

Originality's Other Path

Joseph P. Fishman*

Although the U.S. Supreme Court has famously spoken of a “historic kinship” between patent and copyright doctrine, the family resemblance is sometimes hard to see. One of the biggest differences between them today is how much ingenuity they require for earning protection. Obtaining a patent requires an invention so innovative that it would not have been obvious to a person having ordinary skill in the art. Copyright, by contrast, makes no such demand on authors. It requires an original work of only minimal creativity.

Except sometimes it doesn't. Puzzlingly, in some copyright cases dealing with musical arrangements, courts have demanded a patent-like level of creativity from putative authors. While these cases might seem like outliers, they have a pedigree that is both lengthy and largely unrecognized. The proposition that copyright originality should require patent-style inventiveness beyond artisans' everyday creations dates back to an 1850 music-infringement decision by Justice Samuel Nelson. In fact, only four months later, Nelson himself would author the Supreme Court patent opinion that is now credited as the touchstone for patent law's own nonobviousness doctrine. His corresponding vision for copyright, though, came first.

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Drawing on original archival research, this Article challenges the standard account of what originality doctrine is and what courts can do with it. It identifies Nelson’s forgotten copyright legacy: a still-growing line of cases that treats music differently, sometimes even more analogously to patentable inventions than to other authorial works. These decisions seem to function as a hidden enclave within originality’s larger domain, playing by rules that others couldn’t get away with. They form originality’s other path, much less trod than the familiar one but with a doctrinal story of its own to tell. Originality and nonobviousness’s parallel beginnings reveal a period of leaky boundaries between copyright and patent, when many of the Justices considered a rule for one to be just as good for the other. Their recurring intersections, meanwhile, muddy today’s conventional narrative about copyright’s historic commitment to protecting even the most modestly creative works.

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INTRODUCTION

[A]n opera is more like a patented invention than like a common book

Thomas v. Lennon, 1883¹

The Supreme Court has famously spoken of a “historic kinship” between copyright and patent law, which both seek to encourage their own form of

1. Thomas v. Lennon, 14 F. 849, 853 (Lowell, Circuit Justice, C.C.D. Mass. 1883).

creative production by granting exclusive rights.² Sometimes, though, the family resemblance is hard to see. One of the biggest differences between the two regimes is how much ingenuity they require for earning legal protection. Under copyright's originality standard, a work of authorship need only "possess[] at least some minimal degree of creativity," a bar that the Supreme Court has emphasized is "extremely low; even a slight amount will suffice."³ Earning a patent, by contrast, requires far more. An invention must not "have been obvious . . . to a person having ordinary skill in the art to which the claimed invention pertains."⁴ As the Court has stressed in its most recent interpretation of this nonobviousness standard, the bar is meant to be high enough to exclude "the results of ordinary innovation."⁵

Most intellectual property (IP) commentators today think that this difference in legal protection is sensible, and there's a large literature devoted to justifying it.⁶ One argument is that the two fields are simply trying to maximize different things, with patents trying to funnel activity into a problem's most efficient solution and copyright trying to generate the widest abundance of information possible.⁷ Another is that users of technological goods tend to welcome a high degree of newness, while audiences for expressive works tend to devalue works that they deem too new.⁸ Still another is that, even if copyright had a good reason to encourage works of greater creativity, it lacks the sort of objective criterion for assessing value that patent law can deploy for scientific inventions.⁹ While these theories differ, they all end up in the same place: a patent should require the demonstration of above-average ingenuity, and a copyright should not. And that's exactly what the two bodies of law give us.

Except when they don't. Puzzlingly, in some copyright cases involving music, courts have demanded a patent-like level of creativity from putative

2. Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417, 439 (1984); cf. Shyamkrishna Balganesh, *Copyright as Market Prospect*, 166 U. PA. L. REV. 443, 476 (2018) ("The Court's logic here . . . was . . . steeped in the recognition that both emanated from the same constitutional source, which in turn specified a common normative goal for both institutions: 'promoting the Progress,' a goal that needed to produce similar outcomes in both regimes through the use of similar principles.").

3. Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 345 (1991).

4. 35 U.S.C. § 103.

5. KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 427 (2007).

6. For a survey, see Christopher Buccafusco, Zachary C. Burns, Jeanne C. Fromer & Christopher Jon Sprigman, *Experimental Tests of Intellectual Property Laws' Creativity Thresholds*, 92 TEX. L. REV. 1921, 1928–31 (2014). *But see* Joseph Scott Miller, *Hoisting Originality*, 31 CARDOZO L. REV. 451 (2009) (arguing in favor of a more patent-like originality threshold in copyright law); Gideon Parchomovsky & Alex Stein, *Originality*, 95 VA. L. REV. 1505 (2009) (arguing that works of greater originality should receive stronger protection).

7. See PAUL GOLDSTEIN, GOLDSTEIN ON COPYRIGHT § 2.2.1.1 (3d ed. 2020 Supp. 2021-1).

8. See Jeanne C. Fromer, *A Psychology of Intellectual Property*, 104 NW. U. L. REV. 1441, 1471–74, 1479–83 (2010).

9. See Erlend Lavik & Stef van Gompel, *On the Prospects of Raising the Originality Requirement in Copyright Law: Perspectives from the Humanities*, 60 J. COPYRIGHT SOC'Y U.S.A. 387, 423–24 (2013).

authors.¹⁰ Take, for example, the district court decision that held that a musical arrangement of an earlier, sparsely notated lead sheet lacked sufficient originality because “there must be present more than mere cocktail pianist variations of the piece that are standard fare in the music trade by any competent musician.”¹¹ The notion that protection should depend on outperforming merely “competent” peers in the field sounds much like patent’s nonobviousness test but nothing like the usual copyright standard.¹² Still, on appeal the Second Circuit blessed that formulation.¹³ Another judge subsequently employed it as the governing rule in the recent, high-profile litigation over the copyright status of the song *We Shall Overcome*.¹⁴

One could understandably brand these examples outliers. And certainly, many commentators do.¹⁵ Yet these high-originality cases have a pedigree that is both lengthy and largely unrecognized. The proposition that copyright originality should require patent-style inventiveness beyond the everyday creations of artisans in the field dates back to Justice Samuel Nelson’s 1850 opinion in one of the first reported music infringement cases in the United States, *Jollie v. Jaques*.¹⁶ In fact, only four months later, Nelson himself would author the Supreme Court patent case that is now credited as the touchstone for patent law’s own nonobviousness doctrine, *Hotchkiss v. Greenwood*.¹⁷ His parallel vision for copyright, though, came first.

If Nelson had had his way, both patent and copyright doctrine alike would have denied protection to everyday craftsmen—“mechanic[s],” as he put it in the era’s typical parlance—and reserved it only for “genius[es]” who made a large enough leap beyond the rest of the field.¹⁸ As extraordinary as that proposition sounds when measured against copyright’s traditional originality standard,

10. See discussion *infra* Part III.B.

11. *Woods v. Bourne Co.*, 841 F. Supp. 118, 121 (S.D.N.Y. 1994), *rev’d in part on other grounds*, 60 F.3d 978 (2d Cir. 1995).

12. See Justin Hughes, *The Personality Interest of Artists and Inventors in Intellectual Property*, 16 CARDOZO ARTS & ENT. L.J. 81, 123 (1998) (criticizing the district court’s use of a patent-like standard that “would be disconcerting to almost any other class of beneficiaries of copyright law”).

13. *Woods*, 60 F. 3d at 991 (concluding that the district court had “articulated the correct standard of originality”).

14. See *We Shall Overcome Found. v. Richmond Org., Inc.*, No. 16cv2725, 2017 WL 3981311, at *13–14 (S.D.N.Y. Sept. 8, 2017).

15. See, e.g., 2 WILLIAM F. PATRY, PATRY ON COPYRIGHT § 3:53, Westlaw (database updated Mar. 2021) (discussing the confusion arising from *Woods*, which “came perilously close to the patent novelty standard”); Jeffrey Brandstetter, *The Lone Arranger: Have the Courts Unfairly Singled Out Musical Arrangements by Denying Them Protection as Derivative Works?*, ENT. & SPORTS LAW., Spring 1997, at 1, 18–19 (questioning if the *Woods* court was in reality applying a standard more appropriate for patents than for copyrights); Robert A. Gorman, *Copyright Courts and Aesthetic Judgments: Abuse or Necessity?*, 25 COLUM. J.L. & ARTS 1, 7 (2001) (criticizing *Woods* for its “seemingly patent-like creativity standard”); Hughes, *supra* note 12.

16. 13 F. Cas. 910 (C.C.S.D.N.Y. 1850) (No. 7,437).

17. 52 U.S. (11 How.) 248 (1851).

18. *Jollie*, 13 F. Cas. at 913–14.

Nelson's opinion in *Jollie* initiated a small but significant line of cases seemingly defying that standard up through the present day.

These cases have something curious in common: they're all about musical arrangements. Explicitly or implicitly, each treats music differently than literary works, sometimes even declaring that music is more analogous to patentable inventions than to other copyrightable subject matter. Nelson's copyright legacy thus hasn't been the baseline protectability threshold that he originally articulated. Instead, it's been a mechanism through which later courts could selectively raise that threshold when they encountered musical subject matter.

Drawing on original archival research, this Article identifies that forgotten legacy. *Jollie*'s heightened threshold is originality's other path, much less trod than the familiar one but with a doctrinal story of its own to tell. I trace that path from its start in 1850 to its most recent section in 2017.

After a nutshell summary of each regime's early history in Part I below, I turn in Part II to a detailed study of the disputes that culminated in the *Jollie* decision on the one hand and the *Hotchkiss* decision on the other. Part III describes the trajectory that each body of law has since taken, focusing particularly on the several music cases that have tried to apply *Jollie*'s heightened creativity threshold, even as the rest of copyright law had seemingly left it behind. Many of these cases might have ended up quite differently without the supporting roles played by individuals with idiosyncratic backgrounds, from a music publisher-turned-inventor to a composer-turned-lawyer to a judge-turned-composer.

Beyond the personalities involved, though, I argue in Part IV that this history offers three important lessons for contemporary copyright theory. First, it provides an unlikely but powerful example in support of the Supreme Court's proposition that copyright and patent doctrine have indeed cross-pollinated. After all, the nonobviousness element that is today called "the heart of patent law"¹⁹ and "the final gatekeeper of the patent system"²⁰ was, at its start, seen as a viable addition to both copyright and patent law alike.

Second, this history suggests some proof of concept for how judges can tailor seemingly monolithic copyright standards to particular subject matter's idiosyncratic needs. IP commentators have frequently noted that a single set of uniform rights is ill-suited to govern a world in which the affected industries and creative fields can vary wildly in their production costs, norms, risk tolerances, and so on.²¹ Copyright's dalliance with a nonobviousness-type originality

19. Speech of the Honorable Paul R. Michel Given to the New Jersey Intellectual Property Law Association, in 9 FED. CIR. BAR J. 139, 143 (1999).

20. Robert P. Merges, *Commercial Success and Patent Standards: Economic Perspectives on Innovation*, 76 CALIF. L. REV. 803, 812 (1988).

21. See, e.g., Dan L. Burk & Mark A. Lemley, *Policy Levers in Patent Law*, 89 VA. L. REV. 1575, 1577 (2003); Michael W. Carroll, *One for All: The Problem of Uniformity Cost in Intellectual Property Law*, 55 AM. U. L. REV. 845, 846–50 (2006).

threshold for musical derivatives shows judges' capacity to reduce that uniformity by applying a supposedly homogeneous standard in heterogeneous ways depending on the nature of the dispute.

Finally, courts' selective application of the higher creativity threshold for musical works demonstrates how supposedly vestigial precedents can reemerge in unpredictable and contingent ways. Even as Nelson's vision for patents took over that entire body of law, judges spent six decades all but ignoring his simultaneous vision for copyrights. From the vantage point of a turn-of-the-century observer, the *Jollie* standard had been dead on arrival. In fact, that standard might never have appeared again but for the litigation strategy of one defendant—who happened to have both legal and musical training—in an infringement case from 1914, over half a century after *Jollie* was decided.²² This episode of copyright history shows, in short, the messiness of doctrinal evolution through the common-law process.

I.

COPYRIGHT AND PATENT PROTECTION IN THE EARLY NINETEENTH CENTURY

Copyrights and patents are each intended to promote their own form of innovation through the grant of their own form of exclusivity.²³ Copyrights cover works of authorship like books, music, and movies, while patents cover functional inventions like pharmaceuticals, smartphone components, and manufacturing methods. The same clause in the Constitution empowers Congress to legislate in both spheres in order to “promote the Progress of Science and useful Arts.”²⁴ Most commentators understand that power to be justified by the likelihood that informational goods, whether authorial or technological, would be undersupplied if imitators could easily swoop into the market and undercut the originator without having to bear the same fixed costs of creation.²⁵ A patent's or copyright's exclusivity thus provides an appropriability mechanism that can encourage investment in creative activity that might not otherwise take place.

But before handing out that exclusivity, each regime needs to identify what's worth protecting. One of the main screening tools available is a creativity threshold, a bar of ingenuity over which authors or inventors must leap to obtain

22. See *Cooper v. James*, 213 F. 871 (N.D. Ga. 1914). I discuss *Cooper* below in Part III.B.

23. See, e.g., *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206, 216 (2d Cir. 2012) (noting that both the copyright and patent systems “seek to encourage innovation”); Carroll, *supra* note 21, at 846 (“The law grants patents to inventors and copyrights to authors to encourage investments in technological and cultural innovation.”).

24. U.S. CONST. art. I, § 8, cl. 8; see also *Mazer v. Stein*, 347 U.S. 201, 219 (1954) (“The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in ‘Science and useful Arts.’”).

25. See, e.g., Mark A. Lemley, *The Economics of Improvement in Intellectual Property Law*, 75 TEX. L. REV. 989, 994 (1997).

the legal entitlement.²⁶ Copyright screens through its originality requirement,²⁷ patent law through its nonobviousness requirement.²⁸

The two doctrines are often discussed side by side, not only because they perform a similar role but also because they perform it so differently.²⁹ For patents, only the unconventional need apply. Even an entirely novel invention will be denied a patent if the differences between it and what came before “would have been obvious . . . to a person having ordinary skill in the art to which the claimed invention pertains.”³⁰ In practice, according to the Court’s most recent exploration of the standard in *KSR International Co. v. Teleflex Inc.*, “a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.”³¹ *KSR* further emphasized that some activity may be creative but would nevertheless fall within the statute’s “ordinary skill” zone. “A person of ordinary skill,” it said, “is also a person of ordinary creativity, not an automaton.”³²

For copyrights, by contrast, the Court has set a bar that’s famously easy to clear. In its 1991 decision *Feist Publications, Inc. v. Rural Telephone Services Co.*, the Court declared that “the requisite level of creativity is extremely low; even a slight amount will suffice.”³³ Unlike the technological inventions that patent law seeks to encourage, expressive works need not be especially surprising or clever to earn copyright protection. In fact, the Court all but excluded nonobviousness from the copyright equation when it stated that “[t]he vast majority of works make the grade quite easily, as they possess some creative spark, ‘no matter how . . . obvious’ it might be.”³⁴ Unlike patent law, as one court of appeals summarized the difference, copyright “does not require substantial originality” but instead “only enough originality to enable a work to be distinguished from similar works that are in the public domain.”³⁵ That’s generally not a tall order. In John Duffy’s colorful example, a ten-year-old who

26. See, e.g., Buccafusco et al., *supra* note 6, at 1926-31 (discussing originality and nonobviousness as creativity thresholds); Gregory N. Mandel, *The Public Perception of Intellectual Property*, 66 FLA. L. REV. 261, 281 (2014).

27. See 17 U.S.C. § 102(a) (requiring copyrightable works of authorship to be “original”).

28. See 35 U.S.C. § 103 (withholding patentability “if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains”).

29. See, e.g., GOLDSTEIN, *supra* note 7, § 2.2.1.1; Buccafusco et al., *supra* note 6, at 1926-31; Fromer, *supra* note 8, at 1483-1508.

30. 35 U.S.C. § 103.

31. 550 U.S. 398, 417 (2007).

32. *Id.* at 421; see also *id.* at 420 (“[I]n many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.”).

33. 499 U.S. 340, 345 (1991).

34. *Id.*

35. *Assessment Techs., LLC v. WIREdata, Inc.*, 350 F.3d 640, 643 (7th Cir. 2003).

spends an hour on a homework assignment by writing a trite and mediocre story that earns a bad grade has probably still earned a copyright to go with it.³⁶

Especially given contemporary copyright doctrine's renunciation of any similar validity demands, commentators often point to nonobviousness as the feature that gives patent law its unique doctrinal identity within the IP domain.³⁷ It has famously been called "the heart of our patent system" and its "final gatekeeper."³⁸ Among all patent validity elements, it is the only one that "fully implements the core notion of patent law that patents should be granted only for significant advances over previously known technology."³⁹ One 1998 study found that, among patent validity issues, it was both the most frequently litigated and the most likely to lead to an invalidity judgment.⁴⁰

Though Congress only codified this defining feature in 1952, the Supreme Court has traced it back a century earlier to its 1851 decision in *Hotchkiss v. Greenwood*.⁴¹ In the Court's view, the statutory nonobviousness requirement "was intended merely as a codification of judicial precedents embracing the *Hotchkiss* condition, with congressional directions that inquiries into the obviousness of the subject matter sought to be patented are a prerequisite to patentability."⁴² *Hotchkiss*, not any particular act of Congress, had first established "the condition that a patentable invention evidence more ingenuity and skill than that possessed by an ordinary mechanic acquainted with the business."⁴³

But the Court's decision in *Hotchkiss*, it turns out, wasn't the first judicial opinion to hold squarely that the availability of IP protection should depend on outshining the everyday output of one's peers. Only a few months earlier, in the fall of 1850, there was another. Justice Samuel Nelson, the same judge who authored the *Hotchkiss* majority opinion, issued a trial-court decision while riding circuit that announced a remarkably similar standard, one that required creators to surpass that "which any person of ordinary skill and experience in [the field] could have made."⁴⁴ That standard, however, was not for patents. It was for copyrights.

To appreciate the significance of Nelson's intervention, one first needs to understand that copyrights and patents were far more similar in the early

36. John F. Duffy, *Inventing Invention: A Case Study of Legal Innovation*, 86 TEX. L. REV. 1, 7 (2007).

37. See, e.g., Michel, *supra* note 19.

38. See Craig Allen Nard & John F. Duffy, *Rethinking Patent Law's Uniformity Principle*, 101 NW. U. L. REV. 1619, 1658 (2007).

39. Brief of Intellectual Property Law Professors as Amici Curiae in Support of Petitioner at 5, *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) (No. 04-1350).

40. John R. Allison & Mark A. Lemley, *Empirical Evidence on the Validity of Litigated Patents*, 26 AIPLA Q.J. 185, 208-09 (1998).

41. 52 U.S. (11 How.) 248 (1851).

42. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966).

43. *Id.* at 11.

44. *Jollie v. Jaques*, 13 F. Cas. 910, 914 (C.C.S.D.N.Y. 1850) (No. 7,437).

nineteenth century than they are today.⁴⁵ Thanks to parallel strands of cases pioneered by Justice Joseph Story, early IP law's most influential jurist, neither demanded any special ingenuity. The remainder of this Section briefly reviews these cases, setting the stage for Nelson's double shakeup that follows in Part II.

A. The Origins of Copyright's Originality Standard

When the First Congress passed the United States' inaugural Copyright Act in 1790, originality didn't yet exist as a limitation on copyrightability. Any text that fell into an appropriate class of subject matter—books, maps, or charts—sufficed, so long as its author was a U.S. citizen or resident. As Oren Bracha summarized the history of this period, “At its infancy American copyright law did not include a lax originality threshold. It included no doctrine or concept of this kind at all.”⁴⁶

In two seminal cases, however, Story simultaneously introduced the new requirement, while also ensuring that it wouldn't be onerous to satisfy. First, in *Gray v. Russell*,⁴⁷ he rejected an infringement defense arguing that the copied work wasn't “substantially new,” and thus simply too derivative to merit protection.⁴⁸ The work at issue was a compilation of editorial notes and revisions to a preexisting Latin textbook. To be sure, Story wrote, the putative author who brings the claim must invest some intellectual labor in the work.⁴⁹ No one could secure a copyright on that which had been copied outright from another. But whether that labor yielded something “substantially” new was irrelevant. Rather, the real question presented was whether the revisions “are to be found collected and embodied in any former single work.”⁵⁰ Because they were not, the defense failed. Story conceded that other editors might perhaps arrive at a similar result if they were to work on the problem independently. Yet the likelihood of such convergence, he held, is no bar to copyright:

There is no foundation in law for the argument, that because the same sources of information are open to all persons, and by the exercise of their own industry and talents and skill, they could, from all these sources, have produced a similar work, one party may at second hand, without any exercise of industry, talents, or skill, borrow from another all the materials, which have been accumulated and combined together by him.⁵¹

45. See, e.g., Mark P. McKenna & Katherine J. Strandburg, *Progress and Competition in Design*, 17 STAN. TECH. L. REV. 1, 33 (2013) (“[T]he patent and copyright standards imposed similarly low thresholds for protection during th[e] pre-*Hotchkiss* period.”).

46. OREN BRACHA, *OWNING IDEAS: THE INTELLECTUAL ORIGINS OF AMERICAN INTELLECTUAL PROPERTY, 1790–1909*, at 65 (2016).

47. 10 F. Cas. 1035 (C.C.D. Mass. 1839) (No. 5,728).

48. *Id.* at 1037.

49. *Id.*

50. *Id.*

51. *Id.* at 1038.

Six years later, a second dispute over copying a textbook gave Story an opportunity to expound further on just how minimal the originality threshold was. In *Emerson v. Davies*,⁵² the defendant tried an argument similar to the one that had failed in *Gray*, that the plaintiff's material wasn't "new, or invented by him."⁵³ Story's reaction was, as before, so what if it wasn't? Authors of arrangements and combinations of preexisting materials are perfectly entitled to a copyright so long as "it be new and original in its substance."⁵⁴ In a move that reflected his already-developed jurisprudence on patentability's similarly low bar,⁵⁵ Story reasoned that copyrights ought to demand no more of an intellectual leap than do patents.⁵⁶

Story then waxed philosophical—and decidedly anti-romantic—on the inherently cumulative, incremental, and derivative nature of literary production: "In truth, in literature, in science and in art, there are, and can be, few, if any, things, which, in an abstract sense, are strictly new and original throughout. Every book in literature, science and art, borrows, and must necessarily borrow, and use much which was well known and used before."⁵⁷ To demand otherwise as a condition of copyrightability would, he reasoned, be folly. Such an argument would prove far too much, leaving "no ground for any copy-right in modern times, and we should be obliged to ascend very high, even in antiquity, to find a work entitled to such eminence."⁵⁸

In Story's hands, then, originality emerged as a requirement of intellectual labor, not any particular yardstick of ingenuity or artistic merit. All that was required to pass the test was producing a work by exercising one's "own skill, judgment and labor," and "not merely copy[ing] that of another."⁵⁹ Shortly thereafter, George Ticknor Curtis included that standard in the section of his influential copyright treatise devoted to the issue of "the originality necessary to a valid copyright."⁶⁰ Citing *Emerson*, Curtis wrote that the fledgling originality element turned only on whether the author had "actually produced anything of his own, and not whether his production [was] better or worse than the productions of others."⁶¹ Moreover, "[t]he law [did] not require that the subject of a book should be new."⁶² It required only that the book "contain[] any

52. 8 F. Cas. 615 (C.C.D. Mass. 1845) (No. 4,436).

53. *Id.* at 620.

54. *Id.* at 619.

55. *See infra* Part I.B.

56. *See Emerson*, 8 F. Cas. at 619 ("A man who constructs a new machine, is entitled to a patent therefor, if the combination and arrangements thereof are new and his own invention, although he uses old materials and old mechanical apparatus and powers in constructing such machine.").

57. *Id.*

58. *Id.*

59. *Id.*

60. GEORGE TICKNOR CURTIS, A TREATISE ON THE LAW OF COPYRIGHT 169 (1847).

61. *Id.* at 173.

62. *Id.*

substantive product of his own labor.”⁶³ This version of originality, which by the mid-nineteenth century seemed to represent the legal mainstream, was deliberately modest. It was essentially a no-copying regime, eschewing any interest in the author’s talents or competence on display. In that sense, Story’s originality doctrine began as a way to preempt any notion that copyright law might care where an author’s work stood in relation to that of their peers.⁶⁴

B. *The Invention of Patent’s Invention Standard*

Early American patent statutes didn’t expressly indicate that a novel invention should be denied a patent for want of inventiveness. The first Patent Act, passed in 1790, at least required patentable inventions to be “sufficiently . . . important,”⁶⁵ but that language lasted only three years before Congress overhauled the entire statute.⁶⁶ No court ever considered what the requirement meant for patentability.⁶⁷ Thomas Jefferson, who as Secretary of State voted on patent applications under that short-lived act, drafted a bill in 1791 that parenthetically noted a defendant should be permitted to show that the invention-in-suit was “so unimportant and *obvious* that it ought not to be the subject of an exclusive right.”⁶⁸ Given his choice of words, some modern commentators credit Jefferson as an early proponent of raising patent law’s ingenuity threshold.⁶⁹ That bill, however, never passed and, though the record is murky, might never have been introduced in Congress at all.⁷⁰ His draft doesn’t

63. *Id.* at 173–74.

64. See BRACHA, *supra* note 46, at 70 (“[T]he moment that originality passed from the realm of abstract ideology into doctrinal discourse it was dramatically scaled down. The heroic notion of the author as a creator of radically new ideas ex nihilo had transformed into the thin requirement that he must not be a servile copier.”).

65. Act of Apr. 10, 1790, ch. 7, § 1, 1 Stat. 109, 110 (repealed 1793).

66. Duffy, *supra* note 36, at 34.

67. See *id.* Congress included the same language again in the Patent Act of 1836 as an eligibility condition to be applied by the newly established Patent Office in examining patent applications. Patent Act of 1836, ch. 357, § 6, 5 Stat. 117, 119. Again, however, there’s no record of the Office ever denying a patent on that ground. See Edward C. Walterscheid, *Novelty & the Hotchkiss Standard*, 20 FED. CIR. BAR J. 219, 234 (2010). No court would connect this provision to an inventiveness requirement until *Reckendorfer v. Faber*, 92 U.S. 347 (1875), over two decades after *Hotchkiss* was decided. Walterscheid, *supra*, at 235–36; see also Giles S. Rich, *Principles of Patentability*, 28 GEO. WASH. L. REV. 393, 398 (1960) (criticizing the “sufficiently . . . important” language in the 1836 Act as “disused and moribund”).

68. Thomas Jefferson, Draft of a Bill to Promote the Progress of the Useful Arts (Feb. 7, 1791), in 5 THE WRITINGS OF THOMAS JEFFERSON, 1788–1792, at 278, 278–80 (Paul Leicester Ford ed., New York, G.P. Putnam’s Sons 1895) (emphasis added).

69. See, e.g., Joseph Scott Miller, *Nonobviousness: Looking Back and Looking Ahead*, in 2 INTELLECTUAL PROPERTY AND INFORMATION WEALTH 1, 5 (Peter K. Yu ed., 2007) (arguing that Jefferson “recognized the importance of threshing nonobvious grains of important invention from the obvious chaff of routine, ordinary invention”); Duffy, *supra* note 36, at 35 & n.140 (listing other examples of those who consider Jefferson’s bill to be “a very early forerunner of the modern nonobviousness requirement”).

70. See Miller, *supra* note 69, at 5; Walterscheid, *supra* note 67, at 238–39.

appear to have had much of an effect on his contemporaries.⁷¹ Perhaps Jefferson was ahead of his time. It would take several decades before courts would begin warming to such a restriction on patentability.

Indeed, the first patent case to address what we'd today call a nonobviousness requirement was a vehement rejection of the proposition that any such requirement exists.⁷² As in copyright, Story led the way. The 1825 case of *Earle v. Sawyer* presented the question of whether one could patent an improvement to a shingle mill by substituting a circular saw for the reciprocating saw that such machines had historically featured.⁷³ The patentee, who also happened to be the inventor of the previous-generation shingle mill, accused the defendant of infringing the updated version. At trial, the defendant put on testimony showing that the substitution of one saw for another “was so obvious to mechanics, that one of ordinary skill, upon the suggestion being made to him, could scarcely fail to apply it in the mode which the plaintiff had applied his.”⁷⁴ The jury nevertheless returned a verdict of infringement.⁷⁵

In seeking a new trial, the defendant argued that the patentee's addition of a circular saw to the existing shingle-mill apparatus was “so simple, that, though new, it deserves not the name of an invention.”⁷⁶ Obtaining a patent, he contended, required not just a new and useful thing but also “mental labor and intellectual creation.”⁷⁷ A true invention ought to be something that “would not occur to all persons skilled in the art, who wished to produce the same result.”⁷⁸

Story disagreed. Patent law, he wrote, didn't care whether a new and useful invention would have been obvious to mechanics or only to certifiable geniuses—it would still be an invention either way:

It is of no consequence, whether the thing be simple or complicated; whether it be by accident, or by long, laborious thought, or by an instantaneous flash of mind, that it is first done. The law looks to the fact, and not to the process by which it is accomplished. It gives the first inventor, or discoverer of the thing, the exclusive right, and asks nothing as to the mode or extent of the application of his genius to conceive or execute it.⁷⁹

71. See Duffy, *supra* note 36, at 35–36 (“[D]espite the appearance of the word ‘obvious,’ the provision has only slight significance in the development of the invention standard.”). It is neither clear whether Jefferson was really committed to this change nor, if he was, whether the inclusion of the word “obvious” in an amended statute would have had much significance at the time. See *id.*; Walterscheid, *supra* note 67, at 238–39.

72. See Walterscheid, *supra* note 67, at 252 (dubbing Justice Story's opinion in *Earle v. Sawyer* the “first known discussion” of obviousness in patent law).

73. 8 F. Cas. 254, 254 (C.C.D. Mass. 1825) (No. 4,247).

74. *Id.* at 255.

75. *Id.*

76. *Id.*

77. *Id.*

78. *Id.*

79. *Id.* at 256.

Because Story considered patent doctrine indifferent to a particular invention's level of ingenuity, he sustained the infringement verdict. *Earle* was thus an emphatic disavowal of precisely the same sort of ordinary-skill filter that's now familiar to modern patent practitioners.

That low threshold, like the analogous one that Story would erect for copyright cases, "dominated the first half of the century," essentially defining the early law of patentability.⁸⁰ Refusing to discriminate between high- and low- ingenuity inventions, as Story had instructed, made some sense when everyday laborers without any specialized, technical training were regularly developing industrial innovations.⁸¹ On top of that, there may have been less social need for a rigorous screening process so long as the pace of technological change remained slow enough.⁸²

Justice Levi Woodbury, who in 1845 was appointed to fill Story's seat on the Court as Circuit Justice, repeatedly instructed juries that patents required no heightened inventiveness. In *Adams v. Edwards*, for example, he stated that a new and useful combination of old elements was patentable "no matter how slight is the change."⁸³ Similarly, in *Woodworth v. Edwards*, he denied the defense's request to instruct the jury that "if the mere changing [of the prior art] were only such an alteration or addition as any mechanic of ordinary skill would naturally make, then the mere change . . . was not the subject of a patent."⁸⁴ Consistent with this approach, Woodbury would later dissent stridently in the *Hotchkiss* decision that started the erosion of Story's regime.⁸⁵

80. BRACHA, *supra* note 46, at 224; see also Kenneth J. Burchfiel, *Revising the "Original" Patent Clause: Pseudohistory in Constitutional Construction*, 2 HARV. J.L. & TECH. 155, 189 (1989) ("With [Justice Story's] pronouncement, nonobviousness lapsed into obscurity, seldom again being raised in reported cases until after *Hotchkiss*.").

81. See B. ZORINA KHAN, *THE DEMOCRATIZATION OF INVENTION: PATENTS AND COPYRIGHTS IN AMERICAN ECONOMIC DEVELOPMENT, 1790–1920*, at 90 (2005) (theorizing that Justice Story's "commonsense standard was entirely appropriate for an era in which ordinary nontechnical craftsmen and women could make valuable innovations based on simple know-how"); *id.* at 116 (finding evidence that, as late as 1870, "the technical skills and knowledge associated with occupational classes such as machinists and metal workers/dealers were not at all necessary for patentable invention").

82. See Duffy, *supra* note 36, at 70–71; see also B. Zorina Khan, *Property Rights and Patent Litigation in Early Nineteenth-Century America*, 55 J. ECON. HIST. 58, 70 (1995) (finding "a sharp increase in invention and innovation" over the first half of the nineteenth century, where fewer than 1,000 patents were issued in its first decade while almost 20,000 were granted in the 1850s).

83. 1 F. Cas. 112, 113 (C.C.D. Mass. 1848) (No. 53).

84. 2 WRITINGS OF LEVI WOODBURY: POLITICAL, JUDICIAL, AND LITERARY 320 (Boston, Little, Brown & Co. 1852). These jury instructions went unreported and were contained only in Woodbury's collected writings. In refusing the requested instruction, Woodbury answered that the invention was patentable so long as it "introduced a new principle, and answered a new end." *Id.* The "new principle" requirement was meant to avoid what courts at the time called "substantial identity" between an invention and the prior art, whereby an earlier device that was the same in principle as a later one could anticipate it even if small differences existed between them. See BRACHA, *supra* note 46, at 225. The *Woodworth* jury ultimately found for the plaintiff. A reported decision on an earlier temporary injunction in the case can be found at *Woodworth v. Edwards*, 30 F. Cas. 567 (C.C.D. Me. 1847) (No. 18,014).

85. See *infra* Part II.B.

There were, to be sure, some initial cracks in *Earle*'s edifice as the century neared its halfway point. At least two cases in the 1840s were receptive to considering ordinary mechanical skill when assessing an invention's novelty.⁸⁶ Confusingly, one of these decisions belonged to the otherwise *Earle*-compliant Woodbury.⁸⁷ Even more insistent was Willard Phillips's 1837 patent treatise, which posited a "general rule . . . that any change or modification of a machine or other patentable subject, which would be obvious to every person acquainted with the use of it, and which makes no material alteration in the mode and principles of its operation, and by which no material addition is made, is not a ground for claiming a patent."⁸⁸ That proposition, of course, sounds a lot like the modern nonobviousness test—and a lot like the one that Story had rejected in *Earle*. Where Phillips found this supposedly already-established rule is unclear. Congress had passed a new Patent Act only a year earlier, and the rule was nowhere to be found within it.⁸⁹ And while judges might have had room in the normal common-law process to narrow the doctrinal concept of invention, the leading case had expressly repudiated that move. U.S. courts had not once approved of the rule that Phillips had attributed to them.⁹⁰ As a result, some contemporary commentators have accused Phillips of prescribing law under the guise of describing it.⁹¹

In any event, notwithstanding Phillips's treatise, the factual issue of whether particular inventions would have been obvious to ordinary mechanics was not typically litigated in the decades following *Earle*.⁹² By the century's midpoint, the notion that patent law imposed a separate ingenuity limitation on top of the baseline novelty requirement was still largely out of bounds.

Nelson's majority opinion in *Hotchkiss* would plant the seed that would eventually create that limitation. First, though, he would try to do the same thing for copyright law.

86. See *Hovey v. Stevens*, 12 F. Cas. 609, 612 (C.C.D. Mass. 1846) (No. 6,745); *Many v. Jagger*, 16 F. Cas. 677, 683 (C.C.N.D.N.Y. 1848) (No. 9,055).

87. See *Hovey*, 12 F. Cas. at 612 (allowing testimony that a change in form was "a very obvious change to any mechanic").

88. WILLARD PHILLIPS, *THE LAW OF PATENTS FOR INVENTIONS* 125–26 (Boston, Am. Stationers' Co., 1837).

89. As discussed further below, see *infra* Part II.B, the previous Patent Act had contained a provision that "simply changing the form or the proportions of any machine, or composition of matter, in any degree, shall not be deemed a discovery." Patent Act of 1793, ch. 11, § 2, 1 Stat. 318, 321 (repealed 1836). Congress repealed that provision when it passed the 1836 Act. Phillips concluded that because of the "general rule" that he had identified, the impact of the statutory change was minimal. Duffy has argued that Phillips actually "had his causation backwards," in that the judge-made rule "grew out of the express statutory exception, not the other way around." Duffy, *supra* note 36, at 38, 70.

90. See Walterscheid, *supra* note 67, at 254.

91. See, e.g., *id.* (suggesting that Phillips was "stating as fact that which he would have desired to be fact").

92. See Burchfiel, *supra* note 80, at 190.

II.

JUSTICE NELSON'S HEIGHTENED THRESHOLDS

It's not surprising that early nineteenth-century defendants had tried, even if unsuccessfully, to convince courts to distinguish between ostensibly genuine creators on the one hand and ordinary mechanics on the other. Outside the courtroom, whether in technological or literary innovation, many others were doing the same thing.

Most technologists during this period were mechanics in a literal sense. Their field of practice involved working with machines.⁹³ Branding someone a "mechanic" was thus not so much descriptive as it was rhetorical, meant to designate the purported inventor's labors as intellectually inferior.⁹⁴ It was, in historian Alfred Young's characterization, a colonial-era "term of derision" used against tradesmen "by those above them."⁹⁵ In 1807, a pro-patent association known as the New England Association of Inventors and Patrons of Useful Arts published a pamphlet proclaiming that the inventor is "highest in the scale of useful beings," with the farmer and mechanic following behind him.⁹⁶ The inventor was the one "to whom society is most indebted," not to mention the one "from whom that same society wrest[s] his property without his consent" when patent law fails to provide adequate protection.⁹⁷ Inventors, the creed declared, sat on a more elevated plane than the rest.

Authors and artists, for their part, had in England begun to receive a similar conceptual isolation from mechanics. Up through the first half of the eighteenth century, authors had been considered their own form of craftsmen, skilled operators of rhetorical and prosodic rules.⁹⁸ When their work surpassed that expectation, audiences assumed that some external force—a divine muse, perhaps—must have been responsible.⁹⁹ Later in that century, however, that once-divine inspiration was reconceived as the romantic author's internal voice, a voice possessed only by true geniuses.¹⁰⁰ At the same time, English authors were growing concerned about the lower barriers to entry afforded by writing's increasing commodification.¹⁰¹ In response, they began constructing themselves as a professional literary class that stood apart from "mere [m]echanics" who

93. BRACHA, *supra* note 46, at 223.

94. *See id.*

95. Alfred F. Young, *Afterword: How Radical Was the American Revolution?*, in *BEYOND THE AMERICAN REVOLUTION: EXPLORATIONS IN THE HISTORY OF AMERICAN RADICALISM*, 317, 331 (Alfred F. Young ed., 1993).

96. *See* Edward C. Walterscheid, *Patents and Manufacturing in the Early Republic*, 80 *J. PAT. & TRADEMARK OFF. SOC'Y* 855, 887 (1998) (quoting *NEWENGLAND [sic] ASSOCIATION OF INVENTORS AND PATRONS OF USEFUL ART, REMARKS ON THE RIGHTS OF INVENTORS* 8, 10 (Boston, 1807)).

97. *Id.*

98. *See* Martha Woodmansee, *The Genius and the Copyright: Economic and Legal Conditions of the Emergence of the 'Author'*, 17 *EIGHTEENTH-CENTURY STUD.* 425, 426–27 (1984).

99. *Id.* at 427.

100. *Id.*

101. *See* MARK ROSE, *AUTHORS AND OWNERS: THE INVENTION OF COPYRIGHT* 118–19 (1993).

sought to emulate them.¹⁰² Thus, for example, the poet Edward Young contrasted the organic lifeform of original authorship with second-comers' machine-like imitations: "An Original may be said to be of a vegetable nature; it rises spontaneously from the vital root of Genius; it grows, it is not made: Imitations are often a sort of Manufacture wrought up by those Mechanics, Art, and Labour, out of pre-existent materials not their own."¹⁰³ Similarly, the playwright Henry Fielding accused derivative writers of being "mere Mechanics, to be envious and jealous of a Rival in their trade."¹⁰⁴ Sir Joshua Reynolds told the students of the Royal Academy of Art in 1770 that "intellectual dignity . . . ennobles the Painter's art, that lays the line between him and the mere mechanic."¹⁰⁵ And according to an 1837 account, an unnamed author who wanted to disparage the work of Alexander Pope called him "no poet, but a mere mechanic, who gleaned thoughts from others."¹⁰⁶

Against that cultural backdrop, one could understand how defense attorneys might plausibly challenge works or inventions that seemed insufficiently pathbreaking to merit the law's protection. With Story on the bench, that strategy had failed. But Story died in 1845. Nelson, who had joined the Court the same year,¹⁰⁷ turned out to be far more receptive.

In the following two sections, I examine *Jollie v. Jaques*,¹⁰⁸ in which Nelson announced that copyright should indeed screen out the work of mere mechanics, and then his more famous effort four months later in *Hotchkiss v. Greenwood*¹⁰⁹ that did the same for patents. Although the basics of their reported decisions have long been known, many of the litigation details that I describe here have not. They reveal a moment in jurisprudential time at the century's midpoint when a heightened creativity threshold looked just as likely for copyright law as it did for patent.

102. *Id.*

103. EDWARD YOUNG, CONJECTURES ON ORIGINAL COMPOSITION IN A LETTER TO THE AUTHOR OF SIR CHARLES GRANDISON 8–9 (Dublin, 1759). Benjamin Kaplan credits Young among the "main protagonists" of "the evolution of Anglo-American doctrine about copyright." BENJAMIN KAPLAN, AN UNHURRIED VIEW OF COPYRIGHT 36–37 (1967); see also Peter Jaszi, *Toward a Theory of Copyright: The Metamorphoses of "Authorship,"* 1991 DUKE L.J. 455, 467 (describing the influence of Young's essay on English Romanticism and on the emergence of a concept of authorship that "has given rise to important doctrinal structures in the law of copyright"); Charlene Avallone, "Vast and Varied Accessions . . . from Abroad": *Herman Melville and Edward Young on Originality*, in STUDIES IN THE AMERICAN RENAISSANCE 409, 410–11 (1984) (noting commentators' recognition of Young's essay as "the single most important document on originality to come out of the early Romantic period in England").

104. Henry Fielding, COVENT-GARDEN J., Jan. 4, 1752, at 1.

105. SIR JOSHUA REYNOLDS, A DISCOURSE, DELIVERED TO THE STUDENTS OF THE ROYAL ACADEMY, ON THE DISTRIBUTION OF THE PRIZES, DECEMBER 14, 1770, BY THE PRESIDENT 4 (London, Thomas Davies 1771).

106. R. P. GILLIES, RECOLLECTIONS OF SIR WALTER SCOTT 21 (London, James Fraser 1837).

107. See Jenni Parrish, *Samuel Nelson*, in BIOGRAPHICAL ENCYCLOPEDIA OF THE SUPREME COURT 378 (Melvin I. Urofsky ed., 2006).

108. 13 F. Cas. 910 (C.C.S.D.N.Y. 1850) (No. 7,437).

109. 52 U.S. (11 How.) 248 (1851).

A. *Copyright: Mechanics Versus Authors*

Nelson's 1850 circuit court opinion in *Jollie* is the case that best stands for a stronger creativity threshold in U.S. copyright law. It was also the first significant break from Story's prevailing low-originality standard. Curiously, though, Story's decisions in *Emerson* and *Gray* seem never to have been mentioned over the course of the litigation.

The case involved the work of composer George Loder. Loder had arranged the incidental music for the dramatic comedy *The Serious Family* that was then playing at a New York theater where he also served as music director. One of the selections from that music was a polka number that came to be called eponymously *The Serious Family Polka*. On February 15, 1850, Loder arranged his theater version of the piece for piano. Three days later he then assigned his interest in that arrangement to the music publisher Samuel C. Jollie.¹¹⁰ Though Jollie's name is now known primarily from the case caption of a copyright dispute, he was also an inventor. (In fact, a few years later he would achieve some minor fame in the annals of election transparency as the inventor of a patented ballot box whose receptacle was a glass globe, ensuring that "bystanders may see every ballot which is put in, see all the ballots that are in, and see them when taken out.")¹¹¹

Jollie published Loder's piano arrangement of the polka, reproduced in Figure 1 below. Reflecting the historical meaning of the word "invention" that covered both scientific and artistic novelty, Jollie's edition credited the choreographer with "invent[ing]" the dance figures.¹¹² Jollie secured copyright protection for the piece by depositing it with the district court on February 20.¹¹³ Loder's polka was based on an earlier German piece, *The Roschen Polka*.¹¹⁴

110. Complaint, in Transcript of Case File, at 1, 2–4, *Jollie v. Jaques*, 13 F. Cas. 910 (C.C.S.D.N.Y. 1850) (No. 7,437) (Equity Case No. 1/49) (on file with the U.S. National Archives and Records Administration) [hereinafter *Jollie* Case File].

111. Ballot-Box, U.S. Patent No. 21,684, ll. 12–14 (filed Oct. 5, 1858). Jollie's ballot box apparently was used in New York City elections but later gained wider visibility through depictions in magazines like *Harper's* and *Leslie's*. See Vanessa Meikle Schulman, *Visualizing Race at the Polling Place*, 33 AM. ART 25, 40 (2019).

112. Complaint, in *Jollie* Case File, *supra* note 110, at 1, 4. The final page of the edition provided more information on the "invent[ions]" of the choreographer. *Id.*; *Image 4 of the Serious Family Polka*, LIBR. OF CONG., <https://www.loc.gov/resource/smi1850.661500.o/?sp=4> [<https://perma.cc/MRE5-G8PW>].

113. *Jollie*, 13 F. Cas. at 911. The deposit certificate was dated February 20, 1850. See Copyright Certificate, in *Jollie* Case File, *supra* note 110, at 13, 14. Under today's Copyright Act, protection begins automatically at the moment of fixation in a tangible medium of expression. Under the Copyright Act of 1831, however, no federal copyright subsisted in the work until the owner deposited a copy of it with the clerk of the local district court. See Act of Feb. 8, 1831, ch. 16, § 4, 4 Stat. 436, 437 (repealed 1870).

114. *Jollie*, 13 F. Cas. at 911.

According to Jollie, at least, Loder’s adaptation required much “labor, time and musical knowledge and skill.”¹¹⁵

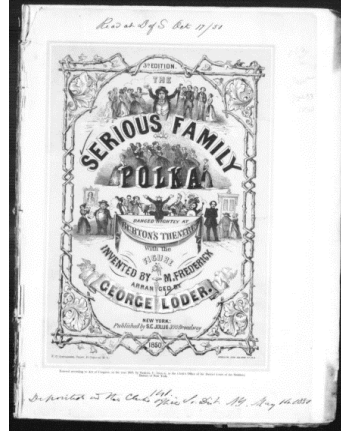


Fig. 1: Cover page to Samuel Jollie’s sheet music for *The Serious Family Polka*¹¹⁶

Within days, the music publisher Jaques & Brother released a competing piano edition of the polka.¹¹⁷ When Jollie got wind of it, he approached John and James Jaques, the partners who gave the publisher its name, and tried to convince them to cease.¹¹⁸ They refused. While they admitted that they had been selling sheet music under the same title as Jollie, they insisted that they had purchased the rights to it from a third party and “had the music in process of publication and the title page engraved before they knew or had heard of” Loder’s version.¹¹⁹

On February 26, six days after he had secured the copyright on the piece, Jollie sued in equity to enjoin the Jaques’s continued distribution of the music.¹²⁰ The defendants argued that “the only similarity” between the two polkas lay “in the melody,” which had been “copied and taken from a composition by some German called the Röschen Polka and which ha[d] been performed by various bands in this city” before Jollie had ever published his version.¹²¹ Loder, they insisted, “has made no change in the melody whatever and has added no original

115. Complaint, in *Jollie Case File*, *supra* note 110, at 1, 2.

116. *The Serious Family Polka*, LIBR. OF CONG., <https://www.loc.gov/item/smt1850.130560/> [<https://perma.cc/PG2X-KM9D>]. The copy on file at the Library of Congress, which may be a slightly later version, bears a handwritten entry stating that the deposit occurred in May, rather than February.

117. Complaint, in *Jollie Case File*, *supra* note 110, at 1, 6.

118. *Id.* at 8.

119. Answer, in *Jollie Case File*, *supra* note 110, at 24, 25.

120. Docket Sheet, *Jollie v. Jaques*, 13 F. Cas. 910 (C.C.S.D.N.Y. 1850) (No. 7,437) (Equity Case No. 1/49) (on file with the U.S. National Archives and Records Administration, New York) [hereinafter *Jollie Docket Sheet*].

121. Answer, in *Jollie Case File*, *supra* note 110, at 25.

matter to the composition.”¹²² Instead, he’d merely “adapted the old melody to the Piano forte.”¹²³

In support, they used a now-familiar infringement litigation strategy that was innovative for its day: expert witnesses.¹²⁴ First was a declaration from the composer and music instructor George H. Curtis. Curtis opined that the parties’ two polkas were “different in their arrangement,” that the defendants’ “contains several bars of matter” that the plaintiff’s version lacked, and that multiple bars between them differed in the arrangement of treble and bass notes.¹²⁵ Moreover, Curtis continued, Jollie’s polka had been “substantially copied in melody” from the underlying German polka, “the only difference being that [the German work] was arranged for the clarinet while the same [melody] appears in [Jollie’s version] arranged for the Pianoforte.”¹²⁶ In a passage that effectively invited the court to assess the average musician’s skill level, he argued that the change “is not [attended] with the slightest difficulty & is susceptible of being accomplished by any person able to transpose music in a very short space of time.”¹²⁷

A second declaration came from Johann Munck, the composer and bandleader, whose rendition of the polka the Jaques had advertised on their sheet music, shown below in Figure 2. Like Curtis, Munck stated that “Loder has made no change in the melody whatever and has added no original matter to the composition and has made no new combination of the materials of said original air but has merely adapted the old melody to the piano-forte.”¹²⁸ Munck explained that before the lawsuit, he had neither heard Loder’s theatrical performance nor seen Jollie’s sheet music. Why, then, was his arrangement also entitled *The Serious Family Polka*? According to Munck, it was because a clerk in a music shop had asked him to arrange a piano version of a popular song he had heard at a party. The clerk didn’t know what it was called, only the name of the theater at which it had been performed. After a failed attempt to get the clerk to whistle the tune, Munck headed to the theater and asked the musicians there, who identified the piece as the German *Röschen Polka*. After learning that the piece accompanied the production of *The Serious Family*, he and the store clerk “jokingly baptized it ‘*The Serious Family Polka*.’”¹²⁹ Although Munck couldn’t convince that particular store to buy the rights to his arrangement, eventually the Jaques brothers did.¹³⁰

122. *Id.* at 24, 25–26.

123. *Id.* at 26.

124. See PATRY, *supra* note 15, § 9:80 (calling *Jollie* “[t]he earliest example of the use of expert witnesses at the infringement stage I have found”).

125. Affidavit of George H. Curtis, in *Jollie* Case File, *supra* note 110, at 19, 20.

126. *Id.* at 21.

127. *Id.* at 21.

128. Johann Munck Affidavit, in *Jollie* Case File, *supra* note 110, at 55, 57.

129. *Id.* at 60.

130. *Id.* at 59.

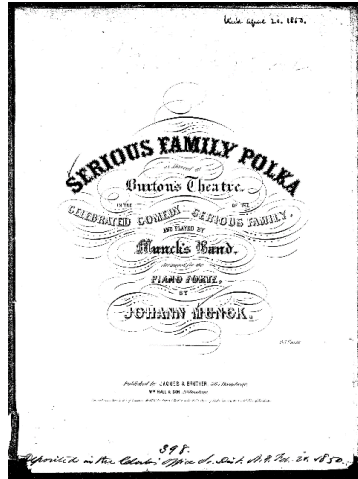


Fig. 2: Cover page to the Jaques Brothers' sheet music for *Serious Family Polka*¹³¹

On September 30, 1850,¹³² Nelson issued a decision deeply skeptical of the plaintiff's claim. Perhaps reacting to the witness testimony that Loder's work must have been easy to do, Nelson reasoned that copyright did not protect "slight and unimportant variations, which any person of ordinary skill and experience in music could have made."¹³³ A mere adaptation of an existing melody was categorically insufficient, he wrote, because "[t]he original air requires genius for its construction; but a mere mechanic in music . . . can make the adaptation or accompaniment."¹³⁴ Original additions to, or adaptations of, preexisting material didn't deserve protection so long as they were the kind that "a writer of music with experience and skill might readily make."¹³⁵

Unable to determine as a factual matter whether the plaintiff's work met that standard on the record before him, Nelson suspended decision on the injunction motion and referred the matter to be tried before a jury ("direct[ed] an issue at law" in the parlance of equity courts).¹³⁶ No further proceedings took place, however. On December 11, the parties filed their consent to discontinue the case.¹³⁷

The *Jollie* theory that only works of romantic "genius" merit protection, while quotidian products of everyday "mechanics" do not, was radical. Anachronistically, of course, it looks nothing like modern copyright's "minimal degree" standard for protectable creativity under *Feist*. More to the historical

131. *Serious Family Polka*, LIBR. OF CONG., <https://www.loc.gov/item/sml850.651930/> [<https://perma.cc/2T8N-QFJS>].

132. On the timing of the decision, see *Jollie* Docket Sheet, *supra* note 120.

133. *Jollie v. Jaques*, 13 F. Cas. 910, 914 (C.C.S.D.N.Y. 1850) (No. 7,438).

134. *Id.* at 913.

135. *Id.* at 914.

136. *Id.*

137. *Jollie* Docket Sheet, *supra* note 120.

point, though, it also looks nothing like Story's vision of humdrum, incremental originality that by that point had been percolating for over a decade. *Jollie* represented a fundamentally different vision of copyrightable authorship.¹³⁸

From what legal authority did Nelson draw this alternative vision? According to the reported opinion, the defendants relied principally on a British precedent from fifteen years earlier, *D'Almaine v. Boosey*.¹³⁹ That case would turn out to be all they needed. *D'Almaine* was the only authority on copyrightability that Nelson cited.¹⁴⁰ But in doing so, he made a larger doctrinal leap than he let on. *D'Almaine* wasn't a case about copyrightability thresholds at all. It was, instead, about the scope of the fair abridgement defense to an infringement claim (the precursor to the modern fair use doctrine).

The dispute in *D'Almaine* concerned a music publisher that had rearranged arias from the 1834 opera *Lestocq* as instrumental dance music.¹⁴¹ When the rights owner sued, the defendant invoked the fair abridgment doctrine that immunized otherwise-infringing copies because, as an earlier case put it, "the invention, learning, and judgment of the [secondary] author is shewn in them."¹⁴² The *D'Almaine* case record reveals that many of the parties' filings focused on the level of authorial skill necessary to execute a successful dance arrangement. Two composers each submitted an affidavit on behalf of the defendant arguing that the arrangements at issue required "a very considerable degree of musical skill and talent," and that the commercial value of the music "is very much increased or diminished by the talent and ability of the composer or arranger of the said music so composed arranged altered or added to for the purpose of being danced to."¹⁴³ In an analogy straight out of the fair abridgment case law, the witnesses characterized the defendant's arrangement as being so different from the underlying arias as to be "equally as distinct as in the instance of two distinct [treatises] upon one and the same subject by different authors in which each Author in his own treatise uses the same [work] as his foundation or from which

138. See BRACHA, *supra* note 46, at 70–71 (calling *Jollie* "an alternative future for American copyright law," where "copyright doctrine would be shaped to reflect the ideal that the essence of intellectual ownership and its ultimate justification is authorship defined by strong originality").

139. (1835) 160 Eng. Rep. 117; 1 Y. & C. Ex. 288; see *Jollie*, 13 F. Cas. at 911 (reporting parties' citations). The case file contains no record of the parties' legal arguments.

140. See *Jollie*, 13 F. Cas. at 913.

141. For a discussion of *D'Almaine*'s elevation of melody above all other musical elements, see Joseph P. Fishman, *Music as a Matter of Law*, 131 HARV. L. REV. 1861, 1877–78 (2018).

142. *Gyles v. Wilcox* (1740) 26 Eng. Rep. 489, 490; 2 Atk. 141; see also *Folsom v. Marsh*, 9 F. Cas. 342, 345 (C.C.D. Mass. 1841) (No. 4,901) (citing *Gyles* for the proposition that, under U.S. law, an abridgement was "fair" and noninfringing if it included "real, substantial condensation of the materials, and intellectual labor and judgment bestowed thereon").

143. Affidavit of William Hawes, in Transcript of Case File, at 21, 21, *D'Almaine v. Boosey* (1835) 160 Eng. Rep. 117 (No. E 103/73/xx) (on file with the National Archives of the United Kingdom) [hereinafter *D'Almaine* Case File]; see Affidavit of George Frederick Harris, in *D'Almaine* Case File, *supra*, at 25, 25–27. I thank Derek Miller for providing me with a copy of the court's records from the U.K. National Archives.

the author takes his lead but amplifies or enlarges or abridges and explains the subject according to his own ideas.”¹⁴⁴

The plaintiff, meanwhile, countered with the affidavit of a music professor who opined that “the melodies or airs are the substantial and essential portions of an Opera and the most valuable and important parts thereof.”¹⁴⁵ Opera composer Henry Bishop (today probably best known for his song *Home! Sweet Home!*¹⁴⁶) also weighed in to declare that composers were customarily compensated not just for full-score reproductions but also for piano-voice arrangements.¹⁴⁷ The common denominator between the various editions was the opera’s melodies, which “constitute the parts of the music of operas most material to the interest of purchasers of the copyright.”¹⁴⁸

The plaintiff’s argument won. The Court of Exchequer held that the rearrangement did not excuse copying the aria’s tune, for “the subject of music is to be regarded upon very different principles. It is the air or melody which is the invention of the author, and which may in such case be the subject of piracy.”¹⁴⁹ In the line that would inspire Nelson’s reasoning in *Jollie*, the court reasoned that melody is “that in which the whole meritorious part of the invention consists The original air requires the aid of genius for its construction, but a mere mechanic in music can make the adaptation or accompaniment.”¹⁵⁰

Jollie’s mechanic/genius dichotomy thus came straight from *D’Almaine*’s assessment of the intellectual labor required for musical arrangements. But it amplified that dichotomy in two ways. First, it grafted *D’Almaine*’s holding—which governed only what a copyist needed to do to avoid infringement—onto the standard for what an author needed to do to secure protection in the first instance.¹⁵¹ Second, it took a principle that might have been limited to music cases and seemingly stated it as a transsubstantive rule of copyrightability. On its face, *D’Almaine* could be read narrowly to stand for the proposition that fair abridgement doctrine works differently when the copied material consists of melodic themes rather than literary ones.¹⁵² Indeed, three years before *Jollie* was decided, that’s precisely how Curtis’s copyright treatise read it. It interpreted

144. Affidavit of George Frederick Harris, in *D’Almaine* Case File, *supra* note 143, at 25, 27.

145. Affidavit of John Weippert, in *D’Almaine* Case File, *supra* note 143, at 38, 38.

146. Modern audiences may recognize the tune from the musical *The King and I* and the final scene of the film *The Wizard of Oz*.

147. Affidavit of Henry Rowley Bishop, in *D’Almaine* Case File, *supra* note 143, at 40, 40.

148. *Id.* at 42.

149. *D’Almaine v. Boosey* (1835) 160 Eng. Rep. 117, 123; 1 Y. & C. Ex. 288, 302.

150. *Id.*

151. See Robert Brauneis, *The Transformation of Originality in the Progressive-Era Debate over Copyright in News*, 27 CARDOZO ARTS & ENT. L.J. 321, 337 n.89 (2009) (“Justice Nelson adapted the ‘mere mechanic’ language for different purposes [than *D’Almaine*’s fair abridgement standard], as a test of whether a work of authorship could be copyrighted . . .”).

152. See *D’Almaine*, 160 Eng. Rep. at 121 (“This is not like the case of an abridgment of a book. The purpose of abridgments is very distinct from that of the works from which they are taken.”).

D'Almaine as distinguishing between books, where the court “apparently recognize[d] the right of making an abridgment of some kind,” and musical compositions, where it did not.¹⁵³ Curtis treated *D'Almaine* as erecting a form of music exceptionalism based on the premise that music lacks the sort of common stock of ideas that literature possesses:

The distinction which [the *D'Almaine* court] makes between music and a literary composition seems to be merely that an air or melody in music is the pure invention of the author, and there is no ground of a common subject for a subsequent composer to fall back upon; whereas, in literature, although the particular composition is original, and exclusively the fruit of the author's mind, the subject is common to all men, and may admit of distinctions between the modes of treating it, which music will not admit of.¹⁵⁴

Jollie appears to go further. It proposes that the work of a “mere mechanic” simply doesn't deserve protection, and that the best way to identify those mechanics is to inquire into the average level of skill within the field of practice. Music isn't the exception; it's the test case for a broader rule. Taken seriously, then, *Jollie* would require that authors seeking copyright protection would always need to show that their work surpassed whatever the author's peers “with experience and skill might readily make.”¹⁵⁵

B. Patent: Mechanics Versus Inventors

The ordinary mechanic would again play the foil to the romantic creator in Nelson's companion decision on patentable invention. The patent at issue was granted in 1841 to coinventors John Hotchkiss, John Davenport, and John Quincy for a new type of doorknob.¹⁵⁶ The point of novelty was an improvement in the material out of which the knobs were made. Whereas existing models had been made out of metal or wood, their patent covered “making said knobs of potters' clay, such as is used in any species of pottery—also of porcelain.”¹⁵⁷

153. CURTIS, *supra* note 60, at 280–81.

154. *Id.* at 284–85.

155. *Jollie v. Jaques*, 13 F. Cas. 910, 914 (C.C.S.D.N.Y. 1850) (No. 7,437).

156. Making Door and Other Knobs of All Kinds of Clay Used in Pottery and of Porcelain, U.S. Patent No. 2,197 (filed July 29, 1841).

157. *Id.* at ll. 12–14.

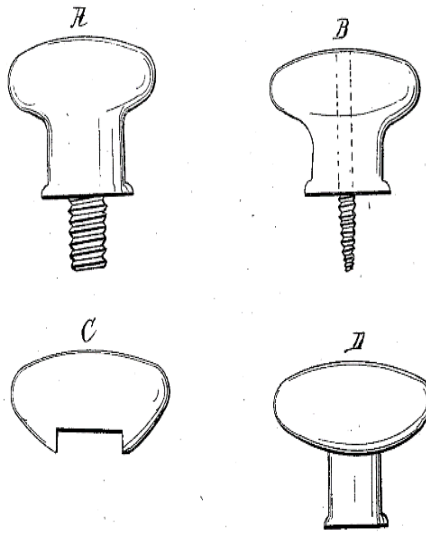


Fig. 3: Drawings of the knobs from the *Hotchkiss* Patent (1841)

Had this patent issued under the Patent Act that had governed up through 1835, it would have had a fatal flaw. That version of the statute had contained a provision stating that “simply changing the form or the proportions of any machine, or composition of matter, in any degree, shall not be deemed a discovery.”¹⁵⁸ Under the standard that courts had fashioned to apply that provision, swapping in clay for metal or wood wouldn’t have been patentable unless, by making that swap, “a new effect is produced” whereby “there is not simply a change of form and proportion, but a change of principle also.”¹⁵⁹ Congress repealed that limitation, however, when it passed a revised Act in 1836. As a statutory matter, at least, it seemed in 1841 that the *Hotchkiss* patent was valid so long as the doorknob was indeed new and useful.

In 1845, the executrix of Hotchkiss’s estate and the other coinventors sued the major Cincinnati industrialist (and soon-to-be Union arms manufacturer) Miles Greenwood, along with his business partner, for infringing the patented knob.¹⁶⁰ Greenwood’s firm was at that time a major iron foundry that supplied hardware items to thousands of homes from Cincinnati westward.¹⁶¹ The record does not specify what specifically the defendants had done to attract the

158. Patent Act of 1793, ch. 11, § 2, 1 Stat. 318, 321 (repealed 1836).

159. *Davis v. Palmer*, 7 F. Cas. 154, 159 (Marshall, Circuit Justice, C.C.D. Va. 1827) (No. 3,645).

160. For more on Greenwood, see Carl M. Becker, *Miles Greenwood*, in *FOR THE UNION: OHIO LEADERS IN THE CIVIL WAR* 259 (Kenneth W. Wheeler ed., 1998). Though not relevant to the litigation, Greenwood himself happens to have been the assignee of a patent covering a different door part, a combined latch, and lock. See *Gravitating Combined Latch and Lock for Doors*, U.S. Patent No. 2,621 (filed May 12, 1842). Not to be outdone, Hotchkiss had a lock patent, too. See *Latch*, U.S. Patent No. 8910X (filed June 19, 1835).

161. See Becker, *supra* note 160, at 267. Greenwood’s operation was “the largest iron-manufacturing concern in the West in 1850” and the largest private employer in the city. *Id.* at 268.

patentees' ire. But Greenwood, dubbed by a contemporary biographer the "Tubal-cain of the West,"¹⁶² at least must have provided a big target.

The dispute attracted major legal talent. Initially representing the plaintiffs was Alphonso Taft, who in the 1870s would become the U.S. Secretary of War and then Attorney General. Of particular note to legal historians of intellectual property, he also later represented the defendant in *Baker v. Selden*,¹⁶³ a canonical case on the proper distinction between copyright and patent law.¹⁶⁴ For unknown reasons, Taft's firm at some point appears to have dropped out of the case. For the duration of the case, the plaintiffs were represented by a "T. Ewing," possibly fellow Ohioan Thomas Ewing, who had served in the U.S. Senate in the 1830s and had reputedly helped draft the Patent Act of 1836.¹⁶⁵

The defendants first retained Charles Fox, who would later become a Cincinnati Superior Court Judge.¹⁶⁶ At some point before trial, he was joined by Salmon P. Chase, the future Chief Justice of the United States.¹⁶⁷ Chase took on a number of patent clients during this period, including the defendant in the celebrated and doctrinally foundational case that invalidated part of Samuel Morse's telegraph patent.¹⁶⁸ When the *Hotchkiss* case eventually made its way to the Supreme Court, it was Chase who delivered the oral argument.¹⁶⁹

During the course of the litigation, Greenwood was elected President of the Ohio Mechanics' Institute.¹⁷⁰ As a card-carrying mechanic himself, it's perhaps

162. *Id.* at 269.

163. 101 U.S. 99 (1880).

164. See Pamela Samuelson, *The Story of Baker v. Selden: Sharpening the Distinction Between Authorship and Invention*, in *INTELLECTUAL PROPERTY STORIES* 159, 175 (Jane C. Ginsburg & Rochelle Cooper Dreyfuss eds., 2006).

165. See *Biographical Sketches of the Commissioners of Patents*, 18 J. PAT. OFF. SOC'Y 145, 200–02 (1936).

166. See LEWIS M. HOSEA, *CINCINNATI SUPERIOR COURT DECISIONS*, at i (1907) (listing Fox as a judge from 1863 to 1868).

167. So far as I'm aware, Salmon Chase has not been previously identified as Greenwood's counsel. The reported Circuit Court opinion lists "Fox and Chase" appearing for the defendants, *Hotchkiss v. Greenwood*, 12 F. Cas. 551, 551 (C.C.D. Ohio 1848) (No. 6,718), and the Supreme Court opinion lists "Mr. Chase" as the lawyer arguing the case, *Hotchkiss v. Greenwood*, 52 U.S. (11 How.) 248, 253 (1851). The Supreme Court's case record, meanwhile, contains a lawyer's handwritten notes signed "S.P. Chase." Letter from S.P. Chase, in Transcript of Case File at 7, 7, *Hotchkiss v. Greenwood*, 52 U.S. (11 How.) 248 (1851) (No. 2,732) (on file with the U.S. National Archives and Records Administration, Washington, D.C.) [hereinafter *Hotchkiss* Case File].

168. *O'Reilly v. Morse*, 56 U.S. (15 How.) 62 (1854). See 1 THE SALMON P. CHASE PAPERS 214 & n.41 (John Niven ed., 1993) (reprinting Chase's journal entries from 1849 discussing his representation of Morse). Chase's oral argument before the Court in the *Morse* case was widely reported. See *Invention of the Electric Telegraph—The Great Telegraph Case in the Supreme Court of the United States*, N.Y. TIMES (Feb. 2, 1853), <https://timesmachine.nytimes.com/timesmachine/1853/02/02/297744692.html?pageNumber=6> [https://perma.cc/ZU24-A578].

169. *Hotchkiss*, 52 U.S. at 253.

170. See OHIO MECHANICS' INSTITUTE, 1828–1878, at 83 (Cincinnati, Wilstach, Baldwin & Co. 1878). The Institute was a technical school that would eventually be folded into the University of Cincinnati. See *Ohio Mechanics Institute*, OHIO HIST. CENT., https://ohiohistorycentral.org/w/Ohio_Mechanics_Institute [https://perma.cc/H57W-USPQ].

fitting that Greenwood's defense entirely avoided the "even a mechanic could do it" theory that some other litigants had tried in the 1840s. Instead, the defense was singularly focused on showing that the patentee's simple substitution of clay for other materials was already anticipated in the prior art. They told the court in 1847 that they had found uses of such knobs in New York, Albany, Philadelphia, and other northeast cities "long before" the patentees' asserted date of invention.¹⁷¹ Moreover, they argued, the patentees themselves had known that such knobs had been previously manufactured and sold abroad and "did not believe themselves to be the first inventors."¹⁷² On the eve of trial the following year, the defendants informed the court that they had unearthed even more anticipating references in the prior art, cataloguing additional uses in Connecticut and dating the public uses of clay and porcelain knobs as far back as 1831.¹⁷³

Supreme Court Justice John McLean presided over a three-day jury trial in Cincinnati in July 1848.¹⁷⁴ After the close of evidence, the plaintiffs requested a jury instruction stating that even if the physical form of their knob had been used before, it remained patentable so long as it had never been attached to clay or porcelain and implementing that attachment "required skill and thought and invention."¹⁷⁵ If those conditions were satisfied, they contended, then the jury must sustain the validity of any knob "better and cheaper" than the metal and wooden knobs that came before it.¹⁷⁶ But McLean refused. In fact, the plaintiffs' strategy of highlighting the skill required to attach the knob's spindle and shank to the clay material may have invited more trouble than they bargained for.¹⁷⁷ The justice reasoned that such attachment may indeed require skill, but merely the kind that "an individual acquainted with mechanics, only, can exercise."¹⁷⁸ He therefore instructed the jury that if constructing the knob required "no other ingenuity or skill . . . than that of an ordinary mechanic acquainted with the business, the patent is void and the plaintiffs are not entitled to recover."¹⁷⁹

These jury instructions are puzzling several times over. First, why did plaintiffs' counsel not raise *Earle*, which flatly disapproved of the court's demotion of mechanical skill?¹⁸⁰ Why, for that matter, didn't McLean see any

171. Notice to Plaintiffs, in Transcript of Record at 6, 6, *Hotchkiss v. Greenwood*, 52 U.S. (11 How.) 248 (1851) (No. 171) (filed Nov. 27, 1848) [hereinafter *Hotchkiss* Transcript of Record].

172. *Id.*

173. *Id.* at 7.

174. In 1847, Chase married a niece of McLean's wife. By the time of trial, then, the defendant's lawyer had become the presiding judge's relative. Chase appeared frequently in McLean's courtroom, however, and the relationship was apparently not an issue. See Paul Finkelman, *John McLean: Moderate Abolitionist and Supreme Court Politician*, 62 VAND. L. REV. 519, 528–29 (2009).

175. *Hotchkiss v. Greenwood*, 12 F. Cas. 551, 552 (C.C.D. Ohio 1848) (No. 6,718).

176. *Id.*

177. See Walterscheid, *supra* note 67, at 262 (surmising that McLean's sua sponte instruction on ordinary mechanics might have been his way of responding to the plaintiffs' argument that "skill and thought and invention" were needed to construct the claimed knob).

178. *Hotchkiss*, 12 F. Cas. at 552.

179. *Id.* at 553.

180. See Walterscheid, *supra* note 67, at 225.

need to deal with it either? Why did his instructions ignore the clay knobs allegedly in the prior art, which the defendants had devoted so much evidentiary attention to, and which if proven might have obviated the entire inventiveness issue?¹⁸¹ And most significantly, given the parties' singular focus on novelty, why did McLean fashion this "ordinary mechanic" test *sua sponte* to begin with?¹⁸² Neither the case record nor McLean's judicial papers suggest any answers. One can only speculate what the court might have done differently had the plaintiffs invoked Story's precedent.

The plaintiffs appealed to the Supreme Court with a sparse assignment of error declaring simply that the trial court had "erred in the instructions which they gave to the jury."¹⁸³ The Court heard argument over two days in February 1851.¹⁸⁴ According to the summary of the argument included in the reported opinion, the plaintiff focused on the invention's novelty and utility, again never citing *Earle*.¹⁸⁵ Chase's argument for the defense didn't cite it either.¹⁸⁶ Instead, it focused on substituting new materials and a then-existing doctrine barring patents on new uses for old devices.¹⁸⁷ He asked the Court incredulously if they were really prepared to endorse a system that would allow someone to find the rare object that hadn't yet been forged in cast-iron—a material that had already been used to make "every thing whose shape can be impressed upon sand"—and then "exclude all other persons from making the same article out of the same material?"¹⁸⁸ The argument didn't turn on anyone's ingenuity, nor did it ever reference the trial court's "ordinary mechanic" standard.

On February 19, about four months after Nelson had issued his copyright decision in *Jollie*, he ported over the same reasoning to patent law through the Court's majority opinion affirming McLean's instructions. "[T]here was no error," Nelson began, "for unless more ingenuity and skill . . . were required [to apply the shank] to the clay or porcelain knob than were possessed by an ordinary mechanic acquainted with the business, there was an absence of that degree of skill and ingenuity which constitute essential elements of *every invention*."¹⁸⁹ These last two words, taken at face value at least, are crucially important. The Court here seemed to announce an element baked into the concept of invention itself, not (as might otherwise be supposed) just into the narrow category of

181. *See id.* at 224.

182. *See id.* at 262.

183. Assignment of Error, in *Hotchkiss* Case File, *supra* note 167 at 4, 5.

184. Docket Sheet, *Hotchkiss v. Greenwood*, 52 U.S. (11 How.) 248 (1851) (No. 2732) (on file with the U.S. National Archives and Records Administration, Washington, D.C.), <https://catalog.archives.gov/id/82590058> [<https://perma.cc/GR8A-UD2J>] (Image 565 of 995).

185. *See Hotchkiss v. Greenwood*, 52 U.S. (11 How.) 248, 253–57 (1851).

186. *See id.* at 257–63.

187. *See* John F. Duffy, *Rules and Standards on the Forefront of Patentability*, 51 WM. & MARY L. REV. 609, 633 (2009) (discussing the wide acceptance of this "double use" doctrine in the nineteenth century and its eventual abrogation under the Patent Act of 1952).

188. *Hotchkiss*, 52 U.S. at 260.

189. *Id.* at 267 (emphasis added).

change-of-form cases where the patentee has simply substituted a new material for an old one. Even a new and useful improvement is ineligible for a patent if it is only “the work of the skillful mechanic, not that of the inventor.”¹⁹⁰ Like the genius authors of *Jollie*, inventors were to be defined in negative relation to the undifferentiated masses of mechanics.

Woodbury dissented. Consistent with his jury instructions in *Adams* and *Edwards*, he accused the majority of instituting a patentability standard that “has not the countenance of precedent, either English or American.”¹⁹¹ He maintained that “the skill necessary to construct” an invention “is an immaterial inquiry.”¹⁹² Unlike every other Justice, he considered the issue settled by Story’s decision in *Earle*. He would have remanded the case for a new trial before a jury that was properly instructed that, like *Earle* had held, “a combination, if simple and obvious, yet if entirely new, is patentable.”¹⁹³ The majority never engaged that precedent. It simply ignored it.

III.

THE TWO HEIGHTENED THRESHOLDS OVER TIME

Despite what in hindsight seems like a sudden doctrinal shakeup, neither *Hotchkiss* for patents nor *Jollie* for copyrights had much of an immediate impact. Each decision’s influence took time to appear. Of course, the nonobviousness regime into which *Hotchkiss* eventually snowballed dwarfs any copyright change that could fairly be traced to *Jollie*. Nevertheless, as this Section argues, *Jollie*’s reverberations continued to be felt in multiple music cases across the twentieth century.

I begin in Part III.A with a summary of the delayed but eventually exponential growth of nonobviousness after *Hotchkiss*. As others have already explored this transformation in depth,¹⁹⁴ my review here is brief. In Part III. B, I then turn, in greater detail, to the comparatively understudied stamp that *Jollie* has left within its own sphere.

A. *What Hotchkiss Did*

On its face, *Hotchkiss* appeared to change patent doctrine immediately. It embedded a new element in the concept of invention. It formally introduced patent law’s version of the reasonable person, the ordinary mechanic (eventually to become known as the person having ordinary skill in the art), to the case

190. *Id.*

191. *Id.* at 270 (Woodbury, J., dissenting).

192. *Id.* at 269.

193. *Id.* (citing *Earle v. Sawyer*, 8 F. Cas. 254, 254 (C.C.D. Mass. 1825) (No. 4,247)). Technically, Woodbury here quoted from one of the published *Earle* opinion’s headnotes, rather than Story’s words themselves.

194. *See, e.g.*, Duffy, *supra* note 36; Walterscheid, *supra* note 67.

law.¹⁹⁵ And most fundamentally, it reoriented the validity test away from the perspective of the businessman and toward that of the scientist.¹⁹⁶

The case law didn't feel those effects right away, however. Some early decisions seemed to march in lockstep,¹⁹⁷ but most judges didn't do much with the case until after the Civil War.¹⁹⁸ Though the twentieth-century Supreme Court saw *Hotchkiss* as the wellspring of nonobviousness,¹⁹⁹ antebellum judges evidently did not. Even Nelson himself rejected a *Hotchkiss*-like defense at an infringement trial later that same year.²⁰⁰ A defendant accused of infringing a patented improvement to a reaping machine argued that the improvement was "so simple and obvious, that the claim, even admitting it to have been new and not before in use, is not the subject of a patent."²⁰¹ Nelson strangely brushed it off, instructing the jury that "[n]ovelty and utility in the improvement seem to be all that the statute requires as a condition to the granting of a patent."²⁰² Perhaps Nelson hadn't truly meant to declare a rule governing all patents (though that's precisely what he had done) and had instead intended a more limited rule only for cases involving substitution of materials.²⁰³

In any event, the broader reading of *Hotchkiss* as a general condition of patentability picked up steam in the 1870s, at a time of growing commercial anxiety over excessive patent litigation.²⁰⁴ The Supreme Court in 1875's *Reckendorfer v. Faber* gave an inventiveness threshold a full-throated endorsement:

An instrument or manufacture which is the result of mechanical skill merely is not patentable. Mechanical skill is one thing; invention is a different thing. Perfection of workmanship, however much it may increase the convenience, extend the use, or diminish expense, is not

195. See Walterscheid, *supra* note 67, at 260.

196. See BRACHA, *supra* note 46, at 227–28 (“[Nelson] shifted the [then-prevailing] focus of the analysis from [the invention’s] added value to the intellectual skill that he saw as the hallmark of true invention The material point was not whether the new doorknob was better, but whether it could be said to be the product of an inventor.”).

197. See, e.g., *Larabee v. Cortlan*, 14 F. Cas. 1136, 1138 (C.C.D. Md. 1851) (No. 8,084) (instructing the jury that an improvement patent would be invalid if “a mechanic of ordinary skill and acquainted with such business” could achieve the same result “with the old improvement before him”).

198. KHAN, *supra* note 81, at 73 (showing that judges hardly ever cited *Hotchkiss* until the 1870s); see also Walterscheid, *supra* note 67, at 263 (“The *Hotchkiss* standard only began to be treated as a ‘general condition’ for patentability after the Civil War . . .”).

199. See *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966).

200. According to the synopsis of an opinion from a later stage in the litigation, the trial occurred in June 1851, about four months after the Supreme Court’s ruling in *Hotchkiss*. See *McCormick v. Seymour*, 15 F. Cas. 1329, 1329 (C.C.N.D.N.Y. 1854) (No. 8,727).

201. *McCormick v. Seymour*, 15 F. Cas. 1322, 1323 (C.C.N.D.N.Y. 1851) (No. 8,726), *rev’d in part on other grounds*, 57 U.S. (16 How.) 480 (1853).

202. *Id.*

203. BRACHA, *supra* note 46, at 229 (offering this theory).

204. Bracha attributes this uptick in inventiveness jurisprudence to entrepreneurial railroad-company defendants, which sought to stem the tide of lawsuits by convincing courts to make patents harder to obtain. See *id.* at 229–30.

patentable. The distinction between mechanical skill, with its conveniences and advantages and inventive genius, is recognized in all the cases.²⁰⁵

In 1880, the Court followed up with its maxim in *Pearce v. Mulford* that “all improvement is not invention.”²⁰⁶ To earn legal protection, the alleged invention “must be the product of some exercise of the inventive faculties” and “involve something more than what is obvious to persons skilled in the art to which it relates.”²⁰⁷ Most significantly, in 1883’s *Atlantic Works v. Brady*, the Court cautioned that “[t]o grant to a single party a monopoly of every slight advance made, except where the exercise of invention, somewhat above ordinary mechanical or engineering skill, is distinctly shown, is unjust in principle and injurious in its consequences.”²⁰⁸ It then poetically detailed those consequences, supplying the Court’s first theoretical justification of its newly expanding inventiveness requirement:

The design of the patent laws is to reward those who make some substantial discovery or invention, which adds to our knowledge and makes a step in advance in the useful arts. Such inventors are worthy of all favor. It was never the object of those laws to grant a monopoly for every trifling device, every shadow of a shade of an idea, which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufactures. Such an indiscriminate creation of exclusive privileges tends rather to obstruct than to stimulate invention. It creates a class of speculative schemers who make it their business to watch the advancing wave of improvement, and gather its foam in the form of patented monopolies, which enable them to lay a heavy tax upon the industry of the country, without contributing anything to the real advancement of the arts. It embarrasses the honest pursuit of business with fears and apprehensions of concealed liens and unknown liabilities to lawsuits and vexatious accountings for profits made in good faith.²⁰⁹

By the time William Robinson published his seminal patent treatise in 1890, the *Hotchkiss* division between invention and mechanical skill had fully taken root. “Inventors,” he wrote, meant only “those by whom creative skill and genius have been exercised. It is the exercise of this creative skill alone which is here recognized as an inventive act, and only the result of such an act, so far perfected as to be available for public use, is an invention.”²¹⁰

205. 92 U.S. 347, 356–57 (1876).

206. 102 U.S. 112, 118 (1880).

207. *Id.*

208. 107 U.S. 192, 200 (1883).

209. *Id.*

210. WILLIAM C. ROBINSON, *THE LAW OF PATENTS FOR USEFUL INVENTIONS* 104–05 (Boston, Little, Brown & Co. 1890); *see also id.* at 117 (“Industry in exploring the discoveries and acquiring the ideas of others; wise judgment in selecting and combining them; mechanical skill in applying them to practical results; none of these are creation, none of these enter into the inventive act.”).

Nonobviousness would take a circuitous road through the twentieth century as courts, and eventually Congress, tried to pin down what exactly the concept ought to be measuring. In 1941, the Court infamously raised the bar to the point that even an invention requiring some “ingenuity” would still fall short if that ingenuity amounted to “no more than that to be expected of a mechanic skilled in the art.”²¹¹ The Court wanted to reserve patents for inventions that “reveal[ed] the flash of creative genius.”²¹² But identifying which inventions displayed such genius, as opposed to the incremental but still laborious advances through which science typically progresses, proved to be a frustrating task. Judge Learned Hand soon bemoaned this interpretation of *Hotchkiss* as requiring the search for something “as fugitive, impalpable, wayward, and vague a phantom as exists in the whole paraphernalia of legal concepts.”²¹³ Congress abrogated that precedent in 1952, when the newly enacted Patent Act finally took the search for “genius” out of the standard and replaced it with the nonobviousness standard still found today in § 103.²¹⁴ I won’t wade through the particulars of this more recent history here, but by the time the Court got around to construing the statutory codification of nonobviousness, it identified *Hotchkiss* as its source.²¹⁵

B. What Jollie Did

Unlike *Hotchkiss*, still cited by the Supreme Court and regularly taught in law-school patent courses, *Jollie* isn’t a household case name. Westlaw and Lexis together tally only six judicial citations to *Jollie* since 1900 (though that number is in fact underinclusive, as both services omit some important ones discussed here).²¹⁶ Contemporary treatises have almost nothing to say about it. Nimmer, for example, omits *Jollie* entirely. Goldstein’s treatise cites it only once, and not for anything to do with its radical originality standard but instead for the banal proposition that courts may admit expert testimony on originality.²¹⁷ Most nineteenth-century treatise writers gave *Jollie* similarly short

211. *Cuno Eng’g Corp. v. Automatic Devices Corp.*, 314 U.S. 84, 91–92 (1941).

212. *Id.* at 91.

213. *Harries v. Air King Prods. Co.*, 183 F.2d 158, 162 (2d Cir. 1950).

214. *See* 35 U.S.C. § 103.

215. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966); *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 427 (2007) (stating that *Hotchkiss* “established” the now-codified “bar on patents claiming obvious subject matter”).

216. *See* *Francescatti v. Germanotta*, No. 11 CV 5270, 2014 WL 2767231, at *9 (N.D. Ill. June 17, 2014); *Shapiro, Bernstein & Co. v. Jerry Vogel Music Co.*, 73 F. Supp. 165, 167 (S.D.N.Y. 1947); *Norden v. Oliver Ditson Co.*, 13 F. Supp. 415, 417 (D. Mass. 1936); *Fred Fisher, Inc. v. Dillingham*, 298 F. 145, 148 (S.D.N.Y. 1924); *Underhill v. Schenck*, 143 N.E. 773, 778 (N.Y. 1924); *Glaser v. St. Elmo Co.*, 175 F. 276, 278 (C.C.S.D.N.Y. 1909). As I discuss below, both services curiously omit what are arguably *Jollie*’s two most significant citations, *Cooper v. James*, 213 F. 871, 872 (N.D. Ga. 1914), in 1914 and *Woods v. Bourne Co.*, 841 F. Supp. 118, 122 (S.D.N.Y. 1994), *rev’d in part on other grounds*, 60 F.3d 978 (2d Cir. 1995), in 1994.

217. GOLDSTEIN, *supra* note 7, § 16.4.

shrift.²¹⁸ Historians know *Jollie* as an anomaly, the exception that proves copyright's rule of a low-creativity bar to protectability.²¹⁹

Yet *Jollie* in fact has a lot more to teach contemporary legal audiences than appearances might let on. While it failed to raise the originality threshold for most classes of subject matter, it nevertheless launched a line of cases that silently raised that threshold when the dispute concerned musical arrangements.²²⁰ Just as Curtis's 1847 treatise understood *D'Almaine* to announce a music-specific infringement standard, later cases have implicitly understood *Jollie* to announce a music-specific originality standard. But these cases almost never state openly that music disputes operate differently. That message is written only between the lines.²²¹

Jollie's effects took decades to materialize. It did receive an approving nod in *Daly v. Palmer*,²²² an 1868 case that, like *D'Almaine*, was focused on the standard for nonliteral infringement. Other than that, though, judges in the second half of the nineteenth century didn't cite *Jollie* in published opinions for anything to do with copyright scope. On the few occasions during this period when courts did invoke the case, it was for a different proposition, such as the unavailability of copyright protection for a work's title.²²³

In fact, the next time a case actually teed up a similar question of originality for musical arrangements, the court not only failed to cite *Jollie* but also contradicted it. *Carte v. Evans*,²²⁴ an 1886 decision enjoining an unauthorized piano arrangement of *The Mikado*'s orchestral score, declared that such arrangements "require[d] musical taste and skill of a high order."²²⁵ The court reasoned that "[n]o two arrangers, acting independently, and working from the same original, would do the work in the same way, or would be likely to produce

218. See Brauneis, *supra* note 151, at 338 n.92 (reviewing *Jollie*'s cursory treatment in the treatises of Eaton Drone, James Appleton Morgan, and Walter Arthur Copinger).

219. See, e.g., BRACHA, *supra* note 46, at 71 (describing "the general acceptance of Story's view of originality and the decline of the alternative presented by Nelson" over the second half of the nineteenth century); Brauneis, *supra* note 151, at 337 (arguing that *Jollie* has had "virtually no influence on copyright law").

220. I have found almost no examples of a litigant urging application of the *Jollie* standard outside of the music context, though my search is inevitably ad hoc given the lack of a searchable database of historical legal filings. For one unsuccessful exception, see *Petition for a Writ of Certiorari* at 18, *Sheldon v. Metro-Goldwyn Pictures Corp.*, 309 U.S. 390 (1940) (Case No. 890) (arguing that a copyright in any literary adaptation or dramatization of public-domain materials does not cover "those additions and variations which a writer with experience and skill might readily make" (citing *Jollie v. Jaques*, 13 F. Cas. 910, 913–14 (C.C.S.D.N.Y. 1850) (No. 7,437))). The petition was denied, though the case would eventually reach the Court on a separate issue dealing with apportioning damages. See *Sheldon*, 309 U.S. 390 (1940).

221. For an exception that said the quiet part out loud, see *Norden v. Oliver Ditson Co.*, 13 F. Supp. 415, 418 (D. Mass. 1936), discussed *infra* text accompanying notes 259–58.

222. 6 F. Cas. 1132, 1137 (C.C.S.D.N.Y. 1868) (No. 3,552).

223. See, e.g., *Estes v. Williams*, 21 F. 189, 189 (C.C.S.D.N.Y. 1884); *Donnelley v. Ivers*, 18 F. 592, 595 (C.C.S.D.N.Y. 1882).

224. 27 F. 861 (C.C.D. Mass. 1886).

225. *Id.* at 862.

the same results, except so far as they might both resemble the original.”²²⁶ The capabilities of ordinary musicians wasn't the court's touchstone for originality. Instead, it was the likelihood that musicians could make different choices about how to solve the same problem—a test that sounds much like the modern *Feist* standard and nothing like Nelson's.

Yet in the twentieth century, *Jollie* was given a second life. The person most responsible for putting it back on the jurisprudential map was a man named Joseph James. James was a lawyer, a composer, and at one point the mayor of Douglasville, Georgia.²²⁷ He was also a founder and leader of the United Sacred Harp Musical Association, an organization devoted to preserving the Christian hymnody tradition known as Sacred Harp singing. The movement, which took its name from Benjamin Franklin White's 1844 hymnal *The Sacred Harp*, had by the beginning of the century spread throughout the rural South.²²⁸

White, the original compiler of the hymnal, died in 1879.²²⁹ James's role in the development of copyright doctrine was rooted in a dynastic struggle over who would succeed White as the steward of the hymnal's authoritative edition. In 1902, after the copyright in the previous incarnation of the hymnal had expired, Wilson Marian Cooper published a new version that quickly gained popularity in his native Alabama.²³⁰ Almost all earlier versions had been written for three voices: treble, tenor, and bass. Cooper's edition supplied a fourth voice part, an alto, that injected an additional inner harmony into the chords. Cooper's revision had been the first significant one in decades, and the choice to employ four- rather than three-part harmony was a genuine innovation in the genre.²³¹

To many in the Sacred Harp movement, however, Cooper was an outsider.²³² Probably motivated by Cooper's success but unwilling to adopt his version, James's United Association decided to put out its own revision.²³³ That new revision appeared as *The Original Sacred Harp* in 1911.²³⁴ Like Cooper's, the James edition uniformly included an alto line in its hymns. It would eventually become a great success, subsequently folded into an edition that

226. *Id.*

227. On James's background, see *Joseph Stephen James*, WIKIPEDIA, https://en.wikipedia.org/wiki/Joseph_Stephen_James [<https://perma.cc/P6PZ-QEXL>].

228. See BUELL E. COBB, JR., *THE SACRED HARP: A TRADITION AND ITS MUSIC* 94 (1978).

229. *Id.* at 87.

230. *Id.* at 89; see W. M. COOPER, *THE SACRED HARP: REVISED AND IMPROVED BY W. M. COOPER* (1902).

231. See COBB, *supra* note 228, at 89–91.

232. *Id.* at 90 (“Those who considered themselves to have received the mantle White had passed down—though they admitted a revision was needed—could never sanction such an interloper.”).

233. *Id.* at 95.

234. See *THE ORIGINAL SACRED HARP* (J. S. James ed., 1911). For more on this edition, see Wallace McKenzie, *The Alto Parts in the “True Dispersed Harmony” of The Sacred Harp Revisions*, 73 *MUSICAL Q.* 153, 153–54 (1989).

would become the most widely used *Sacred Harp* hymnal of the twentieth century.²³⁵

Despite that ultimate success, however, the James edition began in controversy. First, the son of the original 1844 compiler formed a secession movement when the United Association adopted James's revision over his competing one.²³⁶ In news that made the front page of Atlanta's leading paper, that son protested, "The book which has been adopted and which is promulgated by President James, is a clear infringement on the original song book published by my father, and contains practically all the songs which he incorporated in his book."²³⁷ Despite the incendiary language of infringement, though, there's no indication that he brought any legal action against James.

Cooper, by contrast, was more litigious. In 1913, James advertised a "Great Singing Convention" in Atlanta for the United Association's annual session. As shown in the advertisement reproduced below in Figure 4, he billed it as "the largest gathering of vocalists ever assembled in the Southern States."²³⁸

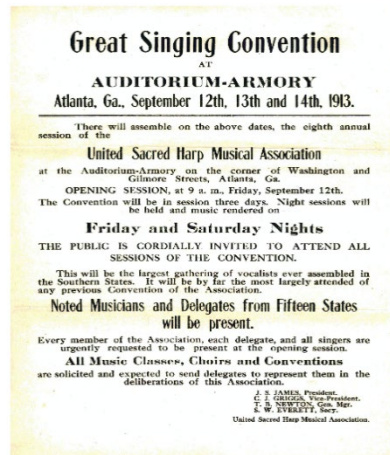


Fig. 4: Advertisement for Joseph James's Sacred Harp Singing Convention

Cooper had evidently seen enough. He brought an infringement claim alleging that James had copied his "arrangements, adaptations and altos."²³⁹ Composing a new alto line for each of the songs, Cooper urged, had been a

235. See McKenzie, *supra* note 234, at 154. As of the new millennium, the Cooper edition and the successor to the James edition have split between them nearly all of the geographic territory where Sacred Harp singing remains popular. See COBB, *supra* note 228, at 85 (noting that outside of northwest Georgia and east Atlanta, the successor to the James edition covers the rest of Georgia, north and central Alabama, the southern tip of Tennessee, and north Mississippi, while Cooper's edition dominates from west Florida to Texas).

236. See *Sacred Harp Singers Split Over Selecting*, ATLANTA CONST., Sept. 9, 1911, at 1.

237. *Id.*

238. Exhibit to Letter from J. S. James to Judge William Newman (Sept. 6, 1913), in Case File at 48, 48, Cooper v. James, 213 F. 871, 872 (N.D. Ga. 1914) (No. 37) (on file with the U.S. National Archives and Records Administration, Atlanta, GA) [hereinafter *Cooper Case File*].

239. Complaint, in *Cooper Case File*, *supra* note 238, at 39, 39 ¶ 2.

serious undertaking that had greatly improved the underlying three-part versions.²⁴⁰ According to Cooper, James had simply taken his alto parts and inserted them into his hymnal edition rather than come up with his own.

James mostly handled his own defense. In a letter to the court at the outset of litigation, he painted Cooper's lawsuit as a vexatious attempt to interfere with the upcoming convention. He asked for an opportunity to be heard before any restraining order was entered.²⁴¹ The court moved quickly, but not nearly that quickly. On September 12, the date that the singing convention was to begin, it set a hearing for about two weeks out.²⁴² It's not clear whether the event in fact took place. In any case, when the hearing date appeared, James was a no-show.

After a month had passed, James reappeared. He explained that he had been ill and, according to his physician, had "suffered from a nervous breakdown from over-work."²⁴³ Nevertheless, he wasn't about to hand off his defense to another attorney, even though he was nominally working with a cocounsel. "[T]he very nature of said case," he wrote, "requires petitioner's personal attention . . . [N]obody understands the facts necessary to file this answer but the defendant . . ."²⁴⁴ With James back in the picture and evidently running the operation, the court lifted the restraining order.

James's litigation strategy was to paint the composition of the alto line as yeoman's work. It was a gambit that relied entirely on *Jollie*. How creative Cooper's new inner harmony actually was is at least debatable as a question of fact.²⁴⁵ But under Story's low-originality threshold that had supposedly won out over Nelson's requirement of musical genius, it's far from obvious that the answer would have even mattered. So long as Cooper had exercised genuine intellectual labor in choosing a vocal part that the surrounding voice leading didn't already dictate, the works should have been protected.

Jollie, however, directed otherwise. The first page in the *Cooper* case file is an undated and seemingly freestanding list of authorities, "As to Right to Original Copyright." And the first such authority listed was *Jollie*'s admonition that copyright protection should be unavailable to whatever a "writer of music with experience and skill might readily make."²⁴⁶ It's not clear whether the document was prepared by James or by the court itself, but either way it conforms perfectly to James's theory of the case: that anyone of even modest musical ability could have composed the alto line.

240. See *id.* ¶ 3.

241. See Letter from J. S. James to Judge William Newman (Sept. 6, 1913), in *Cooper* Case File, *supra* note 228, at 48, 49.

242. Sept. 12, 1913 Scheduling Order, in *Cooper* Case File, *supra* note 238, at 43.

243. Oct. 18, 1993 Petition of J. S. James, *Cooper* Case File, *supra* note 238, at 34, ¶ 2.

244. *Id.* ¶ 3.

245. See McKenzie, *supra* note 234, at 164–68.

246. List of Authorities, in *Cooper* Case File, *supra* note 238, at 1 (quoting *Jollie v. Jaques*, 13 F. Cas. 910 (C.C.S.D.N.Y. 1850) (No. 7,437)).

In a set of interrogatories filed with the court, also untitled and undated, a witness answered a simple “yes” when asked whether the alto part constituted “an addition which a musician of experience and skill, though not an original composer, could readily make.”²⁴⁷ Another interrogatory asked, “Does it necessarily require a person talented in composition to write an alto?” The witnesses responded that “[i]t would not require originality, but to be correct would require training.”²⁴⁸ Given the question’s design to provide a *Jollie*-ready answer, it seems likely that the individual providing the answer was James’s witness.²⁴⁹

In March 1914, James moved to dismiss the complaint in a brief that he signed as counsel. *Jollie*, he argued, compelled that result.²⁵⁰ He didn’t mince words. “An alto,” he declared, “is absolutely nothing and would be of no value whatever to anybody without the balance of the tune It is not original, it is nothing.”²⁵¹ He mocked Cooper as

an egotist, that knows nothing about music so as to be a composer of any ability, that thinks that he can take other peoples [sic] works on which the copyright has expired and appropriate to his own use in a book and put his picture in it and take out a good many of the tunes and put others in the places and claim that he has a copyright.²⁵²

It worked. The court dismissed the case for want of originality, leading with “the rule laid down by Mr. Justice Nelson” that copyright does not extend to what a “writer of music with experience and skill might readily make.”²⁵³ Cooper’s alto lines, the court concluded, failed that test. “[W]hile probably made by musicians of experience and some skill,” the new voice parts were “not necessarily the productions of persons having the gift of originality in the composition of music. An alto may be an improvement to a song to some extent, and probably is; but it can hardly be said to be an original composition, at least in the sense of the copyright law.”²⁵⁴

That this standard sounded patent-like wasn’t lost on the court. It made the connection explicit: “In patents we say that any improvement which a good mechanic could make is not the subject of a patent, so in music it may be said that anything which a fairly good musician can make, the same old tune being

247. Undated Interrogatories, in *Cooper Case File*, *supra* note 238, at 70.

248. *Id.*

249. The costs section of the court’s final judgment reveals that James had taken the testimony of three witnesses before the case was dismissed. Final Decree, in *Cooper Case File*, *supra* note 238, at 99, 99–100. Among them, the most likely candidate for the author of these interrogatory responses was Seaborn Denson, who is credited as the composer of the alto lines in James’s version of the hymnal. See McKenzie, *supra* note 234, at 154 n.4.

250. See Brief of Albert Kemper & J. S. James, in *Cooper Case File*, *supra* note 235, at 71, 74.

251. *Id.* at 84–85.

252. *Id.* at 85.

253. *Cooper v. James*, 213 F. 871, 872 (N.D. Ga. 1914) (quoting *Jollie v. Jaques*, 13 F. Cas. 910 (C.C.S.D.N.Y. 1850) (No. 7,437)).

254. *Id.*

preserved, could not be the subject of a copyright.”²⁵⁵ Despite the nonchalance with which the court made this analogy, it remains an extraordinary doctrinal move. In the early twentieth century, no one had yet explicitly tied the *Hotchkiss* inventiveness standard to copyright’s originality requirement. Perhaps as a result, the court hedged on how far its prescription could go. Its holding doesn’t purport to extend to all copyright subject matter but instead only to music.

Three years later, a treatise writer would pick up on this subject-matter selectivity. William Benjamin Hale, the author of the copyright treatise that formed a volume of the legal encyclopedia *Corpus Juris*, wrote that musical arrangements needed to leap a double hurdle in order to obtain protection. First, as with any copyrightable subject, the composition “must be original, within the meaning of originality as elsewhere explained.”²⁵⁶ But, citing both *Jollie* and *Cooper*, the treatise added Justice Nelson’s further requirement that the work must display more than mere mechanical skill. Picking up right where *Cooper* had left off, it posited that “[t]he distinction is substantially that made in the law of patents between the exercise of inventive genius and the exercise of mere mechanical skill; the former is protected by the statute, but the latter is not.”²⁵⁷

Modern practitioners wouldn’t recognize that proposition. There is no doctrinal first principle that supports a more patent-like protectability threshold for musical works than for other works. But *Jollie* was a music case, and the *Cooper* court didn’t need anything more than a music case to reach its preferred outcome. By 1920, then, judges had a fledgling line of authority concluding that patent’s standard of invention was a reasonable fit for music copyright.

That authority would be invoked sporadically, appearing only a handful of times over the remaining decades of the twentieth century. But even its few citations were prominent enough to reinforce the notion that musical originality should be slotted on a different analytical track than other kinds. In *Norden v. Oliver Ditson Co.*,²⁵⁸ the work-in-suit was an English-language adaptation of a Russian hymn that had required rhythmic changes to compensate for the new words’ syllabification. On the strength of *Jollie* and *Cooper*, the court held that the piece was ineligible for protection. Works of visual art, the court deduced, “need not, like patents, disclose the originality of invention, but may present an old theme if there is distinguishable variation.”²⁵⁹ Musical works, by contrast, were to be judged by *Cooper*’s “fairly good musician” standard. Copyright wasn’t available for the English-language arrangement because it “remained ‘the same old tune,’” whose changes “any skilled musician might make.”²⁶⁰

255. *Id.*

256. WILLIAM B. HALE, A TREATISE ON THE LAW OF COPYRIGHT AND LITERARY PROPERTY § III (1917).

257. *Id.*

258. 13 F. Supp. 415, 416 (D. Mass. 1936).

259. *Id.* at 418.

260. *Id.*

Similarly, in *Arnstein v. Edward B. Marks Music Corp.*,²⁶¹ the court announced that when assessing the copyrightability of musical arrangements, “the same test is to be applied as in the case of patents; that is, it must indicate an exercise of inventive genius as distinguished from mere mechanical skill or change.”²⁶² Unlike the works involved in earlier cases that had invoked Nelson’s standard, the pop song at issue in *Arnstein* was a new piece rather than a new arrangement of a preexisting one. Perhaps as a result, the court deemed it to be sufficiently inventive to pass that high bar.²⁶³ Along the way, though, the court signaled how little it thought of the authorship involved in these mass-culture products, writing that neither the plaintiff’s nor the defendant’s music was a “work of great merit.”²⁶⁴ They were, rather, “popular songs of the kind that have a limited vogue and soon pass into the great limbo of forgotten songs, never to be resurrected.”²⁶⁵

By this point, *Jollie*’s limited progeny had become recognizable as its own line of originality doctrine. In a 1941 report to Congress, for example, the Register of Copyrights wrote that courts held the power to “den[y] the validity of a claim of copyright based on an alleged authorship where that authorship was found to be lacking.”²⁶⁶ This is an unextraordinary assertion, so far as it goes, but the Register’s best authority for that proposition was a single string cite of four cases: *Jollie*, *Norden*, *Cooper*, and *Arnstein*.²⁶⁷ To the Register, apparently, those cases most clearly represented what the absence of originality looked like.

Similarly, when Zechariah Chafee wrote his famous *Reflections on the Law of Copyright* in 1945,²⁶⁸ the move toward patents had become familiar enough for him to endorse it as a bedrock principle. After quoting “Judge Nelson’s test,” Chafee observed that music copyright operated by “an analogy to the rule which refuses to patent an improvement on an existing invention, if any good mechanic could think up the improvement.”²⁶⁹ To Chafee, the analogy was meant to ensure that merely minimal additions didn’t prevent what today we might call evergreening of protection for expressive works.²⁷⁰ That goal, of course, is a familiar one. It’s shared by most contemporary commentators and reflected in judges’ regular insistence that derivative works be readily distinguishable from

261. 11 F. Supp. 535 (S.D.N.Y. 1935), *aff’d*, 82 F.2d 275 (2d Cir. 1936).

262. *Id.* at 536.

263. *Id.*

264. *Id.* at 535.

265. *Id.*

266. THE LIBR. OF CONG. COPYRIGHT OFF., FORTY-FOURTH ANNUAL REPORT OF THE REGISTER OF COPYRIGHTS 16 (1941), <https://www.copyright.gov/reports/annual/archive/ar-1941.pdf> [<https://perma.cc/R9KX-TFA6>].

267. *Id.* at 16 n.8.

268. Zechariah Chafee, Jr., *Reflections on the Law of Copyright: I*, 45 COLUM. L. REV. 503 (1945).

269. *Id.* at 512.

270. *Id.*

their underlying originals.²⁷¹ But tying the bar for sufficient additions to what “any good mechanic could think up” remains a fundamental break from the rest of the generally applicable originality standard. Whereas a derivative in other fields might be able to skate past so long as it was distinguishable enough from the original work, a musical derivative would also need to differentiate itself from the universe of other potential derivatives that persons having skill in the art were likely to produce.

Despite Chafee’s imprimatur, however, over the remaining thirty years before Congress would pass the current Copyright Act, only one case would rely on the *Jollie* standard, *McIntyre v. Double-A Music Corp.* in 1958.²⁷² And between the Copyright Act’s passage and the Supreme Court’s 1991 *Feist* decision clarifying originality doctrine’s low-creativity threshold, no case relied on it. An observer in the early 1990s could have reasonably guessed that Nelson’s high-creativity threshold had simply died out.

But it hadn’t. Three years after the Supreme Court decided *Feist*, Nelson’s threshold came back. The vehicle was *Woods v. Bourne Co.*,²⁷³ a rights-reversion case that hinged on whether a particular musical arrangement qualified as an independently protectable derivative work. The Copyright Act of 1976 permits authors or their statutory heirs to terminate certain transfers after fifty-six years from the inception of the copyright term, notwithstanding any agreement to the contrary.²⁷⁴ Authors and their beneficiaries can thus recapture the interests that they had once bargained away. But the statute makes an exception for the owner of a derivative work that had been prepared under the authority of the grant.²⁷⁵ Even after the grant is terminated and other rights revert back to the grantor, the derivative work’s owner can continue exploiting it. For example, a film studio could continue selling copies of a motion picture that had been derived from a novel, notwithstanding the novelist’s recapture of the exclusive right to exploit the literary work itself. *Woods* presented the question of how this provision should apply to different arrangements of a musical work.

271. See, e.g., *Schrock v. Learning Curve Int’l, Inc.*, 586 F.3d 513, 521 (7th Cir. 2009) (concluding that in assessing the copyrightability of a derivative work, “the key inquiry is whether there is sufficient nontrivial expressive variation in the derivative work to make it distinguishable from the underlying work in some meaningful way”); I MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 3.03[A] (Matthew Bender, Rev. Ed.), LEXIS (database updated 2021) (defining the “necessary quantum of originality” for a derivative work to be any variation “that is sufficient to render the derivative work distinguishable from its prior work in any meaningful manner”).

272. See *McIntyre v. Double-A Music Corp.*, 166 F. Supp. 681, 683 (S.D. Cal. 1958) (relying on *Cooper* for the proposition that the plaintiff couldn’t receive a copyright for “the addition of certain inconsequential melodic and harmonic embellishments such as are frequently improvised by any competent musician”).

273. See 841 F. Supp. 118 (S.D.N.Y. 1994), *rev’d in part on other grounds*, 60 F.3d 978 (2d Cir. 1995).

274. See 17 U.S.C. § 304(c). This provision only applies to transfers that predate the 1976 Act’s passage. A separate termination provision, not at issue in *Woods*, applies to transfers that postdate it. See *id.* § 203.

275. *Id.* § 304(c)(6)(A).

The dispute began when the heirs of Harry Woods, the composer of the 1926 hit *When the Red, Red Robin Comes Bob-Bob-Bobbin Along*, exercised their termination rights to recapture the rights to (and future royalties from) the song, which had been assigned to a publisher the same year it was written.²⁷⁶ The publisher's successor, trying to retain those royalty streams even after termination, countered that it wasn't exploiting the original work but only derivative arrangements that it had prepared. If it was in fact using its own derivative works rather than the original one whose ownership had reverted, then under the statute's derivative work exception it would continue collecting royalties. As a result, the court needed to classify legally just what it was that the publisher had been exploiting: The same original song that Woods wrote in 1926, or a separately copyrightable arrangement? As the trial judge would eventually frame the case, that argument teed up the fundamental question, "What is a derivative work?"²⁷⁷

According to the publisher, the underlying work was the songwriter's unpublished lead sheet, comprising no more than lyrics and the melody line, that he submitted for commercial publication.²⁷⁸ The publisher's first commercial piano-vocal arrangement was, as a result, an independently protected derivative of that lead sheet, and all subsequent versions were either copies of that arrangement or new derivative works themselves.²⁷⁹ By that definition, the only renditions of the song that had ever been commercially exploited in its history would have been publisher-authored derivatives; the songwriter's original work would have been like the tree falling in the forest without making a sound.

The case proceeded to a two-day bench trial before Judge Richard Owen in 1992. Though randomly assigned, Judge Owen was a fitting choice. He was likely one of the most musically literate judges in the history of the federal judiciary. To begin with, he was a bona fide opera composer.²⁸⁰ Over the course of his tenure on the bench, he wrote nine of them.²⁸¹ As a break from his day job, he studied the craft at the Manhattan School of Music, eventually earning an honorary doctorate there.²⁸² In 1976, he also decided one of music copyright's most famous infringement trials, finding that George Harrison's solo hit *My Sweet Lord* had unconsciously plagiarized from the song *He's So Fine* as

276. *Woods*, 60 F.3d at 981.

277. *Woods*, 841 F. Supp. at 120.

278. *Woods*, 60 F.3d at 989.

279. *Id.*

280. See Roberta Hershenson, *Law from His Court Bench, Opera from the Piano Bench*, N.Y. TIMES (Feb. 23, 1992), <https://www.nytimes.com/1992/02/23/nyregion/law-from-his-court-bench-opera-from-the-piano-bench.html> [<https://perma.cc/JXP3-TK78>]; *Deaths: Owen, Richard*, N.Y. TIMES (Nov. 26, 2015), <https://archive.nytimes.com/query.nytimes.com/gst/fullpage-9B03E3D8103AF935A15752C1A9639D8B63.html> [<https://perma.cc/PL2N-ZH4X>].

281. *Deaths: Owen, Richard*, *supra* note 280.

282. *Id.*

recorded by The Chiffons.²⁸³ Owen wasn't shy about bringing his musical chops to bear on the witnesses appearing before him. As Owen himself would later reflect in an interview with the magazine *Opera News*:

I did find that [Harrison] had taken their main theme, but it was subconscious plagiarism. I went home after the first night and thought, 'Well, nobody asked this man the right questions.' The next day, when he got back on the witness stand, I said, 'Mr. Harrison, where did you get this theme?' and sang it to him. He said, 'Mind if I get my guitar?' And for about forty-five minutes, we sang to each other. The transcript is marvelous, because it reads, 'WITNESS SINGS/JUDGE SINGS.'²⁸⁴

In the *Woods* bench trial, the judge similarly took the reins of the examination. Most of the relevant facts were stipulated in advance, and the only witnesses to testify were the publisher's owner and the parties' dueling music experts.²⁸⁵ On direct examination, the Juilliard professor appearing as the publisher's expert testified that, in his view, the arrangements contained numerous creative additions that reflected "knowing what to include and not include throughout the scope of a piece."²⁸⁶ In a line that would have made Nelson proud, the judge interjected disapprovingly, "Is this something that is basically within the skills in your opinion of a cocktail-hour pianist at the St. Regis if he was playing this thing?"²⁸⁷ The two then had the following colloquy:

Witness: How good a cocktail pianist?

Court: He went to Juilliard.

Witness: A Juilliard grad. Okay. I'm saying it is not necessarily a work of genius. If you are asking, is this Beethoven? Probably not Could Beethoven use this line? Yes. I would almost venture to say you would find it somewhere in Beethoven's work. I don't know if that makes this particular line brilliant. It is certainly creative.²⁸⁸

The expert testifying on behalf of Woods's heirs would later pick up on the court's dismissiveness of the hypothetical cocktail-hour pianist. At the close of his testimony, he parroted back that the publisher's additions and deletions "are nothing more than those simple choices that any of us would make, that any journeyman musician would make, that any cocktail pianist would make. They are not creatively significant."²⁸⁹

283. See *Bright Tunes Music Corp. v. Harrisongs Music, Ltd.*, 420 F. Supp. 177, 180–81 (S.D.N.Y. 1976).

284. Brian Kellow, *On the Beat*, OPERA NEWS, Feb. 2003, at 8.

285. See Brief of Defendant-Appellant Bourne Co. at 6, *Woods v. Bourne Co.*, 60 F.3d 978 (2d Cir. 1995) (No. 94-7421) (on file with author); Transcript of Proceedings at 2, 64, 112, *Woods v. Bourne Co.*, 841 F. Supp. 118, 123 (S.D.N.Y. 1994) (No. 89 Civ. 3641) (on file with author).

286. Transcript of Proceedings at 72, *Woods v. Bourne Co.*, 841 F. Supp. 118, 123 (S.D.N.Y. 1994) (No. 89 Civ. 3641) (on file with author).

287. *Id.*

288. *Id.*

289. *Id.* at 192.

The judge and the publisher's expert, meanwhile, parried back and forth about the musical significance of various compositional choices, talking shop on the classification of particular harmonies.²⁹⁰ When the publisher recalled the expert to the stand the following day, Owen shared the details of his morning working through the case at home at the keyboard:

I played these through the piano from 7:30 to 8:15 this morning. A number of times. This coda—(court singing)—as he has there is any one of 50 ways you can get out of this song. You could have had a chord and you could have gone up in a minor II and then gone into a V and hit a cadence and you're out. So this is just a matter of choice. He could have done anything. He could have put a trill in there and then an F-natural and finally hit the F-sharp and the leading tone and he is home.²⁹¹

Of course, under *Feist*, the fact that the arranger had many choices should cut in favor of copyrightability, not against it. And that's how the expert understood the suggestion, replying that the judge's realization had simply confirmed the piece's "creative concept."²⁹²

Yet the *Feist* standard notwithstanding, Owen wasn't nearly as interested in choice for choice's sake. He wanted to see a sufficiently *meritorious* choice. "I will now be a music critic,"²⁹³ he declared—seeming to fly in the face of Justice Holmes's now-canonical admonition against judges assessing aesthetic merit.²⁹⁴ "Playing it through," Owen explained, "I much preferred" the earlier version from 1926, which had "a lot more harmonic interest."²⁹⁵ A later arrangement had concededly added a "semi ostinato bass," but to Owen that had only made things worse, as the new material "detract[ed] from the way the song flowed."²⁹⁶

Roughly a year after the trial ended, the court issued a decision finding in the heirs' favor. It held that none of the publisher's contributions since the song's lead-sheet origins constituted a protectable derivative work.²⁹⁷ The changes were, in its view, simply too banal. "[A]s far back as Mr. Justice Nelson in *Jollie v. Jacques* [sic]," Owen explained, a protectable musical work needed to possess "additions and variations, which a writer of music with experience and skill might readily make."²⁹⁸ Relying also on *Jollie*'s twentieth-century successors

290. See, e.g., *id.* at 86 (discussing whether a chord is properly considered a 7th or a 9th); *id.* at 87–88 (discussing whether a chord is a dominant 7th or instead a diminished 7th).

291. *Id.* at 198–99.

292. *Id.* at 199.

293. *Id.*

294. See *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903) ("It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits.").

295. Transcript of Proceedings, *supra* note 286, at 199.

296. *Id.* at 199–200.

297. *Woods v. Bourne Co.*, 841 F. Supp. 118, 123 (S.D.N.Y. 1994), *rev'd in part on other grounds*, 60 F.3d 978 (2d Cir. 1995).

298. *Id.* at 122 (quoting *Jollie v. Jacques*, 13 F. Cas. 910 (C.C.S.D.N.Y.1850) (No. 7,437)).

Cooper, Norden, and McIntyre, Owen took his quip about cocktail pianists from his trial questioning and enshrined it in the pages of the Federal Supplement. The opinion declared that a musical derivative work needs “more than mere cocktail pianist variations of the piece that are standard fare in the music trade by any competent musician.”²⁹⁹ To pass muster, it should have “such things as unusual vocal treatment, additional lyrics of consequence, unusual altered harmonies, novel sequential uses of themes—something of substance added making the piece to some extent a new work with the old song embedded in it but from which the new has developed.”³⁰⁰

Because the arrangements at issue failed to clear this “competent musician” bar, the court held them to be merely versions of the original rather than independently protected derivative works. The royalty streams from those arrangements would thus revert back to the heirs.

The publisher appealed, predictably criticizing what it perceived to be the trial judge’s conflation of copyright and patent standards of protectability.³⁰¹ It disparaged the *Jollie* and *Cooper* reeds on which the district court had hung its patent-like standard as “two obsolete district court cases and their progeny.”³⁰² The heirs, for their part, contended that the court was simply remaining faithful to the special regime that had historically governed musical works. According to their brief, Owen had not “appl[ied] patent standards,” but rather had applied “the standards that have always prevailed in holdings concerning originality of derivative works of music and other performing arts.”³⁰³

In a way, the publisher and the heirs were both right. Just as the publisher had argued, the trial court’s framework resembled a patentability framework far more than a traditional copyright one. At the same time, just as the heirs had argued, music cases didn’t always play by the same rules as the ones that tradition generally emphasized.³⁰⁴ Though the publisher didn’t style it this way, its argument was effectively a plea for music cases to rejoin the rest of the pack.

299. *Id.* at 121.

300. *Id.*

301. See Brief of Defendant-Appellant Bourne Co., *supra* note 285, at 33 (criticizing the district court’s test as perhaps “appropriate to evaluate the validity of a patent” but inappropriate for copyright cases and “contrary to the Congressional intent” behind the Copyright Act of 1976).

302. *Id.*

303. Brief of Plaintiffs-Appellees at 17–18, *Woods*, 60 F.3d 978 (No. 94-7421) (on file with author).

304. Justin Hughes has highlighted this discrepancy in the *Woods* decision, observing that the court’s “competent musician” language “would be disconcerting to almost any other class of beneficiaries of copyright law.” See Hughes, *supra* note 12, at 123. He argues that “[i]f we substituted ‘screenwriter’ or ‘painter’ in place of ‘musician,’ we would have opinions denying copyrights to works that are the ‘standard fare in the trade by any competent screenwriter,’ or ‘anything a fairly good painter c[ould] make.’ These phrases sound much more like the patent law standard for novelty than the post-*Bleistein* standard for copyright protection.” *Id.*

Though the appeals court hedged a bit on the district court's choice of language, it wound up affirming.³⁰⁵ True, the Second Circuit acknowledged, "the requirement of originality is not the same as the requirement of novelty, the higher standard usually applied to patents."³⁰⁶ Owen's requirement of "unusual vocal treatment" and the like was therefore "overstate[d]."³⁰⁷ But that line, in the appeals court's view, was merely a stray bit of dictum in the midst of an otherwise correct identification and application of the originality standard.³⁰⁸ Significantly, the appeals court did not cast similar aspersions on the part of Owen's decision that pitted competent musicians and cocktail pianists against putatively genuine composers. All that dichotomy meant, according to the Second Circuit, was the innocuous proposition that special physical skills or training is insufficient to achieve protectable originality.³⁰⁹ Never explained was how one could get to that reading from a starting point that all but demanded outperforming the average practitioner in the field. In any event, the court was satisfied that Owen had gotten the originality standard right.³¹⁰

The latest invocation of the *Jollie* standard was in the recent, headline-grabbing litigation over the copyright status of the song *We Shall Overcome*.³¹¹ In 2017, the district court judge overseeing that case invoked Owen's "cocktail pianist" test as appellate precedent, quoting the Second Circuit's acceptance of the reasoning below.³¹² That test hadn't been cited in the written submissions of either party, so the judge seems to have chosen it *sua sponte*. In fact, it's far from clear that the court even needed a heightened threshold to reach the outcome it eventually did. Because the plaintiff seeking protection for its version's first verse was relying principally on individual word changes, such as "will" to "shall" and "down" to "deep," the arrangement failed easily.³¹³ Nevertheless, the court seemed prepared to set the bar higher for any future music arrangements. It justified its ruling on the grounds that the variations at issue were "standard fare in the music trade by any competent musician."³¹⁴

305. *Woods*, 60 F.3d at 990–93. The appeals court did, however, reverse in part on a separate issue regarding post-termination uses within pre-termination audiovisual works. *See id.* at 988.

306. *Id.* at 991.

307. *Id.* at 990–91.

308. *Id.* at 991.

309. *Id.*

310. *Id.* ("[W]e conclude that the district court articulated the correct standard of originality . . .").

311. *See* Christopher Mele, *'We Shall Overcome' Is Put in Public Domain in a Copyright Settlement*, N.Y. TIMES (Jan. 26, 2018), <https://www.nytimes.com/2018/01/26/business/media/we-shall-overcome-copyright.html> [<https://perma.cc/N56P-RLUM>].

312. *We Shall Overcome Found. v. Richmond Org., Inc.*, No. 16cv2725, 2017 WL 3981311, at *13 (S.D.N.Y. Sept. 8, 2017) ("[T]he Court of Appeals has observed that 'stylized versions of the original song,' such as a 'cocktail pianist variations of the piece that are standard fare in the music trade by any competent musician,' are insufficient to satisfy the requirement of originality." (quoting *Woods*, 60 F.3d at 991)).

313. *Id.* at *14.

314. *Id.* (quoting *Woods*, 60 F.3d at 991).

As of this writing, it remains to be seen whether this high-profile endorsement will meaningfully increase the salience of the *Jollie* standard. In the meantime, to be sure, only two cases have relied on *Jollie* since the Supreme Court decided *Feist* in 1991. Still, those cases combined with their earlier predecessors arguably form their own body of law. Litigants can now colorably argue that musical derivatives are simply different doctrinal creatures than literary derivatives. True, as *Feist* cautioned, “[o]riginality does not signify novelty.”³¹⁵ But in music cases originality seems to signify at least something closer to novelty than copyright practitioners would otherwise be used to.³¹⁶

IV.

WHERE ORIGINALITY'S OTHER PATH LEADS

I confess that, in a sense, calling any judicial decision that's reliant on *Jollie* a part of a “path” is overclaiming. The high-originality cases discussed in the previous Section don't form a neat line. They're something more like jurisprudential cicadas, emerging loudly once every couple of decades and then disappearing until we've long since forgotten about them.

But though scattered across a 170-year expanse, these cases nevertheless remain in conversation with each other. And they offer a few lessons for those thinking about copyright law today. The most basic one is probably that, for those commentators who would like to see a more patent-like originality test, the notion has some historical pedigree.³¹⁷ While I'm not here subscribing to such proposals on the merits, those who already have may find it useful to have more precedential wind in their sails.

More broadly, though, *Jollie* and its lineage should inform current debates about what copyright is. The history recounted here should inform across at least three issues: the extent of the historical connection between copyright and patent law; the viability of judicial tailoring of facially uniform copyright standards; and the inherent factual contingency of doctrines that, over time, we may have come to treat as foreordained. I discuss each below.

A. Family Resemblances

The *Jollie* standard bolsters the argument that, however much copyright and patent may differ as mature fields today, they grew up together. The most famous proponent of that argument was the Supreme Court's 1984 decision in *Sony Corp. v. Universal City Studios*, which asserted that the two regimes

315. *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991).

316. As a leading treatise summarizes the case law since the turn of the twentieth century, courts in these cases have “produced a somewhat higher standard of distinguishable, nontrivial variation than is applied to other forms of derivative works.” GOLDSTEIN, *supra* note 7, § 2.16.2.2 (citing *Cooper, McIntyre, Norden, Woods, and We Shall Overcome Foundation*).

317. *Cf.* Miller, *supra* note 6, at 471 (arguing, based on *Jollie* alone, that “[t]he contemporary taboo against comparing originality to nonobviousness” is a recent development).

share a “historic kinship.”³¹⁸ Since then, courts have repeatedly justified applying precedent from one area to another.³¹⁹ Yet *Jollie*’s forgotten post-history turns out to support the kinship theory much better than *Sony*’s own cited authorities do.

That theory merits some initial skepticism. Although the same Constitutional provision empowers Congress to legislate in both areas,³²⁰ the kinship that the *Sony* court spoke of was hardly self-evident. On the contrary, as Peter Menell and David Nimmer have chronicled, the evidence that the Court marshalled for it is underwhelming.³²¹ The Court cited three exemplary precedents meant to show that patent law could be used to interpret copyright law.³²² But two of those precedents dealt with questions of how the entitlement could be legally exploited as an industrial asset, not of the entitlement’s internal workings themselves. One was an antitrust case addressing the practice of refusing to grant a license for one work unless the recipient would also agree to license others.³²³ The other dealt with whether copyright licenses qualified as instrumentalities of the federal government, a status that would have exempted the gross receipts of royalties from state taxation.³²⁴ Neither analogy tells us much about the exclusive rights themselves, how they may be earned, how they may be infringed, or how their violation may be remedied.³²⁵

The third case, *Wheaton v. Peters*, is more on point.³²⁶ *Wheaton* was an 1834 decision that rejected the assertion of perpetual common-law copyright for published works, whose statutory copyright was limited in time. The plaintiffs there had argued against drawing any lessons from patent doctrine, which offered no protection at common law.³²⁷ But Justice McLean, who about fifteen years

318. *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 439 (1984). In the exact context of *Sony*, the Court relied on the kinship to justify applying the Patent Act’s “staple article or commodity of commerce” limitation on contributory infringement, 35 U.S.C. § 271(c), even though the Copyright Act lacks any such limitation—or, indeed, any contributory infringement provision whatsoever.

319. The Supreme Court has invoked this “kinship” rationale most recently in *Impression Products, Inc. v. Lexmark International, Inc.* in support of a rule that a foreign sale of a patented item exhausts U.S. patent rights in that item, just as it would for a copy of a copyrighted work. 137 S. Ct. 1523, 1536 (2017). For a survey of lower-court references to this language, see David W. Barnes, *Abuse of Supreme Court Precedent: The “Historic Kinship,”* 16 CHI.-KENT J. INTELL. PROP. 85 (2016).

320. See U.S. CONST. art. I, § 8, cl. 8.; Edward C. Walterscheid, *Divergent Evolution of the Patent Power and the Copyright Power*, 9 MARQ. INTELL. PROP. L. REV. 307, 309 (2005) (arguing that it’s reasonable to suppose that “by using the singular ‘the exclusive Right’ and combining authority to create both patents and copyrights in the same Clause, the Framers intended the legal consequences of both the patent grant and the copyright grant to be similar, if not identical”).

321. Peter S. Menell & David Nimmer, *Unwinding Sony*, 95 CALIF. L. REV. 941, 985–89 (2007).

322. *Sony*, 464 U.S. at 439 n.19.

323. *United States v. Paramount Pictures*, 334 U.S. 131, 158–59 (1948).

324. *Fox Film Corp. v. Doyal*, 286 U.S. 123, 126 (1932).

325. See Menell & Nimmer, *supra* note 321, at 986.

326. *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591 (1834).

327. See *id.* at 598 (recounting the plaintiff’s argument that “the subjects of patents and of copyrights have little analogy” and are “widely different”).

later would author the trial court decision in *Hotchkiss*, concluded that authors and inventors deserved like treatment. He asked rhetorically:

In what respect does the right of an author differ from that of an individual who has invented a most useful and valuable machine? In the production of this, his mind has been as intensely engaged, as long; and, perhaps, as usefully to the public, as any distinguished author in the composition of his book.

The result of their labours may be equally beneficial to society, and in their respective spheres they may be alike distinguished for mental vigour. Does the common law give a perpetual right to the author, and withhold it from the inventor? And yet it has never been pretended that the latter could hold, by the common law, any property in his invention, after he shall have sold it publicly.

. . . .

Does not the man who imitates the machine profit as much by the labour of another, as he who imitates or republishes a book? Can there be a difference between the types and press with which one is formed; and the instruments used in the construction of the others?³²⁸

Wheaton, unlike the other cases on which the *Sony* court's asserted kinship relies, at least ties the two regimes at a theoretical and doctrinal level.³²⁹ But as foundational as *Wheaton* is within the copyright canon, it's still just a single reed on which to hang the argument. That reed might look especially slim in light of other twentieth-century pronouncements from the Court refusing to engage in similar cross-regime analogies.³³⁰

Jollie and its lineage, however, lends the analogy the extra support that the *Sony* court perhaps didn't know it had. In the mid-nineteenth century, a high-creativity threshold for protectability was part of the same conversation for copyrights and patents alike. For a brief moment, the justices were engaged in a project of uniting a creative class of authors and inventors together as a categorical antithesis of the skilled mechanic.

During this same period, Justice McLean continued the logic of equivalence that he began in *Wheaton*. He questioned the entire existence of copyright's then-ascendant fair use doctrine precisely because no equivalent limitation existed in patent law. In an 1847 decision that is surprisingly never mentioned in discussions of copyright's and patent's historical connections, Justice McLean pronounced that "[t]he same rule of decision should be applied

328. *Id.* at 657–58.

329. Though, as Menell and Nimmer observe, *Wheaton* would at best support analogizing between judge-made doctrines, not inserting a congressionally enacted provision from one statute into another, as the Court did in *Sony*. See Menell & Nimmer, *supra* note 321, at 986–87.

330. See, e.g., *Bobbs-Merrill Co. v. Straus*, 210 U.S. 339, 346 (1908) ("There are such wide differences between the right[s] . . . protected by the copyright statute and the rights secured to an inventor under the patent statutes, that the cases which relate to the one subject are not altogether controlling as to the other." (quoting *John D. Park & Sons Co. v. Hartman*, 153 F. 24, 28 (6th Cir. 1907))).

to a copyright as to a patent for a machine.”³³¹ He began from the premise that “[t]he construction of any other machine which acts upon the same principle,” no matter how much simpler or cheaper, infringes the patent. Copyright, he reasoned, should operate no differently: “Now an abridgment, if fairly made contains the principle of the original work, and this constitutes its value. Why, then, in reason and justice, should not the same principle be applied in a case of copyright as in that of a patented machine?”³³² McLean begrudgingly relented from the analogy only because he felt constrained by the earlier cases that had already recognized fair use as a distinctive limitation on copyright.³³³

Jollie’s progeny show a remarkable willingness to turn to patent principles at least for musical derivative works. Some judges even expressly concluded that patent cases provide a better analytical roadmap for that subject matter than other copyright cases do.³³⁴ They had no difficulty drawing from patent’s well when copyright alone didn’t provide what they were looking for.

Even the cover page of the work at issue in *Jollie* suggests some slippage between the categories of authorship and inventorship. Recall that the sheet music specified who “invented” the choreography,³³⁵ an output that would today be categorized as authorial.³³⁶ At the time, though, the term “invention” included artistic novelties. Even as far back as 1697, John Dryden used the term to describe the work of both poets and scientists in the same breath. An author’s “[w]ant of invention,” he wrote, is treated like “a capital crime . . . for a poet is a maker . . . and who cannot make, that is, invent, hath his name for nothing.”³³⁷ *D’Almaine v. Boosey*, the British case that provided *Jollie* its sole legal authority for a heightened creativity threshold, similarly stated that a composition’s

331. *Story v. Holcombe*, 23 F. Cas. 171, 173 (C.C.D. Ohio 1847) (No. 13,497). A Westlaw search of the case’s citing references shows only one that mentions *Sony*’s “historic kinship” language, and even that article cited it for an unrelated issue. See Walterscheid, *supra* note 320, at 328 n.130.

332. *Story*, 23 F. Cas. at 173.

333. *Id.* (“I am . . . bound by precedent; and I yield to it in this instance, more as a principle of law, than a rule of reason or justice.”).

334. See *Arnstein v. Edward B. Marks Music Corp.*, 11 F. Supp. 535, 536 (S.D.N.Y. 1935), *aff’d*, 82 F.2d 275 (2d Cir. 1936); *Cooper v. James*, 213 F. 871, 872 (N.D. Ga. 1914); see also Chafee, *supra* note 268, at 512; HALE, *supra* note 256.

335. See Cover page to Samuel Jollie’s sheet music for *The Serious Family Polka*, *supra* Figure 1.

336. See 17 U.S.C. § 102(a)(4) (listing “choreographic works” among the categories of copyrightable works of authorship).

337. John Dryden, *Dedication of the Aeneis*, in VIRGIL’S *AENEID* 5, 39 (Charles W. Eliot ed., John Dryden, trans., Cosimo 2009) (1697). Later in his essay, Dryden would go on to assail efforts that place the “invention” standard too high, sounding the same themes of incremental, cumulative authorship as *Story* would over a century later in *Emerson v. Davies*. See *id.* (“[I]f invention is to be taken in so strict a sense, that the matter of a poem must be wholly new, . . . the history of Troy was no more the invention of Homer than of Virgil At this rate, as Solomon hath told us, there is nothing new beneath the sun. Who then can pass for an inventor, if Homer, as well as Virgil, must be depriv’d of that glory?”). My point is, then, not that Dryden thought that good poetry needed to clear a high ingenuity bar, but that he discussed that bar in the language of invention to begin with.

melody “is the invention of the author” and “that in which the whole meritorious part of the invention consists.”³³⁸

Both the 1828 and 1841 editions of Webster’s dictionary define the word “invention” to include not just the development of new devices like the cotton gin and thermometer but also several distinctly artistic meanings: “fiction” (as in “fables are the inventions of ingenious men”); a painter’s “finding or choice of the objects which are to enter into the composition of the piece”; a poet’s “add[itions] to the history of the subject”; and a rhetorician’s “finding and selecting of arguments to prove and illustrate the point in view.”³³⁹ The 1907 edition, from *Cooper v. James*’s time, still defined “invention” in the context of the fine arts as meaning “[t]he exercise of the imagination in selecting and treating a theme, or more commonly in contriving the arrangement of a piece, or the method of presenting its parts.”³⁴⁰ Given that the doctrine of “invention” was patent law’s conceptual source for a heightened creativity threshold, should it be surprising that some judges in this era would try to fit authorial works into the same box?

To be clear, I’m not at all arguing as a normative matter that doctrinal borders between copyright and patent should be weak. While it’s not my project here to make this case, I agree with the many who have argued that society loses out when IP doctrines fail to channel particular innovations into the regime that’s best tailored to them.³⁴¹ Not all creative outputs should receive copyright’s cheap acquisition costs and life-plus-seventy-years duration. Nor should all receive patent’s thicker scope and absolute excludability even against independent developers. Many of the Court’s IP cases, moreover, have been devoted to precisely such channeling.³⁴² But as a descriptive matter, the cases following in *Jollie*’s footsteps suggest that some authorial works fall close enough to the patent side of the divide to invite cross-border exchange.³⁴³ In these cases’

338. (1835) 160 Eng. Rep. 117, 123; 1 Y. & C. Ex. 288, 302.

339. 1 NOAH WEBSTER, AN AMERICAN DICTIONARY OF THE ENGLISH LANGUAGE 1001 (New York, S. Converse 1828) (definition of the noun, invention); NOAH WEBSTER, AN AMERICAN DICTIONARY OF THE ENGLISH LANGUAGE 466 (New York, White & Sheffield, abr. rev. ed. 1841) (same).

340. 1 WEBSTER’S INTERNATIONAL DICTIONARY OF THE ENGLISH LANGUAGE 785 (Noah Porter ed., new ed., 1907) (definition of the noun, invention).

341. The literature on the importance of such channeling doctrines is vast and still growing. See, e.g., Pamela Samuelson, *Strategies for Discerning the Boundaries of Copyright and Patent Protections*, 92 NOTRE DAME L. REV. 1493 (2017); Christopher Buccafusco & Mark A. Lemley, *Functionality Screens*, 103 VA. L. REV. 1293 (2017); Kevin Emerson Collins, *Patent Law’s Authorship Screen*, 84 U. CHI. L. REV. 1603 (2017).

342. See, e.g., *Baker v. Selden*, 101 U.S. 99 (1880) (copyrights and patents); *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017) (same); *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001) (trademarks and patents).

343. Though dealing with infringement rather than protectability, the case of *Thomas v. Lennon*, 14 F. 849 (Lowell, Circuit Justice, C.C.D. Mass. 1883), which is quoted at the top of this Article, is another example of such exchange. The case concerned Gounod’s oratorio *The Redemption*. The plaintiff, later to become the founding music director of the Chicago Symphony Orchestra, was Gounod’s exclusive U.S. licensee. Because he was in negotiations with Boston’s Handel & Haydn

conception, copyright and patent are indeed kinsmen. Even the “heart of patent law”³⁴⁴ evolved from a common ancestor.

B. Subject-Matter Tailoring

A second takeaway of *Jollie*’s lineage is that courts have the power to condition the scope of seemingly one-size-fits-all standards on the particular subject matter at issue. Tailoring has become a familiar phenomenon in copyright law, particularly at the legislative level. Statutory copyright has become increasingly industry-specific over the last century, particularly since the passage of the 1976 Act.³⁴⁵ The Act includes special provisions for particular kinds of works, including musical compositions,³⁴⁶ sound recordings,³⁴⁷ architectural works,³⁴⁸ and computer programs.³⁴⁹ It also contains exceptions and limitations for particular kinds of licensees, including noncommercial broadcasters,³⁵⁰ satellite carriers,³⁵¹ cable companies,³⁵² and jukebox operators.³⁵³ The statute’s detailed interventions into particular markets and carveouts for particular commercial constituencies has made the area of law far more regulatory than it once was.³⁵⁴

The *Jollie* line of cases is an example of a different sort of tailoring, one the courts have led. Open-ended standards allow judges to adjust the margins of

Society for an exclusive performance, he refused the defendant’s licensing request for a second Boston-area concert. The defendant then sought to preempt the authorized performance by creating his own orchestration from a piano score that had been sold in England and then having his ensemble play that orchestration. Under the existing U.S. law concerning foreign publications, those sales had injected the underlying melodies and harmonies into the public domain. The question before the court was whether “a new orchestration, not copied from the original by memory, report, or otherwise, but made from the book, is an infringement of the plaintiff’s rights.” *Id.* at 851. Because it concluded that orchestration was an “essential part” of the piece, its answer was yes. *Id.* at 853. To reach that result, it found patent law more helpful than the copyright law concerning literary works: “[A]n opera is more like a patented invention than like a common book; he who shall obtain similar results, better or worse, by similar means, though the opportunity is furnished by an unprotected book, should be held to infringe the rights of the composer.” *Id.*

344. See Michel, *supra* note 19, at 143.

345. See, e.g., Joseph P. Liu, *Regulatory Copyright*, 83 N.C. L. REV. 87, 97, 105–06 (2004) (noting the origins of industry-specific rights and limitations in the 1909 Act, followed by even more complex tailoring in the 1976 Act); CRAIG JOYCE, TYLER T. OCHOA & MICHAEL CARROLL, *COPYRIGHT LAW* 25 (11th ed. 2020) (describing recent additions to the Copyright Act over the last forty years that “legislate particular regulatory solutions to short-term problems posed by particular technologies in minute (if not exquisite) detail”).

346. 17 U.S.C. § 115.

347. *Id.* § 114.

348. *Id.* § 120.

349. *Id.* § 117.

350. *Id.* § 118.

351. *Id.* § 119.

352. *Id.* § 111.

353. *Id.* § 116.

354. See generally Liu, *supra* note 345.

doctrinal categories for different kinds of works (or parties).³⁵⁵ Commentators have pointed to such standards as a key mechanism for courts to reduce IP laws' otherwise high "uniformity cost," the under-protection or overprotection of different categories of innovative activity that comes with a unitary entitlement.³⁵⁶ Performing this tailoring through judge-made doctrine can avoid some of the administrative costs, industry capture, and quick obsolescence that often accompany legislative carveouts for specific technologies.³⁵⁷

One way patent law implements such tailoring is by tying its nonobviousness standard to the person having ordinary skill in the art.³⁵⁸ The more skill those in the relevant field have on average, the more skill will be attributed to the legal construct of the ordinary person, and the easier it will be for a given invention to be held obvious. The analysis yields industry- or technology-specific applications, in effect even if not in intent.³⁵⁹

Copyright law's originality threshold, however, lacks a similarly context-sensitive foothold. Unlike the Patent Act and *Hotchkiss* before it, neither the Copyright Act nor the Court's originality jurisprudence specifies a perspective from which a work's level of creativity is meant to be assessed. There is no analogous "person having ordinary skill in the art" standard, or even an "ordinary audience for the art," where the fact finder's viewpoint could naturally shift across different artistic genres. The absence of such a viewpoint for protectability questions is especially striking given courts' consideration of different choices for assessing infringement. When assessing product similarity on the infringement side, courts have both experimented with different perspectives for different kinds of works and, in some cases, chosen a perspective with genre-specificity already baked into it.³⁶⁰ As a result, when commentators have pointed

355. See Carroll, *supra* note 21, at 891 ("[C]ourts can choose to use flexible doctrines to strike the incentives-access balance either on a per-work or per-invention basis, or more broadly along industry-specific or technology-specific lines.").

356. See Michael W. Carroll, *One Size Does Not Fit All: A Framework for Tailoring Intellectual Property Rights*, 70 OHIO ST. L.J. 1361, 1395 (2009) (observing that "when taken off the rack, a patent or a copyright appears to be only one size," but, because courts define rights through standards rather than rules, applying those standards in particular cases tailors "the scope or size of a patent or copyright . . . to conform often to industry-specific, technology-specific, or innovator-specific characteristics"); see also Burk & Lemley, *supra* note 21; Carroll, *supra* note 21.

357. For more on these critiques, see Burk & Lemley, *supra* note 21, at 1633–38.

358. See 35 U.S.C. § 103(a).

359. See Burk & Lemley, *supra* note 21, at 1648–51 (describing how variance in the skill level of ordinary practitioners across different fields causes "nominally unitary patent rules to be applied very differently—indeed in directly contradictory ways—in different industries").

360. Compare *Arnstein v. Porter*, 154 F.2d 464, 473 (2d Cir. 1946) (adopting a "lay listener" test rather than one that channeled "the judgment of trained musicians"), with *Boisson v. Banian, Ltd.*, 273 F.3d 262, 272 (2d Cir. 2001) (using a "'more discerning' ordinary observer test" where the plaintiff's work was largely composed of public-domain materials), and *Dawson v. Hinshaw Music Inc.*, 905 F.2d 731, 736 (4th Cir. 1990) (using an "intended audience" standard rather than a lay observer one where "the intended audience is more narrow in that it possesses specialized expertise . . . that lay people would lack"), with *Comput. Assocs. Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 713–14 (2d Cir. 1992) (allowing fact

out copyright doctrine's potential for industry-specificity in the courts, it's often the infringement test—not the threshold protectability determination—that they have in mind.³⁶¹ Originality isn't a natural candidate.

Nevertheless, the cases applying the *Jollie* standard effectively developed a subject-matter-specific originality track just for musical arrangements. Sometimes that move was subtle, relying only on musical-derivative precedents without mentioning their divergence from cases on other subject matter. In *Norden*, it was brazen, as the court all but announced that music precedent occupied an island unto itself.³⁶² Even after *Feist*, with its ostensibly all-encompassing “extremely low” creativity threshold, the *Woods* court assessed originality based on what a competent musician was capable of, a standard that remains good law in the Second Circuit.³⁶³

This goes to show that originality can be a policy lever in copyright law just as much as infringement doctrines can. It does not, however, necessarily mean that courts have been pulling the lever in the right direction. To begin with, for any kind of copyrightable subject matter, demanding more originality may invite individual judges to promote the expressive contributions of some groups while demoting those of others, especially those of groups that society has already marginalized.³⁶⁴ As Robert Brauneis has recently documented, musical arrangements' elevated protectability threshold contributed in the 1950s to a phenomenon of “mirror cover recordings,” in which White musicians would freely copy virtually every distinctive arrangement element of a recording originally made by African American musicians.³⁶⁵ When a record label tried to prevent one such mirror cover through an unfair competition claim, a federal court brushed aside its musicians' expression as too hackneyed to begin with.³⁶⁶ According to the court, the plaintiff's version of the song had contributed nothing more than what was already “well known in the art” and “would [have] occur[ed]

finders to channel the perspective of technical experts when assessing “highly complicated and technical subject matter” such as software).

361. See, e.g., Shyamkrishna Balganes, *The Normativity of Copying in Copyright Law*, 62 DUKE L.J. 203, 230–31 (2012) (identifying the substantial similarity test as court's subtle way of achieving “subject-matter-based tailoring” of entitlement scope). Carroll also points to the idea/expression dichotomy, merger doctrine, and § 113's limitation on protection for the design of useful articles. Carroll, *supra* note 21, at 898.

362. See *Norden v. Oliver Ditson Co.*, 13 F. Supp. 415, 417–18 (D. Mass 1936); see also *supra* text accompanying notes 259–58.

363. See *Woods v. Bourne Co.*, 60 F.3d 978, 990–93 (2d Cir. 1995).

364. See generally K. J. Greene, *Copyright, Culture & Black Music: A Legacy of Unequal Protection*, 21 HASTINGS COMM'NS. & ENT. L.J. 339 (1998) (exploring how Black musicians “as a group, were routinely deprived of legal protection for creative works under the copyright regime”).

365. Robert Brauneis, *Copyright, Music, and Race: The Case of Mirror Cover Recordings* (May 2, 2020) (unpublished manuscript), <https://ssrn.com/abstract=3591113> [<https://perma.cc/24A3-RJLM>].

366. *Supreme Recs., Inc. v. Decca Recs., Inc.*, 90 F. Supp. 904, 913 (S.D. Cal. 1950). The claim sounded in unfair competition, rather than copyright, because the arrangement in question was neither published nor registered. Under then-governing law, copyright protection was therefore unavailable.

to any arranger.”³⁶⁷ As a result, anyone could copy it without paying. That casual dismissal effectively blessed White artists’ continuing uncompensated duplication of Black artists’ recorded performances.³⁶⁸

The potential for such discriminatory effects is a function of copyright in general, not of musical subject matter in particular. It would be easier to understand courts’ special treatment of musical arrangements if there were some policy argument underlying it. But strikingly, across all of the cases and secondary sources reviewed here, almost no one has ever tried to make such an argument. The one exception is the heirs seeking termination in *Woods*. In their appellate brief, they argued that musical arrangements need an especially high bar because “every performance of a musical composition is to some extent an arrangement,” with different compositional features varying “from one performance to another by the same artist.”³⁶⁹ That premise may be true so far as it goes, but it hardly explains the existing case law, in which courts refused to grant any protection even to those who had added significant expressive elements like new orchestrations or voice parts.

I suspect, rather, that the best explanation for musical derivatives’ curiously high originality bar is rooted in courts’ historically narrow account of what makes music creative and commercially valuable. Until very recently, courts in music infringement cases cared only about melodic similarity because, in their view, melody was a composition’s expressive and ontological core.³⁷⁰ As one of these decisions would explain, “[i]t is in the melody of the composition—or the arrangement of notes or tones that originality must be found. It is the arrangement or succession of musical notes, which are the finger prints of the composition, and establish its identity.”³⁷¹ That proposition is wrong on its own terms—there’s plenty of nonmelodic musical innovation to go around—but it grew out of the aesthetic norms of nineteenth-century European art music.³⁷² Courts looking only for melodic similarity in infringement cases were at least being consistent in denying protection for nonmelodic expression in copyrightability cases.

Whether or not musical derivatives represent a good place for courts to be raising the originality bar, though, it’s at least worth considering whether other good places exist. Take, for example, photographs. There is a common understanding that virtually every photograph is subject to copyright protection.³⁷³ The Ninth Circuit has stated that “almost any[] photograph may

367. *Id.* at 911.

368. *See* Brauneis, *supra* note 365, at 19–20.

369. Brief of Plaintiffs-Appellees at 21, *Woods v. Bourne Co.*, 60 F.3d 978 (2d Cir. 1995) (No. 94-7421).

370. *See* Fishman, *supra* note 141.

371. *N. Music Corp. v. King Rec. Distrib. Co.*, 105 F. Supp. 393, 400 (S.D.N.Y. 1952).

372. *See* Fishman, *supra* note 141, at 1892–1903.

373. *See, e.g.*, Justin Hughes, *The Photographer’s Copyright—Photograph as Art, Photograph as Database*, 25 HARV. J.L. & TECH. 339, 373 (2012) (“There is a widespread belief that all photographs

claim the necessary originality to support a copyright merely by virtue of the photographers' [sic] personal choice of subject matter, angle of photograph, lighting, and determination of the precise time when the photograph is to be taken."³⁷⁴ Meanwhile, thanks to the ubiquity of smartphones, the estimated number of new photos annually surpasses a trillion.³⁷⁵ It's said that it takes two minutes today to produce the number of photos produced across the entirety of the 1880s, the decade in which the Supreme Court declared photography to be copyrightable subject matter.³⁷⁶ It may turn out that extending copyright protection to all of these pictures is overly gumming up digital communications without much countervailing improvement in creative output. If so, courts could feasibly raise the quantum of photographic creativity that they deem minimally sufficient under *Feist*.³⁷⁷

I mention photographs only by way of example, and I'm not trying to press the case here for raising their protectability threshold. My point is simply that *Jollie's* high-creativity lineage provides some general proof of concept for using originality as a policy lever to screen out fewer or more works from copyright protection within genre- or industry-specific contexts. It's a lever that future research could consider how best to use.

C. IP Doctrine's Historical Contingencies

What we may today naturally assume to be immutable principles of IP doctrine may turn out to be contingent on the quirks of individual litigants and judges.³⁷⁸ *Jollie's* heightened threshold might never have appeared again after the nineteenth century if not for an especially musically literate lawyer who resuscitated it in *Cooper v. James*. It might never have appeared again after the Supreme Court's decision in *Feist* if not for an especially musically literate trial

are protected by United States copyright law."); Eva E. Subotnik, *Originality Proxies: Toward a Theory of Copyright and Creativity*, 76 BROOK. L. REV. 1487, 1493 (2011) (describing the "tradition of near-presumptive copyright protection" in which photographs are categorically treated as "works of authorship that easily clear the originality threshold outlined by *Feist*").

374. *Ets-Hokin v. Skyy Spirits, Inc.*, 225 F.3d 1068, 1076 (9th Cir. 2000) (quoting 1 MELVIN B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 2.08[E][1], at 2-130 (1999)).

375. Matthew L. Schafer, *The Photograph That Broke the Internet Isn't Copyrightable*, 34 COMM'CS. L., Winter 2019, at 1, 26.

376. *Id.*

377. The Supreme Court has left more room for screening out everyday photographs than is often acknowledged. See *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 59 (1884) (holding that the particular photograph at issue was copyrightable but nevertheless cautioning that "the ordinary production of a photograph" may not be protectable). For more on the underused leeway that courts have to constrain copyright protection for uncreative photographs, see generally Hughes, *supra* note 373. *Cf.* *Oriental Art Printing, Inc. v. Goldstar Printing Corp.*, 175 F. Supp. 2d 542, 546 (S.D.N.Y. 2001) (holding that photographs of food dishes printed on a restaurant menu presented the "rare case where . . . photographs . . . lack the creative or expressive elements that would render them original works" because they "lack any artistic quality").

378. Jessica Litman makes a similar observation in her historical study of one of copyright's most influential cases, *Nichols v. Universal Pictures Corp.*, 45 F.2d 119 (2d Cir. 1930). See Jessica Litman, *Silent Similarity*, 14 CHI.-KENT. J. INTEL. PROP. 11, 15 (2015).

judge in *Woods v. Bourne*. In the extreme, maybe even *Hotchkiss* itself might have played out differently—decided, perhaps, based on an argument that the litigants actually raised—if not for the Justice who happened to have decided *Jollie* on virtually identical grounds only a few months earlier.

Of course, we don't know enough about any of the counterfactuals to verify that these facts caused the doctrine to develop the way that it did. Yet nor do we know enough about any of them to rule it out. That indeterminacy ought to counsel us to approach the case law with some degree of circumspection. We should be open to the possibility that we ended up where we are because of not just doctrinal percolation and lawyerly debate but also one-off strategic decisions and idiosyncratic personalities along the way.

As much as I've tried here to make the case that *Jollie* deserves our attention, it's unfamiliar even to many copyright specialists for a reason: within copyright doctrine, only the domain of musical derivatives felt its impact directly. That narrowness, probably due at least in part to *Cooper's* cabining of the case, is itself noteworthy. While *Jollie* ended up quarantined to musical subject matter only, other music cases have indelibly transformed copyright law across all subject matter. Take *Arnstein v. Porter*, for instance, a 1946 music plagiarism case that ended up setting the ground rules for every future claim of infringing similarity.³⁷⁹ Or, more recently, take *Campbell v. Acuff-Rose Music, Inc.*, a dispute over an alleged parody of a Roy Orbison track that produced a hugely influential Supreme Court decision on the scope of fair use.³⁸⁰ As a closing thought experiment, one might fairly wonder if such a case could plausibly have been limited to musical works, as *Jollie* was, and how the standards for other subject matter might have developed in the case's absence.

CONCLUSION

Virtually every patent law class at least mentions *Hotchkiss v. Greenwood*. Virtually no copyright law class—not even my own, though that's going to change—mentions *Jollie v. Jaques*. It's a pity, because one can better appreciate both cases in juxtaposition. Their parallel beginnings reveal a period of leaky boundaries between copyright and patent, when many of the Justices considered a rule for one to be just as good for the other. Their recurring intersections, meanwhile, muddy today's conventional narrative about copyright's historic commitment to protecting even the most modestly creative works. *Jollie's* still-growing line of cases seems to function as a hidden enclave within originality's larger domain, playing by rules that the rest of its subjects couldn't get away with. Ultimately, perhaps, that might be a healthy thing. Originality needn't be applied uniformly across the myriad kinds of works that it governs.

379. *Arnstein v. Porter*, 154 F.2d 464 (2d Cir. 1946).

380. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994).

The path that *Jollie* and its progeny have blazed is no doubt smaller than the familiar one that copyright practitioners all know. But those thinking about how copyright's history might inform its current design should walk that path every so often. The views are worth it.