Chapter III: United States Copyright

By the end of the eighteenth century the concepts and practices of copyright were in a state of flux. Some of the traditional features of copyright in England and in pre-constitutional America were already being transformed and yet many more transformations were still a thing of the future. The 1789 constitutional moment, despite its importance, was just a point on this continuum of change. Copyright law was not reinvented in one fell swoop. Nor did it remain stable thereafter or develop as the working out of some pre-established general principle. This chapter surveys the radical transformations of the doctrines and fundamental concepts of copyright in the United States during the first century of the federal copyright regime. When observed from this perspective- over a period of a century- the transformation, though gradual, was indeed dramatic. Under the early federal regime copyright was still the traditional book trade privilege of the publisher to print a text, although it came to be bestowed on authors. By the early twentieth century, however, copyright came to be a generalized field of law based on the fundamental principle of general control of authors of their original works. The latter may sound like an abridged law dictionary definition of copyright, but in fact it encapsulates many complex structures of meaning. In the following pages the content of these structures, their gradual process of appearance and development as well as their complex and sometimes curious character will be elaborated.

A. Federal Beginnings: The 1790 Copyright Act

In May 1790 the new Congress exercised the power granted to it in the Constitution and legislated a general federal copyright law. Like the constitutional clause the Copyright Act of 1790[1] stirred no significant controversy or contention. In sharp contrast to the proceedings leading to the Statute of Anne[2] eighty years earlier, there was no vocal opposition or discernable divisions among different interests lobbying for or against such legislation. In the absence of debate or deliberation there is little direct evidence of the concept of copyright espoused by the legislators or of their

[1] Act of May 31 1790, ch. 15, 1 Stat. 124 (hereinafter 1790 Copyright Act).

[2] 8 Anne, c. 19. On the legislation of the Statute of Anne see *supra* chapter 2 Section I(C)(1)(i) and references there.

understanding of the exact regime they were creating.[3] However, both the history of the Act's legislation and its specific content clearly indicate that there was no significant break with familiar English and colonial concepts and practices. In fact, except for the move to the federal level, every aspect of the new copyright regime remained deeply rooted in the traditional framework.

As in the case of patents, the extent to which contemporaries understood the new federal power as entailing little change from familiar practices is demonstrated by the dynamic leading to the Act. Replicating the process that occurred a decade earlier in the states, Congress was petitioned by individual authors seeking specific legislative privileges for their works and it ultimately responded with a general copyright law. The trickle of petitions started at the first session with a petition by David Ramsay arriving

[3] Unlike the Statute of Anne and the copyright acts of the American states the 1790 act did not contain a preamble in which general rationales were declared. Instead, in a pragmatic fashion, its phrasing started immediately with the operational sections that defined the new regime. Not all of the deliberation leading to the legislation of the Act is recorded and available. In the available record there are a few hints that there was some discussion regarding some features of the copyright federal scheme. Nevertheless, there is little indication of any major controversy or debate. One interesting hint to a potential significant controversy of this kind can be found in the legislative history of the Act. The record shows that on February 1, 1790, there was a motion to "strike fourteen years as the length of copyright." The motion, which, somewhat ambiguously, implies a proposal to make copyright perpetual, was denied. 4 DOCUMENTARY HISTORY OF THE FIRST FEDERAL CONGRESS, LEGISLATIVE HISTORIES 520 (Charlene Bangs & Helen E. Veit eds. 1972) (hereafter: LEGISLATIVE HISTORIES). Unfortunately no more details are available regarding this motion

a mere month after the Congress started its operation.[4] It was quickly followed by other petitioners seeking special protection for their works.[5]

Such petitioners, who appealed mainly to the standard reason of compensating the author for his useful labor,[6] were simply following the, by then, familiar practice from the states. Some of them directly appealed to the new Constitution as the source of the power of Congress to legislate such private acts.[7] The petitioners were asking for specific legislative grants of

[4] Ramsay's petition was submited on April 15, 1789. JOURNAL OF THE HOUSE OF REPRESENTATIVES OF THE UNITED STATES, 1st Cong., 1st Sess., 17 (hereafter: HOUSE JOURNAL); JOURNAL OF THE FIRST SESSION OF THE SENATE OF THE UNITED STATES OF AMERICA, 1st Cong. 1st Sess., 14 (hereafter: SENATE JOURNAL). The text of Ramsay's petition is available in: 4 LEGISLATIVE HISTORIES, *supra* note 3, at 509. For a description of the events leading to the first federal copyright and patent acts see: BRUCE W. BUGBEE, THE GENESIS OF AMERICAN PATENT AND COPYRIGHT LAW 131-148 (1967).

[5] On May 12, 1789 Jedidiah Morse petitioned for protection of his *The American Geography or a View of the Present Situation of the United States of America*. HOUSE JOURNAL, 1st Cong., 1st Sess., 40, 43. Nicholas Pike applied on June 8, 1789 for "an exclusive privilege" in his *A New and Complete System of Arthematic*. 4 LEGISLATIVE HISTORIES, *supra* note 3, at 508. Hannah Adams petitioned for protection on July 22, 1789. HOUSE JOURNAL, 1st Cong., 1st Sess.,77, 80. The extent to which petitioners were immersed in the traditional framework of ad hoc petitions and private laws is exemplified by the petition of Enos Hitchcock dating May 26, 1790. At this time the general copyright bill was in the final stages of being passed into law. Hitchcock who, as revealed by his petition, was aware of that found it necessary nonetheless to ask that "the privilege of a late law, may be extended to him for securing the copy-right of a book which he has lately published." *Id.*, 1st Cong., 2nd Sess., 115-116.

[6] Ramsay wrote in his petition that "he ought to be entitled to any Emoluments arising from the sale of the abovementioned works as compensation for his labour and expense." 4 LEGISLATIVE HISTORIES, *supra* note 3, at 509. Jedidiah Morse mentioned his "labour & Expense." *Id.*, at 511.

[7] Ramsay, after his appeal to the justice of being compensated for his labor, mentioned that "the same principle [is] expressly recognized in the new constitution." *Id.*, at 509. Morse slightly confused the articles when he mentioned that "provision is made in the 4h article ["eight" is struck out] Section of the first Article of the Constitution of the United Sates, for

Congress awarding them for a limited time "the sole and exclusive right of vending and disposing of" their books. Jedidiah Morse's petition was somewhat unusual in this respect. Complaining that "it was an easy matter, by a few alterations & Additions, to destroy the Identity of the Books & the maps," he asked to "secure him the exclusive benefit that might arise from said book & maps" and that "it might be so expressed as effectually to secure the Petitioner, against all mutilations, alterations and abridgments… as may operate to his injury."[8] Morse's requested remedy was beyond the standard scope of copyright protection at the time. It was predictive of the future development of American copyright law, but at the time it was the exception. Other petitions and the final resultant legislation defined the exclusive privilege in the narrower terms of the right to print and sell a specific text. Thus, from the perspective of petitioners the new congressional power and the constitutional clause creating it, rather than being a sharp break with the past, simply constituted a projection of existing practice onto the federal level.

Appropriately enough, Congress too followed a familiar precedent from the states. It referred the petitions to a special House committee which also handled individual patent petitions. At first the committee recommended legislating the individual acts as requested.[9] The House, however, decided to respond to the particular petitions by creating a general regime. It ordered that "a bill or bills be brought in, making a general provision for securing to authors and inventors the exclusive right of their respective writings and discoveries."[10] The first draft of the bill presented in June 23, 1789 encompassed both patents and copyrights, albeit in independent sections.[11] In

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Securing to Authors the exclusive right to their respective Writings." *Id.*, at 511.

[8] *Id.*, at 511.

[9] The committee recommended regarding Ramsay's petition that "a law should pass to secure to him the exclusive right of publishing and vending, for a term of years, the two works mentioned in the petition." Committee Report April 20, 1789, *Id.*, at 510.

[10] HOUSE JOURNAL, 1st Cong., 1st Sess., 22. Further applications for both copyright and patents that kept streaming to Congress were referred to the committee handling the general bill.

[11] The joint bill that was presented on June 23, 1789 was HR-10. Its text can be found in: 4 LEGISLATIVE HISTORIES, *supra* note 3, at 513.

January 1790 the House decided to separate the two bills.[12] At the end of May, after a few more incarnations and changes[13] *An Act for the encouragement of learning by securing the copies of maps charts and books, to the authors and proprietors of such copies, during the times therein mentioned* was passed into law.[14]

Like the dynamic leading to it the content of the Act was thoroughly rooted in the traditional practices and concepts of state copyright. It was even more immersed in the structure and concepts of the British Statute of Anne. In fact, except for the move to the federal level there was hardly anything new about the basic arrangements of the 1790 Copyright Act. The Act close resemblance to the Statute of Anne went beyond the titles of the two. The basic regimes constructed as well as many of their specific details were virtually identical. The subject matter covered by the Act was limited to the traditional book trade materials: "map, chart, book or books."[15] Like in the Statute of Anne at the heart of the Act stood a twenty one years entitlement of exclusivity to authors of existing works and their assignees and a fourteen years protection to authors of new works (renewable once for another fourteen years).[16] The only entitlement conferred by the Act was "the sole right and liberty of printing, reprinting, publishing and vending" the protected works.[17] There was a requirement of registration (at the office of the relevant

[12] 1 ANNALS OF CONGRESS, 1st Cong. 2nd Sess., 1080. HOUSE JOURNAL, 2nd Cong., 1st Sess., 23; 4 LEGISLATIVE HISTORIES, *supra* note 3, at 509.

[13] The first independent copyright bill was HR-39. It was presented by Burke on January 28. 4 LEGISLATIVE HISTORIES, *supra* note 3, at 520. Unfortunately, it seems that no copy of this bill survived. The next bill was HR-43 which was presented on February 25, 1790 and after a few amendments was passed into law. An April 30 version of the bill is available in: *id.*, at 526.

[14] HOUSE JOURNAL, 1st Cong., 2nd Sess., 94, 95 10, 114, 126. SENATE JOURNAL 1st Cong. 2nd Sess., 64-65, 68, 73, 74, 76, 83, 91.

[15] 1790 Copyright Act, §1.

[16] *Id.* The works protected under the Act were any chart, map or book. This went beyond the original Statute of Anne that merely protected books, but was in conformity with both the actual scope of protection in England at the time and with many of the state laws.

[17] *Id.* This included a prohibition on importation of copies of protected works. See *id.*, §2.

district court) as well as of deposit of copies.[18] The only remedy provided by the Act was almost identical to that of the Statute of Anne, at least in form. It consisted of the forfeiture of all infringing copies to the owner of the copyright who would destroy them, and a fine of fifty Cents per sheet to be equally divided between the copyright owner and the United States.[19] The main differences between the eighty years old British statute and the new American one were the absence of the arcane and unusable price control mechanism of the Statute of Anne, and the fact that the Act explicitly protected the right of an author in his unpublished manuscript,[20] while in

[18] The registry role assigned by the Statute of Anne to the Stationers' Company was to be carried out by the clerk of the district court of residence. *Id.*, §3. The deposit of one copy with the Secretary of Sate had to occur within six months of publication. *Id*., §4. The copyright owner was also required to publish for two weeks the record of his copyright "in one or more of the 5 newspapers printed in the United States." *Id*., §3. An 1802 amendment added a notice requirement. It provided that a prerequisite for protection was that the owner would "give information by causing the copy of the record which by said act he is required to publish in one or more of the news papers to be inserted at full length in the title page." In the case of a map or chart the notice consisted of the date of registration and the name and state of the owner. Act of April 29 1802, 2 Stat. 171, §1 (hereinafter 1802 Copyright Act).

[19] 1790 Copyright Act, §2. In addition to the sums of the fine, the remedy differed from that of the Statute of Anne in the fact that the latter allowed qui tam actions by third parties while under the act the copyright owner was the only one who could recover. This was a change introduced in a relatively late stage of the drafting since the first copyright bill, HR-10 allowed qui tam actions by providing that half the fine would be awarded to the copyright owner and the other half to "any person or persons who shall sue for the same." Copyright and Patents Bill HR-10, §2, in 4 LEGISLATIVE HISTORIES, *supra* note 3, at 514. The limited scope of the remedy in the Act is conspicuous in view of the remedy for unauthorized publication of unpublished manuscript mandated in §6 which provided for recovery of "all damages occasioned by such injury." 1790 Copyright Act, §6.

[20] 1790 Copyright Act, §6. This protection did not exist in the first version of the bill- HR-10, and appeared only in the later bills. Since HR-39 is not available it is impossible to say when exactly the explicit statutory protection of manuscripts was added.

England such protection was judicial law making read into the statute which was completely silent on that point.[21]

This close proximity in content entailed an almost exact replication of the general framework and fundamental concepts of copyright in late eighteenth century England. Like the state laws and the Statute of Anne, the Act constituted copyright as a universal right. Although the first petitioners asked for individually tailored private laws to protect their works, Congress responded with a general regime under which any person who fulfilled a set of standard substantive and procedural requirements was entitled to a uniform protection as a matter of right. In this the Copyright Act differed from the 1790 Patent Act that retained substantial ambiguity in this respect and created a regime which at least formally still had important elements of ad hoc discretion regarding the grant and its exact terms.[22] As in the precedent of the states, it seems reasonable to assume that it was not only issues of practicability and scale that channeled Congress in this direction. There was also a preexisting thick institutional framework and tradition. The Statute of Anne, for reasons peculiar to the contingent English context of 1710, created a universal right regime. When Congress came to deal with the protection of authors it "naturally" adopted this preexisting framework which was already a longstanding practice in England and a newer but uniformly accepted one in the states. It did so without the question of general rights vs. ad hoc discretionary privileges being considered or even mentioned on record, in spite of the fact that what petitioners asked for and what the committee initially recommended was the latter.

While the character of the new federal copyright as a general right was unquestioned, it still retained some of the flavor of its origins in specific privilege grants. This was most conspicuous in the sole remedy provided by the Act. As mentioned, the Act provided for no form of compensation for damage or restitution of profits in case of infringement. The sole remedy it mandated was the forfeiture and destruction of infringing copies and the fine of fifty Cents per each sheet found in the possession of the infringer, to be equally divided between the United States and the suing copyright owner.[23] This remedy retained a somewhat hybrid character to copyright. It gave it a color of not a full-fledged private right which simply protected the interest of entitled individuals. The remedy, rather, framed copyright as a state

[21] Pope v. Curll, 2 Atk. 342, 26 Eng. Rep. 648 (Ch. 1741).

[22] See *supra* chapter 4, sec. A(1).

[23] 1790 Copyright Act, §2.

regulation enforced through a semi-punitive sanction. In comparison to the Statute of Anne the Act's remedy moved one step closer toward what we would recognize as a standard private right. Unlike the statute it did not allow any third party "informer" to recover in a qui-tam action, which was a popular instrument in old English and colonial legislation for the enforcement of public regulations.[24] Under the Act the only person who could recover half of the statutory fine was the copyright owner. Nevertheless, the remnants of a public regulation character in the remedy are apparent. Again, there is room for doubt whether this was a conscious choice or simply the inertia of following the Statute of Anne, but one fact is indicative in this respect. In conspicuous contrast to the general remedy, in the special case of an unauthorized publication of a manuscript the Act explicitly provided for liability for "all damages occasioned by such injury" to be recovered in a special action on the case.[25] Whatever the reason was, the standard remedy supplied by the Act retained some of copyright's traditional character as a generalized and standardized state granted privilege and regulation.

In the first reported copyright case in the United States- the 1798 *Morse v. Reid*[26]- The Circuit Court for the District of New York virtually ignored the statutory remedy. In an infringement case it ordered the defendant to pay to plaintiff the amount of net profits arising from the printing, publishing and sale of the infringing copies.[27] The issue of whether

[24] The Statute of Anne mandated that half the statutory fine would be awarded to the Queen and the other one "to any Person or Persons that shall sue for the same." 8 Anne. c. 21, §2. The arrangement of the first American copyright bill HR-10 was an interesting hybrid between the British and the final American statute. It provided that the fine would be divided between the copyright owner and "any person or persons who shall sue for the same."4 LEGISLATIVE HISTORIES, *supra* note 3, at 514. The qui tam action disappeared only in later versions of the bills leading to the Act. One must remember that the description of the instrument of qui tam actions as the enforcement of public regulations through private actions is anachronistic. Rather, the qui tam action is yet another example of a legal consciousness that did not yet employ a sharp public/private distinction.

[25] 1790 Copyright Act, §6.

[26] A report of the case can be found in 5 COLLECTIONS OF THE MASSACHUSETTS HISTORICAL SOCIETY 123 (1798).

[27] See John D. Gordan, *Morse v. Reid: The First Reported Federal Copyright Case*, 11 L. & Hist. Rev. 21, 33-35 (1993). The ruling in Morse is further complicated by the intricacies of the law/equity distinction. The proceedings

damages were available as an alternative to the statutory remedy remained somewhat shrouded in obscurity throughout the century.[28] Story in his *Commentaries on Equity Jurisprudence* seems to have taken it for granted that both the common law remedy of damages and the equitable one of account were available in copyright infringement cases.[29] On the other hand, while the Supreme Court did not directly tackle the specific question during the nineteenth century, its general rulings on remedial issues seem to point toward a strict construction of the available remedies.[30] When later in the century, copyright treatises started to appear, their writers took the position

in that case were in equity and the remedy was the disgorgment of profits made by defendant. It is very likely that this was done under one version of the accounting remedy that equity courts gave on a regular basis in support of rights at law, at least when they had other basis for acquiring jurisdiction, such as circumstances justifying an injunction. For the complex structre of the various kinds of accounting actions in law and in equity during this period see: Mark A. Thurmon, *Ending the Seventh Amendment Confusion: A Critical Analysis of the Right to Jury Trial in Trademark Cases*, 11 Tex. Intell. Prop. L. J. 1, 42-55 (2002). It seems that digorgment of profits was commonly given by equity courts during the early nineteenth century. This leaves unanswered the question of whether common law courts granted actual damages before these were added to the statute.

[28] The statute was amended only in 1870 when the penalty was repealed and replaced by "such damages as may be recovered in a civil action." Interestingly, the new remedy applied only to books, while in regard to other subject matter the plaintiff remained limited to the per-copy statutory fine (of an increased amount). Act of July 8 1870, 16 Stat. 212, §§99-100 (hereinafter: 1870 Copyright Act). Only in 1908 did the Supreme Court directly decide the issue of damages for copyright infringement not provided for by the statute. It ruled that the copyright remedies were strictly limited to the statutory ones. Globe Newspaper Co. v. Walker, 210 U.S. 356, 362-367 (1908).

[29] 2 JOSEPH STORY, COMMENTARIES ON EQUITY JURISPRUDENCE AS ADMINISTERED IN ENGLAND AND AMERICA 210, §932 (2nd ed.1839).

[30] For strict interpretation of the remedies in patent and copyright cases see: Livingston v. Woodruff, 56 U.S. 546, 558-560 (1853); Stevens v. Gladding, 58 U.S. 447, 453-455 (1854).

that the remedy of damages was available despite its absence from the statute.[31]

The actual exact remedial practice of the early lower courts, many of whose decisions were unreported, remains unknown. Yet the court's approach in *Morse* opens up an important window to such practices. Although it is impossible to generalize on the basis of one case, the outright "revolt" against the statutory remedy by the Circuit Court and by later commentators is indicative. It seems that the reason for such resistance to the plain statutory framework was the difficulty experienced by later jurists in accepting the remnants of the state privilege character embodied in the statutory remedy. The invention of actual damages was an attempt to convert statutory copyright to a "regular" private right backed by the standard remedy of such a right. This interpretation must remain a conjecture since the court in *Reid* simply ignored the question and awarded damages without any explanation. It is significant, however, that a similar judicial "revolt" against the statutory remedy occurred in England in the same year as *Morse v. Reid.* In *Beckford v. Hood*[32] Lord Kenyon awarded damages in a copyright infringement case. Kenyon's sense of dissonance in the face of the "public" statutory remedy attached to what he already experienced as a private right was more explicit. "[N]othing could be more incomplete as a remedy than those penalties alone," he wrote. In a classic judicial move of forcing later rationales on an unsuspecting early legislature Kenyon explained: "I cannot think that the Legislature would act so inconsistently as to confer a right and

[31] George Ticknor Curtis asserted in his 1847 treatise that: "No action on the case for damages is provided by statute; but there can be no doubt that here, as well as in England, such an action lies at common law." He gave no reason whatsoever to this confident assertion. GEORGE TICKNOR CURTIS, A TREATISE ON THE LAW OF COPYRIGHT 313 (1847). When Drone published his seminal treatise in 1879, the statute already expressly recognized damages as a remedy in the case of books but not in the case of other subject matter. Drone, however, was quick to apply the remedy to other subject matter through the following interpretation: "maps, charts, and musical compositions have been expressly held to be books. Moreover, the common law remedy by action for damages is available in any case where such remedy is not expressly provided by statute." EATON S. DRONE, A TREATISE ON THE LAW OF PROPERTY IN INTELLECTUAL PRODUCTIONS IN GREAT BRITAIN AND THE UNITED STATES 404 (1879).

[32] 7 T.R. 620, 101 Eng. Rep. 1164 (K.B. 1798). One has to notice that *Beckford* involved common law damages while *Morse* most probably awarded disgorgement of profits under the equitable account remedy.

leave the party whose property was invaded without redress."[33] This, however, was exactly how the 1790 American legislature acted when it crafted copyright's remedy. It did so without the slightest sign that anyone involved felt any "inconsistency."

The immediate subjects protected by the new federal right were, unequivocally, individual authors. Of course, assignablity and the rights of assignees were recognized by the Act, but such rights were formally derivative of those of the author. In contrast to the situation in England at the beginning of the early eighteenth century, in 1790 United States the probability of things being otherwise was minimal. In the United States there was no institutional player equivalent to the Stationers' Company that provided either an established tradition of exclusive control of copyright by non-authors, or a significant political pressure in that direction. To be sure, there was the legacy of sporadic printing and vending privileges granted to colonial printers, but that was very far from being an equivalent of the thick institutional tradition and the concentrated political power of the stationers in England. Moreover, in late eighteenth century America the figure of the author was already quite central in public consciousness. When elaborate regimes and a more intensive and consistent interest in copyright arose during the early days of the states, the author was univocally placed at the center of public thinking about copyright. By 1790, there was hardly any viable imaginable alternative to the author as the primary subject of the right. Thus while both the Statute of Anne and the 1790 Act formally located copyright in the hands of authors, the latter was not subject to a period of ambiguity and uncertainty as to the actual legal status of the author. This does not mean, of course, that in 1790 there were well elaborated concepts of authorship and creativity integrated into the legal framework or reflected in its doctrinal details. The exact meaning and consequences of placing the author at the heart of copyright were to be debated, elaborated and transformed during the decades to come.

Finally, as to the object of the right the act followed the Statute of Anne by defining it as the traditional publisher's or printer's trade privilege.

[33] *Id.* at 627, 101 Eng. Rep. 1167. As Gordan points out Kenyon had somewhat stronger reasons to be enraged. The English statutory fine of a penny per sheet was of little value and unlike the American act the statute allowed qui tam actions. Gordan, *supra* note 27, at 37. Nevertheless the similarity between the basic approach of the English and American courts that decided similar issues independently in the space of five weeks is striking.

The only entitlement awarded by copyright was "the sole right and liberty of printing, reprinting, publishing and vending" a map, chart or book.[34] This was the trade privilege of the publisher, familiar both from the English context and the colonial practice, which was now projected on the author. It was limited to the exclusive right to print and sell a particular text. There was in the Act no concept of copyright as a general control of an intellectual "work" or of as a bundle of various entitlement vis-à-vis such "work." Indeed the term and concept of the "work" are completely absent from the Act. The Act is, rather, based on the traditional trade-centered concepts of verbatim reproduction of texts and the sale of such verbatim copies. The transformation of a map, chart and book into the intellectual work and the broader notion of ownership of such a work were yet to come.

Thus with several differences of emphasis and nuances the 1790 Act replicated much of the formal legal situation in post 1710 England. It also adopted by incorporation most of the ambiguities, open questions, unresolved dilemmas and embryonic developments of the English context. Thus although the formal legal question of common law copyright was settled in England in 1774, the United States was still to have a literary property struggle of its own, in which many themes similar to the English ones would be played out involving somewhat different nuances and guises. Despite the glorification of literature and of the genius author in the period's public discourse, copyright was still a rather limited trade regulation of a particular economic branch: the book trade (broadly defined). The 1802 expansion of copyright protection to "every person… who shall invent and design, engrave, etch or work any historical or other print or prints,"[35] was still within this limited framework. As in England where engraving and etching were protected since 1735[36] prints were considered part of the book trade and their incorporation in the copyright regime was hardly a significant development. The more radical expansion of the subject matter of copyright and the conceptualization of copyright protection based on original

[34] An earlier version of HR-43 referred to "any map, chart, book or other writings," but this was amended by Senate by striking out "other writings" and adding "books." See 4 LEGISLATIVE HISTORIES, *supra* note 3, at 526.

[35] Act of April 29, 1802. 2 Stat. 171, §2. The act was somewhat ambiguous regarding the term of protection of prints. It provided for fourteen years protection and did not mention any second term or renewal option. On the other hand it provided that the protection would be "as prescribed by law for maps, charts, book or books." *Id.*

[36] 8 Geo. II c. 13. See *supra* chapter 2, Section I(C)(2)(e).

authorship as an overarching category rather than a trade-specific regulation were a thing of the future. This generalization and abstraction of copyright into a general principle; the debate over copyright as a property right; the notion of ownership of a work as general control; the expansion of the concept of the work; and the curious development of the notions of originality and authorship; were all to appear, and to be shaped in the nineteenth century legislative and case law developments.

B. A Literary Property Struggle All Over Again: Wheaton v. Peters

The 1834 seminal case of *Wheaton v. Peters*[37] probably best exemplifies the fact that American copyright law inherited not only the basic structure and concepts of its English origin, but also the dilemmas, ambiguities and ongoing transformations characteristic of early nineteenth century English copyright jurisprudence. Most existing treatments of the case are mainly interested in two aspects of it. First, *Wheaton* reenacted in the United States sixty years after it was ended in Britain the dramatic debate over literary property and the question of common law copyright.[38] Second, woven into this debate were two competing views of copyright, the division between which has continued to preoccupy copyright jurisprudence ever since. A positivist view of copyright as a state created right based on considerations of public policy and expediency clashed with an opposing conception of copyright as an individual natural right grounded in pre-political reason, prior to any positive law.[39]

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[37] 33 U.S. 591 (1834). In 1834 Peters privately published another more extensive version of the report: RICHARD PETERS, REPORT OF THE COPY-RIGHT CASE OF WHEATON V. PETERS DECIDES IN THE SUPREME COURT OF THE UNITED STATES (1834) (hereinafter: WHEATON V. PETERS). While omitting some parts of the counsel's arguments this independent version conveys a more elaborate and fuller account of the opinions of the Justices and the arguments of the parties. Unless otherwise stated all references here are to the independent report.

[38] See LAYMAN R. PATTERSON, COPYRIGHT IN HISTORICAL PERSPECTIVE 203-212 (1968). Howard B. Abrams, *The Historic Foundation of American Copyright Law: Exploding the Myth of Common Law Copyright*, 29 Wayne L. Rev. 1119, 1178-1185 (1983).

[39] See e.g. Jon Garon, *Normative Copyright: A Conceptual Framework for Copyright Philosophy*, 88 Cornell L. Rev. 1278, 1298-1299 (2003).

Wheaton, no doubt, involved all of these themes, but the focus of my interest in it here is slightly different. The case and the legal-ideological arguments it sparked supply a rare and probably unique[40] window for observing copyright thinking among leading American jurists during the early nineteenth century. The debates over common law and the nature of copyright as positivist or natural right channeled these jurists to deliberate and construct arguments about the fundamentals of the copyright system. They found themselves trying to answer basic questions such as: What is copyright? Is it property? What is property? What does it mean to be the "owner" of copyright? What is the object of ownership in copyright? The attempts of the jurists involved in *Wheaton* to deal with these questions supply a glimpse at the conceptual world of contemporaries. An examination of the American literary property debate and of the arguments constructed by both sides taking part in it reveals that at this point in time the basic conceptual framework of copyright was at an important crossroads. The best legal minds of the time were grappling with new questions. They were trying to elaborate the implications of the recently established authorship basis of copyright and develop novel legal concepts such as property in ideas. Nevertheless in their attempts they ended up falling back on the old concepts and schemes taken from the traditional universe of copyright as the printer's economic privilege. Hence *Wheaton v. Peters* epitomizes the transformation of copyright during the nineteenth century. It is the last significant moment of simultaneously looking forward and backward, beyond which a gradual reworking of the system will ensue and make the old structures of meaning irrelevant.

Like most dramatic moments of grand ideological deliberation *Wheaton v. Peters* was instigated by a clash of very earthly interests. The conflict started when Richard Peters, the reporter of the Supreme Court, decided to republish in a condensed and cheaper series the decisions of the Supreme Court reported by the earlier reporters- Dallas, Cranch and Wheaton. Peters praised the virtues of his own edition, the prominent one of

[40] At the time there was relatively little legal analysis of copyright in the United-States and even less theoretical discussion of the fundamentals of the system within legal discourse. This stood in sharp contrast to Britain where the dramatic events of the previous century left mounds of polemics about the moral and philosophical underpinnings of copyright. Theoretical debates of copyright and its fundamental justification, some of which echoed the British debates, did occur, however, in non-legal publications even before *Wheaton*. See GRANTLAND S. RICE THE TRANSFORMATION OF AUTHORSHIP IN AMERICA 88-92 (1997).

which, he thought, was the accessibility and availability of the law of the land to all citizens of the Republic, even those who could not previously afford to obtain the reports. Understandably Cranch and Wheaton were less impressed. Peters, however, firmly rejected all complaints. Claiming that his actions were perfectly legitimate,[41] he invited them to challenge him in court and promised booksellers offering his reports who grumbled about "threats" to assume full responsibility for any action against them.[42] In 1831 Wheaton and his publisher Robert Donaldson reacted with a lawsuit in the Circuit Court of Pennsylvania. When the suit was rejected[43] the case was appealed to the Supreme Court where it became the first copyright case to be decided in the Supreme Court of the United States[44] and was argued by the most prominent lawyers of the day.[45] *Wheaton v. Peters* was also wonderfully self-referential. It was a case in which the Supreme Court decided a dispute between the incumbent reporter of the Supreme Court and his predecessor over the publication of the reports of the Supreme Court's decisions. The arguments of both Justices and counsel are full of references to the publications at the heart of the dispute, and, needless to say, the case itself was quickly published as part of the defendant's reports. The *Wheaton v. Peters* affair also involved a complex set of personal relations between many of the protagonists including litigants, judges and counsel.[46]

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[41] See: A letter by Peters from March, 2 1831. Cited in WHEATON V. PETERS, at 10-11.

[42] *Id.*, at 9-10.

[43] Later Wheaton charged Judge Hopkinson of taking advantage of the absence of Justice Baldwin due to illness in order to decide the case against him. See, Patterson, *supra* note 38, at 211. Baldwin would later become one of the dissenters from the decision of the Supreme Court.

[44] Although some of the Justices of the Supreme Court decided copyright cases as part of their duty in the federal Circuit Courts.

[45] Wheaton was represented by his former law-partner Elijah Paine and by Daniel Webster. Peters hired the services of Thomas Sergeant and J.R. Ingersoll.

[46] For a comprehensive description of the complex personal and institutional story behind the case see: EDWARD G. WHITE, THE MARSHALL COURT AND CULTURAL CHANGE, 1815-1835 408-424 (1988); Craig Joyce, *The Rise of the Supreme Court Reporter: An Institutional Perspective on Marshall Court Ascendancy*, 83 Mich. L. Rev. 1291, 1364-1386 (1985). For Wheaton's later

1. Property in Ideas and the Materiality of the Text

The argument in *Wheaton* revolved around three main questions: whether all the requirements of the Copyright Act were mandatory and constitutive of the right and whether they were complied with; whether reports of court decisions could be the subject of copyright protection; and whether there existed common law copyright protection independent of the statutory scheme. The bulk of the arguments were devoted to the first question. To the extent they dealt with the third, the focus was on the American reception of English common law and not on the principled issue of property in ideas. English jurists fifty years earlier tended to approach the subject by producing mini-treatises on the nature of property. When George Ticknor Curtis wrote the first American copyright treatise in 1847 he took the same approach. "[T]here are certain great characteristics which mankind have universally attributed to the right"[47] of property, he explained. Only after answering the question "[w]hat constitutes property?" by elaborating these essential characteristics, "we shall be able to say whether any supposed subject of the right posses the general attributes of property, and whether it is agreeable to justice and fitness that it should be so recognized."[48] The Justices in *Wheaton v. Peters*, however, appear to have struggled to avoid such abstract and theoretical discussions. Still the question of the feasibility of copyright as a property right could not be wholly avoided. It received some treatment, especially in the argument of counsel. The ghost of Justice Jacob Yates, who according to Wheaton's lawyer- Elijah Paine- "probably said all that ever was or can be said"[49] against literary property, was clearly hovering over this part of the debate.

The one theme common to the arguments of all parties and Justices in *Wheaton* was the acceptance of a Lockean style labor justification of property. The idea that property, or at least common law property rights, derived from a pre-political "natural law" of reason according to which an individual acquired exclusive property in the product of his labor, pervaded the entire debate. Paine, arguing for plaintiff, framed this argument by using a citation from Edward Christian- Blackstone's commentator:

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bitter accusations against Justice Story see also: Patterson, *supra* note 38, at 211-212 (1968).

[47] Curtis, *supra* note 31, at 4.

[48] *Id.*

[49] WHEATON V. PETERS, at 18.

> "But the true mode of ascertaining a moral right, is to inquire whether it is such as the reason, the cultivated reason, of man kind must necessarily assent to. No propositions seems more comfortable to that criterion, than that every one should enjoy the reward of his labour; the harvest where he has sown; or the fruit of the tree which he has planted."[50]

While the opposing parties agreed to this starting point, the rest of their analysis proceeded in very different directions.

The case of the proponents of common law copyright was based on a strategy introduced by William Warburton almost a century earlier in his pamphlet on literary property:[51] the equation of intellectual labor and intellectual products with physical labor and products. The dissenting Justice Thompson explained this argument as follows:

> "The great principle on which the author's right rests, is, that it is the fruit or production of his own labour, and that labour, by the faculties of the mind may establish a right of property as well as by the faculties of the body."[52]

A major problem faced by the American supporters of literary property was that the argument about mental labor and mental products was at odds with the narratives of the traditional European giants of natural law to the authority of whom they explicitly appealed.[53] These seventeenth century writers did not contemplate the notion of property in intangibles. Their elaborations of the pre-political origin of property rooted in a quasi-historical depiction of the "state of nature" in which people appropriated resources from the commons had strong connotations of physical labor and physical possession. In order to get rid of these troublesome connotations a revised narrative had to be offered. The theoretical model of natural property rights had to be revised in order to encompass property in intangibles.

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[50] *Id.*, at 20.

[51] See *supra* chapter 2, Section I(C)(2)(a).

[52] WHEATON V. PETERS, at 110.

[53] Paine, for example, argued that "[l]iterary property possesses every feature, which Puffendorf considers necessary, to give any subject the character of property." *Id.*, at 24.

Paine accomplished this by turning to English eighteenth century interpretations of labor theory according to which "[n]othing is more erroneous than the practice of referring the origin of moral rights, and the system of natural equity, to that savage state which is supposed to have preceded civilized establishment, in which literary composition, and of consequence the right to it, could have no existence."[54] In order to adjust the seventeenth century narrative to encompass intellectual property the emphasis had to be shifted form the "state of nature" as a quasi-historical description of a "savage state" to the "cultivated reason of mankind." From this perspective "natural law" was no longer identified with history, but rather with abstract reason. When Curtis examined the question of copyright's foundation in natural law in his copyright treatise he performed the same maneuver:

> "It is, of course, impossible to look to the mere light of nature for a solution of this question, or to find it in any speculation upon the condition of man in that imaginary state, which has been called the state of nature… But aside from the fact that the merely natural rights of man could confer no exclusive possession of ideas and sentiments thus uttered, it is to be observed, that the act of committing ideas to any corporeal substance, by means of signs, and the multiplication and delivery of copies, thus produced, for a valuable consideration are things that can only take place after society is formed and an advanced stage of civilization has been reached… we have reached an artificial and refined condition of mankind, in which the mere light of nature will no longer guide us. We must have recourse to those general principles of justice and right, which mankind are supposed to have brought originally from the state of nature, but by which they have agreed to be bound in a state of civilization, where they have become modified, enlarged and strengthe ned."[55]

Thus the emphasis subtly moved from a story of static immemorial universality grounded in the natural ways of the world to a dynamic story of progress in which reason was unveiled as humanity ascended from savagery into civilization. Transplanting the traditional natural law theories of property

[54] *Id.*, at 20. This was yet another citation from Christian.

[55] Curtis *supra* note 31, at 2-3.

in the new context of intellectual property entailed subtle changes in the readings and meanings given to these theories.

While proponents of common law copyright emphasized labor in general and intellectual labor in particular as the basis of property, their opponents shifted the ground of the debate. The latter did not deny that labor was the basis of property. They went on, however, to assert that labor alone could no be a sole sufficient criterion for the existence of property and that other basic characteristics were essential for anything to qualify as such. The opinion of the court written by Justice McLean remained somewhat obscure on this issue. McLean rephrased Yates' argument in *Millar*:

> "That every man is entitled to the fruits of his own labour must be admitted, but he can only enjoy them, except by statutory provision, under the rules of property which regulate society, and which define the right of things, in general."[56]

This implied that the general criterion of labor was not enough and that other conditions had to be met before anything could be recognized by the common law as property. But McLean never explained what these additional conditions were. Instead he argued that the right of the author could not be distinguished from that of the inventor and that authors were compensated for their labor through the sale of their manuscripts.[57]

What then was the essential trait of property missing in literary works according to American opponents of common law copyright? Again Justice Yates was called to the rescue here, speaking through the argument of J.R. Ingersoll for the defendant. The indispensable missing hallmark of property, he explained, was possession:

> "The notions of personal property of the common law, which is founded on natural law, depend materially on possession, and that of an adverse character, exclusive in its nature and pretensions. Throw it out for public use, and how can you limit or define the use? How can you attach

[56] WHEATON V. PETERS, at 100.

[57] Edward White described McLean's opinion for the court as one that "was sketchily reasoned and gave every sign of being hastily written." White, *supra* note 46, at 420.

> possession to it at all, except of a subtle and imaginative character?"[58]

Like the original views of Yates, Ingersoll's statement bundled together indistinguishably two different strands of argument. According to one reading, at the heart of the argument lay the non-excludability of intangible ideas. From this perspective ideas could not be a proper object of property because once they were published, once they were "thrown out" for the use of the eyes and minds of the public, it became impossible to exclude others from using them. A variation on this theme was the argument that once an author put his ideas into such an un-excludable state the act gave rise to a presumption that he intended to open them to unrestricted public use. Justice Thompson in his dissent read the defendant's argument exactly this way and devoted a substantial part of his opinion to exposing what he saw as the fallacy of the argument- especially in its implied intention variant.

However, intertwined with the un-excludability claim there was a different strand of argument. From this slightly different perspective the fatal flaw of the lack of physical possession in the case of ideas was the loss of the supposedly naturally and objectively defined borders of the object of property. Physical possession seemed to supply a self-defining character to the object of property: a natural connection between the owner and the owned and a readymade demarcation of the owned. When it came to elusive intangible ideas this self-defining character grounded in physicality seemed to disappear in a "subtle and imaginative" haze.

The argument, thus understood, invoked deeply rooted structures of meaning about property rights, the common law and the role of the jurist. Since the eighteenth century the common law was often identified with the universal principles of natural law. In early nineteenth century American jurisprudence the concept of natural law was a complex and ambiguous one, weaving together various possible meanings.[59] Yet in the context of property natural law increasingly meant a set of individual pre-political rights that were not created by positive manmade law, but rather were reflected and protected by it within civil society.[60] Thus in the context of property identifying common law with natural law meant presenting it as a reflection

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[58] WHEATON V. PETERS, at 79.

[59] MORTON J. HORWITZ, THE TRANSFORMATION OF AMERICAN LAW, 1870-1960 : THE CRISIS OF LEGAL ORTHODOXY 156 (1992).

[60] *Id.*

of this set of pre-political individual rights defined by "reason." For Ingersoll, the lack of physicality in the case of ideas seemed to destroy exactly this reliance on reason or on the objective nature of the world in defining property rights. The impossibility of simply detecting in the world pre-existing connections between owners and objects and clear pre-defined borders demarcating the various owned objects seemed to destroy the argument that property rights were simply a reflection of a pre-existing natural order. As Ingersoll put it:

> "If you may read, you may print. The possession is not more absolute and entire in one case than the other. It is an artificial and therefore arbitrary rule which draws the distinction; and in order to render it available, the lesson must be read in the statute."[61]

To be sure, where no natural borders and connections existed the law could create them. The law could be crafted, for example, as to mandate that certain books were allowed to be read freely but not reprinted. But that, according to the natural law conception of the common law, meant an exercise of political will. It was imposing by law "arbitrary" arrangements on social reality rather than reflecting the natural state of things in the world. Within this way of thinking, the natural/arbitrary distinction was homologous with that of common-law/statutory-law. Common law and the judges pronouncing it derived their legitimacy from the fact that they were simply reflecting or submitting to a universal reason or to the nature of the world. On the other hand, the political arbitrary line-drawing needed in the absence of "natural" demarcation of property rights was the hallmark of statutory law. For Yates and Ingersoll losing the materiality of the object of property meant losing the objective self-defining character of property rights. This, in turn, meant the politicization of intellectual property rights. Such "arbitrary" rights could only be defined and determined through a political act of will and statutory law.

This part of the defendant's argument is quite striking. By 1834 this mode of argumentation about common law in general and common law property rights in particular was out of fashion in American legal discourse. According to the dominant view in historical research, since the turn of the century the discourse of American private law became increasingly instrumentalist. The dominant trend became to justify particular legal results

[61] WHEATON V. PETERS, at 79.

on the basis of desirable social or economic outcomes.[62] As part of this shift the late eighteenth century sharp distinction between common law and statutory law was disappearing. The common law was increasingly described as a form of law making and its justification and source of legitimacy shifted from being the reflection of universal principles of reason to the promotion of social utility.[63] In the field of property this period is marked by growing awareness of the interdependence of property rights and a move from a static conception of property as absolute dominion over a well defined object toward a more dynamic and instrumentally orientated view.[64] Yet in *Wheaton v. Peters* we find the prominent jurists of the day argue in the terms of common law as the expression of reason and natural rights; of a sharp statutory-law/common-law distinction; and of property as based on objective and stable borders between things. Similarly, George Curtis devoted the bulk of the introduction of his seminal treatise to a lengthy discussion of copyright and natural law.[65]

While it is doubtful that this casts any doubt on the general historical account of the rise of instrumentalism, it seems very clear that the

[62] WILLARD J. HURST, LAW AND THE CONDITIONS OF FREEDOM IN THE NINETEENTH-CENTURY UNITED STATES (1956); WILLARD J. HURST , LAW AND ECONOMIC GROWTH: THE LEGAL HISTORY OF THE LUMBER INDUSTRY IN WISCONSIN 1836-1915 (1964); WILLARD J. HURST, THE LEGITIMACY OF THE BUSINESS CORPORATION IN THE LAW OF THE UNITED STATES, 1780-1970 (1970); MORTON J. HORWITZ, THE TRANSFORMATION OF AMERICAN LAW 1780-1860 1-30. (1977); William E. Nelson, *The Impact of the Antislavery Movement upon Styles of Judicial Reasoning in Nineteenth Century America*, 87 Harv. L. Rev. 513 (1974). For a view which is much more skeptical toward the assumptions that the mid-nineteenth century mode of judicial reasoning was overwhelmingly instrumentalist and that after the Civil War it was supplanted by a formalist higher law approach see: Harry N. Scheiber, *Instrumentalism and Property Rights: A Reconsideration of American "Styles of Judicial Reasoning" in the 19th Century*, 1975 Wis. L. Rev. 1.

[63] Horwitz *supra* note 62, at 4-9, 16-30.

[64] Horwitz, for example, describes a shift in property law from a general rule of quiet enjoyment of one's property toward doctrines and concepts which were more receptive to developmental uses even at the cost of negative influences on another's property. *Id.*, at 31-62.

[65] Curtis, *supra* note 31, at 1-18. Curtis nevertheless added a short section designed to show that "public policy requires a recognition of the natural rights of authors." *Id.* at 18, 18-21.

development of the modes of legal reasoning in the specific context of property in intangibles followed a somewhat different pattern. In the first half of the century, this particular legal context, rather than serving as a drive toward a more abstract and instrumentalist discussion of property as one could expect, actually caused the debate to fall back onto earlier traditional conceptions. What could account for this? One possible reason is simply the inertia of relying on the eighteenth century English precedents. The English literary property debate and the arguments of eminent figures such as Mansfield, Yates and Blackstone left such a mark on the field that they could not be ignored. While mid-century American courts often did not hesitate to reject old English precedents, it was highly implausible that an American jurist of the time would approach the general question of literary property without relying on the by then canonical English debates. That debate constituted much more than a "precedent." It was a complete framework for approaching and analyzing the subject. However, when the English legal arguments were employed by nineteenth century American lawyers, the eighteenth century views about common law and about property rights crept in. Another possibility is that it was the novelty of explicitly and directly facing for the first time the theoretical questions of property in intangibles that caused American lawyers to retreat to the more secure and reassuring terrain of conceptualizing common law property as the reflection of the natural objective order of the world. One way or another, It seems that mid-century legal discourse about the question of property in intangibles was a somewhat exceptional center of natural law concepts of property amid a legal culture whose dominant modes of argument shifted in a different direction.

When Paine, arguing for plaintiff, faced this counterargument he too relied on the English eighteenth century discourse rather than turning to an instrumentalist reasoning. He sought to show that literary works were not the obscure undefined entity depicted by Inersoll; that in this context too there were naturally defined connections between the owner and the owned and objectively marked borders to the object of property. If plaintiff called upon the arguments of Yates the defendant mobilized the authority of Blackstone. There was a fatal flaw in the argument about the fluidity and the lack of objective demarcation of ideas, Paine explained. The flaw was that the object of property in the case of copyright was not ideas at all. Copyright was ownership of the particular language and expression used by the author rather than of his ideas. The problem with the argument of Yates was:

> "forgetting that books are not made up of ideas alone, but are and necessarily must be, clothed in language, and embodied in a form which gives them individuality and identity that make them more distinguishable than any

> other personal property can be. A watch, a table, a guinea, it might be difficult to identify; but books never."[66]

By arguing that "the question is not as to property in ideas but in books"[67] Paine was reenacting the maneuver Blackstone performed in *Tonson v. Collins*[68] and in the *Commentaries*.[69] Indeed, he provided a lengthy citation of Blackstone's definition of the object of property in the case of copyright as the "sentiment and the language" or "the same conceptions clothed in the same words."[70]

Shifting the ground from ownership of ideas to ownership of specific language was a brilliant move. It seemed to restore to the object of property in copyright law the materiality whose absence haunted jurists. The "book" or the "language" constituted a semi-material entity, a seemingly fixed and stable object in which to ground the property right. This was the antithesis of the image of ownership of elusive and indeterminate "ideas" and of the specter of uncertainty and arbitrary line-drawing it carried with it. Moreover, as Meredith McGill argued, Paine's description of the text elevated it to a new level of materiality, one which was marked by an even higher degree of individuality and identity than "regular" material objects.[71] The identity of a watch, a table or a guinea might be mistaken, but never that of a particular language or a "book." This picture of super-individuality had two merits for Paine's case. First, it established clear and objective borders to the object of property. The specific expression of a text as opposed to the abstract "ideas" it communicated played a role equivalent in function to the physical boundaries of other objects of property. It supplied self-defining stable and objective borders. Second, it constructed a view of a world in which texts carried with them inerasable marks of their origin and inseparable bonds to their authors. Books, Paine explained, "may be copied or pirated, but no one

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[66] WHEATON V. PETERS, at 18.

[67] *Id.*, at 19.

[68] 1 Black W. 301, 343, 96 Eng. Rep. 169, 189 (K.B. 1761). See also: *supra* chapter 2, Section I(C)(2)(b).

[69] 2 WILLIAM BLACKSTONE, COMMENTARIES ON THE LAWS OF ENGLAND 405-406 (1765-1769).

[70] WHEATON V. PETERS, at 19-20.

[71] Meredith L. McGill, *The Matter of the Text: Commerce, Print Culture, and the Authority of the State in American Copyright Law*, 9 American Literary History 1, 7-11 (1997).

ever supposed that others would or could accidentally produce the same work as a previous author. It is impossible even to produce the same paragraph."[72] The particular expression of a text was, from this perspective, a permanent stamp communicating to the world its own identity and the identity of its owner-creator. These two elements combined- self-defining stable borders and a permanent mark of identity- made texts the ultimate object of property.

The dissenting Justice Thompson accepted this argument wholeheartedly concluding that Yates' objections "would hardly deserve a serious notice had it not been taken by a distinguished judge."[73] Thompson explicitly turned to the renewed sense of materiality supplied by fixing the object of property in the expression. He explained that the fallacy of the defendant's argument was assuming that "the claim was to a mere idea not embodied or exhibited in any tangible form or shape,"[74] and located the identity of the work in the particular language used:

> "The purchaser of a book has a right to all the benefit resulting from the information or amusement he can derive from it; and if in consequence thereof, he can write a book on the same subject, he has a right to do so. But this is a very different use of the property, from the taking and publishing the very language and sentiment of the author, which constitute the identity of his work."[75]

This amounted to an early version of the idea/expression dichotomy of modern copyright law. Curtis' formulation made this dichotomy even more explicit:

> "The author of every original literary composition creates both the ideas and the particular combination of characters which represents those ideas upon paper. He is therefore an inventor in two senses… The two subjects of the invention are therefore inseparably interwoven…Considered, however, with reference to its component parts, this invention consists of distinct creation, the ideas themselves and the combination of

[72] WHEATON V. PETERS, at 27.

[73] *Id.*, at 113.

[74] *Id.*

[75] *Id.*, at 114.

> characters which exhibits those ideas to the eye… As soon as publication takes place, it is no longer his object or intention to retain to himself the intellectual appropriation and enjoyment of the ideas themselves. What he does seek to reserve is, the exclusive multiplication of copies of the particular combination of characters, which exhibit to the eye of another the ideas that he intends shall be received."[76]

The focus of these formulations was not the modern utilitarian one of striking the right "balance" between control and free dissemination of information. Nor was it predominantly concerned with assuring the free circulation knowledge in society. For Thompson and Curtis the distinction between idea and expression was mainly between that which lacked the fundamental traits of an object of property as they were understood within a tradition of pre-political natural rights, and that which was the perfect object of such property rights.

Implicit in this debate over the proper object of copyright protection, was a conception of the literary "work." The plaintiff's argument was based on a conception of the work that was close to the traditional notion of the "book" or the "copy." Namely, an intangible entity which consisted in the exact wording of a text or in Mansfield's words, which were cited in the argument: "somewhat intellectual communicated by letters."[77] At this point exactly lay the main difficulty of the Blackstone-Paine-Curtis brilliant argument. The narrow conception of the work used by the proponents of common law copyright was consistent with traditional notions of copyright as a trade privilege to print a text. Yet at the very same time that *Wheaton v. Peters* was argued and decided these notions were being eroded and transformed. In a series of cases during the first half of the century, both in England and the United States copyright protection was gradually reinterpreted as protecting the "value" of the original work.[78] This entailed expanding the scope of protection well beyond verbatim reproduction, which in turn implied a much broader conception of the protected intellectual work. At the very same time that Paine and Thompson were relying on the concreteness of the text to justify literary property, the legal conception of the

[76] Curtis, *supra* note 31, at 12-13.

[77] WHEATON V. PETERS, at 18. Citing Millar v. Taylor 4 Burr. 2302, 2396, 98 Eng. Rep. 201, 251 (K.B. 1769).

[78] See *infra* Section (C)(1)(a).

work was being abstracted exactly into the obscure and unstable entity that Ingersoll was describing.

Justice Story and Justice McLean were the two main judicial heroes of this process of transforming American copyright law. In *Wheaton* McLean who wrote for the court avoided the issue by giving the question of literary works as property only a very brief and enigmatic treatment.[79] Story, probably the most prolific judge in the field of copyright during the first half of the century chose to remain silent and concurred with McLean's opinion.[80] George Ticknor Curtis, who wrote a complete treatise on copyright, could not choose any of these routes. Thus, his 1847 treatise is characterized by the tension which is typical of mid-nineteenth century copyright discourse. The introduction defends copyright's qualification as a natural property right on the ground that the object of the property right is a concrete combination of characters. The later chapters, however, construct a much broader, more abstract and instable concept of the intellectual work.[81] At the middle of the century it was exactly this tension that characterized American copyright thinking: a clinging to old concepts accompanied by a rising new framework that would soon take over.

2. Inventions and Books

When Wheaton's lawyers came to argue about perpetual common law copyright they were haunted by the comparison to patents for invention, just as their English predecessors were years earlier. Ingersoll's reference to patents in his argument was mainly on the formal legal level. Claiming that patents and copyrights were essentially identical he relied on an American precedent according to which the showing of patentee's failure to fulfill any of the statutory requirements constituted a defense in patent infringement

[79] WHEATON V. PETERS, at 99-100.

[80] It is quite possible that Story had other motivations for keeping silent. He had a personal relationship with both reporters and although at one stage he tried to arrange a compromise, when it came to the legal determination he tried to remain as distant as possible. Famously Story left Washington before the opinions were delivered. Wheaton later blamed him for fleeing the scene and leaving McLean to "fire off the blunderbuss he had loaded, but had no courage to discharge." See White, *supra* note 46, at 422-424.

[81] Curtis, *supra* note 31, chapter IX .

cases.[82] By way of analogy, he claimed, copyright should receive an identical treatment. Justice McLean, however, analyzed the copyright-patent analogy more elaborately and on a much more principled level. "In what respect does the right of author differ from that of an individual who has invented a most useful and valuable machine?"[83] he asked. The general labor justification for property promoted by plaintiff seemed to apply with equal force to both literary works and inventions. McLean created an identity between the figures of the author and the inventor: "The result of their labours may be equally beneficial to society, and in their respective spheres they may be alike distinguished for mental vigour."[84] In the abstract, this could have been an argument for perpetual property in patents- as indeed some already claimed in the United States. But patents for invention carried with them too much institutional baggage- long standing and hard to undermine practices- which made the argument of common law perpetual property in invention an unlikely one within serious legal discourse. At least within such discourse, it was undisputable that patents were limited term state created privileges. Turn of the century pamphleteers could speculate about perpetual property in inventions, but no eminent lawyer arguing in court, not even those who eloquently argued about copyright as a natural property right, even tried to raise such an argument. As McLean put it, referring to the inventor: "it has never been pretended that the latter could hold by the common law, any property in his invention, after he shall have sold it publicly."[85]

The patents for invention analogy pushed the proponents of common law copyright to a tight corner. Since the institutional weight of well established practices made it impossible to argue that there was perpetual property in the case of patents, the compelling analogy offered by the opponents of perpetual copyright had to be broken by somehow distinguishing inventions and literary works. The dissenting Justices made no effort to establish such a distinction. In fact both Thompson and Baldwin explicitly refused to address the question. "I do not deem it necessary particularly to inquire whether, as an abstract question, the same reasons do not exist for the protection of mechanical inventions as the productions of mental labour"[86] said Thompson. His reason was that "[t]he inquiry is not

[82] Ingersoll referred to Grant v. Raymond, 31 U.S. 218 (1832).

[83] WHEATON V. PETERS, at 99.

[84] *Id.*

[85] *Id.*, at 100.

[86] *Id.*, at 119.

whether it would have been wise to have recognised an exclusive right to mechanical inventions. It is enough, when we are inquiring what the law is, and not what it ought to have been, to find that no such principle ever has been recognised by any judicial decision."[87] This amounted to saying that copyright was recognized as perpetual property and patents were not, simply because these happened to be the relevant precedents. In reality, the English precedents were much more ambiguous than presented by the dissenters.[88] Nevertheless, their argument can be read as a retreat to the cover of legal technicalities and rigid stare-decisis where one ran out of substantive arguments.

More importantly the argument that the implausible divergence between copyright and patents was supported simply by the arbitrary fact that this happened to be the common law, stood in an inherent tension with the picture of common law as the embodiment of the principles of reason painted by the plaintiff's copyright as property argument. As explained, the perpetual copyright argument was entangled with a conception of the common law as the reflection of principles of reason and of the natural order of things. This grounding in reason and nature was the traditional source of the legitimacy of the common law and of its implied superiority over "arbitrary" statutory law. The common-law/statutory-law hierarchical distinction was an important part of plaintiff's argument which attempted to show not only that common law copyright existed but also that it was not preempted by the statutory scheme. The latter part of the argument relied heavily on the supposed superiority of common law and the accompanying interpretative presumption that statutes should be interpreted as to minimize their derogation of common law. As Paine put it:

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[87] *Id.* Baldwin took a similar position. See *id.* at 152.

[88] The majority in *Millar v. Taylor* did rule that common law copyright existed, but the ratio of the later *Donaldson v. Becket* which settled the question against post-Statute of Anne common law copyright was much more obscure. While the dissenters in *Wheaton* presented *Donaldson* as unequivocally premised on the ruling that common law copyright existed but was preempted by the statute, there was in fact a strong strand of argument in *Donaldson* according to which common law copyright never existed. It is impossible to say what was the "true" basis of the decision, since it was decided by a general vote in the House of Lords. See: *supra* chapter 2, note 258; Howard B. Abrams, *supra* note 38, at 1157-1164; MARK ROSE, AUTHORS AND OWNERS: THE INVENTION OF COPYRIGHT 103 (1993).

> "And it is apparent from the sedulous care which the law takes to preserve common law rights and remedies, and not permit them to be taken away by statute, unless the statute expressly takes them away by negative words, that it esteems them as more valuable and of a higher and better nature than statutory rights and remedies."[89]

The dissenters' position went against the thrust of this argument by depriving the common law of its inherently superior nature. Moreover, the traditional eighteenth century tendency for strict adherence to precedent was grounded not only in mere technicality but in the underlying assumption that the thing adhered to derived its vitality and legitimacy from the universal principles of reason it reflected. The dissenters' attempt to justify the different treatment of inventions created a dissonance. By admitting that the treatment of patents contradicted what they presented as the natural law of property they fell back on a traditional adherence to precedent without any of its underlying justificatory systems- neither the old one based on "reason" nor the newer one which relied on an instrumental discourse.

Paine arguing for plaintiff, maybe in awareness of these difficulties, did not simply rely on formal precedents. He strove to maintain the anchor of reason and natural law by creating a substantive distinction between patents and copyright, inventions and literary works. But how could the seemingly compelling analogy be dispelled? Paine started by conjuring up a series of sharp oppositions:

> "… the subjects of patented inventions, and copyrights have little analogy. They are so widely different that the one is property, the other a legalized monopoly. The one may be held and enjoyed without injury to others, the other cannot without great prejudice. The one is a natural right, the other in some measure against natural right."[90]

Property and monopoly, natural right and encroachment upon natural rights- the distinction could not have been sharper. The one is a "merely favoured monopoly… a grant from the state, partly from justice and partly from policy… but as no one has any right without the grant, they are granted as the

[89] WHEATON V. PETERS, at 34.

[90] *Id.*, at 24.

state thinks best."[91] The other is *'property*, which means that it is his own [the author's] like all other property."[92]

But what was the source of this fundamental difference that made the patent a state created limited grant and copyright a pre-political natural right? Paine had three intertwined arguments here, which may be called: the monopoly argument; the policy argument; and the justice argument. The monopoly argument stigmatized patents with all the traditional accusations against monopolies- concentration, price raise and insufficient supply- while exonerating copyright:

> "A single edition will supply the country as easily and cheaper several. Whereas suppose every machine, fabrication or compound, must perpetually emanate form the manufactory of the inventor. The public would be served very little to their mind. This would deserve the name of a monopoly. It was for these reasons of public inconvenience, that a property in inventions has always been stigmatized as a monopoly. But a perpetual copy-right, before the Statute of Anne was not deemed a monopoly. The reason was, it was not felt as such. It gave no public inconvenience. There was no public policy against it."[93]

This was dubious economics and questionable history, but it pinned the traditional claims against monopolies only on patents.

The policy argument was similar, but its focus shifted somewhat from the traditional ills of monopolies to a newer emerging concern with social utility and innovation. Perpetual patents were presented as a serious impediment to innovation, while copyright was again absolved by implication:

> "It would be most mischievous to the public to allow an exclusive right to exist to inventions without restraint and control… For it is obvious at a glance, that a perpetual right to an invention, and to exclude every one else from that ground, would be most mischievous and ruinous to

[91] *Id.*, at 25.

[92] *Id.*

[93] *Id.*, at 27.

> community. New inventions are continually covering almost the same ground as those preceding them. There must consequently be a continual conflict. The new invention is assailed as an infringement on the old one. And legal contests would be unceasing."[94]

This analysis that depicted patents as a barrier for further innovation by relying on a cumulative conception of technological development was accompanied by what a modern lawyer would recognize as the chilling effect argument. As Paine explained: "[p]atents obstruct the progress of invention, by suggesting constant doubts and difficulties, whether the same thing had not been before invented. In the same way they interrupt and check the free use of things, there being a doubt whether the thing is patented or not."[95] From a policy perspective, then, Paine depicted patents but not copyright as a cost on innovation due to both the exclusion of others from essential information and technology and the chilling effect of uncertainty.

Finally, the impediment for innovation argument had also a sub-strand that put the emphasis on justice and fairness rather than social utility. "Minds are all moving in a similar direction, and a discovery by one is what would soon have been made by others" Paine argued. Therefore it would be "unjust, to appropriate to one, what without him might be acquired by all."[96] Perpetual patents, but not copyright, the justice argument went, would deprive some of the benefit of what they would have independently created and hence would leave them worse off.[97]

But why not copyright? Indeed in all three strands of argument the attempt to distinguish and absolve copyright from the ills which are attributed

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[94] *Id.*, at 26.

[95] *Id.*, at 27.

[96] *Id.*, at 26.

[97] A famous modern version of this argument, which does not recognize a patent-copyright distinction, is Robert Nozick's philosophical analysis of patents. Nozick argued that patents are justified only as long as they do not leave anyone worse off relative to the situation in which the invention did not exist. Since, sooner or later, someone would have probably come up with a similar invention, in the absence of that of the patentee, his conclusion is that the patent should be limited in duration to the period which it is reasonable to assume that would have taken for a similar invention to appear. ROBERT NOZICK, ANARCHY, STATE AND UTOPIA 178-182 (1974).

to patents might seem extremely tenuous to the eyes of the modern reader. Paine, however, was relying on a conception of literary works and of their protection by copyright that made the description credible:

> "An invention is the work of a single thought. It is but giving form and body to a single idea. Consequently no one doubts that thousands might invent the same thing. How different are books… A paragraph even, to say nothing of a whole book, is so full of ideas, and they are so clothed in language, and both they and the words have such an arrangement, that chance or invention could not produce two alike."[98]

This was the same notion of the literary work as consisting in the exact language used by the author that animated Paine's argument about the suitability of such works to be an object of property. In this context, however, the depiction of the work as a concrete semi-material object was the premise that gave force to the various arguments for distinguishing patents and copyright. Locating the work on the level of the exact language, supported the justice argument because it made it plausible to argue that it was inconceivable that anyone could ever produce independently the exact same expression, while independent creation of the more abstract invention was quite conceivable. As for the monopoly argument, the narrow definition of the work limited the zone of control and immunity from competition enjoyed by the copyright owner and hence lessened the threat of concentration and price raise. Similarly, on the level of policy the impediment for innovation fear was removed by limiting the right to exclude others to the very specific and narrowly defined expression. The unique identity and super-individuality attributed to the work in Paine's description also solved the chilling effect problems by eliminating uncertainty. Thus Paine's attempt to break the patent-copyright analogy drew heavily on the same conception of the literary work that he used to address the issue of copyright as a natural property right.

One thing that should be noticed here is that the argument used to distinguish patents from copyright was not the one that became conventional in later times. It was not argued that copyright protection was weaker because unlike a patent it did not exclude independent creation of the same work, and hence should last longer (or in this case in perpetuity). This justification and

[98] WHEATON V. PETERS, at 27.

the legal distinction underlying it did not yet appear.[99] There was no legal rule in America according to which independent creation of the same invention or work constituted patent but not copyright infringement. Instead, what Paine was arguing through his employment of his narrow conception of the work was that in the case of literary works an independent creation was simply an impossibility. In this picture there was a law of nature or of probability according to which identical inventions could be created independently but not literary works. From this supposed different "nature" of the subject matter flowed all the policy and legal distinctions.

Paine's argument was a masterpiece, but it suffered from two fatal flaws. First, like in previous attempts of English jurists to distinguish patents and copyright, the argument was based on a covert double standard. Paine simply assumed definitions of the literary work and the invention that appealed to different levels of abstraction. From that starting point the rest followed. The literary work was defined on a very concrete level as the exact language used by the author. This "naturally" led to its super-individuality as

[99] The earliest unequivocal appearance of this argument of distinguishing patents and copyright I am aware of was in late 1830s England. Thomas Talfourd and his supporters in the campaign to extend the term of copyright protection defended against the analogy to patents by arguing that patents provided a stronger monopoly because they precluded independent creation, while copyright only prevented the copying of one's expression and did not prevent independent creation. See: CATHERINE SEVILLE, LITERARY COPYRIGHT REFORM IN EARLY VICTORIAN ENGLAND 12-13, 146-147 (1999). The author credits Talfourd and his supporters for understanding the true "nature of copyright." The point, however, is that what Talfourd was presenting as the obvious distinction between the "nature" of copyright and that of patents- an argument that later would appear in the United States- was in fact a recent construction of legal discourse. The distinction was unknown in the eighteen century. It was not clear at all during that time that a patent precluded independent creation and that copyright did not. The distinction consolidated probably during the first decades of the nineteenth century in England, and only in the second half of the century in the United States. See *infra*, text accompanying notes 338-339. Thus what was at issue was not the true "nature of copyright." Jurists were constructing and inventing this "nature" in legal discourse, almost at the same time they were using it to justify a change of the law toward longer copyright protection. Seville seems to commit the common modern error of taking part of the contingent framework with which copyright ended up as the "nature" that justified one outcome or another.

well as to the related policy and justice considerations. The invention, on the other hand, was presented as "the work of a single thought" or as "giving form and body to the same idea." In other words, it was conceptualized on a more abstract level as the general "idea" that could be manifested in different particular material forms. From this different conception flowed different policy and justice implications. Yet there was nothing, of course, that made this divergence in the level of abstraction "natural" or "real." The literary work could be characterized in a more abstract fashion, just as the invention could be defined in narrow and concrete terms as a particular material design- the equivalent of the literary work's "expression." Shifting the levels of abstraction of the two subject matters as to produce the wanted outcomes was a brilliant rhetorical tactic, but a problematic one nonetheless.

The second problem of the patent-copyright distinction was the one already mentioned. Much of the weight of the arguments rested on the conception of the literary work as the exact language used by the author. Yet copyright law was in the midst of a process of expanding and abstracting the coverage of the protected work. Legal doctrine was beginning to shift toward protecting the "value" of the original work which covered an increasing terrain well beyond verbatim reproduction. This entailed a growingly abstract conception of the protected work as an entity which was broader than any set of particular characters. At the very same time that Paine was relying on the concreteness of the literary work to distinguish copyright form patents, it was acquiring an increasingly abstract character within legal doctrine.

Although it received only a partial treatment in *Wheaton v. Peters* the patent analogy continued to haunt those who tried to justify a different legal treatment to copyright. More importantly, while arguments about natural pre-political rights continued to float around in the context of both copyright and patents, the deeply entrenched and hard to challenge concept of the latter as state created entitlements formed an opposite center of gravity. It contributed to the persistence of a strong positivist strand at the heart of the justification and conceptualization of intellectual property.

3. The Public and the Private

The question for which *Wheatons v. Peters* is best remembered in the modern lore of copyright law- whether law reports are a proper subject matter of copyright protection- received a one sentence treatment by the court. "[T]he court are unanimously of the opinion, that no reporter has, or can have any copy-right, in the written opinions delivered by this court; and that the

judges thereof cannot confer on any reporter such right" wrote McLean, almost as an afterthought at the end of his opinion. Although this was the only issue on which the court could agree the legal rule announced was quite vague. Two years later in his *Commentaries on Equity Jurisprudence* Story had to explain that what the court actually meant was that while there could be no copyright in the opinions of the court "it was as little doubted by the court that Mr. Wheaton had a copyright in his own marginal notes, and in the argument of counsel as prepared and arranged in his work."[100] In the arguments of counsel, however, the question of judicial opinions as copyrightable subject matter received a more elaborate treatment. The two parties supplied mirror descriptions of such texts as constituting either the absolute private or the absolute public. What emerged was a new sharp deployment of a public/private distinction within copyright law, but also intriguing and at times innovative conceptualizations of each of the poles of this dichotomy.

At the early stages of the conflict when Peters was answering complaints from earlier reporters and reassuring threatened booksellers, he made a significant appeal to the republican themes of the wide dissemination of knowledge and of the centrality to the polity of a citizenry well informed of public matters. His condensed reports, he explained "placed the decisions of the Supreme Court within the power of very many who could not purchase the works of Mr. Dallas, Mr. Cranch and Mr. Wheaton."[101] This "will diffuse the knowledge of the decisions of that high court and of those of the circuit courts, and will thus strengthen and secure the foundations of the federal judiciary."[102]

In the argument at trial this appeal to republican values with its emphasis on a component of the republic which was especially close to the heart of the judges- the federal judiciary system- was clothed in legal terms. The theme of the free circulation of civic-knowledge was fused with arguments about the public and the private and about property. Ingersoll

[100] Story explained that the court's final ruling to send the case back to the Circuit Court in order to determine as a matter of fact whether Wheaton complied with all the statutory prerequisites would have made little sense had there been no copyrightable subject matter in Wheaton's reports. Story, *supra* note 29, at .247-248.

[101] WHEATON V. PETERS, at 12.

[102] *Id.*

created a complete identification between law reports and the dissemination of the law:

> "Reports are the means by which judicial determinations are disseminated, or rather they constitute the very dissemination itself… The matter which they disseminate is, without a figure, the *law of the land*."[103]

The presentation of law reports as a pure circulation of the law was accompanied by an appeal the unquestionable principle of broad dissemination of the laws as a fundamental of any enlightened government. "It is therefore the true policy, influenced by the essential spirit of the government," said Ingersoll, "that laws of every description should be universally diffused."[104] Private property or individual control of any sort was portrayed as the antithesis of such universal diffusion, raising the specter of a state of affairs in which it is "at the power of an individual to shut the light by which we guide our action."[105] The conclusion flowing from adopting these premises was inevitable: "the law cannot and ought not to be made the prisoner or the slave of any individual" and hence "no man can be the exclusive proprietor of the decisions of courts."[106] This classified law reports as the ultimate public. Moreover, this public sphere was described as a zone protected from private ownership- that which could never be subjected to private entitlements and control, or in the words of Ingersoll: "That which is public cannot in its nature be made private, but not *e contra*."[107]

In a diametrically opposed maneuver Paine presented law reports as the ultimate case of private property. In his description judicial opinions were just another species of texts that like any other texts were the private property of their authors. "Were not the opinions of the judges their own to give away?" he asked; "are opinions matters of record as Mr. Peters pretends?

[103] *Id.*, at 74.

[104] *Id.*, at 75.

[105] *Id.*, at 78.

[106] *Id.*, at 76.

[107] *Id.*, at 78. Ingersoll made this remark when he argued that even if the first reporter mixed elements that could be proper subject matter of copyright with materials which were essentially public, he could still have no copyright in the whole and that his actions "upon familiar principles" forfeited his rights in the copyrightable materials, at least inasmuch as what was copied was the entire mix.

Was such a thing ever heard of?"[108] In this narrative the opinions were the judges' property which was transferred as a "gift" to the reporter. The private, was presented here as that which could not be turned into public, no matter how socially beneficial such a move seemed. Thus Paine asked rhetorically "is one to be divested of property, is a common rule of law to be overthrown, because the imagination of man can devise a danger which may arise, no matter how improbable?"[109]

The plaintiff's interpretation of the constitutional clause had the same thrust of excluding any "public" considerations from the field of copyright:

> "…they could have no intention but to secure the author's right, and that so far as the rights or interests of the public are concerned, the convention had no motive, and could have had none, for attending to them on this subject."[110]

Under this reading the public/private distinction was conceived of as contiguous with the distinction between securing and regulating:

> "What is the power of Congress over copy-rights? To secure. What is the power *claimed*? To regulate. For if Congress can go an inch beyond securing they can regulate entirely."[111]

As a constitutional matter, the argument went, Congress' only role was to safeguard or "secure" the private preexisting rights of authors in their writings. It could not turn to public considerations and "regulate" the right. The conclusion was that any attempt to "impair the author's property" or to "regulate" it, such as the statutory notice and deposit requirements, were unconstitutional and void.[112] Safeguarding a supposed pre-political right on the constitutional level and divesting Congress of any power to "impair" it was the most extreme version of the common law copyright argument. It was not even addressed in the opinions of the court. Yet it demonstrated the logic of the public/private distinction. Under this mode of thinking, that which was "private" was altogether beyond the interference power of the state.

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[108] *Id.*, at 71.

[109] *Id.*

[110] *Id.*, at 47.

[111] *Id.*, at 46.

[112] *Id.*, at 78.

The casting of the competing arguments of the parties in the terms of a public/private classification is not surprising. The public/private distinction started appearing in American legal consciousness at the early part of the century[113] and it gradually grew in significance and in sharpness. Yet, the particular way in which the classification was elaborated and deployed in the context of copyright in *Wheaton* is intriguing. Traditionally copyright law lacked any sharp public/private divide. This was true not only on the level of general justifications, which often mingled arguments about private rights with considerations of general social welfare, but also on the level of doctrinal details. The 1790 Act, for example, with its many formalities, prerequisites and peculiar remedy embodied much of copyright's traditional character as a blend of state regulation and a private entitlement. The argument of plaintiff about copyright as private property tried to move the entire field of copyright from this undifferentiated state into a sharply defined private sphere. Indeed, Paine went so far as to argue that to the extent that the statutory arrangement was incompatible with the private character of the right it was void.

At one point in the defendant's argument it seemed for a fleeting moment that Ingersoll was about to undertake the opposite task of classifying the entire field of copyright as a public one. After describing the specter of individual control over the public dissemination of information he added: "[t]hese are evils incident to every publication which can be secured by copyright."[114] But he quickly withdrew by asserting that "[m]ere individual works, whether literary or religious, the authors can undoubtedly thus control."[115] During the limited time awarded by the statute under the constitution these evils had "no remedy." In law reports, however, that were depicted as more than "mere individual works" copyright could not consist at all. This divided the possible subject matter of copyright. A certain zone or certain materials were carved out as the absolute public, where individual control could not be suffered at all. The bulk of the field was left, however, not as a purely private sphere, but rather as the murky terrain it always was, where the public and

[113] The 1819 case of Dartmouth College v. Woodward, 17 U.S. 518 (1819) is usually pointed at as a significant land mark in this context- the first major appearance of the public/private distinction in American law. See Horwitz *supra* note 59, at 10-11. On the public/private distinction in general see: Morton J. Horwitz, *The History of the Public/Private Distinction*, 130 U. Pa. L. Rev. 1423 (1982).

[114] WHEATON V. PETERS, at 76.

[115] *Id.*

the private mingled in an uneasy coexistence. Ingersoll never explained why what he was describing as "evils" had "no remedy" in that zone.

When Ingersoll came to describe the purely public zone he fenced out, his description was exceptional in terms of both American jurisprudence and the English copyright tradition. Under the emerging public/private distinction in American jurisprudence the two poles of the dichotomy were usually conceptualized as the equivalent of private autonomy and state power. In this picture, the private sphere was governed purely by the free will of private individuals. Government had no role in that sphere but securing the rights of such individuals. The public sphere, on the other hand was that of total governmental power and discretion to regulate in the name of the public good.[116] The characterization of the public in plaintiff's argument differed markedly from this structure. Instead of presenting the public sphere as one of absolute governmental power and discretion, Ingersoll described it as immune from both individual control and state regulation. Referring to law reports, he explained: "the entrance to the great temple itself, and the highway that leads to it, cannot be shut without tyranny and oppression. It is not in the power of any department of government to obstruct it."[117] And as he explained earlier: "[t]o fetter or restrain their dissemination, must be to counteract this policy. To limit, or even to regulate it, would, in fact, produce the same effect. Nothing can be done, consistently with our free institutions, except to encourage and promote it."[118] Ingersoll defined the public sphere of intellectual materials as that which had to stay free as the air and open to the public at large. Rather than an area of an increased governmental control it was a zone that government had no power to regulate.

Ingersoll was replicating the image of private property as that which government could only secure and not regulate. He shifted, however, the subject enjoying the right from a particular individual to the public at large. In this respect, it is significant that he referred repeatedly to law reports as "public property." This appropriated many of the connotations of "private

[116] Duncan Kennedy described the sharper consciousness of this kind that appeared at the late nineteenth century as based on the notion of powers absolute within their spheres. See DUNCAN KENNEDY, THE RISE AND FALL OF CLASSICAL LEGAL THOUGHT 215 (1975) [an unpublished manuscript]. During the early part of the century this mode of legal thinking was only beginning to emerge.

[117] WHEATON V. PETERS, at 77.

[118] *Id.*, at 75.

property" as immune to governmental regulation while completely shifting the thrust of the argument. The argument constructed an alternative strand of though about the public in the context of copyright, that was very different from the more common conception of the public as a sphere of absolute state power. The public sphere was presented as consisting of those materials which were the object of neither private control nor state regulation, but rather had to remain under conditions of unfettered public access. While not displacing the more common conception of the public, this alternative presentation was to survive as an important available trope in copyright discourse.

The description of a special category of public-character materials as immune to state regulation was also a break with the English copyright tradition which was the main frame of reference of American lawyers at the time. During the seventeenth and eighteenth centuries English law developed its own category of materials with special connection to the state or to the public. This category grew out of the legal conflicts over the printing patent and the gradual circumscription of the royal prerogative to issue such patents. By the eighteenth century this power was limited to narrow categories of materials defined as publications of an inherent public or state-related nature, such as law books, almanacs and bibles.[119] Since the focus of this doctrine was the royal prerogative power, it did not directly map onto the American context and by 1834 it probably had no practical significance in England.[120] Nevertheless the relevance of the general structure implied in the doctrine is obvious. The traditional English rule which specified certain subject matter as being of special public importance constructed this sphere as one where government had amplified power and discretion to regulate in the name of the public good. From this perspective the supposed special character of bibles and law books entailed special powers to government to regulate and control them in terms of both content and economic privileges. This was the opposite of plaintiff's argument in *Wheaton* which presented law reports as a zone immune to governmental restriction and control. Ingersoll was breaking away from an English tradition which presented the public sphere of literary works as one of increased governmental regulation. He replaced it with a new notion of this sphere as the realm of unfettered public access.

The arguments in *Wheaton v. Peters* about the public and the private had an ambivalent character. On the one hand they were part of the general

[119] For a general survey of the gradual circumscription of the prerogative power in the field of printing patents see: *supra* chapter 2, Sec. I(B)(1).

[120] Ingersoll argued in this spirit. See WHEATON V. PETERS, at 77-78.

move in American legal consciousness toward thinking in the categories of a public/private distinction. On the other hand, they introduced into copyright discourse a new mode of conceptualizing the public which differed from both the English copyright tradition and from the emerging general categories of American jurisprudence. Copyright law never fully internalized a sharp public/distinction but the various tropes offered by the parties in *Wheaton* were to be recurring ones in future copyright discourse.

C. The Transformation of Copyright

1. Constructing the Work

The 1790 Copyright Act had no definition of the protected "work." Neither did it employ the term or the concept of the work in its modern sense. The Act referred to maps, charts and books and defined the exclusive entitlement conferred by copyright as "the sole right and liberty of printing, reprinting, publishing and vending" such charts, maps and books.[121] This was the traditional trade privilege of the publisher to exclusively print and sell a "copy." Although struggles and strategies to expand the coverage of the entitlement and to prevent "evasion" by minor-variation reproductions existed since the early days of the Stationers' Company, at the heart of this traditional understanding of copyright stood the idea of verbatim reproduction. The focal meaning of having the "sole benefit" of the "copy" was the right of excluding others from making verbatim reproductions of it.

During the first part of the nineteenth century American judges created a fundamental reinterpretation of this concept of copyright- a project that was only just beginning in the English precedents they inherited. Copyright was gradually re-conceptualized in more abstract terms as protecting the market value of an intellectual work. This entailed a gradual expansion of copyright protection, labeling more and more actions increasingly remote from the focal case of verbatim reproduction as infringement. Implicit in this process was emerging the concept of the protected "work" which is fundamental to modern copyright law. This new concept gradually grew abstract and unstable. It constantly moved the practice of copyright protection away from its rhetorically dominant representation: the assertion that the object of property was a concrete combination of signs or the particular "expression" of the protected work.

[121] 1790 Copyright Act §1.

a. The Work as Value and Bad Intentions

The traditional understanding of copyright as an exclusive privilege of verbatim reproduction had always been under pressure for increased coverage and control and for avoiding frustration of the right by reproduction with minor changes. In the days of the stationers' copyright such pressures were handled by the ad-hoc decisions and compromises of the Company's organs. After the Statute of Anne, however, it fell to common law judges to craft legal doctrine in order to elaborate such concepts as infringement or the protected work and accommodate both the pressure for increased protection and the traditional understanding of copyright as limited in scope. Eighteenth century English judges performed this task by drawing narrow boundaries to the protected work and by providing a rather strict definition of infringement. The basic rule that dominated the case law was that protection went beyond verbatim reproduction. This was necessary in order to avoid emptying copyright of any real significance. Yet this additional sphere of protection was very narrow. Any subsequent use or non-verbatim reproduction of the work was deemed infringing only if the changes made were only "colourable" ones constituting a "mere evasion" of copyright protection.[122] This rule left, of course, areas of ambiguity and of case specific discretion, but its main thrust was clear. It remained rooted in the traditional concept of copyright as the right to print a copy and limited the scope of copyright protection to a zone only slightly broader than verbatim reproduction.

This general rule incorporated two intertwined strands of conceptualizing infringement. First, the question was framed in terms of whether the allegedly infringing work was identical to the protected one.[123] While under the rule that prohibited colorable changes, the identity required was not a perfect one, many derivative works which were based on the original and even drew heavily on it were not considered identical to it. Such

[122] Gyles v. Wilcox, 2 Atk. 141, 143, 26 Eng. Rep. 489, 490 (Ch. 1740). See also: Tonson v. Walker, 3 Swans. 671, 678-679, 36 Eng. Rep.1017, 1019-1020 (Ch. 1752); Sayre v. Moore, 1 East 361, 102 Eng. Rep 139, 140 (K.B. 1785); Cary v. Kearsley, 4 Esp. 168, 170-171, 170 Eng Rep. 679, 680 (K.B. 1802).

[123] See for example: *Gyles v. Wilcox* where Lord Chancellor Hardwicke framed the question as: "Whether this book… which the defendant has published, is the same with Sir Mathew Hale's Histor. Placit. Coronce, the copy of which is now the property of plaintiff." 2 Atk. 143, 26 Eng. Rep. 490.

works were considered new and original rather than mere copies and consequently they were not deemed infringing. This included a whole variety of derivative uses including translations, abridgments, works improved by corrections and commentaries and the indicative category of the good faith imitation. As long as the changes in the subsequent work were not deemed merely "evasive" it was outside the scope of the copyright prohibition. As Justice Willes put it in *Millar v. Taylor*: "Certainly bona fide imitations, translations and abridgments are different, and in respect of the property may be considered new works: but colourable and fraudulent variations will not do."[124]

As the citation indicates the strict requirement of close identity was interwoven with a second strand of thought that tended to conceptualize infringement in intentionalist terms. There was no unequivocal formal rule that required proving of intention in every infringement action, but the framing of the critical question in terms of "evading" copyright contrasted with "bona fide" derivative works tilted the doctrine in the direction of considering the defendant's intentions. A work was deemed infringing only inasmuch as its differences from the original one were such that it was reasonable to assume that they were introduced simply for the purpose of evading the prohibition on reproduction. Lord Ellenborough expressed this tendency in dictum in the 1802 *Cary v. Kearsley* where he explained the fundamental inquiry in cases of alleged infringement:

> "whether the publication… was to convey to the public the notes and observation fairly, or only to colour the publication of the original essay, and make that a pretext for pirating it… a man may fairly adopt part of the work of another: he may so make use of another's labours for the promotion of science, and the benefit of the public: but having done so, the question will be, Was the matter so taken used fairly with that view, and without what I may term the *animus furandi*?"[125]

In his 1844 treatise, which in many respects already reflected the changing character of copyright, the English commentator Godson still cited this rule and talked about "*animus furandi.*"[126] Ellenborough used the language of

[124] 4 Burr. 2310, 98 Eng. Rep. 205.

[125] 4 Esp. 170, 170 Eng Rep. 680.

[126] RICHARD GODSON, A PRACTICAL TREATISE ON THE LAW OF PATENTS FOR INVENTIONS AND COPYRIGHT 477 (2nd ed., 1844).

"fairly adopting" parts of the work of another." However, this formulation was fundamentally different from what is known today as the fair use doctrine, which was soon to be developed in the United States. While the latter appropriated some of the lingual formulas, as we shall soon see, it involved a fundamental transformation of this early English approach and of the concept of copyright implicit in it.

Practical pressures to expand the scope of copyright protection existed in the United-States right from the inception of the federal regime. As mentioned, Jedidiah Morse in one of the earliest copyright petitions to Congress asked for a specific legislative protection of his work that "might be so expressed as effectually to secure the Petitioner, against all mutilations, alterations and abridgments… as may operate to his injury."[127] The drafters of the 1802 amendment to the Copyright Act, which added protection of prints, were apparently cognizant of the problem of evasion and of the practical pressure for broader protection. The amendment explicitly prohibited copying prints "in the whole or in part, by varying, adding to, or diminishing from the main design."[128] Nevertheless the bulk of the task of elaborating the scope of copyright protection as well as related legal concepts such as infringement, copying and the work was left to the courts. When American courts started this undertaking in the 1830s the English precedents, which constituted their main frame of reference, were already in a process of transformation. The eighteenth century rules and the concepts embedded in them were not explicitly overruled, but new strands of legal thought which gradually changed the attitudes employed and expanded the scope of the protected work started to appear.[129] American jurists caught on such new strands of cases and expanded the scope of copyright protection further and further beyond verbatim reproduction. Legal doctrine developed a model of the protected work which was focused on the market value of the literary work and soon started to take seriously Morse's 1790 notion that any subsequent derivative use that may "operate to the injury" of the owner constituted copyright infringement.

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[127] 4 LEGISLATIVE HISTORIES, *supra* note 3, at 511.

[128] 1802 Act, §3.

[129] For a survey of this new line of cases see: BENJAMIN KAPLAN, AN UNHURRIED VIEW OF COPYRIGHT 18-21 (1967). Some of the more significant English cases of this new kind were: Trusler v. Murray, 1 East 362, 102 Eng. Rep.. 140 (K.B. 1789); Longman v. Winchester, 16 Ves. Jun. 269, 33 Eng. Rep. 987 (Ch. 1809); Bramwell v. Halcomb, 2 My. & Cr. 737, 40 Eng. Rep. 1110 (Ch. 1836).

The two eminent re-shapers of American copyright law during the first half of the century were Justice Story from the bench and George Ticknor Curtis as the writer of the only American copyright treatise. Curtis, who supplied the most thorough discussion of copyright law in the United States, started his discussion of infringement with a familiar theme: the need for a balance between the private rights of the author and the public policy and the "interests of knowledge" which demand "a reasonable freedom in the use of all antecedent literature."[130] This starting point was in line with the old English precedents which assured that since the exclusive entitlement of copyright was limited to reprinting of the protected book all "knowledge" remained free for subsequent use.[131] But Curtis immediately started breaking away from this tradition. When a paragraph later he came to define the desired balance, he appealed to a concept of the author's exclusive right which was based not on the notion of reprinting but rather on that of the market value or the profits of the work:

> "… while the public enjoys of reading the intellectual contents of the book to the author belongs the exclusive right to take all the profits of publication which the book can, in any form, produce."[132]

The conceptual shift from the traditional trade privilege to reprint to the more abstract exclusive right to the entire value of the work "in any form" had radical implications. It entailed a revision of the two strands of the older English precedents: the intentionalist conception of infringement; and the broad tolerance and even encouragement of derivative uses. For Curtis the

[130] Curtis, *supra* note 31, at 237.

[131] One of the most eloquent assertion of this kind was made by Justice Willes in *Milar v. Taylor*: "… all the knowledge that can be acquired from a contents of a book, is free for every man's use: if it teaches mathematics, physic, husbandry; if it teaches to write in verse or prose; if, reading an epic poem, a man learns to make epic poems of his own; he is at liberty… But printing is a trade or manufacture. The type and press are the mechanical instruments: the literary composition is as the material; which always is property. The book conveys knowledge, instruction, or entertainment: but multiplying copies in print is quite distinct thing from all the book communicates. And there is no incongruity to reserve that right; and yet convey the free use of all the book teaches." 4 Burr. 2331, 98 Eng Rep. 216.

[132] Curtis, *supra* note 31, at 237-238.

first inevitable result of the value oriented definition of copyright was the purging of any traces of intentionalism in the relevant legal doctrines:

> "… the question of intention does not enter directly into the determinatio n of the question of piracy. The exclusive privilege that the law secures to authors, may be equally violated, whether the work complained of was written with or without the *animus furandi*- the intention to take what belongs to another, and thereby to do an injury."[133]

In a conceptual scheme based on the notion of reprinting, under which the main question was whether the variations of a subsequent work were merely "evasive" of the verbatim reproduction prohibition, it made perfect sense to inquire about intentions. Under the new scheme, whose focus came to be the market value of the protected work, it was only "natural" that the intentions of the subsequent user became irrelevant. For Curtis "[t]o decide the question of piracy upon the motives of the party cha rged with the infringement, would reduce the exclusive right secured to authors by the law to a much lower scale of value and efficiency than the law intends to give it."[134] Thus, he rebuked the English treatise writer Godson for still adhering to the *animus furandi* rule in the context of quotations: "If an injury is caused there is no occasion to prove the intention… If part of one author's book is found in that of another, the question will be, what effect is it to have? Not whether it was taken with bad intent."[135] For Curtis the only meaningful question came to be the effect on the market value of the original work.

b. The Irony of Fair Use

An even more important implication of the new focus on market value was a series of changes in the treatment of derivative uses and the appearance of a newly defined fair use rule. When Curtis was writing in 1847 he already could draw on a group of a few important American cases in which Justice Story initiated these changes. Story did not overrule any of the English precedents. Instead he was drawing on the new strand of decisions in the English case law and masterfully using the formulas of the old ones while pouring new content into them. In his *Commentaries on Equity*

[133] *Id.*, at 238.

[134] *Id.*, at 238-239.

[135] *Id.*, at 252 footnote 3.

Jurisprudence Story repeated the English rule that "bona fide quotations… or bona fide abridgment… or to make bona fide use of the same common materials in the composition of another work" were not an infringement, but observed that what constituted a bona fide use of this kind was "often a matter of most embarrassing inquiry."[136] The distinction between a "fair exercise of a mental operation deserving the character of a new work" and a "mere colorable curtailment of the original work, and a fraudulent evasion" he found to be "another mode of stating the difficulty, rather than a test affording a clear criterion."[137]

The 1839 *Gray v. Russell*[138] afforded the first opportunity to start reshaping these categories. Story explained that "[a]lthough the doctrine is often laid down in the books, that an abridgment is not a piracy of the original copyright; yet this proposition must be received with many qualifications."[139] He repeated the traditional rules with subtle changes. In the case of extracts the question was "whether those extracts were designed bona fide for the mere purpose of criticism, or were designed to supersede the original work under the pretence of a review, by giving its substance in a fugitive form."[140] As for abridgments: "The question, in such a case, must be compounded of various considerations; whether it be a bona fide abridgment, or only an evasion by the omission of some unimportant parts; whether it will, in its present form, prejudice or supersede the original work; whether it will be adapted to the same class of readers; and many other considerations of the same sort, which may enter as elements, in ascertaining, whether there has been a piracy, or not."[141] This was more than just elaborating the conventional formulas. Story was subtly, almost unnoticeably, moving these formulas away from the inquiry of whether subsequent changes were merely a disguised attempt of verbatim reproduction. The shift was toward a broader concept of the protected work. Underlying this shift was the new focus on market value as was hinted by the repetitive references to "superseding" and "prejudicing" the original work. It became even clearer when Story seized upon a recent English case- *Bramwell v. Halcomb*[142]- in order to assert that

[136] Story, *supra* note 29, at 242

[137] *Id.*

[138] 10 F. Cas. 1035 (No. 5,728) (C.C.D. Mass. 1839).

[139] *Id.*, at 1038.

[140] *Id.*

[141] *Id.*

[142] 2 My. & Cr. 737, 40 Eng. Rep. 1110 (Ch. 1836).

"[i]n many cases, the question may naturally turn upon the point, not so much of the quantity, as of the value of the selected materials."[143] "It is not only quantity, but value, which is looked to,"[144] he explained, citing the English case. The market value of the work was looming up as the new gravitational center of copyright protection and in the process it was expanding the boundaries of the work.

In the 1841 *Folsom v. Marsh*[145] Justice Story built on the foundations he laid in *Gray* and introduced to American copyright law what came to be known as the fair use doctrine. There is a profound irony in the history of the fair use doctrine, which is often lost upon modern observers.[146] Fair use is considered, and it is often celebrated, as the main doctrinal tool which mitigates copyright protection and thereby assists in achieving the proper balance between exclusion and access. At the time, however, the introduction of the fair use rule meant a substantial expansion of copyright protection and a narrowing scope of legitimate derivative uses. It is easy to understand this, once one is reminded that the baseline, prior to the development of the rule, was a wide freedom for all derivative uses with the exception of only a narrow penumbra of subsequent works conceived of as the equivalent of verbatim reproduction. Under the very different baseline of modern copyright fair use is a protection-mitigating factor- otherwise infringing actions are allowed if they constitute fair use. In the 1840s, however, fair use was the main vehicle for expanding protection- previously non-infringing actions (such as abridgments) now became infringements unless they were "fair."

Like *Wheaton v. Peters*, the *Folsom* case involved many personal connections between the protagonists. At issue was a publication by Charles W. Upham "in which Washington is made mainly to tell the story of his own life, by inserting therein his letters and his messages, and other written documents."[147] The publication made extensive use of the letters of Washington previously published in eleven volumes together with his biography. The original heir of George Washington's letters was his nephew the Supreme Court Justice Bushrod Washington. Jared Sparks, the compiler

[143] 10 F. Cas. 1038.

[144] *Id.*, at 1039.

[145] 9 F. Cas. 342 (C.C.D. Mass. 1841).

[146] See for example: Lloyd L. Weinreb, *Fair Use and How It Got That Way*, 45 J. Copyright Soc. 634 (1998).

[147] 9 F. Cas. 345.

of Washington's papers and the writer of the published biography, acquired the letters together with Chief Justice John Marshall, who was deceased by the time of the decision. Once again the legal conflict which Story had to decide was very close to home. According to Story "the real hinge of the whole controversy, and involves the entire merits of the suit"[148] was whether the subsequent use of the letters was a new work in its own right that only abridged and selected materials from the original work, as it was allowed to do according to the English precedents.

Story started with his famous observation that "[p]atents and copyrights approach, nearer than any other class of cases belonging to forensic discussions, to what may be called the metaphysics of the law, where the distinctions are, or at least may be, very subtile and refined, and, sometimes, almost evanescent."[149] The exact scope of copyright protection had always been an elusive issue, but the "metaphysical" nature of the inquiry forcefully came to the surface only once judges started expanding protection beyond verbatim or evasive near-verbatim reproduction. As elusive as it was the traditional notion of the right to reprint a "copy" supplied relatively fixed boundaries to copyright. Story made it clear that he was expanding protection beyond those boundaries and that it was in that expanded zone that the metaphysical questions arose:

> "So, in cases of copyright, it is often exceedingly obvious, that the whole substance of one work has been copied from another, with slight omissions and formal differences only, which can be treated in no other way than as studied evasions; whereas, in other cases, the identity of the two works in substance, and the question of piracy, often depend upon a nice balance of the comparative use made in one of the materials of the other; the nature, extent, and value of the materials thus used; the objects of each work; and the degree to which each writer may be fairly presumed to have resorted to the same common sources of information, or to have exercised the same common diligence in the selection and arrangement of the materials."[150]

[148] *Id.*, at 347.

[149] *Id.*, at 344.

[150] *Id.*

Story was obviously concerned with the new terrain in which "the question of piracy" depended upon "a nice balance" rather than with the traditional rule that was focused on verbatim reproduction "with slight omissions and formal differences." Opening up this new terrain rendered the relatively clear and stable traditional rules allowing derivative uses unclear and unstable. Thus, Story appealed to the rules that "a reviewer may fairly cite largely from the original work, if his design be really and truly to use the passages for the purposes of fair and reasonable criticism;"[151] and that "a fair and bona fide abridgment of an original work, is not a piracy."[152] Yet he immediately destabilized these rules: "[b]ut, then, what constitutes a fair and bona fide abridgment, in the sense of the law, is one of the most difficult points, under particular circumstances, which can well arise for judicial discussion."[153]

When defining the new fair use rule Story appealed to a list of specific considerations that were later canonized as the fair use factors: the nature, extent, and value of the materials thus used; the objects and character of the original and the derivative work; and the effect on the market of the original work. All factors, however, were defined in a way that put the emphasis on the last one: the effect on the market value of the original work. Story made it clear that the entire issue depended not on the traditional inquiry of evasive verbatim reproduction but on the new center of gravity for protection- market value:

> "It is certainly not necessary, to constitute an invasion of copyright, that the whole of a work should be copied, or even a large portion of it, in form or in substance. If so much is taken, that the value of the original is sensibly diminished, or the labors of the original author are substantially to an injurious extent appropriated by another, that is sufficient, in point of law, to constitute a piracy pro tanto. The entirety of the copyright is the property of the author; and it is no defence, that another person has appropriated a part, and not the whole, of any property."[154]

[151] *Id.*

[152] *Id.*, at 345.

[153] *Id.*

[154] *Id.*, at 348.

When describing the specific factors, Story kept going back to the issue of market value as the focus of protection. In the context of the character of the materials taken he appealed again to the English precedent of *Bramwell*, recently introduced by him to American law in *Gray*, according to which "[i]t is not only quantity, but value, that is always looked to… we must often, in deciding questions of this sort, look to the nature and objects of the selections made, the quantity and value of the materials used, and the degree in which the use may prejudice the sale, or diminish the profits, or supersede the objects, of the original work."[155] As to the character of the original and the derivative works, he observed that "[m]uch must, in such cases, depend upon the nature of the new work, the value and extent of the copies, and the degree in which the original authors may be injured thereby."[156] Thus the value of the original work, diminishing profits from its sale, and superseding its market position by creating substitutes; constituted the focus of the newly invented fair use rule. This conceptual shift of emphasis from verbatim reproduction to market value entailed an expansion of protection and a destabilization of the traditional rules which sheltered derivative uses.

c. Abridging the Abridgment Rule

The new fair use doctrine did not eliminate with one fell swoop the older rules that categorically allowed various derivative uses such as abridgments, translations and improvements. Yet as the new interpretation of copyright as protection of market value diffused into legal consciousness these rules gradually eroded and fell one by one, until by the last quarter of the century a completely new structure of the scope of copyright protection was in place. The transformation of the English rule that allowed bona fide abridgments is only one example, but it probably reflects best the logic of this process undergone by many of the specific categories of allowed derivative uses. Under the eighteenth century concept of copyright the abridgment was a prominent example of a derivative work which was conceived of as not infringing the copyright entitlement and as worthy of its own protection. The "true" abridgment which reflected more than an attempt to evade the prohibition of verbatim reproduction did not encroach on the exclusive right for printing a copy. Moreover, such an abridgment was understood to be a new original work in its own right embodying both public utility and individual merit and labor on the part of the abridger. Under the new

[155] *Id.*, at 348.

[156] *Id.*, at 349.

interpretation of copyright, however, the abridgment became the epitome of infringement. An abridgment was, almost by definition,[157] an encroachment on the market value of a work. Its entire purpose, at least for some potential buyers, was to forgo the need to read and hence to purchase the original. In a new conceptual world in which the essence of copyright became the protection of the market value of the work, the abridgment rule had to go.

George Curtis based his discussion of infringement on a market value conception of copyright. Hence it was obvious to him that the public policy which admits "some uses of antecedents literature... will not sanction direct and palpable injuries to the author in whom the law invested the sole right to take the profits of his own book and every part of it."[158] The "most material inquiry" in each case came to be "whether the author has sustained or is likely to sustain an injury by the publication of which he complains."[159] The next logical step was to subject all the rules allowing derivative uses to the no-injury criterion:

> "I am not aware of any recorded decision, or of any principle of law, which would deny redress to an author who should prove a direct injury, upon the ground that the writer who had caused it had made a justifiable use of his work. It is easy to imagine cases, where the use which a subsequent writer makes of a previous publication is apparently within the limits of the general right of selection, or citation or tacit adoption; but if an injury can be proved to be the effect, I know of no law, by which, consistently with the strict right of the previous author, such use can be pronounced to be admissible."[160]

By excluding any derivative use "injurious" to the copyright owner, with only the exception of de minimis damage, Curtis overstated the case beyond

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[157] "Almost by definition" because there was always the argument that it was possible that a particular abridgment did not decrease or even increased the sale of the original work. Curtis thought that such an argument should not be allowed to be heard just like the defendant who produced verbatim copies was not allowed to argue that as a matter of fact his actions did not decrease the sales of authorized copies. See, Curtis, *supra* note 31, at 276-277.

[158] *Id.*, at 240.

[159] *Id.*

[160] *Id.*, at 241.

Story's or future authoritative elaborations of the fair use doctrine.[161] But he captured the general trend of the transformation of copyright.

This starting point led Curtis to openly criticize the English precedents on each of the four categories of subsequent uses he identified: verbatim reproduction of the whole (which at least according to some English dicta was allowed under some circumstances[162]); verbatim reproduction of a part; imitation; and abridgment. Regarding the last category Curtis flatly declared: "the general doctrine of the English law on the subject of Abridgments needs revision."[163] Curtis' starting point for analyzing the rule was accepting the definition of a true abridgment as a work that showed real "invention, learning and judgment" on the part of the abridger. Nevertheless, he concluded, an abridgment was still taking "the property of the original owner" which could not be justified by "any amount of learning, judgment or invention, shown in the act by him who thus appropriates the property of another."[164]

Why did the abridgment that was obviously justified and commendable for eighteenth century English judges become so reprehensible to Curtis? The market value model of copyright that animated his conclusions soon came to the surface:

> "When we consider the incorporeal nature of literary property, it will be apparent that no writer can make and publish an abridgment, without taking to himself profits of literary matter which belong to another."[165]

The abridgment according to Curtis "of necessity tends to the injury of the true proprietor" because "[t]he real object of most abridgments is to undersell

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[161] Probably aware of that Curtis wrote: "Notwithstanding some dicta in a few cases, and the general principle (which cannot be established at a fixed line), by which what is called fair use of a previous publication is obscurely hinted at, I apprehend that the doctrine of our law is and must be, that where an injury is caused, an infringement is, in point of strict right, made out." *Id.*, at 241.

[162] Cary v. Kearsley, 4 Esp. 168, 170, 170 Eng Rep. 679 (K.B. 1802).

[163] Curtis, *supra* note 31, at 265.

[164] *Id.*, at, 271.

[165] *Id.*, at 275-276.

the original work."[166] Its unforgivable sin was creating competition to the original work and thereby diminishing its market value: "It makes use of his [the author's] work to raise competition which must always be dangerous, by bringing it in a contracted form within the reach of a larger number of purchasers."[167]

In a last final move Curtis shifted this market value analysis from the original work itself to the copyright in the work. An abridgment, he explained does not only injure the sales of "copies which the true proprietor has already published but it also interferes with his use of the copyright, and of his power of disposing of it."[168] In other words, the abridgment was an interference with the potential abridgments market of the copyright owner: "His copyright must be held to have secured to him the right to avail himself of the profits to be reaped from all classes of readers, both those who would purchase his production in a cheap and condensed form, and those who would purchase it in its more extended and costly shape."[169] Curtis was using a somewhat circular reasoning by arguing that copyright protection had to cover abridgments or otherwise the owner might lose the profits of the abridgments market. But he was also taking the market value conception of copyright to its most abstract form in which the focus was no longer on the value of the original work but rather that on the "copyright." The "right to publish an abridgment" is "a valuable part of the copyright," he explained, and therefore "[i]f, during the existence of the copyright, the work is abridged by a stranger, the copyright is shorn of an incident, the loss of which may greatly affect its value as property."[170] In the last analysis, it turned out, it was the value of the "copyright" that was protected by copyright law. The value of the copyright was an abstraction of an abstraction, an elusive entity covering many "incidents," particular uses and forms of the work, and many potential markets.

Just like Curtis when Justice McLean turned to deal with the abridgment rule in the 1847 *Story v. Holcombe*[171] he relied on a market value conception of copyright and consequently he found the rule incoherent. Yet

[166] *Id.*, at 276.

[167] *Id.*, at 280.

[168] *Id.*, at 278.

[169] *Id.*

[170] *Id.*, at 279.

[171] 23 F. Cas. 171 (C.C.D.Oh. 1847).

another self-referential case, *Story* dealt with a publication which was an alleged abridgment of Justice Story's *Commentaries on Equity Jurisprudence*: James Holcombe's *An Introduction to Equity Jurisprudence: On the Basis of Story's Commentaries*. Story had passed away by the time of the decision, but he is ever-present in McLean's opinion which makes constant references to both Story's *Commentaries* and his seminal copyright decisions. In 1847 the dead hand of Joseph Story was still reshaping American copyright law.

A master appointed by the court concluded that Holcombe's work was a fair abridgment. Accordingly the defendant appealed to the rule that a bona fide abridgment is not an infringement. "This controversy has caused me great anxiety and embarrassment," McLean declared.[172] The cause of this anxiety and embarrassment was what McLean saw as a firmly established line of English precedents which mandated that a bona fide abridgment was not an infringement. He found that he was bound by those precedents. But he accepted the rule grudgingly declaring that had it been an open question he would have felt little difficulty in determining it the other way. "I yield to it in this instance," he said "more as a principle of law, than a rule of reason or justice."[173]

This hostility toward the abridgment rule was animated again by a market value conception of copyright. The essence of abridgment, McLean explained, was serving as a market substitute for the original:

> "An abridgment should contain an epitome of the work abridged - the principles, in a condensed form of the original book. Now it would be difficult to maintain that such a work did not affect the sale of the book abridged… are there not many who are able to buy the original work, that will be satisfied with the abridgment? What law library does not contain abridgments and digests, from Viners and Comyns down to the latest publications. The multiplication of law reports and elementary treatises, creates a demand for abridgments and digests; and these being obtained, if they do not generally, they do frequently prevent the purchase of the works at large."[174]

[172] *Id.*, at 172.

[173] *Id.*, at 173.

[174] *Id.*, at 172-173.

Thus the quality that constituted the worth of the true abridgment for eighteenth century judges- its usefulness to the reading audience- was from McLean's perspective its chief evil. The abridgment was a market substitute for the protected work and as such it encroached upon its value: "Now an abridgment, if fairly made, contains the principle of the original work, and this constitutes its value."[175]

McLean attacked both the rules that allowed such uses and what he saw, rightly or not, as remnants of intentionalism in Story's formulation of the fair use doctrine:

> "This doctrine seems to consider the intention with which the citations are made as necessary to an infringement… But I can not perceive how the intention with which extracts are made, can bear upon the question. The inquiry is, what effect must the extracts have upon the original work. If they render it less valuable by superseding its use, in any degree, the right of the author is infringed: and it can be of no importance to know with what intent this was done. Extracts, made for the purpose of a review, or a compilation, are governed by the same rule. In neither case can they be extended so as to convey the same knowledge as the original work."[176]

When the effect on the market value of the original work became the main focus of copyright protection the traditional rules allowing derivative uses as well as the intentionalist undertones of infringement analysis lost all coherence.

McLean solved this anxiety-generating conflict between what he perceived as binding precedents and the fundamental injustice of these precedents, by applying a very narrow definition of an abridgment. "To abridge" he said "is to preserve the substance, the essence of the work, in language suited to such a purpose."[177] Holcombe's work did not only fail to be entitled "an abridgment" it did not achieve the task of preserving the entire substance of the original work in a condensed form and hence it was a mere "compilation" which did not enjoy the safe haven.[178] Thus the abridgment

[175] *Id.*, at 173.

[176] *Id.*

[177] *Id.*, at 174.

[178] *Id.*, at 174-175.

rule survived *Story v. Holcombe*, but the growing emphasis in copyright discourse on market value was robbing it of its justification, breeding hostility toward it and bringing about a constant erosion of its practical effect.

By the time that Eaton Drone published his seminal copyright treatise in 1879 all such doubts were gone. The traditional rules allowing various derivative uses were replaced by a categorical prohibition mitigated only by a fair use exception. In Drone's account both the prohibition and the exception were structured around the market value interpretation of copyright. In discussing "Piracy" Drone laid down the new structure of copyright law. He started by asking whether copyright protection is "limited to verbatim transcripts, or does it extend to paraphrases and servile imitations? Is the unlicensed translation, dramatization or abridgment of copyrighted work piratical? Did the legislature intend to protect the substance of literary composition, or merely its verbal form?"[179] His answer was a resounding assertion that "literary property is not limited to a precise form of words, the identical language in which the composition is expressed,"[180] and that "the author of a literary composition may claim it as his own, in whatever language or forms of words it can be identified as his production."[181]

Latent in this outlook was a new concept of the work as an intellectual entity much broader and more amorphous than the older notion of the copy as the exact language of the book. However, the more concrete outcome of Drone's turning away from the traditional focus on verbatim or evasive reproduction was an unequivocal rejection of the categorical rules that allowed numerous derivative uses:

> "In this view of the subject, it is no defence of piracy that the work entitled to protection has not been copied literally; that it has been translated into another language; that it has been dramatized; that the whole has not been taken; that it has been abridged; that it is reproduced in a new and more useful form. The controlling question always is, whether the substance of the work is taken without authority."[182]

[179] Drone, *supra* note 31, at 384.

[180] *Id.*

[181] *Id.*, at 385.

[182] *Id.*

Drone was putting in place a new structure of copyright protection. The traditional framework of copyright consisted of: a hardcore of protection against verbatim reproduction; a general rule allowing practically all derivative uses; and an exception to the rule which created an additional thin penumbra of protection by prohibiting derivative uses with only evasive or colorable changes (see fig. 1). The new framework dramatically changed the baseline of copyright protection. It consisted of: a hardcore of protection against verbatim reproduction; a general rule prohibiting all derivative uses; and a fair use exception to the rule allowing a relatively small zone of uses (see fig. 2).

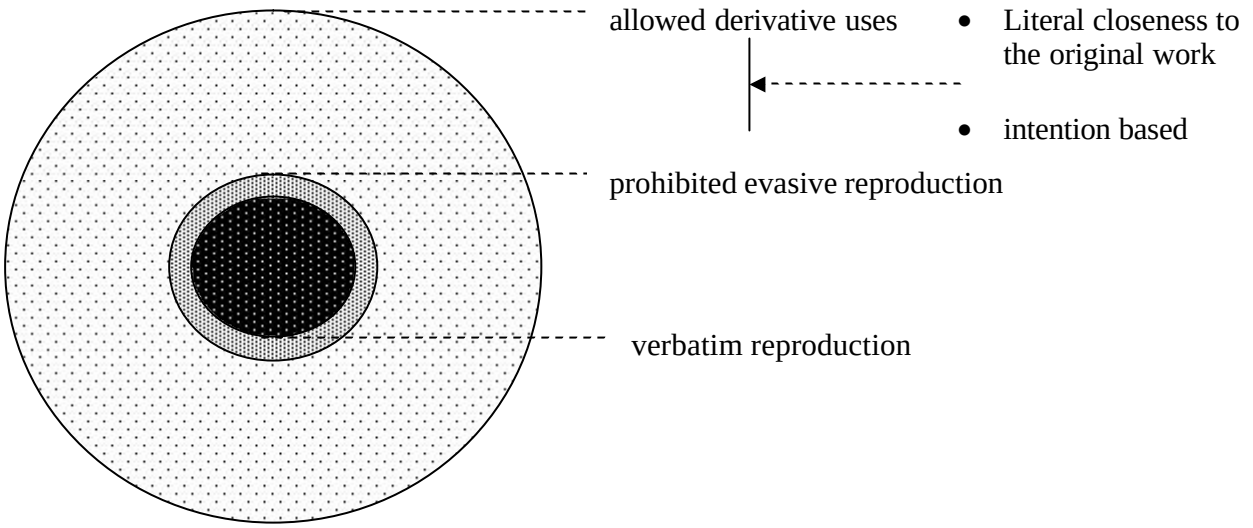

Fig.1 Copyright infringement circa 1800

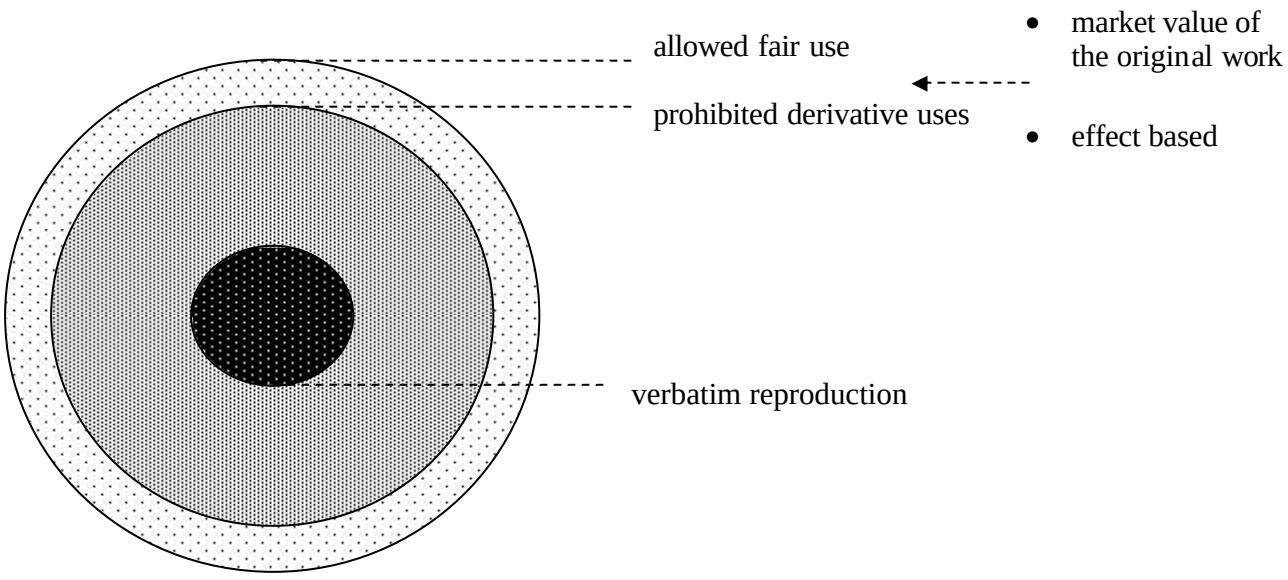

Fig.2 Copyright infringement circa 1880

Drone phrased the fair use exception in the terms familiar to any modern copyright lawyer as an exception to the rule of infringement based on the need for "balance." Since "it would obviously be a hindrance to learning if every work were a sealed book to all subsequent authors. The law therefore wisely allows 'fair use' to be made of every copyrighted production; and this liberty is consistent with the true purpose of the law to give to the earlier author adequate protection for the results of his labor."[183]

As a formal logical matter inverting the rule and exception structure of copyright did not necessarily entail a change in the scope of copyright protection. But in the context of the conceptual transition animating it the formal change had exactly this implication. Underlying the doctrinal shift was a decline of the old emphasis on literal reproduction and on bad intentions and a rise of a new focus on the effect on market value of the protected work. This conceptual change is apparent in Drone's discussion of fair use. Drone insisted that that determining the border between fair use and an unlawful use was "one of the most difficult problems in the law of copyright" which "must generally be determined by the special facts in each case."[184] Yet when he came to analyze the various specific contexts of fair use one principle kept appearing as the main axis of the analysis. Virtually every paragraph in this section of the treatise is laden with references to criteria such as: "superseding the original;"[185] "diminish[ing] the sale"[186] of the original; and "giv[ing] material value to the subsequent treatise, to the substantial injury of the earlier one."[187] Market value was the guiding light of the new structure of copyright. This new animating principle made the scope of the fair use exception much narrower than that of the former rule allowing derivative uses.

Drone's analysis of abridgments was representative of the entire group of formerly allowed derivative uses. The basic controlling principle came to be that "[a]lterations, additions, improvement & c., made without authority, however extensive or valuable they may be, confer no right to use a

[183] *Id.*, at 386-387.

[184] *Id.*, at 387.

[185] *Id.*

[186] *Id.*, at 388.

[187] *Id.*, at 389. The entire section is full with similar criteria for determining fair use. See: *id.*, at 386-399.

copyrighted work."[188] The rest of the analysis consisted of a concentrated attack on the English bona fide abridgment precedents and on McLean's "under protest"[189] deference to them in *Story*. The problem was that "the effect of the abridgment must be to prejudice or to supersede the original, to a material extent."[190] Drone stressed that he was focusing not on "so called abridgments which are made by merely colorably shortening the originals,"[191] but on the supposedly harder case of a bona fide abridgment which "may be a new work in outward form, of great merit and highly useful."[192] He concluded, nevertheless, that such admirable qualities "confer no right on any one to abridge without authority a work protected by copyright."[193] The rationale, as could be expected by now, was that the "very plan of an abridgment and the purpose of its author require that it shall embody what is most valuable in the work abridged,"[194] and that "the publication of the abridgment will tend to supersede the unabridged, to lessen its sale, and thereby to injure its owner."[195] Under a market value conception of copyright what formerly was one of the most salient cases of a non-infringing new meritorious work, became the epitome of infringement. Drone's treatise marked the final disappearance of the traditional abridgment rule and the conceptual scheme underlying it.[196]

d. Ideas and Expressions through the Looking Glass

Implicit in the shift of copyright jurisprudence from verbatim reproduction to market value there gradually appeared the modern legal concept of the intellectual work. The work came to be understood in much less materialist and much more fluid terms than the traditional copy. Treatise

[188] *Id.*, at 433.

[189] *Id.*, at 440.

[190] *Id.*, at 438.

[191] *Id.*, at 441.

[192] *Id.*, at 442.

[193] *Id.*, at 443.

[194] *Id.*

[195] *Id.*, at 444.

[196] In the case law the final reversal of the safe haven for abridgment was in Lawrence v. Dana, 15 F. Cas. 26, 68-80 (C.C.D.Mass. 1869).

writers appealed to this new concept very explicitly. In 1847 Curtis answered what he saw as the pivotal question of copyright law- "what the right includes"- in the following way:

> "In the Jurisprudence with which we are concerned this right includes the whole book and every part of it… It includes also, or may include, the style, or language and expression; the learning, the facts, or the narrative; the sentiment and ideas, as far as their identity can be traced; and the form arrangement and combination which the author has given to his materials. These are, or may be, all distinct objects of the right of property;"[197]

This was the same treatise in whose opening chapter that dealt with the theoretical question of copyright as property Curtis asserted that the right subsisted in the language rather than the ideas.[198] In the context of the literary property debate jurists were clinging to the stability provided by the semi-materiality of a specific language based definition of copyright protection. But in the context of infringement and the scope of protection strong forces were pulling exactly in the opposite direction. Deserting the focus on verbatim reproduction and seeking to protect market value, demanded a much more abstract, broad and fluid concept of the work. Curtis' definition was as abstract as one can imagine:

> "However imperfectly the subject may have been regarded in former times, it is now, I think, to be regarded as settled that whatever is metaphysically part or parcel of the intellectual contents of a book, if in a just sense original, is protected and included under the right of property vested by law in the author; and it is very material to observe, that the arrangement, the method, the plan, the course of reasoning, or course of narrative, the exhibition of the subject, or the learning of the book, may be, according to its character, as much objects of the right of property, as the language and ideas."[199]

In a footnote Curtis alerted the reader that he did not mean to encourage the idea that "a man may appropriate to himself learning that is open to every

[197] Curtis, *supra* note 31, at 273.

[198] See *supra* text accompanying note 76.

[199] Curtis, *supra* note 31, at 273-274.

one, or that any exclusive property can be acquired in a subject."[200] But from Curtis' perspective, this qualification merely meant that any subsequent author could still avoid copyright infringement by resorting to open common sources and not drawing on the protected work.

Thirty two years later, Drone was only slightly more careful in defining the scope of copyright protection:

> "There can be no property in a production of the mind unless it is expressed in a definite order of words. But the property is not in the mere words alone,- not alone in one form of expression chosen by the author. It is in the intellectual creation, which language is merely a means of expressing and communicating. The words of a literary composition may be changed by substituting others of synonymous meaning; but the intellectual creation will remain substantially the same."[201]

The shift away from verbatim reproduction created a new conceptual entity- an "intellectual creation"- that remained stable no matter how much the specific means of "expressing and communicating" changed. In Drone's description this entity grew to almost mythical proportions. It constituted an identity that seemingly could not be lost:

> "So an intellectual production may be expressed in any number of different languages. The thing itself is always the same; only the means of communication is different. The plot, the characters, the sentiments, the thoughts which constitute the work of fiction, form an immaterial creation… The means of communication are manifold; but the invisible, intangible, incorporeal creation of the author's brain never loses its identity."[202]

This constituted again a strange inversion of the arguments of the literary property debate. In that context English and American jurists argued about the unmistakable mark of identity of the literary work. Yet those arguments identified the mark of identity with the language or the concrete expression

[200] *Id.*, at 274.

[201] Drone, *supra* note 31, at 97.

[202] *Id.*, at 97-98. See also: *id.*, at 384-385.

used by the author.[203] For Drone, it came to be an "invisible, intangible, incorporeal creation of the author's brain" which constituted this imperishable entity that survived any transformation on the ephemeral level of expression. Abstractness, immateriality, manifold of shapes and yet also an alleged ultimate stable identity were the traits of the newly born concept of the work.

In judicial opinions a similar process of abstracting the copy into the work occurred on a much less theoretical level. Judges usually avoided the theoretical academic phrasing of the question in terms of defining the creative work. Instead they focused on the more practical version of the question, asking what the scope of copyright protection was in particular cases. But implicit in their answers to the second question there emerged a notion of the work similar to that which developed explicitly in the treatises. The somewhat hesitant beginning of this process in American law can be traced to Story's 1845 opinion in *Emerson v. Davies*.[204] The case dealt with two arithmetic textbooks. The plaintiff did not argue that the defendant reprinted his book or that the defendant's textbook constituted a verbatim copy of it. Instead he alleged that "the defendants have adopted the same plan, arrangement, tables, gradation of examples and illustrations by unit marks, in the same page, in imitation of the plaintiff's book."[205] That was quite different from the traditional focal case of reproduction of a copy. Finding for the plaintiff, Story wrote a characteristic opinion which did not directly attack the old English precedents. The opinion, rather, remained somewhat ambivalent and wove new meaning into the existing formulas. It is full of references to: "servilely copy[ing] the words of another;"[206] "transcribe[ing];"[207] "formal or colorable omissions or alterations;"[208] and even "disguised but still apparent intention to appropriate."[209] This seemed to be quite cozily located within the familiar distinction between evasive colorable copying and a new independent work grounded in the underlying understanding of copying as verbatim reproduction. But then came Story's subtle new tilt:

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[203] See *supra* text accompanying notes 66-78.

[204] 8 F. Cas. 615 (C.C.D.Mass. 1845).

[205] *Id.*, at 620.

[206] *Id.*

[207] *Id.*

[208] *Id.*, at 621.

[209] *Id.*

> "the true test of piracy or not is to ascertain whether the defendant has, in fact, used the plan, arrangements, and illustrations of the plaintiff, as the model of his own book, with colorable alterations and variations only to disguise the use thereof; or whether his work is the result of his own labor, skill, and use of common materials and common sources of knowledge, open to all men, and the resemblances are either accidental or arising from the nature of the subject. In other words, whether the defendant's book is, quoad hoc, a servile or evasive imitation of the plaintiff's work, or a bona fide original compilation from other common or independent sources."[210]

Again this used all the known catchphrases, but Story also injected a fundamental change into the traditional rule. The precedents which limited protection to near-verbatim reproduction, allowed more abstract uses of the protected work in subsequent works as long as they were not conceived of as evasive. But in Story's formula a subsequent bona fide original work could only draw on "other common or independent sources." In other words a resemblance, even on an abstract non-literal level, was either due to causes not involving any use of the protected work or it was by definition a "servile imitation." In short, Story was expanding the coverage of protection and limiting the scope of allowed subsequent uses, while using the traditional terminology.

Behind this stretching of the protection was, unsurprisingly, the new market value understanding of copyright. "[T]o amount to an infringement, it is not necessary that there should be a complete copy or imitation in use throughout; but only that there should be an important and valuable portion, which operates injuriously to the copy-right of the plaintiff"[211] Story explained. The outcome of this new understanding and the increased scope of protection which it spurred was a new concept of the protected work:

> "In truth, every author of a book has a copy-right in the plan, arrangement and combination of his materials, and

[210] *Id.*, at 624.

[211] *Id.*, at 625.

> in his mode of illustrating his subject, if it be new and original in its substance."[212]

This was certainly different from the earlier identification of the protected work with a particular combination of signs. Stealthily, almost unnoticeably, Story started the process of abstracting and expanding the work in American copyright law.

Other antebellum cases continued to show similar tendencies. When Justice McLean protested in *Story v. Holcombe* against the abridgment rule he used an analogy to what he conceived to be the scope of the invention in patent law, in order to expand the borders of the copyrighted work:

> "The same rule of decision should be applied to a copyright as to a patent for a machine. The construction of any other machine which acts upon the same principle, however its structure may be varied, is an infringement on the patent. The second machine may be recommended by its simplicity and cheapness; still, if it act upon the same principle of the one first patented, the patent is violated... Why, then in reason and justice, should not the same principle be applied in a case of copyright as in that of a patented machine?"[213]

The "principle" which McLean suggested as the object of protection in copyright supplied an abstract essence to the work- an identity that was preserved in every subsequent use, irrespective of the specific language used. This anticipated Drone's focus on the "thing itself" which remained the same irrespective of the means of communication.

After the Civil War this trend intensified. Judges were still using the language of evasive and colorable reproductions, but they were constantly moving away from verbatim reproduction and in the process expanding and abstracting the scope of the protected work. This happened in some cases that involved the traditional subject matter of copyright- the product of the press. Thus when in 1881 Horatio Alger published, well, an Horatio Alger story,

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[212] *Id.*, at 619. And also: "An author has as much right in his plan, and in his arrangements, and in the combination of his materials, as he has in his thoughts, sentiments, opinions, and in his modes of expressing them." *Id.*, at 620.

[213] 23 F. Cas 173.

entitled *From Canal-Boy to President* the court found it was an infringement of a biography of president Garfield on which Alger drew. The court explained that "so much of the ideas, language and mode of expression" was taken that parts of the original book were appropriated.[214]

However, many of the significant cases which further elaborated the new concept of the work occurred in the contexts of forms of expression that were newcomers to the field of copyright protection. The 1866 *Daly v. Palmer*[215] dealt with the recently added entitlement of public performance in regard to dramatic compositions,[216] but its main focus was the question of infringement and the boundaries of the protected work. The defendant used in his play *After Dark* a very popular and dramatic "railroad scene" involving an escape of a character tied to the tracks from an oncoming train. The scene was similar to one from the plaintiff's play- *Under the Gaslight*- but the entire play as well as various details and the dialogue in the scene itself were quite different.

The court found the scene to be infringing, relying on an English case from the new brand, which ruled that an adaptation with variations of airs from an opera to dance music, constituted an infringement.[217] The English court found that "the piracy is where the appropriated music, though adapted to a different purpose from that of the original, may still be recognized by the ear. The adding variations makes no difference in the principle."[218] Finding that this line of reasoning is "eminently sound and just, and… applicable to the case of a dramatic composition" Judge Blatchford concluded that "[a]ll that is substantial and material in the plaintiff's 'railroad scene' has been used… in a manner to convey the same sensations and impressions to those

[214] Gilmore v. Anderson, 38 F. 846, 849 (S.D.N.Y. 1889). See also: Lawrence v. Dana, 15 F. Cas. 26, 58 (C.C.D.Mass. 1869); Simms v. Stanton, 75 F. 6, 10 (C.C.N.D.Cal. 1896).

[215] 6 Fed. Cas. 1132 (S.D.N.Y. 1868).

[216] An 1856 amedment added only in regard to dramatic compositions the entitlement of "the sole right also to act, perform, or represent the same, or cause it to be acted, performed, or represented, on any stage or public place." Act of August 18 1856, 11 Stat. 138, (hereinafter 1856 Copyright Act).

[217] D'Almaine v. Boosey, 1 Y. & C. 288, 160 Eng. Rep. 117 (Ex. 1835).

[218] *Id.* at 302; 160 Eng. Rep. 123.

who see it represented, as in the plaintiff's play."[219] As for the object of protection he wrote:

> "The original subject of invention, that which required genius to construct it and set it in order, remains the same, in the adaptation. A mere mechanic in dramatic composition can make such adaptation, and it is a piracy, if the appropriated series of events, when represented on the stage, although performed by new and different characters, using different language, is recognized by the spectator, through any of the senses to which the representation is addressed, as conveying substantially the same impressions to, and exciting the same emotions in, the mind, in the same sequence or order."[220]

This identified the object of protection with an abstract intellectual entity whose identity consisted in the "impressions" and the "emotions" conveyed to the mind rather than in any particular expression. The identity of this entity survived any "adaptation." Whoever, "appropriated" this entity, no matter how much he changed the expressive details, was reduced to "a mere mechanic" and by consequence to a pirate. In 1869 T.W. Clarke, the counsel for the defendant, published a short comment in which he identified the inflation of the work in *Daly*.[221] He thought that it was the first time that "a property in incident" was recognized. Clark also sharply diagnosed the parallelism between this trend and the developments in patent law. The decision, he thought, "may be said to advance in literary law the doctrine of romantic equivalents, analogous to the doctrine of mechanical equivalents of the patent or mechanical law."[222] In patent law it was the doctrine of equivalents that was used to broaden the scope of the "invention,"[223] in copyright the "work" was expanded in a similar way.

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[219] *Id.*, at 1138.

[220] *Id.*

[221] 3 Am. L. Rev. 453 (1869).

[222] *Id.*

[223] See *infra* chapter 4, Sec. B(1)(a).

The photography cases of the late nineteenth century reflect a similar trend.[224] After copyright was extended to photographs in 1865[225] there appeared two lines of attack on such protection. The one focused on the qualification of a photograph as a proper subject matter of copyright due to issues of authorship and originality.[226] The second was more particularistic. It consisted of specific cases in which defendants, who did not mechanically reproduce the photograph but rather created independent photographs or lithographs of varying degrees of similarity, argued that such actions did not constitute infringement. Courts were quite uniform in deploying a standard for infringement which located the protected work on a level of abstraction much higher than the exact details of the original photograph. The 1893 *Falk v. Donaldson* is the most interesting of the photography cases, because the counsel for defendant explicitly appealed in his defense to an idea/expression dichotomy. He argued that "the idea or conception of the original artist may be followed and used by another, provided he clothes such idea or conception in different language or form," and that defendant had "merely taken the conceptions of the other, and clothed them in his own form and expression, his work was original." In short, "[c]opying… involves, not only taking another's ideas or conceptions, but also their expression."[227]

The court agreed that "the lithograph is not strictly a copy of the photograph,"[228] but rephrased the decisive question to "whether the alleged infringer has appropriated the results of the original conception of the artist."[229] It found that "although varying somewhat in design, it is a copy of the conception of complainant"[230] and that "[t]he defendants have appropriated a substantial portion of such conceptions."[231] Again the work was conceptualized as equivalent to the "conceptions" rather to any more concrete level of the details of the protected object. The court also made

[224] See Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53 (1883); Falk v. Brett Lithographing Co., 48 F. 678 (S.D.NY. 1891); Falk v. Donaldson, 57 F. 32 (S.D.N.Y. 1893).

[225] Act of March 3 1865, 13 Stat. 540, §1.

[226] See *infra* Section C(4)(b).

[227] 57 F. 35.

[228] *Id.*

[229] *Id.*

[230] *Id.*, at 36.

[231] *Id.*, at 37.

explicit the connection between the expansion of the work and the focus on market value by declaring: "the measure of complainant's rights is not limited by the mere fact that the lithograph would not displace the photograph in the market. He is entitled to any lawful use of his property, whereby he may get a profit out of it."[232] Although the phrasing is somewhat confusing in its apparent rejection of the market displacement criterion, this amounted to saying that a copyright owner was entitled to the profit extractable not only from the market of the original photograph, but from a whole variety of markets that could be associated with a much broader "conception" embodied in it. According to this logic the defendant was entitled to the profits of such secondary markets as the lithographs market, as long as the particular lithographs, no matter how different in mere details, could be traced as appropriating the identity of his work. Thus, market value and the work came to be inexorably bundled together in a tautological grip. The market value conception of copyright brought about an inflation of the copy into the work. At the same time, however, the broadening of the boundaries of the work widened the scope of the relevant "market value."

In another dramatic composition case- *Maexwell v. Goodwin*[233]- the same pattern repeated. Counsel for the defendant argued that "there is no inherent property right in ideas, sentiments, or creations of the imagination expressed by an author, apart either from the manuscript in which they are contained, or 'the concrete form which he has given them, and the language in which he has clothed them.'"[234] The instructions to the jury in the trial court, however, were phrased in very different terms. The jury was instructed that "the author of a literary composition may claim it as his own in whatever language or form of words it can be identified as his production. The true test of piracy, then, is not whether a composition is copied in the same language or the exact words of the original, but whether, in substance, it is reproduced."[235] Justice Seaman described these two propositions as fundamentally conflicting, and although he found the first to be "not without force," he concluded that the jury instruction was "in accord with the weight and trend of decisions in this country."[236] In the specific case itself defendant's play was found to be non-infringing. The reason was that there

[232] *Id.*, at 37-38.

[233] 93 F. 665 (C.C.N.D.Ill. 1899).

[234] *Id.*, at 665-666.

[235] *Id.*, at 666.

[236] *Id.*

could be found "no copying or imitation in plot, scene, dialogue, sentiment, characters, or dramatic situations, and no similarity, aside from the general features and subjects… - resemblances which may naturally occur when congressional life in Washington is the theme;" and that "no intellectual creation of the one reappears in the other in any form. "[237] Again, the protected object of copyright was identified with the "intellectual creation" while directly rejecting a claim that it was limited to any concrete particular expressions.

A modern copyright lawyer reading the above descriptions may sense that she has just gone through the looking-glass into an inverse world. The elaborations of the concept of the work during the second half of the nineteenth century, as they appear in the bulk of cases, seem to draw on a fundamental dichotomy in copyright law: ideas and expressions. Yet, strangely enough, in total opposition to the familiar modern rule, the protected work seems to be consistently identified with the pole of abstract ideas rather than with that of concrete expressions. In the theoretical elaborations in the treatises as well as in a few cases the proposition that the object of copyright protection is expression rather than ideas is explicitly rejected in unequivocal terms. We find courts insisting again and again in their legal formulas and their application that what is protected is not any particular expression but rather the "intellectual creation" or the "conception" that covers many expressions.

How, then, can this looking-glass inverted world be explained? Was there any change of heart later in the twentieth century that reversed this trend and gave rise to the modern idea/expression dichotomy? The fact of the matter is quite different. As will be demonstrated shortly, at the very same period- around the turn of the nineteenth century- one finds another strand of judicial decisions which strove to set boundaries to copyright protection by limiting the level of abstraction to which it could be applied. This line of cases is the beginning of the modern idea/expression dichotomy. This fundamental tenet of modern copyright law was not a later construct. Nor was there a cyclic pattern of a curtailment of a preexisting rule during the late nineteenth century and its later renewal. The fact that there were earlier antecedents and beginnings notwithstanding, the major development of the idea/expression dichotomy within copyright law occurred during the late nineteenth century. And yet this is the very same period in which many other copyright cases and authoritative elaborations developed in exactly the opposite direction. What could account for this? One possible answer is that

[237] *Id.*, at 667.

the idea/expression dichotomy served as an Ideology in the Marxian sense. Marx used the term Ideology to describe a popular consciousness in which reality is conceived of as the opposite of what it really is and "men and their circumstances appear upside-down as in a *camera obscura.*"[238] From this perspective the idea/expression dichotomy developed in copyright discourse alongside the new concept of the "work" as its ideological representation or counterpart. While courts shifted copyright protection to ever-increasing levels of abstraction they also created a representation and shared a consciousness of such protection as limited to a high level of concreteness. Is this argument plausible? First we have to take a closer look at the second strand of cases in which the dichotomy started to appear.

The roots of the idea/expression dichotomy go all the way back to the eighteenth century cases in which English judges insisted that there could be no property in an entire subject or in "knowledge." These cases, however, were rooted in a conceptual environment in which reprinting of a copy or verbatim reproduction was the focus of copyright protection. The new version of the idea/expression dichotomy, which operated in conjunction with a very different concept of copyright protection, started appearing toward the end of the nineteenth century. The best known of this new strand of cases was the 1879 *Baker v. Selden.*[239] The plaintiff in this case who published a book explaining a new book-keeping system argued that defendant's reproduction of certain blank forms in a form close to that in which they appeared in the book constituted a copyright infringement. Justice Bradley declared that "the truths of a science or the methods of an art are the common property of the whole world, and author has the right to express the one, or explain and use the other, in his own way."[240] He went on to declare that "there is a clear distinction between the book, as such, and the art which it is intended to illustrate."[241] This in effect created a distinction between the concrete expression of the book and the more abstract idea or knowledge it conveyed, limiting protection to the former. "The teachings of science and the rules and methods of useful art," Bradley explained, "as embodied and taught in a literary composition or book, their essence consists only in their statement. This alone is what is secured by the copyright."[242] The "knowledge" itself, on

[238] Karl Marx, *The German Ideology*, in KARL MARX SELECTED WRITINGS 164 (David McLellan ed. 1977).

[239] 101 U.S. 99 (1879).

[240] *Id.*, at 100-101.

[241] *Id.*, at 102.

[242] *Id.*, at 104.

the other hand, was not part of the protected work. The significant point in the particular circumstances of *Baker* was, of course, that the specific "expression" and the "knowledge" or "art" communicated could not be separated. Using the system required a resort to the particular forms or to ones very similar to them. Thus the case is remembered today mainly for introducing the merger doctrine, according to which in cases in which the idea or knowledge inseparably merges with the particular expression, even the latter cannot be protected by copyright.[243] The merger doctrine is the ultimate manifestation of the idea/expression dichotomy. Its essence is that in circumstances in which a choice must be made between protecting the expression and keeping the idea free the latter prevails. Yet at the time the case was a pioneering one not only in the narrower aspect of the merger doctrine. Despite the fact that it did not use the terms, it was one of the first seminal cases that began to articulate the idea/expression dichotomy in its modern form.

The 1899 *Holmes v. Hurst*[244] involved a rather idiosyncratic application of the idea/expression dichotomy but it supplied one of its most eloquent articulations. Justice Brown used the distinction in order to rule that a monthly publication in a newspaper of Oliver Wendell Holmes's (the father of Justice Holmes) *The Autocrat of the Breakfast Table*, constituted a prior publication that invalidated any subsequent attempts to meet the statutory formalities and obtain a copyright in the book as a whole. Brown defined the scope of copyright protection in the following way:

> "The right thus secured by the copyright act is not a right to the use of certain words, because they are the common property of the human race, and are as little susceptible of private appropriation as air or sunlight; nor is it the right to ideas alone, since in the absence of means of communicating them they are of value to no but the author. But the right is to

[243] As the court put it: "And where the art it teaches cannot be used without employing the methods and diagrams used to illustrate the book, or such as are similar to them, such methods and diagrams are to be considered as necessary incidents to the art, and given therewith to the public." *Id.* at, 103.

[244] 174 U.S. 82 (1899).

> that arrangement of words which the author has selected to express his ideas."[245]

The following decades saw a long string of cases which culminated with Learned Hand's classic articulation of the doctrine in *Nichols v. Universal Pictures*.[246] In these cases courts repeatedly cited *Selden* and *Holmes* and applied the idea/expression dichotomy in order to decide whether a particular subsequent work infringed by appropriating the expression or constituted a legitimate use of the general idea.[247] In the 1913 *Eichel v. Marcin* one judge put the issue in terms of the potential cost of copyright protection for subsequent innovation:

> "The object of copyright is to promote science and the useful arts. If an author, by originating a new arrangement and form of expression of certain ideas or conceptions, could withdraw these ideas or conceptions from the stock of materials to be used by other authors, each copyright would narrow the field of thought open for development and exploitation, and science, poetry, narrative, and dramatic fiction and other branches of literature would be hindered by copyright, instead of being promoted. A poem consists of words, expressing conceptions of words or lines of thoughts; but copyright in the poem gives no monopoly in the separate words, or in the ideas, conception, or facts expressed or described by the words. A copyright extends only to the arrangement of the words."[248]

Thus by the early twentieth century the new idea/expression dichotomy changed the emphasis of the eighteenth century precedents. The latter were based mainly on the taken for granted notion of copyright as the exclusive

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[245] *Id.*, at 86.

[246] 45 F. 2d 119 (2nd Cir. 1930).

[247] See for example: Simms v. Stanton, 75 F. 6, 10 (C.C.N.D.Cal. 1896); Kalem Company v. Harper Bros., 222 U.S. 55 (1911); Eichel v. Marcin, 241 F. 404 (S.D.N.Y. 1913); London v. Biograph Co., 231 F. 696 (2nd Cir. 1916); Stodart v. Mutual Film, 249 F. 507 (S.D.N.Y. 1917); Dymow v. Bolton, 11 F.2d 690 (2nd Cir. 1926); Nutt v. National Institute Inc., 31 F.2d 236 (2nd Cir. 1929).

[248] 241 F. 409-410.

right for printing a copy or for verbatim reproduction. Almost as an afterthought or as a side-effect of this fundamental concept some judges sometimes mentioned the happy fact that this left all "knowledge" as free as the air. Under the new version of the dichotomy the emphasis on verbatim reproduction disappeared. The focus moved completely to the question of copyright as an impediment for the free transmission and use of knowledge. In a world in which expanding copyright protection was gradually outlawing previously allowed activities, asserting that "knowledge" remained free and open for all came to be the main purpose of the often cited idea/expression rule.

It seems inaccurate to say that the idea/expression dichotomy as it appeared at the turn of the nineteenth century was purely ideological. After all, under its umbrella Selden was allowed to sell his forms and Marcin was allowed to perform his play. The doctrine was undeniably used to curtail the scope of copyright protection to a narrower domain than the one that could be entailed, at least as a matter of formal logic, from the expansion of the "work" during the late nineteenth century. The idea/expression dichotomy did not simply convey a false representation of reality which was the absolute inversion of the practical effect of the legal rules. Still, the representation it conveyed stood in sharp tension with the main practical thrust of the development of copyright law during the relevant period. Exactly at the time when copyright protection was expanding to construct an increasingly abstract object of property, what came to be one of its fundamental doctrines declared with unprecedented clarity that all "knowledge" and ideas remained free. In other words the idea/expression dichotomy was semi-ideological.

One way to see this is to compare the state of copyright protection and the doctrinal representation of copyright protection at the turn of the nineteenth and twentieth centuries. The result of such a comparison is an inversion of the relationship between the actual legal rules and their rhetorical representation. In 1800 the scope of protection was narrow. It covered only uses close to verbatim reproduction. The representation of copyright as not applicable to "knowledge" was relatively rare, though not non-existent. In 1900 the scope of protection had grown substantially. Under the changing concept of the work protection came to cover many subsequent uses well beyond verbatim reproduction. At the same time the representation of copyright as leaving all "knowledge" utterly free became one of the main tenets of copyright doctrine and one of its most cited rules in the form of the idea/expression dichotomy. Thus, the expansion and abstraction of the protected work and the rise of the idea/expression dichotomy were counterparts of the same process. This is not as surprising as it might seem in first blush. The growing abstraction and expansion of copyright protection

mediated through the concept of the work, created the need for a doctrinal device that would stop these processes from following their internal logic ad-absurdum. It also created a potential anxiety about the ownership of knowledge and the corresponding need for a soothing representation of doctrinal reality that would mitigate such anxiety. The idea/expression dichotomy as a semi-ideological device came to serve both of these two different functions.

At the end of the nineteenth century a new structure of copyright had consolidated. It consisted of a focus of copyright on the protection of market value and in an abstract concept of the work; mitigated but also supported by a fair use exception and an idea/expression dichotomy. This new structure was not rigid or absolutely determinate. It enabled a whole range of arguments about the exact proper scope and character of various doctrinal details, as well as various positions in specific cases. Nor was it necessarily more unstable than the older conceptual scheme that was focused on the notion of verbatim reproduction of a copy. Both the old and the new structures constituted a space within which different specific outcomes and general positions could be justified. Nevertheless, these spaces differed in important ways in the starting points, the fundamental presumptions and the conceptual categories they offered to their users.

2. Entitlements: Copyright as General Control

Intertwined with the process of abstracting and inflating the scope of the protected work was another significant development: There gradually appeared a range of various entitlements enjoyed by the owner of copyright. The traditional single entitlement of the exclusive right of printing a copy was being superseded by a host of various forms of control powers that were entrusted to the owner vis-à-vis the work. Abstracting the concept of the work and expanding copyright entitlements were aspects of the same process. When the protected work came to be conceptualized as a fluid abstract entity whose identity survived despite changes of "forms," expanding the entitlements as to encompass these various forms was a natural move. Protecting the right of public performance, for example, was the conceptual counterpart of conceiving of a performed play as "the same work" as the written text of the play.

The cumulative effect of adding various specific entitlements was a profound transformation of copyright protection. Despite, the common references to copyright as "property," and the dominant description of

property rights as a "sole and despotic dominion,"[249] eighteenth century copyright created a very narrow and limited form of exclusive control. The only formal "dominion" the "owner" had over the copy was the exclusive control of its reprinting. Copyright never became an absolute or general control of the owner over the work. The expansion of entitlements during the late nineteenth century, however, transformed it into a generalized control. Copyright became a broad range of powers enjoyed by the owner over different aspects and uses of the work, rather than a single narrow commercial privilege. In short, by the turn of the century copyright came closer to the modern concept of property as a bundle of various rights enjoyed by the owner vis-à-vis an object of property.

a. Translation and Dramatization

The eighteenth century English rule was that a translation did not constitute an infringement of copyright. Just like the abridgment the translation was considered a new independent work that did not interfere with the exclusive right to reprint the original copy. The American case that directly confronted the question of translations for the first time was the 1853 *Stowe v. Thomas*.[250] It involved a German translation of one of the best known and most successful literary works of the time: Harriet Beecher Stowe's *Uncle's Tom Cabin*.[251] Justice Robert Grier, who, interestingly enough, as a federal judge was a staunch enforcer of the Fugitive Slaves Laws, upheld the traditional English approach. The result was a defeat of

[249] 2 Blackstone, *supra* note 69, at 2.

[250] 23 F. Cas. 201 (C.C.E.D.Pa. 1853). See also Melissa J. Homestead, *"When I can Read my Title Clear": Harriet Beecher Stowe and the Stowe v. Thomas Copyright Infringement Case*, 27 Prospects 201 (2002). The author points out the tension between Stowe's self-cultivated public image as a humble passive recipient of external forces, and her aggressive and sophisticated promotion of her interests. *Id.*, at 209-210.

[251] As Homestead points out it seems hardly accidental that *Stowe* was the first case to seriously test the translation rule in the United Sates. *Uncle Tom's Cabin* was one of the first true best sellers in the United States. It enjoyed unprecedented popularity in a newly appearing national market. As such it attracted many adaptations and translations. Thus Stowe's stakes in expanding the scope of copyright protection as to encompass such ubiquitous and potentially valuable secondary uses were especially high. See *id.*, at 204.

Stowe's action. Grier's opinion was deeply rooted in the traditional concept of copyright as the exclusive right to print a copy. In order to examine the issue of translation, Grier explained, "we must inquire what constitutes literary property."[252] His answer was unequivocal: "The claim of literary property… cannot be in the ideas, sentiments, or the creations of the imagination of the poet or novelist as dissevered from the language, idiom, style, or the outward semblance and exhibition of them. His exclusive property in the creation of his mind, cannot be vested in he author as abstractions, but only in the concrete form which he has given them, and the language in which he has clothed them."[253] This was the older version of the idea/expression dichotomy. It was grounded in the notion of the exclusive right for verbatim reproduction as the only entitlement granted by copyright. The "only property" which the author has, Grier wrote, "is the exclusive right to multiply the copies of that particular combination of characters… This is what the law terms copy, or copyright."[254] Once copyright was thus conceptualized as the sole right to print a copy, it was obvious that the translation was not viewed as an infringement. Or in the words of Grier: "I have seen a literal translation of Burns' poems into French prose; but to call it a copy of the original, would be as ridiculous as the translation itself."[255] In short, Grier was deploying not only the eighteenth century rule that created a safe-haven for translation, but also the entire conceptual scheme and of copyright that filled it with meaning and vitality.

Yet Grier was behind his time. The view of copyright protection he strongly represented was losing ground. *Stowe v. Thomas* was the swan song of the translation rule and of the traditional view of copyright that supported it. Even prior to the case Curtis in his 1847 treatise already started the attack. Curtis argued that the English precedents applied only to translations of foreign works, which under the Statute of Anne did not enjoy protection in Britain. As for translation of works protected by copyright, he concluded "upon principle" that a translation was an infringement. The conclusion was

[252] 23 F. Cas. 206.

[253] *Id.*, at 206.

[254] *Id.*, at 206-207.

[255] *Id.*, at 207. Grier also drew on the theme of arbitrary judicial legislation, as opposed to judicial submission to natural principles: "to call the translations of an author's ideas and conceptions into another language, a copy of his book, would be an abuse of terms, and arbitrary judicial legislation." *Id.*

based on the new concept of copyright which veered away from verbatim reproduction toward an abstract notion of the protected work:

> "The property of the original author embraces something more than the words in which his sentiments are conveyed. It includes the ideas and sentiments themselves, the plan of the work, and the mode of treating and exhibiting the subject. In such cases his right may be invaded, in whatever form his own property may be reproduced. The new language in which his composition is clothed by translation affords only a different medium of communicating that in which he has an exclusive property."[256]

Once the object of property came to be identified with an abstract intellectual entity or essence that encompassed many forms the translation safe-haven lost its coherence. It became only too clear that a translation was just another "dress" of the same intellectual essence.

As a practical matter Grier's decision survived only for a short period. In 1870 the Copyright Act was amended to mandate that all authors may "reserve the right… to translate" their works.[257] Nevertheless, Drone, writing in 1879, unleashed an even fiercer attack on the dying translation rule. In fact, his treatise included a whole subsection entitled "Stowe v. Thomas Criticised."[258] The 1870 amendment notwithstanding, for Drone it was important to show that the entitlement of translation derived from "established principles"[259] of copyright law- that it was an integral part of a coherent and reasoned framework of copyright, rather than just an arbitrary statutory intervention suspect of being the result of rent-seeking by special interests. In addition, the question still retained some practical significance. Until a further amendment in 1891[260] the statute referred to authors' entitlement to "reserve" the right to translate. Arguably the right did not apply to cases in which no prior explicit reservation was undertaken. Thus Drone's task was to show that the right of translation was, by definition, part

[256] Curtis, *supra* note 31, at 293.

[257] 1870 Copyright Act, §86.

[258] Drone, *supra* note 31, at 454-455.

[259] *Id.*, at 446.

[260] Act of March 3 1891, 26 Stat 1106, §1.

of copyright and that the statutory amendment "neither creates nor destroys the right."[261]

The line of argumentation adopted by Drone should be obvious by now:

> "The definition that a copy is a literal transcript of the language of the original finds no place in the jurisprudence with which we are concerned. Literary property, as has been shown, is not in the language alone; but in the matter of which language is merely a means of communication. It is in the substance and not in the form alone. That which constitutes the essence and value of literary composition… may be capable of expression in more than one form of language different than the original."[262]

Here were all the components of the new concept of copyright: a focus on protecting market value, which, in turn, entailed an abstract and fluid concept of the protected intellectual "work." After adopting these premises all that was left to argue was that a translation was "a copy of literary production in its essential attributes" and that "the translator creates nothing" but merely "takes the entire creation of another, and simply clothes it in new dress."[263] Once the translation came to be identified with the ephemeral level of mere form or "dress" which simply reproduced the somewhat mystical intellectual essence of the work, it became inevitable that "[t]he doctrine that an unlicensed translation of a protected work is no invasion of the copyright in the original, as was held in Stowe v. Thomas, is contrary to justice, recognized principles, and the copyright statutes of the United States as judicially construed."[264]

The development of the right to control dramatizations of the copyrighted work followed an almost identical pattern. Plays were potential objects of copyright protection from the early days of the stationer's copyright. But since copyright was rooted in the framework of regulating the book-trade plays were protected as products of the press. There was a

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[261] Drone, *supra* note 31, at 446.

[262] *Id.*, at 451.

[263] *Id.*

[264] *Id.*, at 454.

prohibition neither on performance of a copyrighted text of a play nor on dramatization, namely, the transformation of a book into a play. Neither of these constituted reprinting a copy of the original. The second question - that of dramatization as infringement- was seriously considered in the English courts for the first time only in the second half of the nineteenth century. The initial determination there was that dramatization was not an infringement. By that time, however, copyright in dramatic compositions came to be conceived of in England as a separate sub-category of copyright protection which awarded the author both the exclusive right of reprinting and that of publicly performing the play. This led the English courts to a somewhat odd outcome. Their conclusion was that the dramatization of a literary work was not an infringement of the copyright in the original book. Yet if the author had previously published a play version of the book the subsequent dramatization was considered an infringement of the play. That was the case even if the subsequent dramatization drew exclusively on the book rather than the play.[265] In the United States things were simpler. Prior to the 1870 revision of the Copyright Act dramatization was not recognized as an infringement at all. The 1870 amendment, just as it did with translations, mandated that an author could reserve the right to dramatize his work.[266]

Once again, Drone set out to the task of proving that a dramatization constituted infringement as a matter of copyright principles, irrespective of the statutory amendment and of the author's "reservation" of the right. He advocated the conclusion that a dramatization was an infringement of a book whether the book was previously dramatized by the original author or not. In order to reach this conclusion he required a rather fancy doctrinal footwork. The argument hinged on the protection of the right of public performance of "dramatic compositions" that by the time when Drone was writing was a settled fact in the United-States. If the original book could be defined as a "dramatic composition" then the unauthorized dramatization, at least when performed, would constitute an infringement of the right of public performance. The heart of Drone's argument was that a dramatic work should be interpreted broadly so that "a work of fiction, if it has the essential qualities of a drama, is entitled to protection as a dramatic composition, although not expressly designed for the stage, and although changes in its form may be necessary to adapt it for that purpose."[267] In other words, Drone

[265] See: Reade v. Conquest, 9 C.B. 755, 142 Eng. Rep 297 (C.P. 1861); Toole v. Young, L. Rep. 9 Q.B. 523 (Q.B. 1874).

[266] 1870 Copyright Act, §86.

[267] Drone, *supra* note 31, at 462-463.

was conjuring up a tautology. He explained that the question of whether a dramatization was an infringement was dependent upon the question of whether the original was a dramatic composition; and then went on to define dramatic composition as anything that could be dramatized. Under this logical structure any subsequent dramatization, by definition, was also the proof that the original work was a dramatic composition and hence was entitled to this kind of protection.

These logical circles, however, had an underlying substantive background to support them. When Drone was conjuring them up, he did it with the new concept of the work at the back of his mind, or rather at the front of his text:

> "… the dramatist invents nothing, creates nothing. He simply arranges the parts, or changes the from, of what which already exists… in making this use of a work of which he is not the author, he avails himself of the fruits of genius and industry which are not his own, and takes to himself profits which belong to another."[268]

Again it was the concept of the work as an abstract identity or essence that survives irrespective of the manifold of forms it could take that animated the technicalities of doctrinal arguments.

Drone's reliance on the new concept of the work also highlighted the substantive conceptual differences between his views and those of the English judges he was criticizing. The latter still understood copyright protection in field-specific terms. Particular entitlements were thought to be entailed from the classification of the work as either a "play" or a "book." A book was a book and it could only be copied or reprinted. A play was a different independent intellectual entity that could be both reprinted and performed. A subsequent play could only be a "copy" of the original play but not of the original book. For Drone the overarching notion of the work annihilated what came to be archaic distinctions of this kind. The work was an abstract and fluid entity which under the new conceptual scheme was assumed to remain identical whatever the particular form of expression or dress happened to be- whether a book or a play. As long as this entity could be detected, there was copying in the new broader sense. This "changed form but survival of identity" argument was the basis of the rising right of dramatization just as it was that of the right of translation. There were no

[268] *Id.*, at 464.

American cases in which the more traditional English attitudes regarding dramatization were tested against those of Drone. By 1891 it was clear that the views of Drone had prevailed unequivocally. A new statutory amendment as well as subsequent cases applying it made dramatization an exclusive entitlement attached to all copyrighted works irrespective of any special reservation by the author.[269]

b. Public Performance

As long as plays and music were protected as products of the press no exclusive right of public performance was recognized or protected. Although copyright owners and their assignees employed with partial success a variety of tactics in order to prevent others from performing their dramatic and musical works,[270] the formal recognition of a public performance right gradually appeared only in the second half of the nineteenth century. When earlier at the end of the eighteenth century a few English copyright owners started to claim that public performance of their plays was a form of publication and hence an infringement, there appeared a line of cases that firmly rejected this proposition.[271] Until a statutory amendment in 1833 the

[269] 1891 Copyright Act, §. 565. For examples of such cases see: Harpper v. Ranous, 67 F. 904 (S.D.N.Y. 1895); Dam v. Kirke La Shelle Co., 166 F. 589 (S.D.N.Y. 1908).

[270] Such tactics were usually based on the physical control of the text of the play or the music and avoidance of publication. Such withholding tactics were aided by what came to be known as common law copyright. In the post *Donaldson v. Becket* and *Wheaton v. Peters* era the term "common law copyright" referred to the protection against copying and publication of unpublished manuscripts. The common myth behind this branch of the law was that it had always existed and that, unlike post publication copyright, it was not preempted by the statutory scheme. The truth was that the formal protection under the common law of unpublished manuscripts appeared only in mid-eighteenth century England and was further expanded in scope, strength and importance only in the nineteenth century.

[271] See Coleman v. Wathen 5 T. R. 245, 101 Eng. Rep. 137 (K.B. 1793); Murray v. Elliston, 5 Barn. & Ald. 657, 106 Eng. Rep. 1331 (K.B. 1822). The 1820 Morris v. Kelly, 1 Jac. & W. 481, 37 Eng. Rep 451 (Cha. 1820) obscured things in regard to unpublished plays. The Chancellor issued there an injunction restraining the public performance of an unpublished play, protected by what came to be known as common law copyright rather than by

English courts adhered to the view that performance was not a form of printing or publishing a "copy,"[272] or that copyright "only extends to prohibit the publication of the book itself."[273]

In the United States there appeared no cases that challenged the English precedent or even discussed the question of public performance as infringement. In 1847 Curtis referred, somewhat bewilderedly, to the former "defect in the [English] law" under which authors of dramatic and musical compositions "enjoyed their copyrights" but "had no exclusive privilege to the more valuable form of representation or performance."[274] From a perspective that came to identify copyright with the protection of value, leaving the obviously valuable market of performances uncovered could only be seen as a defect. Nevertheless, Curtis did not try to deny that in the United States copyright law still suffered from such a defect. Relevant interests- publishers and theater managers- did not remain idle. While devising strategies for maximizing their profits from copyrighted plays under the current laws they also actively lobbied for a change in the law. In 1856 this resulted in an amendment to the Copyright Act. Under the new arrangement the copyright in "any dramatic composition, designed or suited for public representation, shall be deemed and taken to confer… along with the sole right to print and publish the said composition, the sole right also to act, perform or represent the same, or cause it to be acted, performed or represented on any stage or public place."[275]

The statutory protection of public performance was a significant landmark, but it stopped short of creating a general principle according to which such an entitlement was a standard part of copyright protection in any applicable context. At first the public performance entitlement was conceived of in narrow terms as a particular privilege added by the legislature as part of the regulation of a specific trade. Drone defined copyright and playright as

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the statutory right which began with publication. The ruling, however, provided no elaborate rationale.

[272] The statutory amendment which explicitly introduced protection of public performance in England was: 3 & 4 Will. IV c. 15.

[273] 5 T.R. 245, 101 Eng. Rep. 138.

[274] Curtis, *supra* note 31, at 104.

[275] 1856 Copyright Act. The amendment also provided that an infringement would entitle the owner to damages by action on the case or to other equivalent remedy and set minimum sums for such damages.

"two independent and distinct rights."[276] The former applied to all printed publications the latter only to dramatic compositions. "Copyright may be infringed by publication in print," wrote Drone, "but not by public performance; playright by representing but not by printing the play."[277] Of course, a printed dramatic composition could be protected by both copyright and playright.

This was not just a meaningless formalistic classification. Singling out playright as a distinct right emphasized the fact that there was no general public performance entitlement as part of copyright. Thus, it was undisputed that musical compositions were protected only against reproduction in print and not against public performance.[278] Even Drone who was eager to expand copyright protection irrespective of change of "dress" concluded that:

> "In the United States, the statute does not give to the composer the exclusive right of playing a piece of music, unless it be a dramatic composition. A work composed of instruments alone, as a symphony concerto &c., cannot be considered as a dramatic composition. Hence, there is no statutory remedy against any person who causes a work of this kind to be played in public without the consent of the owner."[279]

Drone devised a way to sweeten the bitter pill. He argued for a broad definition of dramatic compositions as to include all works combining words and music such as operas and songs.[280] To this he added a syllogism according to which since copyright protected the whole and every part of a

[276] Drone, *supra* note 31, at 601.

[277] *Id.*

[278] See Carte v. Duff [The Mikado Case], 25 F. 183, 186 (S.D.N.Y. 1885). "Strictly, the only invasion of a copyright consists in the multiplication of copies of the author's production without his consent. Any other use of it, such as for the purpose of public reading or recitation, is not piracy… But the copyright laws of congress recognize the playright of the author or proprietor of a dramatic composition, and secure to him the exclusive privilege of its public representation upon the stage."

[279] Drone, *supra* note 31, at 640.

[280] *Id.* See also: *id.*, at 598-601. For judicial recognition of an opera as a dramatic composition see: Carte v. Ford [The "Iolanthe" Case], 15 F. 439, 442 (C.C.D.Md. 1883).

work, a performance of just the music of a protected musical-dramatic work constituted an infringement.[281] Still, when it came to the harder case of bare music Drone admitted that there was no public performance right. This situation was changed only in 1897, once again through lobbying and a statutory amendment that extended the public performance entitlement to musical compositions.[282]

By the time of the 1909 thorough revision of the Copyright Act, public performance was still not defined as a general entitlement covering any copyrighted work when applicable. It was still defined in subject matter specific terms. These specific zones, however, became so numerous and so broadly defined that the net-outcome was close to a general public performance entitlement.[283] The gradual appearance of such a general entitlement constituted yet another aspect of the expanding concept of the protected work. The appearance of the public performance right was part of the transformation of copyright toward protection of subsequent versions well beyond verbatim copies. This process was entangled with two conceptual moves. First, there was the conception of the work as a fluid and abstract identity that could be reproduced irrespective of mere "dress." Second and closely related, there was the guiding principle of protecting market value in subsequent or secondary markets. The rise of the public performance entitlement carried these two principles into the realm of changing media. As we shall see, protection of a copyrighted work irrespective of the media in which it was communicated never became an absolute and undisputed axiom of copyright law. Yet, the general principle did rise into a dominant position in copyright thinking. One of its main earlier embodiments was the rise of the public performance entitlement.

[281] Drone, *supra* note 31, at 640.

[282] Act of January 6 1897, 29 Stat. 481. The amendment also made a "willful" infringing performance a misdemeanor punishable by up to one year imprisonment.

[283] The 1909 Copyright Act protected not only the public performance of dramatic and musical compositions but also the public delivery of a "lecture, sermon, address or similar production. The existing prohibition on dramatization blocked another avenue for public performance, although a public reading of a non-dramatic work was arguably still permissible. See Act of March 4 1909, 35 Stat. 1075, §§1(b)-(e) (hereinafter 1909 Copyright Act).

c. Apollo v. Ben Hur: Derivative Works and Copyright as General Control

At the turn of the nineteenth century American copyright law was gradually taken over by the general logic of derivative works. According to this rising outlook copyright protection, qualified only by the fair use exception, extended to cover any subsequent uses or versions of the original, no matter how much changed in form or media as long as its origin could be reasonably traced to the abstracted notion of the original work. This abstraction of the protected work, as we saw, was intertwined with the notion of protecting market value. The focus on market value pushed toward abstracting and expanding the work. The resultant logic of derivative works, in turn, expanded the notion of market value as to cover more and more secondary markets. At the time of the 1909 revision of the Copyright Act there was no comprehensive copyright entitlement to exclusively control all derivative works. Yet the accumulation of new entitlements and subject matter, the expanded scope of protection and the underlying logic of these developments came close to creating de facto a general principle of derivative works.

The case, however, must not be overstated. Copyright never became total control of all aspects or subsequent uses of the work. While the logic of derivative works came to dominance, there survived a diametrically opposed substratum in copyright legal thought. This was a line of cases that deployed a narrow interpretation of copyright protection and refused to extend it to new derivative uses, at least in the absence of a clear explicit legislative decree to do so. This aspect of the nineteenth century transformation of copyright is probably best understood in terms of the inversion of core and periphery. At the end of the eighteenth century the core of copyright protection was the narrow entitlement of verbatim reproduction. This core was accompanied by a narrow periphery of cases and doctrines that started to broaden copyright protection beyond exact reproduction. By the end of the nineteenth century the core of copyright law consisted of the exclusive control of a broad scope of derivative uses. At the periphery, however, there survived some checks on the general logic of derivative works and some resistance to the expansion of protection. This was the case especially when new forms of reproduction or media were involved. Rather than absolute total control, this new core/periphery formation characterized the new structure of copyright law. This new conceptual structure left room for future political and legal struggles over the extension of copyright protection to new domains. Yet often it also influenced the outcome of such struggles.

This dynamics is best exemplified by two seminal early twentieth century cases that involved new technologies. In the 1908 *White-Smith Music*

Pub. Co. v. Apollo Co.[284] the manufacturers of perforated rolls used by automated player pianos to play copyrighted tunes escaped liability. In the 1911 *Kalem Company v. Harper Brothers*[285] a film based on the novel *Ben Hur* was found to be an infringement of the book's copyright. In both cases Justice Holmes wrote intriguing opinions- per curia in the latter, concurring in the former. Between *Apollo* and *Ben Hur* one can find the story of twentieth century American copyright.

The defense in *Kalem* relied on the recent line of cases which enunciated the new idea/expression dichotomy. "Copyright," it was argued, "does not monopolize the intellectual conception, but only the form of expression." Counsel for the defendant interpreted the distinction in terms that fell back on traditional concepts of copyright. He described copyright as the limited prohibition on reprinting and the protected "copy" as a semi-material object, limited to a specific combination of written signs. According to this argument, the protection extended only to "the form of expression, i.e., the 'arrangement of words,'" or to "the writings of the author."[286] The film, the argument went, could not be a "copy" of the original book- a reproduction of its specific language. As the defense put it: "[b]ooks and pictures are essentially different."[287] Hence the book "was not copied in the making of the pictures, but they are realizations, in a different art, of some of the ideas to which Gen. Wallace gave a written portrayal."[288] The defense even went so far as trying to ground the argument on the constitutional level. Based on the language of the intellectual property clause of the Constitution, which referred to securing the rights of authors in their "writings," it was argued that even explicit legislation of Congress could not extend copyright protection to control derivative films.[289]

Justice Holmes rejected all such arguments. He ruled that since "drama may be achieved by action as well as by speech" the film constituted a dramatization of the book, which was prohibited under the Copyright Act.[290] To the claim that this extended copyright to ideas rather than words he

[284] 209 U.S. 1 (1908).

[285] 222 U.S. 55 (1911).

[286] *Id.*

[287] *Id.*, at 56.

[288] *Id.*, at 58.

[289] *Id.*, at 60.

[290] *Id.* at, 61.

answered that "there is no attempt to make a monopoly of the ideas expressed. The law confines itself to a particular, cognate and well known form of reproduction."[291] This outcome was much less obvious than may appear to the modern observer used to the logic of derivative works and to the longstanding normalization of film adaptations as a form of infringement. At the time motion-pictures were a novel technology and form of expression. It was far from clear that the copyright legislation was meant to encapsulate it. The entitlement of dramatization itself was a recent statutory addition which reversed a long line of precedents in copyright law. The statute was amended as a response to a concentrated demand of specific interest groups in the theatrical profession and it was not self-evident that it applied to different newly emerging industries and media. One can speculate that Holmes' ruling was animated by the rising logic of derivative works, but the opinion itself is concise and offers little hints as to its underlying reasons.

Apollo that was decided three years earlier offers a glimpse both at the operation of an opposite trend in copyright jurisprudence, and at the concepts that animated Holmes's emerging thought on the field. At the center of the dispute was another novel technology that enabled a new derivative use of copyrighted works. The majority of the Supreme Court ruled that perforated rolls used in player pianos were not an infringement of copyrighted tunes played by such pianos. Plaintiff's argument was an eloquent manifesto of the logic of derivative works or of general control. "The policy of the law is to protect the author against every form of piracy without distinction," it was argued, "and the piracy of a musical composition by reproducing and selling it in the form of perforated music is just as culpable as in any other form."[292] Defendant, however, offered an opposite narrow interpretation of copyright protection: "The protection designed to be afforded to the composer by copyright of a musical composition is only the monopoly of the multiplication and selling of copies, and this applies to musical compositions as it does to all other subjects of copyright."[293]

The opinion of Justice Day adopted the second narrative. He explained that "Congress has dealt with the concrete and not with an abstract right of

[291] *Id.*, at 63.

[292] 209 U.S. 3.

[293] *Id.*, at 7.

property in ideas or mental conceptions."[294] Day explicitly rejected the idea of general control and resorted to a narrow, semi-material notion of the copy:

> "The statute has not provided for the protection of the intellectual conception apart from the thing produced, however meritorious such conception may be, but has provided for the making and filing of a tangible thing, against the publication and duplication of which it is the purpose of the statute to protect the composer."[295]

Day admitted that the device at issue was a derivative use of the original, since it enabled "the manufacturers thereof to enjoy the use of musical compositions for which they pay no value."[296] But he denied that "they are copies within the meaning of the copyright act."[297] Hence resorting to more traditional concepts of copyright protection and of the copy resulted in rejecting the general logic of derivative works and the claimed protection for the new use.

Holmes, "concurring specially" due to the weight of existing precedents recoiled from an open dissent. Yet his opinion was in effect a critique of the court's understanding of copyright. It started with the assertion that "the result is to give to copyright less scope than its rational significance and the ground on which it is granted seem to me to demand."[298]: What is most remarkable in Holmes' opinion is the fact that it drew on the mainstream of copyright thought as it developed during the preceding fifty years, while at the same time rejected one of its central tacit premises. The opinion was founded on the two main premises of the rising logic of derivative works: the abstraction of the protected object of property, and the focus on value.

Holmes started with describing copyright as a move from property in physical objects to control of intangibles. "The notion of property starts" with "the right to exclude others from interference" with "a tangible object," he explained. "But in copyright property has reached a more abstract expression. The right to exclude is not directed to an object in possession or owned, but is

[294] *Id.*, at 16.

[295] *Id.*, at 17.

[296] *Id.*, at 18.

[297] *Id.*

[298] *Id.*, at 19.

in vacuo, so to speak."[299] This abstraction of the object of property led to a focus on the protection of value. "The restriction is confined to the specific form, to the collocation devised, of course," Holmes wrote. Yet he immediately added: "but one would expect that, if it was to be protected at all, that collocation would be protected according to what was its essence." Protection had to prevent the "possibility of reproducing the result which gives to the invention its meaning and worth."[300] That was the familiar line of argument: the fluid borders of the abstract object of protection had to be drawn broadly as to protect the "worth" of the work. Holmes was thus stating the new dominant strand of thought in copyright law. This potentially goes a long way in explaining his decision three years later in *Kalem*.

However, at the same time that Holmes was embracing the new copyright orthodoxy he began to challenge one of its main tenets. The notion of copyright as the protection of market value as it appeared during the nineteenth century often had undertones of pre-political natural rights. Since *Wheaton v. Peters* there was little direct judicial discussion of the character of copyright as a property right. Moreover, it was undisputed that after publication the only sort of copyright protection in existence was the statutory one. Nonetheless the dominant notion of copyright as protection of market value remained entangled with a conception of property as a pre-political naturally defined right. The rule that denied post-publication common law copyright did not undermine such an understanding, but rather supported it. Its received form came to be that the statute preempted and took away common law protection from the moment of publication onwards. The historical inaccuracy notwithstanding, this further entrenched the idea that the origin of copyright was in a common law right, which in turn reflected a natural property right. Furthermore, while limiting copyright protection after publication to the statutory arrangement entailed adherence to the statutory requirements and formalities as a condition of a valid copyright, the statute itself was often interpreted in light of the supposed prior common law right. The main thrust of this way of thought was that, the added statutory formalities and limited duration notwithstanding, the statute by and large reflected the common law natural right. Thus, the argument went, since the natural right of copyright or the "nature" of copyright, like other property rights, consisted of protection of the value of the work in all possible forms and dresses, so did the statutory protection. Drone, put it this way:

[299] *Id.*

[300] *Id.*

> "Assuming it to be true doctrine, that literary property both before and after publication, is founded on the same principles, has the same essential attributes, is the same in every respect, as ordinary property, it necessary follows that it must be governed by the same fundamental rules, and protected by the same great safeguards that are thrown around all property. Whatever violates the sanctity of one violates the sanctity of the other."[301]

The judicial and scholarly arguments that articulated the logic of derivative works often wove together natural rights and statutory law in this complex way.

This was exactly the point where Holmes in *Apollo* began his break with the new orthodoxy of copyright. By 1908 his general legal positivism was already firmly crystallized.[302] His opinion was an important landmark that would lead to his famous rejection of the natural-right-value theory of property in the 1918 *International News Service v. Associated Press*, where he wrote: "[p]roperty, a creation of law, does not arise from value."[303] In *Apollo*, while relying on the argument that copyright protected the "worth" of the work, Holmes provided just as clear a positivist conception of property, albeit limited to the context of copyright:

> "It is a right which could not be recognized or endured for more than a limited time, and therefore, I may remark in passing, it is one which hardly can be conceived except as a product of statute, as the authorities now agree."

It is remarkable, and it seems hardly accidental, that Holmes' two most explicit elaborations of a positivist conception of property occurred in the context of intellectual property- copyright in *Apollo* and what came to be known as misappropriation in *INS*. The catalyst that produced such utterances was provided by the special circumstances characteristic of intellectual property. First, there was the elusive and obviously constructed object of property, what Holmes called rights *in vacuo*. Second, there was the obvious fact that the law interfered to create limitations and exclusions where these did not exist at all as a physical or natural matter. As Holmes put it: "It restrains the spontaneity of men where but for it there would be nothing of

[301] Drone *supra* note 31, at 17.

[302] Horwitz, *supra* note 59, at 140-141.

[303] 248 U.S. 215. 223 (1918).

any kind to hinder their doing as they saw fit. It is a prohibition of conduct remote from the persons or tangibles of the party having the right. It may be infringed a thousand miles from the owner and without his ever becoming aware of the wrong."[304] The constructed object of the right and the non-excludable character of intellectual products, brought out to the open the fact that property rights in such products were social constructions through the medium of law. For Holmes it was only too obvious that in the case of intellectual property the law created borders and exclusions where before nothing restrained "the spontaneity of men." In *INS* his positivist position became more mature and developed in two respects. Its coverage was stretched from the more obvious case of intellectual property to cover all property rights; and the positivist interpretation came to encompass judicially crafted property rights in addition to statutory ones. The seeds of the *INS* dissent, however, are clearly visible in the *Apollo* concurrence.

Holmes was articulating a new strand of thought which differed from both rivalrous positions in the eighteenth and mid-nineteenth century debates about literary property, and by implication about property in general. The traditional opposition to literary property as a natural right, and hence to common law copyright, conceptualized property in physicalist terms. The loss of physical character and physical borders meant, according to the opponents of literary property, also a loss of the essence which made property rights pre-political, objective and self-defining. The proponents of literary property, whose views exerted influence even when the formal battle for common law copyright was lost, reinterpreted the general model of natural property rights as to encompass copyright. They abstracted the concept of property and reconstructed it as the natural right for the protection of any kind of market value. Holmes emerging thought about property was a negative version of the latter view. He started with the focal case of property in intangibles and worked out the implication of that case to the general concept of property. From his perspective, the socially constructed origin that was so patent in the case of intellectual property rights, applied to property rights in general. The traditional opponents of literary property tried to save a natural pre-political right concept of property by limiting it to ownership of tangibles. Their rivals constructed a value theory of property in order to explain all property rights in intangibles as well as tangibles as natural rights. Under Holmes' attack the latter project, with its full scope of coverage, started to collapse.

[304] 209 U.S. 19.

Holmes' reliance in *Apollo* on protecting the "worth" of the work as the main justification should thus be understood in light of his positivist conception of intellectual property rights. He was explicitly rejecting the natural rights oriented notion according to which value was the origin of property and had to be protected to the fullest extent. His use of the concept of "worth" of the work was thus a pragmatic one. The argument was merely, that if copyright was to have any practical significance the exclusion power it conferred had to be so interpreted as to enable the owner to capture some meaningful share of the profits that could be attributed to the work. Yet, neither the *Kalem* nor the *Apollo* opinions offered any criterion or discussion of how much control or value should have been allocated to the owner. Once the bright-line of the value oriented concept of property was lost, legal discourse was thrown into the murky terrain of questions of measure and value judgments. How much of the market value of derivative uses of the work should the law divert to the hands of the copyright owner? What subsequent media and new technologies should be controlled and to what extent? Holmes' positivist understanding of property opened the door to all these questions of degree, but he failed to address them.

The dynamics of *Kalem* and *Apollo* encapsulates much of the story of copyright at the dawn of the twentieth century. The main-stream of copyright jurisprudence came to be dominated by the logic of derivative works and the underlying principle that the owner has a right to control the entire value of the work. The value theory of property often had strong natural law tendencies, though it frequently entangled together claims about statutory law and pre-political natural law. Yet, as demonstrated by Holmes, there started to appear also a positivist strand of thought, which nevertheless continued to appeal, somewhat uncritically, to notions of protection of value. The story, however, had another half. The dominance of the logic of derivative works notwithstanding, copyright never became general control of all derivative uses or of all "value" attributable to the original work. There persisted a counter-theme in copyright discourse that offered a narrower understanding of the right and a continuing resistance to the expansion of its scope especially in cases of new derivative forms.

Copyright thinking consisted of the uneasy cohabitation of this dominant theme and its weaker counter-theme. The aftermath of *Apollo* demonstrates that this cohabitation was dynamic rather than static and that its unfolding was limited neither to a purely conceptual realm nor to litigation in the courts. The 1909 Copyright Act legislated one year after the case included a compromise that changed the outcome of *Apollo*. It provided for copyright

protection against recording and mechanical reproduction of music.[305] The legislative amendment, however, did not fully incorporate the logic of total control. Instead the statute put into place what in modern copyright jargon would be called a compulsory license. It allowed unauthorized recordings for pre-set royalties of works that were already recorded by the owner or with his consent.[306] This was the beginning of a pattern of complex Solomnic judgments that would characterize many of the later statutory expansions of copyright in the twentieth century. The episode demonstrated the ongoing dynamic shifting line between copyright as general control and copyright as a narrowly defined set of entitlement.

3. Subject Matter

In 1790 copyright was conceptualized and practiced in the United States as a sector-specific regulation of the book trade. This character of early American copyright followed centuries of tradition and practice in England, ironically enough, at a period in which this aspect of English copyright was beginning to change.[307] Throughout the nineteenth century the subject matter of copyright steadily expanded, and the field came to be understood as premised upon the general principle of protecting all original creative works. This process, however, was slow and gradual. Early in the century copyright was still strictly limited to the product of the printing press. The law of copyright and its general justifications came to be firmly focused on the author. Theoretical discussions of copyright often resorted to the argument that a person's natural property right applied to any product of his mental labor just as it applied to that of his physical labor. Nevertheless, in practice copyright protection was far from covering all products of creative mental labor. The protection as well as the legal concept of copyright accompanying it remained limited in terms of subject matter to the boundaries of the traditional printer's trade privilege. As late as 1883, a time in which the transformation was already quite pervasive, the popular *Bouvier Law Dictionary* described copyright as "confined to the exclusive right secured to

[305] 1909 Copyright Act, §1(e).

[306] *Id.*

[307] See *supra* chapter 2, Section I(C)(2)(e).

the author or proprietor of a writing or drawing which may be multiplied by the arts of printing in any of its branches."[308]

The expansion of copyrightable subject matter occurred mainly through direct statutory amendments, although it was supported by some judicial decisions which rejected narrow interpretations of the statutory definitions. This expansion trend persisted throughout the century (see fig. 3). Amendments during the first half of the century such as the 1802 copyright protection for prints,[309] tended to stay within the traditional field of the product of the press. Later additions, however, broke into more remote areas and media and eventually left little of the framework of copyright protection as a regulation of the book trade. In 1789 the Copyright Act covered maps, charts and books. The 1909 Copyright Act which incorporated many earlier changes extended protection to: books; periodicals and newspapers; lectures, sermons and addresses; dramatic and dramatico-musical compositions; musical compositions; maps; works of art; reproductions of works of art; drawings or plastic works of a scientific or technical character; photographs; prints and pictorial illustrations.[310] Some of the categories of the 1909 act were still quite narrow, following the tradition of trade-specific regulation. Others however, like "works of art," became abstract and inclusive. These broad categories also created forward looking flexibility that enabled easy extension to new specific cases by way of analogy and interpretation. The proliferation of specific subject matter categories and the abstraction of others had a cumulative effect. New media and the ingenuity of lawyers trying to expand protection to new realms would keep the border-wars of copyright subject matter ever-alive. Yet at the beginning of the twentieth century both the practice of copyright and the concept implicit in it came much closer to embodying a general and abstract principle of protecting creative original works.

[308] Cited in Burrow-Giles Lithographic Company v. Sarony, 111 U.S. 53, 56 (1884).

[309] 1802 Copyright Act, §2.

[310] 1909 Copyright Act, §5.

Year	New Subject Matter
1790	maps; charts; books
1802	Prints
1831	musical compositions
1856	dramatic compositions
1865	Photographs
1870	paintings; drawings; chromos; statues; artistic models or designs
1909	lectures, sermons & addresses; works of art; reproductions of works of arts; all the writings of an author

Fig. 3 Expansion of Copyrightable Subject Matter

The pattern of expansion through statutory amendments might mislead. One may conclude from it that the growth of copyrightable subject matter was merely a function of new emerging technologies and the consolidation of political influence and power in the hands of relevant emerging interest groups. There is no doubt, that such factors played a crucial role in the process. Yet at this point I want to illuminate the connections between the expanding subject matter of copyright and other conceptual developments more internal to legal discourse. A suspicion, at least a prima facie suspicion, arises that the expansion of subject matter cannot be wholly reduced to technological and political developments, once one realizes that such works as paintings and statutes came to be covered only in a late stage of the process. Such works were not newly appearing media. Nor is there any reason, on the face of it, to assume that relevant interest groups accumulated significant new political influence. Such cases emphasize the role played by the constitutive power of legal discourse and legal categories as an active rather than merely reactive part of the transformation, alongside other factors.

Thus, the concept of copyright as premised on the underlying abstract principle of the rights of creators in their original works was both the result and part of the cause of the gradually expanding subject matter. As economic, technological and political forces and interests pushed for expansion of protection to new fields the traditional notion of copyright as a trade specific regulation epitomized by *Bouvier Dictionary's* reference to the "art of printing," was losing ground. At the same time, however, the new understanding of the general underlying principle of copyright protection played a part in defining the interests of those who strove for protection and in creating public receptiveness toward their claims. Thus in 1870 representative Jenckes who presented the revision of the copyright act to the House, justified the extension of protection to "paintings and works of art" by the conviction that "an artist has as much right to the exclusive reproduction of his works as an author or engraver."[311] In 1790 copyright protection for sculptures and paintings, though certainly not inconceivable,[312] would have been a novelty and a peculiar idea for many accustomed to think about copyright in terms of the book trade. In 1870 such protection, as Jenckes casual reference demonstrates, became common sense. Thus the growth of subject matter was a process that, to some extent, fed upon its own generated energy. Each expansion to new areas supported the emerging image of copyright as a comprehensive field premised upon an abstract principle of protecting all forms of original authorship. Such image, in turn, facilitated the next expansion and the coverage of new subject matter.

Similar, circular relations existed between the expansion of subject matter and the proliferation of new entitlements protected by copyright. To some extent new entitlements gained some of their relevance and legitimacy from the recognition of new subject matter. The entitlement of public performance, for example, seems much more relevant and "natural" in the context of a musical composition than in that of a map or even a book. In 1856 Senator Bayard justified the new public performance entitlement, somewhat hyperbolically by arguing that "[t]he only value of a copyright to the dramatic author really is to protect the representation of his production in theaters."[313]

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[311] CONGRESSIONAL GLOBE, 41st Cong., 2nd Sess., pt. 4, 2854.

[312] The British 1798 Models and Casts Act protected any new model, cast, bust and statues of certain kinds. 38 Geo. 3 c. 7.

[313] CONGRESSIONAL GLOBE, 34th Cong., 1st Sess., pt. 3, 1643.

Yet causation and legitimation flowed in the opposite direction as well. Expanding entitlements supported the growth of subject matter in two ways. First, new entitlements categorically different from the right to reprint a copy weakened the traditional exclusive association between copyright and the book trade. Second, the very differentiation and definition of a specific category of subject matter within legal discourse was often mediated through the medium of protected entitlements. The category of dramatic compositions provides a good example. Prior to 1856 there was no such independent category in copyright law. The texts of plays were, of course, subject to copyright protection from the days of the stationers' copyright. But they were protected as texts within the framework of the book trade. They were only protected against unauthorized reprint. Thus in legal discourse, the category of dramatic works was invisible. Plays were merely another instance of "books." In 1847 Curtis mentioned very briefly "Dramatic Compositions," but that was already in the newly emerging context of complaining about the lack of a public performance entitlement.[314] The 1856 statutory amendment that added such an entitlement did not amend the definition of copyrightable subject matter. Thus until the revision of 1870 the only statutory reference to "dramatic composition" was in the section which defined the new entitlement of public performance. This nicety of form reflected a broader phenomenon. The recognition of the public performance entitlement brought about a gradual differentiation of a new legal category of subject matter separate from books. In 1879 Drone devoted four chapters of his treatise to dramatic compositions and invested much energy in distinguishing copyright from playright.[315]

Expanding entitlements and expanding subject matter were closely connected. The combination of both developments constituted the break of copyright from its traditional character as a trade specific regulation of the book trade. Copyright became both practically and conceptually a universalized field based on the general principle of protecting creative intellectual works. By 1909 the *Bouvier Law Dictionary* definition of copyright as a right in "a writing or drawing which may be multiplied by the arts of printing in any of its branches," already old-fashioned in 1883, became totally irrelevant.

[314] Curtis, *supra* note 31, at 103-105.

[315] Drone, *supra* note 31, at 553-640, 601.

4. Authorship and Originality

According to most historical narratives of copyright, by the end of the eighteenth century, at the latest, copyright's doctrines and fundamental premises came to be deeply entangled with the rising ideology of the romantic author.[316] This ideology conceptualized the author as an individual genius who creates ex nihilo- the ultimate source of new and original intellectual works. Copyright doctrines and copyright thinking, the narrative goes, both reflected and constituted this ideology. The relations between the ideology and the practice of authorship and the law will be further examined later. At this section, however, I want to focus on one of the most obvious doctrinal sites where the ideology of romantic authorship and copyright law were, under this narrative, likely to merge into one: the legal requirement of originality. To the extent that the figure of the romantic author came to dominate copyright law one's initial expectation would be to find during the late eighteenth and nineteenth centuries a rise in the level of articulation and

[316] The seminal work in this vein is Rose, *supra* note 88. See also: Martha Woodmansee, *The Genius and the Copyright: Economic and Legal Conditions of the Emergence of the "Author,"* 17 Eighteenth-Century Studies 485 (1984), surveying mainly the German context; JAMES BOYLE, SHAMANS, SOFTWARE, AND SPLEENS: LAW AND THE CONSTRUCTION OF THE INFORMATION SOCIETY (1996); James Boyle, *The Search for an Author: Shakespeare and the Framers*, 37 Am. Univ. L. Rev. 625 (1988). Peter Jaszi, who wrote in the same vein, supplied the most sensitive to change and complexities account of nineteenth century American copyright and the ideology of authorship. See Peter Jaszi, *Toward a Theory of Copyright: The Metamorphosis of "Authorship,"* Duke L. J. 455 (1991). Recent work in American literary history raised some doubts and added important refinements regarding the applicability of the rise of the ideology of authorship narrative about eighteenth century England to the nineteenth century American context. See: McGill, *supra* note 71; Homestead, *supra* note 250. My analysis joins this general trend. It differs, however, by not putting the main emphasis on a supposed distinction between the social and ideological context in England and America. Instead I argue that the sole focus on romantic authorship flattens and ignores many of the complexities of actual copyright doctrine as it developed during the nineteenth century. This argument may turn out to be just as applicable to the English context as it is to the American one, although the present inquiry is limited to the latter. For doubts about the explanatory power of the ideology of authorship thesis regarding contemporary copyright doctrine see: Mark A. Lemley, *Romantic Authorship and the Rhetoric of Property*, 75 Tex. L. Rev. 873 (1997).

significance of legal doctrines that emphasized originality as the basis of copyright protection.

The actual development of American copyright doctrine does not reveal such a straightforward relation. Instead the development of the rules involving originality followed a much more complex pattern. On the one hand, during the nineteenth century there was an unmistakable rise of the theme of originality in copyright discourse, as well as a first appearance of a formal requirement of originality as a prerequisite for copyrightability. On the other hand, the actual content and the operative implications of the relevant doctrines were subject to constant remolding and circumscription that by the end of the century all but eradicate any notion that copyright protection was limited to original works of genius in the romantic sense. These were not separate developmental stages. On the contrary the rise of originality discourse and the shrinkage of the actual originality requirement happened simultaneously. They were aspects of the same process. In other words, like in the case of the idea/expression dichotomy, originality doctrine had a strong ideological or rather semi-ideological character. It constituted a certain consciousness or representation of reality, while to a significant extent putting into practice an inversion of that reality. This dynamics played itself out in respect to the two possible latent meanings of the romantic notion of originality: novelty; and substantive merit.

a. Originality as Novelty

Under the old English framework of copyright as the publisher's trade privilege there was little preoccupation with the question of originality either as novelty or as substantive merit. Copyright was the exclusive privilege to print any text that could be printed. It is not farfetched to say, with some overgeneralization, that a stationer could register a copyright in whatever text he got his hands on, provided that it was not already registered by another. As long as the figure of the author was only in the fringe of copyright there was hardly any interest in originality. Even in the post Statute of Anne era the move of authorship to the center of copyright doctrine and thought was only gradual, and so was the appearance of the legal category of originality. During the eighteenth century traces of the requirement of originality were only beginning to appear in a vague form in English copyright law.[317] When

[317] The first case where an argument that a work had to satisfy some originality standard in order to enjoy copyright protection was probably the 1741 *Pope v. Curll.* When arguing the question of whether copyright

American jurists started tackling the issue in the nineteenth century the concept of originality in copyright law was still in its formative era. As the figure of the genius author was at the heart of American copyright discourse right from its inception, at least on the level of general justifications, it is not surprising that when cases began streaming to the courts interested parties started to use and tired to manipulate arguments about originality.

In this context too it was Story's early decisions that paved the way and shaped the basic attitude that would be followed. When faced with arguments that plaintiff's work was not new and original and hence was not entitled to copyright, Story did not flatly deny that some degree of novelty was required. Instead he defined the requirement in minimalist terms. "The question is not, whether the materials which are used are entirely new, and have never been used before," he wrote in *Emerson v. Davies*, "[t]he true question is, whether the same plan, arrangement and combination of materials have been used before for the same purpose or for any other purpose."[318] In other words, at the same time that Story was beginning to expand what constituted a "copy" for the purposes of infringement as to cover many derivative forms, he constructed a very low hurdle of transformative character that a copyrighted work had to pass in order to be considered new and original. The conventional historical narrative focuses on the connection between the image of the romantic author as a creator ex nihilo and the expansion of copyright protection. Yet Story's ruling on the issue of originality supplied the exact mirror image of authorship. His description of the author was one of an anti-hero- an antithesis of the

protection encompassed letters, the defendant invoked a version of an originality as merit standard. He claimed that "this is the sort of work which does not come within the meaning of the act of Parliament, because it contains only letters on familiar subjects, and inquires after the health of friends, and cannot properly be called a learned work." Chancellor Hardwick, rejected this argument by describing the letters as meeting a substantive merit criterion: "It is certain that no work have done more service to mankind, than those which have appeared I this shape, upon familiar subjects, and which perhaps were never intended to be published; and it is this makes them so valuable; for I must confess for my own part, that letters which are very elaborately written, and originally intended for the press, are generally the most insignificant, and very little worth any person's reading." 2 Atk. 342-343, 26 Eng. Rep. 608.

[318] 8 F. Cas. 618-619. For an early example of elaborating a minimal standard of originality see also Justice Taney's opinion in: Reed v. Carusi, 20 F. Cas. 431 (C.C.D.Md. 1845).

romantic vision. Story's minimal standard of originality was grounded in a vivid and elaborated image of authorship as a cumulative dialogical process which always draws on preexisting sources and almost never creates anything which is thoroughly new:

> "In truth, in literature, in science and in art, there are, and can be, few, if any, things, which, in an abstract sense, are strictly new and original throughout. Every book in literature, science and art, borrows, and must necessarily borrow, and use much which was well known and used before. No man creates a new language for himself, at least if he be a wise man, in writing a book. He contents himself with the use of language already known and used and understood by others. No man writes exclusively from his own thoughts, unaided and uninstructed by the thoughts of others. The thoughts of every man are, more or less, a combination of what other men have thought and expressed, although they may be modified, exalted, or improved by his own genius or reflection. If no book could be the subject of copy-right which was not new and original in the elements of which it is composed, there could be no ground for any copy-right in modern times, and we should be obliged to ascend very high, even in antiquity, to find a work entitled to such eminence. Virgil borrowed much from Homer; Bacon drew from earlier as well as contemporary minds; Coke exhausted all the known learning of his profession; and even Shakespeare and Milton, so justly and proudly our boast as the brightest originals would be found to have gathered much from the abundant stores of current knowledge and classical studies in their days. What is La Place's great work, but the combination of the processes and discoveries of the great mathematicians before his day, with his own extraordinary genius? What are all modern law books, but new combinations and arrangements of old materials, in which the skill and judgment of the author in the selection and exposition and accurate use of those materials, constitute the basis of his reputation, as well as of his copy-right? Blackstone's Commentaries and Kent's

> Commentaries are but splendid examples of the merit and value of such achievements."[319]

I quoted in length, because this argument stands in such a stark contrast to the vision of the romantic author that according to common wisdom is supposed to dominate copyright discourse during this period. In fact, it bears a striking resemblance to modern critiques of copyright's reliance on conceptions of romantic authorship.[320] Story's views on this issue were well arrayed. Six years earlier, in *Gray v. Russell* he used almost the same prose in the same context of the question of originality.[321] Later commentators and judges picked on this image of authorship and cited it frequently when discussing originality.[322]

Does this mean that the historical narrative of copyright and romantic authorship is utterly wrong? Not necessarily. The emerging framework of copyright doctrine was simply more complex than a one dimensional focus on romantic authorship. It had many facets, as well as internal tensions. Copyright discourse drew on the image of the romantic author in some contexts, and was focused on its antithesis in others. Copyright law became doubly schizophrenic in this way. One divided consciousness was that of the treatment of originality and authorship in the context of infringement as opposed to their interpretation in regard to the standard of originality required for a valid copyright. Another was the very rise of the prerequisite of originality and the tendency to emphasize originality as the essence of authorship and copyright, contrasted with the simultaneous process of emptying the requirement of originality of almost any viable content.

Curtis' 1847 discussion of originality demonstrates both phenomena. He started his discussion by explaining that copyright was based on authorship and that "the writer cannot have been the author of what he has borrowed from another."[323] In other words, the concept of an "Author… ex

[319] 8 F. Cas. 619.

[320] The metaphor of "no man creates his own language" is especially striking. One needs to resort here to only a slight measure of anachronism in order to say that Story is arguing in the terms of the of the twentieth century linguistic turn.

[321] 10 F. Cas. 1038. See also: Story, *supra* note 29, at 243.

[322] See for example: Curtis, *supra* note 31, at 170-171, 179-180; Drone, *supra* note 31, at 198-199.

[323] Curtis, *supra* note 31, at 169.

termini imports originality."[324] However, when Curtis started discussing the meaning of such originality he stated very clearly: "The law does not require that the subject of a book should be new, or that the materials of which it is composed should be original."[325] Curtis was constructing an originality requirement which did not require originality! What then was the criterion for authorship? "[T]he true inquiry," Curtis wrote, "is whether the claimant's book contains any substantive product of his own labor?"[326] Curtis created a theory of copyright that purged out the criterion of novelty and relied exclusively on individual mental labor, what would be later called the sweat of the brow theory. Thus he concluded that the rules of copyright "must include in their range everything that can be justly claimed as the peculiar product of individual efforts."[327]

The exclusive reliance on mental labor assisted in creating an originality criterion with no traces of a novelty requirement. Yet this aggravated the other schizophrenia of copyright law: the diametrically opposed treatment of originality for the purposes of infringement and for determining the validity of the original right. Derivative and transformative works of various kinds were increasingly treated as being copies of a copyrighted work. Yet the copyrighted work was considered original even if it was heavily based on prior works. Indeed, Curtis' analysis included as original works for purposes of copyright protection all the categories of derivative uses that he worked so hard to reinterpret as mere copying in his chapter on infringement. He explained that abridgments and translations, which involved independent labor, were certainly original works entitled to copyright as long as what was abridged and translated was not itself protected.[328] If the sole focus on mental labor eased the tension between the rising requirement of originality and the drive to vacate it from any demand of novelty; it also highlighted the double standard applied to questions of originality of the protected work and to inquiries about infringement.

It would be inaccurate, however, to conclude that the doctrine of originality was utterly purged of any traces of novelty. Alongside narrow interpretations like Story's, and flat denials like Curtis', there survived

[324] *Id.*, at 169, note 1.

[325] *Id.*, at 173.

[326] *Id.*, at 173-174.

[327] *Id.*, at 172.

[328] *Id.*, at 186-192.

persistently an opposite strand of cases and interpretations which refused to let novelty perish. The 1850 *Jolly v. Jaques* is probably a product of a period in which the question of originality was still quite open, and the view that put the emphasis on novelty was still an equal rival to the Story-Curtis interpretation, rather than a subversive substratum. The elaboration of the originality requirement in the case is striking, because it seems to go beyond mere novelty to require the equivalent of what in patent law came to be known as non-obviousness. From this perspective, the originality requirement could not be satisfied by the mere fact that a work was new. Rather the work had to present qualities of genius beyond mere "mechanical" skills of adaptation and rearrangement. The court in *Jolly* denied copyright protection to a musical work that was adapted from a German composition, explaining that:

> "The musical composition contemplated by the statute must, doubtless be substantially new and original work; and not a copy of a piece already produced, with additions and variations, which a writer of music with experience and skill might readily make."[329]

This was not a "confusion" of copyright law with patent law. It was an attempt to invent a criterion of non-obviousness in copyright, more or less around the same time that it was invented in patent law.[330] Indeed, the writer of the *Jolly* opinion was no other than Justice Nelson who wrote the *Hotchkiss v. Greenwood* decision, that later became the canonical non-obviousness requirement precedent in patent law.[331] Yet in contrast to patent law, this attempt never succeeded in the context of copyright. It was engulfed by the rising tide of minimizing the requirement of originality.

Nevertheless, even in the post-bellum era when the main path of copyright was already set toward a minimalist originality requirement, a strong counter theme survived. The best example is the *Trademark Cases*[332] in which the Supreme Court struck down as unconstitutional the first federal trademark statute. Dealing with the attempt to base the Congressional power to legislate in the field of trademarks on the intellectual property clause of the Constitution, Justice Miller explained that due to the reference of the clause

[329] Jollie v. Jaques, 13 F. Cas. 910, 914-915 (S.D.N.Y. 1850).

[330] See *infra* Chapter 4, Sec. B(2)(b).

[331] 52 U.S. 248 (1851).

[332] 100 U.S. 82, 94 (1879).

to "inventors" and "authors," "originality is required." Thus he found that "while the word writings may be liberally construed" it covered only works "such as are original, and are founded in the creative powers of the mind."[333] The conclusion was that the lack of originality and novelty requirements took the trademark out of the constitutional scope of copyright (and patent) protection:

> "The writings which are to be protected are the fruits of intellectual labor. The trade-mark may be, and generally is, the adaptation 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 mere adoption. By the act of Congress this exclusive right attaches upon registration. But in neither case does it depend upon novelty, discovery, or any work of the brain. It requires no fancy or imagination, no genius, no laborious thought."[334]

Miller's formula entangled the notion of intellectual labor with that of novelty. It did not only refuse to dispense with a grain of a novelty requirement no matter how "liberally construed," but it also fixed it on the constitutional level as a limitation on the very power of Congress.

These two conflicting strands of thought defined the structure of originality doctrine as it consolidated during the late nineteenth century. The dominant trend was to radically minimize any requirement of novelty as a prerequisite of copyright protection. Nevertheless, this purge was never complete. There survived a substratum in copyright thinking that insisted on some degree of novelty as an indispensable fundamental of the right. While originality as novelty had little practical bite in most cases, the principle was always viable, lurking just beyond the corner, providing opportunities, and sometimes successfully employed.

Drone's 1879 treatment of originality followed these lines. Drone started his discussion with a sweeping declaration about the role of originality in copyright, only in order to deprive it of most of its operative significance in the following pages. "The rule has been laid down and universally recognized," he opened the section, "that originality is an essential attribute

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[333] *Id.*

[334] *Id.*

of copyright in literary composition."[335] This, however, was immediately followed by the usual assertion that originality in the legal sense involved little of its "popular" meaning:

> "… the law does not require that a person, to be entitled to copyright, shall be the sole creator of the work for which protection is claimed. Labor bestowed by one person on the production of another, if no rights are invaded, will often constitute a valid claim for copyright. The maker of an abridgment, dramatization, digest, index, or concordance of a work of which he is not the author, may obtain a copyright for the product of his own labor and skill. So, also, any one, by making material changes, additions, corrections, improvements, notes, comments &c. in the unprotected work of another may create a valid claim for copyright in a new and revised edition."[336]

In short, Drone explained that originality did not mean novelty and it did not preclude the copyrighting a whole range of derivative works that came to be interpreted as mere "copies" in the context of infringement. Drone followed Curtis in concluding that "the true test of originality is whether the production is a result of independent labor or of copying."[337]

To some extent the independent labor criterion was helpful in maintaining an originality doctrine while purging it of any novelty requirements. Originality came to mean merely independent labor rather than "copying," even if the outcome of such labor was very similar to existing works. This reinterpretation of originality seems closely connected to the copyright rule, according to which substantial similarity or even identity to an existing work constitutes neither infringement nor lack of originality, as long as the subsequent work was created independently and involved no copying. This rule, which came to be one of the fundamental principles of copyright doctrine and a major difference between copyright and patent law, did not exist in the early days of copyright. It started appearing in the nineteenth century,[338] and came to be generally accepted at the same period when the reinterpretation of originality consolidated. As late as 1910, though somewhat

[335] Drone, *supra* note 31, at 198.

[336] *Id.*, at 200.

[337] *Id.*, at 208.

[338] Blunt v. Patten, 3 F. Cas. 763, 764-765 (S.D.N.Y. 1828)

exceptionally, one court could still rule that substantial similarity constituted infringement even in the absence of copying.[339] By the late nineteenth century, however, it became a common sense assertion that a patent constitutes a broad monopoly by protecting against similar independent invention while copyright protects only against copying. Conceptually, this break was closely related to the fact that patent law discourse remained strongly focused on novelty as a fundamental trait of the protected invention, while copyright thought shifted the focus of originality from novelty to independent labor.

The independent labor criterion, despite its usefulness, could not easily solve all the dilemmas faced by the doctrine of originality. As long as independent creation was involved, the independent labor criterion worked reasonably well in replacing any resort to novelty. But what about all the cases of derivative works such as translations and adaptations that commentators were struggling to interpret as satisfying the originality requirement? Here the distinction between copying and independent labor was not as bright-lined as in other contexts. The similarity of derivative works of this kind to the original necessarily derived to some extent from direct copying. How could one say, under such circumstances what was an independent work involving independent labor and what was copying? Drone struggled with the question in various specific contexts. His answers, smuggled in through the backdoor some of the novelty criterion he was trying to eliminate from the doctrine of originality. Thus according to Drone, in the case of abridgment "the question is whether the maker has fairly condensed the matter of the original, and reproduced it as a work of his own authorship, or whether he has merely shortened it;"[340] a dramatization is original if it has "a value due to the work of the dramatist, and not found in the novel or poem dramatized;"[341] and a compilation "must have a material value not found in the parts taken separately."[342] In such cases, where reliance on a previous work was a given, independent labor could only be defined and distinguished from copying by resorting to the novelty of the outcome. As a result some traces of the novelty criterion that Drone worked so hard to banish from the doctrine of originality remained hidden with it. This was again the same

[339] Hein v. Harris, 183 F. 107, 108-109 (2nd Cir. 1910). At times the opinion seems to blur the distinction between the question of independent creation and that of intention to copy.

[340] Drone, *supra* note 31, at 201.

[341] *Id.*

[342] *Id.*, at 204.

general pattern: originality doctrine was vacated of a novelty requirement, but never in a complete or total manner.

b. Originality as Merit

The treatment of the second possible meaning of authorial originality as substantive merit followed a similar pattern. The bold declarations in treatises about originality as the foundation of authors' copyright were closely followed by flat denials that originality entailed any requirement of substantive merit or quality of the protected work. Curtis explained in 1849 that "[t]he mere utility of a book, or its adaptation to the end which it professes to answer- its value in a critical point of view- cannot determine its legal originality." If the romantic ideology of authorship closely associated originality with genius, jurists worked hard to sever any such connection in legal doctrine. In the first half of the century Story was developing an explicit content-neutrality criterion to govern copyright law. In *Emerson v. Davies* he wrote:

> "I must confess, that it strikes me that the plaintiff's method is a real and substantial improvement upon all the works which had preceded his, and which have been relied on in the evidence; but whether to be better or worse is not a material inquiry in this case. If worse, his work will not be used by the community at large; if better, it is very likely to be so used. But either way, he is entitled to his copy-right, 'valere quantum valere potest.'"[343]

In a parallel move to his patent law decisions, Story worked hard to destroy any notion that a valid copyright depended on any value judgment regarding the quality of the work protected. Legal doctrine was being purged of any reliance on objective merit. The alternative mechanism that was assigned the task of allocating rewards came to be the market. A work, Story wrote, "may be more useful or less useful," but the only effect would be to "diminish or increase the relative values of… works in the market."[344] From Story's perspective the author received his reward not on the basis of any objective evaluation of his work, but rather as he wrote in *Davies* he was "entitled to

[343] 8 F. Cas. 620-621.

[344] *Id.*, at 620.

his copy-right, 'valere quantum valere potest"- meaning, as much value as he can get. The market, in this vision, was the only judge of merit and the sole allocator of value.

This dual drive toward content neutrality and a market definition of value gradually came to dominance in nineteenth century copyright discourse about originality. There was, however, an opposite trend of cases which consistently refused to empty copyright of any reliance on objective merit of the protected work. In 1829 Justice Thompson presented a vision of copyright which stood in sharp contrast to the one that would be elaborated by Story a few years later. In *Clayton v. Stone* Thompson denied protection to a daily "price current." Explaining that "[t]he literary property intended to be protected by the act" should be determined by "the subject-matter of the work," he concluded that "the price-current cannot be considered a book within the sense and meaning of the act of congress."[345] Thompson did not advocate a view according to which the court had to evaluate the literary merit of a work in each specific case, but relying on the constitutional and statutory reference to authors he singled out certain categories of works as being outside the scope of copyright protection:

> "The act in question was passed in execution of the power here given, and the object, therefore, was the promotion of science; and it would certainly be a pretty extraordinary view of the sciences to consider a daily or weekly publication of the state of the market as falling within any class of them."[346]

Some of the objection derived from describing the publication as one of "fugitive a form… the subject-matter of which is daily changing, and is of mere temporary use." But Thompson also appealed directly to the fact that "[t]he title of the act of congress is for the encouragement of learning… and was not intended for the encouragement of mere industry, unconnected with learning and the sciences."[347] The mere industry/learning distinction appealed to a standard of originality as some minimal literary or "scientific" merit, one that could not be met by a mere price list which "must seek patronage and protection from its utility to the public and not as a work of science."[348]

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[345] Clayton v. Stone, 5 F. Cas. 999, 1000 (S.D.N.Y. 1829).

[346] *Id.*, at 1001

[347] *Id.*

[348] *Id.*

Thompson refused to abandon all judgments of value to the market. In his scheme, at least some categories of works lacked any basic merit as literary works and hence could not enjoy protection, no matter how popular they were in the market.

The tale of nineteenth century copyright law was that of a consistent retreat of Thompson's view and the ascendancy of Story's, yet, never in a complete or total fashion. Pushed to the margins though they were, some traces of the originality as merit conception continued to survive. Drone's 1879 discussion of literary merit and quality, demonstrates this pattern. He started by attacking Thompson's opinion in *Clayton* explaining that "a more liberal doctrine now prevails."[349] According to Drone, copyright now covered previously controversial subject matter such as directories, calendars, catalogs, statistics, tables of figures and collections of legal forms. In short, "the requirements of the law to the importance or value of a production are so slight that valid copyright will attach to almost any publication, and to many that appear to be of little or no consequence."[350] That was the dominant drive of emptying originality of any meaningful content, to the extent that any publication would qualify as original. At the very same sentence, however, Drone refused to dispense with originality altogether. "[N]ot every collection of printed words or sentences is entitled to protection," he wrote. Instead, "[t]o be worthy of copyright a thing must have some value as a composition sufficiently material to lift it above utter insignificance and worthlessness."[351] Drone's analysis captured the spirit of copyright's originality discourse during the late nineteenth century. At the very same breath he reduced it almost to nothing, and yet insistently refused to let it go.

Copyright case law reflected the same pattern. Even after Story's decisions there was a viable line of cases in which judges refused to extend copyright protection to subject matter they saw as lacking any creative or substantive merit. Justice McLean denied in 1848 copyright protection to labels.[352] In 1891 the Supreme Court upheld this precedent. Justice Field declared that "[t]o be entitled to a copyright the article must have by itself some value as a composition, at least to the extent of serving some purpose other than mere advertisement or designation of the subject to which it

[349] Drone, *supra* note 31, at 210.

[350] *Id.*, at 211.

[351] *Id.*

[352] Scoville v. Toland, 21 F. Cas. 863 (C.C.D.Oh. 1848).

attached."[353] He found that labels "have no value separated from the articles, and no possible influence upon science or the useful arts."[354] A similar line of precedents denied protection to advertisements and commercial catalogues. In *J.L. Mott Iron Works*, for example, the court stated that the copyright law "sought to stimulate original investigation whether in literature, science or art, for the betterment of the people."[355] It found that plaintiff's "work" was "a mere priced catalogue illustrated with pictures of wares offered for sale"[356] and hence denied protection.

The 1867 *Martinetti v. Maguire*[357] is a striking illustration of the continuing willingness of some courts to reject complete content-neutrality and engage in at least some aesthetic and moral evaluations of works. In its opinion the court described the play at issue as follows: "a mere spectacle - in the language of the craft a spectacular piece. The dialogue is very scant and meaningless, and appears to be a mere accessory to the action of the piece - a sort of verbal machinery tacked on to a succession of ballet and tableaux. The principal part and attraction of the spectacle seems to be the exhibition of women in novel dress or no dress, and in attractive attitudes or action. The closing scene is called Paradise, and as witness Hamilton expresses it, consists mainly 'of women lying about loose'- a sort of Mohammedan paradise, I suppose, with imitation grottos and unmaidenly houris."[358] "To call such a spectacle a 'dramatic composition'," it concluded, "is an abuse of language, and an insult to the genius of the English drama. A menagerie of wild beasts, or an exhibition of model artistes might as justly be called a dramatic composition. Like those, this is a spectacle, and although it may be an attractive or gorgeous one, it is nothing more."[359] Therefore the court found that such a work was not "entitled to the protection of the copyright

[353] Higgins v. Keuffel, 140 U.S. 428, 431 (1891).

[354] *Id.*, at 431.

[355] J.L. Mott Iron Works v. Clow, 82 F. 316, 319 (7th Cir. 1897).

[356] *Id.*, at 318. See also: Baker v. Selden, 101 U.S. 105-107.

[357] 16 F. Cas. 920 (C.C.Cal. 1867). See also Barnes v. Miner, 122 F. 480, 492 (S.D.N.Y. 1903) ("Society may tolerate and even patronize such exhibitions, but Congress has no constructional authority to enact a law that will copyright them, and the courts will degrade themselves when they recognize them as entitled to the protection of the law").

[358] 16 F. Cas 922.

[359] *Id.*

act."[360] Moreover the court went a step further and argued that even if Congress wanted to extend copyright to such works it had no power to do so, since "[t]he exhibition of such a drama neither 'promotes the progress of science or useful arts,' but the contrary. The constitution does not authorize the protection of such productions."[361]

At the same time that such decisions were issued, however, originality as merit was on constant retreat. Commentators and courts were drifting toward a market definition of the required value of the work, which constantly eroded the creative merit requirement. In 1894 one court supplied a lucid elaboration of the market definition of value:

> "… neither courts nor jurors have any certain rule for valuing it, except such as comes from evidence of effect which the composition in question has on masses of man. The claim made by the defendant that 'the box-office value' fails to furnish any test under the copyright laws of the United States, with reference to dramatic compositions, is not sustainable… with reference to matters like this at bar, touching which there are no rules except in the unmeasured characteristics of humanity, their reception by the public may be the only test on the question of insignificance or worthlessness under the copyright statutes."[362]

Once the only criterion of originality came to be identified with market value in this way, there was little left of it. The court was quick to quote from Drone an argument that became a lawyers' favorite: "If it has merit and value enough to be the object of piracy, it should also be of sufficient importance to be entitled to protection."[363] From this perspective whatever got copied, by definition, satisfied the merit requirement- now defined as a market demand requirement- and hence was protected.

Two famous Supreme Court decisions nicely demonstrate the dynamics of eroding the originality requirement around the turn of the nineteenth

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[360] *Id.*

[361] *Id.*

[362] Henderson v. Tompkins, 60 F. 758, 763-764 (C.C.D.Mass. 1894).

[363] *Id.*, at 765.

century. As Peter Jaszi observed *Bleistein v. Donaldson Lithographic Co.*[364] and *Burrow-Giles Lithographic Co. v. Sarony,*[365] which are often presented as part of the same historical trend of expansion of the scope of copyright, were in fact based on markedly different vocabularies and modes of justification.[366]

The 1883 *Burrow-Giles* was a constitutional challenge to the statutory expansion of copyright protection to photographs. The main basis of the challenge was the argument that a photograph was "not the production of an author"- to which the constitutional language limited copyright protection. A photograph, the argument went, was not the same as the traditional subject matter of copyright "in which there is novelty, invention, originality."[367] Instead it was "the mere mechanical reproduction of the physical features or outlines of some object animate or inanimate, and involves no originality of thought or any novelty in the intellectual operation connected with its visible reproduction in shape of a picture"[368]

Justice Miller rejected this defense in the case before him, but his opinion was far from an outright rejection of the originality criterion that the argument suggested and from an unequivocal turn to content neutrality and a market definition of value. Miller faced the argument that "the process is merely mechanical, with no place for novelty, invention or originality. It is simply the manual operation, by the use of these instruments and preparations, of transferring to the plate the visible representation of some existing object."[369] He replied in the following way: "This may be true in regard to the ordinary production of a photograph, and, further, that in such case a copyright is no protection. On the question as thus stated we decide nothing."[370] In other words Miller was willing to accept in dictum not only the doubts regarding the constitutionality of sweeping copyright protection to all photographs, but also a meaningful originality requirement as the foundation of copyright protection. Moreover, he argued that an originality criterion was even more fundamental and stringent in the case of copyright

[364] 188 U.S. 239 (1903).

[365] 111 U.S. 53 (1883).

[366] Jaszi, *supra* note 316.

[367] 111 U.S. 59.

[368] *Id.*

[369] *Id.*

[370] *Id.*

than in that of patents. "Our copyright system," he wrote, "has no such provision for previous examination by a proper tribunal as to the originality of the book, map, or other matter offered for copyright." And hence "It is, therefore, much more important that when the supposed author sues for a violation of his copyright, the existence of those facts of originality, of intellectual production, of thought, and conception on the part of the author should be proved, than in the case of a patent right."[371]

The photograph at issue was entitled to protection, Miller ruled, only because under the particular circumstances of the case it satisfied such a stringent originality criterion. He quoted from the findings of the trial court which described the photograph and its creator in terms taken right out of the jargon of romantic authorship:

> "… it is a 'useful, new, harmonious, characteristic, and graceful picture, and that plaintiff made the same . . . entirely from his own original mental conception, to which he gave visible form by posing the said Oscar Wilde in front of the camera, selecting and arranging the costume, draperies, and other various accessories in said photograph, arranging the subject so as to present graceful outlines, arranging and disposing the light and shade, suggesting and evoking the desired expression, and from such disposition, arrangement, or representation, made entirely by plaintiff, he produced the picture in suit.'"[372]

Only because the photograph was "an original work of art, the product of plaintiff's intellectual invention, of which plaintiff is the author"[373] it was awarded protection.

This was very different from Story's insistence on avoiding merit judgments, and from the efforts of commentators to reduce the requirement of originality to almost negligible dimensions. *Burrow-Giles* is remembered today as establishing copyright protection of photography- a field that at the time was considered tainted with characteristics of a mechanical skill rather than those of an "art" and hence lacking in artistic merit. The decision, however, did so not by joining the rising trend of emasculating originality as a significant legal requirement for copyright. Rather, it was based on reading

[371] *Id.*, at 59-60.

[372] *Id.*, at 61.

[373] *Id.*

meaningful content into the originality requirement. While opening the door to a new controversial subject matter *Burrow-Giles* was, in fact, one of the best examples of a nagging obsession with originality that refused to disappear altogether, even when the main-stream of copyright discourse moved in the opposite direction.

The 1903 *Beilstein* case which involved the copying of circus advertisement posters invoked an even more entrenched tradition against the copyrightablity of subject matter lacking any substantive merit. As mentioned, the firmest line of nineteenth century cases where the originality as merit requirement thrived was that which denied protection to "mere advertisements." Thus there must have been little surprise when the trial court declared that "[t]he court cannot bring its mind to yield to the conclusion that such tawdry pictures as these were ever meant to be given the enormous protection."[374] Similarly, the plaintiff's strategy in the Supreme Court argument was not unlike that of Justice Miller in *Burrow-Giles*. Most of the energy in plaintiff's argument was spent on demonstrating that poster making "require[s] artistic ability, and above all things creativeness or originality of a high order," and that there "was abundant evidence of originality of design, of artistic merit, and of practical value and usefulness."[375]

Justice Holmes writing for the court took an entirely different tack in his opinion. Rather than trying to fit advertisement posters into the Procrustean bed of originality and artistic merit he launched a frontal attack on the criterion itself. Holmes started the decision with a description which appears to be taken directly from the vocabulary of romantic authorship. "The copy," he explained, "is the personal reaction of an individual upon nature. Personality always contains something unique. It expresses its singularity even in handwriting, and a very modest grade of art has in it something irreducible, which is one man's alone."[376] Yet even this bow in the direction of original authorship signified Holmes' pending attack on originality. Saying that the uniqueness of the creator's impression was just as present in very modest grades of art threatened to deprive originality of its traditional association with genius.

[374] 188 U.S. 241.

[375] *Id.*, at 243.

[376] *Id.*, at 250. This was the paragraph that led Benjamin Kaplan to conclude that Holmes's decision in Beilstein was influenced by the ideology of romantic authorship. See Kaplan, *supra* note 129, at 35.

The thrust of the opinion soon shifted to an all out assault on any requirement of originality as artistic merit. "A picture is none the less a picture," Holmes wrote, "and none the less a subject of copyright that it is used for an advertisement."[377] Here came Holmes' famous manifesto of content neutrality and a market definition of the work's value that picked up the trail exactly where Story had left it half a century earlier:

> "It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At the one extreme some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke. It may be more than doubted, for instance, whether the etchings of Goya or the paintings of Manet would have been sure of protection when seen for the first time. At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge. Yet if they command the interest of any public, they have a commercial value - it would be bold to say that they have not an aesthetic and educational value - and the taste of any public is not to be treated with contempt."[378]

This interwove an institutional capacity argument about judges as poor evaluators of artistic merit into an explicit market definition of artistic value. According to the latter anything that had commercial value also satisfied any legal requirement of merit. Hence Holmes concluded with the new lawyers' pet-argument: "That these pictures had their worth and their success is sufficiently shown by the desire to reproduce them without regard to the plaintiffs' rights."[379] In other words, whatever got copied was in demand and that was enough to satisfy any merit requirement. In Holmes' opinion the market was assigned the sole role of value evaluations in the copyright framework. If Miller in *Burrow-Giles* was striving to sustain a viable originality as merit criterion, Holmes in *Beilstein* was moving toward its eradication.

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[377] 188 U.S. 251.

[378] *Id.*, at 251-252.

[379] *Id.*, at 252.

That Holmes' move was, at least to some extent, a novelty which was not taken for granted in 1903 is apparent from the dissent of Justices Harlan and McKenna. The dissent, written by Harlan, was for the most part a quotation of the Circuit Court opinion. It found that "if a chromo, lithograph, or other print, engraving, or picture has no other use than that of a mere advertisement, and no value aside from this function, it would not be promotive of the useful arts, within the meaning of the constitutional provision"[380] and hence it would be awarded no protection. By declaring that a work "must have some connection with the fine arts to give it intrinsic value" it rejected the market definition of value and adhered to an objective merit standard. Harlan concluded that he is "unable to discover anything useful or meritorious in the design copyrighted by the plaintiffs" and with little effort to mask his contempt dismissed it as "a mere advertisement of a circus"[381] which is unworthy of copyright.

If the dissent in *Beilstein* may appear archaic to the modern copyright lawyer, it is exactly because she was initiated into the field long after the strand of thought epitomized by Holmes' opinion was victorious. At the time, however, the dissent was much better grounded in well established precedents, at least inasmuch as the specific context of advertisement was concerned. Holmes' majority opinion, on the other hand, was part of a rising tide in American copyright thought- the very one that soon would make the dissent seem archaic. Nevertheless, one should not overstate the totality of the transformation. While the drive toward content neutrality and the purging out of the objective merit criterion were very real and dominant, they were never complete. Rather than *Beilstein's* majority opinion alone, what captures the framework of turn of century copyright discourse is the dynamics between that opinion and the dissent and even more so the contrast between *Beilstien* and *Burrow-Giles*. Content neutrality and a market definition of value came to dominance, but in the margins of legal discourse there always stubbornly survived traces of preoccupation with substantive merit of the work as a prerequisite for copyright.

c. Originality as Ideology

What should one make of this odd pattern of originality discourse? Of the oddity of the very introduction of the previously non-existent originality

[380] *Id.*

[381] *Id.*, at 253.

requirement into nineteenth century copyright law accompanied by an immediate move toward vacating it of most of its viable content? Of the peculiarity of an unmistakably dominant trend toward content neutrality and a market definition of the work's value interlocked with a stubborn refusal to let go of the originality requirement altogether? The answer is that, very much like the idea/expression dichotomy, the doctrine of originality was constructed and functioned as a semi-ideological mechanism. Originality doctrine was the institutional space where the new focus of copyright on individual authorship was articulated. As Curtis observed authorship "ex termini imports originality."[382] The image of individual authorship, that by the end of the eighteenth century came to underlie copyright jurisprudence, defined originality. Originality, in turn, defined copyright. It did so by differentiating the proper subject matter of copyright- works that were worthy of protection- from other things. This maintained a thin crust of coherence between the fundamental justification or the public image of copyright and its legal doctrines. In a conceptual world that came to identify copyright with the protection of the genius author, to flatly deny all arguments about originality as a prerequisite for the right, would have created a serious and direct dissonance. This was the background of the nineteenth century rising preoccupation with originality in copyright jurisprudence.

At the same time, however, there were strong drives to expand the scope of copyrightable subject matter and to avoid circumscribing it to a relatively narrow zone of genuine original works of "high art" or even "learned works." Such reasons, ideological and economic, will be elaborated later. Suffice it to say here, however, that this combination of clinging to individual authorship as the foundation of copyright and a constant drive to expand the coverage of protection accounts for the peculiar ideological character of originality doctrine. On the one hand, the doctrine trumpeted originality as the sine-qua-non of copyright. It had a very minimal operative content, on the other. Holmes' opinion in *Beilstein* was a masterpiece of manipulating this ideological character of the doctrine. The opinion quickly moved from a declaration about the unique irreducible impression of personality in every original creation to a definition of the work as anything that has market value. It mobilized the image of the genius creator by appealing to Degas and Rembrandt, Goya and Mannet while at the same time eradicating any prerequisite of aesthetic value for copyrightability. In short the opinion flaunted the image of the genius original author as the overarching principal of copyright, while shaping and bending actual doctrine in exactly the opposite direction.

[382] Curtis, *supra* note 31, at 169 note 1.

The same analysis applies to the stubborn insistence of judges and commentators on not putting originality doctrine to rest even when its initially minimal content was further eroded by the turn of the century, when previously excluded categories of works came to be protected. The original and the non-original was the binary opposition by reference to which copyright was defined and legitimized even when in practice the latter pole of the opposition kept shrinking. Still, it would be inaccurate to say that originality doctrine had absolutely no effect in practice. In this sense it was only semi-ideological. The doctrinal requirement, with all the narrow and disabling interpretation it received, survived. As a practical rather than a rhetorical tool, it remained in the periphery of copyright law, ready to be pulled out, used and to exert actual operative effect in specific opportunities.

5. Copyright at the Dawn of the Twentieth century

By the turn of the twentieth century copyright law had undergone a century of profound transformation. To say that in 1900 the development of copyright came to an end or that no significant changes happened since then would be almost as misguided as the originalist narrative that placed the end point at the late eighteenth century. Nevertheless, by that time the structure of American copyright law came to incorporate most of the fundamental forms and components which still dominate the field today. A modern copyright lawyer who is quite likely to be at loss in the face of late eighteenth century American copyright discourse (unless she is armed with an especially large caliber version of the lawyer's conventional weapon for such cases: anachronism) would feel almost at home in the conceptual environment of 1900.

As this chapter demonstrated there are four major fundamental components of modern copyright law which consolidated during the nineteenth century. These can be understood as four interrelated and mutually reinforcing transformations. First, copyright was converted from a particularistic and trade specific economic regulation to a general wide-encompassing field based on the abstract overarching principle of protection of original creative works. If in 1800 copyright was still the exclusive affair of the book trade, in 1900, at least as a conceptual matter, it encompassed a wide variety of media and exhibited general flexibility and receptiveness to accommodate new ones that seemed susceptible to being governed by the abstract principles of the field. Second, the object of protection transformed from the "copy" into the "work." This meant that the older notion of the protected object of the right as a particular combination of signs or

expressions was supplanted by the more abstract and less stable conception of the work as an elusive postulated intellectual entity that covers many concrete forms. Third, the understanding of the right itself changed from the narrow notion of the exclusive privilege to print or to create verbatim copies to the much broader idea of ownership as general control. Rhetorically, this transformation often involved arguments about copyright as absolute control of all aspects of the work. In practice, however, the new understanding of ownership was usually manifested in the less radical form of a bundle of rights, that is to say an amalgamation of entitlements which allowed substantial control of different aspects and uses of the work, rather than absolute control of all aspects. Fourth, copyright doctrine came to incorporate as a fundamental defining component a previously non-existent legal requirement of originality as well as a complex and intricate structure to the meaning of such requirement.

These four features that distinguish modern American copyright law from the late eighteenth century framework are best understood not in static terms but rather as semantic centers around which many competing views, arguments and meanings have emerged. None of these four components had one stable and completely determinate meaning. Instead, right from their inception onward each of them involved a cluster of debates, tussles and conflicting interpretations. Thus, for example, although copyright ceased being the exclusive affair of the book trade, the exact scope of the proper subject matter and media protected by copyright continued to be a fluid and sometimes controversial matter. The concept of the work as well as that of the owner's entitlements have been an endless source for conflicting interpretations and debates. Similarly, originality doctrine was subjected to various elaborations and its rhetorical and practical significance fluctuated over time. Nevertheless, despite this multiplicity of meanings and indeterminacy, these four elements served as common foci for the organization of the field. They were the centers around which debates and conflicting views were constructed and taken place. It is in this sense that the conceptual structure that consolidated at the late nineteenth century persisted with minor changes for almost a century. Only by the last part of the twentieth century new technologies for the creation and dissemination of intellectual works accompanied by related social developments would start to fundamentally shake the core of some of these structures.