

Articles

Authors at Work: The Origins of the Work-for-Hire Doctrine

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I. INTRODUCTION

The death of the author was announced in literary circles quite some time ago.¹ Rumors of the author's demise were, in my view, premature. The author isn't dead; he just got a job. Unfortunately, as if in a company-man dystopia, he has been subsumed into the identity of his corporate employer. His disappearance is by now

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1. ROLAND BARTHES, THE RUSTLE OF LANGUAGE 49 (Richard Howard trans., 1989) (referring to "the death of the author").

almost complete. Although he has gone on writing, the corporation has become the author of his oeuvre.

Yet the desire both to create and to be recognized as a creator is irrepressible. The creative process is both inherently individual and inescapably social. So even as the author has been submerged as employee, she claims recognition in modern copyright law in other ways—perhaps as a joint author or through moral rights. The history I will tell here of the nineteenth-century law's efforts to mediate the inevitable tension between individual and collective creative rights tells us something about law and the ownership of ideas today. As I explain in the pages that follow, nineteenth-century lawyers tried to short-circuit the difficult and complex issue of balancing individual and collective rights through a neat doctrinal rule granting all rights to the employee, but the tidiness did not last. When, at the turn of the twentieth century, courts and Congress adopted the modern work-for-hire doctrine allocating copyrights to the employer, lawyers again hoped that bright-line rules would prevail. Again doctrinal confusion surfaced, revealing the underlying tension. Today, the same tension appears in the debate about the desirable scope of joint authorship.² The author is not dead, and authorship is not a fiction. It has never been easy to divvy up the honor and the money among the many people, both natural and corporate, who contribute to the creative process.

Recent scholarship in law and literary studies has traced the process by which the modern notion of an author evolved with the development of copyright law.³ This literature argues that the

2. I am indebted to David Lange for this insight about the relationship between work-for-hire and joint authorship, and to his article, *At Play in the Fields of the Word: Copyright and the Construction Authorship in the Post-Literate Millennium*, 55 *LAW & CONTEMP. PROBS.* 139 (1992), for the notion that authorship is irrepressible. On the contemporary debate over the scope of joint authorship, see Rochelle Cooper Dreyfuss, *Collaborative Research: Conflicts on Authorship, Ownership, and Accountability*, 53 *VAND. L. REV.* 1162 (2000); Roberta Rosenthal Kwall, "Author-Stories: Narrative's Implications for Moral Rights and Copyright's Joint Authorship Doctrine", 75 *S. CAL. L. REV.* 1 (2001); and Mary LaFrance, *Authorship, Dominance, and the Captive Collaborator: Preserving the Rights of Joint Authors*, 50 *EMORY L.J.* 193 (2001). Peter Jaszi did seminal earlier work on the tension between individual and collaborative work in the joint authorship area. See, e.g., Peter Jaszi, *On the Author Effect: Contemporary Copyright and Collective Creativity*, in *THE CONSTRUCTION OF AUTHORSHIP: TEXTUAL APPROPRIATION IN LAW AND LITERATURE* 29-35 (Martha Woodmansee & Peter Jaszi eds., 1994). Substantially the same article appears under the same title in 10 *CARDOZO ARTS & ENT. L.J.* 293 (1992).

3. Prominent histories of copyright in American, British, and European law include JAMES J. BARNES, *AUTHORS, PUBLISHERS AND POLITICIANS: THE QUEST FOR COPYRIGHT AGREEMENT, 1815-1854* (1974); JAMES BOYLE, *SHAMANS, SOFTWARE, AND SPLEENS: LAW AND THE CONSTRUCTION OF THE INFORMATION SOCIETY* (1996); *THE CONSTRUCTION OF AUTHORSHIP: TEXTUAL APPROPRIATION IN LAW AND LITERATURE*, *supra* note 2; JOHN FEATHER, *PUBLISHING, PIRACY AND POLITICS: AN HISTORICAL STUDY OF COPYRIGHT IN BRITAIN* (1994); BENJAMIN KAPLAN, *AN UNHURRIED VIEW OF COPYRIGHT* (1967); MARK ROSE, *AUTHORS AND OWNERS: THE INVENTION OF COPYRIGHT* (1993); PAUL K. SAINT-

development of copyright law in England and Europe from the eighteenth century onward privileged the concept of the individual “author.”⁴ Michel Foucault’s influential essay, *What is an Author?* launched a wave of literary and historical studies on the origins of the modern concept of authorship.⁵ Most have argued that the legal and literary emphasis on the individual author is overblown and that collaborative and communal practices of creation have been insufficiently noticed.⁶

Turning from literary history to economic history, one sees a similar interest in the process by which property rights in creative works developed over the course of the nineteenth century.⁷

AMOUR, INTELLECTUAL PROPERTY AND THE LITERARY IMAGINATION (2003); DAVID SAUNDERS, AUTHORSHIP AND COPYRIGHT (1992); and, JACK STILLINGER, MULTIPLE AUTHORSHIP AND THE MYTH OF SOLITARY GENIUS (1991). Particularly important analysis of copyright from the perspective of economic history, rather than literary or legal history, is being done by B. Zorina Khan. Her work is unique in giving a macro-perspective on how copyrights functioned and how, in the absence of copyright for works of foreign authors, American publishers created their own form of monopoly rights. See B. ZORINA KHAN, “THE FUEL OF INTEREST”: PATENTS AND COPYRIGHTS IN AMERICAN ECONOMIC DEVELOPMENT (forthcoming 2003); B. Zorina Khan, Do Property Rights Matter? International Copyrights and the Development of the American Economy, 1790-1910 (unpublished manuscript on file with author). On the debate between economically and literarily-inclined approaches to copyright law, see for example Mark A. Lemley, *Romantic Authorship and the Rhetoric of Property*, 75 TEX. L. REV. 873 (1997) (reviewing JAMES BOYLE, SHAMANS, SOFTWARE, AND SPLEENS: LAW AND THE CONSTRUCTION OF THE INFORMATION SOCIETY (1996)).

4. See, e.g., SAINT-AMOUR, *supra* note 3 (surveying the history of copyright literature and studying appearances of the notion of copyright in nineteenth and twentieth-century English and American poetry and novels); Peter Jaszi, *Toward a Theory of Copyright: The Metamorphoses of “Authorship”*, 1991 DUKE L.J. 455 (1991) (United States.); Mark Rose, *The Author as Proprietor: Donaldson v. Becket and the Genealogy of Modern Authorship*, 23 REPRESENTATIONS 51 (1988) (England); Martha Woodmansee, *The Genius and the Copyright: Economic and Legal Conditions of the Emergence of the ‘Author.’* 17 EIGHTEENTH CENTURY STUD. 425 (1984) (Germany).

5. Michel Foucault, *What is an Author?*, in TEXTUAL STRATEGIES: PERSPECTIVES IN POST-STRUCTURALIST CRITICISM 141 (J. Harari ed. & trans., 1979).

6. The origins of the literary and legal discussions of the history of copyright and the notion of authorship, and the convergence of the two bodies of scholarship, are ably traced by Jaszi, *supra* note 2 at 29-32.

7. See, e.g., KHAN, *supra* note 3; Robert Merges, *One Hundred Years of Solitude: Intellectual Property Law, 1900-2000*, 88 CAL. L. REV. 2187 (2000). One sees similar interest in economic histories of intellectual property rights other than copyrights. See, e.g., B. Zorina Khan & Kenneth L. Sokoloff, *The Early Development of Intellectual Property Institutions in the United States*, 15 J. ECON. PERSP. 233 (2001); Naomi R. Lamoreaux & Kenneth L. Sokoloff, *The Geography of Invention in the American Glass Industry, 1870-1925*, 60 J. ECON. HIST. 700 (2000); Naomi R. Lamoreaux & Kenneth L. Sokoloff, *Inventors, Firms, and the Market for Technology in the Late Nineteenth and Early Twentieth Centuries*, in LEARNING BY DOING IN MARKETS, FIRMS, AND COUNTRIES (Naomi L. Lamoreaux et al. eds., 1999); Naomi R. Lamoreaux & Kenneth L. Sokoloff, *Long-Term Change in the Organization of Inventive Activity*, 93 PROC. NAT. ACAD. SCI. 12686 (1996); Naomi R. Lamoreaux & Kenneth L. Sokoloff, *Market Trade in Patents and the Rise of a Class of Specialized Inventors in the 19th-Century United States*, 91 AM. ECON. ASS’N PAPERS & PROC. 39 (2001); Kenneth L. Sokoloff, *Inventive Activity in Early Industrial America: Evidence from Patent Records, 1790-1846*, 48 J. ECON. HIST. 813 (1988); Kenneth J. Sokoloff & B. Zorina Khan, *The*

Economic historians have noted the collaborative nature of creation and the process by which property rights were allocated so as to enable the development of efficient markets for creative products. From the economic perspective, the ability of the firm to obtain property rights in its employees' creative products is a significant feature of an efficient intellectual property regime.⁸

Attribution of authorship may be a fiction in the eyes of literary critics and a business transaction in the eyes of economists, but in the eyes of the law it is, for the most part, simply a question of evidence.⁹ Under modern copyright law, "copyright in a work . . . vests initially in the author or authors of the work,"¹⁰ and as far as lawyers are concerned, identifiable people are in fact the creators of all work eligible for copyright protection. Attribution of authorship is a matter of proof, not a process of cultural attribution, and when corporations are deemed authors, it is because they have hired people who created works.

One significant exception to the law's disregard for the fiction of authorship is in the case of "works made for hire." Here, the Copyright Act expressly recognizes the author as a legal fiction. If a work meets the statutory definition of a work made for hire, "the employer or other person for whom the work was prepared is considered the author" for purposes of federal copyright law.¹¹ The statute specifies that a work is "made for hire" under two circumstances: (1) if an *employee* (a term of art) prepares it "within the scope of his or her employment,"¹² or (2) if one of nine statutorily enumerated types of work prepared by persons not meeting the legal definition of employee was "specially ordered or commissioned."¹³

Democratization of Invention During Early Industrialization: Evidence from the United States, 1790-1846, 50 J. ECON. HIST. 363 (1990).

8. I do not mean to suggest a unanimity of opinion among economists (or anyone else) on what allocation of intellectual property rights between employer or employee is desirable or efficient, or even on whether there should be any such rights at all. See, e.g., Jack Hirshleifer, *The Private and Social Value of Information and the Reward to Inventive Activity*, 61 AM. ECON. REV. 561 (1971); Neal Netanel, *Copyright and a Democratic Civil Society*, 106 YALE L.J. 283 (1996).

9. There are significant exceptions to this. See F. Jay Dougherty, *Not a Spike Lee Joint? Issues in the Authorship of Motion Pictures Under U.S. Copyright Law*, 49 UCLA L. REV. 225 (2001).

10. 17 U.S.C. § 201(a).

11. *Id.* § 201(b).

12. *Id.* § 101(1).

13. *Id.* § 101(2) (emphasis added). The nine categories are (1) contributions to a collective work, (2) motion pictures or other audiovisual works, (3) translations, (4) supplementary works, (5) compilations, (6) instructional texts, (7) tests, (8) answer material for a test, and (9) atlases. However, the parties must expressly agree in a written instrument signed by them that the work shall be considered a work made for hire. *Id.* Thus, the default rule is that works by independent contractors are not works for hire.

On the surface, there is nothing especially noteworthy in the statute's choice to designate employers as "authors" of works for hire. "Author" is simply a term of art, the operative term for the proprietor of statutory rights. Statutes often do their substantive work of according rights and protections by defining terms. On further consideration, however, it becomes apparent that the legal fiction that asserts the employer (usually a corporation) is the "author" of a copyrighted work has greater significance than an ordinary term of art. The notion of authorship is freighted with connotations of creative genius and the moral entitlements that flow from it. Congress chose to call the employer the author for reasons in addition to ease in statutory drafting; it obviated some constitutional questions, and it elided some moral issues as well.

One of the claims I make in this article is that the legal fiction of corporate authorship does what Lon Fuller suggested legal fictions always do.¹⁴ That is, it persuades lawyers that the corporate employer has a legitimate right to the copyright—the moral and legal entitlements that flow from the exalted status of being an author—without the necessity of explaining why. The legal fiction of employer authorship was not always recognized as a fiction, particularly in cases in which factual authorship might have been shared among many employees of a firm. But even if employer authorship is mainly fictional, it works as what Lon Fuller called an "intellectual shortcut" to persuade when a statement of the actual reasons for the ruling are difficult to explain.¹⁵ The legal fiction is an expedient motivated by "the impulse to preserve a form of statement that will make the law acceptable to those who do not have the time or the capacity for understanding reasons which are not obvious—and this class sometimes includes the author of the statement himself."¹⁶

A second claim I make in this article is descriptive: The creation of the modern doctrine preceded its first appearance in the federal Copyright Act of 1909. It neither was invented by the drafters of the 1909 Act, nor was it well recognized in the cases before 1909. The concept began to appear after 1860, though no case actually applied such a rule until a pair of cases did so in 1899 and 1900. As one legal rule (a default rule of employee ownership) was replaced by its exact opposite (a default rule of employer ownership) over the course of

14. LON L. FULLER, *LEGAL FICTIONS* 9-19 (1967).

15. *Id.* at 26.

16. *Id.* An excellent modern work on legal fictions, including Fuller's theory and Jeremy Bentham's vigorous attack on them, is Nomi Maya Stolzenberg, *Bentham's Theory of Fictions—A Curious "Double Language,"* 11 CARDOZO STUD. L. & LIT. 223, 231-36 (1999). See also Aviam Soifer, *Reviewing Legal Fictions*, 20 GA. L. REV. 871 (1986).

seventy-five years, courts struggled to accommodate corporate control over intellectual property to a misty-eyed regard for the prerogatives of authors, artists, and composers. The process repeated an old pattern in copyright history. Eighteenth-century booksellers had conjured up and deployed the modern author—a creative genius possessed of moral and legal entitlements to his creations—and used him to argue for a copyright law protecting against cheaper reprints.¹⁷ Early twentieth-century firms used that same mythic genius in their effort to assert corporate control over an increasingly wide range of intellectual property, while at the same time downplaying or ignoring individual creative genius so as to assert corporate ownership over those copyrighted works. The employee writer, artist, or composer was simultaneously cloaked with the aura of the romantic genius and merged into the corporate entity.

In the long discussion in legal and literary studies about the mutually constitutive roles played by copyright law and popular and academic understandings of authorship, many have noted but few have studied the role of employed authors and employment relations. Most legal, literary, and economic approaches to copyright history note the development of the work-for-hire doctrine in late-nineteenth-century American copyright law as an exception to the individual authorship paradigm.¹⁸ I ask: To what extent does the employment relation make both individual authorship *and* corporate authorship fictional, and what role have metaphors about the nature of authorship played? Both the dominant copyright metaphors of authorship—the work as property (Locke’s mixing one’s labor with the soil of culture) and the work as progeny (Defoe’s “brat of my brain”)—break down when it is someone else’s brain and ideas being tilled or reproduced.¹⁹

The work-for-hire doctrine challenged the rhetoric of individual authorship in more serious ways than is conventionally acknowledged. Peter Jaszi has said that the work-for-hire doctrine has been justified by courts in the usual Romantic authorship paradigm: The “identification of employer as author is more than a crude, instrumental fiction—rather, it is a logical (if perverse) working out of the underlying assumption that the essence of ‘authorship’ lies in original, inspired creative genius.”²⁰ In his view, “it is the ‘employer’s contribution as the ‘motivating factor’ behind

17. Rose, *supra* note 4, at 56. See also ROSE, *supra* note 3.

18. As Peter Jaszi put it, the work-for-hire doctrine is “a dramatic example of the ways in which the ideology of ‘authorship’ has been manipulated.” Jaszi, *supra* note 2, at 34.

19. I am grateful to Mark Rose for illuminating the power of these metaphors for me.

20. Jaszi, *supra* note 2, at 34.

the work (in the words of one decision) that matters, rather than the mere drudgery of the ‘employee.’”²¹ In other words, Jaszi says, courts still focus on the *employer’s* contribution, when they insist that it is the right to control the work of the employee that makes the employer the author.²² As I will show, in the development of the work-for-hire principle some courts did focus on the employer’s contribution or the employer’s right to control. But over time many came to rely simply on the legal fiction that employment renders the employer the author. The “crude legal fiction” was not that the employer’s right to control made it the author; it was that the employer *was* the author.

In addition to my jurisprudential claim about legal fictions and my descriptive claim about what the law was and when it changed, I make five interrelated explanatory claims about why the law started out favoring employees and then changed. Multiple forces converged to generate the radical change in the default rules of copyright ownership between the early nineteenth century and the early twentieth.

First, I argue that the facts of the cases presenting the question of employer ownership of employees’ creative products profoundly affected the courts’ perceptions of the competing claims. The overwhelming majority of nineteenth-century cases involved either legal publishing (court reporters and treatise authors) or theater. The discourse of authorship really meant something concrete to judges when it came to law reports, legal treatises, and theater; they thought they knew exactly what counted as authorship. At the same time, the law developed as it did because courts had a very definite idea of what they wanted to accomplish in allocating property rights in texts. In particular, early nineteenth-century judges thought allocating copyright to employees would facilitate the development of law publishing. Toward the end of the nineteenth century, and at the beginning of the twentieth, cases about advertisements became more common. Thus, a crucial part of the development of the work-for-hire doctrine was the expansion of the types of works eligible for copyright protection to include collaboratively produced commercial media. The expansion of copyright made copyright ownership an important asset to an ever-growing array of businesses and, therefore, simultaneously created incentives for firms to claim ownership of their employees’ products and made it easier for courts to accept these claims.

Second, a related explanation for the pattern of doctrinal change

21. *Id.*

22. *Id.* (citing *Cnty. for Creative Non-Violence v. Reid*, 490 U.S. 730, 751 (1989)).

involves dearly-held beliefs about the moral worth and inherent individuality of the creative process. The romantic conception of authorship as the expression of creative individual genius played a major role in the early period. In the later period, courts were able to reconcile employer ownership with authors' rights in some cases by elaborating a fiction of employer authorship and, in others, by positing the existence of collective creation. This is how legal fictions about authorship played a crucial mediating role. These legal fictions are a fundamental part of the common law process, in which change is incremental, analogies are essential but contestable, and the facts of the cases are of great importance.

Third, the relatively pro-employee rule of the nineteenth century would have been unthinkable in the context of nineteenth-century master-servant law but for the elevated social status of the people who created the works. That the dominant cases involved the Reporter of Supreme Court decisions and some of the most celebrated mid-nineteenth century actor-playwrights was crucial in garnering judicial respect for the rights of employee authors. Although I refer to the employed authors as employees, most of them would be independent contractors in modern parlance. Few, especially in the early cases, were the sort of people who would have been governed by master-servant law in the nineteenth century. Thus, the copyright rules described here were not in conflict with master-servant law so much as completely independent of it—doctrinally, conceptually, and socially.

The increasingly bright distinction between employees and independent contractors played a role late in the century as courts reevaluated old assumptions about the nature of the employment contract, the process by which employment contracts are negotiated, and the role of contractual default rules. At the same time, the ascendance of an objective theory of contract in the late nineteenth century significantly expanded the ability of judges and lawyers to make the conceptual leap from individual authorship to collective creation that, as an inherent feature of the employment contract, entitled the employer to own the intellectual property. The results of some of the cases might not have differed between the early-nineteenth century and now, inasmuch as modern law provides that works by independent contractors are not deemed works made for hire absent an express written agreement to that effect.²³ But the early cases, which involved workers who would today be independent contractors, were sometimes relied on in later cases that did involve workers who would today be deemed employees. Courts

23. See 17 U.S.C. § 101(2).

did not draw the distinction until the statute was later amended to make it plain.²⁴ In virtually all of the cases, whether the hired party had a contractual relationship of independence or one of full-time salaried employment, the hired party occupied a position that might customarily have been filled by a person of considerable independence. In a sense, then, over time the kind of workers to whom the doctrinal categories applied changed as much as the doctrinal categories themselves.

Fourth, closely related to the changes in employment practices and employment law was the rise of the corporate form of business organization. When the dispute over authorship was between one natural person and another, judges tended to think that one of them had to be the real author. But if the work was created collaboratively, and one of the claimants was the corporation that employed the creators, it was much easier to characterize the corporate employer, in its role as the legal representative of the collective, as the author than it would have been if the employer were a natural person.

Fifth, the doctrinal change could occur because judges revamped their thinking about writing, authorship, and the production of works subject to copyright, and changes in the understanding of the nature of ideas made that revamping easier. Pragmatist thought reflected a new approach to ideas which made a new approach to owning them seem more plausible: Ideas are created socially; they are not “out there” waiting to be uncovered, and they are not the product of one individual’s solitary genius.²⁵ They are produced because of the

24. Three of the earliest cases involved “independent contractors” who, the courts held, owned their copyrights. *Wheaton v. Peters*, 33 U.S. 591 (1834); *Little v. Gould*, 15 F. Cas. 612 (C.C.N.D.N.Y. 1852); *Atwill v. Ferrett*, 2 F. Cas. 195 (C.C.S.D.N.Y. 1846). One early case involved an “independent contractor” who did not own his copyright. *Heine v. Appleton*, 11 F. Cas. 1031 (C.C.S.D.N.Y. 1857). In two cases from the middle period, the employment status of the author was ambiguous, and he might today be characterized as employee, contractor, or even possibly partner. *Boucicault v. Fox*, 3 F. Cas. 977 (C.C.S.D.N.Y. 1862); and *Roberts v. Myers*, 20 F. Cas. 898 (C.C.D. Mass. 1860). In another middle period case, the author was probably an employee, and he was held not to own the rights to his work. *Keene v. Wheatley*, 14 F. Cas. 180 (C.C. E.D. Pa. 1861). In another case, the author was a contractor, and the court held the parties had expressly contracted for ownership by the employed person. *Lawrence v. Dana*, 15 F. 26 (C.C.D. Mass. 1869). In two decisions from late in the middle period, the authors were salaried employees, and the courts held that they rather than their employers owned the copyrights. *Callaghan v. Myers*, 128 U.S. 617 (1888); *Peters v. Borst*, 9 N.Y.S. 789 (Sup. Ct. 1889). The earliest case discussing the distinction between employees and independent contractors as relevant to ownership of literary property was *Edward Thompson Co. v. Clark*, 109 N.Y.S. 700, 702 (Sup. Ct. 1904), which held that because the author was an employee rather than an independent contractor, the employer owned all written work and could prevent the employee from publishing it elsewhere even though the employer had rejected the work as unpublishable.

25. My thinking about the cultural changes associated with the early development of pragmatism in the late nineteenth century has been heavily influenced by LOUIS MENAND, *THE METAPHYSICAL CLUB* (2001). On pragmatism and American law, especially the

individual's past experience and social context. If they are created collectively, and if exposure to a particular environment is crucial, then they are neither the exclusive property of the person who wrote them nor the brat of the solitary writer's brain. Moreover, ideas are produced because they are useful. If, as Holmes believed, all thought "is at once 'social' and 'on its way to action,'"²⁶ then both the generation and the practical use of ideas in the workplace are inherently part of the business enterprise. The belief that knowledge or an idea is a tool like any other makes it easier to see that ideas and their embodiment in texts are the product of the group setting in which employees work and which the employer arguably has purchased through wages and the investment in tools and materials.

These five interrelated causal claims are woven throughout this article, but the organization follows the trajectory of the descriptive claim about the evolution of the doctrine. Because the development of the doctrine can be divided into three periods, the article, which is based on every reported American decision involving an employed author before 1910, is too. Part I covers the period before 1860, in which courts quite clearly asserted that persons hired to create works owned the copyright to their works, not the person who hired the creator. Copyright registrations suggest that the actual practices of employers and firms may have recognized a default rule of employer ownership of copyrights, but the case law did not. So few copyright cases were litigated, however, that it is difficult to know whether the courts' and the parties' views of the default rule were the same or different. The paucity of reported cases and the tremendous influence of the few that exist both enable and require me to explore them in depth. I aim to shed light both on why courts adopted the rule and on whether the reported decisions were or were not representative of the way other writers and employers would have understood their rights. Part II treats the period of transition between 1860 and 1900 when courts began to recognize the interests of employers in copyright ownership. Several courts stated a principle of employer ownership in dicta, but the holdings still found that only an express contract was sufficient to locate the copyright in the employer. During this middle period, the rules regarding intellectual property ownership were uncertain and contradictory, thus belying the conventional assumption that certain and definite

pragmatism of Holmes, see Thomas C. Grey, *Holmes and Legal Pragmatism*, 41 STAN. L. REV. 787 (1989). The literature on law and pragmatism is vast, and a full citation to the literature will have to await a full discussion of the influence of pragmatism on the development of the legal ownership of ideas. For better or worse, this discussion will not be found in this article.

26. Here I quote Thomas Grey's characterization of Holmes's own summary of the essential tenets of pragmatism. Grey, *supra* note 25, at 798.

property rules were necessary to and a crucial factor in the rapid economic expansion of the late nineteenth century. Part III treats the beginning of the modern era, in which courts recognized and Congress codified that the fact of employment was sufficient to vest copyright in the employer, even in the absence of a contract expressly allocating ownership.²⁷

II. THE EARLY PERIOD: BEFORE 1860

During the first half of the nineteenth century, the hegemony of author as owner ensured that courts saw no employer claim to the creative products of their employees. Published cases determined that employees were entitled to the copyrights in their works, even though the works had been done during the course of employment or on commission. As will be noted, however, data on copyright registrations show that employers did sometimes copyright work prepared by their employees. The practices in some industries—I use the example of mapmaking—suggest that where authorship was communal, employers claimed copyrights. Following a brief look at copyright and collective authorship before 1830, this section examines the only published decisions on copyright ownership involving employed authors, which involved law publishing and theater. Then, by way of comparison, I examine copyright practices in the area of map publishing. Although the example of map publishing suggests that actual practices of copyright ownership were complicated, the rules articulated by courts in cases where employers and employees disputed copyright ownership were not. Courts were quite clear that, absent an express and clear contrary agreement, the employee-author was entitled to the copyright.

27. The doctrinal change that occurred in these three periods loosely corresponds to similar changes that occurred at the same time in the development of other branches of intellectual property and employment law. See Catherine L. Fisk, *Removing the "Fuel of Interest" from the "Fire of Genius": Law and the Employee Inventor, 1830-1930*, 65 U. CHI. L. REV. 1127 (1998) [hereinafter Fisk, *Law and the Employee Inventor*]; Catherine L. Fisk, *Working Knowledge: Trade Secrets, Restrictive Covenants in Employment, and the Rise of Corporate Intellectual Property, 1800-1920*, 52 HASTINGS L.J. 441 (2001) [hereinafter Fisk, *Working Knowledge*]. Similar reasons for the change explain the law of employee patents, trade secrets, and cognate doctrines. The problem of reconciling corporate authorship with individual creation was more acute in the field of copyright than it was when the creative products were patented or with trade secrets because the courts struggled more consciously with the question of whether the kinds of materials that firms would create were sufficiently original, creative, or even artistic to be worthy of copyright protection. Unlike in patent law, where the only requirements were nonobviousness, novelty, and usefulness, courts seemed to think that copyright required some modicum of artistic expression or creativity. Thus, when courts came to justifying corporate authorship, they had to analogize advertisements to oil paintings and corporations to great artists.

A. Copyright and Collective Authorship Before 1830

For centuries before my study begins, people had been employed to create texts and other works that today would qualify for copyright protection. Literary histories of copyright and authorship note that prior to the Renaissance the collective nature of the creation of texts was widespread. If texts were divinely inspired, original creation was not understood to be the essential characteristic of authorship. And the reproduction of texts involved copying rather than conjuring. The nature of book production was thus inherently collective.²⁸

Evolving notions of authorship, together with Lockean labor theories of value, gradually created the ideas that the author is the one who does the original and creative work of imagining and writing, and that property rights are justified by the labor expended in the creation.²⁹ That understanding of the nature of authorship appeared in Blackstone's *Commentaries on the Laws of England*. Blackstone, of course, was a contemporary of the eighteenth-century English advocates of authors' rights, and he was an author as well. Blackstone famously stated the classic mixed-labor and genius-based justification for copyright:

When a man by the exertion of his rational powers has produced an original work, he has clearly a right to dispose of that identical work as he pleases, and any attempt to take it from him, or vary the disposition he has made of it, is an invasion of his right of property.³⁰

But as the labor theory of property melded with the Romantic notion of authorship, no attention was paid to the question of how to allocate property rights when the labor was that of an employee.

28. One description of the process reveals the similarity between book production and wage labor in the pre-Renaissance period:

With the so-called "book revolution of the twelfth century and university supervision of copying, there came a 'putting out' system. Copyists were no longer assembled in a single room, but worked on different portions of a given text, receiving payment from the stationer for each piece . . ." Through a sort of guilt by association, we can see how wage labor might metonymically become associated with the capacity to possess the knowledge which is the source and aim of the labor. We can also envision how the "employer" of copyists might become a metonym for the owner of the knowledge and thus of the authority supposedly contained within the text.

Marlon B. Ross, *Authority and Authenticity: Scribbling Authors and the Genius of Print in Eighteenth-Century England*, in THE CONSTRUCTION OF AUTHORSHIP: TEXTUAL APPROPRIATION IN LAW AND LITERATURE 231, *supra* note 2 (quoting I ELIZABETH EISENSTEIN, THE PRINTING PRESS AS AN AGENT OF CHANGE 12-13 (1979)).

29. See generally THE CONSTRUCTION OF AUTHORSHIP: TEXTUAL APPROPRIATION IN LAW AND LITERATURE, *supra* note 2; ROSE, *supra* note 3.

30. 2 WILLIAM BLACKSTONE, COMMENTARIES ON THE LAWS OF ENGLAND *405-06. Blackstone had, as a lawyer, represented one of the parties in a prominent English case on the scope of copyright. See ROSE, *supra* note 3, at 75.

The modern notion of the author as the individual creator of text *ex nihilo* was a political and legal strategy employed by publishers to galvanize legislative and judicial support for monopoly rights over books. As Mark Rose explained in his seminal work, *Authors and Owners*, in the seventeenth century,

[t]here may have been some feeling that authors should have the right to control the first publication of their writings. But in England at any rate no clearly defined set of authorial rights existed Indeed, the very concept of “author” was still incompletely developed. Not only was the modern notion of the author as an autonomous creator, the producer and first proprietor of original works, not yet formed, but even the Renaissance notion of the author as an individuated authority was often problematic.³¹

Rose argued that the conceptual foundations for the author's copyright were established in British law in the eighteenth century. Locke's theory of property as arising from the mixing of the individual's labor with nature united easily with an emerging aesthetic of books as products of a creative mind and as manifestations of an individual's personality.³² The author as creative genius and the author as proprietor simultaneously described the nature of literature and justified the existence of legal rights in ideas.³³ The author-proprietor proved to be a very durable synthesis that persists in American copyright law today.

Rose and others have shown how writers from Defoe to Dickens joined forces with publishers in advocating the moral, cultural, and economic benefits of protecting the authors' proprietary rights in their works.³⁴ From the eighteenth century through the twentieth, celebrity authors have been effective lobbyists for a set of copyright rules that benefited corporate publishers as much as individual scribblers.³⁵ The early approach to employee authors is no exception. One of the authors who figured prominently in the nineteenth-century cases involving theater employees, Dion Boucicault,

31. ROSE, *supra* note 3, at 25.

32. *Id.* at 114.

33. *Id.* at 6.

34. See generally *id.* and sources cited *supra* notes 3 and 4.

35. The celebrity author copyright advocates include Daniel Defoe, Alexander Pope, and William Wordsworth. See ROSE, *supra* note 3, at 34-37, 60-65, 110-12; Dion Boucicault, see *infra* text accompanying notes 105-115. A modern example of the successful melding of celebrity with copyright advocacy is the Sonny Bono Copyright Extension Act, Pub. L. No. 105-298, 11 Stat. 2827 (codified in scattered sections of 17 U.S.C.) named for the late entertainer by his widow and other legislative sponsors whose Hollywood constituents perhaps care more that Mickey Mouse never enters the public domain than the music and lyrics to *I Got You, Babe*.

successfully lobbied for a revision of American copyright law to provide that the copyright in a play allowed the author to restrict performances as well as publication.³⁶

Telescoped summaries of the nineteenth-century ethos of copyright posit an unassailable hegemony of the paradigm of the individual author. The dominant ideology of copyright in both law and literature is the position forcefully advocated by Dickens and Wordsworth and usually described as “Romantic Authorship.” That is, copyright exists to reward the genius of the individual author who creates great literature out of his own imagination and hard work and little else. This vision of authorship is part of the nineteenth-century Romanticism that lionized individuality, creativity, and the unique genius that fired both. But the Romantic Author may not have been quite as hegemonic even in the nineteenth century as is sometimes suggested. Paul Saint-Amour’s study of nineteenth-century plagiarism apologists reveals that even in the hey-day of Romanticism, there were many who advocated a broader role for the public domain and for a continued appreciation of collective creation.³⁷ Depending on how broadly Saint-Amour’s thesis applies, the notion that employers might claim to own the creative works of their employees was not as revolutionary as one might think.³⁸

36. See *infra* notes 73-75 and 101-118.

37. See SAINT-AMOUR, *supra* note 3, at 124-63.

38. The dichotomy between authors’ rights and corporate rights in intellectual property is not a uniquely Anglo-American phenomenon and has therefore received attention from continental European courts and scholars as well. In France and Germany, in contrast to Britain and the United States, the conceptual starting point for protecting intellectual property rights in writings is the inalienable and personal right of the natural person who is the actual creator of the work. In the common law countries, the starting point is protection of the value of the work. Given the focus on authors’ rights in civil law regimes, the development of an allocation rule of employer ownership would be particularly vexing. In Germany and France, the law limits the ability of legal entities to be copyright owners more strictly than the law in the United States and the United Kingdom. For the most part, the principle of employer ownership seems to have been achieved through notions of implied contract or implied assignment. But what is significant for present purposes is that scholarship on civil law authors’ rights regimes argues that “the present-day opposed approaches of the civil law and common law systems on the question of corporate ownership of rights are of a comparatively recent date and not rooted in the origins of the two systems.” Gillian Davies, *The Convergence of Copyright and Authors’ Rights—Reality or Chimera?*, 26 INT’L REV. OF INDUS. PROP. AND COPYRIGHT L. 964, 972 (1995); see also Thomas K. Dreier, *Authorship and New Technologies from the Viewpoint of Civil Law Traditions*, 26 INT’L REV. OF INDUS. PROP. AND COPYRIGHT L. 989, 989-94 (1995).

The concept of the individual author’s inalienable moral rights developed in France and Germany in the nineteenth century, just at the same time that corporate ownership of copyrights developed in the United States. See GILLIAN DAVIES, *COPYRIGHT AND THE PUBLIC INTEREST* chs. 6-7 (1994). More significantly, there have always been counter examples in both regimes—of employer ownership in the United States even in the antebellum period and of legal entity ownership in Germany and France.

In Britain, the law was relatively similar, including the rise of contract concepts in the mid-nineteenth century and the vagueness about what kinds of circumstances would give an

It is important to remember that what courts said the default rules were and what employers thought they were may have differed. As Zorina Khan has demonstrated, between forty-four and forty-nine percent of copyright registrations between 1790 and 1800 were by a person *other than* the actual author.³⁹ (At that time, one had to register in order to obtain a copyright; today, registration is no longer required.) A significant number of registrations were for works other than the kinds of books that typically would have an individual author; they included maps and charts, dictionaries, and directories.⁴⁰ It is reasonable to suppose that among these, some employers were registering the copyright to works that persons in their employ had created, at least in part. It is unclear whether all those registrations were pursuant to an express assignment by the employed author. Absent an express assignment, however, the scant case law suggests employers might not have been able to obtain a copyright for a work prepared by an employee. In *Binns v. Woodruff*, Justice Washington, sitting as a circuit judge, held that one who employed others to create an elaborately decorated print of the Declaration of Independence could not obtain a copyright because he had neither designed, drawn, nor engraved the work and thus was not an author as required by the statute.⁴¹

In the face of a dearth of legal or business archival evidence of how firms handled employee copyrights, two somewhat contradictory facts appear. First, compared with today, relatively few kinds of works were subject to copyright (the first Copyright Act of 1790 provided for copyright only in maps, charts, and books)⁴² and there were relatively few copyright registrations in the antebellum

"implied" contractual right to the employer. EATON S. DRONE, A TREATISE ON THE LAW OF PROPERTY IN INTELLECTUAL PRODUCTIONS IN GREAT BRITAIN AND THE UNITED STATES EMBRACING COPYRIGHT IN WORKS OF LITERATURE AND ART, AND PLAYRIGHT IN DRAMATIC AND MUSICAL COMPOSITIONS 243-53 (Boston, Little Brown, 1879). I discuss Drone's treatise *infra* beginning at note 162. But in countries with a stronger emphasis on authors' rights, the story seems to have been somewhat different. In France and Germany, to varying degrees, employee-authors were entitled to the copyright, and employers could obtain the copyright only by express or implied assignment. As the moral rights concept developed in both countries over the course of the nineteenth century, the employee's rights *increased*, for moral rights are inalienable. Yet, at the same time, courts in France, Britain, and Germany employed similar implied contract concepts to transfer, as a matter of law, or at least without any express *agreement* between employer and employee, whatever rights could be transferred from the author to another. *See generally* Davies, *supra*, at chs. 2-3.

39. KHAN, *supra* note 7, at ch. 8, tbl. 1.

40. *Id.* In the period from 1790 to 1800, for example, 17% of the registrations were for dictionaries, directories, atlases, maps, and works of "commerce." Among books that likely had individual authors, 14% were for what Khan calls "social and political" books and another 17% were for textbooks. Eleven percent were for music, poetry, and plays, and 5.7% were for law books. *Id.*

41. *Binns v. Woodruff*, 3 F. Cas. 421 (C.C.D. Pa. 1821) (No. 1424).

42. Act of May 31, 1790, ch. 15, 1 Stat. 124.

period. Second, copyright played a relatively minor role even in those few employment settings in which people were paid by others to create material subject to copyright protection. Although the case law did not recognize an employer's right to employee works until the late nineteenth century, persons not the authors frequently registered copyrights, and it is reasonable to infer that they were registering the copyright in works created by their employees. Thus, employers may have contracted around the default rule or may simply have assumed that the default was precisely the opposite of what it was.⁴³

B. Authors, Owners, and, American Law Publishing: Wheaton v. Peters and the Early Rise of Employee Authorship

One of the most pressing needs of the early American legal community was to develop an adequate system for the reporting and publication of the new American law. It turned out to be a struggle to find enough competent people to report the decisions of the various state and federal courts. Even more difficult was finding printers willing to print the reporters' work at a price that lawyers would pay and to develop a plan for distributing the books once printed. A system, if one can call it that, emerged whereby lawyers interested in the work of the court obtained some sort of appointment from the judges (and, in some states, the legislature) as the official reporter of the court, and it was up to the lawyer to find a printer who would print the reports at a price and quantity to fulfill the reporter's obligation to the court and to enable the reporter to sell enough to make a profit to support himself. The court reporters in these years were not exactly employees of the court; neither the court nor the government paid a salary. They were independent contractors in the modern parlance, although in some jurisdictions they were also office holders.⁴⁴

43. Doctrine and practice were not necessarily inconsistent, in the sense that courts acknowledged the legitimacy of express contracts assigning the copyright to the employer. However, without knowing whether early copyright registrations by employers were pursuant to an express agreement, it is difficult to know whether the court's description of the default rule was consistent with the practice of employer registrations or not.

44. On early American law publishing, see EDWIN C. SURRENCY: *A HISTORY OF AMERICAN LAW PUBLISHING* (1990). On the law reports and law reporters of particular courts and states, see Ann Fidler, "Till You Understand Them in Their Principal Features": *Observations on Form and Function in Nineteenth-Century American Law Books*, 92 BIBLIOGRAPHY SOC'Y AM. 427 (1998); Joel Fishman, *The Digests of Pennsylvania*, 90 LAW LIBR. J. 481 (1998); Joel Fishman, *The Reports of the Supreme Court of Pennsylvania*, 87 LAW LIBR. J. 643 (1995); Craig Joyce, *The Rise of the Supreme Court Reporter: An Institutional Perspective on Marshall Court Ascendancy*, 83 MICH. L. REV. 1291 (1985); John H. Langbein, *Chancellor Kent and the History of Legal Literature*, 93 COLUM. L. REV. 547 (1993); Kurt X. Metzmeier, *Blazing Trails in a New Kentucky Wilderness: Early Kentucky Case Law Digests*,

The first American copyright case in which the author was hired to write was the famous dispute between the third and fourth reporters for the U.S. Supreme Court, Henry Wheaton and Richard Peters.⁴⁵ More accurately, *Wheaton v. Peters* was a dispute between the publishers of the reporters, for just as in the famous eighteenth-century English copyright disputes that established the author's copyright, Wheaton the author had assigned his copyright to his publisher, and it was the publisher who litigated the suit. *Wheaton v. Peters* was also the Supreme Court's first intellectual property decision.⁴⁶ Although it is famous for its rejection of the notion that courts could confer common law copyrights in circumstances where the statutory requirements were not met, a less well-known aspect of the opinion was its assumption that reporters of judicial decisions were entitled to copyright their work.

Henry Wheaton was the reporter of decisions of the Supreme Court from 1816 to 1827, the third in the Court's history.⁴⁷ After Richard Peters became the reporter in 1827, he published and sold a volume called *Condensed Reports of Cases in the Supreme Court of the United States* containing all the Court's decisions from its founding until 1827, including Wheaton's. Wheaton sued Peters for copyright infringement, and Peters argued that Wheaton (actually, his publisher) had not complied with the statutory procedures for registering a copyright, and that the copyright was therefore void.⁴⁸ The Court remanded for factual findings on the adequacy of Wheaton's efforts to register the copyright.⁴⁹ The Court's opinion assumed that if his efforts were sufficient, he would have a valid copyright, notwithstanding his employment or appointment as reporter for the Court.⁵⁰ His status—whether employee or appointed officer of the Court or of the United States—was, in the Court's view, irrelevant to his copyright claim. Nor did the Court mention whether Wheaton's claim to the copyright was based on a contract, on the Reporters Act of 1817 (which said nothing about copyright),⁵¹

93 LAW LIBR. J. 1 (2001); and Edwin C. Surrency, *Law Reports in the United States*, 25 AM. J. LEGISLATIVE HIST. 48 (1981).

45. *Wheaton v. Peters*, 33 U.S. 591 (1834).

46. My account of *Wheaton v. Peters* draws heavily on EDWARD WHITE, THE MARSHALL COURT AND CULTURAL CHANGE, 1815-1835, at ch. 6 (1988) and Joyce, *supra* note 44.

47. Alexander Dallas and William Cranch, Wheaton's predecessors, reported the Court's decision before 1816. After serving, like them, in an uncompensated and unofficial capacity beginning in 1816, Wheaton became the Court's first official reporter in 1817 after Congress enacted a statute providing for an official reporter of the Supreme Court's decisions. See WHITE, *supra* note 46, at 389-90; Joyce, *supra* note 44, at 1343.

48. 33 U.S. at 634-35.

49. *Id.* at 667.

50. *Id.* at 668.

51. See *infra* note 54.

or on other terms of his appointment as the reporter. His right to the copyright was simply assumed, provided he had complied with the statutory registration procedures.

Wheaton had himself assumed he owned the copyright in his reports.⁵² The first Term during which Wheaton was the reporter ended in March 1816, and by early May, Wheaton had the volume ready to publish. But he could find no publisher willing to print it. He finally was forced to give the copyright to the Philadelphia bookseller Matthew Carey in order to persuade Carey to print it, and Carey paid only \$1200 in notes for all the rights.⁵³ Wheaton was not unreasonable in thinking he owned the copyright to the volume. In the first place, Congress had resisted his requests to vote him a formal title and salary as reporter,⁵⁴ and, in the second place, his first volume contained 487 pages of abstracts, arguments, and opinions and forty-six pages of notes; the abstracts, arguments, and notes were, of course, largely Wheaton's writing rather than the Justices'.⁵⁵

Yet in another sense, his employment status had the potential, realized in later cases involving reporters of decisions,⁵⁶ both to strengthen and to weaken his claim to the copyright. In particular, the Court stated "no reporter has or can have any copyright in the written opinions delivered by this court; and . . . the judges thereof cannot confer on any reporter any such right."⁵⁷ Wheaton could copyright whatever he added: headnotes, a summary of the decision, arguments of counsel, pagination, and perhaps even his report of opinions rendered orally. He simply could not copyright the Justices' own work.

As to the parts of the reports that were not opinions, the Court surely had no doubt that Wheaton's work was "authorship" in the sense that would ordinarily entitle him to copyright protection.⁵⁸ Wheaton's industry and erudition in writing the marginal notes and the appendices on admiralty and prize law were plain to all. The

52. So, indeed, did the Justices and both the members of Congress who supported the Reporters Act of 1817 and those who opposed it on the ground that it was unnecessary to pay a salary to the Reporter. *See* WHITE, *supra* note 46, at 389-90.

53. Joyce, *supra* note 44, at 1326.

54. *Id.* at 1325. The Reporters' Act of Mar. 3, 1817, ch. 63, 3 Stat. 376 provided a salary of \$1000 per annum, but Wheaton had been employed before that to prepare the first volume at no salary. As to every year after 1817, Wheaton argued that the \$1000 was "unequal to the labour and time" and was, in any event, compensation for the eighty volumes that the statute obliged him to deliver to the government. 33 U.S. at 614.

55. Joyce, *supra* note 44, at 1327. In fact, some were anonymously written by Justice Story, who gave them to Wheaton to assist him in publishing the Reports. *Id.*; WHITE, *supra* note 46, at 391, 393, 402.

56. *See infra* text accompanying notes 64-67.

57. *Wheaton*, 33 U.S. at 668.

58. *See* WHITE, *supra* note 46, at 390-91.

Court recognized these as his valuable work. And, inasmuch as he was not being compensated for writing them, it would be inconceivable to say that the copyright was not his. Besides sympathy for him, there would also be the instrumental concerns—if he could not sell the copyright to the printer, there would be no printer willing to print, and the opinions would never be disseminated.⁵⁹ It might also have mattered, as the Justices no doubt knew, that the very limited market for law books made the risk of copying seem quite remote.⁶⁰ And finally, there would be the matter of the Justices' respect and affection for Wheaton. He was a personal friend of Story's; indeed, they were roommates at the Washington boarding house where all the Justices stayed during the Term.⁶¹

It was obvious why Wheaton could not copyright the Justices' opinions without their consent, but the Court went further: The Justices could not confer a copyright on the reporter.⁶² The Court did not explain why, although later courts explained that judges could not copyright their written opinions because they were public servants.⁶³ But so were reporters. What was the difference? Two rationales are possible, though neither was offered in the Court's opinion in *Wheaton v. Peters*. One was that law reports, like judges' opinions, could not be copyrighted because they were either not a proper subject of property or should be the "property" of all. In this

59. *Wheaton v. Peters* seems an apt example of why the initial allocation of intellectual property rights as between employer and employee can matter. First of all, the early nineteenth-century judicial mind did not equate allocation of "authorship" as the legal equivalent of allocating rights in Blackacre. Second, the Justices had institutional reasons to insist that Wheaton was the "author" and therefore the initial copyright owner of his Reports. The Justices thought it mattered a great deal whether they, the people of the United States, or Wheaton had the initial entitlement to copyright, for only Wheaton was in a position to negotiate with printers like Matthew Carey to publish and distribute the Reports.

60. See WHITE, *supra* note 46, at 389.

61. See Joyce, *supra* note 44, at 1313, 1322. On the effect of the boarding house residence on Marshall Court practice, see WHITE, *supra* note 46, at 160-61, 190-91.

62. 33 U.S. at 668.

63. Today, there can be no copyright at all in works produced by U.S. government employees. 17 U.S.C. §§ 101, 105. Section 105 provides that copyright protection "is not available for any work of the United States Government," and § 101 defines such works to include "a work prepared by an officer or employee of the United States Government as part of that person's official duties." The legislative history of the 1976 revision of § 105 states that the concept should be construed "in the same way" as works made for hire. H.R. REP. NO. 94-1476, at 59 (1976). The purpose of § 105, according to the legislative history of the 1976 Act, was "to place all work of the United States Government, published or unpublished, in the public domain." *Id.* The predecessor to § 105 first appeared in the Printing Act of 1895, ch. 23, 28 Stat. 601 (1895), and was recodified and retained unchanged in the 1909 Copyright Act. Act of Mar. 4, 1909, ch. 320, 35 Stat. 1075. See H.R. Rep. No. 60-1 (to accompany house bill H.R. 28192, Feb. 1909). Even prior to 1895, there was some recognition that copyrighting federal government materials was problematic. See Robert M. Gellman, *Twin Evils: Government Copyright and Copyright-Like Controls Over Government Information*, 45 SYRACUSE L. REV. 999 (1995).

view, the nature of the written product as law makes it unfit for copyright—the law must be in the public domain so that it is free for all to use, quote, reproduce, and disseminate widely.

A second rationale might be that judges could not obtain copyright and thus could not assign it to reporters because they were public servants and their “employer,” the U.S. government, could be the only proper owner of the copyright. As public servants, the judges could not acquire the copyright in the work they were employed to do—the preparation of opinions—and thus had no rights to confer upon the reporter. If that were the rule the Court adopted, then it might mean more generally that employment to create copyrighted works should be deemed to constitute an assignment of the copyright to the employer.

The one case that did adopt such a rule was based both on an express contract and on a statute providing that the reporter of decisions of the New York Court of Appeals would not obtain a copyright to his notes, to his reports, or to the references he compiled. The view that judges, as public servants, could have no copyright in their opinions to assign to the reporter because the judges’ employer—the state government—should own the copyright was thus not a default rule in the case.⁶⁴ Indeed, the underlying contract between the reporter and the New York Secretary of State contained an assignment of the copyright to the Secretary of State, which suggests that both the reporter and the Secretary of State may have believed that the reporter would, absent the contract, have a copyright to assign.

No nineteenth-century case read *Wheaton v. Peters* to hold that judges, as “employees” of the government, could not confer a copyright on the reporter because the copyright was not the judges’ to confer. A few cases adopted at most a hybrid, but did so only much later. For example, in *Banks v. Manchester*, the Supreme Court held that the reporter of Ohio could not enjoin the copying of the official reports:

In no proper sense can the judge who, in his judicial capacity, prepares the opinion or decision, the statement of the case, and the syllabus, or head-note, be regarded as their author or their proprietor . . . so as to be able to confer any title by assignment on the states, sufficient to authorize it to take a copyright for such matter *Judges, as is well understood, receive from the public treasury a stated annual salary, fixed by law, and can*

64. *Little v. Gould*, 15 F. Cas. 612, 613 (C.C.N.D.N.Y. 1852) (No. 8395). Other phases of the litigation over the copyright to the reports were published as well. *Little v. Hall*, 59 U.S. 165 (1855); *Little v. Gould*, 15 F. Cas. 604 (C.C.N.D.N.Y. 1851) (No. 8394).

themselves have no pecuniary interest or proprietorship, as against the public at large, in the fruits of their judicial labors.⁶⁵

Although the second, italicized part of the passage suggests employment as a public servant rendered one unable to obtain a copyright, the first part of the passage suggests that even the government cannot obtain one. It suggests that opinions prepared by judges are essentially and inherently common property and can be copied by anyone, a rule that was codified as regards U.S. government documents in the Printers Act of 1895.⁶⁶ Moreover, by 1888, courts had begun to see and enforce employees' agreements to assign copyrights. From there it was not a large step to conclude that the contract of employment itself might in particular cases operate as an assignment agreement.

The predominance of disputes involving reporters of appellate decisions in the early cases played a significant role in shaping the law. Although judges no doubt understood them as public servants, they were not the judges' own servants, nor were they "servants" in the conventional sense. They were men of stature and education, trained in the law, whose diligence, analytic skills, and attention to detail were crucial in the dissemination of the law. Their work was also essential to the edification of the bench and bar. They were far too important for judges to see them as servants or to compromise their independence by restricting their claim to copyright. In many cases, their relations with their "employer"—the court or the government—more closely resembled what today would be deemed an independent contractor relationship. In the early nineteenth century, master-servant law applied only to masters and servants, not to every person who worked for someone else, and there was no unified body of law that applied to all who worked for others.⁶⁷ By the late nineteenth century, courts began to apply master-servant principles to all kinds of employed persons. They thus effaced the distinctions of status and independence that previously had accorded different rights to different kinds of persons and replaced them with a uniform body of law that translated rights and obligations previously determined as a matter of status into implied contractual terms. But since the early employee copyright cases had involved persons who would not be governed by the hierarchical rules of

65. 128 U.S. 244, 253 (1888) (emphasis added).

66. See Gellman, *supra* note 63, at 1002-05, 1023-24 & n.102.

67. See DAVID GIBBONS, RUDIMENTARY TREATISE ON THE LAW OF CONTRACTS FOR WORKS AND SERVICES 54, 109 (London, John Weale 1857) (contrasting obligations owed by contractors and those owed by servants); HORACE GAY WOOD, A TREATISE ON THE LAW OF MASTER AND SERVANT 2-3 (Albany, J.D. Parsons, Jr. 1877). See generally CHRISTOPHER L. TOMLINS, LAW, LABOR, AND IDEOLOGY IN THE EARLY AMERICAN REPUBLIC (1993).

master and servant, the courts did not apply the assumptions of master and servant law in deciding the respective rights of the hired person and the hiring party. As a result, the relatively pro-employee rules became settled doctrine, only to be changed at the beginning of the twentieth century once the distinction between employees and independent contractors emerged.

Judges probably also understood more clearly in the case of reporters than in the case of almost any other occupation how crucial allocation of copyright ownership was to the economics of law publishing. Granting the reporter the copyright was in lieu of paying a more generous compensation from the public fisc. In an era in which government was quite limited in its ability to raise revenue to fund a judicial bureaucracy, judges doubtless were reluctant to interfere with the scheme by which reporters could be compensated from sources other than a full salary paid from the treasury. Perhaps judges understood that the willingness of competent, educated men to take on the task depended on their ability to make a profit. The speedy publication and distribution of reports necessary to the law's development may also have benefited from the reporter's industry and been spurred on by the profit motive.

Although law publishing cases dominated the early development of employee copyright law, one other decision from this era took a similar position. Judicial solicitude for the rights of employee authors was thus not entirely the result of concerns about law book publishing. *Pierpont v. Fowler*, a case between an author who had been commissioned to write school books and the person who hired him, presented the question of whether the author or the employer had the right to obtain the renewal term.⁶⁸ The court concluded that the renewal rights did not pass with the contract assigning the initial copyright to the employer.⁶⁹ In explaining the result, the court emphasized the importance of authors' rights:

It was the genius which conceived and the toil which compiled the book that is to be rewarded by even the first copyright, and no one ever dreamed that an assignee could alone take out the second or extended term, unless he has paid for it, clearly contracted for it [I]f such a hirer of others was entitled before to take out a copyright, how does this act encourage and aid genius? It rather aids those kinds of patrons, who fatten on the labors of genius.⁷⁰

68. 19. F. Cas. 652, 14 Copyright Dec. 2075 (C.C.D.Mass 1846).

69. 14 Copyright Dec. at 2088-89.

70. 14 Copyright Dec. at 2087-88.

The court appeared to be more concerned with protecting authors from bad bargains than with facilitating the development of the publishing business.⁷¹

C. Commissioned Works and the Relationship Between Playwrights and Theaters

If the first cases involving law publishing are the antecedents of the branch of work-for-hire doctrine involving employees, the other branch of modern work-for-hire doctrine—commissioned works—had its origins in a different line of cases that began in this early period as well. These were the cases involving playwrights and composers commissioned by theater managers or owners to write a play or adapt or compose a musical score for performance at the theater. During this period, the playwright or composer invariably acquired the copyright unless the parties agreed otherwise in writing.

There is an interesting irony in the courts' insistence that the playwright owned the copyright rather than the theater owner, for in the 1840s and 1850s the playwright had yet to obtain the status of genius artist that people later accorded to Ibsen, Shaw, or O'Neill. Theater in the 1840s was hardly considered art. An evening's bill might last four to six hours and include a main piece, a curtain-raising farce, and a closing burletta. The audience wanted to see comedy, melodrama, and extravaganzas with spectacular effects.⁷² In that context, the playwright was a sort of "handyman to the company. He existed to make their performance possible, rather than they to interpret his work to an audience."⁷³

Yet this was beginning to change around 1860, and one of the moving forces in that transformation was both an important litigant and one of the most prominent playwrights, actors, and theater managers of the era: Dion Boucicault. What is particularly interesting is that the ambiguous roles of playwright, actor, and theater manager in that era were reflected in the ambiguous approaches of the courts to the allocation of intellectual property

71. The restriction of the assignment of renewal rights, so as to protect authors from improvident bargains made when the value of a copyrighted work was unknown, was a pervasive concern in copyright law into the twentieth century. *See infra* note 224. Thus, one ought not read the case as being just about employment, but also about the concern for protecting all authors—employees or not.

72. On the evolving nature of melodrama in the mid-nineteenth century, see BRUCE A. MCCONACHIE, *MELODRAMATIC FORMATIONS: AMERICAN THEATRE AND SOCIETY, 1820-1870* xii-xiii, 242-43 (1992). On Dion Boucicault's use of sensational melodrama, see James Hurt, *Dion Boucicault's Comic Myths*, in *WHEN THEY WEREN'T DOING SHAKESPEARE: ESSAYS ON NINETEENTH-CENTURY BRITISH AND AMERICAN THEATRE* 253 (Judith L. Fisher & Stephen Watt eds., 1989).

73. ROBERT HOGAN, *DION BOUCICAULT* 30 (1969) (quoting GEORGE ROWELL, *THE VICTORIAN THEATRE, A SURVEY* 1 (1956)).

rights in plays. Though the playwright may have worked for the company or the theater, some playwrights such as Boucicault were beginning to enjoy a certain celebrity status and to assert their entitlement to copyright their works (even when they plagiarized from others and were paid to do so by a theater). If, as in the case of Laura Keene discussed below, the playwright, the actor, and the theater manager were one and the same, and the competing claimant was an actor in her company, the courts saw the entitlement to copyright very differently.

The earliest case involving a commissioned work was *Atwill v. Ferrett*, a theater case which stated a general rule that the writer of an opera was the author, even if the work was commissioned by another.⁷⁴ The opinion also stated, however, that since the theater manager who had commissioned the work had been so involved in modifying the opera, he was entitled to a copyright in the version performed in his theater. The plaintiff, Atwill, sought to produce in New York an opera, *The Bohemian Girl*, that had been composed and performed in Europe. He commissioned an unnamed third party to compose an arrangement of the opera, and Atwill copyrighted the new arrangements in his own name. The defendants copied and sold the plaintiff's arrangements and, in demurring to the infringement suit, argued that the plaintiff's copyright was void as he was not the composer. The plaintiff's counsel argued that, under English law, one could secure the copyright in works he had commissioned others to create. The court rejected the contention. In the court's view, the English cases

recognize the right of authorship, although the materials of the composition were procured by another, and also an equitable title in one person to the labors of another, when the relations of the parties are such that the former is entitled to an assignment of the production. But, to constitute one author, he must by his own intellectual labor applied to the materials of his composition, produce an arrangement or compilation new in itself.⁷⁵

The cases cited, according to the court, related to "new productions arranged or compiled from materials before known, or obtained by others for the author, and not to the appropriation by copyright of those materials in the same state in which they are furnished."⁷⁶ The court ultimately determined that the plaintiff's

74. 2 F. Cas. 195 (1846).

75. *Id.* at 197-98.

76. *Id.* at 198.

allegations of having added to and altered the music were legally sufficient to constitute him the author. It cautioned, however, that if the plaintiff's title had rested only on his having commissioned the composition, his claim would have been defective. In short, although the court was prepared to recognize as a matter of equity that an author might have a duty to assign the copyright in a work he had been commissioned to create, the law of copyright recognized no principle that employment or a commission to create by itself entitled the employer to the copyright. The court simply asserted, without defending the proposition, that only intellectual labor could make one an author.

The irony of *Atwill v. Ferrett* is palpable. Notwithstanding the court's insistence that only intellectual labor could make one an author, both the plaintiff and the unnamed third-party author of the arrangement of the opera were pirating it from the European composer and librettist. They were not alone: American book publishers and theater managers were notorious in their liberal reprinting of works that appeared abroad. As described below, Dion Boucicault, who fought so hard for improved American copyright protection for authors, freely borrowed from others. Yet what is significant about *Atwill* is the clear statement of law: employers acquired a claim to the copyright based only on their intellectual contributions, not by virtue of having paid the employee to create.

The same principle of employee ownership was asserted in another case fifteen years later, in a dispute between the copyright owner of a book and newspaper publishers who allegedly printed the entirety of the book in the papers. In *De Witt v. Brooks*, the plaintiff registered a copyright in a book about the life and exploits of a pirate.⁷⁷ Part of the book was allegedly written by the pirate himself, part was the pirate's alleged confession to a Deputy U.S. Marshal, and part was a description of the "phrenological character" of the pirate "as described by L.N. Fowler, Office U.S. Marshal."⁷⁸ Although the court's opinion has been lost, the headnotes state that the court held that the plaintiff could not maintain the action for infringement because he was not the author: "The literary man who writes the book and prepares it for publication is the author, and the copyright is intended to protect him and not the person who employed him."⁷⁹

77. 7 F. Cas. 575 (C.C.S.D.N.Y. 1861). The report in *Federal Cases* contains only the headnotes. 13 Copyright Dec. 756 contains the declarations of the plaintiff and the defendants and a note indicating that the opinion of the court has been lost.

78. 13 Copyright Dec. at 757.

79. 7 F. Cas. at 575.

D. Cartography and Copyright: The Making and Publishing of Maps and Charts

Unlike other industries described in this paper, there appears to have been little reported litigation over the copyrights to maps. Nonetheless, map-making is an important counterpoint to law publishing and theater in a study of copyright. The available evidence suggests that employers may have obtained the copyrights to the works of their employees even if the legal rules described above would suggest they were not entitled to them.

The first American copyright act mentioned only books, maps, and charts among the works subject to copyright. It was not established until the mid-nineteenth century that music and art could be copyrighted. Photography, lithography, and other media followed in the late nineteenth and early twentieth centuries.⁸⁰ Maps and charts were in great demand in early America because of the rapid expansion of white settlements into new regions, the development of roads, canals, and railroads, and the absence of a long-established collection of maps for the white population. Especially noteworthy for my purposes, the making of all but the most rudimentary maps required the efforts of many people, including surveyors, draftsmen, and printers.

My study of the cartography literature suggests that this is a field where, from the beginning, the person or firm who managed to organize the collective effort of the surveyors, draftsmen, and printers was the one who claimed the copyright. The secondary literature does not reveal, however, whether the person or firm who claimed the copyright contracted with the various contributors to assign whatever rights they might have, or whether they simply assumed they owned it.

For the most part, mid-nineteenth-century cartography seems to have been characterized by small enterprises: partnerships, sole proprietors, and, later, small corporations.⁸¹ The publisher—often one or two individuals, sometimes a firm—usually claimed the copyright.⁸² What the publisher did to merit such a claim varied. A

80. See 4 Stat. 436 (1831) (music); 11 Stat. 138 (1856) (dramas); 13 Stat 540 (1865) (photographs); 16 Stat 212 (1870) (painting, drawing, and sculpture); 31 Stat 488 (1912) (motion pictures).

81. See WALTER W. RISTOW, *AMERICAN MAPS AND MAPMAKERS: COMMERCIAL CARTOGRAPHY IN THE NINETEENTH CENTURY*, 20-23 (1985); JOHN RENNIE SHORT, *REPRESENTING THE REPUBLIC: MAPPING THE UNITED STATES, 1600-1900* (2001).

82. See, for example, the discussion of Henry Francis Walling and his “Map Establishment” in New York City. RISTOW, *supra* note 81, at 332. Some of his maps stated that the surveys had been made “under the direction of H.F. Walling”; some have the imprint, “Engraved, Printed, Colored Mounted at H.F. Walling’s Map Establishment”; and some have the imprint “Walling & Rice, Publishers.” *Id.* See also Judith A. Tyner, *Images of the*

single person seldom did all the actual work of surveying, drafting, and design. Although one person could map a town or village with a compass and odometer, larger maps would require the work of more than one surveyor. Maps frequently gave credit to the engraver or lithographer, but not to the draftsmen or surveyors. In some cases, an individual who sought to publish a map did the surveying and drafting himself and contracted with an engraver, lithographer, or printer to manufacture it.⁸³ In others, a publisher with no professional training or experience in cartography or surveying staked his claim to the status of publisher based on his knowledge of map reproduction and printing.⁸⁴

Even before some map publishers grew quite large—Rand McNally was publishing a very large number of maps by the 1870s—the practice of not crediting the contributions of all but the supervising engraver was well established. Even during its early years, Rand-McNally did not identify the compilers, cartographers, or draftsmen who helped create its maps. At most the published maps credited the supervising engraver. An 1876 map said, for example, “engraved under the direction of C.H. Waite.” Immediately below that line, however, the map’s title cartouche read, “Drawn, Engraved and Printed in Colors (under Letters Patent) by RAND McNALLY & CO. Chicago.”⁸⁵

Cartography would seem to be a promising area for the study of copyright and the social construction of knowledge in the work relationship. The creative process is inherently collaborative and usually builds—explicitly or tacitly—on past work. Cartography has been thoughtfully analyzed from this perspective, but the full implications of their insights have been suggested rather than studied.⁸⁶ J. Brian Harley has written that,

Southwest in Nineteenth-Century American Atlases, in THE MAPPING OF THE AMERICAN SOUTHWEST 57, 60-77 (Dennis Reinhartz & Charles C. Colley eds., 1987) (discussing various atlases from 1817 to the 1880s).

83. Henry Francis Walling used this method, for example. See RISTOW, *supra* note 81, at 327.

84. Robert Pearsall Smith is an example. See RISTOW, *supra* note 81, at 339-53. Another prominent example was Matthew Carey, one of the leading publishers in Philadelphia and, hardly coincidentally, the publisher of Wheaton’s Reports of the Supreme Court decisions. See *supra* text accompanying notes 44-62.

85. RISTOW, *supra* note 81, at 471-72. The patents were presumably for the color printing process. A similar phenomenon regarding authorship—usually, but not always, the publisher claimed it—may be seen in the maps of the American Southwest discussed in Tyner, *supra* note 82, at 57, 60-77.

86. See, e.g., J.B. HARLEY, THE NEW NATURE OF MAPS: ESSAYS IN THE HISTORY OF CARTOGRAPHY 35-36 (Paul Laxton ed., 2001); SHORT, *supra* note 81, at 34 (arguing that “the illusion of single authorship” and that “maps resulted solely from the gaze of the Western observer” are two misconceptions about early American maps, but that maps were often

far from holding up a simple mirror of nature that is true or false, maps redescribe the world—like any other document—in terms of power and of cultural practices, preferences, and priorities. What we read on a map is as much related to an invisible social world and to ideology as it is to phenomena seen and measured in the landscape.⁸⁷

He also noted that, “more than many other texts, maps are thus mediated by a series of technical activities, each performed by a different ‘author.’”⁸⁸ Cartographers evidently debate the extent to which copyright should restrict later cartographers from using earlier maps.⁸⁹ Yet, the dearth of reported litigation suggests that proof of infringement was either so difficult or so easy as to make few cases uncertain enough to require litigation to a published disposition.

The paucity of reported decisions involving disputed claims to copyrights in maps or charts suggests that the question of map copyright ownership appears to have been resolved significantly through self-help.⁹⁰ The evidence that does exist is somewhat contradictory. On the one hand, there is the case of Abraham Bradley, Jr., Assistant Postmaster General in the late eighteenth century, who obtained one of the earliest copyrights for a map in U.S. history.⁹¹ Bradley obtained information from postmasters in various parts of the country, and it was their work—the fact that his map was based on new information rather than on previously published maps—that distinguished it from maps published before. Significantly, although Bradley obtained the information on which his map was based from government officials in connection with his official duties, he copyrighted it in his own name and published it privately.

In some respects, he was like the reporters of decisions, in that he was copyrighting a work produced during the course of his government employment, and he was even more of an “employee”

composites building on earlier maps, the notes and sketches of travelers, and the reports of indigenous peoples).

87. HARLEY, *supra* note 86, at 35-36.

88. *Id.* at 38.

89. See, e.g., *id.* at 199 (referring to “the perennial copyright problem,” but suggesting that a more pressing ethical issue for cartographers should be the political and social judgments they make when they draw maps, such as when cartographers of South Africa made the white urban areas the center of city maps and the black townships all but invisible).

90. The editors’ note following one case stated that “[t]he publication of a map made from materials collected while in the service of the government as draughtsman belongs to the government.” *Chapman v. Ferry*, 12 F. 693, 696 (C.C.D. Ore. 1882). However, the report of the case indicates it concerned available remedies for copyright infringement rather than ownership of the copyright as between employer and employee. *Id.* at 695.

91. This 1796 map was obviously the product of work by postal employees. My account draws primarily on RISTOW, *supra* note 81, at 20, 70.

(and less an “independent contractor”) than they were. It may be that the Post Office concluded, just as the courts had, that allowing government employees to copyright their work would be most likely to ensure that the map would be published and distributed widely to those who might benefit from it. Although Bradley’s chart became the official map of the United States Post Office around 1825, the nature of his understanding with the Post Office about ownership and use of the map is not known. Bradley had practiced law before his appointment to the Post Office Department, which may explain his interest in asserting his legal rights to the map. His legal experience is also likely to have given him greater sophistication in negotiating over copyright than most employee authors had at that time.⁹²

Although Bradley’s exploits suggest a principle of employee ownership akin to those enjoyed by reporters and playwrights, a few cases and an attorney general opinion suggest a different rule regarding maps prepared by government employees. These cases might be read either as exceptions to the early rule of employer ownership or as evidence of the coming of the transition period, since they were all decided in the late 1850s.⁹³

92. Other persons commissioned by the government to compile maps may also have claimed the copyright. The commander of the U.S. Army operations in Texas in 1849, General William Jenkins Worth, commissioned the Federal Indian Agent for Texas, Robert Simpson Neighbors, to determine whether troops could pass through Texas between the Pecos and El Paso. Neighbors recruited a former Ranger, John Salmon “Rip” Ford, to accompany him. Both Ford and Neighbors prepared reports; Ford’s report was incorporated into a pamphlet published in 1849 by a draftsman employed by the General Land Office named Robert Creuzbaur, who evidently sought to profit from sales of the pamphlet to the large number of people crossing Texas on their way to the California gold rush in 1849. The pamphlet was privately published in Austin and in New York in 1849. See Robert Sidney Martin, *United States Army Mapping in Texas, 1848-50, in THE MAPPING OF THE AMERICAN SOUTHWEST*, *supra* note 82, at 37, 42-43 & n.16. This article reveals nothing about the copyright on the map or about the nature of the employment relation (if any) between Ford, Neighbors, and the U.S. Army. I infer it was privately published because the citation is to a New York publisher and to Creuzbaur for the Texas publication. However, the maps prepared by Neighbors and Ford probably were incorporated, along with maps and surveys conducted by other Army personnel in 1848-1850, into a larger map that was presented to the Senate and printed by the War Department in 1850. *Id.* at 55-56 & n.50. Thus, the private publication and perhaps sale of the earlier version might not have been objectionable, since the U.S. Army obtained what it wanted in the process.

93. No provision in the early Copyright Acts addressed government maps. In *Atwill v. Ferrett*, the court mentioned in passing that “the title to road-books, maps & c., rests upon [the] principle” that one who, by his own intellectual labor, produces a new composition may claim the copyright even if others procured the materials for him. 2 F. Cas. 195, 198 (C.C.S.D.N.Y. 1846). The 1909 Copyright Act, repeating the prior rule established in the Printing Act of 1895, prohibited copyright in “any publication of the United States Government.” 17 U.S.C. § 8 (1909). See *supra* note 63. However, if a cartographer copyrighted the map before publication by the government, he might have retained the copyright, as § 8 also provided that “the publication or republication by the Government, either separately or in a public document, of any material in which copyright is subsisting shall not be taken to cause any abridgement of the copyright.” *Id.*

One 1858 case concerned a map made by a cartographer who had gathered his materials either while conducting surveys in the employ of the Commonwealth of Pennsylvania or while employed as a draughtsman “of a party working at her cost.”⁹⁴ The court held that all rights to the map were the property of the state, as all the results of his labor while in the state’s employ were state property.⁹⁵ An 1856 opinion letter written by Attorney General Cushing to Jefferson Davis, then serving as Secretary of War, concerned a man who had contracted with the government to engrave plates for a nautical chart, the original manuscript of which was the property of the United States. Attorney General Cushing opined that the engraver had no right to make prints from the engravings: “The printer, who is hired to print any of the works of Irving, Prescott, or Bancroft, might, with as much sense and reason, claim a copyright in them against the author, as Seibert can set up such claim here against the United States.”⁹⁶ But, unlike Bradley, he appeared to be copying an existing chart in a new medium rather than designing a new map from survey data; the different levels of originality in the mapmakers’ work might, therefore, explain the result as much as their employment status.

A case decided in 1857, concerning a field related to cartography, suggests the likelihood that surveyors, engravers, and printers may have explicitly agreed that copyrights would be owned by the publisher. In *Heine v. Appleton*, an artist named William Heine accompanied an expedition to Japan and the China Sea commanded by Commodore Perry.⁹⁷ The U.S. Government had funded the expedition, and Heine’s drawings were included in the expedition report to the Secretary of the Navy, which was published by order of Congress. When Heine later sought to enjoin publication of books containing his illustrations from the expeditions, the court denied the injunction on two alternative grounds. First, the court found that Heine and Perry had expressly agreed that Heine’s drawings would become the property of the U.S. government.⁹⁸ Second, the court found that, after the expedition, the defendants (publishers of the books) had paid Heine to modify several of the original drawings to make them suitable for inclusion in the books. At that time Heine had not claimed the copyright in the drawings. “It would be inequitable now to permit him, when he has been paid to aid in their

94. *Pennsylvania v. Desilver*, 3 Phila. 31, 14 Copyright Dec. 2039 (C.P. 1858).

95. *Id.* 14 Copyright L.Dec. (CCH) at 2039.

96. 7 Op. Att’y Gen. 656 (1856), 15 Copyright Dec. 3049.

97. *Heine v. Appleton*, 11 F. Cas. 1031 (C.C.S.D.N.Y. 1857).

98. *Id.* at 1032.

publication and sale, and has thus aided in their publication, with a view to their sale, to stop their sale, even if he had a valid copyright in them.”⁹⁹

Heine cannot be read as an early work-for-hire case in the modern sense of works-for-hire. Neither of *Heine*’s alternative holdings recognizes that the employer would own the copyright to employee drawings simply by virtue of employment. One holding relied on an express agreement and emphasized that Heine persuaded Commodore Perry to allow him to accompany the expedition only by promising that the government would own his sketches and drawings.¹⁰⁰ The other relied on the notion that Heine was estopped from seeking an injunction against publication of drawings because he had been paid to modify them for publication and had failed to claim a copyright.

At the very least, the example of cartography suggests that even during the mid-nineteenth century (and certainly later), the attribution of authorship and the ownership of copyright of works produced for commercial purposes depended on the nature of the work relationship and the creative process that occurred within it. The more likely that there were multiple creators, the more likely that copyright could be claimed by the coordinator of the creative effort rather than by other contributors. Had the cases that ended up in litigation forced courts to contemplate such a creative process, they might have crafted a different sort of default rule for all other cases involving the employment of creative people. Later in the century, when cases that involved collaborative creative processes in the workplace were litigated, courts struggled to decide whether

99. *Id.* at 1033.

100. The opinion explained the negotiations as follows:

Previous to the sailing of the expedition to Japan, the plaintiff applied to Commodore Perry, to be employed as an artist, and to accompany the expedition, as such [F]inally the commodore consented to receive him in the capacity of a master’s mate, on condition that he should sign the shipping articles as such master’s mate, and do whatever duties might be required of him, and be subject to all the rules and regulations of the squadron. When the commodore consented that the plaintiff might join the expedition, he informed him that all the sketches and drawings which should be made by any one attached to the expedition were to be the exclusive property of the government of the United States, and that no one could appropriate to his own use any sketch or drawing that might be made. To this the plaintiff gave his assent Upon the return of the expedition to his country, the sketches and drawings which the plaintiff made, were, with his assent, incorporated in the report made by the commodore to the secretary of the navy, and were placed at the disposal of congress; Under these circumstances, the plaintiff was not such author of the prints and engravings in question, as to be able to acquire an exclusive right to the same as author or proprietor, by virtue of the certificate of copyright which he obtained. The sketches and drawings were made for the government, to be at their disposal.

Id. at 1032-33.

these early precedents, which clearly articulated a rule of employee ownership, were distinguishable.

The change in default rules between the early nineteenth century and the early twentieth may be explained, in part, by a rise in the number of cases involving employees who participated in collaborative creative processes. The more the courts saw cases in which a number of people had contributed to the work, the more logical it was to accord the copyright to the representative of the collective—that is, the employer. On the other hand, the increasing presence of collaborative creation surely was not the only factor. As explained below, cases involving individual authors working alone (although in the employ of another) continued to dominate the field of employee-employer copyright litigation throughout the nineteenth century.

Prior to the Civil War, no court recognized that an employer was entitled to copyright the works of its employees simply by virtue of the employment; indeed, courts assumed just the opposite. It took an express agreement to assign the copyright to the employer, as in *Heine v. Appleton*, to persuade a court to conclude that an employer owned the copyright. The strikingly pro-employee law was a function of the elevated social status and independence of the “employees” who created the work, the judges’ assumptions about the nature of the creative process, instrumental concerns about facilitating book distribution, and the powerful rhetoric of authorship as highly personal intellectual labor.

III. THE PERIOD OF TRANSITION: 1860-1900

In the postbellum period, courts began to recognize the rights of employers in the copyrighted works of their employees. At the beginning, employer ownership was based on the existence of an express contract granting the employer the copyright or, in one case, on an equitable principle, not a copyright rule. By the end of the century, however, courts increasingly began to describe the employment relationship as a contract by which the employer acquired the rights to *all* of the employee’s work, including the copyrights. Furthermore, by the end of the century, corporations as employers came to the fore. In the earliest such cases, the personal involvement of the corporation’s president was identified as the basis for corporate copyright ownership, but in the twentieth century, courts came to understand that a corporation—the quintessential “corporate” (as in collective) author—should own the rights to the work created by all of the persons who worked for the corporation.

A. Civil War Theater and the Beginning of the End of Employee Ownership

A spate of theater cases decided in 1860, 1861, and 1862 began the transition from the old rule of authorial ownership to the modern rule of employer ownership. All involved actors-cum-theater managers who contracted with theater owners to write a play to be performed in the theater. The cases stated a rule that the employee/actor/stage manager owned the copyright and the employer at most had a license to perform it in that particular theater for that particular run. Yet the courts suggested the possibility for greater rights for theater manager/employers by emphasizing the contributions that they had made to the changes in the plays. Because these cases involved some of the most acclaimed actors of their day, it is unclear how much light they shed on how courts would (or did) handle anonymous, unreported cases involving litigants who were not celebrities.

The first two cases involved *The Octoroon*, written by the famous playwright and actor, Dion Boucicault. These cases should be understood in the context of their facts. Boucicault was famous and, at the time of the litigation, had already had plays produced in New York theaters. He had made his debut on the American stage in Boston and New York in 1854, he and his wife appeared in numerous plays he had written in the late 1850s, and he received significant attention for his successful play, *The Poor of New York*, which opened in 1857 at Wallack's theater in New York.¹⁰¹ Thus, at the time the pair of *Octoroon* cases were decided, Boucicault was hardly the ordinary, anonymous employee. He was something of a celebrity in American theater, and he was a recognized playwright (even if some took a dim view of the intellectual merit of Boucicault's work).¹⁰²

Boucicault had been active in a successful effort to secure improved copyright protection for American playwrights. Along with others, he had lobbied Congress to amend the law to provide for copyright protection in presentations of plays as well as in their texts; Congress enacted such a law in 1856.¹⁰³ Ironically, as one of Boucicault's biographers tartly observed, Boucicault fought for copyright revisions and litigated to protect his rights, yet "he had not

101. See generally RICHARD FAWKES, DION BOUCICAULT (1979); HOGAN, *supra* note 73.

102. Boucicault ranked only behind Shakespeare as the most frequently performed playwright in Philadelphia theaters between 1856 and 1878. The numbers were: Shakespeare, 2314; Boucicault, 1587; Tom Taylor, 934; J.B. Buckstone, 839; John Brougham, 829; and J.M. Morton, 652. BRUCE A. MC CONACHIE, MELODRAMATIC FORMATIONS: AMERICAN THEATRE AND SOCIETY, 1820-1870, at 241 (1992).

103. 11 Stat. 138 (1856).

the least hesitation in continuing his piratical raids on French dramatic literature and, indeed, any place that suggested a fertile idea. Sometimes he quite generously acknowledged his source, but I doubt that he usually paid any royalties.¹⁰⁴ He complained bitterly about London theater managers who preferred to pay £25 for a translation of a successful French play than £300 to £500 for a new but untried work. By such practices, Boucicault protested, “the English dramatist was obliged to relinquish the stage altogether or to become a French copyist.”¹⁰⁵ Or, as Boucicault himself labored to do, the dramatist simply had to make sure that his pirated versions of others’ works were more successful than others’ pirated versions of his.¹⁰⁶

Just as Boucicault was no ordinary employee, *The Octoroon* was no ordinary work.¹⁰⁷ Its portrayal of life on a Louisiana plantation created a sensation in American theater, in part because it dealt with slavery in a way calculated to offend neither North nor South by suggesting that slavery was an intolerable system while depicting Southern slave owners as sympathetic characters. The portrayals of the slaves (and the Indian, who was played by Boucicault) were at once dismally racist and yet humane (at least by the white standards of the time).¹⁰⁸

According to the facts recited in the opinion, Boucicault wrote the

104. HOGAN, *supra* note 73, at 33.

105. *Id.* (quoting Dion Boucicault, *The Decline of the Drama*, 125 N. AM. REV. 243 (September 1877)).

106. Boucicault was not alone in such “raids” or in complaining about the lack of copyright protection. Others complained that Laura Keene preferred foreign plays to native ones because she could obtain them free. Tice L. Miller, *The Image of Fashionable Society in American Comedy, 1840-1870*, in WHEN THEY WEREN’T DOING SHAKESPEARE: ESSAYS ON NINETEENTH-CENTURY BRITISH AND AMERICAN THEATRE 244 (Judith L. Fisher & Stephen Watt eds., 1989)[hereinafter WHEN THEY WEREN’T DOING SHAKESPEARE].

107. It was Boucicault’s first success in American theater; he evidently had made a careful study of American theater and American taste and in the *Octoroon* he finally hit gold. James Hurt, in WHEN THEY WEREN’T DOING SHAKESPEARE, *supra* note 106, at 255.

108. See Dion Boucicault, *THE Octoroon*, in SELECTED PLAYS BY DION BOUCICAULT 135-90 (Andrew Parker ed., 1987). The story of *The Octoroon* is worth telling. A Louisiana plantation is to be sold to satisfy debts incurred by its late, spendthrift former owner, Judge Peyton, on account of the mismanagement of the scheming yankee overseer M’Closky. The slaves are to be sold along with the plantation. The plantation had been left to the judge’s son, George, a charming playboy recently returned from Paris. Zoe, the judge’s daughter by a slave, is to be sold along with the slaves because the judge’s letter manumitting her is declared invalid on account of a legal technicality. Zoe had been raised as a daughter by Mrs. Peyton. Naturally, George and Zoe fall in love. M’Closky arranges to intercept a letter and check containing enough money to pay off the debts, but the faithful slave, Paul, gets the letter first. M’Closky kills Paul and blames the Indian Wahnotee (played by Boucicault) for the murder. A camera happened to photograph the murder and later the photograph is discovered. The Indian Wahnotee avenges the death of Paul by murdering M’Closky. Unfortunately, M’Closky is discovered too late, because Zoe, who had already been sold to M’Closky at the slave auction, swallows poison to avoid her fate, and in the closing scene she dies in George’s arms.

play in 1859 while “employed as an actor and stage manager” of the Winter Garden Theater in New York City. William Stuart (sometimes spelled Stewart) was the lessee and manager of the theater. A couple of years before, Stuart and Boucicault had opened the Washington Theater in Washington, D.C., but the theater was not a success.¹⁰⁹ So the Winter Garden was not their first collaboration, and, obviously, Boucicault was not an “employee” in the sense of being Stuart’s subordinate.¹¹⁰

Boucicault and Stuart orally agreed that the former would, as one court found, “write a play representing life on the Mississippi, and that it should be performed at Stewart’s theater so long as it should continue to draw good audiences.”¹¹¹ Boucicault quit the Winter Garden after six nights because he and his wife, Agnes Robertson, who also acted in the play, were in a dispute with Stuart over their salaries. The day before quitting, Boucicault registered a copyright on the play in his own name. When Stuart continued to run the play without him, Boucicault brought suit in Massachusetts for a preliminary injunction,¹¹² and in New York for damages.¹¹³ Although both courts found that Boucicault was Stuart’s employee at the time he wrote the play, neither thought that fact entitled Stuart to the copyright.

The Massachusetts court rejected Stuart’s defense that Boucicault was employed to write the play. The court determined that he was employed as an actor and stage manager, but not as an author, and that a simple agreement to write a play for his employer did not entitle the employer to the copyright.¹¹⁴ The court’s framing of the case left open the possibility that an employer might obtain the copyright of works by one employed for no purpose other than to write.

In the suit for damages two years later, the New York court did not emphasize the difference between employment as an actor and employment as a writer. Rather, it suggested that only an express contract would entitle the employer to the copyright in any of its employees’ works because of the special nature of authorship. Boucicault’s agreement to write and perform in the play, and to

109. HOGAN, *supra* note 73, at 40.

110. Boucicault indeed is credited in some books as being the producer of the play; certainly one may think of him and Stuart more as partners than as employer and employee in the modern sense. *See, e.g.*, MARY CAROLINE CRAWFORD, THE ROMANCE OF AMERICAN THEATRE 369 (1913).

111. *Roberts v. Myers*, 20 F. Cas. 898, 899 (C.C.D. Mass. 1860).

112. *Id.* at 898.

113. *Boucicault v. Fox*, 3 F. Cas. 977 (C.C.S.D.N.Y. 1862).

114. *Roberts*, 20 F. Cas. at 899.

share half the profits from it, did not confer upon Stuart title to the drama:

The title to literary property is in the author whose intellect has given birth to the thoughts and wrought them into the composition, unless he has transferred that title, by contract, to another. In the present case, no such contract is proved. The most that could possibly be said, in regard to the right of Stuart, or his trustee, in the play, is, that the arrangement entitled them to have it performed at the Winter Garden as long as it would run.¹¹⁵

Note how the paternity metaphor—the work is the “brat of the brain,” in Daniel Defoe’s terms, or “the author whose intellect has given birth to the thoughts” here—does the rhetorical work of justifying employee ownership. In the earlier theater case, *Atwill v. Ferrett*, the court had invoked the property metaphor to achieve the same result: “to constitute one an author, he must by his own intellectual labor applied to the materials of his composition, produce an arrangement or compilation new in itself.”¹¹⁶ In both cases, the crucial reasoning began with a metaphor of the nature of authorship that by itself was supposed to justify copyright—either the rights that flow from Locke’s theory of property or the rights of parents in their children—and then used that metaphor to justify employee ownership of the copyright.

The court ruled that only an express agreement to assign the copyright would suffice to transfer it from employee to employer. It grounded the rule in the particularly personal nature of authorship: “A man’s intellectual productions are peculiarly his own, and, although they may have been brought forth by the author while in the general employment of another, yet he will not be deemed to have parted with his right and transferred it to his employer.”¹¹⁷ If authorship is the “bringing forth” of new life, a new creation, and the creation is “peculiarly” one’s own and irreducibly personal, a legal rule should not presume one has given away one’s property (or one’s children) in the absence of a clear intent to do so. Thus, the court articulated a clear statement rule, explaining that “producers” who employed “authors in particular literary enterprises” could easily, when they felt it in their interests, contract for employer ownership of the copyright, and that a contract transferring the copyright would

115. *Boucicault*, 3 F. Cas. at 980.

116. *Atwill*, 2 F. Cas. at 198. *See supra* text accompanying note 75.

117. *Id.*

be enforceable.¹¹⁸ The personal nature of authorship, in the court's view, justified a default rule of employee ownership and required a clear agreement to transfer the copyright to anyone else.

The third case in the trilogy of actor/writer cases from the Civil War period was the 1861 case *Keene v. Wheatley*, which concerned the famous play *Our American Cousin*.¹¹⁹ The decision articulated a very different and more employer-friendly view of copyright ownership. *Keene* drew on a variety of precedents having to do with ownership of inventions¹²⁰ and trade secrets,¹²¹ and with the doctrine of *Lumley v. Wagner*, which held that an opera singer who breached a contract to perform at one theater could be enjoined from performing elsewhere for the term of her contract.¹²² Significantly, it did not rely on copyright doctrine or on any of the copyright cases that preceded it.¹²³

According to the statement of facts, Joshua Silsbee, an American actor, had performed in *Our American Cousin* in Benjamin Webster's famous London theater company. Silsbee returned with a copy of the play to the United States where he died, bequeathing the manuscript to his widow, who later sold it to two Philadelphia theater producers, Wheatley and John Clark. Meanwhile, the British author of the play, Tom Taylor, sold the American rights to Laura Keene, the proprietor of a theater in New York, for \$1000. With the assistance of Joseph Jefferson, an actor in her company, Keene

118. *Id.*

119. 14 F. Cas. 180 (C.C.E.D. Pa. 1861). The play is about a gullible English baronet whose financial advisor swindles him out of the family fortune. To save the fortune, the baronet's lovely daughter is engaged to be married to the unscrupulous advisor. An American relative turns up on the scene and eventually everything is straightened out. TOM TAYLOR, *OUR AMERICAN COUSIN: THE PLAY THAT CHANGED HISTORY* (Welford Dunaway Taylor ed., 1990).

120. See 14 F. Cas. at 187 ("Where an inventor, in the course of his experimental essays, employs an assistant who suggests, and adapts, a subordinate improvement, it is, in law, an incident, or part, of the employer's main invention.").

121. See *id.* at 186-87 ("A calico printer discharged his head colorman, who sued him in trover for a book of entries of processes of mixing the colors used in his business. . . . The decision was that he could not recover. . . . [T]hough there might be inventions of the plaintiff in it, yet they were the property of the master.") (citing *Makepeace v. Jackson*, 4 Taunt. 770). The principle of employer ownership of a book of secret dye recipes and samples was later adopted in Pennsylvania in a pair of cases, *Dempsey v. Dobson*, 39 A. 493 (Pa. 1898), and *Dempsey v. Dobson*, 34 A. 459 (Pa. 1896). I discuss them in Fisk, *Law and the Employee Inventor*, *supra* note 27, at 1154-56.

122. See 14 F. Cas. at 186 (citing *Lumley v. Wagner*, 42 Eng. Rep. 687 (Ch. 1852)). In a related case, a court held that a theater manager could be enjoined from soliciting the singer to break her exclusive engagement. *Lumley v. Gye*, 118 Eng. Rep. 749, 755 (Q.B. 1853). The *Lumley* doctrine is discussed in Lea S. VanderVelde, *The Gendered Origins of the Lumley Doctrine: Binding Men's Consciences and Women's Fidelity*, 101 YALE L.J. 775 (1992).

123. 14 F. Cas. at 188 ("[T]he equitable jurisdiction which we are now considering is exercisable on grounds which are independent of proprietary right in the party injured, or in any other person.").

adapted it for performance in her theater.¹²⁴ After the play's wildly successful run at Keene's Theater in New York, Keene and her theater company took it to Ford's Theater in Washington, D.C.¹²⁵

Due to *Our American Cousin*'s huge success in New York—which not only shaped taste in theater, but also created fashion¹²⁶—theater managers in other cities eagerly sought to mount their own productions and share in its success. Jefferson, too, sought to share the wealth and sold to Wheatley and John Clark the additions he had developed with Keene's company. But Keene, who had a long and successful career as an actress and theater manager, was a determined adversary. In addition to acting, managing her theater, and touring, Keene also had a play-brokering business. She constantly sought out new material and revised it to suit her needs; she wrote her own plays; she copyrighted all of the plays in her own name; and she frequently licensed them to theater managers all over the country.¹²⁷ It is thus not surprising that Keene litigated over the rights to the play, for she obviously thought of plays as valuable literary properties that she could license to others as well as perform herself. She regarded the company's changes to *Our American Cousin* as her property rather than as the creative property of Jefferson and the others. She copyrighted the play shortly before the

124. *Id.* at 182.

125. It was during the play that John Wilkes Booth shot Abraham Lincoln. He was able to plan the assassination because he knew the play and the theater. After Booth shot Lincoln, he jumped from the state box down onto the stage, knocked Keene out of his way, and ran out the stage door. Keene went up to the box and held Lincoln's head for some of the time until he was carried to the boarding house across the street, where he died. She stayed with Mary Todd Lincoln at the boarding house until morning. Evidently Keene's blood-stained dress became an artifact much sought-after by souvenir hunters. Keene herself was briefly arrested when she and her company left Washington, presumably on suspicion that she had been involved in Booth's plot. She was promptly released and never prosecuted. VERNANNE BRYAN, LAURA KEENE: A BRITISH ACTRESS ON THE AMERICAN STAGE, 1826-1873, at 136-42 (1993).

An interesting coincidence is that Lincoln saw the play on the closing night at Ford's Theater; the play scheduled to open the next night was *The Octoroon*. See TAYLOR, *supra* note 119, at 30 (showing a photograph of Ford's Theater draped in black following the assassination, and in the foreground a billboard announcing *The Octoroon*, which was scheduled to open). The enormous popularity of both plays makes the coincidence not improbable. Boucicault and Keene had also collaborated on other projects. He wrote the famous play *The Colleen Bawn* for her, which premiered in March 1860. CRAWFORD, *supra* note 110, at 370-71.

126. However, perhaps it is a bit much to call it "the play that changed history," as one recent work does. TAYLOR, *supra* note 119.

127. She offered to license one of "her plays" to a Boston theater manager as follows:

It is now the sensation of London and Paris. It has been carefully rewritten by myself to suit America. All my stage knowledge has been employed to give the two grand scenic effects the elements of such a success as will create a genuine sensation. The story is simple, yet thrilling, the piece full of good parts, incidents and fun. . . . It must be played immediately in your city and I give your house the preference therefore an early reply will oblige.

BRYAN, *supra* note 125, at 115-16.

premiere, and, according to her biographer, she dreamed up the title when she filed for copyright because Tom Taylor, the play's original author, had not titled it.¹²⁸

The work of those in Keene's company, including Jefferson, who played the American cousin, Asa Trenchard, may have contributed to the success of the play. Keene allowed an unprecedented two weeks for rehearsal of the play before it opened in New York, and it must have been during those two weeks that the play evolved to the point that she and others would dispute ownership. The two weeks "gave the cast members the unusual privilege of 'developing their characters.'"¹²⁹ Jefferson developed the American cousin character he played by significantly altering a stock character in nineteenth century theater (the "Yankee"), transforming the role from a "droll, awkward, bumpkin" or "broad and extravagant boor" into someone of "stature," a "quiet, easy, natural, and at the same time excessively droll fellow."¹³⁰ Edward Sothern created many distinctive aspects of his Lord Dundreary character: He evidently devised the drooping mustache that became the hallmark of an eccentric comic as well as a variety of verbal and physical tics that became staples of nineteenth-century comedy.¹³¹ The cast, which included and was directed by Keene, collectively revised the script. Keene designed elaborate new sets.¹³² All the work paid off. Sothern and Jefferson became stars and Keene's own fame and wealth grew.¹³³

The court concluded that, because the British author was not a U.S. resident, Keene did not have a valid copyright claim to the original version of the play.¹³⁴ Moreover, she could not obtain a copyright for the additions, even though they were done by

128. *Id.* at 83. Keene and Jefferson disagreed about the extent of their own contributions in revising Taylor's version of the play for the American stage. Keene's biographer emphasizes Keene's rewriting. *Id.* Jefferson's autobiography, not surprisingly, emphasizes his. He suggests that Keene initially "thought little of the play, which remained neglected upon her desk for some time" and that it was only because her business manager "chanced" upon it and gave it to Jefferson, who saw "the chance of making a strong character of the leading part," that the play was recommended for production. JOSEPH JEFFERSON, THE AUTOBIOGRAPHY OF JOSEPH JEFFERSON 193-94 (New York, Century Co. 1889).

129. BRYAN, *supra* note 125, at 83.

130. *Id.* at 84 (quoting Frank Leslie, ILLUSTRATED NEWSPAPER, Mar. 5, 1859). ¹

131. See CRAWFORD, *supra* note 110, at 334. The book also contains a photograph of Sothern as Dundreary.

132. *Id.*

133. *Id.* at 327-33. The play was so popular that she gave benefit performances to raise money for good causes, and eventually she established the tradition of a charity matinee. Society ladies who previously had snubbed Keene began to flock to her theater for the charity performances, and Keene began to find the social acceptance that eluded most actresses and theater people. She also found prosperity. Jefferson quipped that during the run, Keene began "to twinkle with little brilliants until at the end of three months she was ablaze with diamonds." BRYAN, *supra* note 125, at 84 (quoting JEFFERSON, *supra* note 128, at 194).

134. 14 F. Cas. at 185.

American residents (principally Joseph Jefferson), because they were only accessions, not an independent work. Nor could she challenge the defendants' use of the play obtained from Silsbee's widow on any other grounds, for they owed her no duty not to use it.¹³⁵ But the court found she could seek a remedy for the use of the additions procured from Jefferson, which is what makes the case particularly significant:

Mr. Jefferson, while in the general theatrical employment of the complainant, engaged in the particular office of assisting in the adaptation of this play; and made the additions in question in the course of his willing performance of this duty. She consequently became the proprietor of them as products of his intellectual exertion in a particular service in her employment.¹³⁶

To reach this result, the court downplayed the relevance of copyright law, looking rather to general principles of "equitable jurisprudence," independent "of any question of literary proprietorship."¹³⁷ Rather than emphasizing the role of the author, the court relied instead on cases involving other sorts of employees: a calico printer forced to relinquish a book of his dye recipes when fired,¹³⁸ and the opera singer Johanna Wagner, who was enjoined from performing for any other theater during the term of her exclusive engagement.¹³⁹ The court further relied on general principles governing "secrets of inventors, or improper disclosures of knowledge acquired in professional relations or in those of service or agency."¹⁴⁰

The court's treatment of these cognate doctrines involving ownership of workplace knowledge—the enticement rule of *Lumley v. Wagner*, the emerging trade secret rule—was unprecedented. Most of the cases it cited involving employees were of recent vintage (none was more than a decade or two old), and *Keene v. Wheatley* was the first court to put them all together in a published opinion articulating a default rule of employer ownership. The court stated a general principle of employer ownership of employee knowledge or creative works at a time when very few courts had so ruled and when there were some cases stating just the opposite.¹⁴¹

135. *Id.* at 188.

136. *Id.* at 187.

137. *Id.*

138. *Id.* at 186-87 (citing *Makepeace v. Jackson*, 4 *Taunt.* 770).

139. *Id.* at 186 (citing *Lumley v. Wagner*, 42 *Eng. Rep.* 687 (Ch. 1852)).

140. *Id.* at 187.

141. See Fisk, *Law and the Employee Inventor*, *supra* note 27, at 1148; Fisk, *Working Knowledge*, *supra* note 27, at 483.

Keene's win in *Keene v. Wheatley* in 1861 was not the end of the story. She spent years and instituted at least three suits trying (unsuccessfully) to protect her exclusive right to *Our American Cousin*. Six years later, Keene was again trying to fend off those who sought to produce the play without her permission.¹⁴² She learned that Edwin Booth, brother of the infamous John Wilkes Booth,¹⁴³ had purchased the Winter Garden theater and named as manager her adversary from *Keene v. Wheatley*, the co-defendant John Clark. She sued Clark and, perhaps growing skeptical about the efficacy of legal remedies, took her fight public. She wrote a letter addressed to him, but intended for publication, in which she accused him of theft. She asserted that it was her "enterprise, industry and expenditure" that made the play a success:

You know well this is not a case of copyright it was my personal, private property, and should have been held sacred to me by every respectable member of our profession I am so identified with that play that I consider it one of my most valuable possessions. Why seek to deprive a woman of her honestly acquired property? Why not take the Beteran or Rosedale or any other play owned by a man?¹⁴⁴

142. *Keene v. Clark*, 2 Abb. Pr. (n.s.) 341 (N.Y. Super. Ct. 1867). In *Keene v. Clark*, Keene sought to prove that her entitlement to *Our American Cousin* was res judicata by virtue of the judgment in *Keene v. Wheatley*. (She could assert res judicata because Clark was a defendant in both suits; presumably her theory was that Booth was in privity with Clark and thus could be bound by the judgment in the first suit even though he was not a party.) The trial court refused to admit the pleadings and decree, but on appeal the Superior Court held that the record should be admitted, and remanded for a trial at which Keene would prevail if she proved that she had not printed or otherwise dedicated to the public the manuscript to her version of *Our American Cousin*, and that Clark had obtained a copy of it from a "surreptitious source" and intended to produce it in New York. *Id.* at 341. Neither the published opinion nor Keene's biography indicates what happened after the Superior Court sent the case back for trial. Presumably it settled, though on what terms remains unknown.

143. On Edwin Booth's life and relationship to John Wilkes Booth, see CRAWFORD, *supra* note 110, at ch. XIII.

144. The letter read:

Sir—I see by your advertisement in the Herald that you purpose playing *Our American Cousin*. No one in our profession is better aware than yourself that in all honor, honesty and fair dealing the said play is my sole property. I gave the author a large sum for it when it was an unacted manuscript. By my enterprise, industry and expenditure, I made the play a great success. You then being one of the managers of the Arch street theatre, Philadelphia, determined to act the play. You obtained a copy of it, which was proven on trial to have been stolen from the author, Tom Taylor. I brought a suit against you then and it was proved you had obtained all the original matter which had been written by my stage manager and myself from an employee of my theatre. Judge Cadwalader decided against you, and under whose decision you were compelled to play damages. You ultimately apologized for your share of the transaction and wished to shift all the blame on others. You had made many thousands of dollars, however, while the suit lasted. Since then you have played it in Washington, Baltimore, etc., knowing full well that my professional engagements would prevent restraining you by law from so doing. In these places you have again made large sums from its production. Should not the money you

Keene was absolutely right that this was “not a case of copyright.” Unlike the cases involving *The Octoroon*, the ruling in her favor was based on “equitable principles,” not copyright, and thus it was nominally consistent with the Boucicault rulings. But at another level, it was not at all consistent. Except for the fact that she had been involved in adapting *Our American Cousin*, and no one alleged that Stuart had been involved in the creation of *The Octoroon*, there was no more reason for her to receive copyright protection than Stuart, so long as one adheres to the intellectual labor theory of authorship.

The court did not attempt to distinguish the cases, so why the difference? Perhaps it was Keene’s own involvement in adapting *Our American Cousin* that led the court to recognize her entitlement. Keene’s lawyer may have made in litigation the same claim that Keene herself later made in print: the play was her “personal, private property,” and the product of her “enterprise, industry and expenditure.” Characterizing the play as Keene’s own work made the claim of employer ownership more compelling because it did not contradict the extant justification for employee ownership of the copyrights to works that were entirely the product of their own efforts (even though they were employed to exert that effort).

Finally, there was her celebrity, the notoriety of the play, and the fact that it was well known that neither she nor Jefferson was really the “author” in the copyright sense. These facts, as well as her

have already made from my property content you? You know well this is not a case of copyright it was my personal, private property, and should have been held sacred to me by every respectable member of our profession; but now, while I am absent from New York, you take advantage of that absence to play *Our American Cousin*. I am so identified with that play that I consider it one of my most valuable possessions. Why seek to deprive a woman of her honestly acquired property? Why not take the Beteran or Rosedale or any other play owned by a man?

The bad taste of seeking to deprive me of the use of this play is only equaled by your ever appearing in a comedy which ought to have only a memory of shame and horror for you and every member of your family. You cannot lift the cloud which has fallen upon our whole profession by acts which set at naught all regard for principle and right.

Laura Keene

BRYAN, *supra* note 125, at 144-45 (quoting BEN GRAF HENNEKE, LAURA KEENE, A BIOGRAPHY 223-24 (1990)). The letter and its subsequent history underscore the importance of claiming the moral high ground and the rhetorical force of staking that claim in authorship. Keene’s letter used a number of devices to do so. Obviously, one was the characterization of the play as her property that he had stolen. Interestingly, in the ensuing litigation, *Keene v. Clark*, attorneys for both parties stipulated that she did not in fact write the letter accusing him of theft, since, as a *lady*, she could not possibly have written such a scurrilous attack. BRYAN, *supra* note 125, at 145. Perhaps one ought not take this stipulation at face value. Lawyers for both litigants might have wanted the letter excluded from the record for other reasons. A second tactic was to remind the world that a member of the Booth family, above all people, should not have any connection with the play that Lincoln was watching when John Wilkes Booth killed him. Third, invoking chivalry and feminine prerogative, she accused him of stealing from her *because she was a woman*.

aggressiveness in claiming the fruits of her “industry and enterprise” in hiring Jefferson and promoting the play, combined to make her claim to ownership of the play more compelling than the theater managers’ claims had been. The old rhetoric of authorship, thus, did not fit. The court, free from the adverse precedent of *Atwill* and *Wheaton*, created a new rhetoric of employer prerogative based on industry, enterprise, and collaborative creation.

B. Law Publishing and Early Recognition of Employer Ownership

The possibility of distinguishing the *Keene* cases from the *Boucicault* cases on the difference between copyright rules and equitable rules did not last even a decade. In 1869, a federal court in Massachusetts stated in dicta, without acknowledging its apparent departure from *Roberts v. Myers*, that an employer would have the copyright in the literary products of its employees. *Lawrence v. Dana*, which became a very influential decision, was another chapter in the long (and unsuccessful) copyright battles fought by Henry Wheaton, the erstwhile Supreme Court reporter. Wheaton authored a respected treatise on international law and, after his death, his wife Catharine contracted with William Lawrence to prepare an updated edition of her late husband’s work.¹⁴⁵

In *Lawrence*, as in previous cases, the existence (or absence) of an express contract was crucial. Catharine Wheaton had expressly contracted with Lawrence that she would make no use of his notes in any later editions without his written consent and that he would have the right to make any use of them he wished. However, what is significant about the case is the dictum. The court remarked that, absent such a contract, Catharine would have owned the copyright to the notes.¹⁴⁶

The principle of employer ownership as a default rule, recognized in *Keene* and *Lawrence v. Dana*, could be introduced relatively painlessly because in both cases the employee did not lose significant rights. In *Keene*, Jefferson lost little because he was not a party to the litigation; presumably, he had sold Wheatley and Clark his rights, and they were the ones who would stand to lose if it turned out that he had no rights to sell. In any event, he only authored certain additions, not the whole play, and the defendants had an independent source for everything in the play except his additions. In *Lawrence v. Dana*, the employee-author lost nothing by recognition of the principle because there was an express contract protecting his claim to copyright.

145. 15 F. Cas. 26 (C.C.D. Mass. 1869).

146. *Id.* at 50-51.

It is enormously important that the work-for-hire principle slipped into the cases without the usual adversary process (either because the actual employee author was not a party or because the principle was stated in dicta), for these seminal cases did not actually force a court to choose between the rights of the employee and those of the employer. For a generation afterward, courts simply repeated the principle as dicta giving it the patina of age, without ever actually relying on it to decide a case. A string of cases decided in the 1880s and early 1890s persisted in finding one reason or another to recognize the copyright of the employee-author. Many acknowledged employer ownership in dicta, but no courts actually held that the fact of employment *ipso facto* entitled the employer to the copyright.¹⁴⁷

The Supreme Court's 1888 opinion in *Callaghan v. Myers*, an action alleging infringement of the Illinois Reports, also articulated a default rule of employee ownership, making clear that the rationale for the rule was that it reflected the likely intent of the parties.¹⁴⁸ The plaintiff had purchased the copyright from the reporter of decisions. He sued the publisher who was selling copies of the Reports, including the reporter's headnotes, statements of the case, and summaries of the arguments of counsel. The defendants argued that the reporter could acquire no copyright in them. The lower court found the contention would have "great force" "if an adequate compensation was paid by the state to the reporter for the work done by him in preparing the volumes." But the court concluded:

I cannot find that view was taken of the case by the state and the court in the appointment of the reporter at that time. On the contrary, it seems to have been considered that the reporter was entitled to any profits which might arise from the sale of these volumes, and that they constituted part of the perquisites of his office.¹⁴⁹

On review, the Supreme Court found no merit to the contention that the reporter, as a public servant, could acquire no copyright:

Even though a reporter may be a sworn public officer, appointed by the authority of the government which creates the court of which he is made the reporter, and even though he may be paid a fixed salary for his labors, yet, in the absence of any inhibition forbidding him to take a copyright for that which is the lawful subject of copyright in him, or reserving a copyright

147. See *infra* text accompanying notes 148-153 and 178.

148. 128 U.S. 617 (1888).

149. *Myers v. Callaghan*, 5 F. 726 (C.C.N.D. Ill. 1881).

to the government as the assignee of his work, he is not deprived of the privilege of taking out a copyright which would otherwise exist.¹⁵⁰

Later, the Court added that whether the reporter was compensated by salary (he was not), or even by the state's purchase of a certain number of volumes, was irrelevant: "[I]n the view we take of the case, the question of a salary or no salary has no bearing upon the subject."¹⁵¹ Rather, the Court said, there was "*a tacit assent by the government* to his exercising such a privilege."¹⁵²

In just twenty years, courts had reallocated copyright ownership simply by rewriting the implied contract between employer and employee to include a principle of employer ownership.¹⁵³ In other words, once the courts began to think of copyright ownership as a matter of "tacit assent"—rather than as a virtually inalienable right associated with ownership of real property or in terms of the strong tie connoted by the paternity metaphor—courts felt a different default rule was appropriate.

C. Employees and Independent Contractors

A number of factors may explain the change in default rules. Courts might have felt that a default rule of employer ownership was more likely to reflect the intent of most parties and wanted to save the parties the trouble of negotiating for employer ownership. Alternatively, courts might have begun to see employers as possessing a stronger moral claim and believed that any employee who planned to assert copyright ownership ought to be forced to disclose that intent and negotiate for it. Finally, as changing assumptions about the nature of authorship strengthened the rhetorical force of the employer's claim, a default rule of employer ownership might have seemed more intrinsically appealing, irrespective of whether the parties might negotiate around it.

Readers familiar with contemporary American doctrine on work-for-hire would find the result quite unsurprising. In today's law,

150. 128 U.S. at 647.

151. *Id.* at 650.

152. *Id.* at 647 (emphasis added).

153. Two other cases from the 1880s contain significant dicta on the employer ownership principle. *Sarony v. Burrow-Giles Lithographic Co.*, 17 F. 591 (C.C.S.D.N.Y. 1883), restated in dicta the principle from *Wheaton v. Peters* that judges could not own the copyright in their opinions and that, therefore, a reporter could not either. It did so, however, in a way that emphasized the fact of the judges' employment rather than the public nature of statements of law. See *Wheaton*, 33 U.S. at 668. Similarly, *In re Gould & Co.*, 2 A. 886, 896 (Conn. 1885), which preceded the Supreme Court's pro-employee decision in *Callaghan*, held that "[t]he judges and the reporter are paid by the state; and the product of their mental labor is the property of the state, and the state, as it might lawfully do, has taken to itself the copyright."

when the creator is an employee, the default rule is employer ownership; when the creator is an independent contractor, the default rule is employee ownership.¹⁵⁴ The reporter in *Callaghan* would be characterized as an independent contractor because he was paid by the job (rather than salaried) and, for all that appears, the judges had no control over the manner, means, or timing of his work.¹⁵⁵ But the distinction between employees and independent contractors did not exist as clearly in American law in the nineteenth century as it does today,¹⁵⁶ and, in any event, it was never mentioned in the copyright cases. An English treatise on labor contracts, while discussing the right of the “master” to the “produce of the servant’s labour and inventions,” did not note any distinction between servants and other employed persons. It stated:

A person who employs and pays an author to write a drama or literary work, is not by virtue of the employment entitled to the exclusive right of representation or copyright, because the

154. 17 U.S.C. § 101.

155. *See Cmty. for Creative Non-Violence v. Reid*, 490 U.S. 730 (1989) (making the hiring party’s right to control the creator’s work the crucial determinant of whether the creator is an employee or independent contractor within the meaning of copyright law).

156. The distinction between servants and contractors functioned to determine the liability of the employer to third parties for torts committed by the servant or contractor. *See 2 HORACE GAY WOOD, A TREATISE ON THE LAW OF MASTER AND SERVANT* 601 (1877) (defining a servant as “a person who, by contract or operation of law, is for a limited period subject to the authority or control of another person in a particular trade, business or occupation,” and explaining that an employer is not liable for the acts of contractors “except when he retains control over the manner or instrumentalities of the work”). Mechem’s treatise on the law of agency confessed that

[t]he line of demarcation between the relation of principal and agent, and that of master and servant is exceedingly difficult to define. This difficulty arises largely from the fact that the two relations are essentially similar. Indeed, there is much reason for saying that the difference between them is one of degree only, and not of kind.

FLOYD R. MECHEM, *A TREATISE ON THE LAW OF AGENCY* 2 (Chicago, Callaghan & Co. 1889). Mechem ultimately concluded that agency

properly relates to transactions of business with third persons, and implies more or less of discretion in the agent as to the time and manner of his performance. Service, on the other hand, has reference to actions upon or about things. It deals chiefly with matters of mere manual or mechanical execution, in which the servant acts under the direction and control of the master.

Id. at 3. The distinction between “things” and “business” obviously no longer holds, although the different degrees of supervision are today the essential distinction between employees and independent contractors. But Mechem went on to note all the exceptions to the notion of supervision as being determinative, and added that the agent typically works by the project rather than for a fixed period. He then cautioned, however, that an agent’s period of employment might be fixed. *Id.* at 4. *See generally* WILLIAM EVANS, *A TREATISE ON THE LAW OF PRINCIPAL AND AGENT IN CONTRACT AND TORT* (Chicago, Chicago Legal News Co. 1879) (containing a chapter on the liability of employers for injuries caused by the negligence of fellow servants but little discussion otherwise of employment, and no discussion of the distinction between agents and servants); FRANCIS WHARTON, *A COMMENTARY ON THE LAW OF AGENCY AND AGENTS* § 321, at 227 (Philadelphia, Kay & Bro. 1876) (explaining that an agent is paid by commission, whereas a servant is paid by wages).

statutes vest such right in the author, and require the transfer of such a right to be in writing.¹⁵⁷

While it is true, as noted above, that most of the early cases articulating a default rule of employee ownership involved workers who today would likely be deemed independent contractors, courts never mentioned whether the author was a servant or a contractor.¹⁵⁸ Nor did courts observe the distinction when they applied the rule to cases involving workers who today would be deemed employees. It may very well have been the independence of the employee-author that influenced the court to adopt a default rule of employee ownership, and thus the intuition of early courts was similar to the intuition underlying the modern law that independent contractors should presumptively own the copyrights to their works. But none of that was made explicit in the cases. Rather, the courts contended simply that one must examine the “contract express or implied” between the parties, without articulating the basis for interpreting implied understandings.¹⁵⁹

D. Doctrinal Confusion, Default Rules, and the Role of Contracts

By the last two decades of the nineteenth century, the law of employee copyrights was highly uncertain and the results of cases were quite unpredictable. However, as illustrated by *Callaghan v. Myers*, there remained a strong line of cases articulating pro-employee rules.¹⁶⁰ One might expect, therefore, that firms concerned about copyright ownership would increasingly resort to express contracts to achieve their ends. To some extent, the case law bears this out: the reported cases from the 1890s involve more express contracts than appeared in earlier cases. At the same time, as *Callaghan* also illustrates, courts became more inclined to characterize the rules regarding copyright ownership in contract terms rather than in the terms of immutable rules and moral right that had predominated in earlier cases. Courts thus facilitated contracting around the default rules. The judicial endorsement of a contractarian view of copyright ownership paved the way for employers to gain control of copyrights more effectively. At the same time, employers were more likely to see the need for, and to be

157. DAVID GIBBONS, RUDIMENTARY TREATISE ON THE LAW OF CONTRACTS FOR WORKS AND SERVICES 109-10 (London, John Weale 2d ed. 1857).

158. See cases cited *supra* note 24.

159. WOOD, *supra* note 156, at 4.

160. See *supra* text accompanying notes 148-52.

able to effectively negotiate and draft, contracts allocating workplace copyrights.¹⁶¹

The uncertain status of the employee-author and the role of contract concepts in creating a default rule of employer ownership can be seen quite clearly in Eaton Drone's influential 1879 *Treatise on the Law of Property in Intellectual Productions in Great Britain and the United States*.¹⁶² Drone's was the leading nineteenth-century copyright treatise and was frequently cited by courts and lawyers. His utterly ambiguous characterization of the state of the law, as explained below, provided ammunition for employers and employees on almost any position they might have wanted to take.

Drone began his analysis with the uncontroversial proposition that a "literary production is primarily the property of the author who has created it." He then elaborated on this idea: "When a person has conceived the design of a work, and has employed others to execute it, the creation of the work may be so far due to his mind as to make him the author." But, cautioned Drone, "he is not an author who 'merely suggests the subject, and has no share in the design or execution of the work.'"¹⁶³ Drone then went on to explain how authors could assign their common law rights in an unpublished work to another and how the other would thus obtain the right to apply for the statutory copyright. Analogizing from this principle, Drone asserted:

Assuming that the law is rightly expounded above, to the effect that copyright will vest *ab initio* in the owner of an unpublished production, it follows that any person may secure statutory copyright for a work which he has employed another to write. The produce of labor may become the property of him who has employed and paid the laborer. Literary labor is no exception to this universal rule. When an author is employed on condition that what he produces shall belong to the employer, the absolute property in such production vests in the employer by virtue of such employment and by operation of law.¹⁶⁴

Drone cited no cases in support of this proposition. Later, when he came to discussing the cases, he moderated the rule considerably. As to the law in Britain, he agreed that,

161. John Witt has argued that uncertain default rules enhance the ability of employers to use express contracts to their preferred results. See John Fabian Witt, *Rethinking the Nineteenth-Century Employment Contract, Again*, 18 LAW & HIST. REV. 627, 654-56 (2000).

162. DRONE, *supra* note 38, at 236-61.

163. *Id.* at 236 (quoting *Shepherd v. Conquest*, 17 C.B. 427, 445).

164. *Id.* at 243.

it may be going too far to say that the law to this effect is judicially settled. It is conceded that, when one person has employed and paid another to write a work, with the mutual understanding that it shall be the property of the employer, the latter acquires an equitable title which will enable him in a court of chancery to assert his rights in the published production against either the person employed or others.¹⁶⁵

However, said Drone, “Whether a complete legal title to the copyright will vest *ab initio* in such employer without the necessity of a written assignment, is a point on which the law has not been expressly declared by the courts of law.”¹⁶⁶

Drone then discussed an English case in which the court articulated the rule that one employed to compose a musical score for a play retained ownership to the copyright unless the employment involved an express understanding that the composition would belong to the theater owner.¹⁶⁷ The case indicated that the law in Britain, like the law in the United States during that era, found employer ownership only on the basis of an express agreement. Drone recognized as much when he came to discussing American law:

The mere fact of employment does not make the employer the absolute owner of the literary property created by the person employed. Where there is no agreement or *implied understanding* that what is produced shall belong to the employer, it is clear that the latter acquires no title to the copyright.¹⁶⁸

The employer acquires the copyright only if there is an “agreement that he, and not the person employed, is to be the owner of the work produced. But such agreement need not be express. It may be implied from the terms and conditions of the employment.”¹⁶⁹

Thus, Drone’s treatise could be, and was, read to support three contradictory propositions: a default rule of employee ownership; a default rule of employer ownership; and a rule that ownership should be assessed in each case from the express or implied understanding of the parties. Perhaps the confusion Drone reported was due to the fact that default rules of copyright ownership were doubly sticky; not only did parties infrequently contract around them

165. *Id.* at 248.

166. *Id.*

167. *Id.* (citing *Hatton v. Kean*, 7 C.B. n.s. 268).

168. DRONE, *supra* note 38, at 257 (emphasis added).

169. *Id.* at 258.

(which is the usual sense in which scholars refer to sticky default rules), but courts also made them hard to contract around.¹⁷⁰

This fact is more than simply amusing; it invites us to think about how industries premised on intellectual property rights could thrive in a climate of legal uncertainty. If it is claimed that nineteenth-century economic development was facilitated by the existence of certain and definite property rules, surely contrary evidence from the most influential copyright treatise of the era suggests that American publishing and advertising somehow managed to grow without definite rules.

The uncertainty of property rights and the doctrinal chaos reported in Drone's treatise were perhaps ameliorated by the importance of express contracts. Drone explicitly noted the possibility of contracting around whatever default rule existed. Moreover, the fact that most copyrighted materials in the era were produced by people who would have entered into relatively short-term contracts in which both parties contemplated the creation of copyrighted works suggests that in many cases the parties probably allocated ownership rights by contract. The extent to which parties contracted around the default rule is unclear and probably varied significantly by industry.¹⁷¹ However, Rochelle Cooper Dreyfuss offers two reasons to believe that it was not particularly easy to contract around the uncertain defaults. First, the costs of transacting might be high when the parties have to discuss something as touchy as authorship. Employers might have been afraid to alienate employees by demanding assignment of the copyright, preferring to run the risk of litigation later. Employees may have lacked legal sophistication to realize that it was necessary to contract for copyright ownership. Second, the instability of the law may have made enforcement of any contract they did reach highly uncertain.¹⁷²

The experience of Dion Boucicault and William Stuart bears this out. Why, when they agreed that Boucicault would write *The Octoroon* for performance at the Winter Garden, did they not agree who would own the copyright? Surely they both contemplated that their association would produce a copyrighted work and both must have hoped it would be valuable. Moreover, Boucicault was not

170. See Ian Ayres & Robert Gertner, *Majoritarian vs. Minoritarian Defaults*, 51 STAN. L. REV. 1591, 1598 (1999).

171. In future work, I expect to report on an empirical study of the contracting practices of firms that produced copyrighted information. My work in other areas of employee-generated intellectual property, however, suggests that the default rule of employee ownership of trade secrets remained quite sticky until the early twentieth century. See Fisk, *Working Knowledge*, *supra* note 27.

172. See Rochelle Cooper Dreyfuss, *Collaborative Research: Conflicts on Authorship, Ownership, and Accountability*, 53 VAND. L. REV. 1162, 1172-79 (2000).

naïve about copyright law. Perhaps they failed to negotiate explicitly for copyright ownership for the same reasons that playwrights and those who assist them often fail to today: There may be serious costs to the relationship in raising those issues and/or in reducing them to writing. The parties may each hope for a better result through informal resolution, or they may be unsure at the outset what each of their contributions will be and how, therefore, best to divide the credit and profit.¹⁷³ Then as now, there may be many reasons why even those most likely to anticipate the production of a copyrighted work might not negotiate around the default rule.

And when there was no express contract, as Drone's treatise recognized, the problems arose. The dominant contemporary American legal habit of creating all sorts of implied contractual rules defining the obligations of employer and employee was not yet entrenched.¹⁷⁴ Contract surely reigned supreme, but the problem was that Drone provided (because the cases provided) little guidance on how to identify an implied understanding between employer and employee for the ownership of copyrights. The concept of default rules was less familiar than it is today in part because the notion of employment as an entirely contractual relationship in which all obligations are subject to negotiation was only just beginning to emerge.

After publication of Drone's treatise, reported decisions continued to reflect significant uncertainty about whether the default rule was one of employer or employee ownership. As we have seen in *Callaghan*, the dominant view was that the employee-author was entitled to copyright. The Court's decision five years earlier in *Burrow-Giles Lithographic Co. v. Sarony* further illustrated this approach.¹⁷⁵ *Burrow-Giles Lithographic Co.* involved a claim to a copyright of a photograph of Oscar Wilde. The Court held that the photographer, not the man who hired him, had used sufficient

173. See *Thompson v. Larson*, 147 F.3d 195 (2d Cir. 1998) (deciding a dispute between the heirs of the playwright and the dramaturg of *Rent*, the successful Broadway musical of the 1990s); Roberta Rosenthal Kwall, *supra* note 2 (discussing *Thompson v. Larson*); Paulette S. Fox, Note, *Preserving the Collaborative Spirit of American Theater: The Need for a "Joint Authorship Default Rule" in Light of the Rent Decision's Unanswered Question*, 19 CARDOZO ARTS & ENT. L.J. 497 (2001) (same); see also Seth F. Gorman, *Who Owns the Movies? Joint Authorship Under the Copyright Act of 1976 After Childress v. Taylor and Thompson v. Larson*, 7 UCLA ENT. L. REV. 1 (1999); Jane C. Lee, Comment, *Upstaging the Playwright: The Joint Authorship Entanglement Between Dramaturgs and Playwrights*, 19 LOY. L.A. ENT. L. REV. 75 (1998).

174. Indeed, the rise of an objective theory of contract removed from the particulars of the contracting party's status was a phenomenon of the end of the nineteenth century. It was underway at the time of these cases, but hardly well settled. See P.S. ATIYAH, THE RISE AND FALL OF FREEDOM OF CONTRACT 399-412 (1979); LAWRENCE FRIEDMAN, CONTRACT LAW IN AMERICA 20 (1965); GRANT GILMORE, THE DEATH OF CONTRACT (1974).

175. 111 U.S. 53, 61 (1884).

creativity in the composition and lighting to entitle him to a copyright.¹⁷⁶ At the end of the opinion, the Court described with approval an English case involving an employee sent to photograph an Australian cricket team.¹⁷⁷ In that case, the Queen's Bench held that the photographer, not his employer, was entitled to the copyright because "the author is the man who really represents, creates, or gives effect to the idea, fancy, or imagination."¹⁷⁸ The Supreme Court said that the English justices' "views of the nature of authorship and of originality, intellectual creation, and right to protection" confirmed the Court's own views.¹⁷⁹ This statement was dicta in that *Burrow-Giles* did not involve a dispute between employer and employee, but nevertheless it reflects the Court's view that the work of the creator is crucial to copyright ownership.

The one other frequently cited employer-employee copyright dispute of the era, *Peters v. Borst*, also articulated a default rule of employee ownership. The employer—the Litchfield Observatory at Hamilton College—claimed ownership of a star catalog prepared by the director of the observatory and his assistant.¹⁸⁰ Noting that there was no "agreement that any production of these parties as authors should be the property of the observatory or the college," the trial court insisted, "it can hardly be claimed the observatory or college would become the owners of the work they might, as authors, produce and publish to the world."¹⁸¹ The institution could look only to the more intangible benefits that flow from having in their employ "men who might become eminent and distinguished by reason of the mental labor and results they achieved."¹⁸² The Court of Appeals placed more emphasis on the fact that the Director's modest salary was provided by an endowment and that the college was unable to increase it:

Since the college was financially unable to pay him anything approaching a reasonable salary, it may easily be inferred that the director would be allowed and expected to do for himself much work of his own, for which he would not be accountable to the college, and which he could use or dispose of as he pleased.¹⁸³

176. 111 U.S. at 61.

177. *Id.* (citing *Nottage v. Jackson*, 11 Q.B. 627 (1883)).

178. *Id.*

179. *Id.*

180. 9 N.Y.S. 789 (Sup. Ct. 1889).

181. *Id.* at 790.

182. *Id.*

183. *Root v. Borst*, 36 N.E. 814, 814 (N.Y. 1894).

Presuming copyright ownership by the employee because of otherwise insufficient compensation, the court appears to have adopted a default rule that reflected the likely expectations of the parties. If both employee and employer are relatively sophisticated negotiators and both contemplate that the employment will produce copyrightable work, courts need not impose default rules to force one side to disclose its intentions regarding copyright ownership. In later cases, as we shall see, courts felt the need to force disclosure by employees who intended later to claim their copyrights justified a diametrically opposite default rule of employer ownership.

During the 1890s, while courts continued to uphold a default rule of employee ownership, some cases enforced express contracts allocating the copyrights variously to employer and employee. *Press Publishing Co. v. Monroe* involved a poem commissioned by the World's Fair organizing committee.¹⁸⁴ The Second Circuit concluded that the contract allocated the copyright to the author of the poem and granted the committee only a license to publish and reproduce it.¹⁸⁵ In *Mallory v. Mackaye*, by contrast, the Circuit Court for the Southern District of New York concluded that a contract expressly provided that a theater manager owned the copyright to a play written by an actor in the theater.¹⁸⁶ *Carte v. Evans*, which involved the efforts of Gilbert and Sullivan to obtain a U.S. copyright for *The Mikado*, established the principle that an express agreement that the employer should own his employee's literary product vested the copyright entitlement in the employer, even in the absence of a formal assignment.¹⁸⁷ This principle made it easier for employers to

184. 73 F. 196 (2d Cir. 1896).

185. 73 F. at 198-99.

186. 86 F. at 122. As the court paraphrased the contract, Mackaye "agreed to give and devote to the service of Mallory the whole of his time and energy, as Mallory might direct, in any of the capacities of an author, a manager, an actor, a director, or in any other capacity having any connection with theatrical labor, and that the entire product and income of his intellectual and physical labor and skill should belong absolutely to Mallory." Mackaye attempted to gain control of the play he had written and copyrighted, as well as the double stage he had developed and patented under contract with Mallory and for an accounting of the profits Mallory received. Courts found that the contract transferred both the copyright and the patent to the employer and, eventually, decided that Mackaye had breached the employment agreement. These decisions absolved Mallory of the obligation to account for the profits or to continue paying Mackaye under the contract. See *Mackaye v. Mallory*, 6 F. 743 (C.C.S.D.N.Y. 1881); *Mackaye v. Mallory*, 12 F. 328 (C.C.S.D.N.Y. 1882); *Mackaye v. Mallory*, 80 F. 256 (C.C.S.D.N.Y. 1897); *Mallory v. Mackaye*, 86 F. 122 (C.C.S.D.N.Y. 1898); *Mallory v. Mackaye*, 92 F. 749 (2d Cir. 1899).

187. 27 F. 861 (C.C.D. Mass. 1886). The case held that Gilbert & Sullivan's contract with Tracy to compose a piano arrangement of the orchestral score of *The Mikado* and then to copyright the piano arrangement in the United States obviated the need for a formal assignment of the U.S. copyright:

The proprietor as well as the author is entitled to enter the work for copyright. The consent of Tracy was sufficient to constitute [the registered copyright holder] the

obtain copyright protection without the cooperation of the creative employee and without the need to seek an order compelling the recalcitrant employee to assign the copyright.

The doctrinal uncertainty about the nature of the default rules raises the question of their role in actually structuring relations between creative employees and firms. As John Witt has pointed out, there is every reason to believe a huge gap existed between employment doctrines and actual practices. Consequently, we cannot be certain about the extent to which parties contracted around defaults.¹⁸⁸ It may have been especially difficult for nineteenth-century employees and firms to contract for the allocation of copyrights, even if both had understood the need to do so. As Rochelle Cooper Dreyfuss has explained, it can be exceptionally difficult for collaborators in innovation to agree in advance upon an allocation of credit and profit, since the likelihood of profit, the nature of profit, and even the contributions that collaborators might make are highly uncertain.¹⁸⁹ Negotiating over the terms of the association may be especially painful at an interpersonal level, as it involves an attempt to value and assign creativity. Given the complexity and uncertainty of *ex ante* valuation and the very high transaction costs, it may be that few even attempted to contract around the default rules allocating copyrights in the workplace.

Apart from questions about the effect of defaults on employment practices, there are separate questions about what courts thought they were accomplishing by establishing default rules. In some cases, courts might have adopted a default rule of employers' rights simply because they deemed it more likely to reflect the actual understanding of most employers and creative employees ("majoritarian defaults"). In other cases, they may have wanted to force employees who planned to claim copyright to disclose that intent and negotiate for it in advance ("penalty defaults").¹⁹⁰ *Boucicault v. Fox* seems to have imposed a penalty default, as the

proprietor for this purpose, without a formal assignment. The effect of the transaction was the same as if Tracy had made the entry in his own name and then assigned to [the plaintiff].

Id. (citing *Lawrence v. Dana*, 15 F. Cas. 26 (C.C.D. Mass. 1869)). Another case enforcing an express contract giving a publisher the entire "right, title, or interest" in books written by an employee was *Clark v. West*, 86 N.E. 1 (N.Y. 1908), which involved law books published by West.

188. Witt, *supra* note 161, at 635-50.

189. Dreyfuss, *supra* note 2, at 1173-74.

190. See Ian Ayres & Robert Gertner, *Filling Gaps in Incomplete Contracts: An Economic Theory of Default Rules*, 99 YALE L.J. 87, 91 (1989) (introducing the concept of penalty defaults); Ayres & Gertner, *supra* note 170; Frank H. Easterbrook & Daniel R. Fischel, *The Corporate Contract*, 89 COLUM. L. REV. 1416, 1444 (1989) (describing default rules as those "that almost everyone will want to adopt").

court explained that it expected employers to contract expressly for copyright ownership when they deemed it possible and desirable.¹⁹¹ In still other cases, however, such as such as *Peters v. Borst*, the tenor of the court's opinion suggests that it believed a rule of employee ownership genuinely reflected what the parties likely understood, or at least should have.¹⁹²

The change in the default rule around 1900 may reflect both a changing judicial perception of the likely intent of the parties and a changing judicial perception of which party—the employer or the employee—likely has the best information about its future plans to claim the copyright, and which party should, thus, be forced to disclose its intent under penalty of losing the copyright. Whether is the ensuing rule is best described as a penalty default or an “off-the rack” default, the change seems to reflect a changing judicial perception of whether employers or employees *ought* to be able to control the copyright. This shift began gradually after 1860 and rapidly accelerated after 1900.

IV. THE FOUNDATIONS OF THE MODERN ERA: 1900-1910

The principle of employer ownership of copyrights in employee works was established in the first decade of the twentieth century. The ambivalence of earlier courts about whether the employer's right arose only from an express, or relatively clear, understanding between the employer and employee disappeared. Instead, it became quite clear in cases, and was finally enacted by statute, that the employer was entitled to the copyright as a matter of law unless there was an express agreement to the contrary. In other words, where earlier courts had attempted to find an agreement to employer ownership implied in the facts, twentieth-century courts found such agreements implied by operation of law in every employment relationship in which an employee created copyrighted work during the scope of his or her employment.

A. Corporations and Creativity

The ultimate legal fiction underlying modern copyright law is the fiction of corporate authorship. If the fiction were merely a shorthand way of saying that the corporation is the assignee of the works of an author, it would be one thing. But not every case that recognized employer ownership did so simply by assuming that the employee had expressly or impliedly agreed to assign a copyright.

191. See *supra* text accompanying notes 100-15.

192. See *supra* text accompanying notes 180-83.

Some courts persisted in analyzing the matter as if the employer itself had to be the creator. In this context, the rise of the corporation played an ambiguous role. On the one hand, if judges saw authorship as a collaborative process, the fact that a business entity was a corporate body helped the employer's case. The claim of a corporate "author," composed of many different people working toward a common end, had greater rhetorical appeal than the claim of one individual partner to the work of another. On the other hand, the rise of corporate power threatened the very individualist premises and values of much nineteenth-century law. Inasmuch as courts regarded authorship as uniquely individual, corporate authorship was simultaneously oxymoronic and repugnant. Courts did not immediately capitulate to the empire-building tendencies of the growing corporations in this area any more than they did in any other area of law. One way to understand the schizophrenic state of the law of ownership of ideas is as a working-out of the tension between individualism and corporatism in American law and society.

The first case in which a court explicitly held that a corporation owned a copyright in an employee's creation did not require significant departure from past authorship rhetoric because the president of the corporation, "himself an artist of respectable attainments," had been personally involved in the design of the advertising woodcut at issue.¹⁹³ The employee allegedly painted the print under the supervision of the corporation's president.¹⁹⁴ The corporation's "money paid for the painting; its artist colored it; its president designed it, his was the 'originating, inventive, and master mind.'" ¹⁹⁵ Analogizing the corporation to the artist's studio, the court said:

The fact that the artist Stecher [an employee of the corporation] executed Schumacher's design cannot defeat the copyright. The sculptor seldom touches the marble from which his statues are carved. The fact that the brush which embodied Schumacher's idea was held by another artist rather than by himself cannot be important in considering a question of this character.¹⁹⁶

The personal involvement of the corporation's president made the step to the fiction of corporate creation seem to be nothing more than an easy step of agency law attributing to the corporation the acts of its chief officer.¹⁹⁷

193. *Schumacher v. Schwencke*, 25 F. 466, 466 (C.C.S.D.N.Y. 1885).

194. *Id.*

195. *Id.* at 468.

196. *Id.*

197. Several years later, however, the court regarded corporate authorship as

At the same time that courts were first contemplating corporate authorship, they also were grappling with growth in the types of materials subject to copyright. What makes the rhetoric in the cases particularly interesting is the two levels on which the law was changing. On the one hand, courts were invoking eighteenth- and nineteenth-century notions of Romantic authorship to justify the existence of copyrights in new media such as advertising. By analogizing these commercial and corporate creations to the great artistic works of the past, judges and lawyers legitimated new property rights in new media. Schumacher was “an artist of respectable attainments,” and his involvement as corporate president was akin to the master sculptor in his studio who “seldom touches the marble.”¹⁹⁸ Yet, at the same time, courts alternately invoked and ignored the great authors and great painters of the past to justify corporate ownership of the creative works of employees.

In a sense, the core problems of copyright law—what it is that a copyright protects and why we protect it—underlie the difficulty in allocating authorship between employer and employee. Deciding what kinds of materials could be treated as intellectual property was a new and highly controversial exercise for much of the nineteenth century. It became even more difficult as the subjects of copyright protection expanded from books into new media. Questions naturally arose: is it the idea or the expression that is protected? What is it about a particular work that makes it appropriate to grant a monopoly over its use? If rewarding and incentivizing creativity were crucial in justifying the existence of copyrights at all, it became all the more important to identify and lionize the originator. Attribution of authorship is another facet of the same. To the extent that property rights are justified by the moral superiority of the individual artist, corporate authorship is troubling. But to the extent that intellectual property rights exist to encourage investment in intellectual endeavor, corporate authorship is essential.

unproblematic even without evidence of corporate officers’ involvement in the acts of creation. In 1908, an author employed to write a book on the law of corporations challenged enforcement of a contract assigning the entire interest in the manuscript to the employer. He argued, among other things, that the defendant had breached the contract by causing the book to be copyrighted in the name of a corporation that was not a party to the contract. The New York Court of Appeals rejected the claim. *Clark v. West*, 86 N.E. 1 (N.Y. 1908).

198. *Schumacher*, 25 F. at 468; cf. *Nat'l Cloak & Sit Co. v. Kaufman*, 189 F. 215, 216 (C.C.M.D. Pa. 1911) (holding that a corporation owned the copyright to a fashion catalogue because it “made large outlays and expenditures employing in the preparation of its various component parts artists and authors of peculiar skill and ability . . . [and] the illustrations forming component parts of said book were the work and embodied the personal reaction of artists of recognized skill in their calling, and were pictures of artistic merit, and, in addition to their merit as artistic productions, were of peculiar value as portraying original conceptions and creations relating to wearing apparel, of great interest to a large proportion of the public”).

This difficulty of reconciling corporate ownership and individual artistic expression is evident in Justice Holmes's opinion for the Supreme Court in *Bleistein v. Donaldson Lithographic Co.*¹⁹⁹ The Court held that three chromolithographs prepared by employees of a corporation for use as advertisements were proper subjects for copyright protection. Holmes justified copyright protection on the basis of the artistic genius and the uniqueness or singularity of the "personality" or self-hood of the artist, but he found corporate ownership of copyright to be entirely unremarkable.²⁰⁰ In determining that a lithograph for use as an advertisement was the sort of creative work that should be accorded copyright protection even though it was intended to be a faithful representation of actual persons, Holmes wrote a paean to the individuality of artistic genius quite at odds with the previously asserted facts of corporate creation and control. If the law were otherwise, it "would mean that a portrait by Velasquez or Whistler was common property because others might try their hand on the same face."²⁰¹ Holmes insisted that the pictures were

the personal reaction of an individual upon nature. Personality always contains something unique. It expresses its singularity even in handwriting, and a very modest grade of art has in it something irreducible, which is one man's alone. That something he may copyright unless there is a restriction in the words of the act.²⁰²

Ultimately, the fiction that the employer is the author allowed Holmes to elide the question of how a corporation could be entitled

199. 188 U.S. 239 (1903).

200. *Id.* at 248.

201. *Id.* at 249.

202. *Id.* at 248. Justice Harlan's dissenting opinion asserted that an advertisement could not be copyrighted because it was not "art" and lacked sufficient "connection with the fine arts to give it intrinsic value." *Id.* at 252 (Harlan, J., dissenting). Holmes rejected Harlan's view of the proper scope of copyright law:

It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At the one extreme, some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke. It may be more than doubted, for instance, whether the etchings of Goya or the paintings of Manet would have been sure of protection when seen for the first time. At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge. Yet if they command the interest of any public, they have a commercial value,—it would be bold to say that they have not an aesthetic and educational value,—and the taste of any public is not to be treated with contempt. It is an ultimate fact for the moment, whatever may be our hopes for a change.

Id. at 251.

to copyright an advertisement if the justification for the copyright is “the personal reaction of the individual upon nature.”²⁰³

Holmes’ opinion in *Bleistein* is a lovely illustration of his insight about the essential characteristic of the common law method.²⁰⁴ He invoked the traditional notion of authorship as artistic creation—“the personal reaction of an individual upon nature”—while giving it an entirely new significance: corporate authorship of advertisements. To expand copyright protection into new media, he equated “the etchings of Goya” and “the paintings of Manet” with commercial advertising. He did so precisely because giving new content to the old form of authorship was an effective rhetorical strategy to expand copyright protection. By eliding the distinction between the legal fiction of corporate authorship and the fact of collaborative creation in a corporate setting, and by effacing the (ever-shrinking) difference between advertising and art, Holmes made a significant change in doctrine that seemed to be nothing more than a simple analogy.

B. The Work-for-Hire Doctrine in the Courts

The first cases in which courts found that the fact of employment or the act of commissioning a work, without more, entitled the employer to the copyright were decided in 1899 and 1900, respectively. In neither case did the court acknowledge the difference between the precedents, all of which involved a contractual allocation of copyright, and the instant situations where no contract existed.

In *Collier Engineer Co. v. United Correspondence Schools*, a salaried employee had the job of preparing and revising instructional materials for a correspondence school.²⁰⁵ In subsequent employment, the employee-author sought to write similar materials. Although the court declined a preliminary injunction, finding it unclear from the evidence whether the new materials infringed because both the new and the original materials were compilations drawn from other sources, the court nevertheless stated without elaboration that the

203. Another court did not bother to justify it, simply relying on *Schumacher* as controlling authority. *See Mutual Adver. Co. v. Refo*, 76 F. 961, 963 (C.C.D.S.C. 1896).

204. *See* O.W. HOLMES, JR., THE COMMON LAW 5 (Dover photo. Reprint 1991) (1881) (“The customs, beliefs, or needs of a primitive time establish a new rule or a formula. In the course of centuries the custom, belief, or necessity disappears, but the rule remains. The reason that gave rise to the rule has been forgotten, and ingenious minds set themselves to inquire how it is to be accounted for. Some ground of policy is thought of, which seems to explain it and to reconcile it with the present state of things; and then the rule adapts itself to the new reasons that have been found for it, and enters on a new career. The old form receives a new content, and in time even the form modifies itself to fit the meaning which it has received.”).

205. 94 F. 152 (C.C.S.D.N.Y. 1899).

employer was entitled to the copyright on the materials.²⁰⁶ The court acknowledged the possibility that the employee would be unduly constrained from using the knowledge he had acquired about teaching and so attempted to find a middle ground:

[A]lthough Ewald was not at liberty to reproduce so much of his work as had been copyrighted by the employers for whom it was prepared, even by availing of his recollection of the contents of the copyrighted pamphlets, he was not debarred, after his contract terminated, from making a new compilation, nor from using the same original sources of information, nor from availing of such information as to the needs of students and the best methods of getting in mental touch with them as he may have acquired while superintending complainant's school.²⁰⁷

Gone was the focus on the author's entitlement to the fruits of his creative genius. Instead the court focused on the task of accommodating employer ownership of intellectual property with some measure of employee freedom to use his knowledge in subsequent employment.

The next year, in *Dielman v. White*,²⁰⁸ a court recognized the right of the person who commissions a work to own the copyright. Dielman had received the commission to design a mosaic for the Library of Congress. He painted a sketch of the mosaic, copyrighted it, and then sent it to Venice, where the mosaic "was manufactured in the usual manner by workers in mosaic."²⁰⁹ Both the sketch and the mosaic bore the notation: "Copyright, 1896, by Frederick Dielman."²¹⁰ Nothing was said in the correspondence between Dielman and the Library of Congress about copyright ownership. When officials of the Library published photographs of the mosaic, Dielman sought an injunction against their publication, which the court denied:

In general, when an artist is commissioned to execute a work of art not in existence at the time the commission is given, the burden of proving that he retains a copyright in the work of art executed, sold, and delivered under the commission rests heavily upon the artist himself. If a patron gives a commission to

206. *Id.* at 153.

207. *Id.* at 153.

208. 102 F. 892 (C.C.D. Mass. 1900).

209. *Id.* at 893. This characterization of the contribution of the Italian mosaic workers raises the question whether anything that they did was sufficiently creative as to vitiate the claim of either of the American contenders to be the true "author" of the mosaic. The court did not address that question, revealing that its ability or willingness to understand the truly collaborative nature of the creation was not without limits.

210. *Id.*

an artist, there appears to me a very strong implication that the work of art commissioned is to belong unreservedly and without limitation to the patron.²¹¹

The court recognized the constraints such a rule might impose on an artist's ability to make further use of the design, but concluded that those issues were matters "of artistic ethics rather than of law."²¹² What had been a legal rule only a generation before had been downgraded to the status of "artistic ethics."²¹³

After these cases, courts more readily saw employees who produced copyrighted materials as employees hired to write rather than as independent creators whose individuality was reflected in their creation. In *Edward Thompson Co. v. American Law Book Co.*, which concerned the copyright to multi-volume encyclopedias of English and American law, the court deemed it "unnecessary, as it might be impracticable" to identify the actual authors of the work, since "[i]t sufficiently appears that complainant's publication is the result of the intellectual labor of the editors and compilers employed by the complainant."²¹⁴

Similarly, in *National Cloak & Suit Co. v. Kaufman*, the court easily accepted the proposition that a corporation could copyright a fashion catalogue prepared by its employees.²¹⁵ The basis for the corporation's copyright protection was that the corporation "exercised the most careful supervision and discrimination and made large outlays and expenditures."²¹⁶ The court did not find artistic or literary creativity irrelevant; it only decided that the corporation was entitled to the credit. The corporation employed "artists and authors of peculiar skill and ability," and the pictures and text,

embodied the personal reaction of artists of recognized skill in their calling, and were pictures of artistic merit, and . . . were of peculiar value as portraying original conceptions and creations

211. *Id.* at 894.

212. *Id.*

213. Eventually, courts distinguished the rights of employees from those of independent contractors and backed away from the presumption of employer ownership articulated in *Dielman v. White*. In *Edward Thompson Co. v. Clark*, 109 N.Y.S. 700 (Sup. Ct. 1904), and *W.H. Anderson Co. v. Baldwin Law Publishing Co.*, 27 F.2d 82 (6th Cir. 1928), both of which involved publishers of law books, the courts distinguished the rights of independent contractors from those of employees. The Sixth Circuit wrote:

[W]here a contract of employment is silent, there may be an implication in favor of the employer. But in the present case plaintiff was an independent contractor, rather than an employee; moreover, it may properly be inferred that the parties did not intend plaintiff to surrender a copyright in consideration of a sum less than the bare cost of the work.

Id. at 88.

214. 119 F. 217, 219 (C.C.S.D.N.Y. 1902).

215. 189 F. 215 (C.C.M.D. Pa. 1911).

216. *Id.* at 216.

relating to wearing apparel, of great interest to a large proportion of the public on account of the originality and exercise of trained aesthetic faculties displayed in said illustrations.²¹⁷

Finally, in a few cases decided just before the enactment of the 1909 Copyright Act, courts enforced express contracts allocating to employers the copyright in law books prepared by employees. The courts rejected the employees' contentions that they were entitled to credit as authors or to control the corporation's subsequent alterations of their work. The cases thus made clear that employers of works made for hire pursuant to express contracts owned all the rights to the works, just as if the corporations were the authors themselves.²¹⁸

C. The Enactment of a Work-for-Hire Doctrine in the 1909 Copyright Act

The 1909 revision of the copyright law made concrete, as well as catapulted forward, a change that had just begun in the case law. The 1909 Copyright Act added a provision stating that employers were the authors of works made by employees.²¹⁹ The decision to label the employer an "author," rather than create a default rule of implied automatic assignment, appears to have been based on three considerations. First, it was a matter of ease in statutory drafting ("author" is a term of art used throughout the statute). Second, it avoided constitutional doubts about a default rule of employer ownership stemming from the constitutional provision that Congress may give "authors" a copyright.²²⁰ Third, and most importantly, the drafters of the revision wanted to be sure that the employer would be the initial copyright owner rather than an assignee, because only the initial owner is entitled to obtain a renewal.²²¹ Of course, Congress could have achieved the same result by changing the law regarding who may apply for a renewal, but that option was not

217. *Id.*

218. *See, e.g.*, *Chamberlayne v. Am. Law Book Co.*, 163 F. 858 (C.C.E.D.N.Y.), *rev'd*, 165 F. 313 (2d Cir. 1908) (holding that by assigning a copyright by express contract an employee lost his right to sue for "trespass to literary property" for alterations to an article he wrote for inclusion in an encyclopedia); *Jones v. Am. Law Book Co.*, 109 N.Y.S. 706 (N.Y. App. Div. 1908) (holding that an express contract assigned a copyright to an employer and that therefore the employee cannot insist that he be listed as an author of the work).

219. Act of March 4, 1909, ch. 320, 35 Stat. 1075.

220. U.S. CONST. art. I, § 8 empowers the Congress "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."

221. *See* 1 LEGISLATIVE HISTORY OF THE 1909 COPYRIGHT ACT 56 (B. Fulton Brylawski & Abe Goldman eds., 1976).

considered, perhaps because it was deemed too big an incursion into the public domain.

The work-for-hire provision originated in a pair of conferences that Herbert Putnam, the Librarian of Congress, convened in 1905 at the request of the Chairman of the Senate Committee on Patents. Putnam invited representatives from a number of industries and from the American Authors' League to discuss the need for and the desirable terms of a revised copyright law. The early version of the draft bill presented at the first conference stated that only "authors" could obtain copyrights.²²² In a series of discussions on that provision, various representatives of publishing and lithographic industries advocated recognizing the right of the employer to obtain copyright under the statute. One Samuel J. Elder of Boston urged that publishers of encyclopedias and other works requiring the assistance of a large number of people needed some method other than individual assignments to obtain effective ownership of the copyright to the complete project. The problem, he explained, was that only the "author" of a work, and not the "proprietor" who might own the copyright because of an assignment by the author, could obtain a renewal of the copyright after the expiration of the original term.²²³ To renew the copyright to an encyclopedia, the publisher would "have to go searching all over the world from widows and legitimate children, and the search is so great that the renewal term can hardly be obtained."²²⁴ Elder noted, however, that any revision to enable publishers to obtain renewals would be "confined by the language of the Constitution to authors and by the broadening of the idea that the courts have given it to the assignees of authors."²²⁵ He thus seemed to suggest that employers must be defined in the statute as the "authors" of the works in order to obtain a renewal term.

222. 2 *id.* at xxiv.

223. 1 *id.* at 56.

224. *Id.* Renewal rights were inheritable but not readily assignable. Prior to the 1909 Act, the renewal right was given to the author, if living, or to his spouse and children if the author died prior to the commencement of the renewal term. Act of Feb. 3, 1831, ch. 16, § 2, 4 Stat. 436. *See generally* Seymour M. Bricker, *Renewal and Extension of Copyright*, 29 S. CAL. L. REV. 23, 24 (1955) (summarizing provisions of the 1831 Act). The 1909 Act included a similar provision. It did not prevent authors from assigning future rights to renew during the original copyright term. Such an assignment, however, granted only an expectancy, the fulfillment of which depended upon the author's surviving to the end of the initial term. If the author did not survive, the renewal right returned to the author's statutory successors. *See* Miller Music Corp. v. Charles N. Daniels, Inc., 362 U.S. 373 (1960). The rationale for the restriction on renewal was to protect authors and their dependents from improvident bargains; the compulsory bequest that favored the author's heirs over assignees was an additional protection to allow the author's family to renegotiate the value of the assignment when the value of the copyright was known. Daniel A. Saunders, Comment, *Copyright's Broken Rear Window: An Appraisal of Damage and Estimate of Repair*, 80 CAL. L. REV. 179, 185 & nn.23-27 (1992).

225. 1 LEGISLATIVE HISTORY OF THE 1909 COPYRIGHT ACT, *supra* note 221, at 54.

Robert Underwood Johnson, Secretary of the American Authors' Copyright League, objected to the notion that an employer should be deemed the "author" of works created by employees. He proposed that the statute create two categories: "authors" and "proprietors." Each term should be given "the most inclusive definition possible," but he insisted that "a man who gets up a cyclopedia and contracts with other people to write for him" was only "the proprietor and ought to be considered the proprietor, and not the author."²²⁶ Underwood's objection was based on the symbolic value of the term "author," rather than on the notion that the encyclopedia publisher was not entitled to copyright, or even to a renewal term.

Based on the comments made during the first few days of the conference, the Copyright Office drafted a revised bill. It did not have a general work-for-hire provision. Rather, it listed in separate sections the various persons who would be entitled to claim a copyright. Among them was the "publisher of a composite or collective work (a 'series,' a 'library,' or an encyclopaedia) which has been produced at his instance and expense."²²⁷ In a separate section, the draft bill stated:

If a person employs another for valuable consideration to make a portrait, that is to say a work whose principal object is the likeness of any person in any form of art, the copyright in such portrait shall belong to the employer as if he were the author, in the absence of any agreement in writing to the contrary.²²⁸

The discussion on the revised draft circulated by the Copyright Office revealed that publishers and employers remained dissatisfied. One complained:

We have people who work for us who make engravings or etchings for us under salary. Under the new law—if it becomes a law as drafted—they would have the right to copyright, and I think it would be well to express in such a law that where no agreement exists to the contrary the payment of a salary to an employee shall entitle an employer to all rights to obtain a copyright in any work performed during the hours for which such salary is paid. It seems to me these things should not be left to the courts to decide.²²⁹

This comment reflected a number of concerns. It reflected a

226. *Id.* at 56.

227. 2 *id.* at xxiv.

228. *Id.*

229. *Id.* at 65.

perception that the extant law did not operate as a default rule that could be modified by contract since courts would not enforce contracts for employer ownership. It suggested that courts were too unpredictable in what they would find sufficient. It also suggests that employers found it too onerous to have to contract for employer ownership. In other words, this was one of those circumstances in which the initial entitlement to copyright mattered because it would be too expensive or difficult to contract for any other allocation. Employers may also have wanted a default rule of employer ownership because they thought employees were unlikely to realize the rule and would need to contract for their copyrights. As John Witt has suggested, the uncertainty of the default rule may have systematically advantaged employers “who were able to spread the cost of legal expertise and contract negotiation across multiple employment contracts.”²³⁰ Whatever the reason, employers plainly realized that a default rule of employer ownership would be to their advantage.

Richard Bowker of the American Authors’ Copyright League proposed alternative language for the definition of author to include not only writers, composers, and painters, but also “the conductors of a periodical, the joint authors of a collaborative work, a corporate body with respect to the publications of such corporation, and a person or persons at whose instance and expense a composite work is produced.”²³¹

The representative of the Lithographers’ Association and the Reproductive Arts Copyright League argued that “the case of manufacturers” should be distinguished from the case of other artists and writers:

Now, it seems to me that we have forgotten that, and that the right belonging to that artist who is employed for the purpose of making a work of art so many hours a day, or that literary producer who is employed for so many hours, should be very different from the right that is held by the independent artist or man who makes a painting for art’s sake. I would suggest, therefore, that in this clause there should be an exception that this does not apply, where contractual relations exist between the owner and the artist.²³²

In response, it was suggested that “an exception [be] made in behalf of the person at whose expense such works were made.”²³³

230. Witt, *supra* note 161, at 654.

231. 2 LEGISLATIVE HISTORY OF THE 1909 COPYRIGHT ACT, *supra* note 221, at 143-44.

232. *Id.* at 188.

233. *Id.*

After that conference, the Librarian of Congress and the Copyright Office circulated a new draft bill. This version contained a new section 21 defining who may obtain a copyright. The provision stated:

That the author of any work made the subject of copyright by this Act, or his executors, administrators, or assigns, shall have copyright for such work under the conditions and for the term specified in this Act, including:—

The author of any original literary, dramatic, artistic, musical, cartographical, geographical, or other similar production:

....

An employer, in the case of a work produced by an employee during the hours for which his salary is paid, subject to any agreement to the contrary.²³⁴

Finally, in December of 1906 joint hearings were held before the House and Senate Committees on Patents on S. 6330 and H.R. 19853, which included the results of the Librarian of Congress's conferences. The version of the work-for-hire provision that was enacted into law appeared in those bills. It was section 63, which read, in full:

That in the interpretation and construction of this act “the date of publication” shall in the case of a work of which copies are reproduced for sale or distribution be held to be the earliest date when copies of the first authorized edition were sold or placed on sale; and *the word “author” shall include an employer in the case of works made for hire.*²³⁵

This statutory definition of the author as including the employer in the case of “works made for hire” has been in the statute ever since.²³⁶

It would be too simple to say that the drafters of the 1909 Act simply codified what was already clear in the cases, or that the cases changed their tune as soon as the statute was enacted. Rather, both the courts and the drafters seemed to arrive at the same conclusion

234. 3 *id.* at xxx.

235. 4 *id.* at pt. J.

236. See Borge Varmer, *Works Made for Hire and on Commission*, Study No. 13, Copyright Law Revision, Studies Prepared for the Subcommittee on Patents, Trademarks, and Copyrights of the Committee of the Judiciary, U.S. Senate, 86th Cong., 1st Sess. 128 (1960) (noting that the provision of the Copyright Act stating that “the word ‘author’ shall include an employer in the case of works made for hire” was enacted in 1909 “and represented the first legislative attempt to deal with the relationship of employer and employee in the field of copyright”).

at roughly the same time, and evidenced similar sorts of practical concerns as they changed the law. Moreover, neither the courts nor the drafters described their efforts as creating a *new* rule. Rather, both seemed to think they were simply stating what a sensible analysis of what the employment contract already was.

V. CONCLUSION

Throughout the nineteenth century, the rights of employee authors (like those of employee inventors) received considerable respect from courts that were not otherwise inclined to grant significant protections to employee rights. From the Supreme Court's widely cited decision in *Wheaton v. Peters* until 1860 (and in some cases beyond), virtually every court that confronted the issue determined that, as a default rule, employees who produced copyrighted work owned the copyright, even if they did so in the scope of their employment. Around 1860, courts began to recognize employer ownership, either through express contracts as a matter of equity, or, eventually, by discerning in the employment relationship the existence of implied contracts to the same effect. In the first decade of the twentieth century, the default rule became the exact opposite of what it had been in the last century, and employers became entitled to their employees' creative works in the absence of an agreement to the contrary.

It had been well understood for hundreds of years that employers had a property interest in the fruits of their employees' labor. Employers owned the goods they produced, the minerals they extracted, the crops they harvested. Why were creative works different? And why did the rule flip 180 degrees over the course of a few generations?

One task of this article has been to illuminate the many reasons why creative works were different. They were different because they were creative and because the rhetoric of authorship carried special force on the facts of the cases the courts confronted that it did not carry with other forms of property. They were different because the employees who generated them were not servants. They were different because courts thought that employee ownership was a principle that most likely reflected the actual understanding between the parties and, even if they did not, courts were prepared to punish the employer who failed to negotiate explicitly for copyright ownership. And, finally, they were different because employee ownership was most likely to produce the greatest production of copyrighted material that courts cared about most: law books.

Toward the end of the nineteenth century and the early twentieth, however, things had changed. The rise of the corporation made

employer control of all intellectual output of the persons in their employ more logical and more rhetorically appealing. One could say a corporation was the “author” of materials produced by a group of persons in its employ in a way that one could not say that Dion Boucicault’s business partner was the “author” of a play that both of them conceded Boucicault had in fact written. The kinds of materials that were subject to copyright had expanded to include more materials prepared in a collaborative way in a corporate setting. It became apparent that employee ownership of copyrights thwarted the publication of encyclopedias by making it difficult to obtain renewals. Workers who created copyrighted material could more easily be subsumed into the class of employees (not servants). The rise of a unified law of employment, and newly uniform implied rights and obligations, also favored employers.

The development of the work-for-hire doctrine was not inevitable. If American law had recognized moral rights as French law does, it might have been more difficult to imagine how the corporation could acquire all the rights to the employee’s works. One of the drafters of the 1909 Act expressed precisely this concern: He worried that employer ownership might allow a firm to alter and degrade a work after its creation and injure the reputation of the individual employee who was known to have been its creator.²³⁷ Even as late as 1909, those with reservations about a wide-ranging work-for-hire doctrine might have won the day. Conversely, if more map cases and fewer theater and law publishing cases were litigated at mid-century, perhaps the doctrine would have been settled in favor of the employer much earlier. Even a rule that today seems intuitively obvious to many might have taken a turn in a different direction at a number of points in the past.

This episode of doctrinal change suggests a larger point about the crucial importance that legal fictions and the common law method play in mediating profound legal change. The cases are rife with tension between crucial competing policies: the power of the individual and the felt imperatives of economic development, the ideology of individual authorship, and the premises of master and servant law. The basic conflict between individual and corporate rights was obscured in vague discourse about the nature of legal rules. Courts recharacterized the nature of authorship, filling an empty, or perhaps a very malleable, vessel like “authorship” with an evolving meaning. The old form received new content, even as the rhetorical force of the form carried on. Given the force of the concept of “authorship,” it was especially important that the courts

237. 3 LEGISLATIVE HISTORY OF THE 1909 COPYRIGHT ACT, *supra* note 221, at 340.

use the old form rather than reject it and invent a new one, because the old form legitimated a profound change in property rights at a time when the property rights of the individual were near and dear to the hearts of judges and the accumulating power of corporations was viewed with suspicion.

Though this is not the place to assay a theory of jurisprudence and the common law method, a few preliminary thoughts must have their say. I think it was the extraordinary case, not the ordinary one, which drove the development of the law.²³⁸ In *Wheaton v. Peters* and *Boucicault v. Fox*, the employee's claim to authorship was compelling. The absence of an applicable overarching legal category that directed an opposite result (neither *Wheaton* nor *Boucicault* was a "servant" and there was not yet a unified law of "employees") made it logically possible to create a rule of employee authorship without regard for the old master-servant doctrine that would place ownership of the servant's work product in the hands of the master. True to what Llewellyn called the "Grand Style," the Justices or judges felt free to create a rule of employee authorship because there was not a contrary rule and because it suited their philosophical inclination (in both cases) and their instrumental goals (especially in *Wheaton*). Thereafter, judges felt themselves sufficiently restrained by the dictum of *Wheaton* and the holding of the two *Boucicault* cases to rule in most cases that employees owned the copyrights to their works. But they were not constrained entirely, as illustrated by Llewellyn's "selection of available impeccable precedent techniques" for distinguishing precedent.²³⁹ In *Keene v. Wheatley*, the court could create a new equitable principle of employer ownership because copyright rules were not at issue—see Llewellyn's principle No. 19 (the prior rule is kept from application because its reason does not fit); No. 35 (the case falls outside the rule); and No. 54 (the case establishes a new concept).²⁴⁰

When Congress administered the *coup de grace* in the 1909 Copyright Act, one could plausibly claim that the change was simply a small one of statutory drafting, not a large one divesting creative employees of the fruits of their intellectual labor. But since the kind of works subject to copyright had begun to include things less

238. On the question whether the ordinary case or the extraordinary one is the engine of common law change, see BENJAMIN CARDOZO, THE NATURE OF THE JUDICIAL PROCESS 99 (1921), who identifies as factors in common law change "the force of logical consistency," the "gradual breaking down [of doctrines] before the demands of practical convenience in isolated or exceptional instances," and "the generative force of the exceptions as a new stock." *See also* KARL LLEWELLYN, THE COMMON LAW TRADITION: DECIDING APPEALS (1960); ROSCOE POUND, INTERPRETATIONS OF LEGAL HISTORY (photo. reprint 1986) (1923).

239. LLEWELLYN, *supra* note 238, at 77-91.

240. *Id.* at 81, 85, 89.

intellectual, and as the replacement of small partnerships by large corporate enterprises was well underway, the moral claim of the firm seemed stronger (and the notion of corporate authorship less fictional) just as the moral claim of the employee waned.