

CONTRIBUTION TO THE UNDERSTANDING OF THE PUBLIC DOMAIN

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Introduction

The importance of studying the Intellectual Public Domain lies in the rise in both the importance and strength of Intellectual Property Rights (IPRs) in legal and economic arena, both internationally and nationally. In fact, in the last century intellectual property rights have steadily expanded in subject matter, scope, breadth, and in the length of time they have been applied.

This expansion is mirrored by the decrease in the “field” of all of the “intellectual creations”² that were once freely accessible and are now, because the expansion, legally protected.

The concern about the encroachment upon this field of “freedom” has led scholars to look at the other side of intellectual property rights: the public domain. IPRs and the public domain are in fact strictly intertwined and interrelated.

On the one hand, there is the intellectual property (IP) system, which is a normative framework wherein “intellectual endeavours” are regulated by means of creation - by the government - of specific legal institutions (copyright, patent, trade mark, etc.). On the other hand is the public domain that is, *prima facie*, the outside of the intellectual property system, and includes the material that is free for all to use and build upon with no legal restraints.³

As in the communicating vessels, the public domain and the IP system are interdependent, and modifications to one field affects the other. If one’s purpose is to make legally relevant the public interest in the access of all kinds of “intellectual endeavours,” then it makes sense - from a methodological point of view - to approach the IP system focusing attention on its flip side: the public domain.

The purpose of this article is to understand how the public domain has been construed by the Courts.

In the first part of the article, the different ways the public domain has been qualified and construed by scholars are briefly sketched out- for descriptive and introductory purposes to the analyzed cases law. There are scholars that claim that the public domain has no prescriptive or positive meaning all together, or even that it can be harmful to social welfare. On the other hand, there are scholars that argue that the public domain can be construed as a *rule*, a normative concept, variously construed, that would bestow rights and duties. However, between these two opposite schools of thought - that well portray and mark the edges of the spectrum of the meaning of the public domain, as perceived today- lay variegated and authoritative schools of thought.

In light of the different ways the public domain has been qualified and characterized by scholars, in the second part of the article, several well-known and often-quoted cases law are analyzed. In this article, it is argued that the public domain, contrary to authoritative schools of thought, is not construed - by Courts - as a *rule* that determines, in a “binary fashion”, which behaviours “will be coerced by the public power and which behaviours will be allowed.”

It is argued - grounding claims on reading the analyzed cases law - that the public domain is used and construed by courts as both a status of the mere negative aspects of IPRs and as an *argument* (for rhetorical - *strictu sensu* - purposes) that heralds the underlying interest of the “public” in accessing “information”. In light of these findings, this article suggests that it is possible to start building a theory that would render the public domain more apt to make legally relevant the

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² Here “intellectual creation,” “intellectual endeavors,” “information goods,” are used interchangeably meaning all the abstract objects that are capable of IPRs protection.

³ See James Boyle, “The public domain,” “Foreword, the opposite of property?” at 1, *Law and contemporary problems*, 66, (2003).

underlying interest (in the access of “information”) if construed not as a rule, but as an *interpretative principle* that “states a reason that argues in one direction, but does not necessitate a particular decision” and that, once relevant, courts would have to take into account “as a consideration inclining in one direction [rather than] another.”

PART I: THE MANY SHAPES OF THE PUBLIC DOMAIN

§ 1) *The New, New Intellectual Property*⁴

The expansionist trend in the field of intellectual property finds its main justification in technological development;⁵ it is purportedly reinforced by economic factors,⁶ the legal analysis of law⁷, and neo-liberal doctrines.⁸

This increase in protection has been analogized with the English first enclosure movement, a process of privatization of “free” lands with the purpose of rendering them efficient⁹ and, in so doing, avoiding the (alleged inexorably) “tragedy of the commons.”¹⁰

A similar phenomenon is occurring in the field of intellectual property. Some scholars point out that we are in the middle of a “second enclosure movement” or “the enclosure of the intangible commons of the mind.”¹¹ We are assisting a trend where things that were formerly thought of as either common property or uncommodifiable, are being covered with new, or newly extended, property rights.¹² The old assumption by which “the general rule of law is that the noblest of human production – knowledge, truths ascertained, conceptions, and ideas – become, after voluntary

⁴ If in the 60s Charles Reich recognized the emergence of a new “figure” of property in the form of entitlements created by the government, we assist nowadays to the emergence of a “new, new” intellectual property, in the form of new entitlements and enlarged scope of protection. See Charles A. Reich, *The New Property*, 73 *Yale L.J.* 733, 746 (1964); see also Gregory S. Alexander, “Commodity & Property”, 366, *The University of Chicago press*, (1997); See also Anupam Chander, “The new, new property”, 81 *Tex. L. Rev.* 715, (2003).

⁵ See e.g. James Boyle *The Second Enclosure Movement and the Construction of the Public Domain*, at 42, 66, *Law and Contemporary Problems*, (winter/spring 2003). He explains this point well: “imagine a line. At one end sits a monk painstakingly transcribing Aristotle’s poetics. In the middle lies the Gutenberg printing press. Three quarters of the way along the line is a photocopying machine. At the far end lies the Internet and the online version of the human genome. [...] To deal with the monk-copyist, we need no intellectual property rights because physical control of the manuscript is enough. To deal with the Gutenberg press, we need the Statute of Anne. To deal with the internet, we need the Digital Millennium copyright Act, the No Electronic theft Act, the Sonny Bono Term extension Act [...]”

⁶ This trend had had a boost in the late twentieth century when information and IPRs became an important part of United States gross domestic product. Indeed, core copyright industries alone are accountable for five percent of the GDP of most industrialized nations and the full impact of copyright in the United States in 1999 is estimated at 7.33% of GDP or \$ 678 billion. See International Intellectual Property Alliance, *Copyright Industries in the U.S. Economy: The 2000 Report*, Executive Summary, at http://www/iipa.com/copyright_us_economy.html (last visited May. 14, 2005).

⁷ See e.g. Richard A. Posner, “Economic Analysis of Law” (1996).

⁸ According to which, very roughly, the more property, the better. See Michael P. Scharf “The Law of International Organization”, Carolina Academic Press ed., 654 (2001).

⁹ The first enclosure movement was a process of “privatization”, a process by which lands that had been common property, or had been outside of the property system altogether, were converted into private property. See James Boyle, *supra* n. 5 at 37.

¹⁰ In 1968, biologist Garret Hardin labelled as “the tragedy of the commons” the scenario in which, absent of any private property rights regime, environmental dysfunctions of overuse and underinvestment would occur. See Garret Hardin, “The tragedy of The commons”, *Science*, Dec. 13, 1968 at 1243. See *contra* e.g. Elinor Ostrom, Foreword, in Susan J. Buck, “The Global Commons: an Introduction” xiii (1998).

¹¹ See James Boyle *supra* n. 5 at 38.

¹² *Id.*

communication to others, free as the air to common use,”¹³ seems to be inverted and what was the rule is becoming, slowly but inexorably, the exception and vice versa.¹⁴

As pointed out, in this scenario, the public domain may play an important role in off setting this trend.

§ 2) *The Appearance of the term public domain*

At the outset, it must be stressed that the public domain is a relatively new concept that has been introduced in the field of IPRs. In fact, in the USA, the term public domain was used in a statute only in 1909 with the copyright act,¹⁵ meanwhile Courts began using the term in the field of Intellectual property since 1890,¹⁶ in parallel, I point out, with the appearance of the term “public domain” in the international arena.¹⁷

As some scholar have shown, during the 18th and 19th centuries, works and inventions not protected by copyright and patent were mainly referred to as “public property”, “common property” or “publici juris.”¹⁸ These terms, to be sure, did not find their origin in the intellectual property rights field. Indeed, they were borrowed from the field of real estate and public land. This article suggests that there was an implicit intuition behind the use of the various terms, and behind each of these terms laid a different idea of the interest protected.

In the IPRs field of law, the term “public property” was used not indiscriminately but just for patents and copyrights whose terms of protection had expired, for material for which no patent or copyright could be obtained, for material for which no patent or copyright had been obtained and, only in the patent field, for patents which were invalid and for materials disclosed but not claimed.¹⁹ More generally, “common property” was used to describe matter not protected by patent or copyright.²⁰ What was stressed by courts was that any person was free to use “common property” and they analogized such “common property” to elements of the natural environment, such as water and air, which were free for all to use.²¹ Sometimes, courts would also use the Latin phrase “*publici juris*,” to address the specific problem of insufficient novelty in a patent.²²

¹³ See *International New Serv. V. Associated Press*, 248. US 215, 250 (1919) (Brandeis, J., dissenting).

¹⁴ For the concept of “technological inversion” see also Lawrence Lessig, “The Creative Commons”, Dunwoody Distinguished Lecture in Law, Florida Law Review, July 2003.

¹⁵ See 1909 copyright act, available at <http://www.megalaw.com/top/copyright/1909cact.php> (last visited July 17th, 2006)

¹⁶ See *infra* Part II § 1

¹⁷ For a historical perspective of the public domain see: Karl-Erik Tallmo, “The History of Copyright: The Statute of Anne”, available at www.copyrighthistory.com/anne.html (last visited May 1st, 2006); L. Ray Patterson & Stanley W. Lindberg, “The Nature of Copyright”, at 20, *Un. Of Georgia press Ed.*, (1991). Mark Rose, “Nine-Tenth of the Law: The English Copyright debates and the Rhetoric of the Public Domain”, at 76, 66 *Law and Contemporary Problems* (winter/spring 2003). Lyman Ray Patterson, “Copyright in Historical Perspective”, at 20-27, *Nashville Vanderbilt U. Press*, (1968). Malla Pollack, “Purveyance and Power, or Over-Procured Free Lunch: The Intellectual Property Clause a Saint Ally of the Taking Clause in the Public’s Control of Government”, 30 *S.M.U. L. Rev.* 1, at 40-54, (2000). Tyler T. Ochoa and Mark Rose, “The Anti-Monopoly Origins of the Patent and Copyright Clause”, 49 *J. Copy. Soc.*, at 679-99, (2002).

¹⁸ See e.g. Julie E. Cheon “Copyright, Commodification, and Culture: Locating the public domain” at 9, in P. Bernt Hugenholtz & Lucie Guibault, eds, “The Public Domain of Information, (Kluwer Law International, forthcoming 2006).

¹⁹ See Tyler T. Ochoa, “Origins and Meanings of the Public Domain” at 233, 28 *U. Dayton L. Rev.* 215 who delves into this history and that points out two main characteristics of this kind of public property. The first one is that any member of the public could make, use or sell the invention. The second characteristic is that the quality of “public property” is irrevocable: once something had become public property, it was beyond the power of the government to privatize it by granting a new patent or copyright. *Id.* at 234. As I will point out later on, the latter characteristic, if it was true at all at the outset of the IPRs system, it is not true nowadays.

²⁰ *Id.* See also e.g. *Callaghan v. Meyers*, 128 U.S. 617, 623 (1888) (“The answer avers that all matters contained in the volumes are public and common property...and as such not susceptible of copyright”).

²¹ *Id.* at 235.

²² See e.g. *Thompson v Haight*, 23 F. Cas. 1040, 1047 (S.D.N.Y. 1826); See also Julie Choen *supra* n. 18 at 10.

This article argues that courts used different terms according to the nature of the different problems at hand. Using different terms (i.e. public property, common property, etc.) may represent an effort by courts to distinguish among different IPRs fields (e.g. patent as opposed to copyright),²³ different aspects of a same IPR (e.g. lack of novelty as opposed to natural expiration of terms protection), and, above all, different interests protected (or maybe different gradations of the same interest). For example, using the wording “public property” for the expiration of the terms of protection may convey a meaning, tinged to the etymology of the used wording, that is different from the sense embedded in the wording “common property”. It can be argued that “common property” conveys a more incisive meaning than does “public property”. The latter evokes – differently from the former - the idea of something *ab origine* and for *jus naturalis* “inviolable” (by private rights). It seems that - until the appearance of the scene of the public domain – that many different terms were used, as many different (perceived) interests were to be addressed.

However, in the 1890 Singer case, the Supreme Court used the terms common property, public property, and *publici juris* interchangeably, and also added two more: “the domain of things public” and “the public domain”.²⁴ Primarily, the introduction of the term public domain in the Singer case seems to be a matter of *argumentation*.²⁵ The court seemed to search for a ground - precisely an argument – on which to base its case,²⁶ and relied heavily on foreign cases, and English and French jurisprudence and treaties, where the term “*domaine public*” was long since used and well established.²⁷

Furthermore, the court’s use of one term – the public domain – that replaced all previous terms, may represent the acknowledgment of one indivisible public interest (in accessing “information”), that becomes legally relevant when the problem - regarding the relationship and the boundaries between what is controlled by an IRP holder and what is not – is posed.

3) *Old ideas of Public Domain and the Call for a New View*

Turning now to address specifically the *concept* of public domain, it must be recognized that, besides the basic “negative” definition according to which the public domain consists of what is not covered by IPRs, no agreed upon definition of the public domain exists.²⁸

The public domain has long since been defined as the opposite of intellectual property rights. “Public domain in the fields of literature, drama, music and art is the other side of the coin of copyright. It is best defined in negative terms. It lacks the private property element granted under copyright in that there is no legal right to exclude others from enjoying it and is <<free as the air to common use.>>”²⁹ Other scholars have gone further, claiming that the public domain is even harmful to social welfare, and arguing that “information goods”, once entered into the public

²³ It may not be a coincidence that, at the time, the principle of election was operative, which limited an author to only one type of IP protection (indirectly delimiting and singling out each field of the IP system. See *infra*, part. II § 3.1.

²⁴ See *infra* Part II, § 1

²⁵ But see *infra* Part II, § 1.

²⁶ See *infra*.

²⁷ Indeed, as some scholars have already pointed out, the term public domain parallels the French term “*domaine public*” See .g. James Boyle, *supra* n. 5, at 36; Jessica Litman “The Public Domain”, 30 *Emory L. J.* 965, 1990. See also *infra* *Merriam v. Holloway Pub’g Co.*, at 1002, 1003, 1009, 1008; 43 F450 (1890). See also the Berne Convention Concerning the Creation of an International Union for the Protection of Literary and Artistic Works, (as revised at Paris, France, July 24, 1971 Item A-1 (Sept. 9, 1886), Copyright Laws and Treaties of the World (UNESCO 1997).

²⁸ As James Boyle points out, a definition of public domain is useful or useless. “It is not true or false, any more than a new year’s resolution or an insurance policy. A definition is in fact a type insurance against certain risks of confusion. It cannot, any more than can commercial insurance policy, eliminate all risks.” Felix Cohen, “Transcendental Nonsense and the Functional Approach,” 35 *Colum. L. Rev.* 809, 835-36 (1935).

²⁹ See William Kraisilovsky, “Observation on the Public Domain”, 14 *bull. Cr. Soc.* 205, 205(1967). It is possible to analogically extend, *mutatis mutandis*, this definition to all the IPRs.

domain, are typically relegated to oblivion,³⁰ or that the public domain simply represents nothing more than a repository for what is left over after positive property rights have been taken into account.³¹

³⁰ See *Eldred v. Reno*, 239 F.3d 372, 379 (D.C. Cir. 2001) which centred around the constitutionality of the Copyright Term Extension Act of 1998. Judge Douglas Ginsburg of the D.C. Circuit Court of Appeals, in upholding that the recent twenty-year extension of the copyright term for existing works does “promote progress,” claimed that it was romantic nonsense to believe that works are better off in the public domain. *Id.* at. 379. When copyright ends, Judge Ginsburg wrote, works that are no longer private property are likely to “disappear - not enter the public domain but disappear.” *Id.* Keeping them under statutory protection makes them more accessible to the public. *Id.* Increasingly, law and economic scholarship also favours the anti-public domain view, arguing that information resources are more likely to be created and exploited at optimal levels under a comprehensive privacy control regime rather than under one that relies on a large public domain. See generally William M. Landes & Richard A. Posner, “An Economic Analysis of Copyright Law,” 18 *J. Legal Stud.* 325 (1989). According Douglas G. Baird “freedom of expression [...] requires careful guardianship of the public domain. We don’t want corporate giants like Disney suing people who use Mickey to engage in social satire now and again. We also want to protect the moral rights of artists, non-waivable rights to ensure their artistic integrity against corporate rapacity. These impulses, however, are ones that we should resist. It is not necessarily a bad thing that Disney still owns rights to Mickey Mouse. It gives Disney an incentive to preserve this icon. Without intellectual property protection, there would be nothing to stop cheap reproductions and the dilution and tarnishing that comes with them. Without intellectual property protection, there would be nothing to stop the use of Mickey for any and all purposes. Our world is not necessarily a better place if anyone can show Mickey Mouse shooting heroin, as indeed someone has tried. We may have little to fear from the Bogart persona being subject to intellectual property protection. Perhaps, rather than wanting it in the public domain, we should want someone to own the persona, promote it, and take care it is well-preserved.” See Douglas G. Baird, “Does Bogart Still Get Scale? Rights of Publicity in the Digital Age”, at 363-64. 4 *Green Bag 2d ed.* (2001).

On the same line of thought, but from another perspective, Professor R. Polk Wagner argues that enclosure is a good way to promote innovation and that enlarging the public domain would be less effective in stimulating creativity: “I note how dynamic incentive-effects and the inherent nature of information combine to increase the content of the public domain over time, irrespective of the appropriability of the work protected by intellectual property. That is, because even perfectly controlled works nonetheless transfer significant information into the public domain, it turns out that over the long term, additional control is likely to stimulate additional works - and thus grow the public domain, even assuming no access to the protected work itself.” See R. Polk Wagner, “Information Wants to Be Free: Intellectual Property and the Mythologies of Control,” 103 *Colum. L. Rev.* 995, at 1000 (2003). Wagner also assumes, however, that the spillovers - the informational content revealed from inventions and contained in copyrighted works - will escape enclosure and will be added to the public domain. *Id.*

These views are encompassed under the label “semiotic stewardship”: a single proprietor must police the meaning of the intellectual creation in order to maintain its integrity and meaning. If works or marks can be “played to death”, diluted, tarnished, or turned into a cliché, their meaning can be destroyed. See e.g. James Boyle, “Foreword” in “The Public Domain”, at n 3, 66 *Law and Contemporary Problems* (winter/spring 2003).

³¹ See Edward Samuels, “The Public Domain in Copyright Law”, 41 *J. Copyright Soc’y USA* 137, 137 (1993). According to Samuels the “public domain” is not so much a theory as a tendency to resolve borderline or new cases in favour of non-protection rather than protection. See Edward Samuels, “The Public Domain Revisited”, 36 *Loy. L.A. L. Rev.* 389 (2002). He poses the following questions and arguments: “Is the public domain simply whatever is left over after various tests of legal protection have been applied? Is it the mere ‘background,’ the ‘negative’ of whatever may be protected? Or is there something about the public domain, some compelling public policy or legal principle, that gives it a life of its own, that would tend to attribute positive aspects to it, that would make it something of the form instead of just the background?” *Id.* at 617. He answers the questions as follows: “After reviewing the various proposed arguments supporting a general theory of the public domain . . . it would appear that there simply is no such general theory. Instead, there are several discrete contexts in which arguments about the public domain are encountered, each context raising different considerations that may have little or nothing to do with each other, and that cumulatively constitute what remains after one examines all possible sources of legal protection for works of authorship. What is gained by reifying the negative, and imagining a “theory” of the public domain? If one wants to encourage a presumption against new forms or areas of protection, then one can do so without having to invoke a magical “public domain.” There are dozens of battlegrounds between those who want to expand intellectual property protection and those who want to limit it or narrow it in any given context. The arguments in each context should be kept separate, since they raise different policy issues. Nevertheless, the individual issues sometimes tend to be elusive, and one’s attitude toward them tends to be flavored as often as not by one’s general attitude toward copyright law. If those who find themselves continually on the side arguing for a limitation of protection need a rallying cry, perhaps it can be “the public domain.” The invocation may seem to add a moral overtone to the argument, to counterbalance the morally charged principles invoked time and again by the protectionists. In the final analysis, however, [paraphrasing Ralph Brown] “such vague rhetoric does little more than adorn the stage on which actual choices must be played out.” *Id.* at 389-390.

This assumption has been criticized, and an increasing number of scholars have been working to construct the public domain in a way that would confer to it a meaning that would go beyond what can be qualified as merely the negative aspect of IPRs. To react against the overwhelming expansion of IPRs, the concept of public domain has been used as a legal tool that would offset, in the intention of its advocates, the IPRs expansion. Scholars have developed theories to provide for a public domain that would be capable of having a positive definition, be variously qualified and capable of bestowing rights to the public at large. In other words, the public domain would not be the mere opposite of IPRs.

However, until the 1980s, little attention was paid to the public domain. Instead, attention was focused on problems, such as the scope and breadth of the subject matter, and the extension of the term of expiration, thereby underestimating the deep relations between IPRs and the public domain.

Professor David Lange, in the late 1970's, was one of the first authoritative scholars to raise the issue of the public domain as a subject matter that deserved treatment on its own terms.³² His insight was an early call upon scholars and judges for a new approach to IPRs³³; a call to take into account that each increase in protection raises the costs of, and reduces access to, the raw material from which one may build upon; a call to recognize that "information products" (as well as, more

³² "I thought about the public domain at the time when it seemed to me that in the American law there was too much appetite for protectionist theories and an expanded reach of IPRs and no real concern for public domain [...] When I began thinking about it, the public domain was what was left over when IPRs protection expired or what was left over when IPRs were determined not to apply. [By way of contrast], I identified the public domain as an affirmative concept in itself." See Interview with Prof. David Lange, held at the Duke University, Durham, North Carolina, USA on the 4th of April 2005. To explain his idea he used an analogy about the African savannah: "Imagine an African veldt" he suggests, "where lions and jackal and gazelles dwell in uneasy symbiosis while the sun shines down dispassionately upon them. There is symbiosis among them, yet it requires only this much imagination to understand these inhabitants of the veldt as separate animals. Indeed, the function of taxonomy is to enable us to draw these singularly useful, but also elementary, distinctions. You have to be a lion- or a jackal-lover of limited imagination or unlimited commitment to argue that gazelles are to be understood as no more than whatever is left over after their adversaries have finished feeding... My project is to recognize gazelles as gazelles... and to give them means with which to defend themselves against their natural enemies." See David Lange "Reimagining the Public Domain," 66 *law & Contemp. Probs.* (winter/spring 2003). He suggests that "recognition of new intellectual property interests should be offset today by equally deliberate recognition of individual rights in the public domain [...] Each [intellectual property] right ought to be marked off clearly against the public domain." See David Lange, "Recognizing the Public Domain", 44 *law & Contemp. Probs.* 147-50 (autumn 1981). He proposed an approach that would recognize the public domain with its own dignity and capable of an affirmative claim. He points out the existence of a deep link, in the copyright arena, between the ongoing expansion of IPRs and the shrinking of the public domain.

David Lange, when in the late 1970s began thinking about the public domain "was not interested in theory." Instead, he says, "I really wanted primarily to encourage people to take the idea of the public domain seriously and in practical I wanted the people – congress actually – to accept as a kind of guiding principle that no new protection would be recognized unless, first, people that wanted the protection explain why they need it and how it would affect the rights of others." *Id.* Interview. From his first attempt to imagine an affirmative concept of public domain, Lange recognizes that it has been an evolution in this field and that there are scholars that think that there are many public domains but for him "one does not make more sense than another."

Another important thing in the understanding of the public domain, Prof Lange points out is "to decide what yourself want to adopt as your approach to the public domain (since European may think to the public domain in a very different way from American's.)" To be sure, he advises, "the public domain is not necessarily the same for an Italian as for an American." *Id.* Interview. To be sure, my approach takes into account the legal principles that stem from the US legal system but it must be pointed out that I am an European, and more specifically, an Italian, who carries all his cultural and language understanding. Thus, any "objectiveness" of the approach will not be possible. And my approach will be inevitably tainted with my own set of believes and values.

³³ But see also Benjamin Kaplan, "An Unhurried View Of Copyright" 46 (1967); Ralph S. Brown, Jr., "Unification: A Cheerful Requiem for Common Law Copyright", 24 *U.C.L.A. L.Rev.* 1070 (1977); Brown, "Publication and Preemption in Copyright Law: Elegiac Reflections on *Goldstein v. California*," 22 *U.C.L.A. L.Rev.* 1022 (1975); Brown, "Product Simulation: A Right or a Wrong?", 64 *Colum.L.Rev.* 1216 (1964); and Brown, "Eligibility for Copyright Protection: A Search for Principled Standards", 70 *Minn.L.Rev.* 579 (1985).

generally, all human knowledge) are made up of fragments of other information products³⁴ and that, in the end, we all "stand on the shoulders of giants."³⁵ Lange's was a call that, if not strongly heard by courts, was promptly and widely answered by many scholars.

§ 4) *Public Domain as a Rhetorical Trope*

In the effort to give it a positive definition and meaning, the public domain has been variously construed or "shaped" as a *fictio juris*,³⁶ as freedom to access information,³⁷ as a remedy for monopolistic control of information,³⁸ as a cultural landscape,³⁹ as a standard,⁴⁰ and as a sensory stimuli.⁴¹ Furthermore, Yochai Benkler pointed out the first amendment dimension of the public

³⁴ One person's information output is someone else's information input; See e.g. Italo Calvino, "Molteplicità" in "Lezioni Americane. Sei Proposte per il Prossimo Millennio." Mondadori Ed. (1993); Rosemary J. Combee, "The Cultural Life of Intellectual Properties: Authorship, Appropriation, and Law" (1998); Susan P. Carawford, "The Biology of the Broadcast Flag", 25 *Hasting Comm./Ent. L. J.* 603 (2003); See Suzanne Scotchmer, "Standing on the Shoulders of Giants: Cumulative Research and the Patent Law," at 29 *J. Econ. Persp.* (Winter 1991); See Julie E. Cheon supra n. 18; Pamela Samuelson & Suzanne Scotchmer, "The Law & Economics of Reverse Engineering", 111 *Yale L. J.* 1575 (2002).

³⁵ The phrase comes from Sir Isaac Newton, who stated, "If I have seen farther, it is by standing on the shoulders of giants." Letter from Isaac Newton to Robert Hooke (Feb. 5, 1676), reprinted in Robert K. Merton, "On the Shoulders of Giants: A Shandean Postscript" *The Post-Italiante Version 1* (1993).

³⁶ See Jessica Litman "The Public Domain," 30 *Emory L. J.* 965, 1990 at 968. Litman opposes the traditional view of the public domain as the mere negative aspect of property. She claims that "The Public Domain should be understood not as the realm of material that is undeserving of protection, but as a device that permits the rest of the system to work by leaving the raw material of authorship available for authors to use."

³⁷ See Lawrence Lessig, "The Future of The Ideas," Random House Ed, (2001). According to Lessig: "By a commons [i.e. the public domain: when a work, a resource, is accessible for everyone and this work pertains the cyberspace, the term generally used in the literature is *commons*] I mean a resource that is free. *Not necessarily zero cost, but if there is a cost, it is a neutrally imposed, or equally imposed cost.*" In other words, the public domain is a resources that can be protected by a liability rule rather than a property rule. See also: Jerome J. Reichman "Of Green Tulips and Legal Kudzu: Repackaging Rights in Subpatentable Innovation," 53 *Vand. L. Rev.* 1743, 1747-53 (2000); Larry Lessig, "The Architecture of Innovation," 51 *Duke L. J.* 1783, 1788 (2002)

³⁸ Boyle urges that what one argues is or is not in the public domain depends on *why* one cares about it; it depends on the vision of freedom or creativity one thinks the public domain stands for, and what dangers it protects against. The public domain, Boyle argues, will change its shape "according to the hopes it embodies, the fears it tries to appease, and the implicit vision of creativity on which it rests." The peculiar Boyle's concern is maintaining innovation against the danger of monopoly, the monopolistic control over "chock points imposed by the will of others, freedom from others telling us what we can do". In the end, the public domain for Boyle (*rectius*: its content) becomes what "will cure monopoly control of standards with strong network effects."³⁸ But see James Boyle, "Shamans, Software, & Spleens. Law and the Construction on the information Society", at 6, Harvard University press, 1996; James Boyle, "Foreword: The Opposite of Property?", at 1, 66, *law and Contemporary Problems*, (winter/spring 2003) James Boyle, "The Second Enclosure Movement and the Construction of the Public Domain" at 42, 66, *law and Contemporary Problems*, (winter/spring 2003). James Boyle, "A Politics of Intellectual Property: Environmentalism for the Net?" 47 *Duke L.J.* 87 (1997).

³⁹ In her article she (substantially) advances two claims: artistic culture is an intrinsic good worth privileging and, artistic culture is most usefully understood not as a set of products ("cultural goods"), but rather as a relational network of actors, resources, and creative practices. She argues that this network develops in ways that are path-dependent, cumulative, recursive, and collaborative. An interesting point is that, according to Choen, a crucial ingredient in the development of artistic culture is the practical, uncontrolled accessibility of any elements within the network to other elements. She understands the public domain as a "*policy construct*" intended to foster the development of artistic culture. Therefore, she claims, a theory of the public domain makes sense when measured against the ways creative practices work. But see Julie E. Choen supra fn. 18.

⁴⁰ According to Schaffner, "[t]he public domain represents a *standard*⁴⁰ against which congress evaluates added value." In the patent field of law, the invention in the public domain becomes a standard, that is the "concrete example, a specification" against which the choice to grant protection must be evaluated. But see: Joan E. Schaffner, "Patent Preemption Unlocked", *Wis. L. Rev.* 1081, (1995).

⁴¹ After reviewing the purposes and economical meanings of the protection granted to IPRs, Oddi concludes that there is a strong theme running through intellectual property law that recognizes the importance of the disclosure of intellectual

domain,⁴² Wendy Gordon offered a jusnaturalistic insight of it⁴³, and Pamela Samuelson “mapped” it.⁴⁴

Sometimes, however, the attempt to instantiate an affirmative defence of the public domain can increase the risk that the public domain will “appear amorphous and vague, with little more of substance in it than is invested in patriotic or religious slogans on paper currency.”⁴⁵ To be sure, every way in which a work lays in or enters the public domain bears some problem that cannot be resolved with the aid of the concept of the public domain as it is construed by the majority of scholars. For instance, if a work enters the public domain because the term of protection expires, one problem is whether it is possible to extend the term of protection; if an intellectual endeavour is or is not covered by IPRs, a problem could be whether it is possible to (further) enlarge the scope of protection; and, in the affirmative, by means of which guidance? And so on and so forth. Frequently, crafting the public domain one way or another does not solve any of these problems.⁴⁶

However, all of these attempts to fashion a theory of public domain share a rhetorical significance. Rhetoric is a powerful tool that is used to *persuade* when one cannot “convince” because it would be impossible to “geometrically” demonstrate, in a mathematical fashion, a particular outcome in a regulatory framework.⁴⁷ As Mark Rose admonishes: “at the present moment, as we attempt to argue for the value of the public domain, we need to understand that we are fashioning a rhetoric as well as a politics of the public domain.”⁴⁸ According to Rose, “rhetoric is crucial” but, I would argue, it is not enough. Fashion as a policy does not necessarily mean fashion as a “private right.” It is definitely important to make the public domain visible in the social and

creations for their value as stimuli for further creation (and “without the quo of disclosure, the quid of protection is undermined.”) He reviews the neurobiological and psychological mechanisms by which human beings think and perceive external stimuli. He argues that those stimuli, represented by things in the external world and perceived by the senses of humans, trigger the “creative process” that lead, in turn, to new and original mental conceptions and ideas. Oddi argues that all of these stimuli lie in the public domain. But see: A. Samuel Oddi, “The Tragicomedy of the Public Domain in Intellectual Property Law,” at 8, 25 *Hasting Comm. & Ent. L. J.* 1. (Fall 2002).

⁴² Yochai Benkler takes into account the influence of the copyright system on the US First Amendment and he wants to assert that the public domain is not a “subsidy to users” but is a constitutional required element of U.S. information law. See Yochai Benkler, “Free As The Air To Common Use: First Amendment Constraints On Enclosure Of The Public Domain”, 74 *N.Y.U L. Rev.* 354, (1999); Yochai Benkler, “Freedom in the Commons: Towards a Political Economy of Information”, 52 *Duke L.J.* 1245 (2003); Yochai Benkler, “Through the Looking Glass: Alice and the Constitutional Foundations of the Public Domain”, *Law and Contemporary Problems* (Winter/Spring 2003).

⁴³ Wendy Gordon supplies a good exegesis of the natural law theories of John Locke to explain the significance of a rich public domain in intellectual property as so to protect a free speech interest. The main point - that could give a specific meaning to the concept of public domain - is that, according to Gordon’s interpretation of Locke’s theory, when the private and public domain clash, the latter must prevail. But see: Wendy J. Gordon, “A Property Right in Self-Expression: Equality and Individualism in the Natural Law of Intellectual Property,” 102 *Yale L.J.* 1533, 1556-57 (1993).

⁴⁴ Pamela Samuelson proposes to “map” the public domain and defines it as “a sphere in which contents are free from intellectual property rights” even though, she adds, there is a “murky terrain” near the boundaries consisting of some intellectual creation that Courts have treated as in the public domain for some purposes, but not for all purposes. Cfr. Pamela Samuelson, “Mapping the Digital Public Domain: Threats and Opportunities”, at 147, 66, *Law and Contemporary Problems*, (winter/spring 2003); Pamela Samuelson, “Digital information, digital network, and the public domain”, at 80, 68 *J.L. & Contemp. Probs.* (Autumn 2002).

⁴⁵ See David Lange, “Recognizing the Public Domain”, 44 *Law & Contemp. Probs.* 147, 177 (1981) *supra* fn 32.

⁴⁶ See Edward Samuels *supra* fn 31 and accompanying text.

⁴⁷ See Chaim Perelman and L. Olbrechts-Tyteca, “The New Rhetoric: A Treatise on argumentation,” Introduction, University of Notre Dame Press, (1969). To convince means “to overcome in argument,” from Latin *convincere* “to overcome decisively,” from *com-* intensive prefix + *vincere* “to conquer”. Whereas, to persuade is the action of inducing (someone) to believe (something). Above all in the legal field, we cannot “conquer” (“to put down by force) with logic - as in mathematics - the assent of the interlocutor. However, we can *induce* (from Latin *inducere* “lead into, persuade,”) the interlocutor - by means of *arguments* - to take into account our point. See Online Etymology Dictionary, available at <http://www.etymonline.com/> (last visited August 8th 2006).

⁴⁸ See Mark Rose, “Nine-Tenth Of The Law: The English Copyright Debates And The Rhetoric Of Public Domain”, at 87, *supra* fn. 17.

cultural landscape. But, it is also important to develop an affirmative discourse that will make it a positive *legal* argument, grounded on the living law of courts.

§ 5) Public Domain as a Specific Limit to the Power of Government

Attempts to construe the public domain as a positive rule of law have been made by many scholars. Among the more revealing, Edward Lee⁴⁹ claims that “the public domain [embodies] the affirmative rights of the public to the unrestricted access and use of public domain material.”⁵⁰ Beside the tautology,⁵¹ according to Lee, these rights were embodied in the (twin) concepts of *publici juris* (“of public rights”) and public ownership (or public property), both of which eventually merged into the general term of the public domain, meaning the domain of things belonging to the public. And under this conception, the public domain embodies more than what is left unprotected by intellectual property law. Indeed, “it demarcates constitutional limits on the government’s power to grant IP rights in terms of both their duration and their subject matter.”⁵² According to the author, “the government cannot grant exclusive right over something that is public property and free for all to enjoy.”⁵³ Hence, the public domain imposes limits on the government’s ability to restrict the free flow of information, ideas or materials.⁵⁴

Diane L. Zimmerman gives to the public domain the same affirmative meaning as Lee:⁵⁵ public domain as a source of rights, and, in particular, a right not to be excluded (from the enjoyment of whatever is “publicly accessible.”) For Zimmerman, “the default rule seems to be that once factual or other content is in the commons,⁵⁶ further restraints on its use cannot be imposed.”⁵⁷ It is the public domain that *imposes* that what goes into it must stay there.⁵⁸

According Malla Pollack, the copyright clause, relying on the work by W. Gordon,⁵⁹ invokes “the public domain as a Lockean common: a domain from which each individual has the right not to be excluded.”⁶⁰ She claims that Congress is empowered by the Constitution to create individual ownership in intellectual property “only to the extent that such privatization respects the public’s constitutional right to the public domain”⁶¹ because “the public domain is ‘owned’ in inalienable, indivisible commons by the public, not the federal government.”⁶² In this way the public domain represents, as Lee and Zimmerman argue, a limit to the actions of the government and congress. The limit at hand finds expression in preventing both courts and congress from having power “to withdraw the public domain’s boundaries in pursuit of some now-current economic theory.”⁶³

⁴⁹ See Edward Lee, “The Public’s Domain: The Evolution of Lgal Restraints on the Government’s Power to Control Public Access Through Secrecy or Intellectual Property,” 55 Hasting L. J. 91, (2003).

⁵⁰ Id. at 102.

⁵¹ The public domain is a right to something... in the public domain?

⁵² See Lee supra n. 49 at 102.

⁵³ Id. at 118.

⁵⁴ Id. at 116.

⁵⁵ See Diane Leenheer Zimmerman, “Is There a Right to Have Something to Say? One View of the Public Domain,” 73 Fordham L. Rev. 297. The author explores the first amendment doctrine to sustain her claims.

⁵⁶ Here, “commons” has the same meaning of public domain.

⁵⁷ See Zimmerman supra n. 55 at 356.

⁵⁸ Id. at 372.

⁵⁹ See supra fn 43.

⁶⁰ See Malla Pollack, “The Owned Public Domain: The Constitutional Right Not To be Excluded or The Suprem Court Chose the Right Brekfast Cereal In Kellog V. National Biscuit Co.,” at 286, 22 Hasting Comm. & Ent. L. J. 265, (2000).

⁶¹ Id. at 266.

⁶² Id. at 270. Pollack describes the public’s rights to the commons a form of ownership. I have doubt that this can be the right definition since the kind of ownership envisioned by prof. Pollack turn out to be a right not to be excluded (quite different to the classic bundle of right of ownership which one of the principle right is the one to exclude).

⁶³ Id.

However, this article claims that there is no such public domain- at least not in the cases law. In contrast, all legal consequences that are purported to stem from the concept of public domain come – in the analyzed cases law - from different legal basis.

PART II: THE PUBLIC DOMAIN IN CASELAW

In assessing the normative meaning of the public domain in light of judiciary cases law, there are far more cases recognizing the concept of public property, *publici juris*, or the public domain in the context of intellectual property rights than can possibly be discussed here. In the selection, judgment calls have been made about the importance of the cases based primarily on 1) court decisions using the concept of the “public domain” in adjudicating case law, 2) the depth of the discussion about the public domain, 3) often-quoted cases law used by other authors to ground them on an affirmative and positive meaning of the public domain.

§ 1) *Singer Manufacturing Co. v. June Manufacturing Co.* (May 18, 1896)

The *Singer* case represents the first time the term “Public Domain” was used in the Intellectual Property Rights field by the U.S. Supreme Court.⁶⁴

In this case, *Singer Manufacturing* asserted a trademark claim for its mark “*Singer*” after the patents for its sewing machine had expired.⁶⁵

The Supreme Court rejected *Singer*’s claim because when “patents expire, every one has an equal right to make and vend such machines. If the patentees or their assignees could assert successfully an exclusive right to the name ‘*Singer*’ as a trade mark, they would practically extend the patent indefinitely.”⁶⁶

Lee, Pollack and Zimmerman, among others,⁶⁷ argue that according to the *Singer* case it is possible to conclude that “once something enters the public domain, it must remain there for the public’s unrestricted use.”⁶⁸

This conclusion is far reached, as it appears instead that *Singer*’s claim was rejected by the court for two different reasons.

The first reason concerns the fact that “*Singer*” had become a generic term, that is, a term that “only expresses the kind and quality of the machine.”⁶⁹

The court expanded on this issue on the first part of the case and dealt with this point of law as a preliminary one. The first issue the Court faced was to assess whether the name “*Singer*,” used to indicate the patented invention, had assumed a generic meaning.⁷⁰

The Court considered how the name was used both in connection with the sewing machine and in advertisement, and how the name was then perceived by the public at large.⁷¹

The Court in particular found that “the word ‘*Singer*’ was adopted [...] by *The Singer Manufacturing Company*, in their dealing with the general public, as designative of their distinctive style of machines rather than as solely indicating the origin of manufacture.”⁷²

⁶⁴ See *supra* Part I § 2

⁶⁵ See *Merriam v. Holloway Pub’g Co.*, 43 F450 (1890).

⁶⁶ See *Pollack supra n. 60* at 189-190.

⁶⁷ See *supra* Part I, § 6.

⁶⁸ See *Edward Lee supra n. 49* at 108.

⁶⁹ *Id.* at 110.

⁷⁰ See *Merriam supra n. 65*, at 178. For the meaning of genericness see *infra*.

⁷¹ *Id.* *passim* at 180.

⁷² *Id.* at 181.

According to the Court, the name Singer was incapable of trademark protection because “in consequence of the enjoyment of the monopoly by the makers, the name ‘Singer’ came to indicate, in its primary sense, to the public, the class and type of machines made by the Singer Company [...] and *thus* this name constituted their generic description.”⁷³ It “follows from the cessation of the [patent] monopoly and the falling of the patented device into the domain of things public that along with the public ownership of the device must also necessarily pass to the public the *generic* designation of the thing which had arisen during the monopoly in consequence of the designation having been acquiesced in by the owner, either tacitly [...] or expressly [...]”⁷⁴

In the end, the name Singer could not be protected by a trademark because the name had become the only word to express the kind and quality of the sewing machine.

In assessing the meaning acquired by the term “Singer,” the Court faced the following question: “[w]here the name of a patented machine [...] has become, during the monopoly flowing from the patent, a *generic description of such machine*, [...] has the manufacturer, on the cessation of the monopoly, the right to prevent the making by another of a like machine [...] and also the right to prevent another form calling such machine, by the *generic* name attributed to them during the monopoly[...].” The court answered that the owner has no such rights, *but not because of the public domain*.

After having ascertained that the name “Singer” was generic indeed, to corroborate its argument, the Court went on to state⁷⁵ that “it is self-evident that on the expiration of a patent the monopoly created by it ceases to exist, and the right to make the thing formerly covered by the patent becomes *public property*. It is upon this condition that the patent is granted. It follows, as a matter of course that on the termination of the patent there passes to the public the right to make the machine in the form in which the defendant made the machine [...] It equally follows from the cessation of the monopoly and the falling of the patented device into the *domain of thing public* that along with the public ownership of the device there must also necessary pass to the public the generic designation [...]”⁷⁶

That the term “Singer” became generic *is the reason* it could not be protected anew (otherwise competitors and the public would lack a word to refer to that particular article) and *thus* it entered the public domain. Indeed, the Court argues, quoting *Cheavin v. Walker*,⁷⁷ that “it is impossible to allow a man to prolong his monopoly by trying to turn a description of the article into a trade mark. Whatever is mere *description* is open to all the world.”⁷⁸ Arguing *a contrario*, was the used name not generic (not a description) a further protection would have been allowed. Indeed, the argument continues, “it would be extremely difficult who has been by right of some monopoly the sole manufacturer of a new article, and has given a new name to the new article, *meaning that new article, and nothing more*, to claim that name is to be attributed to his manufacture alone after his competitors are at liberty to make the same article.”⁷⁹ In other words, the qualification in terms of (no) “genericness” of the name used to describe a patented invention is the *condicio sine qua non* upon which the trademark protection can be granted.

This construction, which sees the public domain playing an ancillary role in deciding case law, is reinforced by a careful reading of the last part of the Court’s opinion. In rebutting the complainant’s assertion for exclusive right to the name Singer, the Court mentioned the French law,

⁷³ Id at 1007 (emphasis added).

⁷⁴ Id at 185. Tacitly, in the event that the owner accepts the benefits it of the monopoly; Expressly in the event, like in the instant case, that the owner connects the name the name to the machine as to lend countenance to the resulting dedication. It is evident that a trade mark protection could have been granted had the owner not acquiesced in the name.

⁷⁵ By now we do not care what is the particularly phrasing the court uses. We do not care here if the court uses the term *public juris*, public property or public domain. It is a fact that court uses those terms indifferently. See *supra* Part II, chapter 4, § 2.

⁷⁶ See Merriam *supra* n. 65 at 184 (emphasis added).

⁷⁷ See *Cheavin v. Walker* (1877) Ch. Div. 850.

⁷⁸ See Merriam *supra* n. 65 at 194.

⁷⁹ Id. at 195.

making it of its own: “[t]he designation continues to belong to the patentees in every case but one, if the name given to the product has become the only and necessary designation of the patented article”⁸⁰ Again, it is possible to imagine a case in which the name attached to the machine patented is not the “only and necessary designation” of an invention and, thus, nothing would prevent any further protection. Indeed the Court suggests that, had Singer Manufacturing, Co. made different marketing uses of its name (for example, attaching the word Singer to the machine,) ⁸¹ the conclusion might have been different. The court makes explicit this point arguing that, for example, “two elements which compose a name – that is, the surname of the individual or the firm upon the one side and its tracing or distinctive from’ (in a trademark) - are susceptible of falling into the public domain together or separately [...] Thus one may keep the exclusive right to the use of the name, while the remainder of the mark will belong to every one.”⁸² This excerpt explains that even a name that was used to identify an invention can still be protected, by a Trade Mark, and withheld from the public.

The second reason further protection could not be granted is that the extra protection would have gone against the “bargain rationale”⁸³ that underpins patents (as well as copyrights):⁸⁴ the patentee obtains a time-limited right to exclude others from making, using or selling the invention. In return, the patentee discloses her invention to the public so that, at the end of the patent term, the public has the ability to practice the invention.⁸⁵

Once the term expires, the device becomes owned by the public at large “by the disappearance of the monopoly.”⁸⁶ The public domain (or the “domain of things public” as the court expresses itself,) ⁸⁷ is a legal concept that helps the court to define the new status of the invention. The court uses the term “public domain” to indicate a new kind of control exercised (a new status indeed) on the device: not anymore a private control – because of the patent – but a “public thing,” no longer subject to exclusive appropriation. And this “alteration” in *status* is due to the rationale underpinning the granting of the patent (the “bargain rationale”) and not to some sort of particular meaning that the public domain is purported to have. The term *publici juris*,⁸⁸ public ownership,⁸⁹ “domain of things public,”⁹⁰ or “public domain”⁹¹ are all used to indicate this new status acquired over expiration of IPRs.

Moreover, it does not follow that once something enters the public domain, for this reason alone, it can never be withdrawn.⁹² The statement by which once something enters the public domain, it must remain public property “ever afterwards”⁹³ seems a matter of principle. First, a name formerly used to indicate a patented invention, upon some conditions, can enjoy a new trademark protection (indeed, in 1964 a Federal Court stated that Singer company had recaptured from the public domain his trade name).⁹⁴ Second, the idea of a public domain as a source of

⁸⁰ Id. at 197 (emphasis added).

⁸¹ Id. at 178.

⁸² Id. at 180.

⁸³ See e.g. William W. Fisher, “Theories of Intellectual Property”, in *New Essays in the Legal and Political Theory of Property* Stephen R. Munzer ed., forthcoming (2001). See Robert P. Merges, “One Hundred Years of Solicitude: Intellectual Property Law,” 88 Cal. L. Rev. 2187, 2239-40 (2000). See Diane Leenheer Zimmerman, *supra* n. 55 at 302.

⁸⁴ Even though in copyright the bargain theory has a different weight. See *Eldred v. Ashcroft* *infra*.

⁸⁵ See, among others, Pollack, *supra* n. 60 at 291.

⁸⁶ Id. at 1003.

⁸⁷ Id. at 1009.

⁸⁸ Id. at 1012.

⁸⁹ Id. at 1008.

⁹⁰ Id.

⁹¹ Id. at 1013.

⁹² See Lee *supra* n. 49 at 109.

⁹³ See Merriam *supra* n. 65 at 451.

⁹⁴ See below § 10.

positive rights is undermined by the fact that congress continuously withdraws works from the public domain.⁹⁵

To conclude, what serves as limit of the patent-monopoly is not the entering of the invention into the public domain. Rather, the entering into the public domain is the consequence of the expiration. What affects the Court's reasoning concerning the period of protection is the bargain theory that found its foundation in the U.S. Constitution.

§ 2) Kellogg Co. v. National Biscuit Co. (Dec. 12, 1938)

The Kellogg case⁹⁶ is similar to the Singer case in that it includes a claim to trademark protection upon an expired patent.

The National Biscuit Company was the successor in interest to Henry D. Perky who invented this kind of breakfast. After the expiration of the patent, National Biscuit sued Kellogg under the theory of unfair competition. National Biscuits asserted trade-mark rights in the word "shredded wheat" and trade-dress rights in the pillow-shape of the marketed biscuit.⁹⁷ The Supreme Court refused to enforce either claim.

First, the Court held that the plaintiff "has no exclusive right to the use of the term 'Shredded Wheat' as a trade name. For that is the generic term of the article, which it describes with a fair degree of accuracy [...]"⁹⁸ The first reason upon which the Court denied protection is because the term "is generic, [and hence] the original maker of the product acquired no exclusive right to use it."⁹⁹ In the next part of the opinion, the Court dwelled at length on the reasons why the term had become generic.¹⁰⁰

The second remark of the Court, after having assessed the "genericness" of the term "Shredded Wheat," dealt with the public domain. The name "Shredded Wheat", the Court went on, "as well as the product, the process and the machinery employed in making it, has been dedicated to the public."¹⁰¹ But how did the public domain play a role in the Court's argument? The Court did not mean that protection was unavailable because the patented product "has been dedicated to the public domain" *per se*. Yet again, the key point is that the term had become generic. Saying that a term has become generic is to say that the term has been acquired by the public. This is so because once the term that indicates the product is used by the public to designate that article, and that there would be no others ways (other words) to designate it, then the term *is* generic. It is so because "during the life of patents 'shredded wheat' was the general designation of the patented product [that it] passes to the public upon the expiration of the patent"¹⁰² and when the product flows into the public domain it also flows "the name by which it had become known."¹⁰³ In other words, first, if the term had not acquired a generic meaning, it would have been protected. Also, the role played by the public domain is limited. Again, what counts is that the 'shredded wheat' cannot be protected, not because it has fallen abruptly in the public domain. There is no easy equation for the name being in the public domain upon the patent expiration *and* the unavailability of further protection. The reason for barring protection lies in the fact that "the name which was essentially necessary to vest the public with the full enjoyment of that has become theirs by the disappearance of the monopoly." Putting it differently, the public would lack the word to designate that article that

⁹⁵ See The Berne Convention *supra* n. 27; see *infra* § 10.

⁹⁶ See Kellogg co. V. National biscuit co. 305 U.S. 111 (1938).

⁹⁷ *Id.* at 112.

⁹⁸ *Id.* at 112-113.

⁹⁹ *Id.*

¹⁰⁰ *Id.* at 113-114.

¹⁰¹ *Id.*

¹⁰² *Id.*

¹⁰³ *Id.*

is now in the public domain. As we have seen in *Singer*,¹⁰⁴ it is possible that a name used to indicate the patented article can enjoy protection by trademark law. The court, held just this: “[...] to establish a trade name in the term ‘shredded wheat’ the plaintiff must show [...] that the primary significance of the term in the minds of the consuming public is not the product but the producer. This has not been done.”¹⁰⁵ This excerpt shows that had the plaintiff provided necessary evidence, protection would have been available. The public’s right to the name of the former protected article *could* be “beat” (pre-empted) by the concurrent law of trademark.

As far as the Biscuit’s pillow-shape is concerned, the court reasoned in the same way it did for the name “shredded wheat.” The argument was the following: since the patent machine was designed to produce *only* the pillow-shaped biscuit, and since the patent was taken out to cover pillow shaped forms, then, upon the expiration of the patent, the form, as well as the name, was dedicated to the public.¹⁰⁶ Even here, where the “weight” of the public domain seems significant (mandatory dedication to the public upon expiration of protection), it is not the conclusive argument. Indeed, what makes unprotectable the pillow shape is that “[t]he evidence [was] persuasive that this form is *functional* - that the cost of the biscuit would be increased and its high quality lessened if some other form were substituted for the pillow shape.”¹⁰⁷ A feature is functional when “it is essential to the use or purpose of the device or when it affects the cost or quality of the device.”¹⁰⁸

So, what prevented the Court from granting protection to the pillow shape of the biscuit was the fact that the form was functional. Was the form not functional, protection would have been granted, taking leave of the public domain.

§ 3) *Traffix Devices, Inc. v. Marketing Displays, Inc.* (March 20, 2001)

In the *TRAFFIX* case, respondent Marketing Displays, Inc. held an expired patent for a dual-spring design mechanism that keeps temporary road and other outdoor signs upright in adverse wind conditions.¹⁰⁹ The respondent claimed a trade dress on the dual spring design since its sign stands were recognizable to buyers and users because the patented invention was visible at the sign stand’s base. After the expiration of the patent, petitioner Traffix Devices, Inc. began marketing an almost identical product and Marketing Displays sued under the Trademark Act of 1976 for, *inter alia*, trade dress infringement.

The Court held in favour of the petitioner Traffix “because the plaintiff’s design is a functional feature for which there is no trade dress protection.”¹¹⁰

The Court asserted that “[a]n expired utility patent has vital significance in resolving a trade dress claim, for a utility patent is [only] strong evidence that the features therein claimed are functional.”¹¹¹ and this is so because “the design is not an arbitrary flourish in configuration of the respondent’s product; it is the reason the device works.”¹¹²

¹⁰⁴ See supra Part II § 1.

¹⁰⁵ See *Kellogg* supra n. 96 at 113.

¹⁰⁶ *Id.* at 114.

¹⁰⁷ *Id.* at 115.

¹⁰⁸ See *Traffix Devices, Inc. v. Marketing Displays, Inc.* 532 U.S. 23, 121 S. Ct 1255, 149 L.Ed.2d 164. Indeed, the design or packaging of a product may acquire a distinctiveness which serves to identify the product with its manufacturer or source; and a design or package which acquire this secondary meaning, assuming other requirements are met, is a trade dress which may not be used in a manner likely to cause confusion as to the origin, sponsorship, or approval of her goods.

¹⁰⁹ *Id.* at 21.

¹¹⁰ *Id.* at 23 quoting *Qualitex Co. v. Jacobs Products Co.* 514 U.S. 159, 165, 115 S.Ct 1300.

¹¹¹ *Id.*

¹¹² *Id.* at 34.

Thus, protection is barred not because there was a patent that is now expired and that yields to a sort of “untouchable” public domain. The bar of a further protection does not come, as some scholars claim, from the public domain. The reason protection is denied however, is that the respondent “did not [overcome] the strong evidentiary inference of functionality based on the disclosure of the dual-spring design in the claims of the expired patent.”¹¹³ In fact, the Court concluded, “[a] prior patent [...] has vital significance in resolving the trade dress claim [...] If trade dress protection is sought for those features, the strong evidence of functionality based on the previous patent adds great weight to the statutory presumption that features are deemed functional, until proved otherwise by the part seeking trade dress protection.”¹¹⁴ So, as we have seen in *Singer* and in *Kellogg*, the intellectual property protection would have continued, had the design not been functional and, in particular, protection would have been granted if the feature had been shown to be merely an ornamental, incidental, or arbitrary aspect of the device.¹¹⁵ So, what bars the grant of protection is only the “evidentiary significance” of the expired patent. Arguing *a contrario*, the plaintiff could rebut that evidence and it could be demonstrated that the device is not functional and, thus, could obtain further protection. Once the presumption has been overcome and secondary meaning has been proved, nothing would prevent that shape, previously protected by a patent, to be protected anew according to the trade mark law *regardless of* the fact that the device was or was not previously covered by a patent or another IPRs,¹¹⁶ or whether the device entered the public domain.

The conclusion reached by the Court is somehow forced also by the rationale underpinning trade mark law that, the Court said, “does not exist to reward manufacturers for their innovation in creating a particular device; that is the purpose of the patent law and its period of exclusivity.”¹¹⁷ Rather, the Court added, pointing to the rationale of IPRs protection that “copying is not always discouraged or disfavoured by the laws which preserve our competitive economy.”¹¹⁸

The Court, apparently, avoided taking any position regarding the “question of whether the patent clause of the constitution, of its own force, prohibits the holder of an expired patent from claiming trade dress protection.”¹¹⁹ However, even though indirectly, the Court answered that question. To be sure, in ruling this case, the court pointed to the principle that nothing will prevent further protection as long as requirements to obtain other IPRs protection are met, *disrespectfully* of whether a utility patent has expired or there has been no patent at all.¹²⁰ Again the public domain is not, *per se*, a legal limit to a grant of a further protection.

§ 3.1) Principle of Election

Another blow to the assumption that once something enters the public domain it must remain public property ever after,¹²¹ is delivered by the rejection of the “principle of election.”

The principle of election was a rule that was used to limit an author to only one type of intellectual property protection.¹²²

¹¹³ *Id.* at 23.

¹¹⁴ *Id.* at 29-30.

¹¹⁵ *Id.* at 30.

¹¹⁶ *Id.* at 32 ([E]ven if there has been no previous utility patent the party asserting trade dress has the burden [i.e. has the chance] to establish the non-functionality of alleged trade dress feature).

¹¹⁷ *Id.* at 34.

¹¹⁸ *Id.* at 29.

¹¹⁹ *Id.* at 35 “[i]f despite the rule that functional features may not be the subject of trade dress protection, a case arise in which trade dress become the practical equivalent of an expired utility patent, that will be time enough to consider that matter.”

¹²⁰ *Id.*

¹²¹ See Merriam *supra* n. 65 at 451.

¹²² See See Robert P. Merges, Peter, S. Menell, Mark A. Lemley, “Intellectual property in the New Technological Age”, at 570, Aspen Ed. (2003).

The principle of election was rejected in “In re Yardley”¹²³ by the United States Court of Customs and Patent Appeals¹²⁴ in 1974.

“In Re Yardley” was about a design patent application for a watch that featured a caricature of a famous political figure. The patent examiner turned down the application on the grounds that Yardley had already received three copyright registrations for the watch.¹²⁵ The Court of Customs and Patent Appeals reversed and stated that the principle of election was in direct conflict with the patent, copyright and trademark statutes.¹²⁶

The Court held that “the Congress has not provided that an author-inventor must elect between securing a copyright or securing a design patent. Therefore, we conclude that it would be contrary to the intent of Congress to hold that an author-inventor must elect between the two available modes of securing exclusive rights.”¹²⁷ In other words, the court stated that since each statute strikes its own coverage balance, a work that qualifies for protection under more than one statute is entitled to the protection of each.

The rejection of this principle is another element that may shed light on cases like Singer, Kellog and Traffix.¹²⁸ If, in the light of Yardley, a work can be eligible for both copyright and patent design protection at the same time, the conclusions in the previous cases are backed up. Protection had been negated because of the lack of some specific requirements and not because a rule existed that would prevent a sequence of further protection. The Yardley case is clear in rejecting this kind of rule. To claim that the public domain would discharge this function would mean to reintroduce, at least to a certain extent, the principle of election.

§ 4) Merriam et al. v. Holloway Pub. Co. (September 26, 1890)

The Merriam case (better known as the “Webster case”) is similar to the previous cases since here again what is sought is further protection, upon expiration of an intellectual property right.

In the Webster case¹²⁹ the court faced the problem of recognizing trademark protection to the name “Webster’s” after the term of copyright protection on the dictionary had expired. The owner of the expired copyright sought trade-mark protection to prevent further copies of their¹³⁰ dictionary from being sold under the name “Webster’s” (the name by which the public had known the dictionary).

The court rejected the complainant’s claim arguing that “this proceeding is an attempt to establish the doctrine that a party who has had the copyright of a book until it has expired, may continue that monopoly indefinitely, under the pretence that it is protected by a trade mark, or something of that sort. I do not believe in any such doctrine, nor do my associates. When a man takes out a copyright, for any of his writings or works, he impliedly agrees that, at the expiration of that copyright, such writings or works shall go to the public and become public property. I may be the first to announce that doctrine, but I announce it without any hesitations. If a man is entitled to an extension of his copyright, he may obtain it by the mode pointed by law [...]”¹³¹ Copyright law

¹²³ See In Re Yardley 493 F.2d 1389, 181 U.S.P.Q. 331 (1974).

¹²⁴ Now suppressed.

¹²⁵ See In Re Yardley supra n. 123 at 1391.

¹²⁶ Id. passim at 1391-1395.

¹²⁷ Id. at 1394.

¹²⁸ The outcomes in cases like Singer and Webster could have been influenced by this rule.

¹²⁹ See Merriam supra n. 65.

¹³⁰ “I will say... that the contention that complaints have any special property in “Webster’s Dictionary” in all nonsense, since the copyright has expired. What do they mean by the expression “their book”, when they speak of Webster’s Dictionary? It may be their book if they have bought it, as a copy of Webster’s Dictionary is my book if I have bought it...” Id.

¹³¹ In that time, upon expiration of an initial term of a copyright, another 14 years of protection could have been granted.

gives an author or proprietor “a monopoly of the sale of his writings for a definite period, but the grant of monopoly implies that, after the monopoly has expired, the public shall be entitled ever afterwards to the unrestricted use of the book.”¹³² The Court added that “the contention that complainants have any special property ‘Webster’s Dictionary’ is all non-sense, since the copyright has expired.”¹³³

The court pointed out that granting a trademark protection would mean extending the monopoly that is strictly circumscribed by the law (in particularly by the Constitution). Even though there is undoubtedly a strong defence for the value of the public domain, the Court’s reference to the bargain theory, shows the reason it is not possible to grant any further protection, according the same lines of argumentation pointed out in the previous cases. Furthermore, it may be possible to claim that the Webster case (put in the context of 1890) was influenced by the principle of election.¹³⁴

In these four former cases, the problem was to draw boundaries *between* different intellectual property rights. Can two IPRs protections overlap? After the expiration of an IPR – with the “emergence” of the public domain – is it possible to grant a new form of IPR protection?

The next cases deal with the problem of what can be considered to be the subject matter of IPRs protection. In the former cases, the arguments used by the Court are different from those used in the cases to follow. The reader should be warned that the arguments used in one case cannot be conflated with the arguments used in other cases, with the purpose to reach an univocal meaning of the public domain. They must be kept conceptually separate because different is their rationale.

If in *Singer* and *Webster*, for example, a strong weight was lent to the bargain rationale, in the following cases what is stressed by the Court is the *utilitarian* aspect of the patent/copyright clause. There is a little nuisance between the two arguments, which often,¹³⁵ if not pointed out, can yield to confusion.

If what guides the government is the rationale in the US Constitution art. I, which states that the purpose of each intellectual property policy must be based (also) on utilitarian grounds (*id est*. to further human knowledge), and if to further progress and science means also *an interest* to as big of a public domain as possible, it *does not* follow that the public domain acts as a rule asserting to deny or bestow, according the single case, legal protection.

§ 5) William T. Graham et al. v. John Deer Company et al. (February 21, 1966)

The Graham case¹³⁶ was about a patent for a new kind of plough that was held invalid because of obviousness of subject matter.

Some authors read in this case a usage of the public domain to demarcate a constitutional limit that indicates what subject matter or material cannot be made the subject of Congress’ grant of exclusive right.¹³⁷ This however, is a forced interpretation in an attempt to give the public domain a meaning that it does not have.

The court held that: “[a]t the out set it must be remembered that the federal patent power stems from a specific constitutional provision which authorizes the Congress ‘To promote the Progress of [...] useful Arts, by securing for limited Times to[...] inventors the exclusive Right to their[...] inventions.’”¹³⁸ The clause is both a grant of power and a limitation, the Court said.¹³⁹ This

¹³² See Merriam supra n. 65 at 451.

¹³³ Id. at 452.

¹³⁴ See supra Part II §3.1.

¹³⁵ See e.g. Choen supra n. 18, Oddi supra n. 41, Lee supra n. 49.

¹³⁶ See. William T. Graham v. Jhon Deer Co., 383 U.S. 1, (1966).

¹³⁷ See Lee supra n. 49 at 110. See also Boyle supra n. 5.

¹³⁸ See Graham supra n 136 at 687.

¹³⁹ Id. at 679.

qualified authority of the congress, unlike the power often exercised in the sixteenth and seventeenth centuries by the English Crown, is limited to the promotion of advances in the ‘useful arts.’ “It was written against the backdrop of the practices – eventually curtailed by the Statute of Monopolies – of the Crown in granting monopolies to court favorites in goods or business which had long before been enjoyed by the public. The Congress in the exercise of the patent power may not overreach the restraints imposed by the stated constitutional purposes. Nor may it enlarge the patent monopoly without regard to the innovation, advancement or social benefit gained thereby. Moreover, congress may not authorize the issuance of patents whose effects are to remove existing knowledge from the public domain, or to restrict free access to materials already available.”¹⁴⁰

The Court went on to quote British case law and made the remark that in the UK, patents were granted to goods that “had long before been enjoyed by the public.”¹⁴¹ This is exactly what the US farmers wanted to react to. This is the crucial point: the premise the US Framers started from. In fact, this is the key point that Court deemed “must be remembered at the out set.”¹⁴²

What here seems to influence the power of Congress is the patent/copyright clause, the “promotion of progress and useful arts” therein. The public domain *per se*, it is not a limit.

In the end, the Court enlarged on the patent’s rationale and, among others, quoted Thomas Jefferson: “ideas should freely spread from one to another over the globe [...] Inventions [...] cannot, in nature, be a subject of property.”¹⁴³ Thus the reason a patent, a limited monopoly, is granted is because “society may give an exclusive right to the profits arising from [inventions], as an encouragement to men to pursue ideas which may produce utility.”¹⁴⁴ And the reason the patent must *not* be granted to inventions which had long before been enjoyed by the public, is not because of the public domain, but, rather, because “only inventions and discoveries which further human knowledge, and were *new* and *useful*, justified the special inducement of a limited private monopoly.”¹⁴⁵ Inventions neither new nor useful, therefore, do not “further human knowledge.” The answer to *why* an invention must be *novel* is: to promote progress. Holding something back from what is publicly available (i.e. is in the public domain) means not fostering progress but actually discouraging it. Indeed “innovation, advancement, and things which *add to the sum* of useful knowledge are inherent requisites in a patent system which by constitutional command must ‘promote the Progress of... useful Arts.’”¹⁴⁶ To impede the flow into the public domain would mean not “to add” but only to remove something from “the sum of the useful knowledge.” This explains why part of the criteria the patent must meet is “novelty” and “non-obviousness.” Non-obviousness requires that the difference between the invention and what is publicly available be significant enough such that it would have not been “obvious” at “one skilled in the art.”¹⁴⁷ This criteria further promotes the requirement that the invention add value to society by heightening the standard for added value; obviousness (together with the other requirements) define sufficient added value to justify granting property rights to an inventor.¹⁴⁸

If the assumption is that progress is guaranteed by the spread of knowledge and the diffusion of innovation, it does not follow that impeding - *tout court* - something “pouring” into the public domain stifles progress. The granting of patent and copyright does just this. What stifles progress, *in this instance*, is not the grant of protection *tout court* but is the granting of protection in something that was *already* publicly known.¹⁴⁹

¹⁴⁰ Id. at 688.

¹⁴¹ Id. at 690.

¹⁴² Id.

¹⁴³ Id. at 688-689.

¹⁴⁴ Id. at 689.

¹⁴⁵ Id. (emphasis added).

¹⁴⁶ Id. (emphasis added).

¹⁴⁷ See 35 USC § 102(g).

¹⁴⁸ See Schaffner *supra* n. 40 at 1094.

¹⁴⁹ This case is different from the previously one. In this case the complainant is seeking protection for something that has never been protected. In the previously cases, the protection was sought after a former protection had expired.

In this respect the public domain is used (as it was used in the previous cases) as a status and nothing more: what was characterized by the quality of *being* publicly available.

The Court is not concerned about what is now in the public domain because it was once protected. The court is trying to fix the boundaries *of* the patent subject matter (boundaries between public and private ownership) and the Court achieves this purpose by pointing to the public domain but, in the end, resting its conclusion on the “functional theory.” In this case, that theory is the herald and the bearer of public interest, and it absorbs and encompasses the values represented by the evocation of the public domain.¹⁵⁰

§ 6) Feist Publications, Inc v. Rural Telephone Service Company, Inc (March 27, 1991)

Feist Publications¹⁵¹ discusses the originality of databases and represents an analogy of Graham in the copyright field.

The issue in Feist was whether a copyright could be granted to a telephone directory on the basis that the compiler of the directory had “labored” to collect the data. The Court rejected this “sweat of the brow” theory.¹⁵²

Feist Publication Co. is a publishing company that specializes in telephone directories. In an attempt to enlarge its business, Feist began working on a database of telephone numbers. In creating this database, Feist copied a substantial part of the white-pages directory from its competitor Rural Telephone Service, who sued.

The Supreme Court rejected the claim because it found that the compilation allegedly infringed lacked *originality* in its selection and arrangement of facts therein. The attention of the Court was drawn on the concept of “originality.”¹⁵³ Originality means that a work must be independently created by the author (not copied) and must possess a minimal degree of creativity in order to qualify for copyright.¹⁵⁴

The idea that public domain helps to define, in copyright law, what is not original and therefore not copyrightable¹⁵⁵ is fascinating and may hold water,¹⁵⁶ but there is a difference in saying that the public domain helps to define originality with the idea that it bestows rights and duties. I cannot agree with authors that as an apology of the public domain, rely heavily on the fact that the Court stated that materials in the public domain “are, by definition, not original and [thus] beyond the scope of copyright.”¹⁵⁷ To be sure, this is true, but only to a certain extent. Indeed, it is possible to claim a copyright in a work already in the public domain. It is possible, indeed, to rightfully claim a copyright in a work *identical* to a work already in the public domain, when some requirements are met. As we already pointed out “originality” does not require a “novel” creation as patent law does for inventions.¹⁵⁸ This concept is clarified by the Court: “if [...] a man who had

¹⁵⁰ The rule asserted by the Graham case (“Congress may not authorize the issuance of patent whose effects are to remove existent knowledge from the public domain, or to restrict access to material already available”) is limited only to application for patent. See Lawrence Golam v. John Ashcroft USDC 310 F. Supp. 2d 12 15.

¹⁵¹ Feist Publication, Inc. v. Rural Tel. Serv. Co. 499 U.S. 340 (1991).

¹⁵² However, this theory was recognized by the Second Circuit, from which the appeal came: “The right to copyright a book... does not depend upon whether the materials which he has collected consist or not of matters which are *publici juris*, or whether such materials show literary skill or originality, either in thought or in language, or anything more than industrious collection”. See *Id.* at 352-353.

¹⁵³ *Id.* at 445.

¹⁵⁴ *Id.*

¹⁵⁵ See Litman *supra* n. 27 at 998.

¹⁵⁶ *Contra* Samuels *supra* n. 31.

¹⁵⁷ See Lee *supra* n. 49.

¹⁵⁸ See Roger D. Blair and Thomas F. Cotter, “Strict liability and its Alternatives in Patent Law,” Berkley Tech. L. Journ. 17, 799, at 808 ff., (2000).

never known it were to compose anew Keats's Ode on a Grecian Urn, he would be an 'author', and if he copyrighted it, others might not copy that poem, though they might of course copy Keats's."¹⁵⁹

Here, the public domain does not prevent the protection of the newly created "Keats's Ode." So, also in this instance, it is not a limit to copyright protection.

Also in compilations of facts it is possible (to a certain extent) to withdraw something from the public domain. A compilation is defined as a "work formed by the collection and assembling of pre-existent material or of data that are selected, coordinated, or arranged, in such a way that the resulting work as a whole constitutes an original work of authorship."¹⁶⁰ In *that* way what belongs to the public again becomes appropriable. Indeed, this is one of the reasons WIPO¹⁶¹ is reluctant to collect in compilation the various kind of "traditional knowledge".¹⁶² Even if the protection in a compilation is "thin,"¹⁶³ it is protection nonetheless: "the compilation author can claim originality[...] in the way the facts are presented."¹⁶⁴ To that extent, law dictates that the main focus should be on whether the selection, coordination, and arrangement are sufficiently original to merit protection. It is irrelevant if the material used for the compilation is or is not in the public domain.¹⁶⁵ If the facts in the public domain arranged in a compilation meet the requirement set out by law, those facts, even in that limited extent, lose the status of public domain. So: a compilation (among other examples) is either an exception to the ban on withdrawing material from the public domain, or might be another argument to sustain that such a rule does not exist.

In the end, in *Feist*, the Court referred to the public domain as merely a status: "on what basis may one claim a copyright in [compilation]? Common sense tells us that 100 un-copyrightable do not magically change their *status* when gathered together in one place."¹⁶⁶ And also: "copyright[...] has no effect one way or another on the copyright or public domain *status* of the pre-existent material."¹⁶⁷ When the Court refers to the term "status," it refers to the legal condition of non-copyrightability, that is, the "condition" of the facts lacking legal protection. In this case what prevents the copyrightability is that the complainant's compilation was not original in the selection and arrangement of the facts. No one may claim originality as to the facts, and "this is [so] because facts do not owe their origin to an act of authorship."¹⁶⁸ Thus originality is *one* limit of copyright. And even if we concede that the public domain may *help* to define the concept of "originality," it is far reaching to claim that the public domain acts like a legal rule.

§ 7) *Dastar Corporation v. Twentieth Century Fox Film Corporation et al.* (June, 2003)

In 1948 General Dwight D. Eisenhower wrote a book about the Allied campaign in Europe during World War II, which was purchased and published, under the title "Crusade in Europe," by Doubleday Publishing.¹⁶⁹

The publisher copyrighted the book and sold the exclusive television rights to the Twentieth Century Fox Film Corporation who, in turn, hired Time, Inc. to create the corresponding television series, "Crusade in Europe", first broadcasted in 1949.

¹⁵⁹ See *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F. 2d 49, 54 (2d Cir. 1936).

¹⁶⁰ See 17 USC § 101.

¹⁶¹ See World Intellectual Property Organization, at <http://www.wipo.org>. (last visited Mar. 12, 2006).

¹⁶² See WIPO Green Paper at <http://www.wipo.int/news/en/documents.html> (last visited Mar. 12, 2006).

¹⁶³ See *Feist* supra n. 151 at 346.

¹⁶⁴ *Id.* at 358.

¹⁶⁵ See 17 USC §103.

¹⁶⁶ See *Feist* supra n. 151 at 345 (emphasis added).

¹⁶⁷ *Id.* at 359.

¹⁶⁸ *Id.* at 347.

¹⁶⁹ See *Dastar Corp v. Twentieth Century Fox Film Corp.*, Supreme Court of the United States 539 US 23, 123 S.ct, 2041, 156 L. Ed.2d 18 2003.

In 1975, Doubleday renewed the book's copyright while Fox failed to renew its television series' copyright, allowing the series to enter the public domain in 1977. Fox, then, in 1988, repurchased the television rights to *Crusade in Europe* and the exclusive right to distribute the television series on videotape.¹⁷⁰

In 1995, the Dastar Corporation copied Fox's videotape (which was by then in the public domain), edited it into a new videotape series and marketed it by the name of "World War II: Campaigns in Europe."

Respondents brought action alleging, among other things, that Dastar's sale of "Campaigns" was conducted without proper credit to the crusade television series and that this behaviour constituted "reverse passing off"¹⁷¹ in violation of § 43(a) of the Lanham Act.¹⁷²

After the District Court and, in appeal, the Ninth Circuit, held Dastar responsible for violation of the Lanham Act, for "bodily appropriation,"¹⁷³ the United States Supreme Court held in favour of Dastar upholding that the Lanham Act does not prevent the unaccredited copying of an uncopyrighted work.¹⁷⁴

Respondents claimed that Dastar had made a "false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which [...] is likely to cause confusion [...] as to the origin [...] of [its] goods" in violation of § 43(a) of the Lanham Act.¹⁷⁵

According to the court, what had to be decided at the onset was the meaning of the wording "origin" of "goods" in § 43 of the Lanham Act: does "origin" refer only to the manufacturer or producer of the physical good that is made available to the public (here the videotapes) or, instead, does "origin" include the creator of the underlying work that Dastar copied?¹⁷⁶

According to the court, "the most natural understanding of the 'origin' of 'goods' [...] is the producer of the *tangible* product sold in the marketplace."¹⁷⁷ According to the court, the phrase "origin of goods," as used by the Lanham Act, is "incapable of connoting the person or entity that originated the ideas or communications that 'goods' embody or contain."¹⁷⁸

Even though the court was well aware that physical goods are inherently and notably different from "communicative products,"¹⁷⁹ they held that giving special treatment to communicative products *in this context* would inexorably cause the Lanham Act to conflict with the law of copyright, which specifically addresses that subject.¹⁸⁰

The court stated that until "an intellectual property right such patent or copyright protects an item, it will be subject to copy"¹⁸¹ and pointed out that if Dastar had been deemed the "origin" of the "goods" – as the respondent claimed – and, thus, would have been subject to a cause of action under the Lanham Act, it "would create a species of mutant copyright law that [would] limit the public's federal right to copy and to use expired copyrights."¹⁸²

¹⁷⁰ As well as the ability to sublicense the right to distribute the videotape to other company. *Id.*

¹⁷¹ "Passing off," or palming off, as it is sometimes called, occurs when producer misrepresents his own goods or services as someone else's; "reverse passing off," as its name implies, is opposite situation, where producer misrepresents someone else's goods or services as his own. Lanham Trade-Mark Act, § 43(a), 15 U.S.C.A. § 1125(a).

¹⁷² See *Dastar supra* n.169.

¹⁷³ *Id.* at 28.

¹⁷⁴ *Id.* at 32.

¹⁷⁵ *Id.* at 24.

¹⁷⁶ See *Dastar supra* n. 169 at 31.

¹⁷⁷ *Id.* at 31 (emphasis added).

¹⁷⁸ *Id.* at 32.

¹⁷⁹ *Id.* at 33.

¹⁸⁰ *Id.*

¹⁸¹ *Id.* at 33 quoting *Traffix Devices supra* n. 108.

¹⁸² *Id.* at 34 quoting *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.* 486 U.S. 1004, 108 S.Ct. 1727 (Mem)U.S. (1988) at 165. The court goes on and held that the right of an author of an artistic work is acknowledged by the 17 USC § 106 A(a)(1)(A). This normative prevision would be superfluous if the court had recognized in § 43(a) a cause of action for misrepresentation of authorship of noncopyrighted works. See *Id.* Furthermore reading "origin" in § 43(a) to require

In the end the Court concluded that Fox was unable to prevail on its Lanham Act claim and thereby indirectly recapture the copyright that had already expired.¹⁸³ “In sum, reading the phrase ‘origin of goods’ in the Lanham Act in accordance with the Act’s common-law foundations (which were *not* designed to protect originality or creativity), and in light of the copyright and patent laws (which *were*), it is concluded that the phrase refers to the producer of the tangible goods that are offered for sale, and not to the author of any idea, concept, or communication embodied in those goods. Cf. 17 U.S.C. § 202 (distinguishing between a copyrighted work and ‘any material object in which the work is embodied.’) To hold otherwise would be akin to finding that § 43(a) created a species of perpetual patent and copyright, which Congress may not do.”¹⁸⁴

This case represents a strong defense for the value of the public domain, reaffirming that individuals are free to use materials publicly accessible without attributing those materials to the original source.¹⁸⁵ The court confirmed the right to copy materials in the public domain and rejected an encroachment over it that would contravene the “carefully crafted bargain” which the rights of a patentee or copyright holder are expressing.¹⁸⁶ Copyright and patent laws are the outcome of a carefully crafted bargain and only congress can intervene to shape and adjust it.¹⁸⁷

With this decision the court takes position against an encroachment of the public domain that would have come through an extensive construction of a statutory law and would have confirmed that the public domain was indispensable to future creative endeavors. The point is that the court curtailed further extension of copyrights based on the different spheres of application of the Lanham Act, originally intended to prevent “likelihood of confusion” and not illicit copying.¹⁸⁸ The balance between the public domain and the copyright holder, the court held, is an equilibrium that can be modified only by congress, within the boundaries of the copyright clause in the U.S. Constitution.¹⁸⁹

Again in this case the public domain is used by the court only as a status, i.e. what is not any longer protected by copyright. It is a confirmation that the public domain *per se* carries no particular legal meaning, being its breadth of existence devolved exclusively to the congress that must act, however, in accordance with the constitution and its interpretation that it is the one (and not the public domain) that limits the flexibility of the congress in the IPRs field.

§ 8) Sears, Roebuck & Co., v. Stiffel Company (April 6, 1964)

The question faced by the court in this case is whether State law, consistent with the federal patent laws, can prohibit the copying of a device which is protected by neither a federal patent nor a federal copyright.¹⁹⁰ The Court held that it cannot.

The respondent, Stiffel Company, secured design and mechanical patents on a “pole lamp.” After the respondent brought the lamp on the market, the Petitioner began selling a substantially identical lamp. Stiffel sued claiming that by copying his design the petitioner had infringed his

attribution of uncopyrighted materials would pose serious practical problems regarding the true “intellectual” source of the information good. See Dastar supra n. 169 at 35.

¹⁸³ See Kurt M. Saunderson, “A Crusade In The Public Domain: The Dastar Decision”, 30 Rutgers computer & Tech. L. J. 161 (2004).

¹⁸⁴ See Dastar supra n. 169 at 37.

¹⁸⁵ See e.g. Stacey L. Garrett, “No Need to Search the Nile: the Supreme Court Clarifies the Use of Public Domain Works in Dastar v. Twentieth Century Fox.” J. L. Tech. & Pol’y 573 (2003).

¹⁸⁶ See Dastar supra n. 169 at 34.

¹⁸⁷ *Id.*

¹⁸⁸ *Id.* at 74.

¹⁸⁹ *Id.* at 37 quoting Eldred, et al., v. John D. Ashcroft, 538 u.s. 916, 123 s.ct. 1505 (mem), 155 l.ed.2d 243, 71 uslw 3578 (2003).

¹⁹⁰ Sear, Roebuck & Co. v. Stiffel Co., Supreme Court of the United States 376 U.S. 225, 84 S.Ct. 784, 11 Ed.2d 661, 1964 at 226.

patent and that, by selling copies of his lamp, Sears had caused confusion in the trade as to the source of the lamp and thus engaged in unfair competition under Illinois law.

The Supreme Court held in favour of the petitioner on the grounds that the respondent's federal patent was invalid. Once the respondent's patent was invalid, the court reasoned, the defendant had the right to copy the plaintiff's design and to sell lamps identical to those sold by the plaintiff. A State cannot use its law of unfair competition to prevent the copying of an article that federal patent laws permit to be copied.

In this case, the Court held, State law gave protection to an article that was not entitled to the protection of either a mechanical or a design patent.¹⁹¹ This would be "too great an encroachment on the federal patent system to be tolerated."¹⁹² In fact, the court reasoned, the power to grant IP protection (concerning the copying of an item in this case) is strictly curtailed by the constitution. A State cannot, the court says, extend the life of a patent beyond its expiration date or give a patent to an article which lacks the level of invention required for federal patents. Doing otherwise would run against the policy of congress of granting patents only to true inventions and only for a limited time. State law, then, cannot encroach upon the federal patent law when the protection given by the State clashes with the objectives of the federal patent laws.¹⁹³

In this case the court held that the lamp was in the public domain, absent of any federal regulation, and therefore might be made and sold by whomever may choose to do so.¹⁹⁴ To allow a State to prevent the copying of an article not otherwise protected at the federal level, would "permit the state to block off from the public something which federal law has said belongs to the public."¹⁹⁵

In this case the right to prevent copying an article clashes with the "welfare of the community"¹⁹⁶ that requires that the requisites to obtaining a patent are strictly observed. The court mentioned the public domain to evoke the value of the "welfare of the community" and to stress the interest of the public to enjoy goods "publicly available."¹⁹⁷ But there is no prescriptive meaning attached to the term.

§ 9) E. Eldred, et. al. v. J.D. Ashcroft (Jan 15 2003) and Luck's Music Library, Inc. and Moviecraft, inc. v. John Ashcroft. (June 10, 2004)

In the Eldred case what is disputed is the Sonny Bono Copyright Term Extension Act (CTEA) approved by the US Congress in 1998.¹⁹⁸

The 1976 copyright act provided for a basic term of protection of the life of the author plus 50 years.¹⁹⁹ The CTEA extended the copyright term by 20 years for both existing copyrighted works and copyrightable works not yet created, establishing a copyright that lasts the life of the author plus 70 years after the author's death.

The petitioners did not challenge the CTEA's "life-plus-70-years" time span itself.²⁰⁰ The *punctum dolens*, rather, was the extension of the copyright term for *existing copyrighted* works,

¹⁹¹ Id. at 231.

¹⁹² Id. at 232.

¹⁹³ Id. at 231.

¹⁹⁴ Id.

¹⁹⁵ Id. at 232.

¹⁹⁶ Id. at 231.

¹⁹⁷ Id.

¹⁹⁸ See Eldred, et al., v. John D. Ashcroft, 538 u.s. 916, 123 s.ct. 1505 (mem), 155 l.ed.2d 243, 71 uslw 3578 (2003). See Sonny Bono Copyright Term Extension Act of 1998, Pub. L. No. 105- 298, 112 Stat. 2827 (1998) (codified as amended at 17 U.S.C. §§ 108, 203(a)(2), 301(c), 302, 303 and 304).

¹⁹⁹ For works made for hire and anonymous or pseudonymous works, a term of either 100 years from creation or 75 years from publication, which ever is shorter.

²⁰⁰ See Eldred supra n. 198.

giving an additional time protection for works that were going to enter the public domain.²⁰¹ The petitioners urged that the fixed period of protection in effect when copyright is secured be the constitutional boundary in the power of congress to further extend the term of protection and claim violation of both the Copyright Clause and the Free-Speech Clause of the constitution.

The Supreme Court rejected the petitioners' claims.

As far as the violation of the free-speech clause is concerned, the Court stated that the CTEA does not restrict free speech "for it grants the author an exclusive right only to a specific form of expression; it does not shield any ideas or facts contained in the copyright work and allows for 'fair use' even of the expression itself."²⁰²

The Court also rejected the alleged violation of the copyright clause since nothing in the constitutional text or history, the court said, prevents that a "limited time" may be later extended for another "limited time."²⁰³ Furthermore, the court rejected the petitioner's argument for the interpretation of "limited time" in light of the clause's preamble statement of purpose ("To promote the progress of science and useful arts").²⁰⁴

The petitioner urged that the CTEA's extension of existing copyright fails "to promote the progress of science and useful arts" because it does not stimulate the creation of new works, but merely adds value to works already created.²⁰⁵ The Court disagreed and put in evidence that Congress' legislative history reveals a constant practice of granting to authors of works with existing copyrights the benefit of the term extension, so that all works under copyright protection will be governed equally under the same regime.²⁰⁶ In other words, according to the court, congress' consistent practice reflects "a judgment that an author that sold his work a week before should not be placed in a worse situation than the author who sold his work the day after enactment of a copyright extension."²⁰⁷ In placing existing copyright holders in parity with future holders, equal incentives to creators are evenly guaranteed, and for this reason the CTEA does not fail to "promote [...] the Progress of Science."²⁰⁸

Another claim was that the CTEA extension of existing copyrights without demanding additional consideration ignores copyright's *quid pro quo*, whereby congress grants the author of an original work an exclusive right for a "limited time" in exchange for the dedication to the public thereafter.²⁰⁹ The court disagreed reasoning that the bargain theory in copyright does not carry as much weight as it carries in patent law. In fact, the court went on, in copyright, the disclosure is not "exacted from" the copyright holder (as it is in patent law) but disclosure is exactly the desired objective of the author seeking protection.²¹⁰ Moreover, the court said, copyright gives the holder no monopoly on any knowledge, facts, or ideas (meanwhile patent law prevents full use by others of the inventor's knowledge.).

In the Luck's Music case,²¹¹ a seller of public-domain foreign music and motion pictures, challenged the constitutionality of the Uruguay Round Agreements Act (URAA)²¹² provision, restoring copyright protection to certain foreign works.

To restore copyright protection means to reinstate certain copyrights that have previously fallen into the public domain.²¹³

²⁰¹ Id.

²⁰² Id. at 771.

²⁰³ Id.

²⁰⁴ Id.

²⁰⁵ Id. at 189.

²⁰⁶ Id. at 188.

²⁰⁷ Id.

²⁰⁸ Id. at 189.

²⁰⁹ Id.

²¹⁰ Id. at 190.

²¹¹ See *Luck's Music Library, Inc. and Moviecraft, Inc. v. John Ashcroft*, 321 F.Supp.2d 107, 27 ITRD 1151, (2004)

²¹² The URAA implemented the General Agreement on Tariffs and Trade 1994 ("GATT"). S. Rep. No. 103-412, at 3, (Nov. 22, 1994). Title V of the URAA implements the Agreement on Trade Related Aspects of Intellectual Property Rights ("TRIPs"), which requires compliance with the Articles 1-21 of the Berne Convention.

The URAA implemented in the U.S. article 18 of the Berne Convention for the Protection of Literary and Artistic Works.²¹⁴ Article 18 of the Convention provides that a member country must apply the protections of the Convention to all works that have not yet fallen into the public domain through the expiration of the copyright's term in its origin country. Section 514, amending 17 U.S.C. § 104A, restores copyright to foreign copyright holders whose works remain protected in their origin country, but entered the public domain in the United States due to the (a) failure of the foreign copyright holder to comply with U.S. copyright formalities, (b) absence of prior subject-matter protection such as sound recordings fixed before 1972, or (c) failure of the United States to recognize copyrights from that country.²¹⁵

The plaintiffs, employing – *mutatis mutandis* - the same arguments used in *Eldred*, claimed that section 514 exceeded the powers granted to Congress in Article I and violated the First Amendment. In particular, the plaintiffs claimed that the IP clause requires the public to have free access to copy and use works once they have fallen into the public domain.²¹⁶

The plaintiffs argued that by enacting Section 514, Congress violated the IP clause as well as the limit imposed by the IP clause grants, because Section 514 grants retroactive copyrights to works that are not original and, hence, does not promote the progress of science and the useful arts.

The District Court of Appeal rejected both claims.

First of all the Court stated, relying on *Eldred*, that past actions of congress show a clear history of allowing retroactive copyrights, lending significant weight to the constitutionality of the URAA.²¹⁷

The plaintiffs claimed that restoration was impracticable for works already in the public domain and they relied on the *Graham* case, where the court stated that “Congress may not authorize the issuance of patents whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already available.”²¹⁸

Here the Court stated, as already stated in *Eldred*²¹⁹ and *Bonito Boats*,²²⁰ that the *Graham* holding is unavailable because a different “scope of protections creates noticeable differences between patent law and copyright law doctrines.”²²¹ According to the Court “while a copyright confers on its owner an exclusive right to reproduce the original work, a patent provides its owner with the far broader right to exclusive use of the novel invention or design for a time-specific period.”²²² For this reason the court affirmed that the *Graham* holding was inapplicable to the present case and therefore nothing, not least the public domain *per se*, would forbid the restoration of expired copyright.

In *Graham*, the Court based its holdings on the rigors of the patent statute's novelty requirement; requirement that almost completely lacks in copyright. The plaintiffs' argument that a copyright cannot remove existing knowledge from the public domain borrows from the patent's requirement of novelty (and not from a purported public domain-rule).²²³ On the other hand, as is stated, the copyright statute has no such requirement.²²⁴ So, if the court in *Luck Music* envisions a limit²²⁵ to the congress in the patent field, this limit is much thinner in copyright.²²⁶ In the copyright

²¹³ See e.g. Julie E. Choen, Lydia P. Loren, Ruth G. Okedjii, Maureen A. O'Rourke, “Copyright In A Global Information Economy”, at 164, Aspen Law & Business Ed, (2002).

²¹⁴ See The Berne Convention supra n. 95.

²¹⁵ See 17 U.S.C. § 104A(h)(6).

²¹⁶ See *Luck's Music Library* supra n. 211 at 24 – 27.

²¹⁷ *Id.* at 116.

²¹⁸ See *Graham* supra n. 136 at 5-6.

²¹⁹ See supra § 8.

²²⁰ See *Bonito Boats* supra n. 182.

²²¹ See *Luck's Music* supra n. 211.

²²² *Id.* at 117 quoting *Demetriades*, 680 F.Supp. at 6627.

²²³ *Id.*

²²⁴ *Id.* and *Bonito Boats* supra n. 182, at 148.

²²⁵ With thin exceptions. There are cases law in which patent protection had been granted retroactively. See *Eldred* supra n. 189 at 760.

field, as is pointed out,²²⁷ requiring novelty would be practically impossible, which is why we are compelled to rely on the troubled concept of originality.²²⁸

§ 10) Public Domain as a Rule or a Principle ?

From all of the analyzed cases emerges a concept of public domain that has been constantly used by Courts to qualify information that is publicly accessible.²²⁹ The public domain had been used to mean a *status* to indicate the “condition” that the particular abstract object at hand “holds with reference to the [IP] rights which are recognized and maintained by law.”²³⁰ It is thus shown that the public domain is employed to express, in negative terms, what is not protected by any form of intellectual property.

As we have seen, the public domain – *rectius*, the value expressed by the public domain - had also been implemented as an ancillary argument in order to assess the single case.

In light of the Courts’ construction of the public domain, and according to present understanding of the analyzed cases law, the public domain, contrary to the prevailing schools of thought, cannot be construed as a *rule* that determines, in a binary fashion,²³¹ which behaviours will be punished or coerced by the public power and which behaviours will be allowed.²³²

The rule, variously formulated and justified, by which something once in the public domain must remain there or that a “right not to be excluded” exists, cannot be found in judiciary decisions. On the contrary, the conclusions in the Eldred and Luck’s Music cases show that is possible to withdraw information from the public domain on the assumption that it does not hamper the progress of science but, rather, can even foster it. This purported rule is disproved by the practice of congress, backed up by Courts, to restore expired copyrights. In fact, had that rule existed, the restoration would have been deemed unconstitutional. In the Traffix case the Court stated that further protection would have been granted, and that would have allowed a partial recapturing from the public domain, if the respondent had overcome “the strong evidence of functionality based on the previous patent.”²³³ Furthermore in Singer Manufacturing Co. v. Briley²³⁴ there is another

²²⁶ In Eldred, even though the Court stated that the copyright clause’s preamble is not an independently enforceable limit on congress power, nonetheless acknowledged that “the primary objective of copyright is to promote the progress of science” and that “the constitutional command [...] is that congress [in enacting copyright law] create a system that promote the progress of science.” Id. at 785** quoting Graham supra n. 136. Accordingly, it seems that the constitutional proviso is construed more elastically in the copyright field than in patent law. In fact, in Luck’s Music we read that “[t]he courts will not find that Congress has exceeded its power so long as the means adopted by Congress for achieving a constitutional end are ‘appropriate’ and ‘plainly adapted’ to achieving that end.” See Luck’s Music supra n. 476 at 117 quoting Schnapper v. Foley, 667 F.2d 102, 111-112 D.C.Cir. (1981). Indeed, thanks to this broad construction of the congress’ power, in Luck’s Music as well as in Eldred, the Court easily found and stated that Congress – notwithstanding an encroachment on the public field - did act to promote the progress of science. In Luck’s Music the court sustained that Congress’ rationale in enacting Section 514 was to secure the protection of copyrights in foreign countries for U.S. citizens. See Luck’s Music supra n...at 119* In fact, given industry losses of \$43 to \$61 billion through piracy, Section 514 is a significant opportunity to reduce the impact of copyright piracy on our world trade position.) and almost identical arguments are offered in Eldred. See Eldred supra n. 463 at 785 stressing the harmonization between American and European system. See Ronald Dworkin “Taking Rights Seriously” at 24, Harvard University Press, (1977) for the difference between “policy” and principle.”

²²⁷ See Litman supra n 27; See also Roger D. Blair and Thomas F. Cotter, “Strict liability and its Alternatives in Patent Law,” Berkley Tech. L. Journ. 17, 799, at 808 ff., (2000).

²²⁸ See Litman supra n. 27. See also Anupam Chander and Madhavi Sunder, “The Romance of the Public Domain” 92 Cal. L. Rev. 1331 (2004).

²²⁹ See Luck’s Music supra n. 211 passim 111 – 118.

²³⁰ See Black Law Dictionary 8th Ed. (2004).

²³¹ “rules are applicable in an all-or-nothing fashion”; See Dworkin “Taking Rights Seriously” supra n. 226 at 24.

²³² See Achille de Nitto, “Diritto dei Giudici e Diritto dei Legislatori. Ricerche in Tema di Teoria delle ‘Fonti’”, Introduzione, Argo Ed., (2002).

²³³ See supra Part II § 3.

²³⁴ Singer Mfg. Co. V. Briley 207 F.2d 519, 99 U.S.P.Q. 303 (1953).

explicit dictum that is in contrast with the purported public domain-rule. In this case, even though the Court acknowledges that under the holding in *Singer Manufacturing Co. v. June Mfg. Co.*²³⁵ the 'Singer' name had come to indicate the class and type of machines made by that company and thus was in the public domain, *however*, the court stated, “the Singer Manufacturing Company has by the constant and exclusive use of the name 'Singer' in designating sewing machines [...] *recaptured from the public domain the name 'Singer'* and it has come to mean not only that the manufactured goods bearing that name are the manufactured goods of the Singer Manufacturing Company, but that the mark 'Singer' serves as a guarantee of quality and that future purchasers of products so marked are the products of the Singer Manufacturing Co. The name 'Singer' has thus become a valid trademark of complainant and is entitled to protection as such.”²³⁶ The Court, after having negated protection to the Singer name, acknowledged 60 years later that it is possible – contradicting the public domain-rule - to withdraw a name that has previously entered the public domain.

I have pointed out that the phrasing “public domain” was borrowed from the field of real property.²³⁷ In that field of law, every time a good is qualified as “public property,” “common property” or “*publici juris*,” the qualification implies that “public interest” is involved, where the adjective “public” indicates something that transcends private or individual interests. In fact, those goods are not the mere objects of competing claims between private parties. A superior interest – sometimes ordered by the constitution some times implied by common law – must be taken into account in composing interests among private parties and between private parties and the State.²³⁸ The relevance of the “public interest” is the least common denominator in the terms “public property,” “common property” and “*publici juris*”, that have eventually seeped into the omnicomprehensive term “public domain.”²³⁹

More and more scholars have been trying to instantiate an “affirmative” concept of the public domain with the purpose of rendering that concept a herald of the “public interests.” But what kind of *public interest* are they talking about? Different types of public interests exist in the IPRs field. There is an interest, dictated by the Constitution, to foster the progress of science and useful arts, an interest in access information, an interest against monopolies, a public interest against “confusion” in the trademark field, and so forth. According to some scholars, all of these different interests can find expression in the “public domain,” which is why more than one concept of public domain has been fashioned. As many public domains can be imagined, many are the “hopes it embodies, and the fears it tries to lay to rest.” But this assumption renders both the interpretation of the concept troubling and its boundaries fuzzy.

However, the purpose shared by public domain advocates consists of instantiate an interest in the access to information, in order to offset the expansion of IPRs protection. But if the baseline policy - access to information - is shared by all, very different ways exist to implement that policy. In the field of copyright, the public interest is best served, Courts say, by “private ends.” According to the Court, “the two ends [public good and reward for authors] are not mutually exclusive; copyright laws serves public ends by providing individuals with an incentive to pursue private ones.”²⁴⁰ On the other hand, public domain advocates maintain that this “public interest” is best served by means of the concept of public domain that, in the intention of many of them, would act as a rule that would forbid any kind of encroachment upon the field of what is publicly accessible.

²³⁵ See supra n. 136.

²³⁶ Id. (emphasis added)

²³⁷ See supra Part I § 2

²³⁸ Supporting this view probably Choen supra n. 18.

²³⁹ Julie Choen supra n. 18 seems to suggest that common property, public property and *publici juris* were used in regard to elements (such as words and facts for example) that are fundamentally public in character whereas the term public domain was used to address matter once covered by IPRs but which term of protection had expired and thus become public by operation of specific, policy-driven rules. Lee supra n.. argues that the shift to the term “public domain” marked the emergence of a mature and robust conception of noncopyrightable and copyright-expired material as inalienable public property.

²⁴⁰ See Eldred supra n. 198 at 785.

In reviewing the Graham case, as well as in the light of the Eldred and Luck Music cases, it is clear that in the patent field the value of the information in the public demesne, and the interest of the public in the access of existent knowledge, is discharged not by the public domain, but it is absorbed and manifested by the novelty and non-obviousness requirement. If the requirement by which congress cannot remove existent knowledge from the public domain, or to restrict free access to materials already available, is the expression of the interest of the “public,” this interest finds manifestation and protection in the constitutional patent clause and is crystallized and made explicit by the requirements of novelty and non-obviousness.²⁴¹ In the Eldred and Luck Music cases, public domain advocates complain that the public interest in accessing information has been disregarded. The public domain, they claim, was not taken into consideration. But the court did not ignore that interest, and it could have not. Only the courts reasoned that the same public interest was best served, in that instance, granting IPRs protection and thus through “private ends.” In the Kellogg and Traffix cases, the court referred to the problem of granting protection upon cessation of an IPR and the main argument used to implement the public interest and deny protection was the genericness of the name *and* the functionality of the shape.²⁴² In the Singer and Webster cases no IPRs protection was granted because, in doing otherwise, it would have “betrayed” the bargain theory’s rationale - where the public interest represents one fundamental prong of the aforesaid “bargain.” In other instances the public interest is served by reference to the pre-emption rule (such as in Sears) or by means of the “balance of interest” stroked by statues and the constitution (such as in the Dastar case). In all of these cases the public interest is implemented by means of legal arguments different from the public domain. This point is made even clearer in another trademark case wherein the court reasoned that to grant trademark protection to an expired design patent does not mean to “[...] extract something from ‘the public domain,’” thus violating the purported rule that envisions the public domain as an inviolable entity. Rather, the Court reasoned, “if the public accepts [complainant’s trade name or design] in a trade mark sense, [complainant] *seeks only federal recognition of that public interest. It is the public that it is protected [...]*”²⁴³ The court did not ignore the public domain, but only implemented the value it represents through different means.

On the other hand, it is almost universally acknowledged that the cultural process is a complex phenomenon in which it is absolutely difficult to cut the edges between what is owned by the IPRs holder and what is not. It is so because of the ontological abstract nature of the IPRs’ object of protection, which renders difficult any gauging or delimitation of boundaries. And if it is difficult in this field of law to exactly delimitate what is own, it is likewise difficult to individuate what is not owned or “owned by the public.” We rely on the troubled concept of originality to set boundaries in copyright law, but it has been argued that the concept is highly inapt to that end; so much of an inapt and troubled concept that it has been labelled as a “romantic vision of authorship.”²⁴⁴ Even the public domain, I claim, will remain a troubled concept insofar as it is “geometrically” delineated by means of conceptual legal categories of ownership.

But what does “public,” in the wording public domain, mean? What does it mean “owned by the public”? Generally the public domain is understood as “[t]he universe of inventions and creative works that are not protected by intellectual-property rights and are therefore available for anyone to use without charge [and *capable of appropriation*] by anyone without liability for infringement.”²⁴⁵ Other sources state that “anyone can use a public domain work without obtaining permission, and

²⁴¹ In the Graham case, see supra Part II § 5.

²⁴² See supra Part II §§ 1-4.

²⁴³ See Application of Mogen David Wine corp., 54 PA 1086, 372 F.2d at 543 USPQ 593 (1967).(emphasis added); See Paul Goldstein, “International Intellectual Property Law: Cases and Materials,” at 907, Foundation Press, (2001).

²⁴⁴ The “romantic Author” is a philosophical construct of the eighteen century, a mythical, idealized figure who creates “original” works from whole cloth. See Mark A. Lemley, “Romantic Authorship and the Rhetoric of Property” book review, 75 Tex. L. Rev. 873, at 22; See Boyle supra n 5 at 56; See also Peter Jaszi, “Toward a Theory of Copyright: The Metamorphoses of ‘Authorship’” 455 Duke L. J. (1991), Luciano Canfora, “Il Copista Come Autore”, Sellerio Ed. (2002).

²⁴⁵ Black law dictionary, 8th edition (emphasis added).

no one can ever own it."²⁴⁶ It is striking the different formulations that, once more, show the ambiguity and vagueness of the concept of public domain. Is what belongs to the public domain the realm of what is appropriable by everyone? Is it, as the Romans would say, a *res nullius*? Or, instead, is it a realm in which nobody has a legitimate property claim as happened in the *res communes omnia*? Or does it refer to something owned and controlled by the government, like in the *res publicae*?²⁴⁷ Probably, if we persist to implement the usual legal categories of private law, we will always miss the point.²⁴⁸ Insofar as we remain in the conceptual framework of private rights, we will have trouble qualifying the public domain. Recognition of the *values* and *interests* underpinning the public domain comes before, ideologically, deontologically and practically, the fashioning of a private right.²⁴⁹ How can it be possible to pretend to set accurate boundaries, cut edges and isolate, by means of property rights, what belongs to and is the outcome of such a complex phenomenon as the "cultural process"? The true problem is the relationship between the culture, the realm of knowledge in general, and the "product" of that process. It is this relationship that deserves the attention of scholars and that can lead to further progress in instantiating a stronger value in the access to information. If we want to foster the *interest* in access to information goods we should better re-think the way in which the usual old law categories of private rights (irregardless of how they are employed)²⁵⁰ are applied to the complex phenomenon of culture and science.²⁵¹

In the end, whatever path one chooses to take in the fight against the "enclosure of the mind," one must confront with the empirical data that, first, the public domain is used and construed by Courts as a status of the mere negative aspects of IPRs; and second, that even though rhetoric matters, the sum of the very different approaches and theories contribute to an image of the public domain as an "empty box," capable of every form and meaning, and thus, probably, with no defined form altogether.

However, from the analyzed cases law emerges further the idea that if the public domain represents a status, it is also a "lens" – through which we look at the facts - that is being tainted by the underlying interest, variously qualified and grounded, case by case. As it has been said, the public domain is capable of many shapes, but, it cannot change its meaning every time. This would run the risk of replicating already existing contents, or creating useless new ones. An attempt should be made, instead, to coagulate all the different interests and values that have emerged until now, into one strong centrifugal force (to the "enclosure"). The name could be "the public domain". As a proposal for further analysis, this public domain would be more apt to express the public interest in the "access of information" – absorbing all the instances in which courts called upon a public interest denying protection - if construed, not as a rule, but as an *interpretive principle* that "states a reason [freedom in accessing "information"?] that argues in one direction, but does not necessitate a particular decision. [...]", and that "officials must take into account, if relevant, as a consideration inclining in one direction or another."²⁵²

²⁴⁶ See "Copyright and Fair Use" available at http://fairuse.stanford.edu/Copyright_and_Fair_Use_Overview/chapter8/index.html (last visited 2/9/06) (emphasis added).

²⁴⁷ See Maria G. Zoz, "Riflessioni in Tema di *Res Publicae*", Giappichelli E., (1990)

²⁴⁸ Probably the public domain is more akin to the *res communes omnia*, mirroring the legal qualification of the ideas before the IPRs step in. See Peter Drahos, "A Philosophy of Intellectual Property", § 9, Dartmouth ed., (1996); but *contra* cfr. Carol. M. Rose, "Romans, Roads, and Romantic Creators: Traditions of Public Property in the Information Age" at 100, 66 Law and Contemporary problems (winter/Spring 2003).

²⁴⁹ See Jeremy Waldron "From Authors to Copiers: Individual Rights and Social Values in Intellectual Property", Symposium on Intellectual Property Law Theory, 68 Chicago-Kent Law Review (1993). See also Bigliuzzi Geri, Breccia, Busnelli, Natoli, I, 2, "*Diritto Civile*" [Private Law], at. 288, Utet Ed., (1986).

²⁵⁰ See Charlotte Hess and Elinor Ostrom, "Ideas, Artifacts, and Facilities: Information as a Common-Pool Resource," at 111, 66 Law and Contemporary problems (winter/Spring 2003).

²⁵¹ And in this regard the work by J. Choen might be a good start.

²⁵² See Dworkin supra n. 226.