confuse consumers.<sup>239</sup> The exclusionary right of trademark law is highly limited, because the owner cannot prevent others from employing the mark in a variety of noninfringing, even commercial, uses.<sup>240</sup>

From an economic perspective, intellectual property is an intended solution to market failure, not a reward or even an incentive. As noted earlier, intellectual property is a public good, both non-rivalrous and non-excludable.<sup>241</sup> Without a legal right of control over an expressive work, anyone can reproduce and distribute that work after seeing or hearing it with widely available reproduction technologies. The easy availability of cameras, digital recorders, photocopiers, scanners, and similar technologies make infringement a nearly universal possibility. Similarly, anyone with the capability of understanding how to make or use an invention could copy it. Anyone at all can affix a trademark to a product or describe a service using a service mark, and many do. The character of IP as a public good enables free riding, a form of market failure. In the absence of legal protection, a free rider can copy and

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<sup>235</sup> 17 U.S.C. § 106.

<sup>236</sup> 17 U.S.C. § 107.

<sup>237</sup> 17 U.S.C. § 106A.

<sup>238</sup> 35 U.S.C. § 271.

<sup>239</sup> 15 U.S.C. § 1114. In the case of famous trademarks, there is a further “anti-dilution” right to exclude others from nonconfusing uses of the mark, if such use is likely to tarnish the reputation of the mark or reduce the capacity of the mark to distinguish its owner’s goods or services. *See* 15 U.S.C. § 1125.

<sup>240</sup> *See, e.g.*, 1 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §§ 4.17, 11.45-49, 23:11 (5th ed., Dec. 2017 update) (describing both classical and nominative “fair use,” two forms of noninfringing commercial use of another’s trademark that may occur in a commercial context).

<sup>241</sup> In Thomas Jefferson’s phrase, “He who receives an idea from me, receives instruction himself without lessening mine; as he who lights his taper at mine, receives light without darkening me.” Letter from Thomas Jefferson to Isaac McPherson (Aug. 13, 1813), *in* 13 THE WRITINGS OF THOMAS JEFFERSON 333, 333 (Andrew A. Lipscomb & Albert Ellery Bergh eds., 1905).

distribute another's expressive work, reproduce another's invention, or freely affix another's trademark to his own goods. In the case of copyright or patent, the author or inventor may have invested considerable time, effort, and expense in developing the work. In the case of trademark, the merchant may have invested greatly in advertising the brand and building goodwill.<sup>242</sup> Copying is cheap; the free rider has incurred no such investment. As a result, the free rider who offers the work to the public without having undertaken the investment competes with the author or inventor at an advantage, because the copier can offer the work to the public at a price that need not reflect any investment in authorship or product development. The free rider, in short, undercuts the possibility that the market could reward the author or inventor, preventing the originator of the IP from capturing a sufficient part of its economic value to justify creating the work in the first place.<sup>243</sup> This is the standard account of intellectual property law.

The point is that intellectual property law does not incentivize or reward anything. The copyright and patent means is not a grant of reward or other incentive, but rather *the removal of some obstacles to control* over the reproduction, performance, or commercial exploitation of the copyrighted work or patented invention by others. Depending on the market for the work, that control may result in a range of economic benefits, from none at all (for example, most of what I write) to a great deal (for example, most of what Stephen King writes). To the extent an author or inventor is motivated by economic self-interest, copyright and patent merely facilitate attempts to exploit the work for that end. To the extent the author is motivated by a desire to maintain such control over the use of his or her work, copyright gratifies the author in this way as well. If the author or inventor cares nothing for control over his or her work or invention, copyright and patent gratify that author or inventor very little.

In spite of this analysis, it would perhaps still not be implausible to call a grant of temporary and limited exclusionary rights a "reward" or "incentive," using those terms very loosely. The problem is that such rights may be, and indeed more often than not are, worthless. As others have observed, the value of any intellectual property is determined not by the relevant law, but by the market for the work.<sup>244</sup> If there is no market demand for an invention or expressive work, then the power granted by a patent or copyright to exclude others from making or distributing the

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<sup>242</sup> As Mark Lemley and Mark McKenna have observed, courts themselves have increasingly become confused about the purposes of trademark law and based a finding of infringement on condemnation of free riding rather than consumer confusion in making purchasing decisions. See Mark A. Lemley, *Property, Intellectual Property, and Free Riding*, 83 TEXAS L. REV. 1031, 104445 (2005); Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1904–1914 (2007); Mark A. Lemley & Mark McKenna, *Irrelevant Confusion*, 62 STAN. L. REV. 413, *passim* (2010).

<sup>243</sup> For a fuller explanation of this approach to intellectual property law, see generally William M. Landes & Richard A. Posner, *THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY LAW* (2003) and Richard A. Posner, *Intellectual Property: The Law and Economics Approach*, 19 J. ECON. PERSPECTIVES 57 (2005).

<sup>244</sup> See, e.g., Barnes, *supra* note 11, at 110.

invention or expressive work is moot. And this is not a hypothetical observation. Due to the absence of market demand, the great majority of patented inventions and copyrighted expressive works have no economic value.<sup>245</sup> Copyrights and patents cannot be said to provide much of an economic incentive or reward when the owner of the protected work is likely to recover zero compensation.

Trademark law, otherwise so dissimilar to copyright and patent, is no different in this respect. Trademark law protects the ability of the owner to establish and maintain a relationship in the minds of consumers between the mark and the source of the marked goods. This “goodwill” must be established by the commercial efforts of the trademark owner. The grant of a trademark gives the owner no reward or incentive whatsoever to affix the mark to goods for which there is no demand. The trademark is worth only as much as the goodwill associated with it, and in the absence of such goodwill, the mark is valueless.<sup>246</sup> While the grant of a trademark may be a desirable goal for many merchants, it is not because the trademark itself has any inherent value. Like other forms of intellectual property, the trademark removes a disincentive to building and using the commercial brand caused by third-party practices that could divert sales away from the trademark owner by confusing, or at least distracting, consumers.

What about non-economic benefits that could qualify as an incentive or reward? Do not inventors proudly list their patents on their résumés? That argument has no traction for copyrights; nobody writes, and no legislation implies anybody writes, motivated by the idea of obtaining a copyright. A qualifying work receives copyright protection immediately upon fixation in a tangible medium regardless of merit or value. There is no required registration process and, if registration is sought, no

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<sup>245</sup> See John R. Allison, Mark A. Lemley, Kimberly A. Moore & R. Derek Trunkey, *Valuable Patents*, 92 GEO. L.J. 435 (2004); Jonathan A. Barney, *A Study of Patent Mortality Rates: Using Statistical Survival Analysis to Rate and Value Patent Assets*, 30 AIPLA Q.J. 317, 329 (2002); F.M. Scherer, *The Innovation Lottery*, in EXPANDING THE BOUNDARIES OF INTELLECTUAL PROPERTY 3, 7–9 (Rochelle Cooper Dreyfuss et al. eds. 2001) (finding that most of the (already few) profitable patents were “of only modest value.”). That most copyrights are valueless follows from the facts that, first, nearly all original expressions are protected by copyright immediately upon fixation in a tangible medium throughout the world under the Berne Convention and TRIPS Agreement, and yet, only a tiny fraction of these are licensed commercially.

<sup>246</sup> Others have denied that IP law is (or should be) really about incentives. However, they have generally characterized the law not as removing an obstacle to exploitation of the right, but rather as establishing or recognizing the creator’s right of authorship or inventorship based on some theory, either Lockean or Hegelian. See, e.g., Justin Hughes, *The Philosophy of Intellectual Property Law*, 77 GEO. L.J. 287 (1988); Wendy J. Gordon, *A Property Right in Self-Expression: Equality and Individualism in the Natural Law of Intellectual Property*, 102 YALE L.J. 1533 (1993); Alexander D. Northover, “Enough and as Good” in the Intellectual Commons: A Lockean Theory of Copyright and the Merger Doctrine, 65 EMORY L.J. 1363 (2016). To the extent such claims are intended as descriptive rather than prescriptive, I will not repeat an explanation for the dominance of the incentives theory of intellectual property made perfectly adequately elsewhere, see, e.g., Pamela Samuelson, *Economic and Constitutional Influences on Copyright Law in the United States*, 23 EUR. INTELLECTUAL PROP. L. REV. 409, 422 (2001); Mark Lemley, *Faith-Based Intellectual Property*, 62 UCLA L. REV. 1328 (2015). Instead, I take for granted here that consequentialism is the main theory underlying both copyright and patent law as they exist today.

examination of the merits of the work will be conducted. A copyright is exactly as much a reward for new expressive works as a birth certificate is for being born. Similarly, nobody markets goods or services merely to boast of the resulting trademark.

As for patents, perhaps some inventors do take pride in them<sup>247</sup> and are willing to pay \$5000 or more per patent for bragging rights.<sup>248</sup> However, there are good reasons to doubt that many inventors are motivated to seek patents for this reason. In the first place, much commercially significant inventive activity takes place in the corporate setting, where the patent has only strategic business value and is assigned automatically to the employer. It seems likely that any pride an employee feels in obtaining a patent immediately assigned to someone else would be subsidiary to the motivation of keeping his or her job and salary, which depends on the employee's success in innovation.

Second, because most patents are valueless, any pride an inventor feels in owning a patent would be irrational. The patent system is not a meritocracy that award patents only to the valuable inventions. Any invention meeting the statutory criteria qualifies for a patent regardless of how trivial or even foolish the invention may seem. When I teach Patent Law, there comes a moment early in the course when I graphically illustrate that patents are not themselves commercially valuable. I pass around to the students two books documenting dozens of fatuous inventions that have been honored with patents in the United States and Japan.<sup>249</sup> If I had to pick a favorite, it might be this one: "The instant invention relates generally to enclosure devices and more specifically it relates to a greenhouse helmet that incorporates small plants into a sealed helmet to be worn over the head of a person."<sup>250</sup> The greenhouse helmet apparently operates on the theory that, because plants absorb carbon dioxide and emit oxygen, the helmet will increase a person's oxygen consumption. Assuming that small plants will indeed produce a meaningful increase in oxygen; and further assuming that wearing a large, plant-filled helmet for any length of time is ergonomically acceptable to a significant (presumably bull-necked) consumer market; and assuming that these consumers did not mind potting soil in their hair and eyes; and assuming the helmets were affordable when incorporating the necessary "hearing and speaking devices so that the person can hear within and speak out through the helmet"; the drawing for the device depicts spiny cactuses as the plants to be nestled around a perambulating person's head. To exactly nobody's surprise, the patent lapsed after eight years and was not renewed.<sup>251</sup> But the point is, the

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<sup>247</sup> Cf. Andre Geim, *Patents Merely Satisfy a Professor's Pride*, FINANCIAL TIMES (July 2, 2012), <https://www.ft.com/content/071a7a40-c3aa-11e1-966e-00144feabdc0>.

<sup>248</sup> See Gene Quinn, *The Cost of Obtaining a Patent in the US*, IPWATCHDOG.COM (Apr. 4, 2015), <http://www.ipwatchdog.com/2015/04/04/the-cost-of-obtaining-a-patent-in-the-us/id=56485/>.

<sup>249</sup> Kenji Kawakami & Hugh Fearnley-Whittingstall, 101 UNUSELESS JAPANESE INVENTIONS (1995); Ted VanCleave, TOTALLY ABSURD INVENTIONS: AMERICA'S GOOFIEST PATENTS (2001).

<sup>250</sup> U.S. Patent No. 4,605,000 (1986).

<sup>251</sup> GREENHOUSE HELMET, <https://www.google.com/patents/US4605000>.

inventor could boast a patent to pretty much the same extent as the inventor of stem cell therapy.

Of course, given the definite limits to human rationality, the fact that patents do not objectively signal merit of any kind does not mean patents cannot in practice function as a prestige signal. They assuredly can and probably sometimes do. But the U.S. patent system is not premised on the idea that the prestige of obtaining a patent alone will motivate aspiring inventors. Nothing in the legislative history of the Patent Act or any of its predecessors suggests such a purpose. And, for the reasons noted, the high cost of obtaining a patent and the intermediation of many corporate employers suggests that any such motivation is at best a marginal factor in the calculus of most inventors.

#### B. The Rewards of Not Referring to Reward

The conclusion that copyright, patent, and trademark laws are intended to remove an obstacle to a potential and highly contingent benefit of intellectual property rather than to provide an incentive for the production of intellectual property may seem like hair-splitting. Smoothing a racetrack may not provide an “incentive” or “reward” for racers to run faster, but faster running is the intended and actual effect. There are, however, very good reasons for maintaining the distinction in the case of intellectual property. The first, already noted, is that it avoids the erroneous implication that expressive works, inventions, and trademarks become commercially or socially valuable automatically upon federal protection as intellectual property.

The second reason is that a misapprehension about the function of intellectual property law poses process dangers to judicial decision-making and new legislation. In the judicial context, courts that conceive of IP as a “reward” or “incentive” may be consciously or unconsciously influenced toward limiting IP protection on expressive works and inventions they consider socially valueless.<sup>252</sup> It seems intuitively implausible that the drafters of the Copyright Act or Patent Act intended to reward or incentivize worthless expressions and inventions. That intuition is accurate, not because Congress sought to limit copyrights or patents to works and inventions considered valuable by executive or judicial authorities, but because the laws do not incentivize anything in the first place. A judicial desire to further the purposes of Congress should be based on an accurate understanding of those purposes.

The converse may also occur; in the enthusiasm to reward or incentivize expressive works considered important or creative, or inventions considered socially useful, courts sometimes grant protection overzealously, ignoring other statutory requirements unfulfilled by the works or invention or statutory limitations on the

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<sup>252</sup> See, e.g., *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 252–53 (1903) (Harlan, J., dissenting) (arguing that a hand-illustrated circus poster lacks any connection “with the fine arts to give it intrinsic value,” and therefore should not merit a copyright). One pious jurist has even demanded the reintroduction of limits to copyright where, in the opinion of the judges, the work lacks social value as “immoral,” in the sense not only of libelous, but obscene or irreligious. See Ned Snow, *The Regressing Progress Clause: Rethinking Constitutional Indifference to Harmful Content in Copyright*, 47 U.C. DAVIS L. REV. 1 (2013).

rights of the author or inventor. As extensively documented elsewhere, courts have proven susceptible to the influence of granting increased protection in both the copyright context where the work was considered exceptionally “creative”<sup>253</sup> and patents for inventions considered socially desirable.<sup>254</sup> Such forces introduce an arbitrary and subjective bias in copyright and patent law.

A third consequence of viewing intellectual property as a reward or incentive is that it has misled some scholars evaluating the functioning of U.S. copyright and patent law. Several jurists have cited empirical evidence on creativity and motivation as the basis for an argument that IP laws fail to achieve their purported objective. Roberta Kwall argued in 2006, based on “theological and secular narratives,” that “creativity is spurred largely by incentives that are noneconomic in nature.”<sup>255</sup> Rebecca Tushnet, relying primarily on unpublished work and anecdotal evidence collected by a novelist, agreed that “engaging in creative labor is not a task in need of external incentives.”<sup>256</sup> Later, Jessica Silbey concluded based on thirty sociological interviews that IP does not motivate artists and inventors to choose their careers or projects.<sup>257</sup> Still another lawyer has opined that “intrinsic motivation is generally more important than extrinsic motivation when it comes to tasks that are creative in nature.”<sup>258</sup> Inventors are intrinsically motivated to create,<sup>259</sup> he believes, and often “happy to give [intellectual property] away for free.”<sup>260</sup> He interprets the social science evidence to show “quite convincingly” that money does not incentive creativity and that indeed it “is often harmful to the creative impulse; that is, offering to pay for something that someone is motivated to do for free may cause that person to lose motivation altogether.”<sup>261</sup> Many other scholars have accepted and repeated this assertion uncritically.<sup>262</sup> Even the United Nations Special Rapporteur in the field

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<sup>253</sup> See generally Karjala, *supra* note 11, at 185–93 (discussing cases in which courts have treated creativity as a sufficient condition for copyrightability).

<sup>254</sup> See generally Demaine & Fellmeth, *supra* note 123, at 334–60 (discussing the gradual acceptance of patents on medical technologies that lacked patentable subject matter, but that courts allowed anyway because they considered therapeutically valuable). Another example is the problematic concept of “pioneer inventions,” which are those improvements that courts consider decisive advances in technology. Some courts take the position that pioneer inventions should be entitled to a broader range of equivalent protection than other inventions. See John R. Thomas, 10 BERK. TECH. L.J. 35, 45–52 (1995).

<sup>255</sup> Kwall, *supra* note 11 **Error! Bookmark not defined.**, at 1970.

<sup>256</sup> Rebecca Tushnet, *Economies of Desire: Fair Use and Marketplace Assumptions*, 51 WM. & MARY L. REV. 513, 525 (2009).

<sup>257</sup> Jessica Silbey, *Harvesting Intellectual Property: Inspired Beginnings and “Work-Makes-Work,” Two Stages in the Creative Processes of Artists and Innovators*, 86 NOTRE DAME L. REV. 2091, 2112–13, 2122–23 (2011).

<sup>258</sup> Johnson 2012, *supra* note 17, at 640. Elsewhere, Johnson relied heavily on the writings of lawyer and pop nonfiction writer Daniel H. Pink, who has no more formal education or professional training in psychology than Johnson himself. See Johnson 2014, *supra* note 17, at 1959 (discussing DANIEL H. PINK, *DRIVE: THE SURPRISING TRUTH ABOUT WHAT MOTIVATES US* (2009)).

<sup>259</sup> Johnson 2012, *supra* note 17, at 624 (“External rewards are, as a general matter, unnecessary for the flourishing of arts, entertainment, and technology.”).

<sup>260</sup> Johnson 2014, *supra* note 17, at 1937.

<sup>261</sup> *Id.* at 1959.

<sup>262</sup> See, e.g., Christopher Buccafusco & David Fagundes, *The Moral Psychology of Copyright*

of cultural rights has weighed in, alleging that “[s]cholars have found no evidence to support the assumption that scientific creativity is only galvanized by legal protection or that the short-term costs of limiting dissemination are lower than the long-term gain of additional incentives.”<sup>263</sup>

Some have gone further still, arguing that extrinsic motivators such as cash or exclusionary rights not only fail to promote creative production, but might inhibit it.<sup>264</sup> From this perspective, then, copyright and patent law are actually counterproductive. Gregory Mandel, for example, has argued: “So long as a patent or copyright is perceived solely as an extrinsic motivator, it may be expected to produce only algorithmic efforts by inventors and artists. To the extent the drive for a patent or copyright can be internalized, it is much more likely to lead to achievements that are more creative.”<sup>265</sup> He continues:

The nonobviousness requirement [of patent law] thus mandates a certain level of creative achievement in order to secure a patent . . . . To the extent that a potential inventor understands this, the inventor is likely to perceive a patent as a reward only for a creative accomplishment, and thus the patent system may enhance intrinsic motivation in this regard.<sup>266</sup>

Another writer, Diane Zimmerman, has assumed that copyright dangles a “monetary and other economic ‘carrot[]’ before people already endowed by virtue of their backgrounds and innate ability[ies] to be creative,” and questioned whether such incentives really work.<sup>267</sup> Creative types, she argues, must be intrinsically motivated because of the uncertain rewards of creative work.<sup>268</sup> Citing studies by economists and psychologists, she argues that some creators of expressive works create for personal satisfaction, a sense of membership in a community, or altruism rather than economic gain.<sup>269</sup> This research, she concludes, demonstrates that “the willingness to engage in creative activities, and the quality of what is produced, is not enhanced

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*Infringement*, 100 MINN. L. REV. 2433, 2434–35, 2448 (2016); Stephanie Plamondon Bair, *The Psychology of Patent Protection*, 48 CONN. L. REV. 297, 348 (2015); Julie E. Cohen, *Creativity and Culture in Copyright Theory*, 40 U.C. DAVIS L. REV. 1151, 1193 (2007); Loren, *supra* note 223, at 11–12; Mandel, *supra* note 11, at 2000, 2008; Bradford S. Simon, *Intellectual Property and Traditional Knowledge: A Psychological Approach to Conflicting Claims of Creativity in International Law*, 20 BERK. TECH. L.J. 1613, 1658–59 (2005).

<sup>263</sup> *Report of the Special Rapporteur in the field of cultural rights, Farida Shaheed: The right to enjoy the benefits of scientific progress and its applications*, ¶ 65, U.N. Doc. A/HRC/20/26 (May 14, 2012). The U.N. report on the whole evidences an ideologically based hostility to intellectual property rights, of which this statement and its accompanying citation to scholars on only one side of the debate furnish disappointing examples.

<sup>264</sup> See, e.g., Johnson 2012, *supra* note 17 **Error! Bookmark not defined.**, at 643.

<sup>265</sup> Mandel, *supra* note 11, at 2010–11.

<sup>266</sup> *Id.* at 2012 (footnote omitted).

<sup>267</sup> Zimmerman, *supra* note 223, at 30.

<sup>268</sup> *Id.* at 37–42.

<sup>269</sup> *Id.* at 44 (citing Eric von Hippel & Georg von Krogh, *Open Source Software and the “Private-Collective” Innovation Model*, 14 ORG. SCI. 209, 216 (2003) and ERIC VON HIPPEL, *DEMOCRATIZING INNOVATION* 60 (2005)).

by the promise of salient financial rewards for performance, and indeed may actually be harmed by it.”<sup>270</sup>

These scholars all base their analyses and arguments on the assumption that copyrights and patents are supposed to provide incentives for creativity. They then cite psychological research or informal studies that, in their interpretations, provide evidence that authors and artists are self-motivated to engage in creative activities, and indeed that external incentives and rewards, such as those IP laws supposedly provide, can dampen creativity. Therefore, they argue, we should abolish IP laws or at least restructure them to accord with actual human motivations, as these authors understand them.

Assuming *arguendo* that this interpretation of the facts about artistic motivations were correct, and that the IP laws are all about creativity,<sup>271</sup> such arguments still gain no purchase, because they ignore the nature of intellectual property as a negative system. Once we recognize that intellectual property does not actually provide rewards or incentives, but merely addresses one obstacle to benefiting from the work or invention by controlling its use by others, it makes no sense to accuse the IP laws of misidentifying what motivates creators of expressive works. As noted, copyrights, patents or trademarks themselves constitute rewards or prizes to induce authors and inventors to create new expressive works and inventions in only the most superficial sense. The psychological literature relating to direct incentives quite simply cannot be applied to the question of IP law’s effectiveness in providing control over the work (which may or may not include financial reward or other extrinsic benefits) without modification or qualification. The scientific research was not conducted to analyze that specific dynamic.

## V. Conclusion

This article dispels the misconception, common among courts at all levels and scholars as well, that incentivizing creativity lies at the heart of intellectual property law. The words “creativity” and “creative” nowhere appear in the Patent Act, Copyright Act, Lanham Act, or constitutional provisions authorizing those statutes.<sup>272</sup> Notwithstanding some modern deviations in the jurisprudence, the law has not developed to change the traditional policy purposes in that direction. Not only is creativity entirely epiphenomenal to trademark law, but neither copyright law nor patent law require creativity as a condition for the grant of protection. The originality standard requires the minimum possible amount of creativity to ensure the protected work is not a mere recitation of facts or an inevitable portrayal of a general idea. Patent law requires no creativity for protection at all; accident accompanied by logical insight suffices, as does painstaking research along well-known channels, as long as the result is useful and unexpected. It would be perfectly illogical to design a system

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<sup>270</sup> *Id.* at 49.

<sup>271</sup> The first assumption will be fully addressed in DEMAINE & FELLMETH, *supra* note 18. The second assumption was refuted in Part II, *supra*.

<sup>272</sup> In the case of the first two, the Intellectual Property Clause (U.S. CONST. art. I, § 8, cl. 8); in the latter case, the Commerce Clause (U.S. CONST. art. I, § 8, cl. 3).

of intellectual property law with the intention of promoting an activity, without even requiring that activity in order to activate the law's benefits.

Instead, copyright law takes aim at what I have called "expressive productivity," the proliferation of new expressive works, as long as the works do not merely recite facts or general ideas. Patent law, in turn, targets "productivity in unexpected technological advances" and public disclosure, meaning the proliferation and publication of new technologies that are nonobvious, even if the only mental effort involved is pedestrian, effortful research or the bare insight necessary to appreciate the technological potential of an observed accident.<sup>273</sup> For its part, the goals of trademark law and theory are far from promoting creativity; some creative marks may incidentally receive greater protection, but they also may not, and in any case trademark law's goals are to prevent consumer confusion and preserve brand value, not to guide trademarks into ever more creative channels.

The article also points out the misleading consequences of characterizing IP law as "rewarding" or "incentivizing" the production of expressive works or inventions. Intellectual property laws do not reward anything; they mitigate a market-based disincentive to production and dissemination of new expressive works and inventions. And it is the market itself which offers any actual incentive for these activities. This observation is especially important for understanding why those arguments criticizing intellectual property law as useless or counterproductive based on psychological research or interviews cannot effectively impugn the law's effectiveness even if they were based on an accurate interpretation of the science.

Of course, nothing in my discussion casts any doubt on the *relevance* of creativity to any branch of intellectual property law. Creativity is quite obviously not irrelevant to copyright, because some modicum of it is necessary to prevent copyright from disserving its information-spreading function by granting a lengthy period of exclusivity over expressions that are useful. The development of such expressions is either inevitable in the relevant field or positively required for the expression of an idea, or both. Nor is creativity irrelevant to patent law. Creativity is one path to a patent, as long as the creative design or process is new and useful. And, as discussed, there is even some merit to the argument that in trademark law, more creative marks may sometimes receive greater protection, as long as the claim is so limited, and it is recognized that the reverse may be true as well.

More generally, as noted in the introduction, creativity is considered socially valuable very broadly. Creative thinking can expand the vistas of art, knowledge, and science in ways far beyond literal and quotidian thinking, and sometimes even more than that rare pearl—logical cogitation. Veering from the expected lanes of research, indulging in flights of fancy, embracing randomness, and experimenting with novel combinations of knowledge or technique, all require the thinker to invest in unusual cognitive effort or accept high risks of failure, or both at once. The rewards of creativity sometimes justify the investment and risk. For example, a willingness

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<sup>273</sup> See *supra* Part II.B.

to reject conventional ideas and exalt individual creativity helped make European art, science, and technology flourish during the Enlightenment while more conformist civilizations stagnated. The social value of creativity is beyond doubt.

Hard work is of course valuable as well—Edison himself said that genius is 99% perspiration<sup>274</sup>—but anyone is capable of diligent labor. Creativity is one of those attributes that, although every person can exhibit it in theory, in practice it is sufficiently rare that, when it leads to a useful result, it becomes a cause for exceptional celebration and admiration. Because both copyright law and patent law do apply to creative as well as mundane expressive works and inventions, and because creative works of both kinds tend to have greater social value than their more routine counterparts, it is still valuable to study the effect of these bodies of law on promoting creativity, as many scholars have done and are continuing to do. The fact that intellectual property law is not designed to incentivize creativity does nothing to undermine the value of such research. It is merely a mistake to frame a research program or formulate a thesis based on the hypothesis that creativity is the main focus of any field of intellectual property law.

It is also important to remember that this article does not purport to resolve the normative question of the extent to which copyright or patent law *should* reward creativity. Some scholars have argued that copyright law should be more sensitively attuned to fostering creativity specifically by encouraging expressive works of unusual imagination.<sup>275</sup> Others have argued that the injection of creativity into copyright analysis was misguided on law or policy grounds, or both.<sup>276</sup> The same arguments have been made in patent law with respect to the threshold of patent protection.<sup>277</sup> Such arguments are important as well, but they address a policy debate about *lex ferenda* and have no relevance to the *lex lata* of intellectual property law. We must of course understand the purposes and methods of the law clearly before proposing the law's alteration.

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<sup>274</sup> JAMES D. NEWTON, UNCOMMON FRIENDS 24 (1987).

<sup>275</sup> See, e.g., Parchomovsky & Stein, *supra* note 223, at 1506–07; Joseph Scott Miller, *Hoisting Originality*, 31 CARDOZO L. REV. 451, 463–64 (2009); Roberta Rosenthal Kwall, *Inspiration and Innovation: The Intrinsic Dimension of the Artistic Soul*, 81 NOTRE DAME L. REV. 1945, 2001–02 (2006).

<sup>276</sup> See, e.g., Dennis S. Karjala, *Copyright and Creativity*, 15 UCLA ENT. L. REV. 169, 171–72, 182–85 (2008); VerSteeg, *supra* note 31, *passim*.

<sup>277</sup> See Gregory Mandel, *The Non-Obvious Problem: How the Indeterminate Nonobviousness Standard Produces Excessive Patent Grants*, 42 U.C. DAVIS L. REV. 57, 90 n. 144 (2008) and sources cited therein.