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Lost Classics of Intellectual Property Law

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Abstract:

Santayana wrote, “Those who cannot remember the past are condemned to repeat it.” American legal scholarship often suffers from a related sin of omission: failing to acknowledge its intellectual debts. This short piece attempts to cure one possible source of the problem, in one discipline: inadequate information about what’s worth reading among older writing. I list “lost classics” of American scholarship in intellectual property law. These are not truly “lost,” and what counts as “classic” is often in the eye of the beholder (or reader). But these works may usefully be found again, and intellectual property law scholarship would be strengthened by better and more consistent acknowledgement of earlier work.

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Santayana wrote, “Those who cannot remember the past are condemned to repeat it.” American legal scholarship often suffers from a related sin of omission: failing to acknowledge its intellectual debts. This short piece attempts to cure one possible source of the problem, in one discipline: inadequate information about what’s worth reading among older writing. I list “lost classics” of American scholarship in intellectual property law. These are not truly “lost,” and what counts as “classic” is often in the eye of the beholder (or reader). But these works may usefully be found again, and intellectual property law scholarship would be strengthened by better and more consistent acknowledgement of earlier work.

Introduction

Several years ago, I ranted a bit online about how younger American intellectual property scholars either have lost the knack of knowing something about the history of the discipline or never acquired it in the first place. A few years later, I acted on that complaint by compiling lists of what I refer to as “lost classics” of American intellectual property scholarship, older papers and books that appear to be little known to many contemporary scholars yet that contain the seeds of many contemporary ideas. My complaint and my lists first appeared online, as blog posts. I have collected them in this Essay so that they might find a new and possibly broader audience.

I. One Weakness of Contemporary Intellectual Property Scholarship

American intellectual property law scholars are, as a group, pretty sociable and intellectually generous. Since at least the early 1990s, senior scholars have actively mentored, encouraged, and advised junior scholars. As those earliest junior scholars have matured, they have often shared those same gifts with the next generation of juniors, and so on. One institutional manifestation of that tradition has been working papers conferences, the oldest, largest, and most robust of which is the annual Intellectual Property Scholars Conference, or IPSC.¹

IPSC has grown in both size and stature. What was originally conceived roughly 15 years ago as a relatively intimate setting for presentations by newcomers and critiques by senior IP scholars is now an intellectual property free-for-all. I mean that mostly in a good way. The conference is very large; the 2013 version featured well

¹ IPSC has no fixed online home. The conference rotates among Stanford, Berkeley, Cardozo, and DePaul law schools (owing to those being the institutional homes of its original, key faculty sponsors), and each host school assembles a program and website associated with that year’s event.

over 100 presentations. Whereas its earliest iterations limited presentations to those by junior faculty, IPSC now includes presentations by scholars from all across the seniority spectrum. As one would expect of any academic convening, the quality of papers and presentations varies widely, but dinner-and-break conversations are generally very high quality. As a way to track developments in the field, the event has few peers. If you have been in teaching any part of intellectual property law for five years or less, or if as a senior scholar you pride yourself on tracking the new generation of scholarly talent and its work, then IPSC is close to a must-attend conference.

Size and significance come with costs. Some presentations feature mostly finished work, or at least mostly finished paper drafts. But some “papers” aren’t really papers at all, but proposals for papers. Some ideas are raw, and some are half-baked. Panels are usually multi-tracked; usually, relatively little time is given to any particular presenter. While steps are usually taken to discourage people from voting with their feet in the middle of a session, people do. Including papers and presentations by well-established scholars means that juniors can learn from successful models. It also means that large audiences for those well-known folks dilute the pool of listeners and constructive critics of the lesser-known ones.

The growth in the size of the conference partly reflects the tremendous expansion in the number of scholars teaching intellectual property law over the last decade. It also reflects the fact that IP suffers from relatively little of the sclerotic hierarchy that characterizes some disciplines. If you’re a junior scholar and want to present your work, IP offers at least two fora: IPSC and WIPIP (the Works in Progress Intellectual Property colloquium) conference in the Fall. Newer, smaller gatherings of scholars presenting and/or critiquing early work, or work by junior scholars, have emerged at Drake and Michigan State law schools. IPSC itself has gotten so large that work focused on Internet law, which often overlaps with certain parts of IP law, has been hived off into its own working papers conference.

Diversity in paper and presentation quality also follows from a reluctance by the organizers to discipline eligibility too harshly. I organized WIPIP myself once, and I know well the conflicts that are built into managing a conference of this sort. Presenters usually submit and are selected on the basis of abstracts; they are rarely pulled from the program if a paper is not eventually forthcoming. To preserve the spirit of the conference, the organizers largely have to rely on norms of professionalism that suffuse the discipline.

Those norms don’t always exist, or they don’t always suffuse. Law professors who don’t have terminal degrees don’t get trained in the ethos of scholarship the way that graduate students are supposed to, so learning an ethos is sometimes a hit-or-miss proposition. In IP, with the growth in the field over the last several years, there are a

couple of places (in addition to not submitting a paper when an abstract has promised one) where the misses are pretty obvious. In what follows, I address some worrisome tendencies of (mostly) new and junior IP scholars.

One – notable but of less pressing concern – is presenting raw and half-baked ideas at big public conferences like IPSC. Presenting a work-in-progress does not necessarily mean presenting an unfinished work. There are times and places for sharing very-early-stage work: with small numbers of trusted friends and colleagues. At brown-bag lunches. With an Associate Dean for Faculty Development, or a mentor, if there is one. At roundtables organized for that purpose. At a big public conference, however, the paper may not be in its final form, but the form that is delivered should be final. That type of conference is not always a reputation maker, but it can be a reputation breaker. And the audience will give better and more thoughtful feedback to a presentation that has been evidently thought through than it can to one whose gaps are obvious. As always, there are exceptions to the rule; presentation slots at IPSC might be usefully deployed as “brainstorming” sessions by presenters. But one worries that in a competitive environment, with more good proposals than slots, “brainstorming” uses might displace real paper presentations.

Two – and my primary interest here – is not being aware of the historical context of the work. By far the biggest flaw in presentations and papers by junior IP scholars (and sometimes by more senior IP scholars) is their evident ignorance of earlier work. And not just or even work published within the last year or last five years; I’m thinking of the fact that a lot of foundational work published ten years ago or earlier remains significant today. IP doesn’t have a sclerotic hierarchy, but it does have senior people who are still active scholars today, and their earlier work still matters. And, of course, quite a lot of work from decades ago and scholars no longer with us is still relevant today.

This lack of awareness is not uniform. There are many newer IP scholars who demonstrate excellent sensitivity to scholarly context. How to develop this more broadly is an important and difficult disciplinary challenge. Law schools don’t automatically teach it. Law review editors are unlikely to require it; conventional law review articles are often expected to include summaries of the existing literature, but student editors rarely have the knowledge or training to assess them. The echo chamber of law review content doesn’t necessarily produce it; article placement tactics generally reward authors who overclaim the novelty of their work rather than its attention to historical context. Reviews and tenure letters could supply some sense of discipline, but the norms currently associated with those letters mean that they do so only rarely. Reviewers are often selected, or select themselves, for their favorable views of the candidate. Conference organizers could implement more rigorous reviews of proposals, but at obvious costs in terms of access to presentation opportunities.

Works-in-progress and junior scholars conferences could be structured to reward it. More experienced scholars in the field today could volunteer to provide it, both publicly and in one-on-one ways. Some do, I know. But much is left to be figured out on one's own, and that leaves important gaps.

It is possible, of course, that my colleagues are fully informed as to the existence and content of older work and choose not to cite it or discuss it. For any number of reasons that I won't belabor here, I think that's a plausible explanation of part of what I read and hear in current work (or, to be precise, a plausible explanation of what I read and hear omitted from current work), but far from a complete one. The phenomenon is too widespread and long standing. I think that the bigger gap is simply lack of awareness of the intellectual history of the field. Filling *that* gap is what I try to do below.

II. Lost Classics, the Rationale

Off and on during 2009, I assembled lists of key pieces of scholarship and key scholars from an earlier era – from the time before IP became a “hot” topic and before it acquired a somewhat polished theoretical gloss. I came up with three lists, one each for patent, trademark, and copyright law, and at the beginning of 2010 I posted them as the “Lost Classics” series on a blog that I run, madisonian.net. These are pieces that in my own, possibly idiosyncratic opinion, IP scholars should be aware of, even if they haven't read them. The lists are, necessarily, incomplete and provisional, and they reflect some quirks. I'm interested in the intersection of intangible property law and chattel property law, for example, so the work of Zechariah Chafee (memorably the author of a piece titled “The Music Goes Round and Round”) shows up in the Copyright list. I have mostly omitted references to well-known primary sources, such as the Statute of Anne, the Statute of Monopolies, the writings of Thomas Jefferson, and the speeches of Thomas Macaulay.

I call these “Lost Classics” with a bit of rhetorical flourish, not because any of these works or their authors has truly been lost – many if not most are still cited from time to time – but because scholars working in IP today, especially junior scholars, would do well to familiarize themselves with these people and their work. That includes, in the case of the small number of scholars on these lists who are still writing today, their early work. Many of the arguments offered in current scholarship have antecedents or were offered decades ago. Conditions change; the fact that an argument was offered before does not mean that it is not worth reviving. But the intellectual history of an idea is often important.

I applied some simple criteria in compiling these lists: The work must have been first published in 1985 or earlier. Any cutoff date is arbitrary. I chose 1985 primarily to avoid contests about whether work by still-active scholars should be included. Careful readers will note the presence of early work of some people who are, today, leaders in the field. They will also note that the 1985 date means that I omit important early work by others. I might have chosen 1987, or 1989, or 1990. But I didn't. Twenty-five years (working backward from 2010, when these lists were first posted) is a nice round figure.

I did not compile a complete bibliography of relevant scholarship from this earlier era. I included scholars and scholarship whose work or words, it seemed to me, have stood some test of time – or should – or both. (I don't mean, however, to include only work whose arguments anticipate modern equivalents.) Perhaps there are works on the lists that don't belong; no doubt I haven't included works that do. I did not include recent treatises, or casebooks of any kind. Coverage of work published in professional journals rather than in scholarly journals – the *Journal of the Copyright Society*, the *Journal of the American Intellectual Property Law Association*, the *Journal of the Patent and Trademark Office Society*, the *Federal Circuit Bar Journal*, and the *Trademark Reporter*, and their respective predecessors – is spotty, at best. I did not try to cover scholarship published by economists or historians, but some snuck in anyway. And I have not ventured to collect older scholarship first published outside the United States. I don't know that literature, and that's a gap that I hope someone else can fill.

I was struck by the relatively long list that I compiled for copyright law (no doubt due at least partly to my greater personal familiarity with the field) and the comparatively short lists for patent and trademark law. Was there really that much more early scholarship on copyright law? I suspect not.

My various errors and omissions will be cured, I hope, eventually in updated versions of these lists. A few of the entries on the lists below are based on comments contributed to the original posts; thanks to those commenters. I note that one scholar, Lisa Ouellette, picked up and extended the “lost classics” theme in a long blog post on “classic” patent scholarship in 2012.²

The lists begin on the next page.

² See Lisa Larrimore Ouellette, *Classic Patent Scholarship*, WRITTEN DESCRIPTION, <http://writtendescription.blogspot.com/2012/10/classic-patent-scholarship.html> (Oct. 16, 2012).

III. Lost Classics of Copyright Law

(Ordered alpha by author)

HORACE G. BALL, *THE LAW OF COPYRIGHT AND LITERARY PROPERTY* (1944)

AUGUSTINE BIRRELL, *SEVEN LECTURES ON THE LAW AND HISTORY OF COPYRIGHT IN BOOKS* (1899)

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

Ralph S. Brown, *Eligibility for Copyright Protection: A Search for Principled Standards*, 70 MINN. L. REV. 579 (1985)

Ralph S. Brown, *The Joys of Copyright*, 30 J. COPYRIGHT SOC'Y 477 (1983)

Ralph S. Brown, *The Widening Gyre: Are Derivative Works Getting Out of Hand?*, 3 CARDOZO ARTS & ENT. L.J. 1 (1984)

BRUCE W. BUGBEE, *THE GENESIS OF AMERICAN PATENT AND COPYRIGHT LAW* (1967)

Zechariah Chafee, Jr., *Equitable Servitudes on Chattels*, 41 HARV. L. REV. 945 (1928)

Zechariah Chafee, Jr., *The Music Goes Round and Round: Equitable Servitudes and Chattels*, 69 HARV. L. REV. 1250 (1956)

GEORGE TICKNOR CURTIS, *A TREATISE ON THE LAW OF COPYRIGHT* (1847)

Robert Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV. 707 (1983)

Robert C. Denicola, *Copyright and Free Speech: Constitutional Limitations on the Protection of Expression*, 67 CAL. L. REV. 283 (1979)

EATON S. DRONE, *A TREATISE ON THE LAW OF PROPERTY IN INTELLECTUAL PRODUCTIONS IN GREAT BRITAIN AND THE UNITED STATES* (1879)

Paul Goldstein, *Copyright and the First Amendment*, 70 COLUM. L. REV. 983 (1970)

Paul Goldstein, *Derivative Rights and Derivative Works in Copyright*, 30 J. COPYRIGHT SOC'Y U.S.A. (1983)

Wendy J. Gordon, *Fair Use as Market Failure: A Structural and Economic Analysis of the Betamax Case and Its Predecessors*, 82 COLUM. L. REV. 1600 (1982)

Robert A. Gorman, *Copyright Protection for the Collection and Representation of Facts*, 76 HARV. L. REV. 1569 (1963)

Robert A. Gorman, *An Overview of the Copyright Act of 1976*, 126 U. PA. L. REV. 856 (1978)

WILLIAM B. HALE, A TREATISE ON THE LAW OF COPYRIGHT AND LITERARY PROPERTY (1917) [published as Volume 13 of WILLIAM MACK & WILLIAM B. HALE, CORPUS JURIS]

Robert M. Hurt & Robert M. Schuchman, *The Economic Rationale of Copyright*, 56 AM. ECON. REV., May 1966, at 421 (1965 Papers and Proceedings of the Amer. Econ. Ass'n)

BENJAMIN KAPLAN, AN UNHURRIED VIEW OF COPYRIGHT (1967)

David Lange, *Recognizing the Public Domain*, 44 LAW & CONTEMP. PROBS. 147 (1981)

NAT'L COMM'N ON NEW TECHNOLOGICAL USES OF COPYRIGHTED WORKS ("CONTU"), FINAL REPORT (1979)

Melville B. Nimmer, *Copyright vs. the First Amendment*, 17 BULL. COPYRIGHT SOC'Y U.S.A. 255 (1970)

Melville B. Nimmer, *Does Copyright Abridge the First Amendment Guarantees of Free Speech and Press?*, 17 UCLA L. REV. 1180 (1970)

Melville B. Nimmer, *Photocopying and Record Piracy: Of Dred Scott and Alice in Wonderland*, 22 UCLA L. REV. 1052 (1975)

Melville B. Nimmer, *Two Copyright Crises, Foreword to Project – New Technology and the Law of Copyright, Reprography and Computers*, 15 UCLA L. REV. 931 (1968)

L. RAY PATTERSON, COPYRIGHT IN HISTORICAL PERSPECTIVE (1968)

Harvey S. Perlman & Laurens S. Rhinelander, *Williams & Wilkins Co. v. United States: Photocopying, Copyright, and the Judicial Process*, 1975 SUP. CT. REV. 355

Arnold Plant, *The Economic Aspects of Copyright in Books*, 1 ECONOMICA 167 (new series 1934)

J.H. Reichman, *Design Protection in Domestic and Foreign Copyright Law: From the Berne Revision of 1948 to the Copyright Act of 1976*, 1983 DUKE L.J. 1143

Martin A. Roeder, *The Doctrine of Moral Rights*, 53 HARV. L. REV. 554 (1940)

Pamela Samuelson, *CONTU Revisited: The Case Against Copyright Protection for Computer Programs in Machine-Readable Form*, 1984 DUKE L.J. 663

STUDIES PREPARED FOR THE SUBCOMM. ON PATENTS, TRADEMARKS AND COPYRIGHTS OF THE SENATE COMM. ON THE JUDICIARY, FAIR USE OF COPYRIGHTED

WORKS 15, 86th Cong., 2d Sess. (Study No. 14) (Comm. Print 1960) [the so-called Latman study]

ARTHUR W. WEIL, *AMERICAN COPYRIGHT LAW* (1917)

Martha Woodmansee, *The Genius and the Copyright: Economic and Legal Conditions of the Emergence of the "Author,"* 17 EIGHTEENTH-CENTURY STUD. 425 (1984)

Leon Yankwich, *What Is Fair Use?*, 22 U. CHI. L. REV. 203 (1954)

JOHN F. WHICHER, *THE CREATIVE ARTS AND THE JUDICIAL PROCESS* (1965)

IV. Lost Classics of Trademark Law

(Ordered alpha by author)

Harold F. Baker, *The Monopoly Concept of Trade-Marks and Trade Names and the "Free Ride" Theory of Unfair Competition*, 17 GEO. WASH. L. REV. 112 (1948)

Ralph S. Brown, Jr., *Advertising and the Public Interest: Legal Protection of Trade Symbols*, 57 YALE L.J. 1165 (1948)

RUDOLF CALLMANN, *THE LAW OF UNFAIR COMPETITION AND TRADE-MARKS* (1945)

Felix Cohen, *Transcendental Nonsense and the Functional Approach*, 35 COLUM. L. REV. 809 (1935)

Robert C. Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 1982 WIS. L. REV. 158

Ralph H. Folsom & Larry L. Teply, *Trademarked Generic Words*, 89 YALE L.J. 1323 (1980)

Milton Handler & Charles Pickett, *Trade-Marks and Trade Names – An Analysis and Synthesis*, 30 COLUM. L. REV. 168 (1930)

Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203 (1954) [not really trademark law, but a cousin]

Beverly W. Pattishall, *The Dilution Rationale for Trademark – Trade Identity Protection, Its Progress and Prospects*, 71 NW. U. L. REV. 618 (1976)

Beverly W. Pattishall, *Trade-Marks and the Monopoly Phobia*, 50 MICH. L. REV. 967 (1952)

Beverly W. Pattishall, *The Impact of Intent in Trade Identity Cases*, 65 NW. U. L. REV. 421 (1970)

Beverly W. Pattishall, *Two Hundred Years of American Trademark Law*, 68 TRADEMARK REP. 121 (1978)

BEVERLY W. PATTISHALL & DAVID C. HILLIARD, TRADEMARKS, TRADE IDENTITY AND UNFAIR TRADE PRACTICES (1974)

Edward S. Rogers, *The Lanham Act and the Social Function of Trademarks*, 14 LAW & CONTEMP. PROBS. 173 (1949)

Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813 (1927)

FRANCIS H. UPTON, A TREATISE ON THE LAW OF TRADE MARKS (1860)

V. Lost Classics of Patent Law

(Ordered alpha by author)

Donald W. Banner, *Innovation, Patents and the National Interest*, 12 INTELL. PROP. L. REV. 37 (1980)

WARD S. BOWMAN, JR., PATENT AND ANTITRUST: A LEGAL AND ECONOMIC APPRAISAL (1973)

GEORGE TICKNOR CURTIS, A TREATISE ON THE LAW OF PATENTS FOR USEFUL INVENTIONS IN THE UNITED STATES OF AMERICA (1849) [and later editions]

L. James Harris, *Some Aspects of the Underlying Legislative Intent of the Patent Act of 1952*, 23 GEO. WASH. L. REV. 658 (1954)

Edmund W. Kitch, *The Nature and Function of the Patent System*, 20 J.L. & ECON. 265 (1977)

FRITZ MACHLUP, AN ECONOMIC REVIEW OF THE PATENT SYSTEM (SENATE JUDICIARY COMM., SUBCOMM. ON PATENTS, TRADEMARKS, AND COPYRIGHT, STUDY NO. 15, 85TH CONG., 2D SESS. (Comm. Print 1958))

Fritz Machlup & Edith Penrose, *The Patent Controversy in the Nineteenth Century*, 10 J. ECON. HIST. 1 (1950)

Howard T. Markey, *Why Not the Statute?*, 65 J. PAT. OFF. SOC'Y 331 (1983)

A. Samuel Oddi, *Contributory Infringement/Patent Misuse: Metaphysics and Metamorphosis*, 44 U. PITT. L. REV. 73 (1982)

Arnold Plant, *The Economic Theory Concerning Patents for Inventions*, 1 *ECONOMICA* 30 (1934)

Giles S. Rich, *Congressional Intent – Or, Who Wrote the Patent Act of 1952?*, in *PATENT PROCUREMENT AND EXPLOITATION* 61 (The Sw. Legal Found. ed., 1963)

Giles S. Rich, *Escaping the Tyranny of Words – Is Evolution in Legal Thinking Impossible?*, 60 *J. PATENT OFFICE SOC'Y* 271 (1978)

Giles S. Rich, *Laying the Ghost of the “Invention” Requirement*, 1 *APLA Q.J.* 26 (1972)

Giles S. Rich, *The Relation Between Patent Practices and the Anti-Monopoly Laws*, 24 *J. PATENT OFFICE SOC'Y* 85 (1942)

Odin B. Roberts, *Contributory Infringement of Patent Rights*, 12 *HARV. L. REV.* 35 (1898)

WILLIAM C. ROBINSON, *THE LAW OF PATENTS FOR USEFUL INVENTIONS* (1890)

JOSEPH ROSSMAN, *THE PSYCHOLOGY OF THE INVENTOR: A STUDY OF THE PATENTEE* (2d ed. 1931) [republished as *Industrial Creativity: The Psychology of the Inventor* (1964)]

HARRY A. TOULMIN, *INVENTION AND THE LAW* (1936)

ALBERT H. WALKER, *TEXT-BOOK OF THE PATENT LAW OF THE UNITED STATES* (1883) [and later editions and of *Walker on Patents*]