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HOISTING ORIGINALITY: A RESPONSE

By Roberta Rosenthal Kwall*

This commentary originally appeared as part of the inaugural Virtual Workshop sponsored by the Intellectual Property Institute at the University of Richmond School of Law. The workshop featured a paper entitled *Hoisting Originality* by Professor Joseph Miller, along with two commentaries on the paper.¹ When Professor James Gibson of University of Richmond Law School invited me to comment on Miller's work, he mentioned that this was a paper about which I would want to think deeply, and Professor Miller's paper certainly lives up to this representation.

In *Hoisting Originality*, Miller argues that the current statutory copyright standard for originality does not do the job, and proposes instead that copyright "draw on patent law's nonobviousness requirement—with its focus on departure from conventional wisdom as the mark of a protectable invention"² Thus, Miller's recommendation would call for an assessment of whether a given work embodies a unique authorial voice that "stands apart from conventional expression."³ The "creative" aspect of originality, according to Miller, should be judged by whether it reflects "the unconventional, the unpredicted, the unorthodox."⁴

The problem, as we all know, is that copyright has developed in ways that were not imaginable during the last go-round of reform discussions in the middle of the twentieth century. For years now, intellectual property scholars have proposed a multitude of cures for a system that is generally perceived as increasingly ailing and ineffective. It makes sense that originality should be part of this discussion. Miller reads my own work on originality and moral

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1. The idea of a virtual workshop, complete with widespread virtual participation beyond that of the initial contributors, is a wonderfully different idea and I thank Professor James Gibson of Richmond for inviting (and encouraging) me to participate and for pairing me with Professor Justin Hughes, a scholar for whom my personal respect is evident in so many of my own works.

2. Joseph Scott Miller, *Hoisting Originality*, 31 CARDOZO L. REV. 451, 463 (2009).

3. *Id.* at 477.

4. *Id.* at 484-85.

rights, *Originality in Context*,⁵ as an endorsement for keeping the current low standard of originality for copyright law but invoking a heightened standard of originality for purposes of our currently non-existent moral rights laws. In reality, however, my purpose in writing this article, as well as my forthcoming larger work on moral rights,⁶ was not to challenge the current standard of copyright originality but rather to devise an appropriate and viable standard for moral rights in the context of the *current* copyright law. In terms of Miller's suggestion that moral rights should be applied to works with lower originality than copyright law,⁷ this position would be inconsistent not only with the Berne Convention but also with virtually every other country with moral rights protections. Notable exceptions are two of the instruments composing the International Bill of Human Rights, which contemplate the extension of moral rights to non-copyrightable works.⁸ Nonetheless, for reasons I have explored in my other works, to the extent the United States contemplates the enactment of a more comprehensive form of moral rights protections than currently exists under VARA, I do not believe the best approach is to apply moral rights to a wider array of works than are currently covered under copyright law.⁹

My approach to moral rights does not, however, foreclose the question of whether copyright itself ought to be refashioned with a heightened standard of originality. In this respect, if given the opportunity to re-evaluate copyright's originality requirement, I would certainly be open to elevating the standard for copyright protection, especially if this were done as part of a larger effort of copyright reform on a more general basis. The need for increased attention to originality was, somewhat ironically, evidenced even during the relatively brief period we had to write our responses to Miller's article by the decision in *Situation Management Systems*,

5. Roberta Rosenthal Kwall, *Originality in Context*, 44 HOUS. L. REV. 871 (2007).

6. See ROBERTA ROSENTHAL KWALL, *THE SOUL OF CREATIVITY: FORGING A MORAL RIGHTS LAW FOR THE UNITED STATES* (forthcoming 2010).

7. Miller, *supra* note 2, at 494.

8. These instruments are the Universal Declaration of Human Rights and the International Convention on Economic, Social and Cultural Rights of 1966.

9. See *generally* KWALL, *supra* note 6.

Inc. v. ASP Consulting, LLC, a copyright infringement suit in which the First Circuit vacated the district court's finding of noninfringement on the ground that the training manuals at issue met the minimal originality standard.¹⁰

As Diane Zimmerman has reminded us, it makes sense to frame the issue of originality by addressing the values that copyright law protects; unfortunately, however, there is no one clear answer to this question.¹¹ We do know that the Framers were motivated by concerns regarding dissemination of knowledge and preservation of a public domain necessary to insure access to necessary information. Relevant to these concerns was the Framers' desire for the United States to be "culturally competitive" with other nations, a goal that could only be achieved through the enactment of copyright laws that would encourage authorship activity.¹²

As Miller notes, the concept of originality has captured significant scholarly attention.¹³ Most recently, copyright scholars have pondered whether a graduated system of originality is the best way to promote copyright's objectives.¹⁴ This view, if ever formally enacted, might result in a system of protection based on multiple levels of originality. Although such a content-specific system of protection may seem very remote, hints of this idea exist in proposed federal legislation that would afford a form of *sui generis*, or copyright-like, protection for the overall appearance of new and original fashion designs for a three-year period.¹⁵

10. *Situation Mgmt. Sys., Inc. v. ASP Consulting LLC*, 560 F.3d 53, 62 (1st Cir. 2009).

11. Diane Leenheer Zimmerman, *It's an Original! (?): In Pursuit of Copyright's Elusive Essence*, 28 COLUM. J.L. & ARTS 187, 189 (2005). See also Pamela Samuelson, *Enriching Discourse on Public Domains*, 55 DUKE L.J. 783 (2006)(identifying thirteen conceptions of the public domain).

12. Irah Donner, *The Copyright Clause of the U.S. Constitution: Why Did the Framers Include It with Unanimous Approval?*, 36 AM. J. LEGAL HIST. 361, 362 (1992).

13. Miller, *supra* note 2, at 462-463

14. See Gideon Parchomovsky & Alex Stein, *Originality*, 95 VA. L. REV. (forthcoming 2009) available at <http://ssrn.com/abstract=1361911>. The idea of a graduated system of originality also was a major theme in the informal discussion at the Interdisciplinary Intellectual Property & Technology Immersion Conference, in New York City (2006) (sponsored by Albany Law School).

15. Design Piracy Prohibition Act, H.R. 2033, 110th Cong. § 2 (2007); S.

I have written elsewhere that copyright ownership ought to be understood as involving “duties to the public as well as rights in the work,”¹⁶ and refining the originality requirement, either through a graduated system or a more unified “hoisted” framework as Miller proposes, fosters the idea that one’s rights should correspond to the level of one’s contribution. Moreover, I believe that “hoisting” the statutory originality requirement is a completely “kosher” approach from the standpoint of the history of copyright’s development. As William Patry has observed: “The *Feist* Court did not strip Congress of its voice on all originality issues; instead, the Court only set a threshold standard. Congress is free to set a higher standard, or, in protecting particular types of works, to declare how the originality requirement must be satisfied.”¹⁷

Additionally, Miller’s call for reforming copyright originality by invoking patent law’s standard is intriguing, at least on a superficial level. The Supreme Court has invoked patent law analogies in applying copyright law on at least two occasions—*Sony*’s “substantial non-infringing uses”¹⁸ and *Grokster*’s “inducement”¹⁹ applications. Nonetheless, the use of a patent law analogy in assessing the issue of contributory infringement does, at least in my mind, have a completely different feel from the invocation of a patent law analogy in the context of the fundamental issue of what type of subject matter ought to qualify for protection in the first place. As David Lange and Jeff Powell write, “the nature of the property interest at stake in copyright is substantially different from the more exclusive interest . . . in a patent.”²⁰ Miller recognizes this distinction, however, and qualifies his proposal by explaining that he does not recommend

1957, 110th Cong. § 2 (2007).

16. See Roberta Rosenthal Kwall, *The Author as Steward “For Limited Times,”* 88 B.U. L. REV. 685, 704 (2008).

17. See William Patry, *The Enumerated Powers Doctrine and Intellectual Property: An Imminent Constitutional Collision*, 67 GEO. WASH. L. REV. 359, 377 n.104 (1999).

18. *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 439-40 (1984). See also DAVID L. LANGE & H. JEFFERSON POWELL, NO LAW: INTELLECTUAL PROPERTY IN THE IMAGE OF AN ABSOLUTE FIRST AMENDMENT 53 (2009).

19. *MGM Studios, Inc. v. Grokster, Ltd.*, 545 U.S. 913, 935-36 (2005).

20. LANGE & POWELL, *supra* note 18, at 55.

that copyright adopt the same standard as patent law,²¹ but rather a “patent-inspired” one.²² He urges a standard that seems to be *informed* by patent law’s nonobviousness standard. As noted above, the essence of his position appears to be that unconventionality should be the new *sine qua non* of originality.

On a practical level, any reform of the originality requirement will necessitate a corresponding reform of the copyright registration system, an area Miller does not address in detail. The Copyright Office does not probe deeply into the status of a work’s originality: “The application form obliges the applicant to assure the Register under oath that the work is original, but as a rule no attempt is made to search probingly for evidence of prior works that might throw suspicion or doubt upon that assurance.”²³ Most copyright applications are approved.²⁴ This situation stands in stark contrast to that of patent registration procedure.

Another difficulty with Miller’s approach lurks on the cusp between its practical implementation and conceptual grounding. With respect to issues of proof, Miller seems to contemplate that originality can be proved both by prospective copyright owners in applying for a copyright²⁵ (thus raising the above issue regarding the examination procedure), as well as by accused infringers who must assemble a “rich factual record” showing conventionality in order to defend against an infringement claim.²⁶ At the trial level, it seems as though such a standard will inevitably foster expert witness battles regarding a work’s conventional nature within the genre at issue.

Moreover, it is not entirely clear to me whose narrative would govern whether a given work would meet this proposed originality standard. Miller appears to endorse a “*work-centered*” creativity assessment, based in part on the standard in *Burrow-Giles* rather than an “*author-centered* effort assessment.”²⁷ I wonder, however, whether these criteria are independent. For example, my read of

21. Miller, *supra* note 2, at 468

22. *Id.* at 464.

23. LANGE & POWELL, *supra* note 18, at 39.

24. *Id.*

25. Miller, *supra* note 2, at 486.

26. *Id.* at 487.

27. *Id.* at 475-76.

Burrow-Giles is that the Court was not impervious to “author-effort.” *Burrow-Giles* focused on the photographer’s pre-shutter staging of the process as the justification for originality, which made sense in terms of both the artistic view of photography prevalent at that time and the need for preserving the notion that post-shutter activities are free of artistic choice, and thus remain author-free and objective.²⁸ Christine Farley has observed that at the time of this decision, the prevailing view was that the image produced by photography was free of human intervention and, therefore, well-suited as objective evidence in legal disputes.²⁹ A focus on the photographer’s input as consisting of pre-shutter activity facilitated this conception.

More fundamentally, however, it is not clear to me why “the degree to which [a] work moves away from conventional expression for [a given] genre at the time the author authors it”³⁰ should be the key to originality. In fact, a recent paper by Amy Adler suggests the very problems inherent in this approach. Adler laments how moral rights regimes fail to recognize “the defining role that destruction has come to play in contemporary artistic practice.”³¹ Her work provides numerous examples of this “destruction art” which, in effect, challenge the application of the standard proposed by Miller. For example, in 1953 Robert Rauschenberg created “Erased de Kooning Drawing,” which consisted of nothing more than a month’s long effort by Rauschenberg erasing a drawing by Willem de Kooning, resulting in a “sheet of paper bearing the faint, ghostly shadow of its former markings.”³² Admittedly, this was an unorthodox and radical approach, given that de Kooning was regarded as an icon at the time of Rauschenberg’s endeavor. Adler notes that in this milieu, “erasing a drawing by de Kooning was a shocking, sacrilegious act” which “captured, perhaps better than anything else Rauschenberg did, his scandalous assault on a particular

28. See Christine Haight Farley, *The Lingering Effects of Copyright’s Response to the Invention of Photography*, 65 U. PITT. L. REV. 385, 437 (2004).

29. *Id.*

30. Miller, *supra* note 2, at 462.

31. Amy Adler, *Against Moral Rights*, 97 CAL. L. REV. 263, 265 (2009).

32. *Id.* at 283 (quoting CALVIN TOMKINS, OFF THE WALL 97 (1980)).

conception of ‘art.’”³³ Clearly Rauschenberg’s erasure would meet Miller’s proposed standard for originality. But the operative question is whether Rauschenberg’s “creation” *ought* to be regarded as more “original” for purposes of applying copyright’s protections than Miller’s own law review article, which he suggests (although perhaps with “tongue in cheek”) might not meet his proposed standard.

There are other complications inherent in the “unorthodox” standard that are also illustrated by the modern art genre. Returning to Adler’s discussion of Rauschenberg, Adler makes it clear that his erasure work was unorthodox in its time. Now, however, the concept of “destruction art” is ubiquitous in the world of contemporary art. Under Miller’s proposal, it is at least questionable whether the many such works that pervade the Chelsea galleries today would qualify as copyrightable subject matter because they are no longer seemingly “unorthodox.” A further problem, at least in the context of this particular genre, is whether even modern contemporary art visionaries would fail to meet Miller’s proposed originality standard because their unorthodox works consist almost entirely of labor and sweat, which *Feist* ruled out as a basis for satisfying the “modicum” of creativity necessary for originality.³⁴ Adler also writes about Damien Hirst, “the best-selling living artist,” who sought to produce the most expensive work of contemporary art by encrusting a skull with diamonds. This work was sold to an investor for a hundred million dollars.³⁵ Unorthodox? Of course! Would Miller say this satisfies his proposed standard for originality? If so, one has to wonder exactly what is being protected here—an original work of expression, a work of labor, or just an unorthodox idea? And how would appropriation art fare under Miller’s proposed standards? These questions illustrate that the lines of application and theory are easily blurred.

Notwithstanding these reactions to Miller’s articulated standard, it seems to me that an elevated standard for copyright originality has promise, and I have already laid the groundwork for how I could see this working in connection with my recommendations

33. *Id.* at 283.

34. *See Feist Publ’n Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 346 (1991).

35. Adler, *supra* note 31, at 298.

regarding enhanced moral rights protections.³⁶ Drawing on some of these prior observations, I recommend that we consider a statutory standard for originality that depends upon “substantial creativity.” I would also propose for consideration an amendment to the copyright statute that eliminates from coverage particular types of subject matter characterized by low levels of creativity, thus raising the bar in a transparent manner. Such statutory exclusions will not, however, address all of the originality issues, because cases will arise in which a work is otherwise covered from a categorical standpoint but lacks substantial creativity in its particular execution.

In these situations, courts (and perhaps copyright examiners in the first instance) will simply have to decide what constitutes “substantial creativity.” This should not be especially problematic in my view. In *Burrows-Giles*, the Supreme Court recognized that because copyright law lacks the patent system’s safeguard of a prior examination by an authoritative tribunal, it is more important in a copyright case for the author to prove originality.³⁷ So from an early point in time, courts were sensitive to the importance of how to prove originality in copyright law. I also want to emphasize that I agree with Miller’s point that the originality determination should not be made to depend entirely on the judge’s subjective perception. Moreover, his proposed “unconventionality” standard potentially has relevance to a determination of the requisite originality, although I see it as furnishing an incomplete basis for the standard’s articulation and application. I would prefer to see an approach that is more nuanced and capable of greater creativity in application. The beauty of copyright law, however, is that it already contains the seeds for how a substantial creativity standard of originality can be applied.

Thus, I would augment evidence of unconventionality with additional evidence focusing on the *author’s* narrative and the perceptions of *reasonable ordinary observers*. *Burrow-Giles* is an important precedent in this regard, because it focused on the narrative supplied by the photographer with respect to his actions in furtherance of pre-shutter, “composition-making” activity.³⁸

36. See KWALL, *supra* note 6, chapter 6.

37. *Burrows-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 59-60 (1884).

38. *Id.* at 60.

The importance of the claimant's narrative also is underscored by the line of decisions addressing the issue of conceptual separability, which, in assessing whether the design process reflects the creator's artistic judgment independent of functional considerations, requires the claimant to furnish "evidence relating to the design process and the nature of the work"³⁹ Such a test relies upon the sequences of the author's actions and decisions in the design process, but also leaves room to consider the nature of the work itself. In fact, I believe this type of evidence underscores Miller's inclination to equate creativity "with an author's thoughtful, considered engagement with the stuff of expression"⁴⁰ Unlike Miller, however, I do not understand this type of evidence to be limited to the objective character of the work.⁴¹

Moreover, in applying the above test for conceptual separability, some courts also have incorporated a focus on whether reasonable beholders of the work are able to conceptualize its artistic aspects as existing independently of function. The "ordinary reasonable observer" traditionally has been invoked to decide other conceptual issues in copyright law such as substantial similarity. Thus, there is no reason to preclude such evidence in determinations of originality, and the introduction of such evidence would serve as a useful counterpart to evidence based on the author's narrative and the work itself.

The beauty of our profession is that we continually have the opportunity to engage in the "circle" of creativity. The original Virtual Workshop in which both Professor Miller and I participated demonstrated the operation of this circle in a most compelling way. I would like to conclude by "hoisting" the level of originality of this commentary by doing something rather unorthodox insofar as the "reply/commentary" genre is concerned. Therefore, I dedicate this commentary to my dear friend and now former colleague, Kathy Strandburg, whom all of us at DePaul very much miss.

39. *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1145 (2d Cir. 1987).

40. Miller, *supra* note 2, at 479.

41. *Id.*

