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# DIGITAL PROPERTY/ANALOG HISTORY

*Susan Scafidi\**

## I. INTRODUCTION

Intellectual property law takes pride in its cutting-edge status, its central role in the Information Age. While traditional fields regulate the real and the concrete, intellectual property contemplates the virtual and the intangible. Its practitioners envision boundaries apart from the physical realm,<sup>1</sup> describe previously unknown creations of the human mind, and distinguish original promptings of genius from the routine and the derivative. The cultural significance and constructed nature of intellectual property are apparent in the public debates surrounding everything from health care-related patents to music file sharing. Intellectual property law is, in short, a twenty-first-century discipline, focused on the future of innovation.

The use of the past in American intellectual property jurisprudence, however, remains tethered to a view of history largely associated with the nineteenth century. As implicit in the constitutional justification for granting patents and copyrights, “[t]o promote the Progress of Science and useful Arts,”<sup>2</sup> the rhetoric of intellectual property resonates with what is critically termed the “Whig interpretation of history.”<sup>3</sup> This “winner’s history” approach

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1. See Michael A. Heller, *The Boundaries of Private Property*, 108 YALE L.J. 1163, 1174 (1999).

2. U.S. CONST. art. I, § 8, cl. 8.

3. HERBERT BUTTERFIELD, *THE WHIG INTERPRETATION OF HISTORY* (NORTON 1965) (1931). For alternative interpretations of the concept of “progress” in intellectual property law, see *Eldred v. Ashcroft*, 537 U.S. 186 (2003); Malla Pollack, *What is Congress Supposed to Promote?: Defining*

to historiography, which today functions as a dismissive epithet rather than a professional method, is characterized by a tendency “to emphasise certain principles of progress in the past and to produce a story which is the ratification if not the glorification of the present.”<sup>4</sup> Historians are warned to exercise caution not only with respect to anachronistic interpretation of the past, but also in regard to claims of linear, teleological movement and sequential improvement.<sup>5</sup> In other words, the historical profession has become skeptical of “progress.”

Intellectual property policy, by contrast, rests upon a faith in the novel and the original and a belief that their creation and dissemination can be harnessed to serve the public good. Such reflexive optimism defined the intellectual property realm in the early Republic, and continues to define it in our own era. The 1994 Agreement on Trade-Related Aspects of Intellectual Property (TRIPS), to date the most far-reaching international agreement on intellectual property, describes its objectives as follows: “The protection and enforcement of intellectual property rights should contribute to the promotion of technological innovation and to the transfer and dissemination of technology . . . in a manner conducive to social and economic welfare . . . .”<sup>6</sup> While neither the Constitution nor TRIPS assumes that the social benefits of innovation are self-executing, intellectual property jurisprudence displays a persistent confidence in the concept of societal improvement driven by the products of human creative endeavor—progress rather than mere change.<sup>7</sup> This socio-technological Darwinism forms the basis of legal policies that encourage and reward ever more innovation.

In addition to its perspective on “progress,” intellectual property jurisprudence operates via largely unquestioned assumptions regarding factual truth and objectivity. Agency in the creation of

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“Progress” in Article I, Section 8, Clause 8 of the United States Constitution, or Introducing the Progress Clause, 80 NEB. L. REV. 754 (2001).

4. BUTTERFIELD, *supra* note 3, at v.

5. *See id.*

6. Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, Legal Instruments – Results of the Uruguay Round, vol. 31, 33 ILM 1125, 1197 (1994).

7. *See, e.g.,* Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99 (1951).

intellectual property, for example, is assigned to a clearly defined realm of authors and inventors. American intellectual property law, particularly in the realm of patents, assumes its ability to recognize the first appearance of an invention or scientific publication.<sup>8</sup> Similarly, copyright and trademark both presume to distinguish copying from independent production.<sup>9</sup> Despite frequent examples of laboratories on different continents engaging in near-simultaneous Nobel prize-worthy invention, Hollywood movies from competing studios sharing markedly similar plots, or a plethora of companies attempting to register e- or i- trademarks in the late 1990s, the law crowns persons rather than cultural trends with the laurels of authorship. Rarely the result of historical reflection and perspective, the rewards of intellectual property protection instead arise at or near the birth of an apparently new creation.

This simple, linear approach to stories of creation is echoed in intellectual property law's treatment of works of history themselves. If historians merely collect and organize "facts" regarding the past and its march to the present, reasons the law, then works of history are entitled to extremely limited protection.<sup>10</sup> One court notes that "the scope of copyright in historical accounts is narrow indeed, embracing no more than the author's original expression of particular facts and theories already in the public domain . . . . [C]laims of copyright infringement where works of history are at issue are rarely successful."<sup>11</sup> While historians are engaged in active debate over the possibility of objectivity and the concept of truth in relating the past,<sup>12</sup> intellectual property jurisprudence depicts history as a science

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8. See 35 U.S.C. § 102 (2000) (setting forth novelty requirement for patentability).

9. See, e.g., *Alfred Bell*, 191 F.2d at 103 (1951) (noting that copyright protection is available even for an independently created work "completely identical with what went before"); Lanham Act § 2(d), 15 U.S.C. § 1052(d) (2002) (providing for concurrent registration of a trademark when more than one party is entitled to use the mark in commerce).

10. *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 974 (2d Cir. 1980).

11. *Id.*

12. See, e.g., PETER NOVICK, *THAT NOBLE DREAM: THE "OBJECTIVITY QUESTION" AND THE AMERICAN HISTORICAL PROFESSION* 523 (1988); JOYCE APPLEBY ET AL., *TELLING THE TRUTH ABOUT HISTORY* 73 (1994).

of discovery (or perhaps recovery) rather than creation.<sup>13</sup> In the eyes of intellectual property law, Clio is less a muse than a file clerk.

The intent of the following pages is to highlight examples of intellectual property law's perspective on history and to re-evaluate some of the underlying assumptions of intellectual property jurisprudence in light of developments in the field of history. After a brief discussion of the development of American historiography in the first section, the second section goes on to explore the role of invention and historical context in patent jurisprudence. Focusing on a landmark decision from the early years of radio, this section gathers insights from the history of science, social and cultural history, and political history to argue that historical methods could alter the study and practice of intellectual property law. In the third section, a copyright dispute over the story of the slave ship *Amistad* illuminates the treatment of history and historical fiction in intellectual property jurisprudence. Were the law to develop a more contemporary understanding of the field of history, it would arguably grant more equitable protection to historians and the authors of historical fiction. Finally, the conclusion goes on to suggest ways in which modern historical methods might contribute to a more nuanced approach to intellectual property, challenging the very notions of progress and creativity that underlie this branch of law.

## II. A HISTORICAL MOMENT

While a historiographic survey is beyond the scope of the present discussion, it is necessary to pause for a moment and offer in general terms a brief chronological perspective on theories and methods of historical study. At its inception, the American historical profession patterned itself on the models of German scholarship and the scientific method.<sup>14</sup> Following the example of the natural sciences, these post-Enlightenment strategies emphasized ostensibly neutral, value-free observation and exposition of the past and the steady progress of civilization.<sup>15</sup> Like nature, human society was thought to follow a positive evolutionary path.<sup>16</sup> Nineteenth-century historians' laboratories, like those of their modern counterparts, were

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13. See *Hoehling*, 618 F.2d at 980.

14. NOVICK, *supra* note 12, at 21.

15. *Id.* at 25, 32-34.

16. See *id.* at 21.

university libraries and seminars; historical documents were their rigorously dissected objects of study.<sup>17</sup> History was neither merely a record of names, dates, and places, nor a collection of oft-told tales about past events, but a repository of universal laws of human society and indeed of philosophical truth itself.<sup>18</sup> The concepts of progress and objectivity that continue to inform intellectual property law were celebrated pillars of the historical method.

In the early decades of the twentieth century, however, reform-minded historians began to abandon the deterministic assumptions of the profession. While continuing to engage in “scientific” study of the past, scholars questioned the earlier celebration of progress, toppled the icons of a previous generation, introduced new and less flattering social perspectives, and allowed a degree of indeterminacy to influence their work.<sup>19</sup> French historian Marc Bloch, writing shortly before he was captured and executed by the Nazis, ascribed changes in the historical profession in part to changes in the concept of science itself.<sup>20</sup> According to Bloch:

Our mental climate has changed . . . . [W]e are much better prepared to admit that a scholarly discipline may pretend to the dignity of a science without insisting upon Euclidian demonstrations or immutable laws of repetition. We find it far easier to regard certainty and universality as questions of degree. We no longer feel obliged to impose upon every subject of knowledge a uniform intellectual pattern, borrowed from natural science, since, even there, that pattern has ceased to be entirely applicable.<sup>21</sup>

This increasingly critical approach to history grew in importance after World War II, and it continues to influence the profession.<sup>22</sup>

Beginning in the 1960s, a new theoretical challenge to the social sciences, including history, appeared.<sup>23</sup> Postmodernism and its progeny questioned not only the idea of progress but also the

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17. APPLEBY, *supra* note 12, at 72–73.

18. See HEGEL'S PHILOSOPHY OF RIGHT 216 (T.M. Knox trans., Oxford University Press 1967) (1821).

19. See APPLEBY, *supra* note 12, at 137–42.

20. MARC BLOCH, THE HISTORIAN'S CRAFT 17 (Peter Putnam trans. 1953).

21. *Id.*

22. See NOVICK, *supra* note 12, at 522.

23. *Id.* at 522–23.

possibility of scientific objectivity itself.<sup>24</sup> As historian Peter Novick observes, "Most crucially, and across the board, the notion of a determinate and unitary truth about the physical or social world, approachable if not ultimately reachable, came to be seen by a growing number of scholars as a chimera."<sup>25</sup> This set of perspectives, echoing the Nietzschean view of historical culture "as a fault and a defect in our time,"<sup>26</sup> has enjoyed a mixed reception within the various branches of the historical profession.<sup>27</sup> Both practitioners and philosophers of history have nevertheless been forced to reconsider the nature of truth and objectivity in the context of studying the past.

Legal theory, in general, is more resonant with these broad academic and historiographic trends than the field of intellectual property would indicate. In the early twentieth century, the legal realist movement subjected law to social-scientific investigation that was similar in focus to the approach favored by contemporary progressive historians.<sup>28</sup> Cutting-edge legal scholars, engaged in various projects of reform, did not necessarily question the concept of progress as readily as their counterparts in history departments. Both lawyers and historians did, however, place their trust in the scientific method and the truths that it could reveal. As in history, law's faith in objective truth was challenged in the second half of the twentieth century by the theories of postmodernism. In a self-styled "guided tour" of the critical legal studies movement and its approach to history, Robert Gordon describes its primary contribution as having "added powerfully to the critique of the functionalist-evolutionary vision that has so long dominated legal studies."<sup>29</sup> The meeting of jurisprudence and postmodernity, in essence, challenged law's historical and potential role as positive agent for social change. Many scholars questioned or even feared the implications of this

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24. *See id.* at 523.

25. *Id.*

26. FRIEDRICH NIETZSCHE, *THE USE AND ABUSE OF HISTORY* 4 (Adrian Collins trans., Macmillan Publ'g 1957) (1873-76).

27. APPLEBY, *supra* note 12, at 225.

28. *See generally* LAURA KALMAN, *LEGAL REALISM AT YALE, 1927-1960* (1986); JOHN HENRY SCHLEGEL, *AMERICAN LEGAL REALISM AND EMPIRICAL SOCIAL SCIENCE* (1995).

29. Robert Gordon, *Critical Legal Histories*, 36 *STAN. L. REV.* 57, 125 (1984).

approach to law; Owen Fiss, at one point in his attack on the “new nihilism,” insisted simply, “The law evolves. There is progress in the law.”<sup>30</sup> The ultimate outcome of the postmodernist challenge to law, like history, remains unclear. Both disciplines, however, have been affected by forces of academic change in ways that underscore the anachronistic aspects of intellectual property jurisprudence. Following the practice in both history and the common law of illustrating principle through narrative, the pair of case studies below will demonstrate the limited historical sensibility of intellectual property law.

### III. “MARCONI PLAYS THE MAMBO”—OR DOES HE?<sup>31</sup>

When Guglielmo Marconi died in 1937, a front-page article in the *New York Times* called him the “inventor of the wireless.”<sup>32</sup> Additional articles eulogizing Marconi were even more effusive; a description of broadcast tributes around the world heralded him as the “Father of Radio.”<sup>33</sup> While the front-page obituary noted that the development of radio had been accompanied by patent lawsuits in many nations, it claimed that Marconi had remained above such squabbles and focused instead on developing new technologies, even those that theorists claimed were impossible.<sup>34</sup> For his efforts, Marconi shared the Nobel Prize in Physics in 1909, an impressive honor for a self-taught inventor. He also received a number of other awards in America, Britain, and his native Italy.<sup>35</sup>

A mere six years after the celebrity inventor’s death, however, the United States Supreme Court issued an opinion that in the eyes of

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30. Owen Fiss, *Objectivity and Interpretation*, 34 STAN. L. REV. 739, 750 (1982).

31. STARSHIP, *We Built This City*, on KNEE DEEP IN THE HOOPLA (RCA 1985). One publication recently placed this song first on its list of those with the all-time worst lyrics, a distinction due in part to the allegedly obscure historical reference to Guglielmo Marconi as the inventor of the radio. Joan Anderman, “*We Built This City*” is Best of the Worst, BOSTON GLOBE, Apr. 24, 2004, at E1 (reporting on *Blender* magazine’s list).

32. *Marconi is Dead of Heart Attack*, N.Y. TIMES, July 20, 1937, at 1.

33. *Leaders in Radio Broadcast Eulogy*, N.Y. TIMES, July 21, 1937, at 14.

34. *Marconi is Dead of Heart Attack*, *supra* note 32.

35. *Id.*; see also GAVIN WEIGHTMAN, SIGNOR MARCONI’S MAGIC BOX 228 (2003).



many undermined Marconi's place in history.<sup>36</sup> The patent infringement claims at issue in *Marconi Wireless Telegraph Co. of America v. United States* dated back to World War I,<sup>37</sup> a period in which both allies and enemies realized the advantages of wireless communication over vulnerable long-distance telegraph cables.<sup>38</sup> The Marconi Wireless Telegraph Co. of America (Marconi Company), which the government had taken over during the war,<sup>39</sup> argued that patents issued to its founder and others were infringed; the United States countered by challenging the validity of those patents.<sup>40</sup> Although the Marconi Company had under federal pressure transferred all of its assets to the newly formed Radio Corporation of America in 1919,<sup>41</sup> it retained its patent infringement claims against the government.<sup>42</sup> A quarter-century later, during another World War, the Supreme Court found that the majority of the claims in Marconi patent number 763,772 were invalid in light of the prior art, and it remanded the sole claim that a lower court had declared valid and infringed for further consideration.<sup>43</sup> Some forty-three years after the initial application, and thirty-nine years after its issuance,<sup>44</sup> one of the patents that buttressed the Marconi legend was essentially nullified.<sup>45</sup>

Chief Justice Harlan Fiske Stone, writing for the majority, indicates an awareness of the historical, if not the political, implications of the decision.<sup>46</sup> According to Chief Justice Stone, "Marconi's reputation as the man who first achieved successful radio transmission rests on his original patent . . . which is not here in question."<sup>47</sup> The majority was nevertheless determined not to allow Marconi's historic achievement to influence the Court. The opinion continues, "That reputation, however well-deserved, does not entitle

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36. See *Marconi Wireless Tel. Co. of Am. v. United States*, 320 U.S. 1 (1943).

37. *Id.* at 5 n.1.

38. See WEIGHTMAN, *supra* note 35, at 268.

39. *Id.* at 282-83.

40. *Marconi Wireless*, 320 U.S. at 1.

41. WEIGHTMAN, *supra* note 35, at 283.

42. *Marconi Wireless*, 320 U.S. at 5 n.1.

43. *Id.* at 60.

44. *Id.* at 4.

45. *Id.* at 60.

46. *Id.* at 37-38.

47. *Id.*

him to a patent for every later improvement which he claims in the radio field. Patent cases, like others, must be decided not by weighing the reputations of the litigants, but by careful study of the merits of their respective contentions and proofs."<sup>48</sup> Such evenhanded treatment of a party, focusing upon reasoned analysis of the controversy before the Court rather than impressionistic deference to individual stature, is in itself an admirable approach to jurisprudence. In this case, however, the Court's decision to ignore the extralegal judgments of history obscures the potential contributions of the history of science, cultural history, and political history.

Two dissenting opinions highlight the limited perspective of the majority in the Marconi case. Justice Felix Frankfurter, arguably more flexible in his approach to jurisprudence than the Chief Justice, wrote a brief and insightful dissent in which Justice Owen J. Roberts joined.<sup>49</sup> This dissent's primary objection is that the majority opinion adopts an anachronistic view of the patents and technical writings that preceded the Marconi Company's patents. After considering the difficulties associated with judicial review of patents, Justice Frankfurter warns, "Above all, judges must avoid the subtle temptation of taking scientific phenomena out of their contemporaneous setting and reading them with a retrospective eye."<sup>50</sup> Like other academics of the era, he describes scientific advancement—which is, after all, the object of patent protection—as an evolutionary process.<sup>51</sup> The dissent does not, however, privilege the Court's own temporally and scientifically advanced perspective over the judgment of Marconi's contemporaries. Indeed, Justice Frankfurter casts doubt upon the ability of the modern mind to interrogate the past, noting:

To find in 1943 that what Marconi did really did not promote the progress of science because it had been anticipated is more than a mirage of hindsight. Wireless is so unconscious a part of us, like the automobile to the modern child, that it is almost impossible to imagine

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48. *Id.* at 38.

49. *Id.* at 62 (Frankfurter, J., dissenting).

50. *Id.* (Frankfurter, J., dissenting).

51. *Id.* (Frankfurter, J., dissenting).

ourselves back into the time when Marconi gave to the world what for us is part of the order of our universe.<sup>52</sup>

According to this frankly postmodern view, science may progress, but post hoc judicial comprehension of what constitutes an instance of scientific progress is more likely to be distorted and eroded than enhanced over time. This is not because evidence is lost or memories grow dim, but because decision makers are enmeshed in the knowledge systems of their own eras. Once a principle is discovered and incorporated into a social group's consciousness, hindsight tends to anticipate its discovery.<sup>53</sup> According to media theorist Marshall McLuhan:

Without any exception, in every human development, in every discovery, all the effects come before the cause or the discovery itself; so when the discovery is finally made, everybody says, "Well, anybody could have seen that. The time was ripe." About the time somebody discovers the telephone, there are a thousand people who invent the telephone, and then the law courts are filled with suits for generations.<sup>54</sup>

In the Marconi case, the length of time between the initial patent application and the ultimate invalidation of its claims, as well as the prominence of the field of technology in question, heightens this distorting effect.

Justice Wiley B. Rutledge, in a separate and more comprehensive dissent, underscores the importance of contemporaneous judgment regarding scientific advancement, citing both popular references and foreign cases that vindicated Marconi's claims.<sup>55</sup> He also relies repeatedly on the publicly demonstrated, measurable results of the inventor's efforts, noting, "School boys and mechanics now could perform what Marconi did in 1900. But before then wizards had tried and failed."<sup>56</sup> In addition, Justice Rutledge

52. *Id.* at 63. (Frankfurter, J., dissenting).

53. For a discussion of backward projection in the context of cognitive theory, see MARK TURNER, *COGNITIVE DIMENSIONS OF SOCIAL SCIENCE* 31–35 (2001).

54. MARSHALL MCLUHAN, *Living at the Speed of Light, in UNDERSTANDING ME: LECTURES AND INTERVIEWS* 225, 239–40 (Stephanie McLuhan & David Staines eds., 2003).

55. *Marconi Wireless*, 320 U.S. at 64–80 (Rutledge, J., dissenting).

56. *Id.* at 65 (Rutledge, J., dissenting).

offers a description of the progress of science that emphasizes modest advances along a single theoretical trajectory. In the words of the dissent, "The invention was, so to speak, hovering in the general climate of science, momentarily awaiting birth. But just the right releasing touch had not been found. Marconi added it."<sup>57</sup> Given the large and distinguished field of scientists, many older and better-trained than Marconi, engaged in the late nineteenth- and early twentieth-century race to enable wireless communication, Justice Rutledge finds the majority's emphasis on conception and description far less persuasive than his own measure of results. Even a "short step forward," his dissent reminds the Court, is sufficient to support a patent.<sup>58</sup>

While the dissenting opinions in the Marconi case employ a more nuanced historical approach to scientific development than does the majority opinion, particularly in their emphasis on the importance of contemporaneous evidence regarding an inventive step, developments in historiography have still more to offer by way of analysis.

#### *A. The History of Science and the Judicial Analysis of Progress*

Drawing from the history of science, a retroactive application of Thomas Kuhn's 1962 distinction between normal science and paradigm shifts could add theoretical weight to the insights of both Justice Frankfurter and Justice Rutledge.<sup>59</sup> Kuhn's now axiomatic description of the progress of "normal science," defined as "research firmly based upon one or more past scientific achievements, achievements that some particular scientific community acknowledges for a time as supplying the foundation for its further practice," explains the clustering of similar experimental efforts to achieve wireless communication.<sup>60</sup> It is unsurprising that a scientific community mesmerized by the mathematical prediction and subsequent artificial creation of electromagnetic waves should

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57. *Id.* at 66 (Rutledge, J., dissenting).

58. *Id.* at 65 (Rutledge, J., dissenting).

59. See THOMAS S. KUHN, *THE STRUCTURE OF SCIENTIFIC REVOLUTIONS* 10 (3d ed. 1996).

60. *Id.*

collectively rush to explore the new medium further.<sup>61</sup> Knowledge of electromagnetic waves arguably constituted a Kuhnian paradigm shift, establishing a new tradition of research in the field of physics and attracting scientists who would develop its possibilities.<sup>62</sup> Marconi was one of those scientists. His claimed achievement was not the establishment of a new scientific tradition, a paradigm shift, but participation in the incremental development of an existing understanding, a function of normal science.<sup>63</sup> Patent protection, as Justice Rutledge points out, extends to both.<sup>64</sup> The subtle advances of normal science, however, are perhaps best appreciated by the contemporaneous practitioners and decision makers who can apprehend their role in the still crystallizing paradigm. Once the new paradigm has become a mature science, to again employ Kuhn's terminology, its basic principles are likely to appear obvious to scientists, judges, and even the general public—until it is supplanted by a later paradigm shift.<sup>65</sup> Under these circumstances, as Justices Frankfurter and Rutledge implicitly understood, justice requires deference to the judgments of history rather than hindsight.<sup>66</sup> Were the Court to have had access to Kuhn's theory at the time, the majority might have reached a different conclusion, or at least engaged the dissenting arguments. Intellectual property jurisprudence is purportedly engaged in the promotion and validation of scientific progress; its practice could be enriched by an elaborated historical understanding of the pattern of scientific development.

### *B. Socio-cultural History and the Legal Construction of Inventorship*

Social and cultural history, too, offer an enhanced perspective on the legal recognition of invention. Marconi's fame as the inventor of wireless telegraphy was so well established that Chief Justice Stone took judicial notice of his place in history, even while denying

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61. See WEIGHTMAN, *supra* note 35, at 14–15 (discussing the impact that Heinrich Hertz's discovery of electromagnetic waves had on the scientific community).

62. See KUHN, *supra* note 59, at 10–11.

63. *Marconi Wireless*, 320 U.S. at 65 (Rutledge, J., dissenting).

64. *Id.* (Rutledge, J., dissenting).

65. See KUHN, *supra* note 59.

66. *Marconi Wireless*, 320 U.S. at 66–67 (Rutledge, J., dissenting).

the particular assertions before the Court.<sup>67</sup> Both dissents echo Marconi's popular accolades as well.<sup>68</sup> One of the long-term effects of the Court's decision, however, is the negative effect on Marconi's reputation. A recent biography of one of his chief competitors, Nikola Tesla, lists the case as evidence that popular history is incorrect with respect to Marconi's preeminence in the field of radio.<sup>69</sup> In addition, while Justice Rutledge in his dissent cites the *Encyclopedia Britannica* as evidence of Marconi's "almost universal repute,"<sup>70</sup> the current online edition of that venerable reference work notes the majority's decision and indicates that others appeared to anticipate some of Marconi's claims.<sup>71</sup> These consequences to the inventor's reputation, whether or not deserved, serve as a reminder that intellectual property decisions exert more than economic impact. The construction of inventorship in a patent case is recorded in social and cultural terms as well. Whether the disputed invention is great or small, its assignment to an individual becomes part of the historical record. Such recognition of scientific achievement is an important function of the patent system, given our Western placement of the locus of creativity within the individual, which is itself a reflection of cultural history.<sup>72</sup>

### C. *Political History and the Judicial Recognition of Invention*

Although political history is likely to play a significant role in the outcome of only a few patent cases, it nevertheless calls attention to the context in which both invention and decision making occur. This context is particularly dramatic in *Marconi Wireless*, which involved alleged United States government infringement of an

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67. *Id.* at 37–38.

68. *Id.* at 62, 64 (Frankfurter, J., dissenting) (Rutledge, J., dissenting).

69. MARGARET CHENEY, *TESLA: MAN OUT OF TIME* 221 (Touchstone 2001) (1981).

70. *Marconi Wireless*, 320 U.S. at 64 & n.2 (Rutledge, J., dissenting).

71. *Guglielmo Marconi*, *ENCYCLOPEDIA BRITANNICA*, at <http://search.eb.com/eb/article?eu=52059> (online ed. 2004) (incorrectly using the analogous British patent number in a description of the U.S. Supreme Court case).

72. See Martha Woodmansee, *On the Author Effect: Recovering Collectivity*, in *THE CONSTRUCTION OF AUTHORSHIP: TEXTUAL APPROPRIATION IN LAW AND LITERATURE* 15, 16 (Martha Woodmansee & Peter Jaszsi eds., 1994) (describing the origins of the modern concept of authorship).

invention of military significance during the First World War and was decided during the Second World War.<sup>73</sup> The inventor, moreover, was an Italian citizen and a well known associate of Benito Mussolini, who reportedly served as Marconi's best man.<sup>74</sup> During this time the U.S. was keenly aware of the significance of scientific research for national defense, going so far as to empower the Office of Alien Property to seize Tesla's papers after his death in early 1943, despite the fact that he was a naturalized citizen.<sup>75</sup> Under the circumstances, a neutral observer might reasonably wonder whether patriotic interests influenced the Court in *Marconi Wireless*. While neither progressive historians nor legal realists would be likely to ignore this possibility, both the majority and the dissenting opinions remain silent on the matter.<sup>76</sup> So long as technological innovation occupies a significant place in the American national consciousness, intellectual property jurisprudence would be strengthened by an awareness of the sweep of political history.

*Marconi Wireless* is unusual on several levels: the significance of the field of technology, the famous actors, the historical moment, even the lengthy period of time between the alleged infringement and the final decision. These larger-than-life characteristics nevertheless illustrate the potential contribution of historical scholarship to patent jurisprudence, even if the relevant questions would ordinarily operate on a more limited scale. Whether or not the Marconi Company would have prevailed before a more historically oriented Court, an appreciation of historical analysis could have produced a narrative of greater nuance and social relevance. From a more sophisticated concept of the progress of science, to the social and cultural significance of invention, to an understanding of the national consciousness, historical methods could benefit the study and practice of intellectual property law. In addition, as the next section will suggest, an infusion of historical theory into intellectual property jurisprudence could enhance the legal treatment of history itself.

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73. See *supra* text accompanying notes 34–45.

74. *Marconi is Dead of Heart Attack*, *supra* note 32; see also WEIGHTMAN, *supra* note 35, at 288 (describing Marconi's relationship with Mussolini).

75. CHENEY, *supra* note 69, at 331.

76. *Marconi Wireless Tel. Co. of Am. v. United States*, 320 U.S. 1 (1943).

IV. "YOU TOO UPHELD THE VEIL FROM CLIQ'S BEAUTY"<sup>77</sup>

Although the African slave trade was considered illegal under Spanish law in the early nineteenth century, the lucrative transport of human beings from West Africa to Cuba for sale nevertheless continued—though occasionally with unexpected results.<sup>78</sup> One such transaction occurred in 1839, when two Spanish planters bought a number of people who had been kidnapped from the Mende region.<sup>79</sup> After the illegal sale, the purchasers engaged the schooner *Amistad* to transport the slaves to plantations elsewhere in Cuba.<sup>80</sup> One night, however, a group of the Mende captives broke free and took command of the ship.<sup>81</sup> Two months later a U.S. Navy vessel intercepted the *Amistad* in Long Island Sound and took the ship into custody.<sup>82</sup> A legal battle involving both criminal charges and property claims followed, culminating in the U.S. Supreme Court with former President John Quincy Adams arguing for the freedom of the alleged slaves.<sup>83</sup> The Court ultimately allowed the Mende men and women to return to Africa on the grounds that they were not in fact legitimate property under Spanish law.<sup>84</sup> During the proceedings, *The Amistad* became a cause célèbre of the abolitionist movement, and it has continued to generate scholarly and popular interest to the present day.<sup>85</sup>

The most recent property battle over the passengers of the *Amistad* involved the dramatic presentation of their history. In 1997, prize-winning African-American novelist Barbara Chase-Riboud sued Dreamworks, Inc., to block the distribution of director Steven Spielberg's movie *Amistad*, claiming copyright infringement of her

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77. JOHN KEATS, *To Charles Cowden Clarke*, in 4 THE COMPLETE WORKS OF JOHN KEATS 6, 6 (1884) (referring to Clio, the muse of history).

78. See *United States v. Libellants of the Schooner Amistad (The Amistad)*, 40 U.S. (15 Pet.) 518, 593 (1841).

79. See *id.* at 587–88; Federal Judicial Center, *Amistad: The Federal Courts and the Challenge to Slavery*, at <http://www.fjc.gov/history/amistad.nsf> (last visited Sept. 1, 2004).

80. *The Amistad*, 40 U.S. at 587–88.

81. *Id.*

82. *Id.*

83. *Id.* at 538.

84. *Id.* at 593–96.

85. Federal Judicial Center, *supra* note 79.



historical novel *Echo of Lions*.<sup>86</sup> Despite the existence of numerous similarities between the novel and the movie, as well as evidence that the credited screenwriter had been involved in earlier efforts to license the motion picture rights to Chase-Riboud's novel, a federal district court concluded that there was insufficient reason to grant the author a preliminary injunction.<sup>87</sup> Chase-Riboud dropped the lawsuit shortly thereafter and publicly complimented both the director and the film.<sup>88</sup>

In its denial of Chase-Riboud's motion, the district court applied a standard analysis of copyright infringement to the facts at hand.<sup>89</sup> The Court initially established that the author held a copyright in the allegedly infringed work and that the defendant had access to that work.<sup>90</sup> Next, the Court turned to the more complex issue of whether "substantial similarity" existed between the original novel and the subsequent motion picture.<sup>91</sup> As part of the extrinsic or objective comparison of the two works, it is first necessary to determine the scope of original copyright protection, filtering out any "unprotectable elements."<sup>92</sup> It is a commonplace of copyright jurisprudence that the law protects only an author's expression, not facts or ideas.<sup>93</sup> Similarity between unprotectable elements, including "historical or contemporary facts, material traceable to common sources or in the public domains, and *scenes a faire*,"<sup>94</sup> as well as clichés or general themes, may give rise to suspicion of copying. Such similarities, however, do not constitute copyright infringement.<sup>95</sup> The court is thus left to compare only bits and pieces

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86. *Chase-Riboud v. Dreamworks, Inc.*, 987 F. Supp. 1222, 1224 (C.D. Cal. 1997).

87. *Id.* at 1233.

88. Bernard Weinraub, *Plagiarism Suit over "Amistad" is Withdrawn*, N.Y. TIMES, Feb. 10, 1998, at A10.

89. *Chase-Riboud*, 987 F. Supp. at 1224.

90. *Id.*

91. *Id.*

92. *Id.* at 1225-26.

93. *See Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 547-48 (1985).

94. *Chase-Riboud*, 987 F. Supp. at 1226 (quoting *Walker v. Time Life Films, Inc.*, 615 F. Supp. 430, 435 (S.D.N.Y. 1985)).

95. *See id.* For a more extensive discussion of the types of unprotectable elements that may appear in a work of authorship, see *Alexander v. Haley*, 460 F. Supp. 40, 44-46 (S.D.N.Y. 1978).

of the works in question, concluding in this case that Chase-Riboud had not established a likelihood of success on the merits.<sup>96</sup> Had the author created a work of purely imaginative fiction rather than an embroidered and embellished retelling of history, she might have had greater success against the motion picture studio. Her use of historical events, however, left her with the type of “thin” copyright protection that is so often the fate of historians.<sup>97</sup>

From the perspective of the historical profession, it can be difficult to accept that “the protection afforded the copyright holder has never extended to history, be it documented fact or explanatory hypothesis.”<sup>98</sup> As in other fields of human endeavor, the practice of history would suffer a chilling effect from the removal of documentary evidence from the public domain.<sup>99</sup> One historian’s fact, however, may be another’s false interpretation. The generation of historical narrative and theory can require years of advanced study, months spent in dusty archives scattered around the world, and countless solitary hours reading crumbling old tomes, faded letters, or endless spirals of microfilm. Explaining to a historian that intellectual property law views this lifelong effort as roughly equivalent to the compilation of a telephone book is unlikely to elicit a printable response.<sup>100</sup> The author of a Selden Society volume or a critical edition will not be reassured by judicial acknowledgment that “[e]ven within the field of fact works, there are gradations as to the

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96. *Chase-Riboud*, 987 F. Supp. at 1232. The court declined to apply the second part of its test for infringement, an intrinsic or subjective comparison of the works taken as a whole. Instead, the court found this inquiry to be better suited to resolution at trial. *Id.* at 1226 n.4.

97. See *Jacobsen v. Deseret Book Co.*, 287 F.3d 936, 943 (10th Cir. 2002) (quoting 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.03[A], at 13–28 (2000)).

98. *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 974 (2d Cir. 1980).

99. See generally LAWRENCE LESSIG, THE FUTURE OF IDEAS (2001) (charging that too many constraints will stifle the Internet’s promise of innovation and that free resources are crucial to innovation.)

100. See *Feist Publ’ns v. Rural Tel. Servs. Co.*, 499 U.S. 340, 352–56 (1991) (noting in the context of a case involving alleged infringement of a telephone directory that “sweat of the brow” is not protected under copyright jurisprudence).

relative proportion of fact and fancy. One may move from sparsely embellished maps and directories to elegantly written biography."<sup>101</sup>

However proud a historian may be of her elegant prose, rest assured that she does not think of her work as the product of mere "fancy." Indeed, the policy of granting more extensive legal protection to fabrication or error than to meticulously researched historical detail can appear counterintuitive, especially in light of the constitutional mandate governing copyright and patent law. In a field that often equates original scholarship with new theories or insights into the past, moreover, intellectual property law's failure to protect ideas seems almost anti-intellectual. While historians cannot expect the law to replace professional standards or address every instance of plagiarism, the protection available to works of history or even historical fiction is extremely limited.

The history profession needs look no further than its own past to explain this treatment of historical works in intellectual property law. History's nineteenth-century and early twentieth-century emphasis on the scientific method appears to have left a lasting impression on intellectual property jurisprudence.<sup>102</sup> If history is analogous to the natural sciences, then it follows that protection of its "discoveries" should be similarly limited. It is well established that

[t]he laws of nature, physical phenomena, and abstract ideas have been held not patentable. Thus, a new mineral discovered in the earth or a new plant found in the wild is not patentable subject matter. Likewise, Einstein could not patent his celebrated law that  $E=mc^2$ ; nor could Newton have patented the law of gravity.<sup>103</sup>

A new bit of information uncovered in an archive, Hegel's pattern of thesis-antithesis-synthesis, or the enduring theory of Montesquieu's *L'Esprit des lois* correspondingly lie beyond the reach of intellectual property protection. Like the scientist who publishes a description of

101. Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539, 563 (1985) (quoting Robert A. Gorman, *Fact or Fancy? The Implications*, 29 J. COPYRIGHT SOC'Y 560, 563 (1982)).

102. See *supra* notes 14-18 and accompanying text.

103. *Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980); see also *Funk Bros. Seed Co. v. Kalo Inoculant Co.*, 333 U.S. 127, 130 (1948) (holding that manifestations of nature are not patentable).

a new discovery, the historian is entitled only to minimal copyright protection of her expression.

By clinging to this “scientific” approach to history, however, intellectual property jurisprudence ignores at least a half-century of historiographic development. Historians no longer unanimously subscribe to the belief that they are engaged in a search for objective truth, and few would claim to discern universal laws of history.<sup>104</sup> The proportion of historical research that yields concrete, unassailable facts is dwarfed by the amount of expressive material generated by historians. Even the names, dates, and places that apparently comprise the most straightforward part of the historical record are often written in pencil—especially if the handwriting is not one’s own but that of a colleague in the field.

In constructing a narrative, moreover, the historian makes a series of choices about what to include and how to characterize or portray the past. Consider the following passage from Peter Brown’s classic, “elegantly written biography” of Augustine, originally published in 1967 and reissued in 2000:

Instead, forests of olive-trees had come to cover the hillsides of southern Numidia. Augustine could work all night in Africa, his lamp stocked with plentiful supplies of the coarse African oil: it was a comfort he would miss during his stay in Italy. This oil came from little men, from villages which lacked the swagger of the Roman towns. These sturdy planters, suspicious of the outside world, living in tight-knit communities, whose habits had changed little since pre-historic times, had become the arbiters of the prosperity of Africa: “Here lies Dion, a pious man; he lived 80 years and planted 4000 trees.”<sup>105</sup>

To what degree has Brown imagined this unfootnoted landscape? Does he mean to imply that Augustine regularly worked all night by lamplight, or is the biographer merely identifying with his subject? And why should “little men” who once grew olives make a cameo appearance in an academic study of a famous theologian? An exercise of “analytic dissection” intended to cull unprotectable “fact”

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104. See *supra* notes 19–27 and accompanying text.

105. PETER BROWN, *AUGUSTINE OF HIPPO: A BIOGRAPHY* 8 (2000) (citations omitted).

from the author's expression would misapprehend the nature of the work.<sup>106</sup> Brown himself, in a preface explaining why he chose not to update his original text in light of subsequent developments, states,

The biography was never meant to be a comprehensive study of Augustine, valid for all times and so needing to be kept up to date as if it were a scientific manual. It was a book written at a particular time, by a young man at a particular moment in scholarship.<sup>107</sup>

Historical works in the wake of postmodernism are not easily reduced to the objective categories enshrined in intellectual property law.

Perhaps the most radical exponent of the indeterminacy of historical study is Hayden White, who blurs the distinction between history and fiction by emphasizing the "poetic nature" of both.<sup>108</sup> According to White, "It is often said that history is a mixture of science and art. But, while recent analytical philosophers have succeeded in clarifying the extent to which history may be regarded as a kind of science, very little attention has been given to its artistic components."<sup>109</sup> Although more traditional historians have condemned White's "relativism,"<sup>110</sup> his conclusion that a choice among alternative visions of history ultimately rests on moral or aesthetic rather than scientific grounds captures an important trend in historiography.<sup>111</sup> Intellectual property jurisprudence remains insulated from this academic development, continuing to maintain its colloquial view of works of history.

As one historian notes, "We seem to have reached an odd point in our evolution where it is the historian who has to preach the fragility of his own subject's truth-claims to those who have never tried to construct them but none the less regard them as robust."<sup>112</sup>

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106. See *Chase-Riboud v. Dreamworks, Inc.*, 987 F. Supp. 1222, 1226 (quoting *Walker v. Time Life Films, Inc.*, 615 F. Supp. 430, 435 (S.D.N.Y. 1985)).

107. BROWN, *supra* note 105, at vii.

108. HAYDEN WHITE, *METAHISTORY: THE HISTORICAL IMAGINATION IN NINETEENTH-CENTURY EUROPE*, at x-xi (1973).

109. *Id.*

110. NOVICK, *supra* note 12, at 599.

111. WHITE, *supra* note 108, at 433.

112. MICHAEL BENTLEY, *MODERN HISTORIOGRAPHY: AN INTRODUCTION* 159-60 (1999).

The law's failure to comprehend the nature of modern historical inquiry has led to extremely thin copyright protection for both scholarly works and historical fiction. Whether history is ultimately judged, in constitutional terms, to be a Science or a useful Art, the law should encourage and reward its practice. To this end, intellectual property jurisprudence requires a more contemporary understanding of the practice of history.

#### V. PAST AND FUTURE PERFECT

Intellectual property law, the great defender of digital property, should not be content to settle for an analog version of history. Like other areas of jurisprudence, intellectual property must instead incorporate a useable theory of the past informed by current scholarship. Only then can legal practice begin to reflect a more subtle understanding of history as both an arbiter and an object of human creativity.

At a systemic level, modern historiographic trends challenge intellectual property to reevaluate the basic concept of progress and the capacity of the judicial process to measure it. If society follows a meandering rather than a teleological or even a cyclical path through history, what is the role of a legal discipline intended to encourage progress in human endeavor? And what is the measure of whether a new development constitutes progress?

On an individual creative level, contemporary historiography also calls into question assumptions regarding agency and originality. If many new inventions are at least in part the result of the sequential development of knowledge systems, to whom are such creations attributable? How does communal influence affect the concept of rewarding a particular person as the first to invent? What is the social significance of the construction of inventorship or authorship, and how is this construction affected by extralegal forces? And in light of such creative indeterminacy, is originality or novelty really any more valuable than industry?

The self-reflections of the historical profession, when introduced into intellectual property jurisprudence, have the potential to affect more than just the legal treatment of contested inventions or works of history. Modern historical study, by holding a mirror to the longstanding conventions of intellectual property law, can ultimately reveal this branch of jurisprudence to itself.

