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First PIP (Pondering Intellectual Property) Competition, 2012



Topic
**Should the process of creating an invention
or work determine its protectability as an intellectual
property?**

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Who Is Entitled to the Antelope First: a Lioness or a Vulture?

U.S. IP Law’s Implicit Recognition of Labor Answers the Lioness

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I. INTRODUCTION	1
II. U.S. IP LAW & THE PROCESS OF CREATION.....	2
A. <i>PATENT LAW</i>	2
1. Written Description and the Process of Creation.....	3
2. Obviousness and the Process of Creation	3
3. The True Inventor and the Process of Creation	4
B. <i>COPYRIGHT LAW</i>	5
1. Sweat of the Brow Doctrine.....	5
2. The Feist Decision	6
III. JUSTIFICATIONS FOR PROTECTING IP	7
A. <i>JOHN LOCKE’S LABOR THEORY</i>	7
B. <i>LAW & ECONOMICS</i>	8
C. <i>DISTRIBUTIVE JUSTICE</i>	8
IV. U.S. IP LAW IMPLICITLY RECOGNIZES PROCESS OF CREATION	8
V. CONCLUSION	10

I. INTRODUCTION

On the plains of Serengeti, a lioness spots a herd of antelope. The lioness hones in on one antelope and begins her chase. The genetic agility of the antelope is a tough match for the lioness. She struggles to carry her weight while the antelope’s sprint looks effortless. At last her labor is rewarded and the lioness has caught the prey. After she is done reaping her rewards, the remains of the antelope return to the plains for the vultures and hyenas to consume. Should society reward the lioness’s skills and labor in securing the antelope? This paper answers the question through the lens of intellectual property (IP).

IP covers legally protected assets.¹ These assets include patents, trademarks, copyrights, and trade secrets.² In the U.S., IP protection is governed by the Constitution that grants Congress the power to “promote the Progress of Science and useful Arts, by Securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”³ Under one reading of the IP

¹ Alexander I. Poltorak & Paul J. Lerner, *ESSENTIALS OF INTELLECTUAL PROPERTY* xxvii (2nd ed. 2011).

² *Id.* at 1.

³ U.S. Const. art. I, § 8, cl. 8. Some aspects of IP continue to be governed by state law, rather than federal law, such as local trademark law. *See generally State Trademark Information Links*, UNITED STATES PATENT AND TRADEMARK OFFICE, http://www.uspto.gov/trademarks/process/State_Trademark_Links.jsp (last updated July 24, 2012).

Clause, one can argue that Congress has only the powers explicitly granted to it, namely to “promote . . . [p]rogress” and nothing more, including evaluating the process of creation when evaluating protectability. Under an alternate reading of the Clause, it could be argued that while Congress’s powers are limited to those explicitly granted in the Clause, the phrase “promote the Progress” is fairly broad and could include any method of promotion, including taking into account the process of creation. But examining the entire IP Clause yields yet another perspective. Professor Dotan Oliar has suggested the term “to” modifies “promotion,” meaning the goal of the Clause is for Congress to promote the progress.⁴ And the term “by” modifies “securing for limited times,” meaning that the method of achieving the previously identified goal—promotion—is by granting time-limited rights.⁵ Because numerous ways to read the Clause exist, trying to divine the Framers’ precise intent often leads to divergent views.⁶

Therefore, the text of the IP Clause alone provides limited guidance in determining whether the process of creating an invention or work should affect IP protection. Accordingly, this paper analyzes current law and theories behind IP protection for additional guidance. Specifically, it focuses on patent and copyright law in the United States as representative forms of IP protection. Part II of this paper addresses how U.S. laws regard the process of creation in determining copyright and patent protection eligibility. Part III focuses on the philosophical justifications for protecting IP. Finally, Part IV of this paper attempts to reconcile the lessons of theory and current law; concludes that while the U.S. IP system does not explicitly account for the process of creation in evaluating protectability, it implicitly accounts for labor; and argues that the law’s current treatment of the process of creation is correct.

II. U.S. IP LAW & THE PROCESS OF CREATION

A. PATENT LAW

To qualify for patent protection in the United States, an invention must meet four statutory requirements: (1) the invention must be described in writing and enabled, (2) the subject matter of the invention must be eligible for protection, (3) the invention must be novel, and (4) the invention must be non-obvious.⁷ Enablement and written description require that the patent application explain “the invention, and . . . the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same.”⁸ Enablement represents an exchange between the inventor and the public: the inventor gains patent rights in his

⁴ See Dotan Oliar, *Making Sense of the Intellectual Property Clause: Promotion of Progress as a Limitation on Congress’s Intellectual Property Power*, 94 GEO. L.J. 1771, 1774 (2006).

⁵ See *id.*

⁶ *Id.* at 1781 (arguing that four major interpretations exist with numerous smaller variations). See also *Youngstown Sheet & Tube Co. v. Sawyer*, 343 U.S. 579, 634 (1952) (stating “Just what our forefathers did envision, or would have envisioned had they foreseen modern conditions, must be divined from materials almost as enigmatic as the dreams Joseph was called upon to interpret for Pharaoh.”).

⁷ 35 U.S.C. §§ 112, 101, 102, 103 (2012).

⁸ *Id.* § 112(a).

invention only if the inventor enables the public to practice the invention.⁹ The second requirement mandates that the subject matter of the invention must be a “process, machine, manufacture, or composition of matter.”¹⁰ However, the Supreme Court has held that “laws of nature, physical phenomena, and abstract ideas” do not qualify as patentable subject matter.¹¹ The third requirement, novelty, is defined by what it is not: an invention is not novel if it “was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention.”¹² Similarly, an invention fails to meet the final requirement of non-obviousness “if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”¹³ The role of the inventor’s process of creation comes into play in U.S. patent law in several ways, discussed below.

1. Written Description and the Process of Creation

The written description requirement constrains the process of creation to some degree because, under current Federal Circuit case law, the written description must show that the inventor is “in possession” of his or her invention.¹⁴ This means that based on the written description, a person having ordinary skill in the art is able to perceive that the inventor knows what he or she has invented.¹⁵ The Federal Circuit has explained that the root of this requirement is that patent protection is not available to mere academic theories; rather, protection is available only when an inventor has put in the labor to reduce a theory to a final invention.¹⁶ For example, an inventor of a “species” may not claim the “genus” to which that species belongs without describing the genus.¹⁷ The reasoning behind this policy is that unless the inventor can describe the broader genus of his invention, he is in possession only of the particular species he can describe.¹⁸

2. Obviousness and the Process of Creation

To determine whether an invention would have been obvious in light of the prior art at the time of invention, a court must first ascertain: the concepts and inventions that the prior art discloses, how the claims of the patent at issue differ from what the prior art contains, and finally the level of skill of a person having ordinary skill in the art.¹⁹ A court may also consider “secondary considerations,” including “commercial success, long felt but unsolved needs, [and] failure of others.”²⁰

⁹ *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 736 (2002).

¹⁰ 35 U.S.C. § 101.

¹¹ *Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980).

¹² 35 U.S.C. § 102(a).

¹³ *Id.* § 103(a).

¹⁴ *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc).

¹⁵ *Id.* at 1350.

¹⁶ *Id.* at 1353.

¹⁷ *Id.* at 1349–50.

¹⁸ *See id.* at 1350.

¹⁹ *KSR Intern. Co. v. Teleflex, Inc.*, 550 U.S. 398, 406 (2007) (citing *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966)).

²⁰ *Id.*

Notably, the statutory provision governing obviousness states that “[p]atentability shall not be negated by the manner in which the invention was made.”²¹ But the case law addressing obviousness reveals that there is some tension between adhering to this principle and the analysis in which a court engages in its obviousness inquiry. The Federal Circuit has explained that while a court must avoid using the creative process of the *inventor* in its obviousness analysis, the court *should* consider what the creative process of a person having ordinary skill in the art would have been at the time of the invention.²² To that end, the court has stated, “The inventor's own path itself never leads to a conclusion of obviousness; that is hindsight. What matters is the path that the person of ordinary skill in the art would have followed, as evidenced by the pertinent prior art.”²³

Consequently, the process of creation affects whether an invention is unpatentable as obvious, but it is not the inventor’s process of creation. Rather, the process of creation that would have been followed by a hypothetical person having skill in the art controls the inquiry.

3. *The True Inventor and the Process of Creation*

There is one final caveat regarding the process of creation under patent law in the United States: the statutory scheme explicitly provides that a person is not entitled to patent protection if “he did not himself invent the subject matter sought to be patented.”²⁴ Although this provision appears to be straightforward, it can play an important role in determining whether a person is entitled to patent rights in cases of alleged derivation of the invention from another,²⁵ as well as in cases of joint inventorship.

If a purported inventor derived his or her claimed invention from another, he or she does not qualify for patent protection.²⁶ Consequently, the process of creation affects patent rights when the purported inventor’s creative process included derivation.

U.S. law provides that two or more inventors may apply for patent protection as joint inventors.²⁷ The statute explicitly provides that “[i]nventors may apply for a patent jointly even though (1) they did not physically work together or at the same time, (2) each did not make the same type or amount of contribution, or (3) each did not make a contribution to the subject matter of every claim of the patent.”²⁸ Joint ownership signifies a collaborative process.²⁹ To qualify as a co-inventor, each joint inventor must have contributed significantly to the conception of the invention, and even contributing to a single claim can be sufficient.³⁰

²¹ 35 U.S.C. §103(a).

²² *Otsuka Pharm. Co. v. Sandoz, Inc.*, 678 F.3d 1280, 1296 (Fed. Cir. 2012).

²³ *Id.*

²⁴ 35 U.S.C. § 102(f).

²⁵ *Creative Compounds, LLC v. Starmark Labs.*, 651 F.3d 1303, 1313 (Fed. Cir. 2011).

²⁶ *Id.*

²⁷ 35 U.S.C. § 116(a).

²⁸ *Id.*

²⁹ *Falana v. Kent State Univ.*, 669 F.3d 1349, 1357 (Fed. Cir. 2012).

³⁰ *Id.*

As a result, the details of the process of creation can play an important role in determining an individual's patent rights in the case of joint inventorship.

B. COPYRIGHT LAW

Under the Copyright Act of 1976, copyright protection is afforded to works (1) of authorship; (2) fixed in a tangible medium; and (3) that are original.³¹ The first requirement of copyright protection, work of authorship, includes literary works, musical works; dramatic works; pantomimes and choreographic works; pictorial, graphic, and sculptural works; motion pictures and audiovisual works, sound recordings, and architectural works.³² The second requirement, fixation, is met if the work "can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device."³³ The third requirement, originality, is generally met with "independent creation" and "a modest quantum of creativity."³⁴ While originality is now an express requirement for copyright protection in the United States, courts prior to 1991 gave less weight to originality and instead rewarded labor.³⁵

1. Sweat of the Brow Doctrine

The sweat of the brow doctrine, also known as the industrious collection doctrine, awards labor and time with copyright protection.³⁶ Courts that applied the doctrine justified awarding copyrights even when the alleged owner did not satisfy the originality requirement as now prescribed in the 1976 Act.³⁷ Courts looked to labor because the 1976 Act did not explicitly define what constitutes originality.³⁸ In response to lower courts' reasoning that granting copyright protection under the sweat of the brow doctrine without considering the originality of a work would "risk putting large areas of factual research material off limits and threaten the public's unrestrained access to information,"³⁹ the U.S. Supreme Court in 1991 addressed whether the sweat of the brow doctrine has a place in copyright law, in light of the originality requirement of the 1976 Act.⁴⁰

³¹ 17 U.S.C. § 102(a).

³² *Id.* at § 102(a).

³³ Craig Joyce et al., COPYRIGHT LAW 67 (8th ed. 2010).

³⁴ *Id.* at 82.

³⁵ See *Feist Publ'ns, Inc., v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991).

³⁶ *Feist*, 499 U.S. 340 at 352. See also Lyombe Eko et al., *To Google or Not to Google: The Google Digital Books Initiative and the Exceptionalist Intellectual Property Law Regimes of the United States and France*, 15 J. INTERNET L. 12, 27 (2012) (stating the sweat of brow doctrine originated from the biblical idea that because of their sins, humans must exert hard work to sustain themselves).

³⁷ *Feist*, 499 U.S. at 352.

³⁸ Jane C. Ginsburg, *Creation and Commercial Value: Copyright Protection of Works of Information*, 90 COLUM. L. REV. 1865, 1895 (1990).

³⁹ *Id.* at 1896 (citing *Financial Information, Inc. v. Moody's Investors Serv., Inc.*, 808 F.2d 204, 207 (2d Cir. 1986)). In *Financial Information*, the Second Circuit held that a publisher for a financial reporting service failed to satisfy the originality requirement. *Financial Information*, 808 F.2d at 207. The court reasoned that copyrightability should not be evaluated by "the amount of effort the author expends, but rather by the nature of the final result." *Id.* at 206.

⁴⁰ See *Feist*, 499 U.S. at 345.

2. The Feist Decision

In *Feist Publications, Inc. v. Rural Telephone Service Company*, the Court denied copyrightability of a telephone directory for failing to meet the originality requirement.⁴¹ In that case, a local telephone service provider sued a publisher of white and yellow pages, alleging copyright infringement.⁴² When the publisher responded by challenging the service provider's copyright, the telephone service provider argued that its labor in going door-to-door and participating in phone surveys to collect information of the consumers entitled it to protection.⁴³

The Court's opinion, written by Justice O'Connor, is often cited for its proclamation that originality is the "*sine qua non* of copyright."⁴⁴ Facts, which lack originality, are generally not copyrightable, but a compilation of facts, which satisfies the originality requirement through its selection and arrangement, is copyrightable.⁴⁵ The Court held that the telephone service provider's alphabetical listings failed to satisfy the originality requirement and therefore were not protected by copyright.⁴⁶

While the Court's opinion acknowledges the unfairness of ignoring the telephone service provider's process of creating the listings—specifically its labor in collecting and compiling the consumer information in alphabetical order—it makes it clear that it is beyond copyright's objective to account for labor.⁴⁷ The *Feist* court clarified that courts in the past have incorrectly justified protection of non-original works under the sweat of the brow doctrine.⁴⁸ The Court also asserted that it had already discredited the doctrine in its prior decisions.⁴⁹ In fact, when the Copyright Act of 1909 was re-hauled as the 1976 Act, Congress replaced the phrase "all the writings of an author" with "*original* works of authorship" (emphasis added) to expressly stress the originality requirement.⁵⁰ The Court's opinion concludes with a quote from its 1980s opinion in *Baker v. Selden* that "great praise may be due to the plaintiffs for their industry and enterprise . . . yet the law does not contemplate their being rewarded [with copyright protection]."⁵¹ *Feist* remains good law in the U.S. and stands for the proposition that the sweat of the brow doctrine cannot supplant the statutory requirement of originality.⁵²

⁴¹ *Id.*

⁴² *Id.* at 342–45.

⁴³ *Id.*

⁴⁴ *Id.* at 345.

⁴⁵ *Id.* at 348.

⁴⁶ *Id.* at 364.

⁴⁷ *Id.* at 349 (stating "the primary objective of copyright is *not* to reward labor of authors, but '[t]o promote the Progress of Science and useful Arts'" and that "originality, not 'sweat of the brow,' is the touchstone of copyright protection.") (emphasis added).

⁴⁸ *Id.* at 351.

⁴⁹ *Id.* at 353 (citing *International News Service v. Associated Press*, 248 U.S. 215 (1918), in which the Court held that copyright protection in a news article did not extend to the facts themselves because facts lacked the requisite originality).

⁵⁰ *Id.* at 351.

⁵¹ *Id.* at 364. (citing *Baker v. Selden*, 101 U.S. 99, 105 (1879))

⁵² See *Am. Massage Therapy Assn. v. Maxwell Petersen Associates, Inc.*, 209 F. Supp. 2d 941, 949 (N.D. Ill. 2002) (citing *Feist's* rejection of the sweat of the brow doctrine). See also *Mid Am. Title Co. v. Kirk*, 59 F.3d 719, 721 (7th Cir. 1995) (same).

III. JUSTIFICATIONS FOR PROTECTING IP

The existence of policy in shaping judicial decisions is unquestioned.⁵³ As set forth in the Part I, *supra*, U.S. IP law is governed by the Constitution. Nevertheless, philosophy has influenced the justification for IP. This section of the paper surveys some prominent philosophy theories, including those of John Locke, Richard Posner, and John Rawls.

A. JOHN LOCKE'S LABOR THEORY

The major premise of John Locke's theory on property is that labor justifies property rights.⁵⁴ Under Locke's view, everything in nature belongs to the public, or the "commons."⁵⁵ A person appropriates property out of the commons by expending effort.⁵⁶ The labor described in Locke's theory is not limited to pure physical exertion.⁵⁷ Specifically, Locke identifies "[i]nventions and [a]rts" as examples of property appropriated in accordance with his labor theory.⁵⁸ The commons, as described in Locke's theory, have been analogized to the public domain in IP, where not-yet-formulated ideas are stored and later return, after the expiration of an intellectual asset.⁵⁹

While Locke's theory of real property has been extrapolated to IP, its application has faced criticism. Firstly, because Locke's theory applies to real property, items in the commons are tangible; only one person can use an item at a time.⁶⁰ On the other hand, IP is typically intangible, and works in the public domain can be freely used by multiple people.⁶¹ Secondly, under Locke's theory, items in the commons do not have prior owners.⁶² In contrast, works and inventions in the public domain often have prior owners because IP reverts to the public domain upon expiration of a statutory fixed term.⁶³ While Locke's labor theory strongly supports the proposition that the process of creation, namely the labor, should be considered when determining IP protection in the form of property rights, these criticisms have restricted the theory's influence on U.S. IP law.

⁵³ See Frank B. Cross, *The Ideology of Supreme Court Opinions and Citations*, 97 IOWA L. REV. 693, 695 (2012) (asserting that "[s]cholars today widely recognize that Supreme Court opinions are not purely legal but, to some degree, reflect the ideology of the Justices.").

⁵⁴ Robert P. Merges, *JUSTIFYING INTELLECTUAL PROPERTY* 31 (Harvard University Press 2011).

⁵⁵ *Id.* at 34.

⁵⁶ *Id.* at 35.

⁵⁷ See Adam Mossoff, *Saving Locke from Marx: The Labor Theory of Value in Intellectual Property Theory*, 29 SOC. PHIL. & POL'Y 283, 317 (2012). See also Hughes, *The Philosophy of Intellectual Property*, 77 GEO. L.J. 287, 301 (1988) (arguing that IP invokes the iconic image Thomas Edison's arduous testing to eventually create the light bulb and that this idea can be analogized to mechanical labor as well).

⁵⁸ *Id.* at 310 (citing John Locke, *TWO TREATISES OF GOVERNMENT: SECOND TREATISE* section 44 (Peter Laslett ed., student ed. 1988)).

⁵⁹ Merges, *supra* note 54 at 33.

⁶⁰ *Id.* at 36.

⁶¹ *Id.*

⁶² *Id.*

⁶³ *Id.*

B. LAW & ECONOMICS

Another theory to justify IP is Law and Economics, often recognized by its association to Judge Richard Posner. The foundation of Posner's theory is that society is driven by "wealth-maximization."⁶⁴ Economic principles support existing IP law's policy of granting time-limited exclusive monopolies of the rights in intellectual assets to authors or inventors in exchange for the author or inventor's time and effort in creating the asset.⁶⁵

C. DISTRIBUTIVE JUSTICE

The principle theory of distributive justice, fathered by John Rawls, is that resources should be distributed fairly.⁶⁶ This theory is often said to conflict with Locke's labor theory that rewards property rights to those who invest labor.⁶⁷ The reasoning behind this conflict is that appropriating property as a function of labor "teaches away," in the words of patent law, from allocating property in an equal manner.⁶⁸

IV. U.S. IP LAW IMPLICITLY RECOGNIZES PROCESS OF CREATION

The survey of how current U.S. law treats the process of creation in the areas of patent and copyright, discussed in Part II, *supra*, reveals a common theme: while the labor a creator or inventor puts into his or her work sometimes affects the IP protection he or she is granted, labor alone is not enough to merit protection. Certainly some works are useful even when they are not sufficiently "new," but the reward for developing such a product comes from the marketplace, not from a grant of rights. To qualify for IP protection, the invention or work must be new, original, non-obvious; that is, it must provide a benefit to the public through its "newness."

For example, the "in possession" requirement in patent law illustrates this relationship between labor and "newness." An invention must be non-obvious to be patentable, but if the inventor has not invested enough labor into his or her work to transform an academic theory into a final invention—as Locke would say, to be adequately "in possession" of it—he or she will receive no patent protection.⁶⁹ Furthermore, this relationship can explain the effects of the "true inventor" requirement. Patent applicants who derived their inventions from another are not entitled to protection, despite the newness of their inventions, because they did not put any labor into the invention itself. Conversely, joint inventors have put labor into the invention by contributing significantly to it.

⁶⁴ See Tom G. Palmer, *Intellectual Property: A Non-Posnerian Law and Economics Approach*, 12 *HAMLIN L. REV.* 261, 261 (1989).

⁶⁵ Viktor Mayer-Schönberger, *In Search of the Story: Narratives of Intellectual Property*, 10 *V.A. J. L. & TECH.* 11, 30 (2005)

⁶⁶ *Merges, supra* note 54 at 102.

⁶⁷ *Id.* at 135.

⁶⁸ *Id.* See also *KSR Intern. Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007) (stating that "when the prior art *teaches away* from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.") (emphasis added).

⁶⁹ See Part III, *supra*.

Similarly, putting in the time and effort to compile the data necessary to print a phonebook is not enough to merit copyright protection when there is no element of originality.⁷⁰ But arguably developing a copyrightable work that is original requires the creator to put labor into the work. As Locke has explicitly stated, labor is not restricted to physical exertion.⁷¹ For example, arranging the costume and accessories of a subject prior to taking a photo or designing a mannequin head with a “hungry look” requires some exertion of mental labor to all but a minute proportion of the population.⁷² Therefore, labor alone is not enough for copyright protection, but it can affect the rights an inventor or creator is granted when the newness requirement is met.

Advocates for taking into account the labor that a creator puts into his invention or work in determining the work’s IP protection would likely argue that the labor exerted should be rewarded to serve as an incentive to work hard. Without assurance that their efforts will be rewarded, will individuals be motivated to put the time and effort to bring their creations to life? Will their intrinsic intellectual motivation to create be enough to incentivize them? Some people clearly believe the answer is no. For example, many employers offer their employees financial incentives to file patents,⁷³ a practice that indicates that they believe their employees will not invent, or at least not as much as they should, without this incentive.

Furthermore, rewarding labor is in accordance with the major justifications for IP protection.⁷⁴ From a Lockean perspective, real property is the tangible non-temporal reward for one’s labor. For intellectual property, on the other hand, there is often no tangible non-temporal reward for an inventor’s hours of laboriously formulating an innovative idea, apart from perhaps a nominal employer subsidy, as described. Accounting for labor is also in line with a Posnerian economics perspective. Given that society’s goal is wealth-maximization, implementing some incentive program recognizing and justifying an inventor’s labor to pursue a work or creation capable of IP protection is advantageous for the success of a business.⁷⁵ In some instances, however, many individuals will still pursue creative, inventive activities even without any guarantee of valuable IP rights at the end of their efforts.⁷⁶

Moreover, attempting to take into account the labor spent on a work or invention has serious practical drawbacks. If the U.S. Patent and Trademark Office inquired into the time and resources spent on an invention in a patent application, for example,

⁷⁰ See *Feist Publ’ns, Inc., v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991), discussed in Part II, *supra*.

⁷¹ Mossoff, *supra* note 57 at 317.

⁷² See *Pivot Point Intern., Inc. v. Charlene Products, Inc.*, 372 F.3d 913, 931 (7th Cir. 2004) (holding that plaintiff was entitled to copyright protection on its mannequin which expressed a “hungry look”); see also *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 61 (1884) (holding that photographs are copyrightable).

⁷³ See Geoffrey Owen, *The Science of Innovation*, LOS ANGELES TIMES, Sept. 23, 2012, <http://articles.latimes.com/2012/sep/23/business/la-fi-books-20120923>.

⁷⁴ See Part III, *supra*.

⁷⁵ See Donald Brown, *Protecting Intellectual Property Right from the Start*, E-COMMERCE TIMES, Sept. 22, 2009, <http://www.ecommercetimes.com/story/68175.html> (stating that “[u]p to 75 percent of the value of a U.S. publicly traded company is solely based upon its intellectual property”) (emphasis added).

⁷⁶ See Hughes, *supra* note 57, at 302 (asserting that “many people who spend time producing ideas prefer this activity to manual labor”).

applicants would presumably have to provide some documentation or other proof of that effort. This additional requirement would add another step in the already lengthy patent application process.

Similarly, in the context of litigation, courts or juries might be called upon to determine whether the labor expended while developing a given work was “sufficient” to merit protection, a deeply subjective inquiry.⁷⁷ Moreover, what metric would be used? For instance, if the labor put into a work was measured by the hours spent developing it, inventors would not be incentivized to be efficient. In fact, such a policy would encourage them to spend more time on each individual work, even when the inventor would better serve the ultimate goal “promoting progress” by spending his or her time on other projects and ideas.⁷⁸ Perhaps for the drawbacks of quantifying, courts in the U.S. have generally shunned the idea of a direct correlation between labor and granting IP.

V. CONCLUSION

The Supreme Court in *Feist* concluded that one’s labor should not be evaluated when affording IP protection,⁷⁹ yet the U.S. legal system nevertheless appears to account for the skill and effort an inventor puts into a work in some ways. Society also incentivizes labor by rewarding inventors with monetary prizes and name recognition for the intellectual asset.

Just as a lioness is rewarded for her labor in capturing an antelope, the U.S. should continue to reward inventors for their efforts in creating protectable assets. While codifying a “process of creation” requirement is impractical because of the difficulty in quantifying labor, that should not preclude courts from considering labor, where the asset satisfies the required “newness” criterion. Rewarding labor also serves to motivate inventors to continue creating protectable assets once their IP has enjoyed its statutorily-afforded protection. Once the lioness has reaped her temporal reward of enjoying the antelope, the remains of the antelope return to the plains of the Serengeti or the “commons,” just as IP returns to the public domain after expiration of the protection term: for the enjoyment and benefit of others.

⁷⁷ Ginsburg, *supra* note 38 at n.137 (expressing concern that “a work-by-work analysis again invites courts to draw elusive distinctions between the truly ‘sweaty’ socially useful sweat works”); *cf.* *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251–52 (1903) (discussing the potential dangers of judging the worth of art).

⁷⁸ The America Invents Act, which has the primary effect of converting the existing first-to-invent system to a first-to-file system, in line with most countries, complicates the idea of quantifying labor. With a rush to file a patent as quickly as possible, labor most likely cannot be measured objectively by number of hours spent. *See also, The America Invents Act and General Patent’s Contingency Patent Enforcement Business Model: Wealth of Ideas, November 2011*, GENERAL PATENT CORPORATION, available at <http://businesses.generalpatent.com/america-invents-act-and-general-patent’s-contingency-patent-enforcement-business-model> (last visited Sept. 29, 2012) (expressing concern about “poor quality” patent applications resulting from the rush to file a patent).

⁷⁹ *See Feist Publ’ns, Inc., v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991).