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Mark Bartholomew

University at Buffalo School of Law

John Tehranian

Southwestern Law School

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Historical Kinship & Categorical Mischief: The Use and Misuse of Doctrinal Borrowing in Intellectual Property Law

Mark Bartholomew* & John Tehranian**

ABSTRACT: Analogies are ubiquitous in legal reasoning, and, in copyright jurisprudence, courts frequently turn to patent law for guidance. From introducing doctrines meant to regulate online intermediaries to evaluating the constitutionality of resurrecting copyrights to works from the public domain, judges turn to patent law analogies to lend ballast to their decisions. At other times, however, patent analogies with copyright law are quickly discarded and differences between the two regimes highlighted. Why? In examining the transplantation of doctrinal frameworks from one intellectual property field to another, this Article assesses the circumstances in which courts engage in doctrinal borrowing, discerns their rationale for doing so, identifies whether certain patterns of borrowing exist, and scrutinizes the value, propriety, and impact of such borrowing. By tracing the different strains that animate the courts' analogical jurisprudence in patent and copyright law, the Article builds on broader insights from the scholarship on legal borrowing and offers guidance on how to approach analogies between related legal regimes in a more disciplined fashion. In the end, the Article seeks to provide a better understanding of what juridical techniques courts may deploy to strengthen the efficacy of borrowing—so that importation of legal doctrine can do more good than harm—in intellectual property law and more generally.

* Professor, University at Buffalo School of Law.

** Visiting Professor of Law, UCLA School of Law & Paul W. Wildman Chair and Professor of Law, Southwestern Law School. This Article profited from feedback from presentations at the 2023 Copyright Scholarship Roundtable at the University of Pennsylvania Law School, the 2023 Law & Society Association Annual Meeting in San Juan, Puerto Rico, and the University at Buffalo School of Law, including suggestions from Shyamkrishna Balganesh, Barton Beebe, Bill Gallagher, Joseph Fishman, Jeanne Fromer, Jim Gardner, Shubha Ghosh, Paul Gugliuzza, Mathew Higbee, Jacob Noti-Victor, Gideon Parchomovsky, Jennifer Rothman, Jessica Silbey, David Simon, Eva Subotnik, Xiyin Tang, Rebecca Tushnet, Polk Wagner, and Christopher Yoo. Special thanks also go to Jeffrey Laufer for his invaluable research assistance and to the Kenneth and Harle Montgomery Foundation for its support.

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INTRODUCTION

Patent law and copyright law have a love-hate relationship. At times, courts embrace one of these intellectual property regimes as a defining example for the other. In the most important Supreme Court copyright cases of the past three decades—from introducing doctrines meant to regulate online intermediaries to evaluating the constitutionality of resurrecting copyrights to works in the public domain—the Justices have relied on patent

law analogies to guide their decisions.¹ Intellectual property crosspollination sometimes acts in the other direction as well. For example, the Court has chastised courts below for failing to use existing copyright rules to decide patent cases.² A lawyer assessing the copyright-patent interface from these cases alone would be justified in assuming the two doctrines were perfectly in sync.

At other times, however, patent and copyright law are characterized as opposites that do not attract, with judges abruptly contending that one has nothing to tell the other. Although courts frequently reference the “historic kinship” between patent law and copyright law as a warrant to import doctrines from the former regime into the latter, there are few examples of such borrowing in the opposite direction. The Federal Circuit, the only appellate court designated to hear patent cases, tends to find copyright law analogies unpersuasive and has repeatedly heralded “the need for a distinct patent-law analysis.”³ Such patent law exceptionalism is not confined to the Federal Circuit. Justice Ginsburg cautioned that patent law and copyright law “are not identical twins” while Justice Breyer noted “relevant differences,” including different histories of treatment of the two areas of law by the courts and Congress.⁴

Even more significant than the disparate treatment of patent-to-copyright borrowing versus copyright-to-patent borrowing is a more general inconsistency when it comes to this particular jurisprudential technique. When successful, appeals to other branches of intellectual property law are justified through references to history, doctrine, and parallel public policy goals. Yet in analogous situations, courts reject claims of a shared history between intellectual property regimes, find past examples of borrowing unavailing, or contend that differences between copyright and patent law make the public policy aims of one inapposite to the other. A wider perspective on intellectual property borrowing shows something observers often miss when focusing on a single case: tremendous judicial discretion and unpredictable application of borrowing arguments. Such variance should give borrowing proponents pause, as a lack of agreement on the guidelines for borrowing makes the technique appear less a disciplined measure for judicial decision-making and more a fungible rhetorical move designed to engineer a desired outcome.

What explains such divergent approaches to borrowing? Is there any way to predict when an analogy between bodies of intellectual property law will succeed and when it will fail? This Article takes a deep dive into intellectual

1. See *Golan v. Holder*, 565 U.S. 302, 321–24 (2012); *MGM Studios Inc. v. Grokster, Ltd.*, 545 U.S. 913, 935–37 (2005); *Eldred v. Ashcroft*, 537 U.S. 186, 201–04 (2003); *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 439–42 (1984).

2. See *Impression Prods., Inc. v. Lexmark Int’l, Inc.*, 581 U.S. 360, 374 (2017).

3. See, e.g., *Lexmark Int’l, Inc. v. Impression Prods., Inc.*, 816 F.3d 721, 756 (Fed. Cir. 2016).

4. *Lexmark*, 581 U.S. at 384 (Ginsburg, J., dissenting in part) (quoting *Sony*, 464 U.S. at 439 n.19); *SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC*, 580 U.S. 328, 352–54 (2017) (Breyer, J., dissenting).

property analogies to provide an answer. A small but growing body of scholarship debates the advantages and disadvantages of borrowing as a general jurisprudential technique. Borrowing's champions—many of whom operate in the field of constitutional law—contend that borrowing enhances predictability for litigants, makes legal reasoning more transparent, and democratizes once insular legal fields by increasing opportunities for nonspecialists. Borrowing's critics—including some scholars of intellectual property as well as other legal disciplines—warn that cross-legal fertilization erodes important boundaries between legal regimes.

To determine whether borrowing from one intellectual property arena to reform another does more good than harm, we need to examine the heuristics of the practice and assess how borrowing analyses are actually conducted by the courts. A review of the relevant jurisprudence reveals certain themes and tendencies when judges borrow and provides a means for evaluating when courts adequately justify borrowing and when they fail to do so.

The Article begins by synthesizing the existing literature on borrowing, defined as “importing elements from one [legal] domain to another to justify a certain outcome or treatment.”⁵ Part I explains what borrowing is and how it can be distinguished from the general legal technique of analogical reasoning. It also chronicles academic discussion of borrowing's purported advantages and disadvantages, both generally and in the particular context of intellectual property law.

Part II examines the case law to gain a better appreciation of how borrowing works on the ground. The cases reveal various ways courts justify patent-copyright borrowing as well as ways they reconcile decisions to reject such borrowing. Seminal Supreme Court decisions that shape not only the scope of copyright law but also the limits of free expression and the structure of international trade rely on the notion of a shared historical origin between patent and copyright law to justify importing a modern doctrinal rule from one to the other. At other times, the sheer weight of precedent—borrowing begets more borrowing—or recognition of theoretical or structural commonalities in the two regimes supplies the necessary support for the practice. Curiously, however, these justifications for borrowing are also just as likely to be discarded—in many cases, judges elect to discount advocates' claims of shared histories or public policy goals and deem past borrowing events unpersuasive.

Perhaps there is a better way to borrow. Part III moves from the descriptive to the prescriptive, asking whether borrowing, as currently applied, is leading to beneficial outcomes for intellectual property law and suggesting ways to engineer a more reasoned and rigorous approach to the practice. By consciously tethering borrowing to the benefits touted by its supporters—enhanced

5. Jacob D. Charles, *Constructing a Constitutional Right: Borrowing and Second Amendment Design Choices*, 99 N.C. L. REV. 333, 335 (2021); see also Nelson Tebbe & Robert L. Tsai, *Constitutional Borrowing*, 108 MICH. L. REV. 459, 461 (2010) (providing an alternative definition to borrowing).

predictability and accessibility—while keeping a careful eye on the advantages of preserving boundaries between legal regimes, this important, yet inconsistent, interpretative technique can be brought to heel and mobilized to improve the law of intellectual property. And while the focus of this Article is primarily on patent and copyright jurisprudence, we anticipate that the guidelines developed by our analysis have relevance for the crosspollination of legal doctrines in other areas of jurisprudence such as constitutional law, where the practice of borrowing is rife with both possibilities and peril.

I. BORROWING AS JURISPRUDENTIAL TECHNIQUE

This Part describes borrowing as a technique of judicial decision-making and chronicles its reception in the legal scholarship, situating the particular issue of borrowing between copyright and patent law within a broader general discussion of borrowing. Borrowing brings two bounded domains of legal knowledge into conversation even though the borrower accepts that each domain enjoys some degree of separateness and integrity. As described below, particular characteristics differentiate borrowing from the general use of analogical reasoning in the law.

A. WHAT BORROWING IS

Borrowing involves taking frameworks from one legal domain and deploying them in another domain.⁶ In perhaps the most influential article on borrowing, Nelson Tebbe and Robert Tsai define it as “the practice of importing doctrines, rationales, tropes, or other legal elements from one area of constitutional law into another for persuasive ends.”⁷ Modern constitutional law is especially teeming with borrowing. To take one example, in *Planned Parenthood v. Casey*,⁸ the U.S. Supreme Court announced an “undue burden” test to evaluate the constitutional legitimacy of restrictions on a woman’s right to terminate a pregnancy, weakening the *Roe v. Wade* framework that was less receptive to such restrictions.⁹ According to Tebbe and Tsai, *Casey*’s undue burden test originally came not from the law of substantive due process or reproductive rights, but from an earlier line of case law relating to the Dormant Commerce Clause, which is triggered when a state law interferes

6. Charles, *supra* note 5, at 335; Robert L. Tsai, *Considerations of History and Purpose in Constitutional Borrowing*, 28 WM. & MARY BILL RTS. J. 517, 518 (2019).

7. Tebbe & Tsai, *supra* note 5, at 461.

8. *Planned Parenthood of Southeastern Pennsylvania v. Casey*, 505 U.S. 833 (1992).

9. *Id.* at 873–74; Tebbe & Tsai, *supra* note 5, at 472–73. Of course, with the Supreme Court’s decision in *Dobbs v. Jackson Women’s Health Org.*, 142 S. Ct. 2228 (2022), which overturned *Roe v. Wade* and found that there was no constitutional right to an abortion secured under the Due Process Clause, this framework is no longer good law. *Id.* at 2242.

with (i.e., unduly burdens) Congress's power to regulate commercial activity.¹⁰ *Casey*'s undue burden standard has in turn been borrowed to assess some Second Amendment claims.¹¹ Other examples of borrowing abound, from export of the equal protection tiers of scrutiny to free speech jurisprudence¹² to reliance on one country's constitutional provisions to construct the constitution of another¹³ to, as we will see, deploying specialized doctrines from patent law to resolve copyright law issues.

Importation from a separate legal regime is not always a welcome development. For a successful borrowing event to occur, there must be some articulation, or at least implication, of an underlying principle of commonality.¹⁴

10. Tebbe & Tsai, *supra* note 5, at 472–73; see *Quill Corp. v. North Dakota*, 504 U.S. 298, 312 (1992) (citation omitted) (“[W]e have ruled that [the Commerce] Clause . . . bars state regulations that unduly burden interstate commerce.”); *Pike v. Bruce Church, Inc.*, 397 U.S. 137, 142 (1970) (applying “excessive burden” test for state regulation of interstate commerce); see also *Dobbs*, 142 S. Ct. at 2335 (Breyer, J., dissenting) (discussing use of *Casey*'s undue burden standard beyond abortion).

11. See *Nordyke v. King*, 644 F.3d 776, 785–88 (9th Cir. 2011); *People v. Flores*, 86 Cal. Rptr. 3d 804, 809 n.5 (Cal. Ct. App. 2008); see also Melanie Kalmanson, Note, *The Second Amendment Burden: Arming Courts with a Workable Standard for Reviewing Gun Safety Legislation*, 44 FLA. ST. U. L. REV. 347, 374–75 (2016). In its most recent decision on firearms regulations, *New York State Rifle & Pistol Ass'n v. Bruen*, 142 S. Ct. 2111 (2022), the Supreme Court's emphasis on historical practices resulted in the adoption of a “comparable burden” test, which required future courts to assess whether a modern firearm regulation imposed a “comparable burden [to relevantly similar historical regulations] on the right of armed self-defense and whether that burden is comparably justified” to determine the modern regulation's constitutionality. *Id.* at 2133.

12. Joseph Blocher & Luke Morgan, *Doctrinal Dynamism, Borrowing, and the Relationship Between Rules and Rights*, 28 WM. & MARY BILL RTS. J. 319, 321 (2019).

13. James A. Gardner, *Introduction: Election Law—Universal or Particular?*, in *COMPARATIVE ELECTION LAW* 2, 3 (James A. Gardner ed., 2022). A rich literature exists on how constitutional provisions travel (or do not travel) between different constitutional regimes around the world. Such international borrowing is outside the scope of this Article, which is focused on borrowing between legal subject areas in U.S. law. In recent decades, aside from acknowledgements regarding the borrowing of much of common law from the United Kingdom, the U.S. Supreme Court has often expressed profound reluctance to indulge anything that could be described as borrowing from the law of other countries. *Printz v. United States*, 521 U.S. 898, 921 n.11 (1997); *Lawrence v. Texas*, 539 U.S. 558, 598 (2003) (Scalia, J., dissenting); Guiseppe Franco Ferrari, *Legal Comparison Within the Case Law of the Supreme Court of the United States of America*, in *JUDICIAL COSMOPOLITANISM: THE USE OF FOREIGN LAW IN CONTEMPORARY CONSTITUTIONAL SYSTEMS* 94, 117 (Guiseppe Franco Ferrari ed., 2019) (describing commitment of recent appointees to the U.S. Supreme Court during their confirmation hearings to avoid recourse to foreign legal sources). *But see, e.g.*, *Roper v. Simmons*, 543 U.S. 551, 575 (2005) (citing international consensus in deeming the death penalty unconstitutional for offenders under the age of eighteen and noting that that “the Court has referred to the laws of other countries and to international authorities as instructive for its interpretation of the Eight Amendment's prohibition of ‘cruel and unusual punishments’”).

14. Blocher & Morgan, *supra* note 12, at 330; Charles, *supra* note 5, at 359 (“Courts and commentators do not typically import doctrine from another area of constitutional law without explaining *why* that choice is appropriate.”); Michael R. Siebecker, *Political Insider Trading*, 85 *FORDHAM L. REV.* 2717, 2745 (2017) (“The essential question is whether the concerns in each doctrinal realm are sufficiently similar so that transferring common law duties from one context to the other does not seem odd.”).

Different kinds of commonality may be convincing, but there are two chief borrowing rationales. First, there is the prudential argument—a claim that both the exporting law and the importing law are meant to serve the same economic or social goals.¹⁵ Hence, the belief that both areas of law are ideologically proximate can be used to justify borrowing. The thought is that if both areas of law are geared to solving similar social problems, then it is more likely that one regime’s legal framework will be a good fit for the other. For example, a belief that strict scrutiny is desirable to uncover forbidden governmental motivations justifies the standard’s transplantation from the equal protection context to free speech cases.¹⁶

Second, borrowing may be justified by the perceived similarity of two areas of law thanks to their structural or historical proximity. This seems to be the case with the migration of jurisprudence under the Free Speech Clause to other First Amendment domains like freedom of the press and assembly,¹⁷ and it is the argument made by those in favor of redeploying rigorous First Amendment doctrinal tests to evaluate firearm restrictions under the Second Amendment.¹⁸

When borrowing is rejected, it is typically because perceived dissimilarities in the two areas of law make claims to prudential or historical similarity unconvincing. Corporate law was deemed too foreign from agency law to allow the same duty of care to be applied in both contexts, with legal actors citing the two legal areas’ lack of structural alignment.¹⁹ For those opposed to repurposing First Amendment tests to also define the constitutional right to bear arms, much of the opposition stems from the belief that the two amendments serve fundamentally different purposes.²⁰

For the purposes of this Article, borrowing will only refer to the transplanting of a *doctrinal* framework from one legal context to another. We define borrowing in this way to focus our analysis and avoid certain risks inherent to the adoption of a broader conception of borrowing. Tebbe and Tsai cast a wider net in their analysis of constitutional borrowing, looking not just for trans-substantive application of doctrinal rules but also shared use of metaphors or values.²¹ They even included the shared use of “phrases or figures of speech” as well as “experiences” and “prototypes” in their analysis

15. PHILIP BOBBITT, *CONSTITUTIONAL FATE: THEORY OF THE CONSTITUTION* 61 (1982) (defining prudential argument).

16. Blocher & Morgan, *supra* note 12, at 331–32.

17. See generally TIMOTHY ZICK, *THE DYNAMIC FREE SPEECH CLAUSE: FREE SPEECH AND ITS RELATION TO OTHER CONSTITUTIONAL RIGHTS* (2018) (discussing the impact of the Free Speech Clause on other constitutional rights).

18. Joseph Blocher, *The Right Not to Keep or Bear Arms*, 64 *STAN. L. REV.* 1, 23 (2012).

19. Edward Rock & Michael Wachter, *Dangerous Liaisons: Corporate Law, Trust Law, and Interdoctrinal Legal Transplants*, 96 *NW. U. L. REV.* 651, 663–68 (2002).

20. See ZICK, *supra* note 17, at 203; Gregory P. Magarian, *Speaking Truth to Firepower: How the First Amendment Destabilizes the Second*, 91 *TEX. L. REV.* 49, 51–52 (2012).

21. Tebbe & Tsai, *supra* note 5, at 467.

of constitutional borrowing.²² While the broader considerations of borrowing engaged in by Tebbe and Tsai have value, consistently tracking the themes, rhetorical moves, or “experiences” listed in the relevant universe of all published opinions in a particular legal domain is a fraught, subjective exercise, more likely to generate misses and false positives. Relatively speaking, doctrinal methodologies have reasonably concrete, identifiable features, making accurate identification of a court’s decision to borrow (or not to borrow) more likely. One hazard of investigating borrowing is a tendency to spot only successful transplants while failing to detect borrowing failures.²³ Limiting scrutiny to doctrinal rules helps address this selection bias problem—courts are more likely to directly describe in a written opinion why they are rejecting a litigant’s proposed import of another legal methodology than to explain why they declined to adopt a particular theme, narrative, or metaphor favored in another area of the law.

Doctrinal rules are worthy of exclusive study not just because they are relatively easier to track across legal categories but also because they are the basic tools that players in the legal system rely on in arguing for particular outcomes in cases. Narratives and turns of phrase are part of the advocate’s toolkit, but approved doctrinal methodologies can take on greater persuasive power given their prior explicit judicial blessing in another context.²⁴ Borrowing still requires persuasive legal argument to succeed, but it is an approach that enjoys some presumption of legal favor given that the doctrinal mechanism to be exported is already recognized as “good law” in at least one legal subject area.²⁵ Given its seemingly persuasive force in legal argument, the phenomenon of borrowing deserves a close examination.

B. WHAT BORROWING ISN’T

As any first-year law student knows, legal decision-making rarely involves simply applying an established legal rule that is on all fours with the factual situation at hand. Law’s forward-looking nature necessitates a certain amount of abstraction, making it impossible to forecast its application to all potential

22. *Id.* Others have kept borrowing in tighter focus, only looking to the importation of particular doctrinal tests and frameworks from one area of law to another. *E.g.*, Blocher & Morgan, *supra* note 12, at 323; Jennifer E. Laurin, Essay, *Trawling for Herring: Lessons in Doctrinal Borrowing and Convergence*, 111 COLUM. L. REV. 670, 672 (2011).

23. Blocher & Morgan, *supra* note 12, at 338; Lee Epstein & Jack Knight, *Constitutional Borrowing and Nonborrowing*, 1 INT’L J. CONST. L. 196, 197 (2003).

24. Sometimes too much power. *See, e.g.*, Brandon L. Garrett, *Misplaced Constitutional Rights*, 100 B.U. L. REV. 2085, 2090 (2020) (chronicling misplacement of constitutional rulings by different governmental actors into settings they were not intended to regulate).

25. *See, e.g.*, Eric Ruben, *An Unstable Core: Self-Defense and the Second Amendment*, 108 CALIF. L. REV. 63, 81 (2020) (maintaining that judges engage in frequent borrowing “in part ‘to take advantage of the accumulated wisdom’ from better-developed areas of the law”).

scenarios.²⁶ Moreover, the body of extant jurisprudence is always finite, particularly so as one moves up the authority ladder. New, unforeseen situations prompt battles of analogies, particularly in legal fields where social, economic, and technological changes can foment new types of controversies ripe for adjudication. Cases can hinge on what line of precedent in a particular legal subject matter has the strongest resemblance to the matter at hand.²⁷ Some even go so far as to say that every hard case requires some form of analogical reasoning.²⁸

One might be inclined to think that when courts borrow from an area of law, they are simply analogizing one area of law to another, thereby engaging in the same kind of analogical reasoning endemic to legal argument. Courts deciding intellectual property cases argue about whether new technologies resemble dance halls,²⁹ valet parking,³⁰ driving on the highway,³¹ or using a library card.³² Is a contention that, for a particular legal issue, copyright law should be analogized to patent law no different from any other use of analogical reasoning in the law? If so, then maybe the phenomenon of legal borrowing is not worthy of its own study.

There are some things that make borrowing different from general reasoning from analogy and deserving of its own particularized examination. First, borrowing is purposive and conscious. The borrower intentionally appropriates something from another legal domain and seeks to deploy it in another legal domain, all the while making the act of borrowing transparent to audiences. This does not mean that borrowing is always fully thought out or optimal, but it does mean that it is not a subconscious process. As described by one scholar in chronicling how Second Amendment jurisprudence has been built by transplanting elements from other parts of the Constitution: “Borrowing occurs whenever constitutional actors argue for importing elements

26. Michael C. Dorf, *Legal Indeterminacy and Institutional Design*, 78 N.Y.U. L. REV. 875, 883 (2003) (“The indeterminacy problem appears to be built into the nature of the legal enterprise.”).

27. For example, in determining whether a party could be held secondarily responsible for copyright infringement without knowledge of the infringing activity, courts evaluated whether the relationship between the defendant and the direct infringer more closely resembled the relationship between a landlord and her tenant (no liability) or that of a dance hall operator and a musician operating on the premises (liability). *Fonovisa, Inc. v. Cherry Auction, Inc.*, 76 F.3d 259, 262–63 (9th Cir. 1996); *Shapiro, Bernstein & Co. v. H.L. Green Co.*, 316 F.2d 304, 307–08 (2d Cir. 1963).

28. Wilson Huhn, *The Stages of Legal Reasoning: Formalism, Analogy, and Realism*, 48 VILL. L. REV. 305, 305 (2003). Others would disagree. See Antonin Scalia, *The Rule of Law as a Law of Rules*, 56 U. CHI. L. REV. 1175, 1186–87 (1989) (urging resort to analogy only after formal application of an existing rule of law has failed); Douglas G. Baird, *Common Law Intellectual Property and the Legacy of International News Service v. Associated Press*, 50 U. CHI. L. REV. 411, 411 (1983) (criticizing the promiscuous use of analogical reasoning in intellectual property jurisprudence).

29. See *Fonovisa*, 76 F.3d at 262–64.

30. See *Am. Broad. Cos. v. Aereo, Inc.*, 573 U.S. 431, 448–49 (2014).

31. See *Brookfield Commc'ns, Inc. v. W. Coast Ent. Corp.*, 174 F.3d 1036, 1064 (9th Cir. 1999).

32. See *Aereo*, 431 U.S. at 456 (Scalia, J., dissenting).

from one constitutional domain to another to justify a certain outcome or treatment. . . .”³³ In other words, there must be some sort of claim as to why the borrowing is justified.³⁴ Borrowing demands some articulated rationale of commonality—in fact, such articulations are the measure of borrowing’s success or failure. This stands in contrast to analogical reasoning, which also relies on a perceived similarity but often occurs without a conscious or articulated perception of the principle that makes the similarity possible.³⁵

Second, borrowing differs from analogical reasoning in terms of the universe of what is available for the comparison. Borrowing only includes “legal elements” and those elements must be contained in another discrete body of law.³⁶ For borrowing to occur, the doctrinal device exported from one legal arena to another must be somewhat specific to the original arena. For example, use of the tiers of equal protection scrutiny to decide First Amendment issues or exportation of patent law’s rule immunizing sellers of “staple articles of commerce” from secondary liability to copyright law constitute instances of borrowing because they transplant a regime-specific doctrine to a new context. Analogizing the capture of wild animals to natural gas deposits is not borrowing because there is no well-defined legal boundary between wild animal law and natural gas law.³⁷ Nor would an appeal to the plain meaning of a legal text or a plea for judicial economy constitute borrowing—such appeals are endemic to legal argument in general and are not historically delimited to a particular legal subject matter.³⁸

Hence, the pool of potential material for borrowing is far more limited than the larger universe of things that are available for analogical reasoning. Analogical reasoning in the law looks for similarities between some previous set of facts and the set of facts currently under consideration.³⁹ All these

33. Charles, *supra* note 5, at 335.

34. *Id.* at 359 (“Courts and commentators do not typically import doctrine from another area of constitutional law without explaining *why* that choice is appropriate. In other words, they recognize that some justificatory work is required.” (footnote omitted)).

35. Frederick Schauer & Barbara A. Spellman, *Analogy, Expertise, and Experience*, 84 U. CHI. L. REV. 249, 266 (2017) (“What makes analogical reasoning distinctive is that although people who draw analogies see similarities that are necessarily based on principles or theories, these principles or theories are often so embedded in their thought processes that they are not consciously perceived.”); Frederick Schauer, *Precedent*, 39 STAN. L. REV. 571, 584 (1987); Blocher & Morgan, *supra* note 12, at 330; R. George Wright, *The Role of Intuition in Judicial Decisionmaking*, 42 HOUS. L. REV. 1381, 1417 (2006) (discussing “the inescapable dependence of the analogical method on intuitionism”).

36. Charles, *supra* note 5, at 345–46 (dividing recognized sources for borrowing into legal methodologies and “substantive rules”).

37. See generally Carol M. Rose, *Possession as the Origin of Property*, 52 U. CHI. L. REV. 73 (1985) (exploring how property comes to be owned, including how cases about possession of wild animals can help determine who owns natural resources).

38. Tebbe & Tsai, *supra* note 5, at 465.

39. Schauer & Spellman, *supra* note 35, at 253.

available facts give the legal decisionmaker an infinitely broader canvas than when the decisionmaker is deciding a question of borrowing.

A good example of the comparatively unfettered nature of analogical reasoning comes from *American Broadcasting Cos. v. Aereo, Inc.*,⁴⁰ a Supreme Court case where the Justices tripped over themselves in a rush to analogize Aereo's service, which digitally retransmitted over-the-air television broadcasts, to activities in the analog world.⁴¹ In a nearly comical scene at oral argument, ABC's attorney, Paul Clement, began with an analogy likening Aereo more to a car dealer, which sells cars to the public, as opposed to a valet parking service, which simply parks the cars that others own, Justice Roberts then wondered whether Aereo was actually akin to a type of valet service: "[L]ike a public garage in your own garage? I mean, you know, if you – you can park your car in your own garage or you can park it in a public garage."⁴² In an analogy that ultimately prevailed, Justice Sotomayor likened Aereo to a cable company, receiving signal transmissions and then "[m]ak[ing] secondary transmissions by wires, cables, or other communication channels."⁴³ Justice Breyer separately compared it to a record store (even though few of those exist anymore) that "sells phonograph records to 10,000 customers."⁴⁴ Comparisons were also drawn to coat checkrooms⁴⁵ and storage lockers.⁴⁶ After six Justices ultimately signed on to Justice Sotomayor's cable analogy, Justice Scalia excoriated the majority for its undisciplined approach to "guilt-by-resemblance."⁴⁷ Scalia then offered his own analogy: to "a copy shop that provides its patrons with a library card."⁴⁸ This kind of metaphoric free-for-all is not possible within the restrained confines of doctrinal borrowing.

Finally, borrowing offers greater persuasive momentum for a particular legal construction than a garden-variety use of analogical reasoning. Unlike a situation where a court argues that one factual situation resembles another, borrowing involves the selection of a legal element already considered and approved in another legal territory. This endows the borrowed item with a certain amount of currency, putting those opposed to such borrowing in a defensive posture. In contrast, for other kinds of analogical reasoning, the analogy touted to justify one side of a legal issue enjoys little presumption of

40. See generally *Am. Broad. Cos., Inc. v. Aereo, Inc.*, 573 U.S. 431 (2014) (using analogical reason to compare digital activities to analog ones).

41. See Transcript of Oral Argument at 3, *Am. Broad. Cos., Inc. v. Aereo*, 573 U.S. 431 (No. 13-461), 2014 WL 1608487, at *3.

42. *Id.* at 13-14.

43. *Id.* at 4.

44. *Id.* at 6.

45. *Id.* at 25.

46. *Id.* at 13.

47. *Am. Broad. Cos., Inc. v. Aereo, Inc.*, 573 U.S. 431, 457, 460 (2014) (Scalia, J., dissenting).

48. *Id.* at 456.

accuracy and is likely to be challenged by those on the other side as inapt.⁴⁹ This phenomenon was on display in the analogic battle royale in *Aereo*.⁵⁰ Indeed, determining that the already-approved undue burden test from Dormant Commerce Clause jurisprudence also fits well enough in the alternate setting of abortion rights and substantive due process is a rather different jurisprudential argument than claiming that abortion does or does not sufficiently resemble other medical procedures.⁵¹ The former argument enjoys some presumptive legitimacy that the latter argument lacks.⁵²

A study of intellectual property cases limited to doctrinal borrowing also avoids conflating borrowing with a different (though related) issue: the application of different philosophies of legal interpretation. The theoretical inputs for making a legal decision can be controversial.⁵³ In recent years, interpretative philosophies such as originalism and pragmatism have been increasingly viewed as tethered to political commitments.⁵⁴ By contrast, the outputs derived from such techniques, i.e., the doctrinal frameworks that implement the desired legal outcome, are still considered to be more of a neutral tool than a partisan judicial philosophy. As such, the borrowing of doctrines can also be less controversial.⁵⁵ This lack of controversy may explain

49. See, e.g., *Brookfield Commc'ns, Inc. v. W. Coast Ent. Corp.*, 174 F.3d 1036, 1064–65 (9th Cir. 1999).

50. One observer, Parker Higgins, quipped that, “The highest praise I’ve seen of the *Aereo* decision so far is that maybe it’s /such/ a mess that it can’t be applied to anything else.” Parker Higgins (@xor), TWITTER (June 25, 2014, 3:41 PM), <https://twitter.com/xor/status/481885025856933888> [<https://perma.cc/QP2Z-MYSM>]. In the decade since the holding, Higgins’s prescient view has proven largely true.

51. See Richard A. Posner, *The Problematics of Moral and Legal Theory*, 111 HARV. L. REV. 1637, 1675 (1998) (critiquing use of analogies to abortion because they “stimulate inquiry; they do not justify conclusions”).

52. This is not to say that borrowing is a trump card that automatically determines the outcome of a case. As discussed in detail below, there are many situations where borrowing is rejected. Moreover, borrowing from an area of law can fall out of fashion, leading to a decline in successful transplants from one legal regime to another. See David S. Law & Mila Versteeg, *The Declining Influence of the United States Constitution*, 87 N.Y.U. L. REV. 762, 850–55 (2012) (speculating as to reasons for declining influence of the U.S. Constitution as a model for written constitutionalism in other countries). Our point here is simply that legal borrowing—perhaps by virtue of its dependence on preapproved legal constructs and the subject matter expertise required for its application—possesses a greater degree of persuasive authority than mere reasoning by analogy.

53. See, e.g., Anya Bernstein & Glen Staszewski, *Judicial Populism*, 106 MINN. L. REV. 283, 284–85 (2021); David H. Gans, *This Court Has Revealed Conservative Originalism to Be a Hollow Shell*, ATLANTIC (July 20, 2022), <https://www.theatlantic.com/ideas/archive/2022/07/roe-overturne-d-alito-dobbs-originalism/670561> [<https://perma.cc/CJ3Z-TZUH>].

54. See, e.g., Gans, *supra* note 53.

55. Charles, *supra* note 5, at 350 (“Methodological borrowing is not all that controversial.”); Tebbe & Tsai, *supra* note 5, at 461 (“Borrowing is simply assumed to be as legitimate as any other mode of persuasion.”). Of course, the selection of doctrinal tools is not a neutral exercise and the line between legal interpretation and legal construction is not watertight. As Blocher and Morgan point out, some doctrinal tools are so bound up with the rights they are meant to

why borrowing has been relatively understudied. As we will see in Part II, however, this lack of scrutiny has allowed for some inconsistent results.

C. BORROWING'S RECEPTION IN LEGAL SCHOLARSHIP

So, is borrowing a good way to decide a new legal question? Overall, the extant legal scholarship on borrowing is celebratory. Borrowing is often touted as a mechanism with two chief benefits for deciding novel legal issues. It generates greater predictability than other legal techniques by virtue of harmonizing different parts of the law with each other. It is also described as a particularly transparent and accessible technique of legal interpretation—one that lends itself to further interrogation and refinement by nonexperts. Most academic commentary on borrowing centers on constitutional law. There is much less discussion of borrowing in the intellectual property context, and what little exists is not nearly as enthusiastic. Borrowing's most vocal critics have focused heavily on one potential shortcoming: its ability to erode considered and salutary boundaries between subject areas.

1. In General Legal Scholarship

While the legal scholarship on borrowing acknowledges potential problems, its benefits are seen as outweighing its costs.⁵⁶ One supposed benefit of borrowing is as a device for greater legal predictability. By causing a trend toward greater harmonization in the law, borrowing arguably makes the inevitable project of updating the law easier to forecast. Tebbe and Tsai maintain that borrowing clues in advocates to which forms of persuasion are likely to count, no matter the legal subject area. Rather than opening up appellate briefs to an endless array of potential borrowing opportunities, borrowing “has promoted a stable range of expectations.”⁵⁷

Borrowing also promotes predictability by helping judges avoid making decisions based on their judgment of the economic or political effects of a particular rule. According to Cass Sunstein, analogizing one area of the law to another is a way for courts and advocates to avoid “high-level theory,” which treads dangerously close to public policy judgments as opposed to legal interpretation.⁵⁸ Borrowing steers judges away from these public policy decisions,

implement that the line fades away completely. Blocher & Morgan, *supra* note 12, at 345. Still, this lack of separation is more likely to happen in the field of constitutional law than in the arena of intellectual property and “splitting the atom of rights and doctrine and focusing on the minutiae of doctrinal rules can provide valuable insights into the bigger picture questions.” *Id.* at 346.

56. Most of the scholarship on borrowing addresses constitutional law, examining the transfer of elements from one constitutional domain to another. *See, e.g.*, Tsai, *supra* note 6, at 518. In fact, some define borrowing as a uniquely constitutional phenomenon. *See* Charles, *supra* note 5, at 335.

57. Tebbe & Tsai, *supra* note 5, at 486.

58. Cass R. Sunstein, Commentary, *On Analogical Reasoning*, 106 HARV. L. REV. 741, 747 (1993).

for which (according to Sunstein) they are ill-equipped and are hard for outsiders to predict in advance.⁵⁹

Relatedly, borrowing is a legal technique that avoids the difficulty of applying broad-based theories of legal interpretation to resolve specific legal disputes. People typically lack a large-scale theory to develop reasons for making a decision, and even when equipped with such a theory, they have trouble yoking it to an explanation for a judgment. Just holding an originalist or pragmatist legal philosophy does not provide the answer as to how a case will be decided.⁶⁰ Another concern with reliance on broad theoretical constructs is that they may not be amenable to evolution over time and fail to adapt when morality or other surrounding conditions change.⁶¹ Instead of trying to implement a top-down legal theory to decide a particular issue, it is better to engage in bottom-up reasoning through comparison with other legal territories, a process that is not only more open to new facts and perspectives but actually more predictable than deciding cases based on “originalism” or “pragmatism.”⁶²

In addition to predictability, the other supposed benefit of borrowing is its accessibility. By promoting cross-fertilization between legal domains, borrowing resists the capture of a legal field by particular sections of the bar or other specialists. As one area of the law takes on the doctrinal methods of another, generalist attorneys and practitioners from other legal fields are encouraged to participate.⁶³ On similar grounds, others laud borrowing for promoting more coherence in the law, making it more easily understood by legal outsiders.⁶⁴ Instead of larding up areas of the law with unique multifactor tests and specific exemptions that can act as barriers to outside understanding

59. *Id.*; see also Adam J. Hirsch, *Intercategorical Analysis of Law*, 16 WASH. U. JURIS. REV. (forthcoming), <https://ssrn.com/abstract=4442129> [<https://perma.cc/AD9W-2BF3>] (calling for more “intercategorical analysis,” in part, because “a judge . . . should have an easier time thinking about multiple fields of law than applying with any degree of sophistication the principles of law-and-economics”).

60. Justice Kagan famously declared “we are all textualists now,” Harvard Law School, *The 2015 Scalia Lecture: A Dialogue with Justice Elena Kagan on the Reading of Statutes*, YOUTUBE (Nov. 25, 2015), <https://www.youtube.com/watch?v=dpEtszFToTg&t=113s> [<https://perma.cc/38XB-8ZV5>], but she has since questioned whether textualism truly guides the decisions of the Court. *West Virginia v. EPA*, 142 S. Ct. 2587, 2641 (2022) (Kagan, J., dissenting) (“It seems I was wrong. The current Court is textualist only when being so suits it.”). See generally Lawrence Solum, *We Are All Originalists Now*, in CONSTITUTIONAL ORIGINALISM: A DEBATE 1, 1–77 (2011) (discussing disagreement over meaning of “originalism”).

61. Sunstein, *supra* note 58, at 782.

62. *Id.*; see also Shyamkrishna Balganesh, *The Pragmatic Incrementalism of Common Law Intellectual Property*, 63 VAND. L. REV. 1543, 1547 (2010) (approving use of analogies in the common law of intellectual property as opposed to “relying on a single foundational theory”).

63. Tebbe & Tsai, *supra* note 5, at 484–94.

64. David S. Rubenstein & Pratheepan Gulasekaram, *Immigration Exceptionalism*, 111 NW. U. L. REV. 583, 632 (2017) (“[B]y bridging otherwise discreet doctrines, borrowing can deliver more coherence to the law.”); see also Schauer & Spellman, *supra* note 35, at 261 (arguing that analogical reasoning is domain-independent and, therefore, not the subject of expertise).

and entry, borrowing offers a vision of a more standardized, approachable universalist legal doctrine.⁶⁵

Borrowing backers also make a related point—borrowing differs from other mechanisms for rendering legal judgments in its transparency. Cass Sunstein contends that by prompting a conversation between two legal regimes, borrowing increases the visibility of legal argumentation, thereby allowing for more interrogation and testing from other litigants and courts.⁶⁶ Tebbe and Tsai suggest that borrowing makes legal actors more accountable.⁶⁷ Not only will legal officials be held to account for their acts of importation, particularly if they disturb settled ways of viewing the law in a particular area, but refusals to adopt frameworks that have been embraced in other areas will be strictly scrutinized.⁶⁸

Not every scholarly examination of borrowing has been positive. Critics have raised questions as to the potential for borrowing to stunt the development of areas of law that become net importers of doctrine⁶⁹ and the tendency of intentional acts of borrowing to provide momentum for unintentional further borrowing.⁷⁰ Indeed, as we shall see, in its worst incarnation, borrowing can take a discrete legal field with a carefully delineated statutory scheme and morph it over time, potentially driving it far away from the intent of legislators.⁷¹ Overall, however, scholars have generally cheered doctrinal borrowing, viewing the convergence it promotes between separate legal regimes positively for its predictability and accessibility.⁷²

2. In Intellectual Property Scholarship

There is much less scholarship specifically analyzing borrowing in the intellectual property law context. In fact, it is rare for intellectual property scholars to specifically refer to “borrowing” at all.⁷³ To the extent any discussion

65. Blocher & Morgan, *supra* note 12, at 336.

66. Sunstein, *supra* note 58, at 782.

67. Tebbe & Tsai, *supra* note 5, at 491.

68. *Id.*

69. ZICK, *supra* note 17, at 247; Blocher & Morgan, *supra* note 12, at 335.

70. Garrett, *supra* note 24, at 2089–90; Laurin, *supra* note 22, at 674.

71. *See infra* Section III.C.1.

72. Laurin, *supra* note 22, at 676 (“Notably, much of the academic attention paid to doctrinal borrowing has been positive or, at worst, neutral: It has focused on borrowing’s potential for facilitating the spread of desirable legal norms or assessed its role as a natural and inevitable dynamic in the law’s evolution.”).

73. *But see* Eva E. Subotnik, *Copyright and the Living Dead?: Succession Law and the Postmortem Term*, 29 HARV. J. L. & TECH. 77, 83 (2015) (noting that the Supreme Court “arguably engages in constitutional borrowing when using patent precedents to assess the constitutionality of copyright statutes”).

of borrowing between intellectual property regimes exists, it pulls in a very different direction.⁷⁴

Instead of celebrating borrowing for tearing down barriers between copyright and patent law, some lament borrowing's potential to erode boundaries purposefully set between the two regimes. For example, Pam Samuelson does not specifically address borrowing, but she views decisions permitting overlapping copyright and patent rights as a problem because such mixing flies in the face of congressional intent.⁷⁵ As proof of this intent, she points to the "starkly different contours" of the two regimes, including differences in duration, scope of rights, and remedies.⁷⁶ Presumably, every statutory difference between patent and copyright law reflects a legislative choice to treat the two regimes as separate entities. As a result, some observers, such as Christopher Yoo, have objected to decisions to borrow that neglect the role of legislative intent, as in the Supreme Court's jurisprudence on third-party liability for copyright infringement.⁷⁷ Nevertheless, as Yoo argues, such a risk is not a sufficient basis to categorically oppose all patent-copyright borrowing.⁷⁸

It is also worth considering Congress's creation of the Federal Circuit—an appellate court with exclusive jurisdiction over patent matters—as additional evidence of congressional desire for patent exceptionalism as opposed to a

74. Although not specifically discussing "borrowing," many articles maintain that it would be inappropriate to simply transplant a doctrinal test from patent to copyright. *See, e.g.*, Deepa Varadarajan, *The Uses of IP Misuse*, 68 EMORY L.J. 739, 773–75 (2019); Peter S. Menell & David Nimmer, *Unwinding Sony*, 95 CALIF. L. REV. 941, 943–44 (2007).

75. Pamela Samuelson, *Strategies for Discerning the Boundaries of Copyright and Patent Protections*, 92 NOTRE DAME L. REV. 1493, 1497–99 (2017).

76. *Id.* Samuelson's article focuses on efforts to simultaneously claim patent and copyright protection over the same article or different features of the same article, and she does not specifically examine examples of patent-copyright borrowing. Yet her critique would seem to also have implications for that practice. To the extent exports of patent doctrine to copyright law erode the distance between those two areas of law, such acts of judicial discretion seem to contradict congressional preference. For another critique of doctrinal convergence, see Barton Beebe, *What Trademark Law Is Learning from the Right of Publicity*, 42 COLUM. J. L. & ARTS 389, 389 (contending that convergence of these areas of law has "giv[en] us the worst of both worlds").

77. Christopher S. Yoo, *The Impact of Codification on the Judicial Development of Copyright*, in INTELLECTUAL PROPERTY AND THE COMMON LAW 177, 199–201 (Shyamkrishna Balganesh ed., 2013). Yoo reads the Copyright Act of 1976 as signaling no legislative intent to delegate authority to the courts to make law on this issue and maintains that the patent statute's broader secondary liability scheme should have triggered "a negative inference . . . with respect to copyright." *Id.* at 199.

78. *See, e.g., id.* at 178 ("It is an open question whether the patent provisions establish broad policies that should be applied to copyright law or whether the failure to enact parallel provisions with respect to copyright gives rise to a negative inference that renders such importation illegitimate."); *id.* at 196 ("Although limiting judges to drawing on the approaches taken by related statutes is easier to reconcile with legislative supremacy, reflexively drawing broad analogies between copyright and patent would be a mistake. Instead, courts must determine whether the legislature intended the statutes to be read together and, if so, whether a positive or negative inference would be more appropriate.").

wish to have the same rules govern both branches of IP.⁷⁹ Copyright cases must take a far more traditional path, proceeding no differently through the federal court system than general commercial litigation claims. Congress's decision that the subject matter of patent, but not copyright, warranted a unique appellate court suggests an interest in keeping the two bodies of law discrete.

Congressional intent aside, there are also strong prudential arguments for maintaining doctrinal distance between patent and copyright. Each regime's doctrine has been calibrated over time to encourage innovation, disseminate information, preserve competition, and accommodate free expression. Patent and copyright may have started as close cousins, but they quickly diverged as common law adjudication produced more and more sensible, regime-specific interventions.⁸⁰ Loosening of boundaries between the two regimes jeopardizes these decades of judicial fine-tuning.⁸¹

Furthermore, copyright law (as well as trademark and design patent law) has developed different rules meant to channel away certain works deemed better suited to the considered tradeoffs of the utility patent system. Because of the competitive dangers of monopoly control over the functional aspects of design, it makes sense to steer evaluation of those aspects to patent law, with its relatively high requirements for earning protection and its relatively short term, and away from copyright. Copyright law possesses multiple doctrinal tools—from a prohibition on copyrighting “any idea, procedure, [or] process”⁸² to a particularly rigorous test for analyzing the copyrightability of software given its high functionality⁸³ to a special “separability” analysis for utilitarian elements of industrial design and applied art⁸⁴—that are meant to serve this steering objective. Blithely swapping copyright and patent doctrines is in tension with copyright law's channeling aims.⁸⁵

Not all object to forging a closer relationship between patent and copyright law. According to Clark Asay, although rigid separation between the

79. Tejas N. Narechania, *Certiorari, Universality, and a Patent Puzzle*, 116 MICH. L. REV. 1345, 1400 (2018).

80. See Edward C. Walterscheid, *Divergent Evolution of the Patent Power and the Copyright Power*, 9 MARQ. INTELL. PROP. L. REV. 307, 355 (2005) (“At the end of the eighteenth century, there was indeed an historic kinship between patent law and copyright law . . . but today that kinship has largely, if not entirely, disappeared due to the divergent interpretation of the patent power and the copyright power by both Congress and the courts in the intervening 200 years.” (footnote omitted)); see also Derek E. Bambauer, *Paths or Fences: Patents, Copyrights, and the Constitution*, 104 IOWA L. REV. 1017, 1019–20 (2019) (discussing “a markedly different pattern in how [the Supreme Court] adjudicates copyright and patent cases”).

81. Samuelson, *supra* note 75, at 1515.

82. 17 U.S.C. § 102(b) (2018).

83. *Comput. Assocs. Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 706 (2d Cir. 1992).

84. *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 580 U.S. 405, 422–24 (2017).

85. See Mark P. McKenna & Christopher Jon Sprigman, *What's In, and What's Out: How IP's Boundary Rules Shape Innovation*, 30 HARV. J. L. & TECH. 491, 493 (2017) (discussing importance of “a reasonably clear and stable sense of what belongs to utility patent law” in articulating boundaries between copyright and other types of intellectual property).

two regimes may have made some sense in the past, modern creative and inventive activities are increasingly interdependent.⁸⁶ Asay believes that, instead of keeping to their legal silos, copyright and patent law should become more interdisciplinary and one way to achieve this hybridization is through doctrinal exchange.⁸⁷ In addition, there are a few examples of intellectual property scholars proposing particular acts of borrowing, even if they do not label it “borrowing,” or commenting on the wisdom of such cross-fertilization. Some of these scholarly suggestions include creating a patent fair use doctrine modeled on the defense in copyright,⁸⁸ altering copyright fair use to incorporate the patent law doctrines of novelty and nonobviousness,⁸⁹ deploying patent’s use of experts to rehabilitate copyright’s substantial similarity and fair use doctrines,⁹⁰ and transplanting copyright’s independent creation defense into patent law.⁹¹

There is an understandable tendency to view some level of borrowing between patent and copyright law as justified and one can hardly fault scholars and jurists for finding links between the two regimes. After all, the basis for both forms of protection lies in the same clause of the Constitution.⁹² Our legal nomenclature (at least in recent years) refers to the field of “intellectual property,” which conflates patent and copyright protections (along with trademarks, trade secrets and publicity rights).⁹³ And, promotion of progress serves as the common goal of both regimes.⁹⁴ Nevertheless, to the extent intellectual property scholars have considered the general phenomenon of borrowing, their overall reviews have been unenthusiastic and primarily concerned with the need for strong boundaries between the two fields.

In sum, the limited amount of legal scholarship on borrowing points to two benefits and one concern. The general practice of borrowing is celebrated (particularly in constitutional law) for making legal decision-making more predictable and accessible. In the setting of intellectual property, borrowing’s reception has been less favorable. There appears to be greater attachment to preserving boundaries between legal regimes in this context and more fear that borrowing could weaken those boundaries. What these mixed signals in

86. Clark D. Asay, *Intellectual Property Law Hybridization*, 87 U. COLO. L. REV. 65, 69 (2016).

87. *Id.* at 70.

88. See Maureen A. O’Rourke, *Toward a Doctrine of Fair Use in Patent Law*, 100 COLUM. L. REV. 1177, 1180 (2000); Katherine J. Strandburg, *Patent Fair Use 2.0*, 1 U.C. IRVINE L. REV. 265, 266 (2011).

89. Asay, *supra* note 86, at 112–15.

90. Jeanne C. Fromer & Mark A. Lemley, *The Audience in Intellectual Property Infringement*, 112 MICH. L. REV. 1251, 1299–1301 (2014).

91. Clark D. Asay, *Enabling Patentless Innovation*, 74 MD. L. REV. 431, 487–94 (2015).

92. See U.S. CONST. art. I, § 8, cl. 8.

93. See Mark A. Lemley, *Property, Intellectual Property, and Free Riding*, 83 TEX. L. REV. 1031, 1033–34 (2005) (noting that “[p]atent and copyright law have been around in the United States since its origin, but only recently has the term ‘intellectual property’ come into vogue” and detailing the “exponential growth in the use of the term” in recent decades).

94. See U.S. CONST. art. I, § 8, cl. 8.

the legal literature reveal is that the debate over borrowing demands empirical analysis. Careful study of the case law can reveal whether patent-copyright borrowing truly leads to more nonexpert participation, greater predictability, or the collapsing of key boundaries. In short, we need to investigate how borrowing actually works in the courts to come up with a more informed normative judgment about it. This is the task of Part II.

II. PATENT-COPYRIGHT BORROWING

To judge the success or failure of borrowing, it is best to evaluate it against its primary credits and demerits as articulated in the scholarly literature. As established in Part I, according to this literature, borrowing advances predictability and accessibility in the law, but also threatens to collapse key walls of doctrinal separation between subject areas. To assess how well borrowing matches these predicted costs and benefits, this Part scrutinizes the cases where courts have evaluated pleas for doctrinal exchange between patent and copyright law and the rationales advanced to either reject or accept such pleas. It begins with a detailed look at *Sony Corp. of America v. Universal City Studios, Inc.*—the most influential example of intellectual property borrowing.⁹⁵

A. SONY UNLEASHES THE MODERN ERA OF INTELLECTUAL PROPERTY BORROWING

Patent-copyright borrowing's big bang⁹⁶ can be traced to a 1984 U.S. Supreme Court decision involving a new technology of the time: the VCR.⁹⁷ The question before the Court was whether Sony, the maker of the device, could be held secondarily responsible for unauthorized replication of copyrighted television broadcasts by VCR owners.⁹⁸ Common law doctrines of

95. It is true that courts, including the Supreme Court, had occasion to compare intellectual property regimes against each other before *Sony*. At times, these comparisons produced arguments about how, at least for a particular legal issue, one intellectual property regime should be treated like another. For example, in determining whether a patentee, after conveyance to a wholesaler, could limit the price at which the patented item could be resold at retail, the Supreme Court found analogy to copyright law compelling, declaring “[t]he sale of a patented article is not essentially different from the sale of a book.” *Bauer & Cie v. O'Donnell*, 229 U.S. 1, 13 (1913). At the same time, however, courts were skeptical of such inter-regime borrowing. The Supreme Court cautioned that “wide differences” existed between patent and copyright law, see *Bobbs-Merrill Co. v. Straus*, 210 U.S. 339, 346 (1908) (quoting *John D. Park & Sons Co. v. Hartman*, 153 F. 24, 28 (6th Cir. 1907)), and lambasted appeals for treating trademarks legally similar to inventions or works of authorship as “surrounded with insurmountable difficulties.” *Trade-Mark Cases*, 100 U.S. 82, 93–94 (1879).

96. Courts had certainly engaged in intellectual property borrowing prior to 1984, but not so nakedly, keenly, and frequently.

97. *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 419–20 (1984). Technically, it was the Betamax. *Id.*

98. *Id.* at 420–21.

secondary liability have existed throughout the law for centuries,⁹⁹ but it was unclear which of these doctrines should apply in copyright law, which strives to balance the rights of authors with breathing spaces for downstream creation and technological innovation.

Searching for the right framework to balance these competing interests, the Court turned to patent law:

If vicarious liability is to be imposed on [the petitioner] in this case, it must rest on the fact that it has sold equipment with constructive knowledge of the fact that its customers may use that equipment to make unauthorized copies of copyrighted material. There is no precedent in the law of copyright for the imposition of vicarious liability on such a theory. The closest analogy is provided by the patent law cases to which it is appropriate to refer because of the historic kinship between patent law and copyright law.¹⁰⁰

Once the Court approved this instance of borrowing, Sony was in the clear. That was because, according to Section 271(c) of the Patent Act, the manufacturer of a device considered “a staple article or commodity of commerce” capable of “substantial noninfringing use” is not contributorily responsible for infringement even if it knew that the device was used by some to infringe.¹⁰¹ Because taping television programs to view them at a more convenient time qualified as a noninfringing fair use, the VCR qualified as a staple article capable of noninfringing activity.¹⁰²

For our purposes, the main question of interest is how the Court rationalized plucking this rule from patent law’s statutory scheme and embedding it in the separate world of common law copyright. *Sony* signaled a new receptivity to intellectual property borrowing from a Court that had previously emphasized the differences between patent and copyright law. Advocates got the message, promoting new arguments for sharing doctrines between the two legal regimes, and judges deployed *Sony*’s language as the template for evaluating such arguments.¹⁰³

The *Sony* majority used appeals to history, doctrine, and shared policy goals to justify transplanting a patent rule into the field of copyright law. It began with history, pointing to what it deemed the “historic kinship” of the two areas of law in the United States.¹⁰⁴ The Court did not articulate the

99. See Mark Bartholomew & John Tehranian, *The Secret Life of Legal Doctrine: The Divergent Evolution of Secondary Liability in Trademark and Copyright Law*, 21 BERKELEY TECH. L.J. 1363, 1366 (2006).

100. *Sony*, 464 U.S. at 439.

101. See 35 U.S.C. § 271(c).

102. *Sony*, 464 U.S. at 442.

103. Some borrowing in the lower courts took place immediately after the decision. See, e.g., *Harris v. Emus Records Corp.*, 734 F.2d 1329, 1333 (9th Cir. 1984) (referring to *Sony*’s “historic kinship” language to harmonize copyright licensing rules with patent law).

104. *Sony*, 464 U.S. at 439.

sources of this “historic kinship,” perhaps expecting its audience to know that both kinds of intellectual property protection are enshrined in the same clause of the Constitution and that Congress enacted legislation to implement them around the same time.¹⁰⁵ The Court did suggest that copyright and patent law were sufficiently similar because they were both so different from another intellectual property field: trademark law.¹⁰⁶ Citing to an 1879 case holding that trademark law could not claim the same source of constitutional origin as patent and copyright law, the *Sony* majority explained: “We have consistently rejected the proposition that a similar kinship exists between copyright law and trademark law, and in the process of doing so have recognized the basic similarities between copyrights and patents.”¹⁰⁷

The Court also made a doctrinal argument, essentially suggesting that its prior acts of patent-copyright borrowing paved the way for its borrowing in this matter. It offered three cases supposedly testifying to this doctrinal trend.¹⁰⁸ The Court provided citations only, with no explanation of the relevant analysis contained in each case.¹⁰⁹ Examination of the three cases reveals that each makes the broad point that both copyright and patent seek to incentivize the output of creators (whether authors or inventors) to benefit the public.¹¹⁰ None of the three cases touch on the specific issue of interest in *Sony*: selecting the proper standard for contributory infringement.

Finally, the majority contended that patent law and copyright law shared similar policy goals and that this similarity justified a common approach to assessing contributory liability. It noted that patent law’s primary concern lay in providing the public with access to new technologies.¹¹¹ Although this typically meant incentivizing inventors by allowing them to use the law to secure temporary monopolies, on some occasions such incentives needed to yield so as to facilitate other means of inventive dissemination.¹¹² The majority maintained that this was the case with patent’s “staple article of commerce”

105. See Dotan Oliar, *The (Constitutional) Convention on IP: A New Reading*, 57 UCLA L. REV. 421, 463–69 (2009) (using historical analysis to find that the text of the Intellectual Property Clause was not meant to distinguish between “science” and “useful arts”).

106. See *Sony*, 464 U.S. at 439 n.19.

107. *Id.*; see also *Sovereign Mil. Hospitaller v. Fla. Priory*, 702 F.3d 1279, 1291–92 (11th Cir. 2012) (chastising court below for borrowing from patent law to weaken the standard for evaluating fraud in an application for trademark registration given the lack of “historic kinship” between patent and trademark law).

108. *Sony*, 464 U.S. at 439 n.19 (citing *United States v. Paramount Pictures, Inc.*, 334 U.S. 131, 158 (1948); *Fox Film Corp. v. Doyal*, 286 U.S. 123, 131 (1932); *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591, 657–58 (1834)).

109. *Id.*

110. See *Paramount Pictures, Inc.*, 334 U.S. at 158; *Fox Film Corp.*, 286 U.S. at 127; *Wheaton*, 33 U.S. (8 Pet.) at 621.

111. *Sony*, 464 U.S. at 429.

112. *Id.* at 441 (“For that reason, in contributory infringement cases arising under the patent laws the Court has always recognized the critical importance of not allowing the patentee to extend his monopoly beyond the limits of his specific grant.”).

rule, which permitted patent holders to attach liability to some indirect infringers but not in all situations.¹¹³ The Court maintained that the same rule should apply in the copyright context as it correctly balanced incentives for creation with public access to beneficial technologies.¹¹⁴ Although not in the published opinion, during deliberations, Justice O'Connor wrote internally to Justice Blackmun, author of the *Sony* dissent, to make the case for patent-copyright policy commonality on this issue:

I had thought that the 'staple article' doctrine developed in order to limit the patent holder from depriving society of the good that comes from the existence of other enterprises that nevertheless frustrate the patent holder's monopoly to some degree. I see no reason why we should not be similarly concerned with what the copyright holder does with his monopoly. If the videorecorder has substantial noninfringing uses, we should be reluctant to find vicarious liability.¹¹⁵

Hence, the *Sony* decision invoked three kinds of argument—historical, doctrinal, and policy-based—to justify its act of patent-copyright borrowing. The rest of this Part examines how courts deploy these rationales in conjunction with the three measures the scholarship suggests for evaluating borrowing: predictability, accessibility, and preservation of necessary boundaries.

B. PREDICTABILITY

We might quibble with the strength and sufficiency of the *Sony* rationales for borrowing, but successful arguments for patent-copyright borrowing are not the whole story. When the aperture is expanded to show both successful and unsuccessful attempts at borrowing, we see courts sometimes moving in exactly the opposite direction of the historical, doctrinal, and prudential methods described above. Judges may refuse to engage in patent-copyright borrowing because they reject claims of a shared history, consider the benefits from adopting a rule in the patent context inapplicable to the copyright context (or vice versa), or find past examples of borrowing unavailing. A closer look at the fungible use of *Sony*'s central rationales calls into question the supposed predictability gains from borrowing.

113. *Id.* at 442.

114. *Id.* ("We recognize there are substantial differences between the patent and copyright laws. But in both areas the contributory infringement doctrine is grounded on the recognition that adequate protection of a monopoly may require the courts to look beyond actual duplication of a device or publication to the products or activities that make such duplication possible.")

115. Menell & Nimmer, *supra* note 74, at 967–68 (recounting Memorandum from Associate Justice Sandra Day O'Connor to Associate Justice Harry A. Blackmun 2–3 (June 18, 1983)). Justice Blackmun disagreed about the value of the transplant, maintaining that patent and copyright were too different for the staple article doctrine to have the same social benefits in the copyright realm. *Sony*, 464 U.S. at 491 (Blackmun, J., dissenting).

Take, for example, treatment of *Sony*'s historical argument in subsequent cases. In two key cases—both involving constitutional challenges to the length of copyright protection—the Court returned to its “historic kinship” language and used it to justify acts of patent-copyright borrowing.

First came *Eldred v. Ashcroft*, which evaluated federal legislation extending the term of copyright by twenty years.¹¹⁶ Eric Eldred, who published copyrighted works without permission once their copyright expired, challenged the extension as violating the language of the Intellectual Property Clause, which only gave Congress the authority to grant copyright protection for “limited Times.”¹¹⁷ A majority of the Court rejected Eldred’s argument, concluding that the extension was constitutional, in part, because of *patent* law precedent.¹¹⁸ As the majority explained, “[b]ecause the Clause empowering Congress to confer copyrights also authorizes patents, congressional practice with respect to patents informs our inquiry. We count it significant that early Congresses extended the duration of numerous individual patents as well as copyrights.”¹¹⁹ Prior practice of lengthening the terms of existing patents became strong evidence that the terms of copyright could be lengthened as well.¹²⁰

Golan v. Holder involved a second constitutional challenge to copyright duration, this time for works that had already fallen into the public domain.¹²¹ The general rule is that once a copyrighted work’s copyright expires, it must become the common property of everyone—this is the *quid pro quo* for enjoying copyright protection.¹²² But Congress singled out certain preexisting works that continued to be successfully protected by copyright in their home countries while their U.S. copyright protection had lapsed.¹²³ Congress proposed to resurrect these particular works and once again anoint them with copyright protection.¹²⁴ As in *Eldred*, this was challenged as unconstitutional under the language of the Intellectual Property Clause.¹²⁵ If Congress’s ability to grant copyright protection was indeed circumscribed to “limited Times,” the argument went, then resurrecting works that had already passed into the

116. *Eldred v. Ashcroft*, 537 U.S. 186, 193 (2003).

117. *Id.* (quoting U.S. CONST. art. I, § 8, cl. 8).

118. *Id.* at 201.

119. *Id.*

120. Dissenting Justice John Paul Stevens disagreed with the holding, but he did not disagree about fundamental compatibility of copyright and patent on this question, in part because of their simultaneous constitutional origin. *See id.* at 227 (Stevens, J., dissenting) (“We have recognized that these twin purposes of encouraging new works and adding to the public domain apply to copyrights as well as patents.”).

121. *Golan v. Holder*, 565 U.S. 302, 307–08 (2012).

122. Ronan Deazley, *The Myth of Copyright at Common Law*, 62 CAMBRIDGE L.J. 106, 108 (2003).

123. *Golan*, 565 U.S. at 307.

124. *Id.*

125. *Id.* at 308.

public domain meant that Congress was not observing any temporal limits with respect to copyright.¹²⁶

As with *Eldred*, the Court found in favor of Congress, reaching to patent law for its decision.¹²⁷ Examining past congressional practice with respect to patents (just as it did in *Eldred*), the Court highlighted examples of past restorations of lapsed patents by legislative fiat.¹²⁸ It borrowed from this practice in the patent arena to maintain that, in the parallel realm of copyright, restorations of lapsed copyrights should be allowed as well.¹²⁹ *Eldred* and *Golan* lean heavily on the supposed historical parallel development of the two intellectual property regimes to justify taking a rule from patent law—any term of protection is constitutional so long as it is not infinite—and planting it in the separate but related field of copyright.

In other cases, however, courts have rejected attempts at borrowing based on historical similarities. For example, in articulating an extremely low creativity threshold for protection of copyrighted works, Judge Jerome Frank of the Second Circuit contrasted “authors” with “inventors,” noting “[t]hose who penned the Constitution, of course, knew the difference.”¹³⁰ Frank went on to chart the divergent paths of the copyright and patent laws in the United States shortly after the Constitution was ratified to argue against applying similar rules to both legal regimes.¹³¹

A more recent rejection of an appeal to historic parallels came from a district court—subsequently affirmed by the Federal Circuit, then reversed by the U.S. Supreme Court—determining the effect of foreign sales on the rights of patent holders.¹³² The court held that sale of a patented product outside the United States should not exhaust the rights of the patent holder, even though a contrary legal rule applies to international sales of copyrighted works.¹³³ The court deemed the traditions of patent and copyright law too dissimilar.¹³⁴ It highlighted patent exhaustion’s exclusive development through common law decision-making as opposed to copyright exhaustion, which was shaped by legislative activity, contending that this difference in historical trajectories made borrowing inappropriate.¹³⁵

126. *Id.* at 318; see U.S. CONST. art. I, § 8, cl. 8.

127. *Golan*, 565 U.S. at 318, 322.

128. *Id.* at 322.

129. *Id.*

130. *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 100 (2d Cir. 1951) (footnote omitted).

131. *Id.* at 101–02.

132. *Lexmark Int’l, Inc. v. Ink Techs. Printer Supplies, LLC*, 9 F. Supp. 3d 830, 832 (S.D. Ohio 2014); *Impression Prods., Inc. v. Lexmark Int’l, Inc.*, 581 U.S. 360, 368–70 (2017).

133. *Lexmark*, 9 F. Supp. 3d at 835.

134. *Id.*

135. *Id.* at 836.

Just as courts have different levels of receptivity to historical arguments on behalf of borrowing, they also vary in how they treat doctrinal arguments. The doctrinal rationale for borrowing relies on precedent: an act of borrowing should occur now because of previous acts of borrowing. This rationale was instrumental in *MGM Studios v. Grokster*.¹³⁶ In that case, decided twenty years after *Sony*, the Supreme Court again had to grapple with the contours of secondary copyright infringement, this time in the context of the file sharing controversies of the early 2000s.¹³⁷ Grokster supplied a new generation of file sharing software, intentionally decentralized so that no inventory of songs or videos for download resided on Grokster's own servers.¹³⁸ Instead, Grokster simply played matchmaker—providing the means for music lovers to find who had what songs online and to download accordingly.¹³⁹ The *Sony* decision was Grokster's best argument for why it should escape liability for knowingly facilitating the unauthorized copying and dissemination of copyrighted content. Although it was true that most users of Grokster were seeking out the copyrighted music of Metallica, No Doubt, Def Leppard, and other musical artists of the time, at least some were using the software to find older music in the public domain or from artists that had renounced their rights to prevent unauthorized downloads, like the band Wilco.¹⁴⁰ Grokster could argue that, under *Sony*, its software was “capable of substantial noninfringing uses” under the staple article of commerce doctrine and, therefore, it should not be held contributorily responsible for the infringing acts of file sharers.¹⁴¹

Grokster's argument did not work, however, as the Supreme Court unanimously elected to engage in a new instance of borrowing to avoid the limits imposed by its previous act of borrowing in *Sony*. Because the “unlawful intent” of Grokster's behavior was “unmistakable,” the Court held that it was irrelevant whether Grokster's software was capable of substantial noninfringing uses.¹⁴² According to patent law, intentional contributions to infringement need not be balanced against the public's interest in access to potentially infringing technologies.¹⁴³ A party that intends to induce patent infringement cannot take advantage of the staple article of commerce doctrine.¹⁴⁴ In a

136. *MGM Studios Inc. v. Grokster, Ltd.*, 545 U.S. 913, 914 (2005).

137. *Id.* at 919–20.

138. *Id.* at 920.

139. *Id.* at 921.

140. *Id.* at 945 (Ginsburg, J., concurring).

141. *Id.* at 927–28 (majority opinion).

142. *Id.* at 940.

143. *Id.* at 932 (“[W]here an article is ‘good for nothing else’ but infringement . . . there is no legitimate public interest in its unlicensed availability” (citation omitted)).

144. *Id.* at 936–37.

surprise to most legal experts,¹⁴⁵ *Grokster* announced adoption of the same rule for copyright.

To justify exporting the same rule to copyright law, the Court cited its prior act of borrowing from contributory patent law, even though the *Sony* decision avoided imposing liability whereas borrowing patent law's "intent to induce" rule did the opposite. "For the same reasons that *Sony* took the staple-article doctrine of patent law as a model for its copyright safe-harbor rule," the Court explained, "the inducement rule, too, is a sensible one for copyright."¹⁴⁶ The Court pointed to many cases in the patent context where a defendant was held to account for intentionally marketing its technology for infringing purposes and drew a parallel with *Grokster*, which had suspiciously adopted a name resembling a known and adjudicated infringing entity: *Napster*.¹⁴⁷

One way to look at the *Grokster* decision is as a simple example of borrowing based on precedent: because an act of borrowing between areas of law took place before, a new act of borrowing can take place now. Once this premise is accepted, a decision to borrow can appear elementary.

But doctrinal arguments, even as borrowing precedents pile up over time, do not always carry the day. The Federal Circuit has taken a strong stand against importing doctrines from copyright to determine patent law's rules for secondary liability and international sales. Contrary to copyright law, it held that the patent holder's rights in a particular article are only exhausted by an unrestricted sale of the article *in the United States*.¹⁴⁸ One consequence of this rule was that domestic purchasers of patented items possessed an affirmative defense of rightful repair that foreign purchasers did not possess.¹⁴⁹ The Federal Circuit waved away borrowing precedents like *Sony* and *Grokster*, contending "[t]he [Supreme] Court has long recognized the distinctness of

145. Note, *Central Bank and Intellectual Property*, 123 HARV. L. REV. 730, 743 (2010) ("The Court had previously borrowed patent doctrines to apply to copyright law, but there was no special reason to think it would do so in *Grokster*, so the outcome was somewhat surprising." (footnote omitted)).

146. *Grokster*, 545 U.S. at 936.

147. *Id.* at 936, 939. One thing to note here is that the Court borrowed a statutory rule from patent law to construct a common law rule for copyright. Patent law's provision of contributory liability for intent to induce infringement is a product of an act of Congress. Yet *Grokster's* intent-to-induce variety of infringement is strictly a creature of the Court's own common law decision-making. Hence, although not addressed in the Court's decision, one can wonder if Congress had its own reasons for promulgating such a rule in the patent context yet failing to do so in the copyright realm. One could argue that Congress—aware of parallels between copyright and patent—acted intentionally when it imposed one rule for patent law but declined to legislate the parallel rule for copyright. See Yoo, *supra* note 77, at 199–201.

148. *Jazz Photo Corp. v. Int'l Trade Comm'n*, 264 F.3d 1094, 1105 (Fed. Cir. 2001).

149. *Fuji Photo Film Co. v. Int'l Trade Comm'n*, 474 F.3d 1281, 1293–94 (Fed. Cir. 2007).

the copyright and patent regimes and observed that particular questions require separate analysis for each body of law.”¹⁵⁰

Skepticism as to borrowing precedent is also on display in the Federal Circuit’s treatment of secondary liability. The court had to interpret the phrase “to actively induce the combination” in a provision of the Patent Act governing activities both inside and outside of the United States that produce a combination that infringes the original patent.¹⁵¹ The Federal Circuit concluded that this language did not require the involvement of a third party “induced” to infringe but rather could refer just to the defendant’s own combination of components in an infringing manner.¹⁵² A Supreme Court decision in the copyright context, *Grokster*, already defined inducement as “entic[ing] or persuad[ing] another.”¹⁵³ In other words, for copyright, there had to be another party involved—it was impossible to “induce” yourself. Nevertheless, the Federal Circuit rejected the defendant’s plea for copyright-patent borrowing, simply stating that *Grokster*’s gloss on the word “induce” was not “the question of statutory construction we face here.”¹⁵⁴

The Federal Circuit is not the only court sometimes resistant to the appeal of doctrinal arguments in favor of intellectual property borrowing. Judges question the relevance of past borrowing successes for various reasons, including their outdatedness,¹⁵⁵ textual and historical differences not at issue in the prior act of borrowing,¹⁵⁶ and a general characterization of such borrowing as “rare,” “nonbinding,” or “unpersuasive.”¹⁵⁷ It should be noted that even the prime progenitor of intellectual property borrowing, the *Sony* decision, was a split decision. Four of the nine justices rejected the borrowing precedents trumpeted by the majority.¹⁵⁸ The dissenters contended that the staple article of commerce doctrine should not apply to copyright law because “patent and copyright protections have not developed in a parallel fashion,

150. *Lexmark Int’l, Inc. v. Impression Prods., Inc.*, 816 F.3d 721, 756 (Fed. Cir. 2016). Subsequently, the Supreme Court reversed, holding that *Sony*’s notion of “historic kinship” indeed applied to the question of international patent exhaustion. *Impression Prods., Inc. v. Lexmark Int’l, Inc.*, 581 U.S. 360, 378–79 (2017).

151. 35 U.S.C. § 271(f)(1); *see* *Promega Corp. v. Life Techs. Corp.*, 773 F.3d 1338, 1351 (Fed. Cir. 2014).

152. *Promega*, 773 F.3d at 1351.

153. *MGM Studios Inc. v. Grokster, Ltd.*, 545 U.S. 913, 935 (2005) (quoting *inducement*, BLACK’S LAW DICTIONARY (8th ed. 2004)).

154. *Promega*, 773 F.3d at 1353, 1353 n.11.

155. *Silvers v. Sony Pictures Ent., Inc.*, 402 F.3d 881, 905 (9th Cir. 2005) (Bea, J., dissenting).

156. *SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC*, 580 U.S. 328, 352–55 (2017) (Breyer, J., dissenting); *Silvers*, 402 F.3d at 895 (Berzon, J., dissenting); *Lexmark Int’l, Inc. v. Ink Techs. Printer Supplies, LLC*, 9 F. Supp. 3d 830, 835 (S.D. Ohio 2014).

157. *GAF Bldg. Materials Corp. v. Elk Corp. of Dallas*, 90 F.3d 479, 483 (Fed. Cir. 1996).

158. *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 491 (1984) (Blackmun, J., dissenting).

and this Court in copyright cases in the past has borrowed patent concepts only sparingly.”¹⁵⁹

Finally, there is the argument that borrowing is warranted because both legal arenas are motivated by the same policy concerns. Take, for example, the position of the Fourth Circuit in *BMG Rights Mgmt. v. Cox Communications*.¹⁶⁰ In that case, the court had to determine whether mere negligence could satisfy the knowledge standard for a finding of contributory copyright infringement.¹⁶¹ Deciding between conflicting precedents in copyright law, the court turned to patent law for guidance. Contributory patent infringement requires actual knowledge—it is not enough to prove that the defendant “should have known” of infringement.¹⁶² The Fourth Circuit argued transplanting this actual knowledge requirement to copyright law made sense because patent and copyright law addressed the same policy choices on this issue. In the court’s view, both regimes needed to make a “sensible” tradeoff between imposing liability on culpable facilitators of infringement and fostering the development of technologies that can be used for both infringing and noninfringing purposes.¹⁶³ In a move similar to the *Sony* argument regarding shared policy goals, the *BMG Rights* court used intellectual property’s supposedly shared solicitude for new technologies to justify an act of patent-copyright borrowing. Because of “the similar need in both contexts to impose liability” without discouraging innovation, it explained, importing patent law’s actual knowledge rules “appropriately targets culpable conduct without unduly burdening technological development.”¹⁶⁴

A similar process occurred when the Second Circuit needed to resolve a dispute involving the Queen of Hip-Hop, Mary J. Blige.¹⁶⁵ A songwriter named Sharice Davis claimed that two songs on one of Blige’s hit albums infringed her own copyrighted compositions.¹⁶⁶ After the litigation commenced, a coauthor of the songs with Davis executed an agreement supposedly assigning his rights in the songs as of the time of their creation to the defendants.¹⁶⁷ The district court held that the assignment was valid and, therefore, defeated Davis’s claims as Blige could not infringe if she had permission to use the songs.¹⁶⁸ The Second Circuit disagreed, concluding that the coauthor had no right to release any rights held by Davis in a retroactive manner.¹⁶⁹ Explaining

159. *Id.*

160. *BMG Rts. Mgmt. (US) LLC v. Cox Commc’ns, Inc.*, 881 F.3d 293, 309 (4th Cir. 2018).

161. *Id.* at 308.

162. *Id.* at 309.

163. *Id.*

164. *Id.*

165. *Davis v. Blige*, 505 F.3d 90, 104 (2d Cir. 2007).

166. *Id.* at 94.

167. *Id.* at 95–96.

168. *Id.* at 97.

169. *Id.* at 109.

“[w]e find support for this holding in the law of patents,” the court cited three patent law decisions that blessed prospective licenses as applicable against patent co-owners but declined to do so for retroactive licenses.¹⁷⁰ In support of this borrowing maneuver, the court noted that “[l]icenses in patent and copyright function similarly, and thus it is appropriate to consider copyright licensing, like patent licensing, prospective in nature.”¹⁷¹

Yet in other situations, an appeal to shared policy goals falls on deaf ears. Take, for example, the now familiar issue of how to treat the effect of sales of a protected work on an intellectual property holder’s rights. For ten out of twelve judges on the Federal Circuit, the policy rationales for treating foreign and domestic sales of copyrighted works the same simply did not apply in the different context of patent law.¹⁷² Libraries and museums needed a rule for copyrighted works that did not require deep investigation into the provenance of a sale; hence, the announcement of a nongeographical approach to the effect of a sale for copyright law. But the lack of an analogous purchasing class for patented items (as well as the higher threshold and cost for securing patent rights) convinced the ten judges that patent holders would not be adequately incentivized if foreign sales extinguished their rights.¹⁷³ As such, the Federal Circuit rejected arguments invoking past instances of borrowing and the historical kinship of copyright and patent law and declined the invitation to borrow from the former regime for the latter.¹⁷⁴

Beyond the rules regarding sales and rights exhaustion, there are other examples of borrowing rejections that reveal judicial disagreement as to the policy linkages between copyright and patent law. Although “misuse” doctrines exist for both copyright and patent law to deal with the problem of overzealous claiming of intellectual property rights, the two doctrines have grown increasingly divergent over time. As we explore in greater detail later,¹⁷⁵ rather than reflecting doctrinal incoherence, one can argue that the divergence makes sense given differences in each regime’s subject matters, eligibility requirements, and primary audiences. Other cases highlight the current gulf between patent and copyright law when it comes to eligibility requirements and use that gulf to justify continuing such differential treatment and avoiding appeals for greater convergence.¹⁷⁶

170. *Id.* at 104.

171. *Id.* (citation omitted).

172. *Lexmark Int’l, Inc. v. Impression Prods., Inc.*, 816 F.3d 721, 771 (Fed. Cir. 2016).

173. *Id.* at 762.

174. *Id.* at 773–74.

175. *See infra* Part III.

176. *See generally* *Mazer v. Stein*, 347 U.S. 201 (1954) (noting the differences between design patent and copyright protection when regarding a functional or useful article, in this case a lamp); *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951) (distinguishing between patent law’s high “novelty” standard and copyright law’s low “originality” standard in holding that only “minimal creativity” was required to satisfy the latter); *Lotus Dev. Corp. v. Borland*

The chart below summarizes the varying approaches to the three main borrowing rationales. In general, courts appear to have a certain amount of freedom to accept or reject patent-copyright borrowing by flipping each rationale on its head.

Table 1: Judicial Flip-Flops on Patent-Copyright Borrowing

Reasons for Borrowing	Reasons for Not Borrowing
Historical argument that special “kinship” between patent and copyright law justifies borrowing. (Examples: <i>Sony v. Universal City Studios</i> , <i>Eldred v. Ashcroft</i> , <i>Golan v. Holder</i>) ¹⁷⁷	Historical argument that borrowing is disfavored given legislative attention to patent/copyright differences. (Examples: <i>Alfred Bell v. Catalda Fine Arts</i> , <i>Lexmark Int’l v. Impression Prods.</i> (district court)) ¹⁷⁸
Doctrinal argument that a sufficient history of patent-copyright borrowing exists to warrant even more of it. (Examples: <i>Sony v. Universal City Studios</i> , <i>MGM v. Grokster</i> , <i>BMG Rights Mgmt. v. Cox Comm.</i> , <i>Carson Optical v. Prym</i>) ¹⁷⁹	Doctrinal argument that there are not enough examples of patent-copyright borrowing to justify borrowing. (Examples: <i>Lexmark Int’l v. Impression Prods.</i> (Fed. Cir.), <i>Promega v. Life Techs.</i> , <i>Sony v. Universal City Studios</i> (dissent), <i>SCA Hygiene Prods. v. First Quality Baby Prods.</i> (dissent), <i>Silvers v. Sony</i> (dissent)) ¹⁸⁰
Prudential argument that borrowing strikes the correct public policy balance between rights holder incentives and downstream activity for both regimes. (Examples: <i>Sony v. Universal City Studios</i> , <i>BMG Rights Mgmt. v. Cox Comm.</i> , <i>Davis v. Blige</i>) ¹⁸¹	Prudential argument that patent and copyright are too different in terms of up-front requirements and scope of rights for a rule that makes sense in one context to make sense in the other. (Examples: <i>Bobbs-Merrill v. Straus</i> , <i>Lexmark Int’l v. Impression Prods.</i> (Fed. Cir.), <i>Lotus v. Borland</i>) ¹⁸²

Int’l, Inc., 49 F.3d 807 (1st Cir. 1995) (noting the differences in requirement between patent and copyright law to support the nonprotection of command hierarchy within a computer program for its efficiency).

177. See *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 439–42 (1984); *Eldred v. Ashcroft*, 537 U.S. 186, 201 (2003); *Golan v. Holder*, 565 U.S. 302, 320–24 (2012).

178. See *Alfred Bell & Co.*, 191 F.2d at 101–02; *Lexmark Int’l, Inc. v. Ink Techs. Printer Supplies, LLC*, 9 F. Supp. 3d 830, 833–34 (S.D. Ohio 2014).

179. See *Sony*, 464 U.S. at 442; *MGM Studios Inc. v. Grokster, Ltd.*, 545 U.S. 913, 936 (2005); *BMG Rts. Mgmt. (US) LLC v. Cox Comm’ns, Inc.*, 881 F.3d 293, 309–10 (4th Cir. 2018); *Carson Optical, Inc. v. Prym Consumer USA, Inc.*, 11 F. Supp. 3d 317, 331 (E.D.N.Y. 2014).

180. See *Lexmark Int’l, Inc. v. Impression Prods., Inc.*, 816 F.3d 721, 773 (Fed. Cir. 2016); *Promega Corp. v. Life Techs. Corp.*, 773 F.3d 1338, 1351–53 (Fed. Cir. 2014); *Sony*, 464 U.S. at 491 (Blackmun, J., dissenting); *SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC*, 580 U.S. 328, 352–56 (2017) (Breyer, J., dissenting); *Silvers v. Sony Pictures Ent., Inc.*, 402 F.3d 881, 905 (9th Cir. 2005) (Bea, J., dissenting).

181. See *Sony*, 464 U.S. at 442; *BMG Rts. Mgmt. (US) LLC*, 881 F.3d at 309; *Davis v. Blige*, 505 F.3d 90, 104 (2d Cir. 2007).

182. See *Bobbs-Merrill Co. v. Straus*, 210 U.S. 339, 346 (1908); *Lexmark*, 816 F.3d at 835; *Lotus Dev. Corp. v. Borland Int’l, Inc.*, 49 F.3d 807, 814–15 (1st Cir. 1995).

This table and the prior discussion should lead us to question the predictability gains touted by borrowing's proponents. If every rationale for justifying the use of patent doctrine in the copyright context can be countered by an equally persuasive and opposite rationale for rejecting borrowing, this may reveal that borrowing is in danger of transforming from a valuable technique of judicial decision-making to a convenient rhetorical move designed to engineer a particular desired outcome.¹⁸³

C. ACCESSIBILITY

Along with predictability, improved accessibility is the other supposed advantage of doctrinal borrowing. Scholars note borrowing's potential to make the law more accessible by opening doctrinal transplants to interrogation by experts and nonexperts alike.

One has to wonder if borrowing is really doing much to make the law more accessible though, at least in the intellectual property arena.¹⁸⁴ The evidence is mixed when it comes to the test case of borrowing in intellectual property. On the one hand, acts of borrowing have led to greater synchrony between patent and copyright law, potentially facilitating understanding from those steeped in one intellectual property field but not the another. On the other hand, the Federal Circuit, a specialist court largely served by specialist lawyers is the chief utilizer of borrowing. This would suggest that rather than promoting accessibility, borrowing may most appeal to legal elites.

Thanks to doctrinal borrowing, at least some hurdles to outside understanding have been removed in copyright and patent law. Secondary infringement law in both domains looks very similar after cases like *Grokster* and *BMG Rights*. To the extent lower courts and advocates must take their cues from the highest court in the land, the Supreme Court has promoted borrowing and rejected patent exceptionalism. In recent years, the Court has sent strong signals that it favors patent-copyright harmonization, quickly

183. Cf. KARL F. LLEWELLYN, *THE COMMON LAW TRADITION: DECIDING APPEALS* 521–36 (1960) (revealing that each and every canon of statutory construction could be countered by an equal and opposite countercanon); Menell & Nimmer, *supra* note 74, at 944 (deeming the patent-copyright borrowing in *Sony* “a post hoc rationalization for a particular policy preference”).

184. It is worth asking whether accessibility is a value that applies with more force in some fields than others. For example, the literature on accessibility and borrowing has largely pertained to constitutional law. To give one example, Tebbe and Tsai posit that the practice of “constitutional borrowing . . . promises to foster wider participation in the maintenance of constitutional norms.” Tebbe & Tsai, *supra* note 5, at 488. While intellectual property scholars would like to think patent and copyright law have the same significance as constitutional law, to the average American, they do not. Constitutional law pertains to the fundamental structure of our system of governance, so there is a strong civics component to the regime. As such, issues of transparency and legibility may be salient to the public at large in a way that is just not the case with intellectual property law.

justifying doctrinal imports as “straightforward” and “easily fit[ting].”¹⁸⁵ Moreover, on a host of procedural disputes, borrowing has been used to support a uniform approach to such issues as standing and the right to jury trial.¹⁸⁶ Even though not every plea for borrowing is accepted, every successful borrowing attempt moves the different intellectual property regimes closer together. In the nearly four decades since *Sony* was decided, patent and copyright law have been brought into greater alignment.

Yet it is fair to question whether these legal changes make patent law significantly more accessible to a copyright practitioner or vice versa. As revealed in the prior Section, the application of borrowing principles can be wildly inconsistent. Given this unpredictability, it seems unlikely that borrowing has made the law markedly more coherent to outsiders, even if there are some areas of commonality. To someone interested in handicapping how the next big copyright or patent decision will go, arguments relating to history or shared disciplinary ideologies seem to be as likely to be discounted as to be believed. Pleas to yoke borrowing to a more systematic scrutiny of legislative intent¹⁸⁷ seem to have gone unheeded.¹⁸⁸

At the same time, it is hard to argue that borrowing has made intellectual property law more friendly to nonspecialists given who actually engages in borrowing. Although examples of borrowing can be found in various federal courts, a specialist court, the Federal Circuit, is a prime deployer of intellectual property borrowing since *Sony*.¹⁸⁹ The Federal Circuit handles not only patent cases but wades into copyright law issues as well.¹⁹⁰ As a result, even with its

185. *Impression Prods., Inc. v. Lexmark Int’l, Inc.*, 581 U.S. 360, 378 (2017); *SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC*, 580 U.S. 328, 336 (2017).

186. *Am. Soc’y for Testing & Materials v. Public.Resource.org, Inc.*, 78 F. Supp. 3d 534, 537 (D.D.C. 2015); *Re-Alco Indus., Inc. v. Nat’l Ctr. for Health Educ., Inc.*, 812 F. Supp. 387, 395 (S.D.N.Y. 1993).

187. Menell & Nimmer, *supra* note 74, at 989–91; Yoo, *supra* note 77, at 192–96.

188. See *infra* Section III.C.1.

189. See, e.g., *SAS Inst., Inc. v. World Programming Ltd.*, 64 F.4th 1319, 1331 (Fed. Cir. 2023); *Lexmark Int’l, Inc. v. Impression Prods., Inc.*, 816 F.3d 721, 786–87 (Fed. Cir. 2016) (Dyk, J., dissenting); *WesternGeco L.L.C. v. Ion Geophysical Corp.*, 621 F. App’x 663, 664 (Fed. Cir. 2015) (Wallach, J., dissenting) (per curiam) (mem.); *Promega Corp. v. Life Techs. Corp.*, 773 F.3d 1338, 1359 (Fed. Cir. 2014) (Prost, J., dissenting); *LifeScan Scot., Ltd. v. Shasta Techs., LLC*, 734 F.3d 1361, 1376 (Fed. Cir. 2013); *Akamai Techs., Inc. v. Limelight Networks, Inc.*, 692 F.3d 1301, 1326 (Fed. Cir. 2012) (Newman, J., dissenting); *Terasense, Inc. v. Becton, Dickinson & Co.*, 649 F.3d 1276, 1295 (Fed. Cir. 2011); *Ultra-Precision Mfg., Ltd. v. Ford Motor Co.*, 411 F.3d 1369, 1382 (Fed. Cir. 2005); *Dynacore Holdings Corp. v. U.S. Philips Corp.*, 363 F.3d 1263, 1274 (Fed. Cir. 2004); *Atari Games Corp. v. Nintendo of Am. Inc.*, 975 F.2d 832, 841 & n.4 (Fed. Cir. 1992).

190. See Corynne McSherry, *The Federal Circuit Has Another Chance to Get It Right on Software Copyright*, ELEC. FRONTIER FOUND. (Aug. 30, 2021), <https://www.eff.org/deeplinks/2021/08/federal-circuit-has-another-chance-get-it-right-software-copyright> [<https://perma.cc/AG7N-KEGH>] (“The Federal Circuit is *supposed* to be almost entirely focused on patent cases, but a party can make sure its copyright claims are heard there too by simply including patent claims early in the litigation, and then dropping them later.”).

own resistance to borrowing from copyright to resolve patent cases, it still seems to boast more examples of intellectual property borrowing than any other court of appeals.¹⁹¹ This makes a certain amount of sense given the Federal Circuit's docket, which is filled mostly with intellectual property disputes. Still, borrowing is dramatically more evident in this circuit than any other, even as compared to circuits like the Second and the Ninth, which handle many more copyright cases than the Federal Circuit,¹⁹² suggesting that there is more at work here than simply the number of intellectual property cases adjudicated by each court.

It seems that rather than democratizing intellectual property law, borrowing particularly appeals to insiders. The generalist Supreme Court tends to favor intellectual property borrowing but it does so under the guidance of those embedded in the field. In describing the litigation strategies that produced *Sony's* importation of the defendant-friendly staple article of commerce safe harbor into copyright law, Peter Menell and David Nimmer credit the patent litigation expertise of Sony's lead counsel as well as amicus briefs from industry players.¹⁹³ In other words, the big bang of intellectual property borrowing was detonated by subject matter experts.

It may be that legal transplanting appeals most to those already steeped in a particular doctrinal area. If so, borrowing may not be a force for breaking down participatory barriers. There is a danger in entrusting legal development to a specialized bar and a specialized court—the Federal Circuit. Scholars point to an “insular viewpoint” that has taken hold of patent law, one that can lose sight of the effect of patent law rulings on nonlitigants.¹⁹⁴ Patent law has been criticized for an obscure and unintuitive vocabulary that profits insiders, but keeps nonpatent specialists at a distance.¹⁹⁵ Even though borrowing avoids

191. See *supra* note 189 (listing Federal Circuit borrowing cases); see also David W. Barnes, *Abuse of Supreme Court Precedent: The “Historic Kinship,”* 16 CHI.-KENT J. INTELL. PROP. 85, 105–07 & n.89 (2016) (cataloguing that, in a search for cases invoking the “historic kinship” language from *Sony*, more Federal Circuit cases were identified than any other court of appeals). Of course, while federal district courts can hear patent cases (and potentially borrow from copyright law to resolve them), courts of appeals outside of the Federal Circuit do not typically hear patent law disputes and, hence, will have few, if any, opportunities to implement copyright-to-patent borrowing.

192. Transactional Recs. Access Clearinghouse, *Fewer Copyright Infringement Lawsuits Filed*, TRAC REPS. (Sep. 29, 2017), <https://trac.syr.edu/tracreports/civil/483> [<https://perma.cc/EG5L-5H6G>]. In the period between 1996 and 2018, for example, the top two states by number of copyright claims initiated in federal court were California (16,817) and New York (11,115). Texas was a distant third (5,223). See *Just the Facts: Intellectual Property Cases—Patent, Copyright, and Trademark*, U.S. COURTS (Feb. 13, 2020), https://www.uscourts.gov/news/2020/02/13/just-fact-s-intellectual-property-cases-patent-copyright-and-trademark#figures_map [<https://perma.cc/W9V-6UZQ>]. The appeals for all of these cases end up in the Ninth and Second Circuits, respectively, with the exception of the small number of copyright suits tethered to patent infringement claims.

193. Menell & Nimmer, *supra* note 74, at 947, 959.

194. Daniel R. Cahoy & Lynda J. Oswald, *Complexity and Idiosyncrasy at the Federal Circuit*, 19 COLUM. SCI. & TECH. L. REV. 216, 226 (2018).

195. *Id.* at 226–34.

some insularity by utilizing insights from another legal discipline, when borrowing is mostly practiced by a narrow band of legal professionals and judges, it may build more barriers than bridges to understanding.

D. BOUNDARY COLLAPSE

A borrowing fan might argue that even if the predictability and accessibility gains spawned by borrowing are meagre, they are still gains and, at the least, borrowing is a jurisprudential technique that does not do any harm. Judges need to find doctrinal solutions to new legal issues somewhere and it arguably makes more sense to appropriate existing solutions from other bodies of law than to create doctrine from whole cloth. But what about the specter of boundary collapse, the main concern of the intellectual property scholars that have remarked on the issue? It turns out that, so far, intellectual property law's most important boundaries—the ones reliant on subject-specific doctrines meant to reserve protection for functional features to patent law—are standing firm despite more and more decisions to borrow. But this does not mean that they could never fall.

1. The Boundaries Are Holding

Remember that the chief concern with borrowing is as a threat to intellectual property law's various channeling doctrines.¹⁹⁶ These doctrines are designed to route efforts to claim rights over a work's functional elements to utility patent law. The rationale for channeling is that the involvement of intellectual property regimes outside of patent law in protecting functional designs jeopardizes patent law's carefully crafted balance between incentives for innovation and provision of beneficial technologies to the public. Patent protection lasts for only twenty years and requires an inventor to satisfy stringent eligibility requirements.¹⁹⁷ Allowing copyright law, with its flimsy eligibility rules and a duration that extends seventy years past the death of the author,¹⁹⁸ to intrude on the preserve of patent law threatens to disrupt that balance.

Review of the relevant cases reveals that intellectual property borrowing—whatever its flaws—has not been deployed so far to erode these channeling doctrines, which demand a certain amount of separation between intellectual property regimes. Many of the borrowing cases (particularly at the Supreme Court level) involved trans-substantive issues like secondary liability and when conduct overseas should exhaust property rights.¹⁹⁹ These are important issues and one can argue that they should be handled differently by the patent system than the copyright system. Nevertheless, decisions aligning copyright

196. See *supra* Section I.C.2.

197. 35 U.S.C. § 154(a)(2); see 35 U.S.C. §§ 101–103, 112.

198. 17 U.S.C. §§ 102; 302(a).

199. See generally, e.g., *Impression Prods., Inc. v. Lexmark Int'l, Inc.*, 581 U.S. 360 (2017) (analyzing conduct overseas and exhaustion); *MGM Studios, Inc. v. Grokster, Ltd.*, 545 U.S. 913 (2005) (analyzing secondary liability).

and patent law on these questions do not seem to place channeling doctrines like copyright's separability requirement for the functional elements of commercial design or its ban on copyrighting "processes" in jeopardy.

To assess the resilience of critical patent/copyright boundaries, it is important to look not just at which borrowing attempts have been successful but which attempts have failed. A sizeable proportion of the cases that reject borrowing involved legal questions that implicate channeling doctrines. Questions of copyright eligibility directly touch on whether a creative work with utilitarian elements would be better addressed by the patent law regime. For example, in a case evaluating whether a command hierarchy from a popular spreadsheet program could be protected under copyright law, the court flagged the differences between patent and copyright law as the reason for not holding the hierarchy copyrightable.²⁰⁰ Computer software can be protected under both copyright and patent law.²⁰¹ Yet software's inherent functionality requires courts to be circumspect in awarding copyright protection. Because "[g]ranting [copyright] protection . . . can have some of the consequences of *patent* protection," as an appellate judge noted, courts must review claims of copyright in utilitarian elements of software with a skeptical eye.²⁰²

In addition to subject matter eligibility issues, the doctrines describing infringement and fair use also implicate copyright law's channeling function. As with eligibility rules, copyright's rules for determining infringement and fair use are meant to limit an author's rights when the subject matter at issue is meant to be shunted to the utility patent system.²⁰³ Rather than failing to preserve disciplinary boundaries, courts have reshaped the tests for copyright infringement and fair use to address functional technologies. When confronted with scenarios involving software and other intellectual products that possess features eligible for both patent and copyright protection, courts have redefined infringement and fair use in a way that emphasizes differences between the two bodies of intellectual property law rather than similarities.

In the course of announcing these new limits on copyright protection, courts have reinforced boundaries. For example, when Sega argued that a rival infringed the copyrighted code in its video game console by making a copy of the console's operating system to understand what would be required to design compatible games, the Ninth Circuit highlighted patent-copyright

200. *Lotus Dev. Corp. v. Borland Int'l, Inc.*, 49 F.3d 807, 819–20 (1st Cir. 1995) (Boudin, J., concurring).

201. *Atari Games Corp. v. Nintendo of Am. Inc.*, 975 F.2d 832, 839 (Fed. Cir. 1992) ("Title 35 [patent] protects the process or method performed by a computer program; title 17 [copyright] protects the expression of that process or method. While title 35 protects any novel, nonobvious, and useful process, title 17 can protect a multitude of expressions that implement that process.").

202. *Lotus*, 49 F.3d at 819–20 (Boudin, J., concurring).

203. See Edward Lee, *Technological Fair Use*, 83 S. CAL. L. REV. 797, 820–22 (2010) (discussing fair use and other copyright doctrines meant to provide a "buffer between copyright and patent systems").

differences.²⁰⁴ Because functional insights are only meant to be governed by “the more stringent standards imposed by the patent laws” and Sega lacked a patent, the rival’s copying was deemed fair use.²⁰⁵ Similarly, recognizing that “patent registration, with its exacting up-front novelty and non-obviousness requirements” is “the more appropriate rubric of protection” for software, the Second Circuit created a highly influential specialized copyright infringement analysis for software, further reifying the differences between patent and copyright law.²⁰⁶

Recently, even the proborrowing Supreme Court affirmed the importance of this patent-copyright boundary work. In a decision involving the protectability of “declaring code” for computer programming, the Court highlighted the differences between patent and copyright law en route to adopting a generous view of copyright fair use, thereby underlining the availability of patent protection (rather than copyright protection) for such code.²⁰⁷ Hence, at least on issues implicating copyright law’s channeling role, judges have been more focused on maintaining doctrinal difference than making intellectual property more cohesive.

Similarly, rather than revealing doctrinal convergence, the rules pertaining to initial ownership of a copyright versus a patent have diverged markedly through the years as a direct result of judicial intervention. While copyright law has bent over backwards to facilitate the notion of corporate authorship—chiefly through a “work for hire” doctrine that allows hiring parties to immediately claim ownership of the copyrightable outputs of their employees—patent law has not succumbed.²⁰⁸ The judicial role in both creating and preserving this dichotomy is particularly salient. Facially speaking, the Constitution gives no more reason to allow the former than the latter.²⁰⁹ One

204. *Sega Enters. Ltd. v. Accolade, Inc.*, 977 F.2d 1510, 1526 (9th Cir. 1992).

205. *Id.* (citing *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 159–64 (1989)).

206. *Comput. Assocs. Int’l, Inc. v. Altai, Inc.*, 982 F.2d 693, 712 (2d Cir. 1992) (citing Randell M. Whitmeyer, Comment, *A Plea for Due Processes: Defining the Proper Scope of Patent Protection for Computer Software*, 85 NW. U. L. REV. 1103, 1123–25 (1991); *Lotus Dev. Corp. v. Borland Int’l, Inc.*, 788 F. Supp. 78, 91 (D. Mass. 1992)).

207. *Google LLC v. Oracle Am., Inc.*, 141 S. Ct. 1183, 1195–96 (2021).

208. See Xiyin Tang, *Centering Creative Labor: Towards a Progressive Copyright 7–10* (2023) (unpublished manuscript) (discussing how copyright law has strengthened the work for hire doctrine to make it easier for corporations to own creative works outright) (on file with the authors).

209. After all, patent and copyright law both emanate from the very same constitutional provision—Article I, section 8, clause 8—which grants Congress the power to “secur[e] for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.” U.S. CONST. art. I, § 8, cl. 8. According to a plain reading, the passage’s verbiage seemingly dictates that the exclusive rights to writings vest in authors and the exclusive rights to discoveries in inventors. There is consequently a colorable constitutional argument that the copyright and patent monopolies always belong—at least as an initial matter—to the actual creator or innovator, not any (commissioning or otherwise) third party. See John Tehranian, *Et Tu, Fair Use? The Triumph of Natural-Law Copyright*, 38 U.C. DAVIS L. REV. 465, 467–68 (2005) (providing a historical context of the Constitution’s Intellectual Property Clause that also appears to support this view).

might be tempted to conclude that the divergence between copyright and patent law with respect to a work-made-for-hire doctrine is simply the product of legislative will. After all, the modern Copyright Act expressly acknowledges the doctrine and the possibility of corporate authorship²¹⁰ while the Patent Act does not. But, courts in the second half of the nineteenth century played a key role in pressing Congress to embody the work-made-for-hire doctrine in the Copyright Act.²¹¹ Yet no such change has occurred in patent law. As the Supreme Court recently concluded, “[a]lthough much in intellectual property law has changed in the 220 years since the first Patent Act, the basic idea that inventors have the right to patent their inventions has not.”²¹²

Oddly, none of the foundational jurisprudence leading to copyright’s work-made-for-hire doctrine appears to have ever been cited, let alone discussed, in patent cases.²¹³ Instead, courts hearing patent cases largely seemed to ignore

210. See 17 U.S.C. § 201(b) (vesting authorship of works made for hire in “the employer or other person from whom the work was prepared”).

211. See Catherine L. Fisk, *Authors at Work: The Origins of the Work-for-Hire Doctrine*, 15 YALE J. L. & HUM. 1, 33–43, 55, 66–67 (2003). During this time of dramatic change in copyright’s vesting rules, patent law resisted (or, more aptly, ignored) any adoption of a general work-made-for-hire rule. Inventorship has remained the exclusive domain of human beings—the inventors themselves—and not corporations. Nothing in the Patent Act compels this position, as it remains silent as to whether inventorship is limited to natural beings. In fact, it was only in 2022 that a federal court held that the inventor listed on a patent application must be a human. See *Thaler v. Vidal*, 43 F.4th 1207, 1213 (Fed. Cir. 2022).

212. See *Bd. of Trs. of the Leland Stanford Junior Univ. v. Roche Molecular Sys., Inc.*, 563 U.S. 776, 785 (2011). That said, patent law has not been stagnant in this area, and, in fact, it has evolved (or devolved, depending on your perspective) to become more employer friendly. Specifically, in the patent context, courts have adopted various rules, including shop-rights, see generally *McClurg v. Kingsland*, 42 U.S. (1 How.) 202 (1843) (granting employers an implied license to make use of a former employee’s invention developed while the employee was with the company such that they cannot face threat of suit from a former employee); employee improvement, see *Agawam Co. v. Jordan*, 74 U.S. (7 Wall.) 583, 603 (1868) (recognizing that, notwithstanding the general rules of inventorship, employee improvements to an employer invention belong to the employer); and the hired-to-invent doctrine, see generally *Standard Parts Co. v. Peck*, 264 U.S. 52 (1924) (recognizing that, even if an employee had not signed a formal contract assigning invention rights, if said employee were specifically hired to invent something, the employee is inherently obligated to assign the invention to the employer). Together, these doctrines almost—but not quite—accomplish the same result as copyright’s work-made-for-hire rules. See, e.g., Charles Tait Graves, *Is the Copyright Act Inconsistent with the Law of Employee Invention Assignment Contracts?*, 8 N.Y.U. J. INTEL. PROP. & ENT. L. 1, 3 (2018) (noting that, while “the Copyright Act focuses on what an employee was hired to do and what he or she intended by creating the work at issue[,] [t]he law of invention assignment contracts, by contrast, treats the employee’s role and mental state as irrelevant and instead asks whether the created work is related in some manner to the employer’s business – a broad definition the boundaries of which remain unclear”). Combined with the usual practice of employers obtaining inventorship assignment agreements from their employees, this framework usually resulted in corporate ownership of inventions developed by employees. But, importantly, inventorship (and the crediting that came with it) remained with employees.

213. A citation check performed on these cases—*Colliery Engineer Co. v. United Correspondence Schools Co.*, 94 F. 152 (C.C.S.D.N.Y. 1899); *Dielman v. White*, 102 F. 892 (C.C.D. Mass. 1900);

the development of a deviating line of jurisprudence regarding vesting rights in copyright. As a result, we are left without much overt contemporaneous analysis that grapples with the divergence or statements of reasoning that may help us discern why patent law did not take the same path as copyright law.²¹⁴ Still, the century-long divergence of copyright and patent's vesting rules illustrates not only that boundaries between the regimes are holding but, in some areas where copyright law and patent law once started in the same place, doctrinal and prudential justifications—along with simple neglect of one another—may have pushed the regimes apart.

2. That Doesn't Mean They Will Never Fall

Intellectual property has some features that may reduce the appeal of borrowing compared to some other areas of law. Despite the Supreme Court's best efforts at encouraging copyright-to-patent borrowing, the Federal Circuit's exclusive patent jurisdiction tends to support preservation of at least one doctrinal silo. Moreover, a general recognition in the law that particular kinds of creative output should be channeled into the patent system should act as a brake on borrowing. But if borrowing has not yet influenced copyright's channeling functions or other essential boundary conditions between the two IP regimes, that does not mean it never will. The momentum created by borrowing events along with the sometimes cursory judicial analysis announcing such events threaten to eventually overtake important areas of separation between patent and copyright law.

In one recent example, the Federal Circuit approved a district court's decision to engage in a "Copyrightability Hearing" to assess the copyrightability of the nonliteral elements of the plaintiff's software.²¹⁵ The hearing was akin to a *Markman* hearing—a now standard procedure in patent cases where, in a pretrial hearing, the judge (not the jury) examines and rules on evidence from the parties on the meaning of contested words and phrases in a patent claim. The Federal Circuit concluded that the district court's borrowing of

Edward Thompson Co. v. American Law Book Co., 119 F. 217 (C.C.S.D.N.Y. 1902); *National Cloak & Suit Co. v. Kaufman*, 189 F. 215 (C.C.M.D. Pa. 1911)—reveals that they have only been cited by other copyright cases.

214. Instead, we are left to speculate. Some of the differential treatment might be explained by the real-world circumstances of the era. Although corporate copyrighted works of the time involved the efforts of many individuals, such circumstances were largely absent in patent law in the late nineteenth century, leading to fewer calls for rights to reside with businesses instead of individual inventors. In 1885, a whopping eighty-eight percent of patents were issued to individuals rather than corporations. Joshua L. Simmons, *Inventions Made for Hire*, 2 N.Y.U. J. INTELL. PROP. & ENT. L. 1, 45 (2012). Thus, the failure to import copyright's rules may have made practical sense—at least during that era. Notably, however, by 1950, that number had reversed sharply, as more than seventy-five percent of patents issued to corporations, and that number had risen to eighty-four percent by the 1980s. *Id.* Indeed, Joshua Simmons argues that the changing nature of invention strongly militates in favor of the adoption of a work-made-for-hire doctrine in patent law. *Id.* at 49–50.

215. *SAS Inst., Inc. v. World Programming Ltd.*, 64 F.4th 1319, 1334 (Fed. Cir. 2023).

the *Markman* procedure, though novel for a copyright case, fell within the court's discretion to manage pretrial matters.²¹⁶ As justification, it noted multiple examples of various district courts crafting particularized hearings to more efficiently evaluate patent disputes as well as its own decisions dismissing patent actions for failing to sufficiently detail claim construction or infringement theories.²¹⁷

What the Federal Circuit's opinion failed to do was grapple with any of the differences between patent and copyright law that could be implicated when allowing and making a pretrial legal determination as to the scope of the plaintiff's intellectual property right. After all, in holding that patent claim construction was the province of judges and not juries, the Supreme Court noted the unusual nature of the patent right—bounded by written claims that have only become more “highly technical” over time—made this atypical assertion of judicial prerogative appropriate.²¹⁸ Yet this atypicality was nowhere mentioned in the Federal Circuit's exporting of *Markman* to copyright (and though one might apply such reasoning to certain types of copyrighted works, it would hardly seem to apply to the majority of them). Concerned amici protested that such borrowing threatened copyright law's unique solicitude for “individual authors and small entities” by imposing on them the high costs of *Markman*-like pretrial litigation.²¹⁹ One could argue that the very subject of the hearing—eligibility—reflects what has heretofore been a key area of doctrinal separation between the two regimes.

One thing that is clear is that borrowing begets more borrowing. To the extent there are rationales that can be deployed to analyze a proposed borrowing event, the character of these rationales can change under the weight of borrowing precedent. Take appeals to doctrine, i.e., arguments that patent-copyright borrowing should be looked on favorably because it has already happened before. These appeals, perhaps unsurprisingly, have only grown stronger as the inertia of intellectual property borrowing builds. From the Supreme Court to courts of appeal to trial courts, all rely on the point that borrowing should occur because it has happened in the past.

Doctrinal and historical arguments for borrowing work together as each judicially approved transplant becomes another data point on the timeline showing greater interdisciplinary convergence and making historical arguments for borrowing ever so slightly more compelling. Citations to *Sony*'s historic kinship language in the service of intellectual property borrowing are

216. *Id.* at 1332–33.

217. *Id.* at 1332 nn.8–9.

218. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 388–90 (1996) (quoting William Redin Woodward, *Definiteness and Particularity in Patent Claims*, 46 MICH. L. REV. 755, 765 (1948)).

219. Corrected Brief of Amici Curiae Scholars of Copyright L. in Support of Plaintiff-Appellants and Reversal at 7, *SAS Inst., Inc. v. World Programming Ltd.*, 64 F.4th 1319 (Fed. Cir. 2023) (No. 21-1542), 2021 WL 2283834, at *7.

now frequent.²²⁰ Past examples of courts rejecting this kinship,²²¹ such as Judge Jerome Frank's argument that patent and copyright are historically different,²²² seem increasingly disfavored. The district court in *Lexmark* made just such an argument about historical difference.²²³ The accused infringer in that matter wanted to apply a rule from copyright law, but the court noted that the two legal regimes had different histories on the issue. "Importantly," the judge explained, "the patent exhaustion doctrine's history differs from the history of the first sale doctrine," because patent exhaustion developed exclusively through common law decision-making whereas copyright's own doctrine was shaped by legislative activity.²²⁴ In other words, the history showed that Congress had telegraphed its desire for a particular rule regarding international sales of copyrighted works, but had not chosen to do so in the separate realm of patent. This sensible historical argument for rejecting borrowing fell on deaf ears at the Supreme Court, which relied on its "historic kinship" language to conclude that "the bond between the two leaves no room for a rift on the question of international exhaustion."²²⁵

Speaking of the Supreme Court, it has rebuked the Federal Circuit for failing to approve acts of borrowing from copyright to patent, messaging its own predisposition in favor of greater intellectual property synchronization.²²⁶ It is worth discussing in some detail the Court's decision in *Lexmark*, briefly mentioned earlier,²²⁷ to import a copyright rule—the sale of a product outside the United States exhausts the copyright holder's rights over that product—to the separate domain of patent law. *Lexmark* illustrates how problematic reasoning sustaining borrowing could eventually jeopardize critical boundaries between copyright and patent.

Lexmark makes printer toner cartridges and objected to the practice of other businesses acquiring used cartridges from overseas sellers, refilling them with toner, and then selling them at a cheaper price in the United States.²²⁸ *Lexmark* holds patents on components of the cartridges and the manner in which they are used.²²⁹ Sued for patent infringement, the resellers contended that any sale, foreign or domestic, of a *Lexmark* cartridge should

220. See Barnes, *supra* note 191, at 98, 102 ("Quite frequently, a bare reference to the 'historic kinship' in a footnote is all the analysis lower courts employ.")

221. See *supra* Section II.B.

222. See *supra* note 132 and accompanying text.

223. *Lexmark Int'l, Inc. v. Ink Techs. Printer Supplies, LLC*, 9 F. Supp. 3d 830, 835–37 (S.D. Ohio 2014).

224. *Id.* at 836.

225. *Impression Prods., Inc. v. Lexmark Int'l, Inc.*, 581 U.S. 360, 379 (2017).

226. *Id.* at 378–79; *SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC*, 580 U.S. 328, 336 (2017); *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 392–93 (2006).

227. See *supra* Section II.B.

228. *Lexmark*, 581 U.S. at 367.

229. *Id.*

have extinguished Lexmark's patent rights over that particular cartridge.²³⁰ The resellers had one key authority on their side: a Supreme Court case holding that foreign sales did indeed extinguish rights over *copyrighted* items.²³¹

The Federal Circuit, well aware of the Court's copyright decision, nevertheless concluded that Lexmark could still enforce its patent against the resellers because of some key differences between patent and copyright law. The Federal Circuit noted that the statutory provisions at play on this question were far different in copyright than they were in patent, with the text of the Patent Act containing hints of geographical limits that were not to be found in the Copyright Act.²³² It also highlighted patent-copyright differences in its historical approach to this particular legal question as well as different policy concerns.²³³ On the latter point, the Federal Circuit provided a battery of practical reasons for differential treatment.²³⁴ Unlike copyright, which has been largely harmonized internationally and has minimal eligibility requirements regardless of country, patent laws differ greatly from jurisdiction to jurisdiction and, at the same time, typically demand strenuous examination and costly fees to secure a nation's protection.²³⁵ As a result, even if successful in acquiring rights in the United States, patentees may often be denied protection overseas or elect to not bother with patent protection in other jurisdictions—circumstances that are not typical of copyright protection abroad. A one-size-fits-all exhaustion rule would cause patentees to forfeit their rights from any sale overseas and allow the same products to be brought back into the United States at below-market prices. For the Federal Circuit, this potential blow to inventor economic incentives made transplanting copyright's international exhaustion rule inappropriate.²³⁶

The Supreme Court rejected the Federal Circuit's considered approach in a slim opinion. It saw "little benefit" to allowing patent holders the ability to restrict the import of products back to the United States after foreign sales.²³⁷ It brusquely concluded that whatever diminution in patent holder incentives would be caused by a foreign sale exhaustion rule was outweighed by the need to promote the free flow of commerce.²³⁸ It did little to address the Federal Circuit's detailed arguments about patent-copyright differences on the issue, calling application of copyright's exhaustion rule "straightforward"

230. *Id.* at 367–69.

231. *Kirtsaeng v. John Wiley & Sons, Inc.*, 568 U.S. 519, 528–30 (2013).

232. *Lexmark Int'l, Inc. v. Impression Prods., Inc.*, 816 F.3d 721, 757 (Fed. Cir. 2016).

233. *Id.* at 759–60.

234. *Id.*

235. See Sarah R. Wasserman Rajec, *The Harmonization Myth in International Intellectual Property Law*, 62 ARIZ. L. REV. 735, 750–52 (2020) (contrasting the greater harmonization of copyrights in the Berne Convention to the more limited harmonization of patents under the Paris Convention).

236. *Lexmark*, 816 F.3d at 762.

237. *Impression Prods., Inc. v. Lexmark Int'l, Inc.*, 581 U.S. 360, 372 (2017).

238. *Id.*

and contending that rejecting this act of borrowing “would make little theoretical or practical sense.”²³⁹

Our objection here is not that the Supreme Court picked the wrong doctrine for patent law—a rule privileging the free flow of goods over inventor incentives may make for the best policy. Rather, the Court’s opinion did little to identify the specific historical, doctrinal, or policy similarities that warranted an act of borrowing, particularly in light of the Federal Circuit’s thorough identification of relevant differences on the issue.

Moreover, *Lexmark* is not the only decision revealing the Court’s less-than-considered approach to intellectual property borrowing. In a case addressing the availability of a laches defense within a statute of limitations period, the Court failed to address relevant points of difference between copyright and patent, proclaiming that the same reasoning from a copyright case holding such a defense unavailable “easily” applied to patent law as well.²⁴⁰ This omission was all the more glaring given Justice Breyer’s dissent, which offered a detailed explication of relevant copyright-patent differences on the issue.²⁴¹

In another example of brusque borrowing, the Court’s decision in *eBay v. MercExchange* relied on copyright doctrine to reverse the Federal Circuit’s presumption (and over a century of patent precedent) that a permanent injunction should issue when a plaintiff prevails in a Patent Act dispute.²⁴² The Court instructed the Federal Circuit to instead look to “our treatment of injunctions under the Copyright Act,” which applied general equitable principles rather than a firm presumption in favor of injunctive relief.²⁴³ The rationale for this act of copyright borrowing and rebuke of the Federal Circuit? The majority opinion noted two commonalities: (1) “[l]ike a patent owner, a copyright holder possesses ‘the right to exclude others from using his property’”²⁴⁴ and (2) both the Patent Act and the Copyright Act state that courts “may” (rather than “shall”) issue injunctions.²⁴⁵ While true, it is unclear why various relevant differences between the two regimes—ability to quantify harms from infringement, ease of acquiring rights, susceptibility to “hold up” threats, etc.—were outweighed by these general similarities.²⁴⁶ Our critique is not necessarily that the *eBay* decision was ultimately incorrect. But, rather, it failed to employ the kind of rigorous analysis that should occur when engaging

239. *Id.* at 378.

240. *SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC*, 580 U.S. 328, 336 (2017).

241. *Id.* at 354–55 (Breyer, J., dissenting); see *infra* Section III.A.2.

242. *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 392–93 (2006).

243. *Id.* at 392.

244. *Id.* (quoting *Fox Film Corp. v. Doyal*, 286 U.S. 123, 127 (1932)).

245. *Id.* at 392–93.

246. *eBay*’s holding with regard to patent law permanent injunctions has subsequently impacted the way courts evaluate preliminary injunctions for copyright law. See *Salinger v. Colting*, 607 F.3d 68, 74–75 (2d Cir. 2010).

in borrowing, particularly in the course of enunciating a binding rule with widespread consequences for the entire world of innovation.

At this point, the Supreme Court's embrace of borrowing has not encompassed any legal rules that implement copyright law's channeling doctrines. Exhaustion, laches, and standards for injunctive relief do not implicate the doctrines copyright law uses to ensure exclusive treatment of functional components by the patent system. Still, the Court's unwillingness to wrestle with patent-copyright differences and its surface approach to identifying the historical and policy similarities necessary to warrant an act of borrowing should give us pause. Analysis from the highest court that does not sufficiently pinpoint when an act of borrowing is justified promotes similarly slapdash analyses in the lower courts, potentially leading to the kind of intellectual property overlap that would threaten copyright law's channeling function. Borrowing becomes more dangerous the less explicit it is.

In sum, prophecies of boundary collapse have not yet been realized, at least in the two decades since the *Grokster* decision reinforced patent-copyright borrowing as a valid judicial approach and not just an idiosyncratic move from the *Sony* Court. Borrowing does take place, but it tends to occur on legal questions that do not threaten the critical walls of separation between patent and copyright. But this is not to say that those walls will forever remain in their current condition. The cases discussed in this Part demonstrate that intellectual property borrowing is not always sensitive to legal or historical context, which is precisely the sort of sensitivity needed lest future borrowing threaten copyright's channeling function. The next Part elucidates how to engage in more mindful borrowing such that not only will key boundaries be preserved, but the technique can live up to its promise as a tool for greater predictability and accessibility in the law.

III. BETTER BORROWING

This final Part turns from the descriptive to the prescriptive, detailing a better way to interrogate intellectual property borrowing. Sometimes a comparison of two related phenomena can bring their similarities and differences into greater relief and provoke a deeper understanding of their innate characteristics. Hence, it would be a mistake to simply urge that copyright and patent law are too different to ever learn from each other.

At the same time, one has to be careful. The case law on intellectual property borrowing reveals some rather blithe appeals to shared histories, precedent, and common policy aims as justification for significant legal innovations. Borrowing has its own inertia, which leads to accretion and unintended consequences. Too cozy of a relationship between copyright and patent law would do just what some fear: erode the boundaries between the two regimes and throw off kilter the careful ways in which each is calibrated to encourage innovation while promoting competition and free expression.

What is needed is a more cautious approach to borrowing between patent and copyright doctrine for the benefit of both regimes. A successful resort to borrowing should do more than invoke the “historic kinship” between patent and copyright. It should also involve some articulation of why patent law’s differences do not make the transplanting of a patent doctrine into copyright (or vice versa) inappropriate.

A. *MAKING BORROWING LESS INDETERMINATE*

Analysis of patent-copyright borrowing since *Sony* reveals indeterminacy. For every successful appeal to history, doctrine, or shared policy goals, there is a counterexample rejecting the same appeal to commonality.²⁴⁷ Borrowing’s proponents celebrate its role in making the law more predictable, but this seems not to be the case, at least in the intellectual property context. Better borrowing, which would lead to greater predictability in legal outcomes, requires a more thoughtful, contextual approach to the use of doctrine, history, and policy.

1. Better Use of Doctrine

Doctrinal arguments rely on the wisdom of prior courts—the more times judges have made a particular choice in similar situations, the more it makes sense to repeat that choice. There is nothing inherently wrong with this sort of argument. It intentionally facilitates the conservatism of legal change while also reducing the potential for idiosyncratic errors by taking note of decisions of others.²⁴⁸

Doctrinal arguments cannot justify borrowing, however, if they fail to diagnose a relevant interlegal similarity. Even if it made sense to transplant one framework from a legal terrain to another on one occasion that does not mean that every transplant between those terrains always makes sense. Just because a decision may be made to borrow the First Amendment’s strict scrutiny review of regulations of speech and apply it to firearms restrictions that does not mean that other First Amendment doctrines—“fighting words” or the *Lemon* test for violations of the Establishment Clause—should also be borrowed. Instead, doctrinal arguments should be made as specific as possible, not just citing any past act of borrowing but rather borrowing involving issues related to the matter at hand.

At least when it comes to borrowing in the intellectual property context, part of the problem may lie with the *Sony* decision itself. The *Sony* Court’s doctrinal argument relied on three prior instances of intellectual property borrowing that had nothing to do with the actual legal issue at stake: defining

247. See *supra* Section II.B.

248. BOBBITT, *supra* note 15, at 41–42; see also *Dobbs v. Jackson Women’s Health Org.*, 142 S. Ct. 2228, 2319 (2022) (Breyer, J., dissenting) (describing *stare decisis* as “a foundation stone of the rule of law: that things decided should stay decided unless there is a very good reason for change”).

the scope of responsibility for another party's acts of infringement.²⁴⁹ One case from 1834 cited by the Court addressed whether Congress had the authority to create a federal law of copyright and thereby preclude a separate common law of copyright.²⁵⁰ The two other cases dealt with copyright in motion pictures, one affirming that copyright royalties are a taxable source of income,²⁵¹ and the other finding that the old studio system requiring theatres to acquire licenses to all films released by a studio violated the antitrust laws.²⁵² Although each of the three cases contains language suggesting similarity between patent and copyright law, they only mention the obvious: patents and copyrights are both designed to incentivize certain activities that redound to the benefit of the larger public.²⁵³ Moreover, none of these invocations of patent-copyright similarity was essential to the ultimate holding of each case. In fact, none represented a real act of borrowing, i.e., the transplanting of a doctrinal frame from one subject area to another. Hence, *Sony* rests its doctrinal argument for patent-copyright borrowing on an extremely slender and nonspecific reed.

Better borrowing demands specific interrogation of past borrowing precedents to make sure they are germane to the actual doctrinal rule being exported from one legal territory to another. Take, for example, a decision to rely on prior case law involving patent law and preemption to determine preemption rules for copyright law.²⁵⁴ In evaluating a preemption dispute, a federal district court acknowledged a general history of patent-copyright borrowing, but then went deeper, probing particularized borrowing precedent directly relevant to the issue at hand.²⁵⁵ The court examined patent case law holding that allegations of “bad faith” or “ill-intent” are insufficient to distinguish a state law unfair competition claim from a concurrent patent infringement claim.²⁵⁶ According to this case law, without more, the state law claim must be preempted in favor of the federal patent infringement claim.²⁵⁷ Noting that this situation was analogous to filing a state law unfair competition claim alleging “bad faith” alongside a copyright infringement claim, the court concluded that borrowing, and preemption, was warranted.²⁵⁸ This particularized inquiry—in contrast to the approach in *Sony* and many subsequent borrowing

249. Menell & Nimmer, *supra* note 74, at 985–89.

250. *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591, 627 (1834).

251. *Fox Film Corp. v. Doyal*, 286 U.S. 123, 131 (1932).

252. *United States v. Paramount Pictures, Inc.*, 334 U.S. 131, 160 (1948).

253. *See Paramount Pictures, Inc.*, 334 U.S. at 158; *Doyal*, 286 U.S. at 131; *Wheaton*, 33 U.S. (8 Pet.) at 657–58.

254. *See generally* *Carson Optical, Inc. v. Prym Consumer USA, Inc.*, 11 F. Supp. 3d 317 (E.D.N.Y. 2014) (analyzing copyright infringement under federal patent law preemption rules).

255. *Id.* at 331.

256. *Id.*

257. *Id.* at 328–30.

258. *Id.* at 330.

cases—is essential lest borrowing’s inertia simply determine every new proposal for doctrinal transplantation.

2. Better History

It is true that we can tell very similar origin stories for both copyright and patent law.²⁵⁹ In the United States, both kinds of intellectual property protection are enshrined in the same clause of the Constitution and Congress enacted legislation to implement them around the same time.²⁶⁰ Recent scholarly research shows that original understandings of the framing of the Intellectual Property Clause reflected a refusal to separate patent and copyright protection into rigid categories.²⁶¹ Promotion of “[s]cience” was not the exclusive goal of the patent power nor was promotion of the “useful [a]rts” the exclusive goal of the copyright power.²⁶² Rather “there was no dichotomous distinction between ‘science’ and [the] ‘useful arts’ in 1787.”²⁶³ Instead, the Framers seem to have understood it to be the province of both copyright and patent law to promote science and to promote the useful arts.²⁶⁴

Yet it does not take much to complicate this narrative. Looking at the development of copyright and patent law through a longer historical lens reveals a significant gulf between the two areas of intellectual property that only grew over time. The historical record reveals significant divergence, both before and after the introduction and approval of the Constitution (including the Intellectual Property Clause) in 1787.²⁶⁵ Just as importantly, the subject matter, duration, and scope of copyright and patent law have developed independently over the past two and a half centuries, frequently with good reasons relating to the respective goals of the regimes and the advent of distinct social, economic, and technological changes.

As a result, sweeping and undisciplined historical kinship arguments can lead to troubling results that disregard meaningful and subsequent doctrinal divergences that warrant caution.²⁶⁶ Just as it is essential to not simply recognize

259. Cf. Tsai, *supra* note 6, at 534 (discussing importance of “a historically grounded jurisprudence” that evaluates borrowing by asking “why past generations of Americans have insisted that certain rights be discussed and protected together”).

260. See Oliar, *supra* note 105, at 463–69.

261. *Id.* at 466.

262. See U.S. CONST. art. I, § 8, cl. 8.

263. Oliar, *supra* note 105, at 466.

264. *Id.* Indeed, in the early 1800s, federal patent and copyright protection were quite similar, even having the same term of protection: fourteen years (albeit with a renewal term for copyrights that was absent in patent law). See also Joseph P. Fishman, *Originality’s Other Path*, 109 CALIF. L. REV. 861, 915 (2021) (discussing “a period of leaky boundaries between copyright and patent” law in the early 1800s, including a parallel approach in setting a creativity threshold for patentability and for the copyrightability of musical works).

265. Walterscheid, *supra* note 80, at 309.

266. Although the free-speech portion of the decision is not a case of borrowing involving patent law, *Eldred v. Ashcroft* illustrates this phenomenon in action with the Supreme Court’s

borrowing precedent but to identify borrowing precedent directly relevant to the legal issue at hand, so it is crucial to only rely on the persuasive appeal of shared patent and copyright histories when there is a particularized historical connection with the legal rule being potentially exported. Different historical details in two legal regimes' treatment of an issue should outweigh any generalized appeal to "historic kinship." Returning to the example of whether a laches defense can be asserted before the conclusion of the statute of limitations for filing a patent claim, Justice Breyer astutely pointed out historical differences that, while not determinative, militated against a case of copyright to patent borrowing.²⁶⁷ Copyright doctrine holds that laches cannot be asserted as a defense against a claim for damages within the statute of limitations.²⁶⁸ But, as Breyer noted, patent law has a different historical backdrop that must be considered.²⁶⁹ Copyright law offered a relatively blank canvas on the issue, with no federal statute of limitations existing until 1957.²⁷⁰ By contrast, the history of patent law reveals a statute of limitations in existence since 1897 and "a century and a half of history during which courts held that laches and a statute of limitations could coexist."²⁷¹ The majority seemed to overlook this relevant history in its zeal to borrow.

It is of paramount importance when investigating the historical argument for borrowing to make sure the historical excavation is complete. Those making appeals to historical similarity run the risk of overlooking key events from the past that can make a similarity no longer as resonant. For example, Chief Justice Roberts touted history when deciding that patent law should borrow from copyright law's rule that an international sale exhausts one's rights in the item sold.²⁷² "There is a 'historic kinship between patent law and

approach to the alleged tension between First Amendment rights and copyright. *Eldred v. Ashcroft*, 537 U.S. 186, 193, 219 (2003). The majority opinion drafted by Justice Ginsburg posited that, because the First Amendment and the Copyright Clause were passed in close temporal proximity and because they purportedly shared the common goal of encouraging free expression, they operated in relative harmony and shared a historical kinship. *Id.* at 219. Consequently, she argued, any free speech concerns raised by copyright could generally be addressed through the copyright's internal metes and bounds, as such as the idea-expression dichotomy and the fair use defense. *Id.* at 219–21. Ginsburg's invocation of historical kinship obfuscated the profound differences between eighteenth century and twenty-first century copyright law. Such a position also presumes the Framers would never do anything contradictory—a tenuous position, at best. The very individuals who passed the First Amendment thought it a good idea to enact the Alien and Sedition Acts of 1798, which, among other things, effectively banned public opposition to the government and trampled freedom of the press in perhaps one of the most flagrant assaults on free speech in American history.

267. *SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods.*, 580 U.S. 328, 348–52 (2017) (Breyer, J., dissenting).

268. *Petrella v. MGM*, 572 U.S. 663, 667–68 (2014).

269. *SCA Hygiene Prods. Aktiebolag*, 580 U.S. at 352–54.

270. *Id.* at 354; Act of Sept. 7, 1957, Pub. L. No. 85-313, 71 Stat. 633 (codified as amended at 17 U.S.C. § 507(b)).

271. *SCA Hygiene Prods. Aktiebolag*, 580 U.S. at 354.

272. *Impression Prods., Inc. v. Lexmark Int'l, Inc.*, 581 U.S. 360, 366 (2017).

copyright law,” he proclaimed, “and the bond between the two leaves no room for a rift on the question of international exhaustion.”²⁷³ Because, in Roberts’s view, patent and copyright exhaustion rules both shared the same “roots in [an] antipathy toward restraints on alienation,” borrowing from copyright on the issue was a simple decision that manifested not only good policy but congressional intent.²⁷⁴ But the relevant history is actually not so simple. As Herbert Hovenkamp has pointed out, Congress has stepped in to ratify previous “judge-made exhaustion rule[s] for copyright[ed]” works but has chosen not to do so in the case of patent law.²⁷⁵ This attention to the subsequent history of congressional activity in the area hints that Congress may not desire a patent international exhaustion rule that matches copyright.²⁷⁶ At the least, it shows that the historical argument for borrowing is not a clear-cut as Roberts’s majority opinion would have us believe.

Selective historical amnesia is not just a problem for intellectual property law. For example, emerging Second Amendment jurisprudence calls upon courts to engage in what critics have called “law office history,” for which jurists are arguably ill-equipped and untrained. Judge Richard Posner popularized the term “law office history” when critiquing the Supreme Court’s outcome-oriented decision in *District of Columbia v. Heller*.²⁷⁷ He defined the practice as one where

[t]he judge sends his law clerks scurrying to the library and to the Web for bits and pieces of historical documentation. When the clerks are the numerous and able clerks of Supreme Court justices, enjoying the assistance of the capable staffs of the Supreme Court library and the Library of Congress, and when dozens and sometimes hundreds of amicus curiae briefs have been filed, many bulked out with the fruits of their authors’ own law-office historiography, it is a simple matter . . . to write a plausible historical defense of his position.²⁷⁸

As Posner noted, the resulting recitation may be “breathtaking, but it is not evidence of disinterested historical inquiry. It is evidence of the ability of well-staffed courts to produce snow jobs.”²⁷⁹

273. *Id.* at 379 (citation omitted).

274. *Id.* at 363.

275. Herbert Hovenkamp, *Reasonable Patent Exhaustion*, 35 YALE J. ON REG. 513, 522–23 (2018).

276. *See id.*

277. Richard A. Posner, *In Defense of Looseness*, NEW REPUBLIC (Aug. 27, 2008), <https://newrepublic.com/article/62124/defense-looseness> [<https://perma.cc/8ND5-RR9D>]. *See generally* *District of Columbia v. Heller*, 554 U.S. 570 (2008) (employing a historical and textual reading of the Second Amendment to find an individual right to keep and bear arms for the purpose of self-defense).

278. Posner, *supra* note 277.

279. *Id.*; *see also* Saul Cornell, *Heller, New Originalism, and Law Office History: “Meet the New Boss, Same as the Old Boss,”* 56 UCLA L. REV. 1095, 1098 (2009) (critiquing, from the perspective of a

Our study of the borrowing cases leads us to conclude that historical appeals should be the least persuasive argument in the borrowing toolkit. One does not have to be as cynical as Posner to worry about the ability of advocates and judges to excavate all relevant details of a purported historical parallel. As Justice Breyer warned when criticizing another prominent example of slipshod legal history: “Courts are, after all, staffed by lawyers, not historians. Legal experts typically have little experience answering contested historical questions or applying those answers to resolve contemporary problems.”²⁸⁰ We think that similar historical trajectories do indeed militate in favor of borrowing but, prudentially speaking, busy judges may not always be in the best position to evaluate such arguments. At the least, appeals to borrowing based on shared histories should be careful not to omit relevant details from the past and judges should review such arguments with particular rigor.

3. Better Policy

Prudential arguments contend that there is a match between the public policy grounds for a doctrinal rule in two separate legal contexts. In some ways, the prudential argument operates in the opposite manner of doctrinal or historical arguments. As described by constitutional law scholar Philip Bobbitt, whereas those rationales are “used in an effort to escape the impress of peculiar facts to get to the high[er] ground of principle,” the prudential argument grounds itself in “the political and economic circumstances surrounding the decision.”²⁸¹

Just as with the doctrinal and historical arguments for intellectual property borrowing, courts have been guilty of failing to adequately specify the public policy similarities that would legitimate an act of borrowing. Take, for example, the Fourth Circuit’s search for the appropriate mental state to trigger liability for contributory copyright infringement in *BMG Rights*. The court had to decide what mental state should be actionable for a defendant who did not intend for infringement to occur but materially contributed to the infringement.²⁸² Copyright holders wanted an objective standard, which would hold deep-pocketed communications platforms liable if they “should have known of . . . infringement.”²⁸³ For their part, technologists advocated for a subjective standard, requiring confirmation that the defendant knew of infringement regardless of whether a reasonable person in the same situation would have known that infringement was taking place.²⁸⁴ The Fourth Circuit

prominent historian, law office history as “a results oriented methodology in which evidence is selectively gathered and interpreted to produce a preordained conclusion”).

280. *N.Y. State Rifle & Pistol Ass’n v. Bruen*, 142 S. Ct. 2111, 2177 (2022) (Breyer, J., dissenting).

281. BOBBITT, *supra* note 15, at 61, 66.

282. *See* *BMG Rts. Mgmt. (US) LLC v. Cox Commc’ns, Inc.*, 881 F.3d 293, 307 (4th Cir. 2018).

283. *Id.* at 308 (emphasis omitted) (quoting *In re Aimster Copyright Litig.*, 334 F.3d 643, 650 (2003)).

284. *Id.*

sided with the technologists, borrowing from patent law to make its decision.²⁸⁵ In patent law, thanks to a Supreme Court decision in a case called *Global-Tech*, secondary liability under Section 271 (b) of the Patent Act has to be based on what the defendant actually knew, not what it should have known.²⁸⁶ So-called willful blindness—when the defendant takes active steps to avoid learning of infringement—also counts.²⁸⁷ The Fourth Circuit decided this should be the rule for contributory copyright infringement as well: “We are persuaded that the *Global-Tech* rule developed in the patent law context, which held that contributory liability can be based on willful blindness but not on recklessness or negligence, is a sensible one in the copyright context. It appropriately targets culpable conduct without unduly burdening technological development.”²⁸⁸

The problem is that the Fourth Circuit did not go on to explain why the *Global-Tech* rule was “appropriate” or not “unduly burdensome” in both contexts. It is not really an answer to just say that a subjective mental state standard strikes the right balance between the interests of copyright holders and the public interest in technological innovation. After all, that is what every intellectual property rule is meant to do. Although copyright law implicates new technologies, they are not front and center in the same way that they are in patent law. It may very well be that the relevant policy concerns are similar enough to justify borrowing in this instance. But for better borrowing that similarity needs to be articulated so it can be interrogated by the parties and by courts in subsequent cases.

Some argue that this sort of rationale should not feature into a decision to borrow or not to borrow. To the extent borrowing is supposed to promote predictability, borrowing that relies on public policy considerations arguably makes the law less predictable. Sunstein maintains that acts of borrowing (and other associated acts of analogical reasoning) make the law more predictable by not bogging judges down in considerations for which they are ill-equipped and likely to hold disparate views.²⁸⁹ His view rests on a conception of borrowing that hews more to historical and doctrinal similarities and leaves policy concerns to the legislature.²⁹⁰

At least in the context of intellectual property, and probably in any borrowing evaluation, however, policy similarities and dissimilarities should not be removed from consideration. As difficult as they are to predict, the social and economic consequences of new intellectual property rules are a necessary part of judicial rulemaking in this area. Taking judges’ eyes off of the “progress” that is the constitutionally mandated prime directive for any

285. *Id.* at 308–10.

286. *Global-Tech Appliances, Inc. v. SEB S.A.*, 563 U.S. 754, 766 (2011).

287. *Id.* at 771.

288. *BMG Rts. Mgmt. (US) LLC*, 881 F.3d at 309.

289. Sunstein, *supra* note 58, at 782–83.

290. *See id.* at 746–47.

new legal test for copyright or patent law would lead to suboptimal results.²⁹¹ Although Sunstein considered the nonpolicy aspects of borrowing a feature, not a bug, failure to consider the policy considerations animating patent-copyright boundaries jeopardizes their ultimate purposes.²⁹² Some predictability gains from borrowing may be sacrificed if courts continue to rely on predictions of similar economic or social consequences to justify their decisions; but, this is a better result than allowing courts to elide investigation of the public considerations or the “high-level” principles at stake in their decisions.²⁹³

B. MAKING BORROWING MORE ACCESSIBLE

Even if borrowing was not making intellectual property law more coherent, it still might be valuable for its role in democratizing participation in patent and copyright law matters. According to its backers, borrowing, by bridging divides in legal subject matters, allows greater understanding by those not steeped in a particular legal discipline.²⁹⁴ In the context of intellectual property, however, we have seen that there is some cause to doubt borrowing’s democratizing effects, particularly given the central role played by the Federal Circuit in acts of patent-copyright crosspollination.²⁹⁵ Better borrowing requires evening the playing field and this means that generalist circuits, not just the Federal Circuit and Supreme Court, should engage with borrowing.

Even more importantly, to encourage maximum accessibility and new ways of approaching existing doctrine—when appropriate—we see no reason why borrowing should only flow in one direction. To date, juridical adoption of theories of liability, defenses, and other doctrinal innovations in intellectual property have usually flowed from patent to copyright law, and not the other way around. We are unaware of any court having ever addressed the reason for this bias squarely, but one particular cause for the unidirectional nature of the borrowing does come to mind: notions of hierarchy.

Judges, as human beings, are naturally impacted by perceptions of prestige and stature. In intellectual property law, a distinct pecking order exists as patent law is tacitly, if not expressly, viewed as the pinnacle of the field. Within the legal profession (and, possibly, even without), patent law is often perceived of as more complex and specialized than copyright law. After all, while patent law has its own court (at least at the appellate level),²⁹⁶

291. Samuelson, *supra* note 75, at 1496–97, 1513–15; *see also* Christopher Buccafusco & Mark A. Lemley, *Functionality Screens*, 103 VA. L. REV. 1293, 1296 (2017) (“[C]ourts have not coordinated the various functionality doctrines across different IP regimes, allowing them to develop in the appropriate ways.”).

292. Samuelson, *supra* note 75, at 1513–14.

293. Sunstein, *supra* note 58, at 747.

294. *See supra* Section I.C.1.

295. *See supra* Section II.C.

296. *See* 28 U.S.C. § 1295(a)(1) (granting the Federal Circuit exclusive jurisdiction over patent appeals).

copyright law does not. Patent law requires specialized practitioners: An attorney must be a member of the U.S. Patent and Trademark Office and have a scientific background to prosecute patents.²⁹⁷ Meanwhile, although there are no *de jure* certification formalities to practice patent litigation, the profession has imposed *de facto* regulations that create a significant barrier to entry to the field for most attorneys. Specifically, most patent firms do not hire those without science backgrounds.²⁹⁸ No such training or barriers to entry are present in practicing copyright law.

Colloquial legal language also suggests an implicit hierarchy. Copyright law (along with trademark law and right of publicity law) are referred to as “soft” IP while patent law is “hard” IP, and, other than with bread rolls, hard always carries superior connotations to soft.²⁹⁹ The top legal firms also buy into such a hierarchy. At one of the AmLaw100 firms where one of the authors used to work, recruiting efforts were limited to individuals in the top ten percent of their class and the prestige of one’s law school was weighed significantly in the initial hiring decision. But there was an exception: For patent attorneys, the firm dispensed with the ten-percent rule and showed much greater flexibility with respect to law school affiliation. Patent-related qualifications and experience were viewed as inherently elite and scarce.³⁰⁰

With an implicit intellectual property hierarchy entrenched in minds of the legal profession, it should not be surprising that doctrinal developments tend to flow from patent to copyright law and not the other way around. After all, to take an example familiar to all legal academics, Yale and Harvard do not borrow; they lead the way and let others adopt their positions and methodologies. Thus, it was not until Yale and Harvard—the perennial top ranked schools—decided to abandon the long-criticized U.S. News and World Report rankings, after thirty years of cooperation, that other law schools suddenly followed suit in a course of just weeks.³⁰¹ In the same spirit, courts

297. See 37 C.F.R. § 11.7 (2022) (setting out the qualifications required for being admitted to practice as a patent prosecutor before the USPTO). This requirement even applies—without good reason—to the nontechnical field of design patents. See Christopher Buccafusco & Jeanne C. Curtis, *The Design Patent Bar: An Occupational Licensing Failure*, 37 CARDOZO ARTS & ENT. L.J. 263, 265 (2019) (critiquing said licensing requirement as “completely irrational”).

298. See Robin A. Rolfe, *IP Practice Management: Observations from the Outside*, 7 LANDSLIDE 54, 54 (2015) (noting that, historically, “[m]ost IP firms were essentially patent practices whose attorneys had scientific or engineering backgrounds, which distinguished them from lawyers in other legal disciplines”).

299. See Amanda Levendowski, *Hard Truths About Soft IP*, COLUM. L. REV. F. (forthcoming 2023) (manuscript at 3–4, 7), https://papers.ssrn.com/sol3/papers.cfm?abstract_id=4374762 [<https://perma.cc/38K3-YA2U>].

300. Such prejudices are not entirely without basis. The technical moorings of most patent work can easily intimidate those without formal scientific backgrounds.

301. See Anna Esaki-Smith, *After Yale and Harvard Law Schools Leave U.S. News Rankings, Stanford, Columbia, Others Follow*, FORBES (Nov. 21, 2022, 8:56 AM), <https://www.forbes.com/sites/annaesakismith/2022/11/21/after-yale-and-harvard-law-schools-depart-us-news-rankings-stanford-columbia-others-follow> [<https://perma.cc/48KG-NM6G>].

may be more likely to turn to “hard IP” decisions in patent law for guidance in copyright cases than they are to turn to “soft IP” decisions in the less prestigious field of copyright law for guidance in patent cases.

This unchecked and unjustified bias may not be serving our jurisprudence well. An example of copyright to patent borrowing from an earlier era when the relative statuses of patent and copyright law were not so clear shows what is being lost. In the 1950 decision *Graver Tank*, the Supreme Court formally enunciated patent law’s modern “doctrine of equivalents,”³⁰² holding that, even in instances when an allegedly infringing product does not contain all of the elements of a patented invention, a finding of infringement can still issue.³⁰³ Under the doctrine of equivalents, if an allegedly infringing product performs “substantially the same function in substantially the same way to obtain substantially the same result as the claim limitation,”³⁰⁴ equitable considerations can support a finding of infringement.³⁰⁵ As the Court reasoned in *Graver Tank*,

to permit imitation of a patented invention which does not copy every literal detail would be to convert the protection of the patent grant into a hollow and useless thing. Such a limitation would leave room for—indeed, encourage—the unscrupulous copyist to make unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the claim, and hence outside the reach of law.³⁰⁶

Of particular significance was the rationale cited by the Court to support the development of this heretofore unknown doctrine: the Court referred to copyright law. As the Court analogized, “[o]ne who seeks to pirate an invention, like one who seeks to pirate a copyrighted book or play, may be expected to introduce minor variations to conceal and shelter the piracy.”³⁰⁷ Implicit in this statement was the view that copyright law had successfully found a way to make such conduct actionable and that patent law should follow suit. To interdict disingenuous workarounds and prevent “not-liable” verdicts on technicalities, patent law needed a mechanism that, like copyright law, eschewed resting all infringing findings on pure one-to-one copying. The *Graver Tank* Court noted as much:

302. *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 612 (1950). The origins of the doctrine of equivalents reach back further. Most observers trace it back to the Supreme Court’s 1853 decision in *Winans v. Denmead*, 56 U.S. 330 (1853), although the formal term was not used in that case. See Darcy August Paul, *The Judicial Doctrine of Equivalents*, 17 HARV. J. L. & TECH. 247, 250 (2003).

303. *Graver Tank*, 339 U.S. at 607 (1950).

304. *Schoell v. Regal Marine Indus., Inc.*, 247 F.3d 1202, 1209–10 (Fed. Cir. 2001).

305. *Graver Tank*, 339 U.S. at 608 (citing the “wholesome realism of [the] doctrine”).

306. *Id.* at 607.

307. *Id.*

Outright and forthright duplication is a dull and very rare type of infringement. To prohibit no other would place the inventor at the mercy of verbalism and would be subordinating substance to form. It would deprive him of the benefit of his invention and would foster concealment rather than disclosure of inventions, which is one of the primary purposes of the patent system.³⁰⁸

Copyright law did not officially have a doctrine of equivalents, but its operative infringement test demanded *substantial* similarity, not identity.³⁰⁹ The doctrine of equivalents borrowed this critical theme, tailoring it for use in patent law.

If borrowing is a potentially welcome practice, absent substantial justification (which has not materialized so far), one would expect that it would occur both ways.³¹⁰ But, in conceding inspiration from copyright law, *Graver Tank* is an outlier, at least under modern conditions. Courts may be undertheorizing and missing opportunities for (borrowed) doctrinal innovations in patent law because of internalized perceptions that it may be above it all.³¹¹ Our recommendation on this issue is a modest one: judges, including those on the Federal Circuit, should police themselves for bias. This policing should be easier to achieve if the other recommendations we make here for better borrowing are always followed regardless of the borrowing source.

C. AVOIDING BOUNDARY COLLAPSE

As described in Part II, it appears that subject matter boundaries between patent and copyright are holding, at least for now. But the hydraulic pressure exerted by successful borrowing is significant and only increases over time. Just as one defending a military stronghold should deploy resources to strengthen areas of maximum value and vulnerability, steps should be taken to bolster intellectual property's channeling doctrines in the face of growing general alignment between patent and copyright law. This Article recommends three steps. First, legal actors should police themselves and others for universalist appeals to borrowing—mindful borrowing requires the articulation of *specific* relevant similarities between the two regimes. This recommendation has already been discussed earlier in this Part.³¹² Second, more attention should be paid to the difference between statutory and common law rules. Third, acts of borrowing must be adopted with the flexibility to subsequently tailor one regime's doctrinal rule to the potentially different circumstances of another.

308. *Id.*

309. *Comptone Co. v. Rayex Corp.*, 251 F.2d 487, 488 (2d Cir. 1958).

310. Hirsch, *supra* note 59, at 23 (contending that “[a]s a working principle . . . *intercategorical analysis should operate reciprocally*”).

311. And, at the risk of committing sacrilege, we posit that the Yales and Harvards of the world might actually benefit from borrowing positions, innovations, and pedagogical approaches from less prestigious institutions.

312. *See supra* Section III.A.

1. The Special Case of Borrowing from Statutory Sources

Common law and statutory borrowing should be evaluated differently. The borrowing of statutory precedent raises significant concerns that a court may be undoing a studied determination by the legislature to impose a rule on one regime but not the other. Indeed, statutory precedent demands significant deference, both on separation of powers grounds and based both on the superior fact-finding and on information-gathering tools enjoyed by legislatures over courts.³¹³ The unusual, subtle, and heretofore unacknowledged importation of patent's treble damages statutory regime into the copyright damages jurisprudence provides an instructive example of the dangers of borrowing statutory precedent.

Despite whatever "historical kinship" they might share, copyright and patent law have distinct damages regimes which are the product of careful (albeit lobbyist-inflected) legislative consideration. By statute, infringed utility patent holders receive only actual damages, typically by way of a hypothetical reasonable royalty.³¹⁴ A potential trebling of actual damages is available at the discretion of the court,³¹⁵ but solely in cases of willfulness,³¹⁶ and attorneys' fees are only available in "exceptional" cases.³¹⁷ By sharp contrast, in copyright law, assuming timely registration, plaintiffs can receive statutory damages of up to \$30,000 per act of infringement, or up to \$150,000 per act of willful infringement.³¹⁸ Such awards require no proof of actual damages whatsoever.³¹⁹ Meanwhile, prevailing parties are eligible to receive their attorneys' fees at the discretion of the court, with no finding of willfulness needed.³²⁰ Even plaintiffs who are ineligible for statutory damages and fees (for want of timely

313. See Yoo, *supra* note 77, at 207 ("A court should eschew broad categorical approaches, such as categorically analogizing to patent law, in favor of more granular analysis of the precise contours of legislative intent.").

314. 35 U.S.C. § 284 (providing prevailing patent plaintiffs with "damages adequate to compensate for the infringement, but in no event less than a reasonable royalty for the use made of the invention by the infringer"). Since 1946, patent plaintiffs have been ineligible to receive a disgorgement of profits, as amendments to the Patent Act effectively eliminated this remedy. See Pamela Samuelson, John M. Golden & Mark P. Gergen, *Recalibrating the Disgorgement Remedy in Intellectual Property Cases*, 100 B.U. L. REV. 1999, 2070–71 (2020).

315. 35 U.S.C. § 284 ("[T]he court may increase the damages up to three times the amount found or assessed.").

316. *Graco, Inc. v. Binks Mfg. Co.*, 60 F.3d 785, 792 (Fed. Cir. 1995) ("Willfulness of the infringement is the sole basis for the court's exercise of its discretion to enhance damages under 35 U.S.C. § 284 (1988).").

317. 35 U.S.C. § 285.

318. See 17 U.S.C. § 504(c)(1)–(2).

319. See *id.*; H.R. REP. NO. 94-1476, at 161 (1975) (noting Congress's intent that a plaintiff "is not obliged to submit proof of damages and profits" to receive statutory damages under the 1976 Copyright Act).

320. See 17 U.S.C. § 505.

registration³²¹) can recover actual damages *and* disgorgement of profits,³²² thereby receiving both compensatory and restitutionary relief.

All told, therefore, the law effectively permits some level of efficient infringement of patents—a state of affairs that reflects the utilitarian nature of patents and the accompanying public policy tolerating a certain level of patent infringement to leave room for societal exigencies and basic issues of human welfare (for example, during a pandemic).³²³ Indeed, in patent litigation, so long as a defendant's actions are not willful, the worst outcome it will typically face is having to pay the royalty it would have had to pay *ex ante* had it obtained a license in the first place.³²⁴ Meanwhile, for timely registered works of authorship, the statutory damages hammer serves as a powerful restraint on all copyright infringement—a position that, among other things, reflects the absence of life-or-death necessity in the use of copyrighted works.³²⁵

At the end of the day, the structure of the respective remedy schemes reflects a judgment about the nature of the regimes, the subject matter of the protections, and the stakes at issue. As Roger Blair and Thomas Cotter have emphasized in their comparative assessment of infringement damages, these differences especially speak to varying conditions facing rightsholders in the respective intellectual property fields.³²⁶ Copyright's statutory damages regime responds to the particularly salient problem of pervasive small-scale infringement of creative works,³²⁷ an issue that has only grown more pronounced with the explosion of digital technology. Indeed, with smartphones in all of our pockets and the power to reproduce and transmit creative works throughout the world in a matter of minutes at our fingertips, individuals can now infringe copyrighted works on unparalleled scale.³²⁸ The resulting ease and quantity

321. See 17 U.S.C. § 412.

322. See 17 U.S.C. § 504(a) (“[A]n infringer of copyright is liable for . . . the copyright owner’s actual damages and any additional profits of the infringer.”).

323. Joe Nocera, *The Patent Troll Smokescreen*, N.Y. TIMES (Oct. 23, 2015), <https://www.nytimes.com/2015/10/24/opinion/the-patent-troll-smokescreen.html> [<https://perma.cc/32YW-BJZ5>] (arguing that “big companies can now largely ignore legitimate patent holders. Of course, they don’t call it stealing . . . [Instead,] a new phrase has emerged in Silicon Valley: ‘efficient infringing’”).

324. It is only under willful circumstances that a multiplier (and the possibility of fees) applies and then, only upon clear and convincing evidence brought by the plaintiff and, at most, that multiple is three (treble damages).

325. This is to say nothing of the criminal sanctions available in copyright law which are wholly absent in patent law. See Irina D. Manta, *The Puzzle of Criminal Sanctions for Intellectual Property Infringement*, 24 HARV. J. L. & TECH. 469, 469 (2011).

326. See generally ROGER D. BLAIR & THOMAS F. COTTER, *INTELLECTUAL PROPERTY: ECONOMIC AND LEGAL DIMENSIONS OF RIGHTS AND REMEDIES* (2005) (providing an overview of enforcement and licensing practices across patents, trademarks, and copyrights). Notably, Blair & Cotter do not excuse all differences as grounded in rational concerns about varying real-world conditions. For example, they argue that patent law’s failure to provide restitutionary remedies “is difficult to rationalize and probably should be abandoned.” *Id.* at 71.

327. *Id.*

328. John Tehranian, *The New ©ensorship*, 101 IOWA L. REV. 245, 265 (2015).

of infringement, coupled with the difficulties of establishing actual damages and carrying out successful enforcement (as a result of the challenges of digital anonymity, jurisdictional complexities, and the sheer magnitude of unauthorized use), make statutory damages an ideal fit for copyright in the eyes of Congress.

In recent years, however, case law emanating from various district courts has dramatically undermined Congress's statutory damages regime in copyright law by adopting a default rule of treble damages.³²⁹ These courts have betrayed the clear text of the Copyright Act and, tacitly and without justification, borrowed from patent law's distinctive remedies scheme. While the courts have not expressly invoked patent law in this process, they could not be doing anything but. Treble damages are a relatively uncommon remedy.³³⁰ In federal law, they are found only under the Clayton Antitrust Act,³³¹ the Lanham Act,³³² RICO,³³³ and of course, the Patent Act.³³⁴ The source of the borrowing is even more obvious when one notes that the adoption of the treble damages rule for copyright law has typically required an accompanying finding of willfulness. While the Copyright Act does not condition statutory damages on willfulness, patent law conditions treble damages on such a finding.

In sum, many district courts have effectively implemented a treble-damages rule in copyright—without explanation other than reliance on other cases that issued treble damages—the plain statutory language of the Copyright Act and its legislative history be damned.³³⁵ The trend is most widespread and prominent in the Second Circuit.³³⁶ Epitomizing just how entrenched the treble default standard is in the Southern District of New York, a published decision there rejected a request for a statutory damages

329. See *infra* notes 329–31 and accompanying text.

330. For example, with its treble damage remedy, antitrust law “stands relatively unique in the American tort universe.” Spencer Weber Waller, *The Incoherence of Punishment in Antitrust*, 78 CHI.-KENT L. REV. 207, 207 (2003).

331. 15 U.S.C. § 15.

332. 15 U.S.C. § 1117(a)–(b).

333. 18 U.S.C. § 1964.

334. 35 U.S.C. § 284.

335. *E.g.*, *Broad. Music, Inc. v. Pub Dayton, LLC*, No. 11-cv-58, 2011 WL 2118228, at *4 (S.D. Ohio May 27, 2011); *Sailor Music v. IML Corp.*, 867 F. Supp. 565, 570 & n.8 (E.D. Mich. 1994).

336. See, *e.g.*, *Broad. Music, Inc. v. Prana Hosp., Inc.*, 158 F. Supp. 3d 184, 199 (S.D.N.Y. 2016) (“Second Circuit case law . . . reflects that courts in this Circuit commonly award, in cases of non-innocent infringement, statutory damages of between three and five times the cost of the licensing fees the defendant would have paid.”); *Erickson Prods., Inc. v. Only Websites, Inc.*, 12-cv-1693, 2016 WL 1337277, at *3 (S.D.N.Y. Mar. 31, 2016) (“Courts in this District have also found that damage awards amounting to three times the plaintiff’s licensing fee are adequate both to deter the defendant from violating copyright law in the future, and to serve as a general deterrent to other potential infringers.”); *Nat’l Photo Grp., LLC v. Bigstar Ent., Inc.*, 13-cv-5467, 2014 WL 1396543, at *4 (S.D.N.Y. Apr. 11, 2014) (report and recommendation adopted) (finding that, in cases of willful infringement, “trebling the licensing fee . . . is in line with the general approach taken by courts” in calculating statutory damages).

award amounting to six times an unpaid license fee and criticized the plaintiffs for “not [having] explained the basis for exceeding that customary norm.”³³⁷ In the process, the court elided the fact that the so-called norm to which it was referring is imported from patent law, which has a completely different damages regime dictated expressly by Congress—presumably with good reason. There is nothing in the Copyright Act that suggests the appropriateness of a norm of trebling actual damages when providing statutory awards. Quite to the contrary, the legislative history of statutory damages and the fact that the Copyright Act expressly does not use patent law’s treble damages metric strongly suggest otherwise.

Some courts adopting the treble damages scheme in copyright law have seemingly gone so far as to suggest that any multiplier of actual damages is conditioned on a finding of willfulness.³³⁸ This is more evidence of unsupported borrowing. After all, it is only patent law that provides a multiplier effect (treble) in instances of willfulness. By sharp contrast, by statute, statutory damages in copyright law apply whether or not an infringement is willful.³³⁹ So, insofar as statutory damages constitute a multiplier regime, they are available for all prevailing plaintiffs who have timely registered their works,³⁴⁰ regardless of the defendant’s intent or mens rea. Nevertheless, in perhaps the most misguided statement by a court on the subject, an unpublished disposition by the Second Circuit stated (quite incorrectly) that, “to discourage willful infringement, the Copyright Act allows a trial court to grant treble damages and attorneys’ fees.”³⁴¹

To be clear, this is only an act of partial patent-copyright borrowing. Courts in the Second Circuit appear to be importing patent law’s provision for treble damages without also bringing along its entire remedial scheme, including the obligation to submit proof of damages for any monetary award. Still, this backdoor importation of patent law’s treble damages provision into copyright law has occurred in the absence of serious analysis or scrutiny, any concern about the relevant doctrinal differences between the regimes, or any acknowledgement of the real-world challenges facing their respective enforcement.³⁴² To make matters worse, the subversion has happened in a

337. *Prana*, 158 F. Supp. 3d at 199.

338. *See, e.g.*, *Broad. Music, Inc. v. 120 Bay St. Corp.*, No. 09-cv-5056, 2010 WL 1329078, at *2 (E.D.N.Y. Apr. 5, 2010) (“In light of defendants’ willful infringement, I find an award of damages that is approximately three times the annual license fee to be reasonable.”); *Natl. Photo Grp.*, 2014 WL 1396543, at *4 (finding treble damages appropriate in part because of willful infringement).

339. 17 U.S.C. § 504(c)(1)–(2).

340. 17 U.S.C. § 412.

341. *Lawton v. Melville Corp.*, No. 96-9461, 1997 WL 346129, at *2 (2d Cir. June 24, 1997).

342. Even in patent law, critics have charged that treble damages do not come close to providing adequate compensatory damages for rightsholders. *See* Robert H. Lande, *Are Antitrust “Treble” Damages Really Single Damages?*, 54 OHIO ST. L.J. 115, 161–63 (1993) (providing an empirical assessment of the current antitrust damages regime to conclude that plaintiffs’ awarded damages amount to less than their actual damages).

manner that violates traditional separation of powers concerns (since wholesale reform of copyright's damages regime would seem to lie within the province of Congress, not the courts) and disregards Congress's superior power to investigate, study, and deliberate over public policy issues. By effectively supplanting a specific remedial scheme knowingly and carefully implemented by Congress, this act of legerdemain has functioned to overturn statutory law and convert the special statutory damages in copyright law to the treble damages system of patent law by judicial fiat.

2. Maintaining Regime-Specific Flexibility

The borrowing (and distinctive evolution) of the misuse doctrine from patent to copyright law provides a more welcome example of thoughtful borrowing. For our purposes, the story of the misuse doctrine's move from patent to copyright law illustrates the need to keep a watchful eye on key inter-regime boundaries even after the initial act of borrowing. Ironically, borrowing the doctrine from patent law has assisted in patrolling regime boundaries by guarding the functionality line that divides patent and copyright protection. With the expansion of the subject matter of copyright to include works such as software which have functional dimensions—the traditional province of patent law—the particularized adoption of the misuse doctrine has provided an important tool to judges concerned about rightsholders trying to convert their legitimate copyright monopolies into quasi-patent monopolies.

Although the doctrine of patent misuse dates back many decades,³⁴³ it received the formal blessing of the Supreme Court in 1942 in the foundational *Morton Salt* case.³⁴⁴ In that decision, the Court recognized that, in certain conditions, a rightsholder's unsavory conduct can serve as an equitable bar to the enforcement of its patent rights and provide a complete defense to infringement for a defendant during the period of misuse.³⁴⁵ Notably, defendants can raise the misuse defense even if they are not the actual victim of the misuse. As the Supreme Court opined, “[i]t is the adverse effect upon the public interest of a successful infringement suit, in conjunction with the patentee's course of conduct, which disqualifies him to maintain the suit, regardless of whether the particular defendant has suffered from the misuse of the patent.”³⁴⁶

Morton Salt presaged this leap from patent to copyright law by using intentionally broad language when it opined that a “patentee, like these other holders of an exclusive privilege granted in the furtherance of a public policy, may not claim protection of his grant by the courts where it is being used to subvert

343. The Supreme Court first alluded to the availability of the defense, but not by name, in 1917. See *Motion Picture Pats. Co. v. Universal Film Mfg. Co.*, 243 U.S. 502, 519 (1917).

344. *Morton Salt Co. v. G. S. Suppiger Co.*, 314 U.S. 488, 493 (1942).

345. *Id.*

346. *Id.* at 494.

that policy.”³⁴⁷ But the transplantation of the misuse doctrine from patent law to copyright was not a forgone conclusion; it had no direct precedent when the Fourth Circuit became the first court to adopt the copyright misuse defense in *Lasercomb v. Reynolds*.³⁴⁸

In the case, Lasercomb had developed a copyrighted computer software that enabled designers to produce cardboard cutout templates that the program would then use to mechanize the creation of a conforming steel rule die.³⁴⁹ As a condition for using the program, named Interact, Lasercomb required licensees to covenant that they would not participate in the creation of any alternate die-making software for a period of ninety-nine years.³⁵⁰ When Lasercomb sought to enforce its copyright to Interact, the defendant, Reynolds, claimed misuse.³⁵¹ After admitting the live question of whether a copyright misuse defense existed at all, the court pointed to “parallel public policies [that] underlie the protection of both types of intellectual property rights,” as evidenced by their common origins and similar developments, to support importation of the doctrine.³⁵² As the court reasoned:

Both patent law and copyright law seek to increase the store of human knowledge and arts by rewarding inventors and authors with the exclusive rights to their works for a limited time. At the same time, the granted monopoly power does not extend to property not covered by the patent or copyright.³⁵³

Since *Lasercomb*, several circuit courts have followed suit, recognizing the viability of the defense.³⁵⁴

Having reasoned that the misuse doctrine could apply in the copyright context, the *Lasercomb* court proceeded to assess whether Lasercomb’s license terms rose to the level of misuse and found that they did.³⁵⁵ In the process, the court showed particular concern that the imposed conditions effectively called upon any company licensing Interact to withdraw the creative abilities of its entire workforce and not work on alternative (and potentially superior)

347. *Id.* (emphasis added).

348. *Lasercomb Am., Inc. v. Reynolds*, 911 F.2d 970, 973, 976–77 (4th Cir. 1990).

349. *Id.* at 971.

350. *Id.* at 973.

351. *Id.* at 972–73.

352. *Id.* at 974.

353. *Id.* at 976.

354. For example, the Ninth Circuit adopted the defense, see *Prac. Mgmt. Info. Corp. v. Am. Med. Ass’n*, 121 F.3d 516, 521 (9th Cir. 1997), and the Fifth Circuit followed suit, see *Alcatel USA, Inc. v. DGI Techs., Inc.*, 166 F.3d 772, 793–94 (5th Cir. 1999). Notably, the Federal Circuit acknowledged the defense yet expressed some discomfort with it given its explicit statutory mention in the Patent Act, see 35 U.S.C. § 271 (d), but not in the Copyright Act. See *Atari Games Corp. v. Nintendo of Am. Inc.*, 975 F.2d 832, 846 (Fed. Cir. 1992); Yoo, *supra* note 77, at 180.

355. *Lasercomb*, 911 F.2d at 979.

die-casting software.³⁵⁶ Such a state of affairs not only harmed the licensee but, above all, constituted a use of the copyright monopoly to effectively deprive the public of further innovation and the dissemination of that innovation.³⁵⁷

The practice of leveraging one's legitimate intellectual property monopoly to illegitimately secure another type of monopoly or inequitable advantage not granted by law has always laid at the heart of a typical misuse claim.³⁵⁸ But, as Deepa Varadarajan argues, while patent misuse doctrine has almost exclusively focused on anticompetitive, antitrust-related violations, copyright misuse has taken a broader, more amorphous form, applying to a wider variety of conduct that imperils socially valuable uses of copyrighted works.³⁵⁹ The *Lasercomb* court quickly dispensed with the notion that antitrust principles would necessarily guide its finding of misuse: "The question is not whether the copyright is being used in a manner violative of antitrust law . . . but whether the copyright is being used in a manner violative of the public policy embodied in the grant of a copyright."³⁶⁰ Thus, while the *Lasercomb* court was the first court to borrow patent law's misuse doctrine, it was also the first court to chart copyright misuse's evolution in a different direction. And while some critics may bemoan such capacious applications "as indicative of the doctrine's overall incoherence, and counsel either a narrowing of copyright misuse to mimic patent misuse's antitrust-inspired focus on competition harms or a scrapping of the misuse doctrine altogether,"³⁶¹ Varadarajan celebrates them as evidence of a salubrious evolution in the doctrine to meet the particular contours of copyright law.³⁶²

Also illustrative of the flexible maturation of misuse once in the hands of copyright law are cases addressing copyright claims with the potential to stifle free expression. Copyright law implicates significant First Amendment concerns that are largely absent in patent law. Accordingly, copyright misuse has evolved to address free speech (and not merely market competition) issues that may come from overly expansive and abusive attempts to enforce one's copyright monopoly. In the earliest adoption of the misuse doctrine in copyright law in the Third Circuit, the court recognized, but ultimately found unavailing, a defendant's misuse claim grounded in Disney's conditioning of content licenses on covenants that the websites upon which licensees make use of Disney's work will not be "derogatory to or critical of the entertainment industry or of [Disney] (and its officers, directors, agents, employees,

356. *Id.* at 978.

357. *Id.*

358. *Morton Salt Co. v. G. S. Suppiger Co.*, 314 U.S. 488, 492 (noting that the patent misuse doctrine reflects the fact that public policy "forbids the use of [a] patent to secure an exclusive right or limited monopoly not granted by the Patent Office").

359. Varadarajan, *supra* note 74, at 759–61.

360. *Lasercomb*, 911 F.2d at 978.

361. Varadarajan, *supra* note 74, at 773.

362. *Id.*

affiliates, divisions and subsidiaries) or of any motion picture produced or distributed by [Disney].”³⁶³

Even more illustrative of how borrowing can take place without the erosion of critical boundaries, as the subject matter of copyright has expanded into areas within the traditional province of patent law, copyright misuse doctrine has provided a vital defense to help patrol the line between copyright and patent protection. Thus, borrowing from patent law in this instance has enabled better policing of the copyright-patent divide. For example, the Fifth Circuit drew on the misuse doctrine to bar DGI Technologies, the owner of certain telecommunications software, from enforcing its copyrights thereto because it had conditioned licensing of its work on exclusive use of (unpatented and functional) hardware that it just so happened to manufacture.³⁶⁴

The court decried such tying as an indirect attempt “to obtain patent-like protection of its hardware—its microprocessor card—through the enforcement of its software copyright.”³⁶⁵ Similarly, the copyright misuse defense played a key role in litigation where Omega tried to prevent importation of its (unpatented and functional) watches by placing an engraved design on their backs and claiming copyright infringement when Costco sold them without a license.³⁶⁶ At the district court level, Costco prevailed on summary judgment based on the misuse doctrine.³⁶⁷ Although the Ninth Circuit ultimately affirmed on different grounds,³⁶⁸ a concurring opinion emphasized the misuse at play and the role of the doctrine in preventing an attempt to gain “a copyright-like monopoly over uncopyrightable Seamaster watches.”³⁶⁹ Copyright misuse therefore prevented both DGI and Omega from gaining monopolies related to functional, useful articles such as microprocessor cards

363. *Video Pipeline, Inc. v. Buena Vista Home Ent., Inc.*, 342 F.3d 191, 203 (3d Cir. 2003) (alterations in original). Ultimately, the limited scope of the restrictions—which did not fully censor the licensees’ speech but, rather, only prevented it on the very websites on which Disney content appeared—led the court to conclude that the defendant was unlikely to prevail on the copyright misuse defense. *See id.* at 206. But, quite importantly, the court recognized the viability of a copyright misuse defense and noted that such censorial practices—particularly if they had been less restrained (e.g., preventing licensees from making any speech that is negative about Disney or the entertainment industry)—might impermissibly leverage Disney’s monopoly over the public distribution and performance of its works into securing an effective gag order against criticism. Such a holding was not—strictly speaking—merely in support of a potential violation of antitrust law or only about market competition. Rather, as the court explained, such restrictions could undermine the very constitutional goal of the copyright regime: the facilitation of artistic creativity and free expression for the public good. *Id.* at 204.

364. *Alcatel USA, Inc. v. DGI Techs., Inc.*, 166 F.3d 772, 793 (5th Cir. 1999).

365. *Id.*

366. *Omega S.A. v. Costco Wholesale Corp.*, No. CV 04-05443, 2011 WL 8492716, at *1 (C.D. Cal. Nov. 9, 2011).

367. *Id.* at *2.

368. *Omega S.A. v. Costco Wholesale Corp.*, 776 F.3d 692, 695 (9th Cir. 2015).

369. *Id.* at 703 (Wardlaw, J., concurring).

and watches—the proper province of patent law—through the illegitimate exploitation of the copyright monopoly.

Unlike patent law, copyright law has virtually no formalities and provides for protection for decades longer than the twenty-year patent term.³⁷⁰ Recognizing the threat from attempts to use copyright law to gain patent-like protections for utilitarian aspects of creative works, courts took it upon themselves to alter the contours of copyright misuse from its patent origins. As Laura Heymann has summarized, “[c]ourts have on occasion deployed the misuse doctrine to prevent copyright owners from asserting copyright in ways that seem far removed from the economic interests traditionally seen to be at the core of copyright law, even when antitrust interests are not at stake,” particularly when “plaintiffs are attempting an end-run around the limitations of a particular legal doctrine.”³⁷¹ The success of misuse’s deployment in copyright law was buoyed by the lack of judicial rigidity in transplanting the doctrine from patent law. This meant the application of the misuse defense in copyright could take on a different character that calibrated it to the regime’s particular needs, including those not present in patent law. All told, the evolution of copyright’s misuse defense illustrates how courts can carefully borrow in a manner that reflects regime differences and respects (and, in fact, enforces) doctrinal boundaries.

CONCLUSION

Doctrinal borrowing is a practice regularly deployed by courts and, like most juridical techniques, borrowing can do both harm and good. Yet the use of borrowing has been undertheorized and underscrutinized, particularly in the field of intellectual property. Such a state of affairs is especially significant given the big bang of intellectual property borrowing, which occurred in 1984 when the Supreme Court employed an appeal to the purported “historical kinship” between copyright and patent law to justify wholesale importation of patent’s “staple article of commerce” doctrine into copyright for the very first time. The Supreme Court’s blessing of the practice of intellectual property borrowing has triggered a veritable deluge of patent-copyright crosspollination over the past few decades. In some instances, such borrowing has bolstered both the copyright and patent regimes, enabling them to better meet their respective goals. But, as we have seen, that has not always been the case. And, alarmingly, we have witnessed numerous instances where blind recitation of the “historical kinship” trope or undisciplined citations to ostensible precedents have been used to justify borrowing without appropriate scrutiny and consideration of the relevant historical record, doctrinal evolution, and the public policy at issue. On the opposite end of the spectrum, some courts have

370. *Golan v. Holder*, 565 U.S. 302, 306 (2012).

371. Laura A. Heymann, *Overlapping Intellectual Property Doctrines: Election of Rights Versus Selection of Remedies*, 17 STAN. TECH. L. REV. 239, 268, 270 (2013).

waived away the possibility of entertaining any kind of borrowing based on knee-jerk reactions in favor of regime integrity, thereby missing potentially valuable opportunities for doctrinal development.

Courts can and should do better. As we have detailed, with a more rigorous use of doctrine, history, and policy considerations, courts can improve the determinacy of borrowing. Freed from ill-conceived notions of hierarchy, courts can also ensure that borrowing (or the lack thereof) does not occur only unidirectionally. Moreover, by favoring certain forms of borrowing over others (common law over statutory, flexible over rigid), courts can better respect important doctrinal boundaries and prevent regime blur that can undermine the efficacy of a given set of legal rules. Our taxonomy of borrowing therefore presents several key principles that can guide courts grappling with issues of cross-pollination:

- Articulate specific parallels between two legal regimes when engaging in borrowing. Appeals to history, doctrine, or policy should pertain to the legal rule at issue, and not be so general as to justify any exchange between the two regimes;
- Treat the use of prior borrowing to rationalize further borrowing with skepticism. A blind obeisance to past precedent for borrowing does not enhance interests in respecting stare decisis but, rather, more often than not leads to undisciplined acts of importation that can threaten to blur doctrinal boundaries and undermine the public policy goals of the regime in question;
- Eschew sweeping claims of historical kinship that often ignore the differing evolution of intellectual property regimes over time (such as technological developments relevant to enforcement efforts or dichotomies in terms of subject matter coverage and rights protection). We should be particularly doubtful of such efforts to justify borrowing given the troubling tendency toward the undisciplined use of “law office history”;
- Avoid knee-jerk reactions in favor of regime integrity that may reflect implicit hierarchical biases. In categorically waiving away the possibility of entertaining any kind of borrowing, jurists can miss potentially valuable opportunities for doctrinal development and making the law more accessible to nonspecialists;
- Approach statutory, as opposed to common law, borrowing with greater skepticism. Unlike the latter, the former raises significant concerns that a court may be undoing a studied determination by the legislature to impose a rule on one regime but not the other. Separation-of-powers concerns and the reality of superior fact-finding and information gathering tools enjoyed by legislatures over courts caution against such borrowing; and
- Even after borrowing, continue to review related doctrinal innovations for the need for regime-specific adjustments.

Sometimes, once the legal transplant has been made, it should be allowed to develop its own salutary adaptations in a new environment.

Our common law tradition demands some consideration of past doctrine when confronting novel legal situations, but such efforts must be conscious and well-reasoned. Otherwise, borrowing becomes a smokescreen for the “inconsistency and caprice” of outcome-driven judicial determinations that ignore relevant regime-specific contexts.³⁷² Without the legislature’s power of the purse or the executive’s power of the sword, courts ultimately derive their strength from a perception of legitimacy—a perception bolstered by faith in their reasoning. Many proposals have been made for restoring their “tattered credibility” as of late.³⁷³ Better borrowing would be a start.

372. Jill Lepore, *The Supreme Court’s Selective Memory*, NEW YORKER (June 24, 2022), <https://www.newyorker.com/news/daily-comment/the-supreme-courts-selective-memory-on-gun-rights> [https://perma.cc/YME3-W9MS].

373. Mark A. Lemley, *The Imperial Supreme Court*, 136 HARV. L. REV. F. 97, 116 (2022).