Patent©

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In his influential 1970 piece, *The Uneasy Case for Copyright*, Justice Breyer notes the most well trotted tension in copyright law: consumers want cheap products and producers want strong protections.[1] He cites this argument back to 1914;[2] the tension is certainly nothing new, and as Breyers' attention suggests, it is well trodden ground. From the consumers' standpoint, they want free competition, and they trust the market to bring prices close to marginal cost. Producers counter that if the industry is to survive, they must see returns greater than marginal cost, so they demand protection from competition.

But what if there is no commercial market for the good and the production of the good is already paid for? Is there any argument for granting protection to producers of that good? Traditionally, the answer is resounding no. If the good is already produced, incentivizing production is wasteful, especially if no market facilitates the incentive. But a cautious approach might find that value could be gained from such protections. After all, a good could provide value to the public without a commercial market. If so, the public would prefer to protect the good and may reasonably think

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1 Stephen Breyer, *The Uneasy Case for Copyright: A Study of Copyright in Books, Photocopies, and Computer Programs*, 84 HARV. L. REV. 281, 282 (1970).

2 *Id*. at 281.

the producer of the good is the ideal entity to do that. Alternatively, the good may serve the general public well and simply not have a market yet. In such a case we should provide protection so that when the market is created, the proceeds may be funneled into producing more of the base good.

This Note addresses these questions looking specifically at patent documents. In particular, this Note addresses whether, under a utilitarian framework of intellectual property, a patent document should receive copyright protection. This Note also investigates whether, under current law, patent documents do receive copyright protection, and what might be done to align the legal answer with the theoretical answer. Part I lays a groundwork by defining copyright protections in a patent document, considering who they might vest in, and summarizing the patent drafting process. Part II addresses patent document copyrights under a utilitarian framework and seeks to answer whether a patent document should receive copyright protection. It considers three theoretical explanations for copyright protection: the incentive function, the subsidization function, and encouragement of searchability features. Part III evaluates both the current state of the law and what steps might align the law with the theoretical determination of Part II. It considers applying the originality requirement in light of the factual and functional content of a patent document, the merger doctrine, and the legal significance of a copyrighted work.

I. Part I

This Part lays a groundwork aiding later discussion. As this Note addresses whether some form of protection should extend to the document used in procuring patent protection, this Part addresses what is involved in the creation of a patent document, the relevant portions of a patent document, and the party in whom copyright protection is likely to vest.

A. Process

A patent document begins its life at the invention of some novel, nonobvious, and useful invention.[3] The inventor records his creation, likely taking experimental data and lab notes, and sends the record off for a specialized patent drafter. This drafter, often an attorney, is certified to practice in front of the United States Patent and Trademark Office (USPTO). The drafter takes the record information from the inventor, often (if not always) interviewing the inventor to fully understand the invention and drafts a document that describes the invention. The drafter submits this document to the USPTO as a patent application. The USPTO reviews the document and determines if the underlying invention meets the requirements of patent law. Additionally, the USPTO determines if the document itself meets certain requirements. The document must fully describe the invention, proving the inventor truly possessed it, and fully enable a person having ordinary skill in the art to make and use the invention.[4] This ensures the invention is properly given to the public. There is almost

[3] 35 U.S.C. §§ 102, 103 (West 2012).
[4] 35 U.S.C. § 112 (West 2012).

always some back and forth between the USPTO and the drafter at this point over whether the requirements have been met. The UPSTO files office action rejections, and the patent drafter amends the document or argues against the rejection. Once the document and invention meet all requirements, the USPTO issues a notice of allowance. Once fees have been paid, the USPTO publishes the document as allowed, granting the inventor patent protections in the invention.

B. Content of the Patent Document

The patent contains several key portions: a title, the background of the invention, a brief summary of the invention, a brief description of the drawings, a detailed description of the invention, the claims for the invention, an abstract of the document, and drawings.[5] The background of the invention describes the field of the invention as well as the relevant prior art in the field.[6] The brief summary of the invention, with the drawings, the descriptions of drawings, and detailed description, collectively "the description," sufficiently describes the invention to prove the inventor had it when the document was filed. Additionally, the description must sufficiently enable a person having ordinary skill in the art to make and use the invention.[7] The claims specify what is protected, drawing from the prior portions of the document for support.[8] The abstract gives a brief synopsis of the entire document.[9]

So what might these parts be protected from? The background of the invention might be used in another patent application in the same field. The claims, description, and abstract are too specific to be cannibalized into another application except for one that derives from the original invention. However, the description might be used to provide technical support for the use and creation of the invention. Further, together all parts may be used to determine prior art against other patents. In an extraordinary case, the entire document (but especially the drawings of a popular or important invention) may be used aesthetically, often as decoration.[10]

C. Ownership

Under current U.S. law and patent prosecution practice, copyright protections vest in the patent drafter.[11] Because the drafter compiles the information from the

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5 U.S. PATENT AND TRADEMARK OFFICE, MANUAL OF PATENT EXAMINING PROCEDURE, § 608.01(A) (8th ed. 7th rev., 2015) [hereinafter "MPEP"].

6 *Id*.

7 *Id*.

8 *Id*.

9 *Id*.

10 *See 'Star Wars R2D2 Patent' Graphic Art Print in Blue*, WAYFAIR, https://www.wayfair.com/17-Stories-Star-Wars-R2D2-Patent-Graphic-Art-Print-in-Blue-STSS4003-L1318-K~STSS4003.html?refid=GX249082067513-STSS4003&device=c&ptid=408750204128&network=g&targetid=pla408750204128&channel=GooglePLA&gclid=Cj0KCQjwuMrXBRC_ARIsAL-WZrIiwvfHsNq7kKuolXiIlmzFlv3OAYxVDbyi63wQyfFfVECjtxB2B-vEaAvw9EALw_wcB (last visited May 9, 2018).

11 17 U.S.C.S. § 201 (West 2012).

inventor and other information into an application, the drafter is considered the creator of the document. There is little ground to claim a work-for-hire situation unless an employee-employer relationship exists. If handled in-house, the protections vest in the inventing company. However, if, as is common, the work is hired out to a law firm, no employee-employer relationship exists between the inventor and the drafter. The law firm, then, likely holds the copyright as it employs the drafter of the document.[12] The right is unlikely to vest, at least initially, in the inventor unless they significantly contribute to the drafting of the patent and can claim co-authorship.[13] This Note proceeds under the assumption that the law firm holds whatever protections vest.

II. Part II

This Part covers a normative theoretical analysis of copyright protections in patent documents under a utilitarian framework. The utilitarian theory of IP states that protections are granted in informational goods because this grant increases public welfare.[14] Utilitarian theory seeks to enhance net social welfare. As social welfare is an amorphous concept, and difficult to quantify, it is often measured by economic impact. Although utilitarian theory may be satisfied by noneconomic impacts, these are often overlooked because they are unquantifiable. Further, the economic impacts of IP are extraordinarily difficult to decipher without a comparable example without IP protection. Below I discuss several mechanisms by which IP might enhance social welfare and how the utilitarian framework applies to patent documents.

A. Incentive Function

The dominant mechanism (at least rhetorically dominant) by which social value is created by a property system is the incentive function.[15] As the name implies, the incentive function works by goading creators to create.[16] It relies on the understanding that, without sufficient incentive, at least some creators would not create, and that the social costs of the incentives are less than the social value gained from the innovation. Additionally, it is assumed that a copyrighted work generally provides social value and, thus, social welfare is better served by having more copyrighted works (even with the cost of necessary incentives) than it is without those works.[17]

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[12] 17 U.S.C.S. § 201(b) (West 2012) (specifically falling under the first definition of a "work made for hire").

[13] *Id*. When a patent is drafted by a law firm, no employee-employer relationship exists between the patentee and the drafter. As such the only way the patentee could be considered an author of the patent is by contributing copyrightable material to the patent. Often the involvement of the patentee is supervisory and limited to providing uncopyrightable facts upon which the patent is drafted.

[14] *Intellectual Property Rights and the Principle of Utility*, 110, 112 shodhganga.inflibnet.ac.in/bitstream/10603/14592/9/09_chapter%203.pdf (last visited August 1, 2019).

[15] Mark A. Lemley, *The Economics of Improvement in Intellectual Property Law*, 75 TEXAS L. REV. 989, 993 (1997). *See Fox Film Corp. v. Doyal*, 286 U.S. 123, 127 (1932) ("The sole interest of the United States and the primary object in conferring the monopoly lie in the general benefits derived by the public from the labors of authors").

[16] In reality the property system enables the market to goad creation.

[17] *But see* Michael Abramowicz, *A New Uneasy Case for Copyright*, 79 GEO. WASH. L. REV. 1644,

Without property rights in informational goods, creators are unable to recoup their investments through the market.[18] This is because the cost of initial creation of informational goods—innovation—is greater than the cost of imitation. The inability to prevent copying is the "nonexcludability" feature of informational goods. This, in combination with the ease and low cost of copying informational goods, creates the problem IP rights seek to curtail. As a counter example, real property does not face this problem because it is impossible to imitate. Similarly, chattel property has a high relative cost of imitation and a low relative cost of innovation. When an author attempts to bring their informational good to market, once the first fixation of the informational good is sold, the author must compete with others who wish to sell fixations of her creation. This competition drives prices towards marginal cost. The author, having greater sunk costs than the copier, needs to charge a price higher than marginal cost to turn a profit. The market thus discourages the author from creation, because the author cannot afford to create.[19]

Intellectual property rights seek to curtail the nonexcludability of informational goods by providing creators with a set of entitlements that allow them control over their creations.[20] The result for creators is some degree of price control.[21] Now, an author may bring her book to market without competition from copiers that force market prices down to marginal.[22] She is thus able to recoup her investment in creation and turn a profit. This incentivizes her to create.

With perfect information, an author would charge each consumer exactly the most they are willing to pay for her good, over marginal cost. Every consumer willing to pay greater than marginal cost could enjoy the work, maximizing both the author's earnings and the public's enjoyment of the good. However, perfect price discrimination is non-administrable. The cost of discovering the perfect price for each consumer is great, likely greater than the value gained by having perfect discrimination. Therefore, only a limited amount of tailoring is available. This creates a "deadweight" loss. Because the author charges each consumer a relatively static price, many consumers who would be willing to pay an above-margin price are denied access to and enjoyment of the good.

1644–45 (2011) (citing Breyer, *supra* note 1, at 309) (pointing out that even if an author is not incentivized to create, they are still going to do something, and that this something is likely beneficial to social welfare, and specifically citing Breyer's discussion of what scholars might occupy their time with if not incentivized to write textbooks).

18 *See* Lemley, *supra* note 15, at 994–95; *cf.* Breyer, *supra* note 1, at 302 (discussing how first mover advantage, self-help, and mass contracts might obviate the need and usefulness of copyright).

19 The incentive function usually describes ex ante considerations. For example, an author considers all of this before writing her novel. But it can function ex post, as when an author has written her novel, finds she is unable to recoup her investment, and therefore decides not to write another novel.

20 *See* 17 U.S.C. § 106 (West 2012).

21 *See* Christopher A. Cotropia & James Gibson, *The Upside of Intellectual Property's Downside*, 57 UCLA L. REV. 921, 927 (2010).

22 *Id.* However, she still has to compete with imperfect substitutes for her book that deny her the ability to have true monopolistic price controls.

Additionally, the incentive function cuts directly against its own intent, to facilitate the creation of more works.[23] Innovation is heavily based on and borrows from older works.[24] Consider storytelling: how many stories have been written about the love of two star-crossed lovers whose families or situations deny them each other.[25] Protections that enable an author to recoup investments in the market also disable later creators from using that work in their own works. Under the typical understanding of utilitarian theory this is problematic as creations enhance social welfare.[26]

B. Application: Incentive Function

Examining a patent under the utilitarian framework suggests the patent ought not receive protection. Patents cut directly against the baseline assumptions of the incentive function. First, the incentive function assumes that the work would not be created without property protections acting to incentivize the creator. Patent documents have an independent incentive for creation. Second, the incentive function assumes the work might be marketable. A patent document, at least generally, is not. Patent documents lack both the need to be incentivized and a market that would facilitate such incentives.

For patentees, patent documents protect an underlying invention. As such, an incentive to create already exists, the protection incentive. For drafters, this translates into patentees offering to pay a fee for the creation of the patent document. This obviates the need for any encouragement of creation and leaves only the cost of the incentives without the value of creations. However, an independent incentive is not necessarily a problem under utilitarian theory. Utilitarian theory could still be satisfied even if some creation already occurs. If sufficient creations are made on account of the property incentive to outweigh the cost of the incentive, utility favors copyright protection of patents. This cost, however, would have to reflect both the cost of the newly incentivized works, and of the works that would be created anyway and are thus over-incentivized.

This leads to the second issue: Patent documents are not marketable and thus property rights cannot incentivize their creation. There are insufficient markets for the patent document as a whole. There may, however, be markets for portions of patents, but these markets likely provide insufficient incentive to outweigh the costs of a property system and likely do not need a property system to function.

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[23] *Id*. at 931–32 (using the example of Flash Gordon being the first "space opera" as conceivably stifling the creation of Star Wars).

[24] Lemely, *supra* note 15, at 997 (citing Sir Issac Newton's alleged statement: "If I have seen further it is by standing on the shoulders of giants").

[25] *See* Romeo and Juliet, The Hunchback of Notre Dame, Westside Story, Underworld, etc. Perhaps at this point what is described is an uncopyrightable idea or *scene a faire*, but it illustrates how works borrow and develop from each other.

[26] *But see* Cotropia & Gibson, *supra* note 21, at 921 (arguing that in some cases innovations are harmful to social welfare and that inhibiting innovations in these areas is thus a boon of the intellectual property regime rather than an unfortunate loss).

The main use of a patent document as a whole is to secure protection in an invention. Such a use requires a highly tailored and individualized document that the patentee must commission. While different scenarios might be imagined in which a patent drafter must use copyright protections to extract his fee due from an obstinate patentee, such a situation ignores the respective positions of the parties. Drafters, who generally have sufficient skill in the law and technology to satisfy the USPTO and are not usually so unsophisticated as to need copyright protections to enforce payment. Further, such inventor-drafter relationships involve substantial service to prosecute the patent. This relationship is sophisticated; the parties can care for themselves.

A second use of patent documents as a whole is ensuring compliance. The question of whether compliance uses encourage creation is distressingly paradoxical. For example, purchasing law books so that one does not break the law (i.e. for a compliance use) encourages the creation of the law that one must purchase to ensure compliance.[27] This self-enforcing cycle does not enhance social welfare unless we believe that social welfare is best served by mountains of law. Additionally, a compliance use should not be subject to monetization as the use ensures the rule of law. Any restriction on this use would weigh heavily against any possible incentive to the creator.

A use that might be subject to market forces is the search use. When attempting to patent an invention or invalidate a patent, it is incredibly valuable to know what prior art exists for that invention. Under U.S. law, patents count as prior art against other patents.[28] As such it is very advantageous to know and to find prior art, either to invalidate a competitor's patent or to protect your patent from that competitor. A compilation of patents, efficiently indexed, could thus be a very valuable tool for attorneys and companies alike. Such a tool could command some market power and could perhaps provide a market for patents.

But would such a situation require, or at least be more efficient under, a property system? Because patents are published by the USPTO upon issue (as are patent applications after 18 months), patent drafters would need some excludability to extract money from the market.[29] Because the document is open to the world, a system that curtails the nonexcludability of the patent document would be necessary.

The background of the invention section of a patent document might be subject to use in another patent. This section does not relate directly to the invention and thus might be reusable for other inventions in the field. As such it is conceptually possible that it could be marketed. However, in order for it to be used in another patent application the drafter would first have to ensure that the prior art and field of invention of the two inventions are sufficiently similar to use a premade background-of-the-invention section. Therefore, it is unlikely the background would be recycled outside of a

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[27] Note this is different than the argument presented below that a model code producer needs to be allowed copyright to retain the incentive to produce model code. The difference lies in that a model code is presented as an option for adoption into law rather than being simply added on to the pile of laws.

[28] 35 U.S.C. §§ 102, 103 (West 2015).

[29] 35 U.S.C. § 122 (West 2015).

patent drafter using their own work with which they are intimately familiar. The market, if any, would be very small as a result, and the incentive created by property rights would be likewise small.

The drawings of particularly popular inventions have a market. But the market is only for the drawings of incredibly successful and popular inventions. The drawings for these inventions are likely well known to be successful; take, for example, design patent drawings for popular Star Wars characters. Such drawing needs no incentive as the base patent is created with or without any value being extractable from those drawing. Alternatively, it may be too far beyond the drafter's or inventor's expectations at the time of drafting to incentivize creation, as is the case with baseball patent drawings.[30]

Both the static and dynamic costs of patent documents present special concerns over and above those of standard informational goods. The static access loss is enhanced because patent documents have legal significance. The dynamic access loss is increased because a patent not only embodies its own informational good, but also the underlying invention, such that copyright protection could disrupt the patent system.

Because patent documents hold legal importance, and infringement, even accidental, can subject someone to significant liability, limited access to patent documents results in the loss of both enjoyment of the document and proper notice of the law. To a person, real or otherwise, notice of the law allows for avoidance of infringement. To society notice of the law helps to ensure just rule of law. Both these concerns are within the interest of the utilitarian paradigm despite not being entirely economic in nature,[31] because utilitarian theory has a broader view than simply net economic outcome.[32] Concern for due process, reduced infringement, and avoidance of litigation pushes hard against copyright protections.

This can be best seen in comparing the incentivized patent document state with the normal incentivized informational good state. Under the standard case, those willing and able to pay a suitable-over-marginal-cost amount will have access to the good. The patent document case is the same. The important difference is to those that cannot or do not pay a suitable over marginal cost and thus lose access to a protected good. In the standard case, they are not damaged. There is no difference to them between the incentivized state and the non-incentivized state. In both states they lack access to the good. There is nominally[33] no difference between not having the good because

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[30] *Baseball Patent 6-Print Collection, Chalkboard, 18x24*, HOUZZ, https://www.houzz.com/product/69512406-baseball-patent-6-print-collection-chalkboard-18x24-industrial-prints-and-posters?m_refid=PLA_HZ_69512406&device=c&nw=g&gclid=Cj0KCQjwuMrXBRC_ARIsALWZrIgrmhMDE-HPmcly7wPwr6pjizIT6Z3wrjaJnkgszdwkL_6YVICMr8YaArj6EALw_wcB (last visited May 9, 2018).

[31] Although both concerns certainly involve economic factors, the expense of administering justice is significant and self-policing would reduce the need for litigation.

[32] Mark A. Lemley, *Faith-Based Intellectual Property*, 62 UCLA L. REV. 1328, 1330 (2015).

[33] One can easily imagine the case where, in addition to the value of the informational good for its own

it does not exist and not having the good because one cannot or chooses not to afford it. The quasi-law nature of the patent documents, however, change this. Because the document also delineates which acts incur liability, those that cannot afford or choose not to afford the good are charged with notice without being afforded access. This disrupts the just rule of law and the reasonable avoidance of litigation.

Further, protections on the patent document would disrupt the function of the patent system. Part of the equation for patent protection is the giving of the invention to the public. The patent system requires inventors to provide a document that sufficiently enables recreation and use the invention. If protections are allowed in a patent document, use of the document as an instruction manual for the invention would be curtailed. Curtailing such a use disrupts the utilitarian math of the patent system leading to greater costs than protections of other informational goods.

C. Subsidy Function

The subsidy function considers that by allowing a copyright on a patent document the administrative costs of filing a patent can be offset and more inventions can be brought to the public, increasing social welfare. The protections in the document allow for monetization of the document. Any money earned from the document effectively lowers the cost of patenting. Because the cost of patenting an invention is lowered, less potential profits need to be made in order to recoup the costs of invention, and more patents will be filed. Therefore, the protections in the patent document bolster the patent system.

Ultimately, the subsidy function fails on its face: there is no need for a property system to perform this function, nor is there a real value provided by this function. Further, subsidization decreases the channeling function of the patent system. Therefore, instead of bolstering the patent system, subsidization detracts from it.

This function could much more easily be accomplished by simply cutting the fees associated with filing a patent. A general tax could be levied to subsidize the fee reduction, based conceptually on having those that enjoy access to the good—society at large—pay to subsidize its creation.

Ultimately, administrative costs are not cut, and this simpler route is not taken, because the cost of patent filing is intentionally discouraging. An administrative cost reduces the number of patents and increase the innovation from patents. By having a certain fixed cost associated with a patent, patentees will be unwilling to file patents

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enjoyment, users of the good also enjoy a status effect from having enjoyed the work, either in the ability to participate in popular culture or simply as a status symbol. Thus, those who do not enjoy the work are excluded from popular culture or decrease in social status thus putting them worse off than in the no-creation state. *See* John Everington, *Apple iPhone X review: An expensive status symbol that still wows*, THE NATIONAL (Nov. 2, 2017) https://www.thenational.ae/business/technology/apple-iphone-x-review-an-expensive-status-symbol-that-still-wows-1.672505 (discussing the IPhone X and IPhones more generally as status symbols. "[The Iphone X's] eye watering price [has] made the iPhone X, for better or for worse, an object of desire first and a smartphone second").

they are not sure will recoup significantly more than that fixed cost. This seeks to eliminate patents that are only small improvements on existing technology. If such patents were allowed the system would face what is termed the anti-commons problem. The anti-commons problem occurs when too many exclusionary rights are granted.[34] When too many of such rights are granted it becomes prohibitively difficult to utilize anything in which the rights are granted. A novel product might involve a multitude of patents. Thus, to properly license the product, the product creator would have to find each right holder and negotiate a license. The more patents issued, the greater the administrative burden on finding and negotiating licenses. Here, protections that are intended to fuel innovation instead snuff it out.

Finally, subsidization in this manner decouples the connection between inventors and the market. One of the beauties of the decentralized nature of any IP system, but of the patent system in particular, is that it directly connects inventors to the markets. This connection encourages the invention of what the market deems most useful. The market is the best determination of the merit of an invention. A prize system, on the other hand, relies on a central authority to determine what needs to be invented. If this central authority truly knows what is best to be invented, then there is no problem. But if the central authority is mistaken, significant resources are wasted on unnecessary inventions.

Allowing for copyright protections on the patent document confuses the stream of income to the inventor. Now instead of just the market for the invention determining the success of the inventor, and directing further inventive efforts, the market for the patent documents plays a role in the success of the inventor. Creating such a marketable document on its own is not a problem but detracting from the creation of marketable inventions is. Again, copyright protections in patent documents drive increased costs compared to other informational goods.

D. Searchability

As discussed above, there may be a market for patent documents to provide for a well indexed database allowing for prior art searches in litigation and in prosecution of patents. The above only discussed this concept in terms of incentive function, this section discusses searchability as a socially beneficial feature IP may be able to encourage.

The ability to take mountains of data and find a particular part of it quickly is invaluable. The internet and computerization have both allowed for the creation of the masses of data as well as tools to sift through them. More searchable patent documents would mean less difficulty in clearing rights,[35] reduction of costs for the patent office in running their own prior art searches, and an overall reduction in the administrative costs of having a patent system.[36]

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[34] Michael A. Heller, *The Tragedy of the Anticommons: Property in the Transition from Marx to Markets*, 111 HARV. L. REV. 621, 622–25 (1998).

[35] Potentially alleviating some anti-commons problems.

[36] Reducing this cost is socially beneficial even if reducing the cost of receiving a patent is not as

There are certain ways of drafting documents that make them friendlier to these tools. Inclusion of metadata, keywords, and key phrases can increase the ability of search algorithms to properly find, sort, and identify documents. So how might a property system encourage the inclusion of searchability features?

Searchability could be improved in much the same way that the incentive function encourages the creation of new works. If the market values these searchability features, a document with them can charge a premium in comparison to a document without them. Thus, the market incentivizes the creation of documents with certain features.

The focus on just these features yields a problem of scope. If a property system seeks to encourage just a set of features, then only those features should be protected. A limited protection provides just as much incentive to include these features as would protection of the whole document. Limiting protection to just the desired features reduces the negative impact of protections. Essentially, a properly tuned property system would apply the incentive function to just the searchability features.

Even limited property protections are, however, not the most efficient way to acquire these features. If the features that best enhance patent searchability are known, the USPTO or Congress may, by fiat, force all patent documents to include them. If these features are unknown, companies creating the indexes could simply provide "prizes" to patent drafters that include their desired features or to patentees who require their drafters to include them. This is because, under the assumption each company has its own idea of what is best, and the document must be incorporated into an index, there is no need to exclude these features. The fiat and private "prize" systems avoid the value loss of the property system because neither restricts access.

Under the view that IP rights exist to increase social welfare, there is no reason to allow copyright protections for patent documents. The standard incentive mechanism by which IP rights provide social welfare is mostly inapplicable to patent documents and the narrow categories where it may be applicable do not provide sufficient justification for the losses exacerbated by the unique nature of patent documents. A subsidization mechanism fails because no value is provided by such a function, and it disrupts the patent system. Finally, although encouragement of searchability features provides some grounds for a narrow property grant, this function is better completed by different means.

III. Part III

In Part II, this Note lays out how, under utilitarian theory, patent documents should not be granted broad copyright protection, if any protection at all. Part III discusses whether the law allows for such copyright protection and how the law might be changed to better match the normative analysis of Part II. It addresses copyrightable subject matter, dealing first with the standard requirements of copyright and then

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discussed above. These two costs need not be linked.

addressing problems of legally significant documents. Additionally, this part addresses what might be done to bring the law in line with the normative analysis of Part II.

A. Requirements

The U.S. copyright regime only protects "original works of authorship."[37] Courts have taken this to mean "only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity."[38]

The requirement of independent creation excludes portions of any work that do not owe their existence to the author. Namely, this includes facts and portions copied from elsewhere.[39] Under a utilitarian theory, there is no need to incentivize the author as they have not created these portions. Such portions that do not owe their existence to the author receive no protection, but the arrangement and compilation of such portions may.[40] The arrangement itself, rather than what it contains, must satisfy the copyrightability requirements.

The minimal degree of creativity is just that: minimal. It is perhaps as minimal as it is poorly defined. This requirement is not a call for ingenuity, novelty, or creative merit – the Supreme Court has declined to be the judges of such things for copyright.[41] Perhaps the best expression of the creativity requirement is that it calls for independent effort creating any distinguishable variation beyond the merely trivial.[42] This low bar filters outs commonplace practices of data arrangement and occasions where the facts are arranged or compiled without an author's selection.[43] The creativity requirement attempts to avoid any chilling affect on authors of avant-garde works while still filtering out works that need no incentive.[44]

Further, copyright does not protect subject matter that is not "an original work of authorship."[45] The cost of protecting this subject matter is deemed too great and, thus, copyright is denied categorically. However, protection of the illustration of that subject matter yields a different conclusion.[46] This dichotomy arises as discussed above with facts and compilations. If, however, copyright protection for expression

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37 17 U.S.C. § 102 (West 1990). There is also, of course, the requirement of fixation, but as a patent must be submitted to the USPTO in certain formats this requirement is easily met and requires no serious discussion.

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

39 *Id.* at 347–48.

40 *Id.* at 341 ("A compilation is not copyrightable *per se* but is copyrightable only if its facts have been 'selected, coordinated, or arranged *in such a way* that the resulting work as a whole constitutes an original work of authorship.'").

41 17 U.S.C. § 102 (West 1990), *See Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251–52 (1903).

42 1 NIMMER ON COPYRIGHT § 2.01 (2018) (citing case law from the various circuits).

43 *Feist Publ'ns Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 342 (1991).

44 *Id.*

45 17 U.S.C. § 102(b) (West 1990).

46 *Baker v. Selden*, 101 U.S. 99, 106 (1879).

of the underlying uncopyrightable subject matter also allows for control over the subject matter, copyright is denied. One may not use the copyright system to monopolize a method, system, or other barred subject matter but one may utilize the copyright system to monopolize an explanation or illustration of such.[47] The cost of the former monopoly is too great to allow copyright.

As an example: If a mathematician writes his treatise on his discovery of a new mathematical formula and describes his formula both with the mathematical equation in all its complexities and proofs as well as with an analogy that perfectly illustrates its function and effectively instills in the minds of those that read it the use and function of the formula, the equation receive no protection but the analogy does.[48] This is because protection in the former may act to truly exclude another from the use of the formula while protection in the latter, despite its incredible utility, does not prohibit the use of such formula.

These categorical decisions of what is protectable and what is not may be viewed as a utilitarian balancing act between the expected costs and benefits of protection. Some categories of informational goods by their nature cost more to protect. Facts, for example, have a greater cost because of the greater need of others to rely on them. Copyright doctrine also specifies what is protectable when granting protection. In a compilation containing uncopyrightable subject matter, only the compilation, to the extent it satisfies other requirements, receives protection – not the uncopyrightable facts. The system denies wholesale protection when only limited protection is necessary in such a case.

B. Special Consideration for "The Law"

An interesting issue arises when defining precisely what falls into each category of uncopyrightable subject matter. Statutes, codes, and other legal documents present this issue. There is no debate as to whether the concepts and ideas of the prohibitions and procedures that the letter of the law describe is outside the scope of copyright. There is, however, question of whether the exact language used in the statute so controls these ideas or facts that it is deemed to merge.[49] Proponents of merger say that only the exact language of the law may properly describe the entire nuance of the law. They cite a foundational principle in the interpretation of statutes: "the starting point for interpreting a statute is the language of the statute itself."[50] Opponents reject this, contending that there is a multitude of ways to express the content of the law, such as

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47 *See id*.

48 Assuming that this analogy is only helpful in explaining the formula and mathematical concepts and not necessary for such explanations and use.

49 *Veeck v. S. Bldg. Code Cong. Int'l*, 293 F.3d 791, 801 (5th Cir. 2002) (en banc) [hereinafter *Veeck II*] ("It should be obvious that for copyright purposes, laws are 'facts': the U.S. Constitution is a fact; the Federal Tax Code and its regulations are facts; the Texas Uniform Commercial Code is a fact"), *Veeck v. S. Bldg. Code Cong. Int'l, Inc.*, 241 F.3d 398, 407–08 (5th Cir. 2001) (en banc) [hereinafter *Veeck I*] (examining the issue in a broader sense that there are multiple ways of expressing the law as *exemplified* by competing model building codes).

50 *Consumer Prod. Safety Comm'n v. GTE Sylvania, Inc.*, 447 U.S. 102, 108 (1980).

the plethora of competing model codes.[51] Proponents counter that only a single way of expressing the *authoritative* law exists, despite the competing models to choose from.[52] Of the handful of cases that have been brought to the circuits, only the Fifth Circuit has held that the uncopyrightable concepts of the law merge with the expression of them.[53]

Copyright in law also brings up special issues of due process. Again, courts are divided on the interplay of due process and copyright.[54] The conflict is essentially the same as discussed at the beginning of the Note: the society wants access and creators want to be able to charge for that access.[55] The difference is that now society has a stronger reason for wanting access.

The circuits are divided on the application of due process rights and questions of when a work might enter the public domain as a function of adoption into law.[56] The Second and Ninth Circuits, however, agree to some basic contentions, such as the following:

> (1) Whether the entity or individual who created the work needs an economic incentive to create or has a proprietary interest in creating the work and (2) whether the public needs notice of this particular work to have notice of the law.[57]

Applying these factors, the Second Circuit held Suffolk County tax maps did not fall into public domain.[58] In examining the first factor, the court stated that although the government pays the wage of the creator, copyright may still be preserved.[59] Rather, it must be shown that additional incentive of copyright is unnecessary to incentivize the creation of the work.[60] Although the court stated that, categorically, legislatures and judges do not need additional incentive to create legislation and court opinions respectively, the court left open the door for more specialized works.[61] The court seemed particularly convinced by the idea that governmental computer programs might need such additional incentive to be created.[62] In examining the second

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[51] *E.g.*, *Veeck I*, *supra* note 49, at 407–08.

[52] *E.g.*, *Veeck II*, *supra* note 49, at 801–02.

[53] *Id.* at 793; *see Practice Mgmt. Info. Corp. v. Am. Med. Ass'n*, 121 F.3d 516, 520 n.8 (9th Cir. 1997) (stating that the circuit has used merger only to ensure adoption of industry standards that do not "stifle independent creative expression in the industry"); *see also CCC Info. Servs. v. MacLean Hunter Mkt. Reports, Inc.*, 44 F.3d 61, 68–73 (2d Cir. 1994) (addressing merger not with regard to the law but rather to a compilation of prices for cars).

[54] *See Veeck II*, *supra* note 49, at 799; *see also Practice Mgmt. Info. Corp. v. Am. Med. Ass'n*, 121 F.3d 516, 519 (9th Cir. 1997).

[55] *See supra* text accompanying note 1.

[56] *See Veeck II*, *supra* note 49, at 804; *see also Practice Mgmt.*, 121 F.3d at 516.

[57] *Cty. of Suffolk v. First Am. Real Estate Sols.*, 261 F.3d 179, 194 (2d Cir. 2001) (citing *Practice Mgmt.*, 121 F.3d at 518–19).

[58] *Id.* at 195.

[59] *Id.* at 194.

[60] *Id.*

[61] *Id.*

[62] *Cty. of Suffolk v. First Am. Real Estate Sols.*, 261 F.3d 179, 194 (2d Cir. 2001).

factor, the court first considers whether such notice is required by due process.[63] It contends that notice is only required by due process for criminal, significant civil, and administrative issues where the law in question creates the criminal, civil, or administrative obligation.[64] The court further found that the document in question did not create the obligation, but rather allowed for the assessment of it.[65] This suggests that only laws creating obligations (not refining and specifying them) need to be accessible.

In its case, the Ninth Circuit made quicker work of the first issue.[66] The court was confronted with a work that was independently made well before adoption into law by reference.[67] These facts pushed heavily in favor of copyright protection.[68] This is in significant distinction to *Suffolk*, where the work at issue was created by the local government. The Ninth Circuit analyzed the second factor much the same way as the Second Circuit.[69] The court readily dismisses the idea that copyright would bar actual users or that it would reduce access.[70]

The Fifth Circuit, however, flatly rejects these factors.[71] The Fifth Circuit rejects the utilitarian nature of the first prong and instead relies on a theory of citizen authorship.[72] The court cites to earlier decisions holding that judges hold no copyright in their opinions as they are employed by the public to create them, and thus these works are rightly considered authored by the public.[73] The court takes this contention further, applying it to the democratic process of lawmaking. The court suggests that, through the expression of public will, "the law" is born and, as such, is "authored" by the public.[74] The court goes so far as to say even when consciously adopting model codes as law this is still an expression of the public will, and thus "the law" is authored by the public.[75] The court suggests there are two distinct works: "the law" and the model code. Anyone may publish or access the former without regard to copyright, but the latter may maintain such protection.[76] In this, the court seems to combine their discussion of due process and merger. The court does, however, attempt to distinguish the case of model code adoption and incorporation by reference.[77] The court declares "The copyrighted works do not 'become law' merely because a statute refers to them," but does little to clarify.[78]

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63 *Id*. at 195.
64 *Id*.
65 *Id*.
66 *See Practice Mgmt.*, 121 F.3d at 518.
67 *Id*.
68 *Id*. at 517-18.
69 *Id*. at 519.
70 *Id*.
71 *See Veeck II*, *supra* note 49, at 798.
72 *Id*. at 796–97.
73 *Id.*at 795.
74 *Id*.
75 *Id*. at 796.
76 *See Veeck II*, *supra* note 49, at 796.
77 *Id*. at 804–05.
78 *Id*. at 805.

While the Second and Ninth Circuits use a utilitarian framework, it is a rather narrowly focused framework. It only considers the benefit of incentives and only a narrow category of static access loss. Although incentives receive appropriate consideration by the Second Circuit mechanically, in that the judges considered even the case where incentive exists, the court gives too much weight to this factor and not enough weight to the cost of access. Both circuits only require a very minimal "generally available" level of access to justify constructive notice.[79] This minimal degree of access requirement does not take into full account the impact of notice. It only considers the enforcement of law, not commentary, discussion, and criticism that is the cornerstone of an effective democratic system, vital to social welfare.

On the other hand, the Fifth Circuit rejects a direct utilitarian framework entirely. Instead the court indirectly addresses utilitarian theory through merger doctrine. Further, the court's declaration about incorporation by reference gives some reprieve to an otherwise aggressive stance on copyright and law.

C. Application to Patent Documents

As discussed in Part I, patent documents contain a variety of different sections, each containing different information. Thus, each portion of the patent document may need different treatment under copyright.

Examining first the requirements of copyright law, without examining special considerations of copyright in "the law," no single section of a patent document presents a great problem. Because the description, claims, and abstract are specific to each patent, it is unlikely that they lack originality or creativity. If these sections describe a truly novel invention, as required by patent law, it is difficult to imagine how they might lack originality as a whole. Within the description especially, there will often be instances of facts or experimental data presented that receive no copyright protection categorically. However, the presentation and arrangement of this data is unlikely to be so mechanical as to deny copyright on the whole section. As a whole, copyright in the patent document should not be categorically denied on originality grounds.

On other grounds, patent documents present an issue. Denial of copyright on methods or systems when applied to patent documents demonstrate nicely the purpose of such denials. The denial may channel different informational goods into the appropriate property regime. Patent documents must fully enable a person having ordinary skill in the art to make and use the invention. Thus, patent documents act somewhat as instruction manuals. Copyright, however, categorically denies protection to instructions on the grounds that protection is too costly and there is a better system to facilitate creation. The enablement of the invention itself does not receive protection under the current copyright regime. But the specific embodiment of the enablement can receive protection, assuming protection of the embodiment does not grant a monopoly in the enablement.

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[79] *See Cty. of Suffolk.*, 261 F.3d at 195, *Practice Mgmt. Info. Corp.*, 121 F.3d at 518.

The more interesting analysis considers the legal implications of the patent document. Patents protections hold potential for millions of dollars of infringement damages. These damages apply even to unintentional infringement. Because the patent document fully describes what is protected under patent law, access to the patent document is paramount in ensuring compliance with the law.

Under Second Circuit jurisprudence, it is not apparent that patent documents will be denied copyright on the grounds of their legal significance. The circuit has not held that merger in law is possible and provides little support for denying copyright on due process grounds. The circuit first examines whether the patent drafter needs a copyright incentive to create the patent document. As argued above in Part II, the answer is generally no, as to the entire document. Patent documents are readily created under a commissioning system and copyright incentives have little effect in most cases. But the Second Circuit takes a very liberal approach in applying this factor. It may find that the limited incentive aesthetic uses of patent documents offer suffices. The circuit would then examine if the public needs notice of the work to have notice of the law. Under the circuit's analysis, tax maps are unnecessary to have notice of the law as they do not create the obligation, but rather aid in the assessment. So, it is unclear what the circuit would decide as to patent documents. As discussed above, patent documents do not themselves obligate the public but rather define what obligation the public has under patent law. Because patent documents do significantly more than tax maps do, they are likely needed to effect notice of the law under Second Circuit jurisprudence. Again, it is unclear how the Second Circuit might hold on the issue of patent documents, as it seems reasonable to interpret both factors either way.

Fifth Circuit jurisprudence is similarly unclear as to how patent documents might be handled. While merger is an option under the circuit's jurisprudence, it may not apply at all, and it is certainly unclear that it applies to the whole document. The portion of the document most likely to face the issue of merger with law is the claims. The claims specify what is protected under patent law. Much like the approach to interpreting law starts with examination of the language of the statue; the first step in interpreting patents is examining the language of the claims.[80] The claims may merge with "the law." The rest of the patent document is unlikely to face the same issue of merger. Although the description informs the interpretation of the claims,[81] the Fifth Circuit is unlikely to find that control of the exact language of the description controls the uncopyrightable "law."

Due process, however, may paint a different picture. Just as model codes are submitted for incorporation into the law, so are patent documents. The acceptance of the patent document and the subsequent allowance might be seen as the democratic process adopting the patent document into "the law," even if by an administrative agency. However, the patent document's legal significance arises not by its own

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[80] *Merrill v. Yeomans*, 94 U.S. 568, 570 (1876) ("This distinct and formal claim is, therefore, of primary importance, in the effort to ascertain precisely what it is that is patented to the appellant in this case.").

[81] *See id*. at 570–71.

adoption but rather by patent law referring to issued patents. Perhaps this is the adoption by reference the Fifth Circuit had in mind, and thus due process will not put the document in the public domain.

D. Matching Law and Theory

In either circuit, the ultimate fate of a patent document is unclear. Utilitarian theory, however, is clear: patent documents need no protection and should not receive any.

Copyright analysis is poorly equipped to deal with the edge case of patent documents. The few categorical bars, originality requirement, and merger doctrine offer some utility in analyzing the utilitarian balancing problem of works that come before the courts, but they are incomplete. Originality is intentionally weak in this respect, as a strong requirement would have significant chilling effects. These few categorical bars are only useful for issues that have presented themselves before and thus offer very little to the analysis of novel problems. Merger doctrine is likewise poorly equipped as it only provides effective enforcement of the categorical bars.

The limited analysis on works having legal importance is scattered and difficult to interpret. The Second Circuit's analysis is too narrow to properly consider all issues relevant under utilitarian theory. The Fifth Circuit's analysis seemingly rejects utilitarian theory and instead arguably creates a new categorical bar with its merger doctrine analysis. And neither consider affects outside access to the law such as the disruption that copyright protections in patent documents would have on the patent regime.

The strongest argument for copyright protections is to encourage searchability, as discussed above. If protection is granted on these grounds, then the grant should be limited accordingly. To affect this, it would be best to explicitly bar copyright protections in patent documents except to the relevant parts. This would function much like the bar on facts. While facts receive no copyright, arrangements of facts might. Likewise, patent documents may receive no copyright, but certain features in these documents might. This incentivizes creation of these features without the loss of access to the document as a whole. Further, such a system would minimally disrupt the rest of the copyright regime.

However, even this strongest argument for copyright protections is unpersuasive. A property system may offer advantages over no system, but when compared to the governmental fiat or private "prize" system described above, property is less efficient. Because there is little value to incentivizing patent documents with copyright protections and the losses associated would be abnormally great, patent documents should be barred from copyright protection categorically. This results in minimal disruption to the copyright system and would function effectively within it as another statutory bar.

IV. Conclusion

Patent documents present an interesting opportunity to evaluate the utility of

copyright protections. Such documents present both concerns of documents having legal significance and potential synergies amongst intellectual property systems. Under utilitarian theory, patent document protection offers no significant gains and presents extraordinary losses. Despite this, the law regarding copyright protection of patent documents is unclear. Because the law is ill-equipped for effective analysis of patent documents, the only change to the law should be a simple statutory bar categorically denying patent documents copyright protections.