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THE PUBLIC DOMAIN: ENCLOSING THE COMMONS OF THE MIND by James Boyle

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THE PUBLIC DOMAIN: ENCLOSING THE COMMONS OF THE MIND by James Boyle. Yale University Press, 2008, 315 pp. Paperback $28.50.

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In the age of the Internet, what are lawmakers doing to protect the public *from* copyright? This is the central question James Boyle considers as he explores the history, application, and future of intellectual property laws to works of authorship using contemporary technologies. On one hand, Boyle draws lessons from history, adroitly explaining the positions of legal theorists such as Thomas Babington Macaulay and Thomas Jefferson toward the possibilities and limitations of intellectual property. On the other hand, Boyle draws distinctions from pre-Internet thought, noting the transformations on traditional intellectual property that the age of instantaneous publication and distribution requires. The theme unifying the two is clear: In our history of expanding intellectual property rights, legislatures have consistently neglected to preserve the public domain as an important natural resource.

After briefly explaining the relevant intellectual property law for those not already versed in the field, Boyle focuses the reader on a letter from Thomas Jefferson to Isaac McPherson, dated 1813 (p.17). In that letter, Jefferson opines about the theoretical underpinnings of intellectual property, "[c]onsidering the exclusive right to invention as given not of natural right, but for the benefit of society"[1] (p.21). Boyle identifies a set of cautions in Jefferson's letter, labeling the "Jefferson Warning," akin to Miranda Warnings given suspected criminals (p.21). Those cautions include the difference between intellectual property and tangible property, the lack of entitlement to intellectual property rights, and inherent and proscribed limitations on intellectual property rights (p.21-22). Writings and orations of others, such as British Lord Thomas Babington Macaulay, mirrored this philosophy about intellectual property, questioning the assertion that

copyright is a natural right and upholding "a tradition of skeptical minimalism" that treated intellectual property rights warily (p.35).

If the Jefferson Warning is Boyle's protagonist, its antagonist is the Internet Threat—the notion that "[w]ithout an increase in private property rights, ... cheaper copying will eat the heart out of our creative and cultural industries" (p.53). This Internet Threat, Boyle argues, is responsible for a pervasive belief that "[t]he strength of intellectual property rights must vary inversely with the cost of copying" (p.60). In turn, this belief has led to a system that ignores the benefits of the Internet and instead seeks merely to contain it, and in particular, the intellectual property its users may copy. The intended result is achieved by a conversion of previously common property into private ownership—a second "enclosure movement" reminiscent of the enclosure of English commons from the fifteenth to the nineteenth centuries (p.43).

Conversion is occurring in the form of piecemeal legislation intended to address specific needs of specific industries, effectively curtailing public access to information that would previously have been considered incapable of ownership. As an example, Boyle considers the Digital Millennium Copyright Act (DMCA).[2] The DMCA prohibits the circumvention of copyright protection systems, such as encryption and digital rights management. Application of the DMCA, by granting rights irrespective of traditional copyright analysis including fair use, operates contrary to the First Amendment, becoming "a congressionally created off-switch for fair use" created specifically as a reaction to the Internet Threat (p.97). Moreover, interpretation of the DMCA through the courts has stifled the competition that intellectual property rights are intended to foster.

Specific examples further illustrate the importance and recent enclosure of the public domain to creative and innovative industries, as well as those industries' disparate reactions. In an interesting narrative, Boyle integrates pop culture and copyright law to demonstrate how the music industry, once reliant on the public domain for inspiration, now thwarts others in that same creative process with increased rules and heightened protection. Asks Boyle, "[a]re we in fact killing musical creativity with the rules that are supposed to defend it?" (p.156).

On the other hand, Boyle examines the cases of synthetic biology and computer code, reflecting that the successful steps taken to grant intellectual property rights in industry outputs have resulted in a countermovement to ensure the public availability of information. In the field of synthetic

biology, in which "the product or process involves biological materials not found in nature" (p.171), many scientists rebuff patent rights in the name of innovation. Notes Boyle, "I was depressed by the idea that scientists would have to spend their valuable time trying to work out how to save their discipline from being messed up by the law" (p.174). In the case of computer software, the creators took charge, offering the software as free and open source. Using the General Public License from the Creative Commons, Boyle notes that the:

> …open quality of the creative enterprise spreads. It is not simply a donation of a program or a work to the public domain, but a continual accretion in which all gain the benefits of the program on pain of agreeing to give their additions and innovations back to the communal project (p.186).

One of Boyle's stronger arguments is to recognize that these examples and arguments are just that, and the ultimate proof may be a "test case in which one country adopts the proposed new intellectual property right and another similarly situated country does not, and we can assess how they are both doing after a number of years" (p.207). To this end, he studies the European Union Database Directive,[3] the *sui generis* right in effect in the European Union since 1996, and the resulting report by the Commission tasked with evaluating it ten years later. His conclusions, and the conclusions of the European Union Commission, are telling: even when given specific intellectual property rights to stimulate intellectual creation in a given industry, that protection actually hinders production of new databases, as opposed to facilitating it. The analogy is imperfect. It might be difficult to posit that the United States is a country "similarly situated" to any European country in the production of databases, and this example addresses creation of a new ilk of intellectual property as opposed to the extension of established intellectual property rights to new technologies. Despite these weaknesses, Boyle's story of the Database Directive responds nicely to the question of whether governmental privatization of information has any social benefit at all.

Ultimately, Boyle calls us out on our cultural agoraphobia—our likelihood "to undervalue the importance, viability, and productive power of open systems, open networks, and nonproprietary production" (p.231). He identifies the major problems intellectual property faces—the relative obscurity of the issue, the implications for distinct and separate groups, the ideology shaping its adherents' beliefs, and the lack of empirical evidence— and posits that this moment in time for intellectual property law

and policy is at the same point that the environmental law movement occupied in the 1950s (p.239). He calls for a "cultural environmental movement" (p.247), allowing us to see and preserve the public domain as a national resource just as important as clean air and water. And, while tempering his criticism with optimism, Boyle leaves us with a warning of his own:

> Good intellectual property policy will not save our culture. But bad policy may lock up our cultural heritage unnecessarily, leave it to molder in libraries, forbid citizens to digitize it, even though the vast majority of it will never be available publicly and no copyright owner can be found (p.246).

ENDNOTES

[1] Letter from Thomas Jefferson to Isaac McPherson (August 13, 1813), in 13 THE WRITINGS OF THOMAS JEFFERSON, at 335 (Albert Ellery Bergh ed., The Thomas Jefferson Memorial Society of the United States, 1907), available at http://memory.loc.gov/ammem/collections/jefferson_papers/mtjserI.html.

[2] Digital Millennium Copyright Act (DMCA), Pub. L. No. 105-304, 112 Stat. 2860 (1998) (codified as amended in sections of 5, 17, 28, and 35 U.S.C.).

[3] Directive 96/9/EC on the legal protection of databases, OJ L 77, 27.3.1996, p. 20–28, located at http://eur-lex.europa.eu/smartapi/cgi/sga_doc?smartapi!celexapi!prod!CELEXnumdoc&numdoc=31996L0009&model=guichett&lg=en.

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GENE PATENTS AND COLLABORATIVE LICENSING MODELS: PATENT POOLS, CLEARINGHOUSES, OPEN SOURCE MODELS AND LIABILITY REGIMES, edited by Geertrui Van Overwalle.
Cambridge University Press, 2009, 455 pp. Hardcover $123.00.

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The typically esoteric world of patents has recently been thrust into the headlines as cases involving patented genes have received an unprecedented amount of press. For decades, academics, scientists, practicing attorneys, and legislators have vigorously debated the merits of granting patents on genes and medical diagnostic procedures. Only recently, however, have the courts entered the fray. For example, in March 2010, Judge Sweet of the U.S. District Court for the Southern District of New York handed down a ruling that invalidated a number of patents covering the BRCA genes that signal an increased likelihood of developing breast cancer.[1] Judge Sweet's ruling held that the patent claims on the BRCA genes were directed to unpatentable "product of nature." A few months later in a separate case, the U.S Court of Appeals for the Federal Circuit, following a grant-vacate-remand from the Supreme Court, upheld the validity of a patented method for determining a proper drug dosage level based on a patient's metabolite levels.[2] The courts' entrance into the debate surrounding patenting of human genetic material and medical diagnostics has elicited interest from the full spectrum of public news outlets: from the New York Times to Nature magazine.[3] It would seem that one, or perhaps both, of these cases will be heard at the Supreme Court. In any case, the contentiousness surrounding gene patenting and diagnostic patenting is unlikely to subside any time soon.

In light of the controversy surrounding patents on genetic material, Geertrui Van Overwalle has compiled a collection of writings on this topic by an outstanding group of academics and practicing attorneys in a book titled

GENE PATENTS AND COLLABORATIVE LICENSING MODELS. Van Overwalle and her fellow contributors ask whether collaborative licensing models can reduce public concerns that gene patents will lead to reduced access to research and health care choices. Van Overwalle's book examines the best methods of achieving innovation and maximizing access while assuming that "the problems created by patent law in genetic diagnostics are best served by contractual, collaborative measures" (p.454), and not by restricting patentability as some commentators have proposed. In light of the book's purpose and scope, this review will touch on the licensing ideas raised by the authors while critically examining Van Overwalle's summary of the various authors' contributions, which appears at the book's conclusion.

Before providing private solutions to the problems surrounding gene patenting, Van Overwalle first seeks to identify the precise problems that widespread patenting of genetic material and diagnostic procedures create. Two primary concerns are identified, both of which focus on transaction costs. First, the book examines the problem of increased transaction costs in upstream or basic research. Incentives to engage in initial upstream research can be reduced when an excessive number of property rights holders drive up the transaction costs associated with commercializing those property rights.[4] In the patent field, upstream research is thought to be harmed when, in order to commercialize a particular technology, it is necessary to obtain rights in a multitude of patents held by a multitude of owners (patent thickets), or when multiple patents covering the same technology are held by competing patent owners (blocking patents). Various contributors to GENE PATENTS AND COLLABORATIVE LICENSING MODELS note that empirical studies suggest that patent thickets are not currently a concern in the genetics field (pp.4, 387). Regardless, many observers predict that patent thickets may emerge in the field of medical diagnostics as diagnostic tools improve and personalized DNA arrays become more affordable. Indeed, patent clearance may prove to be the primary driver of diagnostic cost in the coming age of personalized medicine. Second, the book examines the risk of reduced downstream investment, or under-commercialization of patented genetic inventions. At least part of the "translational gap" between early-stage genetic research and therapeutic applications of that research may stem from the transaction costs associated with drug-related negotiations between academic and industry players.

In order to overcome obstacles to the upstream research problem, Van Overwalle's book examines three primary collaborative arrangements:

patent pools, clearinghouses, and open source models. Patent pools, such as the DVD and MPEG-2 pools, have been successfully employed for some time by the electronics industry (pp.33-41). However, the translation of a licensing arrangement from the electronics industry to the diagnostic industry is not without pitfalls. First, most successful patent pools to date (particularly in the electronics industry) have been established in order to create industry standards; the genetics industry, by contrast, does not have such standards with which to comply (pp.38, 48). Whereas the electronics industry is able to increase the value of its products via mutually agreed-upon standards, the genetics industry does not enjoy such interoperability benefits. The lack of standards-driven economics in the genetic industry leads Birgit Verbeure to conclude that patent pools will not provide great benefits to the genetics industry (p.29). Second, and perhaps most troubling from a diagnostic perspective is the problem of holdouts. In the electronics industry, interdependency increases value; the establishment of standards (e.g., the standard diameter of compact discs) increases interoperability and reduces or eliminates switch-over costs. In essence, consumer electronics manufacturers rely on their competitors to create a market for electronic products. Value in the biotech industry, on the other hand, is driven by exclusivity, not interoperability (pp.55-56). Thus, biotech patentees risk much less and stand to gain much more than electronics patentees by refraining from joining a patent pool. Some authors, such as Jorge Goldstein, envision a standards-based regime emerging in the biotech industry via respected health organizations such as the WHO or NIH (p.56). Others, including Dan Burk and Verbeure, suggest that reducing the property-like rights of the patent holder (either through liability regimes or compulsory licenses) may ameliorate some of the holdout issues (pp.28, 306). While promising, both governmentally-set standards and compulsory licenses involve non-contractual solutions to the holdout problem, which, as I discuss below, is not optimal.

The second licensing arrangement discussed in Van Overwalle's book is the clearinghouse model. Clearinghouses come in many shapes and sizes, some dealing primarily with efficient knowledge transfer while others are concerned with rights management and royalty collection. While the idea of facilitating access and knowledge through clearinghouses enjoys universal authorial support, the various authors acknowledge that the analogy between existing copyright clearinghouses and potential patent clearinghouses is inexact at best and undesirable at worst. For example, Esther Van Zimmeren concludes that the time is not ripe for patent royalty collection clearinghouses (pp.111-12). She reads the literature on copyright clearinghouses as demonstrating that while "collectivization" of rights and

enforcement may indeed increase the value of IP rights, it is unclear whether access is increased by such clearinghouses (pp.111-12). Michael Spence cautions that any analogy between established copyright clearinghouses and potential patent clearinghouses is inexact (pp.166-67). Spence concludes that patent royalty clearinghouses could lower transaction costs for genetic innovators, but may also increase royalty stacking and cost of access for consumers (p.167). For Spence, establishment of patent clearinghouses will not overcome the potential anticommons problems in the genetics industry and may exacerbate rather than remedy the access problem in diagnostics (pp.166-68).

The book suggests that open source models are a third licensing scheme that could be employed to improve access to diagnostics while maintaining incentives to innovate in the industry. Janet Hope proposes employing the open-source model that has transformed the software industry (p.192). However, other authors cast doubt on the applicability of software norms into the genetics industry conclusion. Arti Rai notes that the set of participants and economic realities in biotechnology is wholly different than that of software (p.217). Whereas the software industry involves numerous manufacturers and millions of users, the biotech industry has a smaller set of players and a targeted group of potential consumers. More importantly, there is little evidence that IP rights are strong drivers of creation in the software industry, whereas IP serves as the principal incentive to biotech companies (p.215). Thus, software designers are likely to be much more willing than their biotech counterparts to contribute to a public commons. Echoing Rai's suggestion that the high value of IP in the biotech industry may severely reduce the applicability of an open source model, Andrzej Kilian states that the only opportunity for using open-source in genetics will be "in an area of limited financial opportunity, where competition with mainstream companies would be less intense" (p.211). Wholly new business models would have to arise in order for biotech to embrace open-source, Van Overwalle concludes (p.431).

Van Overwalle concludes that licensing schemes meant to solve the patent thicket problem in upstream research (namely patent pools, clearinghouses, and open source models) are capable of achieving the goal of increasing access to diagnostic procedures (p.454). She is optimistic that pools, clearinghouses and open source can enable access despite widespread genetic patenting. Her conclusion, however, does not enjoy universal agreement from her contributors. The controversy surrounding the applicability of such regimes stems from their ability to attract actors interested in maximizing the value of their intellectual property. While

open-source models have been employed to increase access to intellectual property-protected goods in the software industry, the translation of open-source models to diagnostic testing appears to be limited to the small subset of cases in which profit motive is not the driving force behind research and development. Van Overwalle notes that numerous commentators are skeptical of open-source's feasibility in a for-profit genetics setting: "[I]t is questionable whether [the open source] model can stand the test in market segments aiming at the largest potential profit margins, such as the biomedicine sector" (pp.452). Obviously, this is a rather large problem. If open source is not an attractive alternative for profit-maximizing organizations, the ability of open source to overcome access problems in the medical diagnostics industry will be quite limited. Van Overwalle's optimism regarding the ability of licensing schemes to overcome research access problems also must be tempered by the reality that few authors can offer a licensing solution to the holdout problem. If valuable genetic patents are withheld from pooling or clearinghouse schemes, the effectiveness of those schemes in reducing transaction costs is likely to be greatly limited. Van Overwalle acknowledges this problem (pp.448) and suggests that "compulsory license schemes and informal norms of fair licensing" can be helpful in eliminating blocking patents. Of course, if reducing the access problems associated with genetic patents requires some form of compulsory licensing scheme or relies on the establishment of informal norms, then licensing models such as clearinghouses and patent pools are either unnecessary or inadequate to solve the problems associated with upstream research of diagnostic innovations.

To address the translational gap, the book deftly moves from the problem of patent thickets and blocking patents, to the problem of downstream commercialization. Oftentimes patents can stymie the translation of early-stage genetic inventions into medical applications because patents increase the transaction costs between upstream researchers (often-times academics or publically funded institutions) and downstream developers (typically private entities) (pp.392-93). This so-called "translational gap" is well-known in the pharmaceutical industry, but seems to be less prominent in the field of diagnostics (pp.246-57, 392-93), primarily because finding a link between a particular nucleic acid sequence and the ability to diagnose a disease does not involve the same enormous investment that creating marketable drugs entails.

In order to bridge the translational gap, the book examines various liability regimes. The most robust proposed solution to the translation gap comes from Arti Rai. Rai proposes a two-tiered public-private partnership in

which participants enter into contractual agreements to treat their discoveries under a liability regime rather than as property (p.247). Initial research would be conducted behind a "veil of ignorance" which would be breached only when promising collaborators had been identified. The attractiveness of Rai's proposal is that it increases knowledge sharing (assuming buy-in by a large number of players) and reduces transaction costs. Dan Burk builds on Rai's proposal, likening the regime to one of option trading (pp.294-306). Van Overwalle concludes that liability regimes are "rather limited in this area [diagnostics]" (p.454). She bases this conclusion on the practical difficulties that implementing any liability regime is bound to face. Her concern with the hurdles faced by a liability regime is, of course, correct. The implementation of a large-scale liability regime to encourage development of medical technology is destined to encounter practical problems: the devil is always in the details. However, as Rai's elaborate proposal demonstrates, there is common ground upon which profit-maximizing corporations and academic researchers can collaborate and which can result in increased diagnostic tools at reduced prices to consumers. Because Rai's liability regime is modeled on a world in which players are profit-maximizing, it would seem that such a regime would offer the best potential to create real-world change. Van Overwalle's practical objections aside, liability regimes provide a theoretical licensing solution to reduced commercialization of genetic discoveries.

At the end of the book, Van Overwalle writes a final piece to summarize and crystallize the various contributions of the authors. Her synthesis of the literature and the contributions is very nicely done and gives the book—which is truly an exploration of the future landscape—a feeling of finality. The book offers an important survey of different perspectives on what is certain to be a central issue in patent law going forward. Van Overwalle has done an excellent job in creating a compilation that offers diverse perspectives on the feasibility and desirability of translating successful licensing schemes from other industries (electronics, software, entertainment) to biotechnology. Anyone interested in the future of diagnostic and genetic patents—and the manner in which the social drawbacks of such patents might be mitigated—would be well-advised to examine the book.

ENDNOTES

[1] Ass'n for Molecular Pathology v. U.S.P.T.O, 702 F. Supp. 2d 181 (S.D.N.Y. 2010).

[2] Prometheus Labs., Inc. v. Mayo Collaborative Services, 2010 WL 5175124 (Fed. Cir. Dec. 17, 2010).

[3] New York Times, March 29, 2010, available at http://www.nytimes.com/2010/03/30/business/30gene.html; Jeffrey L. Furman, et. al, 468 Nature 757-78 (Dec. 9, 2010).

[4] See, e.g., Michael A. Heller, The Tragedy of the Anticommons: Property in the Transition from Marx to Markets, 111 Harvard L. R. 668 (1998).

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VIRTUAL JUSTICE: THE NEW LAWS OF ONLINE WORLDS, by Greg Lastowka. Yale University Press, 2010, 226 pp. Hardcover $27.50.

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Greg Lastowka's VIRTUAL JUSTICE is an introduction to the legal issues involving virtual worlds, examples of which include Blizzard Entertainment's World of Warcraft, Linden Lab's Second Life, and Disney's Club Penguin. Many of these virtual worlds are gaming worlds, though some, like Second Life, are better described as social worlds. Lastowka discusses several areas of law, focusing on issues of jurisdiction, contract, property, computer fraud (hacking), and copyright (with other areas of intellectual property law receiving only passing attention (p.194)). While in many ways the book is a survey of the field, threaded throughout the discussion are two related arguments, both made quite gently. The first is that it is meaningful to conceive of "virtual law" as a separate body of law. At present, virtual law is only "one corner of cyberlaw" (p.74), but Lastowka predicts it will and should become a distinct and recognized body of new law in the future (pp.11, 69). The second is that virtual law should be distinctive in large part by empowering customers against the "wizards" and the "online overlords" who own and control virtual worlds (pp.153, 195).

Lastowka defines virtual worlds as "persistent, interactive, simulated social places where users employ avatars" (p.31). For those who are not up to speed on virtual worlds, let alone the legal issues raised by them, the early chapters will fill in the gaps. While the lines between them are not rigid, Lastowka divides virtual worlds into three basic categories: (1) MMORPGs (Massively Multiplayer Online Role-Playing Games), (2) social worlds, and (3) kid worlds (p.58). MMORPGs like World of Warcraft are the game worlds (pp.59-61). Social worlds like Second Life are virtual worlds without the gaming elements. They are instead places to "hang out" (pp.61-

64). Kid worlds may be more like MMORPGs or more like social worlds, but either way, they are oriented towards children and feature heavy restrictions on what users can do and say (pp.64-66). In explaining the development of these modern virtual worlds, Lastowka reviews several areas of relevant history, including the ancient Greeks (Plato's *Cave*) and more contemporary novels, films, television shows, and non-electronic games (pp.29-38). For example, Dungeons & Dragons, probably more than any other game, provided important ideas for the features and content of early computer adventure games, and its influence remains evident to this day (pp.36-38, 59). The history of virtual worlds is of course in substantial part the history of computer and video games, and Lastowka covers the important developments here as well.[1]

Lastowka's first major point is the distinctive character of virtual law. Like aviation law, which became the subject of comprehensive legislation in the 1920s, he sees virtual law as also becoming a body of "new law" (pp.68-69). As someone who teaches a seminar on computer and video game law, it might be expected that I would be sympathetic to this argument, but I see this area of law as mostly about the nuances of established fields of law, such as intellectual property law and First Amendment law. A sensible law school course is not about examples of disputes that *happen* to involve video games (or horses), e.g., an employment discrimination dispute that involves a video game publisher, but it could be about legal questions where the presence of video games affects the legal analysis. For example, what features of a game constitute unprotectable procedures, processes, or systems under 17 U.S.C. 102(b)?[2] Are video games more like posters and coffee mugs or more like books and films for purposes of the right of publicity?[3] May the government restrict minors' access to violent video games because video games have negative effects attributable to video games' particular form of interactivity? Even if focusing on these questions does not "illuminate the entire law,"[4] they are substantial and worthwhile, but I don't think they define a truly separate area of law. Lastowka, however, finds more than just nuances in virtual law.

Virtual worlds often include gaming elements, and Lastowka views law and games as an uneasy mix, at least as the law exists now. He views games as separate jurisdictions from law, "jurisdictions of play" (p.105). Games are a "rival regime of social ordering" to law, and game rules are "inherently in tension with the rules of law" (p.105). "We desire laws," says Lastowka, "to be rationally designed to efficiently promote the common good" (p.108). Games are different. They are "strange, inefficient, and economically counterproductive" (p.137). The consequence is apparently to push the law

and virtual worlds apart and create both an opportunity and a need for new law to deal with the resulting "anarchic online frontier" (p.121).

This tension between law and games is, I think, overstated. We want law to further the common good and various social ends. One of these ends surely includes the individual enjoyment afforded by a recreational activity like gaming. As a related example, law presumably favors the (efficient) production of films desired by consumers. It would be odd if law was then hostile to consumers enjoying them, as if law favored only production and not consumption. Perhaps the enjoyment of games is somehow different than the enjoyment of films in terms of efficiency, but the apparent inefficiency of games is essential to their enjoyment. Lastowka quotes Bernard Suits' characterization of games as being "directed towards bringing about a specific state of affairs, using only means permitted by the rules, where the rules prohibit more efficient in favor of less efficient means" (p.109). But Lastowka omits the rest of this description: "the rules [of games] are accepted just because they make possible such activity."[5] The rules are essential to a game. While Lastowka concludes "play is . . . oriented toward a *process*, not a goal" (p.115), Suits points out the important relationship between rule-governed processes and goals: "Rules in games thus seem to be in some sense *inseparable* from ends, for to break a game rule is to render impossible the attainment of an end."[6] Assume a race around a circular track, an example used by both Suits and Lastowka (p.109). Would law, with its goal of efficiency, prefer that the contestants cut across the middle rather than run around the track? Lastowka apparently thinks so, but I don't see why.

While I do not think that there is an *inherent* tension between law and games, I agree with Lastowka that they can sometimes clash. Lastowka discusses the example of the Georgia Supreme Court's holding that the decisions of football referees cannot be challenged in court (p.109).[7] He suggests that "law may have difficulty balancing the competing interests" between law and games because game rules are "sub-optimal" (p.110), but the law's existing interest in efficiency and the common good seems a help rather than a hindrance. It supports allowing players to resolve their disputes through expert private referees rather than courts, at least when the disputes are of the conventional type for the relevant game. And despite the literal words of the Georgia Supreme Court—"courts of equity in this state are without authority to review decisions of football referees"[8]—there are undoubtedly limits. Referees cannot imprison or execute players as penalties, but there is much referees can do that courts can quite properly and quite confidently decline to second guess.

As a potentially more serious clash between law and games, Lastowka claims that courts have allowed at least some games, such as football, to "operate outside the boundaries of traditional social expectations" because at least some violence is permitted in football (p.113). Traditional social expectations, however, often countenance at least some violence. It all depends on the context. Russian roulette is out because the risks are so great and the benefits are so negligible.[9] Football offers greater benefits (in terms of competitive enjoyment and spectator entertainment), and it does so with much less risk than Russian roulette. The limited autonomy granted to football is not because games are a sort of oddity that law struggles to deal with, but because law recognizes this autonomy is necessary to preserve the legitimate social value of games.

To the extent law grants games limited autonomy, what do we make of situations where, for example, game rules allow one player to defraud another, especially in a virtual world containing virtual property with real world value? Lastowka quotes a commenter on a blog who rejects the notion that such activity should be a problem: "It would be like suing someone you lost to at poker" (p.121). This seems correct to me. Like bluffing in poker or outright lying in a game of Diplomacy, thievery could very well be a legitimate "play style." In Electronic Arts' Ultima Online, this is the clearly stated rule (p.13). Thievery is part of *playing* the game, not the basis for a complaint to Electronic Arts—or to a court.[10] Lastowka seems to have doubts about these types of rules, even when they are clear, but the more difficult problem he discusses involves situations where the rules of the game are ambiguous.

Ambiguous rules of conduct with real world monetary consequences can arise in any virtual world, including social worlds that lack traditional gaming elements and even in virtual worlds that prohibit the buying and selling of virtual items. Not surprisingly, there is extensive buying and selling of these items in violation of contract terms. Lastowka reports that Blizzard Entertainment has closed thousands of World of Warcraft accounts of players engaged in "gold farming," the harvesting of virtual money to sell to other players (pp.22-24). Sony Online closed the account of someone who supposedly made approximately $100,000 from selling virtual currency for Everquest II (p.159). In these situations, the gold farmers knew the risks of violating the contract terms. A loss from closed accounts, when it happens, does not seem inappropriate. Nor is it unfair to prohibit buying and selling in the first place. Virtual world owners need to control their

worlds to maintain the experience of players (p.140). Even insuring the scarcity of virtual items is necessary to maintain player interest (p.165).

But what if virtual property is legitimately bought and sold in a virtual world, and someone loses this investment for violating an ambiguous rule? Such problems are not completely novel. As a related example, courts have resolved ambiguous contest rules. In one case, the question was whether a player in a golf tournament managed to shoot a hole-in-one on the required hole to win an automobile; unfortunately, the required hole was ambiguously defined.[11] Virtual worlds magnify this type of interpretive problem. Games like poker have relatively simple rules compared to a virtual world. The software necessary to support a virtual world and regulate player conduct is extremely complicated. Glitches and bugs are common and are often discovered by players before the virtual world owners (pp.156-160). It can often be genuinely unclear whether a particular activity in a virtual world constitutes cheating and different players can legitimately have different expectations (pp.121, 145-46). Hard cases will likely result.

As an additional complication, virtual world users may expect owners to assist them against other users. Second Life's terms allowing users to retain their copyrights in uploaded content inevitably generates conflicts among users over copyright violations (pp.191-93). Users with disputes may demand the virtual world owner act. One class action lawsuit against Linden Lab was based on its alleged failure to act to protect user property (p.193). Users may instead sue each other, but virtual world owners may be dragged into these disputes as well (p.141). From the standpoint of virtual world owners, creative freedom for users combined with user ownership can "attract lawsuits from all directions" (p.193).

Virtual world owners—the "online overlords" (p.195)—recognize all of these problems and are likely to protect themselves with contract terms sometimes perceived (rightly or wrongly) as one-sided (pp.93-96). As a contributing cause of one-sided terms, Lastowka points to the problems of consumers not being able to freely negotiate terms with virtual world owners and often not reading the terms (p.91). While these are conventional concerns, I doubt the potential problem here has much to do with contracts of adhesion.[12] For most people, even most contracts professors, not needing to negotiate or even read most contracts is surely a blessing, not a curse. There may still be virtual world terms that the law should not enforce, and interesting questions will no doubt arise about whether one-sided terms in these contracts rise to the level of unconscionability, but like the questions

mentioned earlier, I see these issues as more likely representing the nuances of contract law rather than truly new law.

Lastowka's most aggressive suggestion for dealing with at least some of the legal problems of virtual worlds is to create "democratic and participatory structures," ones that would empower players by allowing them to more directly participate in the governance of virtual worlds. He doesn't detail how these should be created or argue for particular participatory structures, but he does briefly describe one experiment in virtual government in the relatively small virtual world of LambdaMOO (pp.40-41, 79-84). He describes the experiment, while it lasted, as "complicated, theatrical, contentious, and time-consuming" (p.82). Weighing against this innovation in other virtual worlds would be the desires of the players themselves. I assume Lastowka is correct when he predicts most players would not be interested in virtual legislatures or similar features in their virtual worlds (pp.89, 195).

With easy entry and exit into virtual worlds and extensive competition among them, I worry much less than Lastowka about the "anarchic online frontier," and I also doubt the future of virtual law becoming the distinctive field Lastowka envisions. I readily agree, however, that the legal questions raised by virtual worlds are interesting, substantive, and worthy of scholarly attention, and Lastowka's book provides an excellent introduction to them.

ENDNOTES

[1] Given the nature of the book, it is perhaps a justified quibble to note that Lastowka incorrectly refers to Ralph Baer as the inventor of Pong and the inventor of the patent covering table tennis, a patent that figured prominently in the legal history of the video game industry (p.37). Baer is certainly relevant to the general discussion as he is credited with the pioneer patent in the video game industry. See Magnavox Co. v. Chicago Dynamic Indus., Nos. 74-1030 and 74-2510, 1977 U.S. Dist. LEXIS 17996, at *2 (N.D. Ill. Jan. 10, 1997) ("[Baer's] '480 patent, I think, is the pioneer patent in this art[.]"). He is also relevant to the more specific history of Pong, but Baer credits William Rusch with the idea for the table tennis video game. See Ralph H. Baer, VIDEOGAMES: IN THE BEGINNING 45-47 (2005); Deposition of Ralph H. Baer, Midway Mfg. Co. v. Magnavox Co., No. 74-1657, at 11:28 (S.D.N.Y. Feb. 18, 1976) ("Q. Do you credit Mr. Rusch with having conceived the ping pong type game where one image appears to bounce off another? A. To the best of my recollection, that's how it was.").

Rusch is also the inventor listed on the relevant patent. See U.S. Patent No. RE28,507 ("Television Gaming Apparatus"). As Baer notes in his own history of video games, it was Rusch's patent that was the critical one for determining infringement during the many years of litigation. Baer, supra note 1, at 126. See also Magnavox Co. v. Mattel, Inc., No. 80-4124, 1982 U.S. Dist. LEXIS 13773, at *96 (N.D. Ill. July 29, 1982) (finding infringement of the '507 patent); Magnavox Co. v. Chicago Dynamic Indus., Nos. 74-1030 and 74-2510, 1977 U.S. Dist. LEXIS 17996, at *16-17 (N.D. Ill. Jan. 10, 1997) (same).

[2] See, e.g., Atari Games Corp. v. Oman, 979 F.2d 242, 245-46 (D.C. Cir. 1992) (suggesting that the game play mechanics for the movement of video game playing pieces are subject to copyright protection); Midway Mfg. Co. v. Artic Int'l, 704 F.2d 1009, 1013-1014 (7th Cir. 1983) (holding that an unlicensed device that speeds up the rate of play of a video game violated the exclusive rights of the copyright owner to produce derivative works).

[3] See, e.g., J. Thomas McCarthy, 2 RIGHTS OF PUBLICITY AND PRIVACY § 7:26 (2d ed. 2010); Restatement (3d) of Unfair Competition, § 47 cmts. b and c.

[4] Frank H. Easterbrook, Cyberspace and the Law of the Horse, 1996 U. Chi. Legal. F. 207, 207 (1996). See also Lawrence Lessig, The Law of the Horse: What Cyberlaw Might Teach, 113 Harv. L. Rev. 501, 502 (1999) ("I agree that our aim should be courses that 'illuminate the entire law[.]'").

[5] Bernard Suits, THE GRASSHOPPER: GAMES, LIFE AND UTOPIA 48-49 (Broadview 2005). Lastowka cites page 34 for this quotation.

[6] Id. at 39 (emphasis added).

[7] See Georgia High School Assoc. v. Waddell, 285 S.E.2d 7, 9 (Ga. 1981).

[8] Id.

[9] See, e.g., Neitzel v. State, 655 P.2d 325, 337-38 (Alaska Ct. App. 1982) ("[A] participant has a 16.7% chance of being killed or seriously injured and an 83.3% chance of not being killed or seriously injured in a game of Russian Roulette each time he puts the gun to his temple and pulls the trigger. The act is so dangerous and so lacking in social utility, however,

that it demonstrates extreme indifference to human life and serves to distinguish murder from manslaughter.").

[10] The policy states, "[A]nything considered a valid play style in Ultima Online is not considered harassment. In other words, *player killing and thievery, including res-killing, is not considered harassment*. By valid, we mean that there are game mechanics created around these play styles in Felucca, such as stat loss, the thieving skill, bounty systems, murder counts, the existence of guards, etc. Ultima Online is a role-playing game that encourages various play styles, and players should seek ways of protecting themselves against these play styles through game mechanics rather than calling on customer support staff for help in these cases." Ultima Online Harassment Policy, available at http://support.uo.com/harass.html (emphasis in original).

[11] See, e.g., Grove v. Charbonneau Buick-Pontiac, Inc., 240 N.W.2d 853, 856 (N.D. 1976) ("The offer made by Charbonneau Buick stated that a 1974 Pontiac Catalina would be awarded to the 'first entry who shoots a hole-in-one on Hole No. 8.'").

[12] See generally Douglas G. Baird, The Boilerplate Puzzle, 104 Mich. L. Rev. 933 (2006).

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The IP Law Book Review

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THE SOUL OF CREATIVITY: FORGING A MORAL RIGHTS LAW FOR THE UNITED STATES, by Roberta Rosenthal Kwall. Stanford University Press, 2010, 247 pp. Cloth $22.45.

Reviewed by Shubha Ghosh, University of Wisconsin Law School. ghosh7@wisc.edu.

Professor Roberta Kwall's book brings together a wealth of academic literature and case law analysis to make the argument for a more fully developed and rounded moral rights regime in the United States. For those readers unfamiliar with the debate within copyright law, a moral rights regime is a system of legal rights and duties that protects the rights of an author of a work from the distortion, misattribution, or unauthorized or unfavorable publication of the work. Continental Europe originated such a system in the Nineteenth Century. The theoretical underpinnings are in the work of Immanuel Kant on the relationship between the private and public spheres and the need for protecting the dignity interests of individuals who publicize their private thoughts. Moral rights developed on the European continent through the efforts of Victor Hugo as a means to protect the interests of authors against publishers. A moral rights regime recognizes an inalienable right in the dignity of authors against publishers who would treat authorial works as mere commodities to be altered, distributed, and commercialized as the market demanded.

Professor Kwall offers an original argument in support of legal reform in the United States that would recognize the moral rights of authors. Her argument begins with a recognition of the creative urge in individual authors (pp.11-12). This creative urge, grounded in spirituality, imbues works of authorship with a meaning and message (pp.20-21). Professor Kwall argues that a moral rights regime is needed to protect this meaning and message from misattribution and from adaptations and uses that compromise the integrity of the work (pp.21-22). With this aim in mind, Professor Kwall explores how moral rights are consistent with the public domain (pp.66-67), with separating the rights of employer and employees in

copyrighted works (pp 100-101), with protecting the artistic persona more effectively than traditional right of publicity doctrines (pp.129-131), and with recognizing international human rights treaties (pp.143-44). She concludes with a reform proposal for recognizing a right of attribution and a limited right of integrity in the Copyright Act (pp.148-150).

As Professor Kwall reminds us, United States Copyright law has long eschewed such subtleties and treated copyrighted work as an ordinary commodity subject to utilitarian-based legal regulation (pp.42-43). This arrangement suited the United States fine until the country had to recognize some form of moral rights in order, in the late 1980's, to be able to sign onto the Berne Convention, a multilateral treaty governing global copyrights. Professor Kwall's case for moral rights, needless to say, is not based on such expediency. Her goal is to develop a rich theoretical justification for a moral rights regime and a legislative proposal for implementing moral rights within existing copyright law. Her broader goal is to break free of the utilitarian constraints on United States copyright law in order to recognize greater legal protections for creators and the creative persona (which may or may not be distinct depending on how one reads the argument). The book is provocative and a seminal academic work on the topic of moral rights. But for those mindful of intellectual property policy, I would be very cautious in moving its ideas out of the academic realm and into that of concrete policy, for reasons I develop below.

At a very basic level, Professor Kwall is making the case for non-economic rights in copyright law. She begins the book with a discussion of how U.S. copyright law does not protect authorial integrity or attribution. For example, if I publish a work but put the name of the wrong author on the work, I have not violated copyright law. Similarly, if I destroy the work or physically mutilate the work, I also have not violated copyright. In some circumstances, the author can obtain a remedy for the economic harm created by these acts through tort remedies, such as defamation or conversion. But federal copyright law offers no or limited redress. What is troubling for Professor Kwall is copyright law's silence as to the noneconomic harm created in these two examples, specifically the harms to the authorial personality and the creative vision imbued by the author. The work is an extension of the author, and the distortion and destruction of the work inure to the author. A system of economic rights misses this point entirely.

What is original about Professor Kwall's argument is her grounding of these non-economic interests in a more sophisticated understanding of the

motivations of individual creators. Utilitarian foundations for copyright, Professor Kwall implies, are based on material gain as the sole, or primary, motivation for creation. Psychology and religion prove otherwise. It would not be a distortion of Professor Kwall's argument to say that she sees the roots of creativity as spiritual, whether understood in emotional or theological terms. This argument is developed in the second chapter of her book and is the basis for the rest of her argument, which consists of identifying how U.S. copyright law is out of step with the legal regimes of other countries. I would argue that her case for understanding the motivations for creativity is the keystone for her book. Starting from that premise, I will make it the primary focus of the rest of this review. Does Professor Kwall have it right about what motivates creativity and, if so, do her critique and policy recommendations follow?

Professor Kwall isolates two distinct types of motivation for creativity, non-economic and spiritual. Although they can be confused, they are different. Non-economic motivation is based on something other than the calculation of the return or reward of creating a new work. An artist may create spontaneously or on a whim. The work may be a labor of love, resulting from much sacrifice and both emotional and physical pain. Nonetheless, the creator continues to produce the work purely for the sake of creating. Spiritual motivation may also involve such sacrifice and may, from a cost-benefit perspective, not be worth it. But a creator driven by spritual motivation gains something: a spiritual reward, the ecstasy of spiritual release, the satisfaction of serving one's muse. One can go so far as to say that spiritual motivation may include the love of lucre, the reward that comes from material success is a sign of divine election. Adam Smith's infrequent use of the term "invisible hand" in *The Wealth of Nations* was meant ironically, a jab at those who viewed wealth as the result of invisible forces as opposed to the hard work and energies of the mercantile class and workers. A case could be made that the wealth of nations derives from non-economic motivation, individuals acting in their narrow interest to work and provide labor independent of any direct reward from that labor.

Motivations for any act are complex. Do we write law review articles for monetary reward? Spiritual ones? Purely personal ones? I imagine all of these motives are true. An acquaintance who is an English professor asked why I cared so deeply about a specific author and his novels. From his perspective, a new novel from the particular author meant more things to write articles about and the greater prospect for a raise. The time I spend reading, thinking, and writing on the same novel goes seemingly unrewarded. Is this an investment in some yet-to-be seen reward, a frolic, a

source of spiritual satisfaction? Depending on how one looks at my acts, and when, my motivation can be construed to be any one of these. Because of the inherent ambiguity of motivations, they generally do not serve as a compelling linchpin for policy and legal doctrine. They may be a factor to consider in some cases, for example in discerning mens rea. But too much should not be made of them.

Yet motivations are critical to Professor Kwall's argument, and they are critical in any incentive-based justification for intellectual property rights. I am not a big fan of incentive-based theories, largely for the same reasons that I am skeptical about the concept of motivation. Nonetheless, I may be in a minority on this point, and the dominant rhetoric to justify intellectual property rights is some variation of an incentive-based theory. The problem is that even within incentive-based theories, Professor Kwall's proposal for a moral rights regime in the United States seems flawed for several reasons.

First, if one accepts the proposition that motivations are mixed, it is not clear why protection for economic motivations would not be adequate for protecting non-economic and spiritual ones. Other areas of law also cover multiple types of injuries without providing redress for all harms. Contract breach can result in emotional injury for which contract law offers little remedy. Tort law distinguishes between recoveries for physical injuries, emotional injuries, and economic injuries and carefully circumscribes what can be recovered for the latter two categories and has limits on the first one as well. These choices may reflect ideology or conceptual biases towards quantification. But more assuredly, they reflect practical choices about what the legal system is capable of doing. Professor Kwall is less convincing about why a focus solely on economic motivations in intellectual property is inadequate for what the legal system can deliver.

Second, even if Professor Kwall responds to the last objection on deontological grounds, that we need to protect noneconomic motivations because it is the right thing to do, she would still need to distinguish between noneconomic and spiritual motivations. If creators would produce even without the economic reward of copyright, what then should be the basis for remedy? It does not necessarily follow that a creator with such noneconomic motivation would care about correct attribution or integrity either. My guess is that much of the content on YouTube is spontaneous creation, people who happen to have a recording device at the right time and in the right place. Much is also staged creation by people who act on a whim with what seemed at the time to be a funny idea. Would misattribution or distortion of the sort Professor Kwall espouses be of

concern to such creators? I am skeptical. I am confident, however, if such spontaneous or whimsical creation became iconic or economically valuable (think, for example, of the Zapruder film of President Kennedy's assassination), the creators would pursue those interests zealously. What is labeled noneconomic motivation masks this implicit lottery.

However, Professor Kwall's case becomes stronger for creators who are driven by spiritual motivations. For such creators, the injury that occurs from a misattribution or a distortion cannot be readily quantified or even translated into the calculus of legal claims protecting against defamation or conversion. On this point, Professor Kwall stands on stronger grounds. Skeptics may harp on the abstruseness and lack of clarity in protecting "spiritual interests." But let me be the first to defend Professor Kwall's identification of spiritual motivations. The defense has little to do with one's theological beliefs. Rather, I am willing to accept and argue in the defense of the existence of psychological factors that are associated with creation. Perhaps they can be reduced to brain chemistry, the equivalent of a runner's high. Furthermore, these motivations do not fall neatly into dichotomies such as religion versus science. Darwin's *On the Origin of Species* ends with a long paragraph describing the invisible, incremental forces that lead to the development of speciation and the spread of life on the planet. To call it spiritual may belie the materialistic theory that he was espousing. But when compared with the literalism, the fixation on the Biblical text, that his critics, then and now, essentially extoll, Darwin's view should be understood as spiritual. Aestheticians, like Edmund Burke, would call the feeling sublime. It is perhaps the feeling some of you may have had upon first seeing a natural wonder—Mt. Shasta, the Himalayas, the Grand Canyon—a feeling that is stirred and amazingly inspired by a hunk of rocks. Professor Kwall is correct in identifying this emotion, and I have no doubt that it plays an important role in creation, both artistic and scientific.

The problem is identifying precisely the implications the existence of spiritual motivations has for law. John Muir, Rachel Carson, Ansel Adams individually and collectively identified the sublime in the natural world. Such feelings stirred the environmental movement which in turn helped to shape environmental law. But it would be a leap to say that environmental law somehow protects these spiritual feelings, even if they were an inspiration for the law. The problem of contingent valuation illustrates the problem of how to incorporate these values into a measure of recoverable damages. Once again practicality limits how much the sublime can shape the law.

It is true that within a purely incentive theory of intellectual property, spiritual motivations do not necessarily lead to the protections for attribution and integrity that Professor Kwall is advocating. The problem, however, is that her recognition of spiritual motivations is too underinclusive. Much labor arguably involves spiritual motivation. The notion of craft, for example, is in part a spiritual one. But copyright law, like all intellectual property law, makes distinctions among different types of work, in part for practical reasons, in part because the incentive theory cannot fully explain the structure of intellectual property law. Why is the integrity of the creator more needing of protection than other providers of labor and service in society? Dignity should have more of a role in the structure of the legal system than it does, but I feel hard pressed to conclude that it should take the form that Professor Kwall prescribes.

Admittedly, Professor Kwall's case is limited to recognizing dignity-based claims in copyright law and so the previous critique may be deemed as misguided. But even within the parameters of copyright law, Professor Kwall's appeal to spiritual motivations is underinclusive. If the laying of paint on canvas, the putting of words on paper, the snap of a photograph, each has a spiritual component, then so do the viewing and reading of objects. The notion of the sublime applies equally, and perhaps more forcefully, to the audience for a work. Music has charms to sooth the savage breast, and that spiritual soothing, within the terms of Professor Kwall's argument, deserves recognition within intellectual property law. Once one also recognizes that spirituality is as much a collective experience, as an individual one, Professor Kwall's claims return us to the central questions that inform intellectual property policy. Is IP law about individual reward or access? Are the terms of IP individual or collective? Is IP policy about individual ownership or commons management? Professor Kwall's identification of spiritual motives in creation does not clarify these questions and merely adds to the ongoing debate over the structure and purpose of intellectual property.

Underlying Professor Kwall's arguments is an appeal to stewardship in intellectual property (pp.18-19). Unfortunately, this concept is not well developed in the book, except for a brief discussion in the context of copyright duration (p.58). The concept of stewardship certainly is connected to notions of spirituality and the sublime in intellectual property as it is in environmental law. To view intellectual property in terms of stewardship is to recognize that creativity is beyond the scope of finitely lived individual authors and the needs of the current generation. The

problem is how to channel the notion of stewardship into concrete legal reform. In Professor Kwall's book, the concept of stewardship is raised and then dropped as the author takes the concept of spirituality to support the rights of attribution and integrity. But in taking such a narrow focus, the author ignores how the concept of stewardship would apply to all users and creators within the intellectual property system. The reform proposals assume intellectual property rights are individual and not within a broader communal system. As a result, the argument replicates some of the criticisms of intellectual property and belies the appeal to stewardship that was an enticing start to the book.

The individualistic focus of Professor Kwall's argument is ironic in light of the origins of the moral rights tradition in copyright. Immanuel Kant's conception of the moral rights system recognized an intimate connection between the public and private realms. Creators would retreat to private domains to develop their ideas and their work which in turn would be disseminated in the public realm. Distortions of the work in the public realm would affect what creators did in the private realm by either influencing creators to retreat permanently from the public or to refrain from creating altogether. This vision of private and public realms in tandem informs much of contemporary intellectual property law, as can be seen in discussions of secrecy, branding, and privacy in the fair use context. Needless to say and perhaps not surprising, Kant had a very monastic view of creation. In the modern world, the public and private are not distinct realms and overlap in the creation and dissemination of creative works. Professor Kwall's defense of moral rights strikes me as a retreat from the public-private remix we inhabit today to an individualistic notion of creativity. This point may be most apparent in her discussion of joint authorship and the claim that one co-author may have a claim against distortions of the work by other co-authors (pp.100-101). I was left wondering why this veto power is justified and what about the role of user generated creation and remix more broadly. Arguably, it takes a village to make a work or to shape an individual soul, even one driven to create.

Grounding moral rights law in spiritual foundations ignores the practical politics that drove the development of what we call the moral rights tradition. As a protection for the dignity of authors and artists, moral rights was a means of protection against publishers, whose focus was solely on the commercial potential for a work, ignoring the vision of the creator. The famous case of *Gilliam v. American Broadcasting Companies, Inc.*[1] is an example of this tension. The broadcast company, as publisher, distorted the work of the Monty Python troupe as it was first being introduced to the U.S.

audience. The court fashioned a remedy based on contract law and trademark law, that was, as Professor Kwall points out, unsatisfactory as a policy matter (pp.32-33). But the court's solution illustrated the height of pragmatism in protecting the interests of the authors against the acts of the publishers. The U.S. statutory attempt at moral rights through the Visual Artists Rights Act (VARA) completely ignores the roots of moral rights in limiting the rights of publishers. The published cases interpreting VARA illustrate a tension the Act creates between artists and users, specifically municipalities or museums as surrogates for users.

Although I find much of value in her book, I am concerned that Professor Kwall's reform proposal might also create further tension between artists and users, ignoring the purpose of moral rights law as protection against publishers. The source of this tension is in identifying creativity as a personal, spiritual experience which ignores the social context of both creativity and spirituality. It is too limiting to view religion as purely a personal matter. Religion and spirituality are not only about personal salvation or personal expression. Instead, religion and spirituality see personal salvation as part of building community norms and values, which would include in the copyright context values of access. Perhaps Professor Kwall does not pay enough attention to these communitarian values. But her book may pave the path for a broader, more inclusive notion of intellectual property.

ENDNOTES

[1] Gilliam v. American Broadcasting Co., Inc., 538 F.2d 14 (2d Cir. 1976).

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INHERENT VICE: BOOTLEG HISTORIES OF VIDEOTAPE AND COPYRIGHT by Lucas Hilderbrand. Duke University Press, 2009, 320 pp. Paper $24.95.

Reviewed by Marc H. Greenberg, Golden Gate University School of Law. mgreenberg@ggu.edu.

Over the past few decades, legal scholars have recognized the merit of focusing scholarly efforts on the role law plays in its interaction with other areas of academic and practical disciplines. Cross-disciplinary efforts that focus on law and society, law and economics, law and science and related areas have become the norm. Lucas Hilderbrand's 2009 book, INHERENT VICE: BOOTLEG HISTORIES OF VIDEOTAPE AND COPYRIGHT is a fascinating contribution to this cross- disciplinary oeuvre. Hilderbrand is an Assistant Professor of Film and Media Studies at the University of California, Irvine. Although not a lawyer or legal academic, he has consulted with attorneys and law professors in his endeavor to understand and offer commentary on the role copyright law played in the relatively short-lived history of videotape and videotape recorders.

The book is presented in two parts. The first part begins with a thirty-page introduction entitled *The Aesthetics of Access*, in which Hilderbrand introduces the array of agendas which inform the book, ranging from offering a validation of video via an aesthetic reading of its history and impact, to the presentation of an argument that copyright law includes users' rights of access in addition to creators' rights.

In his Introduction, Hilderbrand explains that the title, INHERENT VICE is derived from a phrase librarians use to describe the effect the acidity of chemically processed wood-pulp paper has on book pages—this is what turns the pages brown and brittle with age. Turning to video, he asserts that it has two inherent vices: its degenerative properties (known to anyone who now tries to play back videos recorded more than ten years ago—sound quality and picture deteriorate pretty quickly), and its role as a "bootleg

technology" created "for the purpose of recording television without permission" (p.6).

This characterization of video recorders as outlaw tech seems a bit of a romanticized stretch. Home audio taping was already the norm by the time video recorders were introduced to consumers, and no television networks brought suit against video recorder companies for unauthorized taping of shows. It was only motion picture companies, worried that home taping of uninterrupted cable broadcasts of their feature films would cut into the pre-recorded tape market, which led to Universal filing its action against Sony's Betamax recorder.

Hilderbrand continues this discussion with two assertions that are at the core of INHERENT VICE. I found both of these assertions troubling and largely unsupported. First, he asserts that "[i]t was imagined that video could become a medium for the people and a viable alternative to broadcast networks programming", and that "[A]udience access suggests a partial reorientation of power" (p.8). Hilderbrand doesn't explain who, if not the audience, does hold the power in this context. The issue is by no means a simple one. The television industry, particularly today, isn't dominated by a single source or group—artists, distribution companies, networks, cable distribution companies, and others share power in an uneasy union. To the extent Hilderbrand is arguing that the creation and presentation of art by artists places them in a power relationship with their audience, I am a bit dubious of this claim—the struggle most artists encounter in finding ways to get their work noticed, distributed and to make a living from their art suggests very little power resides in their hands.

The second assertion is that bootlegging, a concept generally defined as the unauthorized recording and distribution of audio tapes and performances, should be re-defined as a "[f]air use of video technologies"; a use Hilderbrand praises, saying: "Fair use bootlegging can be a beautiful thing" (p.23). He goes on to distinguish his conception of bootlegging from piracy, thusly: "Pirates steal for profit, not for the egalitarian or productive redistribution of culture and information". *Id.* He justifies the theft involved in this "redistribution" by noting that despite "[w]hining about piracy, the technology manufacturers and studios still reap enormous revenues and will surely find new business models to continue doing so." *Id.*

The distinction Hilderbrand offers between bootlegging and piracy, that the former is done with good intentions and for the benefit of the community, whereas the latter remains theft that should be punishable by law seems to

suggest that civil remedies for infringement should be eliminated or at least greatly narrowed. In essence he seems to be championing a sort of Robin Hood approach to copyright—that it is indeed acceptable to rob the rich for the benefit of the poor—a particularly difficult policy to apply in reality, given the difficulty of defining who fits in each category—human endeavor is a bit too fluid to pin down so easily.

The Introduction is followed in the first part by a detailed analysis of the history of video, entitled *Be Kind, Rewind: The Histories and Erotics of Home Video* (pp.33-72). In this chapter, Hilderbrand takes the reader back to the rise of video in the 1970's, chronicling the rapid spread of this groundbreaking technology throughout the world, and its unique qualities as a means of not only playing back pre-recorded videos (which actually came later in the history), but also as a way for people to record and distribute their own videos, and amateur versions, both copies and derivative works, of pre-existing copyright protected audiovisual works. In support of his bootlegging thesis from the Introduction, he notes that adult film entrepreneur David Friedman asserted that "the home video market was 'founded by pirates and pornographers'" [1] (p.34).

In the second chapter of part one of INHERENT VICE, Hilderbrand offers his analysis of how the law, and in particular copyright law, responded to video recorders and videocassette uses. This chapter, entitled *The Fairest of Them All? Home Video, Copyright, and Fair Use*, starts with a description of copyright law and fair use, followed by an analysis of *Sony v. Universal*[2], the seminal U.S. Supreme Court decision applying fair use doctrine to videotape technology, a case which has become known by the name of the first video recorder, the Sony Betamax, ie: the "Betamax Case" (pp.77-114).

In this section of the book Hilderbrand aligns himself with the views of Prof. Lawrence Lessig and the "copyleft" movement. Hilderbrand presents the argument that contemporary copyright has become a tool of corporate interests to suppress free expression, noting:

> The considerable liberty for users in the early, anonymous, and unregulated days of home video, the Internet, and even YouTube has repeatedly given way to more constrained, corporatized, and consumptive uses.
>
> …

> As Lessig argues, in the digital media age, the content, the distribution, and the hardware are typically all owned or controlled by corporations with vested interests in regulating them.
>
> …
>
> But copyright law, in particular, has increasingly served the interests of big media at the expense of audiences and, to a certain extent, creators[3] (pp.78-79).

Hilderbrand supports the argument that this "corporatizing" of copyright is a movement away from copyright's fundamental grant, which he asserts was targeted not only to protect creators, but also those who view and engage with their works:

> Copyright works through a bargain: artists and publishers are granted protection to commercially exploit their works in exchange for making them publicly accessible. This means that copyright is intended to serve the interests of the audience as much as it rewards publishers, distributors, writers, filmmakers, musicians and artists….L. Roy Patterson and Stanley W. Lindberg argue that users' interests in copyright law are as important as those of authors and entrepreneurs, yet because users' rights of access are implicit, they are often forgotten[4] (p.80).

The argument that copyright law confers rights on users as well as creators is subject to criticism on several fronts: first, if this right exists, it must be implied from conduct, since nothing in Article 1, Section 8 of the Constitution expressly provides for it; second, since copyright rights exist and, under the 1976 Act, are vested, once a work is placed in a tangible form, publication is no longer required before rights exist—so artists are granted protection even if they never publish their works; and lastly, the argument that users have equal rights under copyright law has only come to the forefront of the debate as a result of the ease of copying and distribution the digital age affords users—no one claimed to have an inherent right to make copies of published books and distribute them without penalty until it became easily possible to do so online.

The position that copyright has, particularly through the terms of the Digital Millennium Copyright Act and the "opt-out" nature of the 1976 Act, aided in the "corporatizing" of creative works, has been cogently presented by Professors Lessig, Neil Netanel, Edwin Baker, Yochai Benkler, Jed Rubenfield[5], and many others. Yet these arguments are not unanimously accepted among copyright scholars. In my article, *Reason or Madness: A*

Defense of Copyright's Growing Pains[6], I note that articles by Professors Paul Schwartz & William Treanor, Kevin Galbraith and Julia Mahoney[7], as well as my work, offer a very different view. The explosive growth of creative, expressive works from millions of voices given new-found access in the digital age, offers a contrary view to the concern that expression is being suppressed by corporate giants. The global nature of this expressive explosion is also often overlooked by copyright's critics, whose focus often overlooks creative works in Asia, Africa, South America and the rest of the world.

Unfortunately, Mr. Hilderbrand does not devote, to any significant degree, any part of his critique of copyright to explore the other side, the pro-creators side, of this debate. Had he done so, the contribution INHERENT VICE offers in this debate might have been more balanced, and might have offered recognition of the nuanced nature of this issue.

A final note on this chapter dealing with law and video: Hilderbrand is critical of the DMCA, arguing that in its desire to protect the nascent Internet market, it went overboard in its pro-business orientation. He concludes as follows:

> Policies with a goal of starting up the Internet should have taken the form of short-term funding initiatives or regulatory guidelines rather than a permanent addition to copyright law; with the goal of establishing Internet commerce by and large achieved, the law is overdue for reevaluation—a reconsideration that the Supreme Court has yet to undertake (p.103).

This struck me as an odd proposal. It is not the Supreme Court's role to undertake a reevaluation of law—that is the province of Congress. Reevaluation of the DMCA has been on ongoing project of a number of congressional committees, a process complicated by the need to try to find new approaches that reasonably accommodate the often conflicting needs of a wide array of stakeholders.

The second part of INHERENT VICE offers readers three case studies: the conflict between the Vanderbilt Television News Archive and CBS over whether copyright protected television news broadcasts; the fascinating history of filmmaker Todd Haynes' 1987 satire of the sad story of pop singer Karen Carpenter, entitled *Superstar: The Karen Carpenter Story*, told using Barbie-style dolls, and chronicling the rise of the Carpenters as a pop group, and the decline and ultimate death of Karen Carpenter due to

complications stemming from her anorexia; and the use of video chain letters as a network in the riot grrrl feminist community (pp.117-224).

These case studies are offered to show the benefits bootlegging activity offers to these different communities, despite their being infringing copies and/or derivative works. The author views this activity as the kind of benign infringement the law should be able to discern and allow.

Scattered throughout the book are what the author calls *Video Clips*; these are short (4-6 pages) profiles depicting ways in which video had, and continues to have, cultural impact. One Clip focuses on video retailing, and how unauthorized duplication tapes, or "dubs" proliferate in the retail context, another features videos sold at genre expos, yet another explains the work of the Frameworks listserv, an e-mail discussion group about underground film, and the last clip offers a discussion about artists who use the deterioration of video over time to create artwork based on the distortion and deterioration of the media.

While I found the case studies and video clips to be interesting reading, particularly the discussion of the *Superstar* video, my sense is that if, after reading part one of the book, you have accepted the author's view of the importance and value to the "commons" of what he defines as bootlegging, then you will see the case studies and video clips as valuable anecdotal support of that thesis. Viewed independently, however, they don't offer sufficient support of his viewpoint given their fairly narrow focus.

Hilderbrand concludes the book with an Epilogue entitled: *YouTube: Where Cultural Memory and Copyright Converge*. His focus here is on the controversial practice of YouTube users uploading unauthorized video clips. He praises the impact this practice has in a variety of contexts. He posits that it is a form of community archive, while acknowledging that the lack of organization and completeness of it precludes considering it to be a true and formal archive that academics could use. He opines that the situation in which the same unauthorized clip is uploaded with added content, or in a parody form, results in "[b]lurring distinctions between authorship, ownership and distributing rights", suggesting that "[t]hese postings reflect the ethics of the cultural (and creative) commons" (p.240). This view is a restatement of his view about video—unauthorized non-profit use of others' content is a "productive redistribution" which should not be penalized. Current case law is split on this issue—a series of cases allowing unauthorized copying if the work is "transformative" have recently been followed by other cases (the Harry Potter codex case is an example)

finding that the changes to a work aren't transformative enough to escape copyright infringement liability. Historically, these kind of pendulum swings ultimately result in compromise approaches that adopt a middle-ground position – the next few years of case decisions may move us to that firmer ground.

One benefit of INHERENT VICE is that it gets you thinking about the uses of video in the past, and the extent and manner in which they are replicated today. For example, unlike the video recorders of the past, DVD players generally don't have recording capability, and the market for blank DVDs is not based on their use in these players. Does this mean that consumers no longer are interested in creating their own content? No, what has happened instead is that consumers have found a far more robust set of tools for creating video content—their computers and even more frequently, video cameras embedded in smart phones and related mobile devices. The ability to create visual mash-ups and add a sophisticated array of audio and visual effects far outstrips the capabilities available to consumers 30 years ago.

In sum, INHERENT VICE, with its blend of history and legal analysis, helps place video and videotape recorders in their rightful place in the history of copyright in the U.S. and provides food for thought and continued debate over the role of copyright in the digital revolution. It is an interesting read for scholars of law and culture.

ENDNOTES

[1] Citing Bob Davis, X-Rated Video Losing Share of Tape Sales, Wall Street Journal, January 18, 1984 at 33.

[2] Sony Corp. of Amer. v. Universal City Studios, Inc., 464 U.S. 417 (1984).

[3] Citing Lawrence Lessig, THE FUTURE OF IDEAS: THE FATE OF THE COMMONS IN A CONNECTED WORLD (2002) at 23-25, and generally Lawrence Lessig, CODE: VERSION 2.0 (2006).

[4] Citing generally to L. Roy Patterson & Stanley W. Lindberg, THE NATURE OF COPYRIGHT: A LAW OF USERS' RIGHTS (1991).

[5] See, e.g., Neil Weinstock Netanel, Locating Copyright Within the First Amendment, 54 Stan. L. Rev. 1 (2001); C. Edwin Baker, First Amendment Limits on Copyright, 55 Vand. L. Rev. 891 (2002); Yochai Benkler, Free as the Air to Common Use: First Amendment Constraints on Enclosure of the

Public Domain, 74 N.Y.U.L.Rev. 354 (1999); and Jed Rubenfield, The Freedom of Imagination: Copyright's Constitutionality, 112 Yale L.J. 1 (2002).

[6] Marc Greenberg, Reason or Madness: A Defense of Copyright's Growing Pains, 7 The John Marshall Rev. of Intell.Prop. Law 1 (2007).

[7] See, e.g., Paul M. Schwartz and William M. Treanor, Eldred and Lochner: Copyright Term Extension and Intellectual Property as Constitutional Property, 112 Yale L.J. 2331-2332 (2003); Kevin D. Galbraith, Note, Forever On the Installment Plan? An Examination of the Constitutional History of the Copyright Clause and Whether the Copyright Term Extension Act of 1998 Squares with the Founders' Intent,12 Fordham Intell. Prop. Media& Ent. L. J. 1119 (2002); Julia D. Mahoney, Book Review, Lawrence Lessig's Dystopian Vision, 90 Va. L. Rev. 2305 (2004).

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The IP Law Book Review

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BEYOND INTELLECTUAL PROPERTY: MATCHING INFORMATION PROTECTION TO INNOVATION, by William Kingston. Edward Elgar, 2010, 256 pp. Hardcover $115.00.

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William Kingston frames this book around a clearly stated premise: the focus of information protection regimes has shifted from benefiting the public to benefiting private individuals with interests in the game—and this shift is not good. Early on, protection of information was shaped by actors with no personal stake but rather a desire to encourage invention and innovation for the public good. These actors were primarily limited by constitutional provisions and bureaucratic inefficiencies. As time went on, and as information became a more important commodity, information protection schemes were fashioned, or perhaps twisted, by the parties that would derive the most benefit. Stakeholder driven systems are unlikely to be able and willing to adapt to changing technology and innovation. The transition from public interests to individual interests, Kingston claims, has resulted in a "dysfunctional system" in need of "rescue" (p.125). Public good must be the heart of any reform to information protection, and Kingston concludes by offering a set of proposals to that end (pp.136-37).

The book proceeds in two parts: First, the book explains the transition of information protection regimes from focusing on protecting the public interest to benefiting private interests. Second, the book presents a number of reforms that would return the balance of information protection to the public good (p.*vii*). He treats the first goal in roughly the first half of the book. Perhaps because of my familiarity with intellectual property, law, and information protection, I found the first half of the book to be less relevant. One intended audience for the book, as stated on its back cover, includes "students of IP and innovation [and] patent agents and attorneys." I imagine these groups would react much as I did to the first half of the book. To be fair, throughout this first half, there are a number of interesting

historical nuggets buried, even where the topic being described was old hat. Another intended audience, "economic policy-makers," may find the first half of the book somewhat more practical, particularly as Kingston weaves economic literature and commercial data throughout his discussion of the evolution of information protection. The second half of the book, where Kingston sets forth his proposals for improving protection of information, will likely be more appealing for all types of readers. In the context of reform proposals, the author shares his wide-ranging knowledge of protection regimes in multiple jurisdictions, as well as how protection particularly affects different technology areas such as software or genes, to provide a solid base on which to understand and evaluate his proposals. Although the latter half of the book was much more attention-grabbing from my perspective, there are note-worthy portions throughout this book for most every reader.

A quick review of the topics of this book may help elucidate what any particular individual reader would find interesting. Of course, a book discussing information rights must necessarily begin by defining what is meant by "information" and protection thereof. In an interesting chapter that traverses from Bell's telephone to Mozart to Murano glass makers in Venice, Kingston presents a comprehensive conception of information rights by integrating mathematical and biological models of information with commons theory and economic thought.

The next three chapters discuss the historical and current state of information rights. Kingston starts off, not addressing intellectual property regimes, but discussing how other means of protecting information may be more effective (p.17). Again he incorporates historical points of interest, using the story of Boulton and Watt's steam engines to demonstrate how information is initially valuable only to those with the capability to make use of it, providing a basic advantage to the originator even in the absence of protection regimes. The introduction of corporate structures, such as limited liability partnerships and corporations, allowed originators to pair with investors to exploit capability (pp.21-25). After capability, Kingston contends that marketing is the second most important means of protection. He then covers the basics of trademark law and how it too provides the originator of information with market power. The following chapter on patent and copyright protection of information is less intriguing, perhaps because it covers well-worn territory or because some of the discussion stretches to cover subject matter that is not typically considered information, such as pharmaceuticals (p.53), music (p.59), and plants (p.64). Kingston wraps up his discussion of existing regimes with a survey

of international protection of information under various intellectual property conventions and agreements.

At this point in the text, Kingston approaches the first of his goals: discussing how information rights evolved from a system for public good to a system driven by interested parties. Although information protection regimes started with the best intentions, a number of limitations prevented these regimes from keeping pace with the evolution of technology. One reason that American law is particularly ill-suited to protect information rights is a "particularly strong tether to the past" and a Constitution that prohibits forward-looking law (p.85). The Constitution is used to explain why the growth of federal trademark law was hampered; why bodies that could react quicker to technology change, such as state legislatures, are prohibited from doing so; and even why patent office procedures are less than effective. Kingston also considers how bureaucratic influences, such as lobbying, led to the shift of information protection for the public good to the protection of private interests.

While the reasoning behind the shift, i.e., that legal development was occurring at a much slower pace than technological advancement, seems fairly straightforward, the assault by these private interests took place on many fronts. Kingston points to activities at the international, national, and industry level, all with the intent of shaping the future of information protection for the benefit of the actors involved. Many of the key international intellectual property conventions were negotiated with the best interests of the United States and Britain in mind (p.101). At the national level, countries often enacted intellectual property laws that were not the product of careful legislation to protect the states' interests, but were based on proposals offered either overtly or quietly by interested groups. Kingston offers as examples the 1952 United States Patent Act, written by patent attorneys but passed by a Congress that did not know what it contained or meant (p.102) and the Japanese patent system, which facially fulfilled the country's obligations under international intellectual property treaties but worked to the benefit of Japanese conglomerates (pp.106-108). Other groups also took advantage of their size and power to focus information protection benefits on themselves, including alliances like the European Union and industry organizations like the Union of Industrial and Employers' Confederations of Europe, (UNICE), the tobacco industry, and the American music and movie groups, including the Recording Industry Association of America (RIAA) and the Motion Picture Association of America (MPAA).

Because the existing regimes were not adapted to today's technology, including software, biotechnology, genetic inventions, and business methods, the interested parties have forced current systems to accommodate these and other advancements as they saw fit. At the end of the day, we have been left with a patent system that is "in crisis," a copyright system that is protecting software in a way that is "bad logic and bad law," and international protection schemes that are simply "imperialistic, outdated, and overprotective" (pp.127-28). Of course, as Kingston acknowledges, others have made similar observations and suggested various routes to improvement, such as prizes, second-tier patent protection, and compensatory liability.

With this as a background, Kingston sets out a number of proposals to improve the protection of information. He contends that his ideas can be put into effect without revamping the system (pp.146-47). These suggestions are as wide ranging as the problems he seeks to repair, such as setting out compulsory arbitration, changing the contours of information protection, focusing protection on small and medium enterprises (SMEs), and considering sui generis protection of information. Perhaps because of this broad scope of proposals he takes on, I feel that some of the proposals could use additional consideration and support.

Kingston begins with those proposals that would require less difficulty in implementation. The easiest to implement, according to the author, would be to require arbitration for dispute resolution. Because this proposal does not run afoul of TRIPS so long as an appeal is possible and because only a provision of national treatment would be required to make the proposal compliant with the Paris Convention, he contends that this solution is well within reach. In fact, Kingston states that there should not be any difficulty in introducing compulsory arbitration in the United States, although there may be some issues with implementing arbitration in the European Union (pp.159-160). Aside from being easy to implement, Kingston states that arbitration is a less expensive option than litigation, which is useful particularly for information because of the fuzzy boundaries of these rights. Also arbitration is becoming more and more popular in various technical industries because of the ability to have an expert arbitrate technical disputes. Kingston points to the interference proceedings in the United States Patent and Trademark Office, as well as the British Patent Office opinions procedure, as being potential models when creating the arbitration system. Although I question whether the implementation of such a system would be as simple as Kingston contends, I agree that this would certainly allow for smaller entities, which may not be able to afford litigation, to be

able to participate in shaping information protection, weakening the opportunity for large firms to solely control the shape of the laws.

Kingston next proposes to change the parameters of protection for information. He takes particular issue with the time component of existing intellectual property protection—20 years from filing for patent protection, 50-70 years after the author's death for copyright protection, and nearly indefinite trademark rights. These time frames simply are not rational measures for information. Kingston instead suggests that money should be a better parameter; specifically, protection should last as long as it takes for the creator to receive a socially acceptable multiple of the investment he made in developing the information. This multiple should ideally be based on the subjectively assessed risk of the endeavor. The multiple would, of course, be difficult to value, but at least a rate that corresponds to the amount of investment would lead to more appropriate protection. The multiple would be used as the price to be paid for compulsory licensing of the information, and late-comers would be able to use the information by sharing in the investment made by the originator. As further enticement, Kingston also proposes that the compulsory licenses be imposed as a one-time payment, rather than as a royalty. The originator then has a more secure source of recoupment of his risk and the late-comer would have greater incentive to make the most use of the licensed information.

The idea of compulsory licensing based on a multiple is more difficult to swallow than the mandatory arbitration proposal. Kingston acknowledges this by providing substantially more support for this suggestion, addressing many of the thornier aspects. Estimating the value of the investment risk, and thus the determination of the multiple, is going to be one of the most difficult pieces of this proposal. To this end, Kingston relates how existing research programs, such as the Small Business Innovation Research (SBIR) Programs in the United States, have had some success in developing numbers of this type. There is also discussion on how to establish the research and development cost basis on which to apply the multiple. Next, he considers the effects of this proposal on a number of information-heavy industries, such as university patents on biotechnology, computer software, databases, and pharmaceuticals, concluding in each case that adopting this proposal is better than any system currently in place.

Against the most typical argument, that compulsory licensing decreases incentives for firms to engage in research and development, Kingston cites to "more than 100 antitrust settlements" that involved compulsory licensing, none of which, according to Kingston, had a significant adverse effect on research incentives. Kingston also argues that some of the most widely

licensed patents are also the most profitable, such as the Cohen-Boyer gene-splicing patent (p.165). On this point, because it is such a regularly raised issue and because, by its very nature, compulsory licensing dilutes the incentive of exclusive rights, I would have liked to see a more vigorous discussion.

Even were the compulsory licensing system put in place, Kingston notes that it would not have the desired effect for smaller firms. Additional changes to any information protection system would need to be made to account for these actors. While Europe and other areas recognize the potential of smaller firms, known as small and medium-sized enterprises (SMEs), these firms have made the most impact in the United States, both in terms of their financial success as well as the number of United States Patents received by smaller firms from other countries (p.177). But regular information protection regimes are failing these firms. Either their inventions do not reach the level required for protection, because they are not novel or obvious in the patent field, or they are sufficiently inventive but lack seed capital to go forward. To address these problems, Kingston makes a wide range of suggestions. For example, inexpensive routes to protection would be helpful, such as the concessions made by the British Patent Office for individuals and SMEs or petty patents. He also makes suggestions for assisting SMEs to enforce their information protection rights, including litigation insurance. However, as he explains, a feasibility study of patent insurance was performed at the behest of the European Union and the results were not favorable. Indeed, the study determined that there would need to be compulsory participation for the system not to fail (p.186).

Another proposal that has been better received provides for a period of incontestability for SMEs' intellectual property, not unlike the incontestability provision of the United States Orphan Drug Act of 1983. In addition to avoiding the threat of litigation early in the life of the patent, the incontestability provision would also make these inventions more attractive to investors, thereby negating some of the negative effects of information protection that apply particularly to SMEs. As part of implementing an incontestability period, Kingston points to Open Review, a process similar to the Peer-to-Patent pilot study occurring in the United States.

The last proposal that Kingston makes is also the most challenging for implementation. One way to overcome the disadvantages of the existing intellectual property regimes as applied to information is to protect information directly as information (DPI). The author was the creator of one of two DPI proposals studied by the European Union.[1] Kingston's

proposed "Innovation Warrant,"[2] the subject of this chapter, is not surprisingly the one regime change in the book that is well explained and well supported. It is also the proposal that he indicates is the "best candidate" (p.236).

Kingston lays out the case for and the basics of DPI. The focus is not the information itself, but the investment required to make the information into something useful. For example, the question about whether the information is sufficiently novel becomes: "Is the subject-matter of the application for protection available now in the ordinary course of trade?" If the answer is "no", what is protected is the investment required to change the answer to "yes" (p.210). In order for the DPI to address some of the problems associated with traditional information protection schemes, it is important for the protection granted to reflect the risk taken in making the investment. The first prong that Kingston poses is that the state should both grant the protection and enforce what it grants. The second prong is how risk should be determined. Kingston illustrates this with a matrix relating type of innovation (low, medium, and high) to type of risk (incremental, tech-transfer, and radical) resulting in some number of years of protection (p.215). Although the terms listed in the matrix are generally shorter than patent protection, DPI would be preferable because of the period of incontestability and because it would be the state's duty to enforce. Kingston discusses in detail the workings of the system, including the application and enforcement processes. Included in these processes are elements of opposition proceedings and compulsory licensing, as well as the opinion practice used in the British Patent Office. Some of the other key features of the DPI system include protection of expectations, because there are categories of risk, calculated in the abstract and not subject to discretion; reliance on third-party expertise; and flexibility to adapt to new technologies or even to allow for different treatment of particular technologies.

In Kingston's epilogue, however, he concludes that implementing this system in the countries most likely to influence international information protection will be quite difficult. The DPI proposal is unlikely to fall within the intellectual property clause of the Constitution and the Department of Commerce will not want to set up, under the Commerce clause, a system that overlaps so much with the patent system that they already oversee. Europe, too, is an unlikely candidate because the European Union has long worked on a universal patent for its members and has situated its intellectual property matters in Brussels (frustrating the DPI provision of enforcement by state). By considering DPI not as intellectual property, but as economic policy, it is possible that European Union members could

introduce the system nationally, although single implementations may not give as much bang for the buck. Kingston suggests that Canada or Australia may be better suited, but these countries have concerns about international intellectual property that would make their adoption of DPI improbable.

As is often the case when trying to convey an extraordinary amount of information, not to mention describing and justifying a broad range of proposals, it is likely impossible to make all readers happy with what has been included and what has not. There were areas I wish that the author had covered more concisely or not at all and areas that I would have liked to have seen more analysis and detail. That being said, this book provides a broad, if occasionally superficial, panorama of the current and potential future landscape of information protection.

ENDNOTES

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[1] DIRECT PROTECTION OF INNOVATION. (W. Kingston ed., Dordrecht, Netherlands and Boston, MA, USA, Kluwer Academic Publishers for the Commission of the European Communities, 1987).

[2] W. Kingston, An Investment Patent, 7 European Intellectual Property Review 131-136 (1981).

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PATENT ETHICS: LITIGATION, by David Hricik. Oxford University Press, 2010. 270 pp. Paperback $225.00.

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Ethics in patent litigation is important to attorneys, not only for moral reasons, but also because of the possibility of extreme judicial sanctions. Many litigators know of the controversy in the high profile patent infringement lawsuit between Broadcom Corporation and Qualcomm Inc., which was heard in federal court in the Southern District of California. There, during the course of a jury trial, a witness's testimony revealed that relevant documents had not been produced to opposing counsel. Shortly thereafter, the magistrate judge referred six Qualcomm attorneys to the State Bar of California for disciplinary proceedings for the alleged non-production of documents. The legal press reported the story and patent litigators took note. After further proceedings, the sanctions were eventually lifted, but by that time, significant damage had already been inflicted upon the attorneys' reputations and careers. Given that many in the community are concerned about this issue, Professor David Hricik's book on ethics in patent litigation is extremely timely.

Professor Hricik is one of the leading scholars on patent ethics. The present book is the second of his two volume treatise on ethics. His previous book, PATENT ETHICS: PROSECUTION (co-authored with Mercedes Meyer), was favorably reviewed by Professor Christopher M. Holman of the University of Missouri - Kansas City School of Law.[1] In the first book, Professor Hricik addressed ethical issues related to practice before the United States Patent & Trademark Office. Now, Professor Hricik has turned his attention to practice in patent litigation, which mainly occurs in U.S. district courts. Both books are geared toward practitioners, not academics, which explains the somewhat hefty price of $225 for each book.

In the current book, Professor Hricik steers the reader through many aspects of patent litigation. The book is well organized and thoughtfully arranged. The Table of Contents contains sufficient detail to enable a reader to quickly locate relevant sections of the book. There is also a useful and detailed Index, as well as a Table of Cases, both of which facilitate use of the book.

Additionally, the book is relatively thorough on each topic which it covers. For example, Chapter 3 of the book is devoted to conflicts of interest in litigation. The book reiterates the basics such as identifying who is the client and determining when an attorney-client relationship has been formed, and then explains the rules on conflicts of interest relating to former clients (pp.15-61) Of particular use, after discussing the "substantial relationship" test, the book provides a table with summaries of Federal Circuit decisions both finding a substantial relationship and not finding a substantial relationship (pp.50-53). The chapter concludes with an in-depth analysis of consents to conflicts, and of other reasons for denial of disqualification (pp.62-75).

The book also has a detailed discussion of pre-trial investigations. While many attorneys are familiar with the contours of Rule 11 in general, Professor Hricik explains the nuances of pre-filing investigations in patent litigation in Chapters 5 and 6. He recounts the Federal Circuit case law on what constitutes an adequate factual investigation of the accused product (pp.94-101). He also sets forth various ethical constraints with which attorneys may be less familiar. For example, most lawyers understand that they may not directly communicate with a represented party under ABA Model Rule 4.2; rather, they must interact with the party's attorney (pp.107-109). But the book expands upon the basic understanding of the rule to identify gray areas in the law, such as how long before the filing of a lawsuit the rule applies (pp.109-111). Furthermore, common situations confronted in patent litigation, such as contacting current employees through web sites of the opposing party, are discussed (p.115).

Patent litigators rely heavily on expert witnesses. These witnesses testify about a range of issues including infringement, validity and inequitable conduct. The book provides straightforward information and advice about expert witnesses and reports. It then provides more detailed information about conflicts and disqualification of experts in Chapter 8. For instance, the book explains that disqualification may be warranted if a first party's expert received confidential information from the opposing party, typically when the opposing party was considering engaging the expert (pp.154-165).

While most attorneys generally understand how to assist in preparation of an expert report, few understand the applicable rules on conflicts dealing with experts. Particularly practical, the book sets forth a checklist of best practices for dealing with experts (pp.174-77). These include ensuring that employee confidentiality agreements are broad, and asking the expert early in the engagement about prior work for the opposing party or counsel.

Many of the areas discussed in the book have not been directly addressed by Federal Circuit case law. For example, conduct during discovery is rife with potential ethical issues. The parties resolve most discovery disputes, often after considerable argument and discussion. Sometimes a disagreement lingers and is brought to the trial court's attention. Then, the district court judge (or the magistrate judge) must rule on a motion to compel, a motion for a protective order, or some other discovery motion. These orders and rulings generally are not immediately appealable as they are not final orders. Consequently, it is rare for these to ever make their way to the Federal Circuit. This explains why there is only a very small body of appellate case law relating to discovery in patent cases. Professor Hricik's book had the ability to make a significant dent in this lack of knowledge. However, I found his section on discovery slightly unsatisfying; it was less than ten pages (pp.182-89). I fully recognize that it is difficult to discuss and analyze the numerous potential discovery issues that can occur in patent litigation. However, because ethics play a significant role in discovery, more attention is warranted.

In some areas, the law has substantially developed in the brief time period (several months) since publication of Professor Hricik's book. For example, district courts have occasionally restricted access to lawyers involved in patent prosecution from certain highly confidential documents exchanged in patent litigation. These restrictions are located in protective orders and are usually called "prosecution bars." In May 2010, the Federal Circuit decided a case of first impression about this very issue, *In re Deutsche Bank Trust Co. of America.*[2] The *Deutsche Bank* case provides the first guidance on prosecution bars by the Federal Circuit, and was not yet issued at the time of the book's publication. Professor Hricik rightly notes the issue of prosecution bars in protective orders in Chapter 10, but given his study of the issue, it is unfortunate we do not have his interpretation of the case or his suggestions about how to approach prosecution bars in the future.

Finally, the book should spend more space on the relationship between opinion counsel and trial counsel. Opinion and trial counsel both represent the same client with similar goals. Because privilege is typically waived for

work performed by opinion counsel (and it is rarely, if ever, waived for work performed by trial counsel), much thought must be given as to how to structure and organize the relationship among the client, opinion counsel and trial counsel. Advice from Professor Hricik on this issue would have been helpful. While the book explains the Federal Circuit case law on this issue including a discussion of *In re Seagate* and *In re Echostar* in Chapter 10, and walks the reader thru the various ethical rules including the prohibition in some model ethical rules on lawyers acting as both witnesses and advocates, the book does not propose best practices or other guidelines for practicing attorneys.

While the book is not perfect, it is an important reference for patent litigators. Despite its minor shortcomings, some of which I have noted, the book is a significant and useful addition to the scant literature on patent litigation ethics. Not only is this book currently the best resource available on the topic, its thoroughness will make it essential to litigators for years to come.

ENDNOTES

[1] 1 The IP Law Book Review 40 (2010).

[2] In re Deutsche Bank Trust Co. Ams., 605 F.3d 1373 (Fed. Cir. 2010).

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