SEPARATING OWNERSHIP FROM CREATORSHIP IN INTELLECTUAL PROPERTY SYSTEMS

Timothy E. Murphy[†]

[†] Assistant Professor at University of Idaho College of Law. The author would like to thank the following individuals for comments and advice on earlier drafts of this article: Tun-Jen Chiang, Colleen Chien, Benji Cover, Nikola Datzov, Jason Dykstra, Charles Tait Graves, Jordan Gross, Camilla Hrdy, John Hinton, Joe Isanga, David Levine, Christopher J. Morten, Elizabeth Rowe, John Rumel, Sharon Sandeen, Christopher Seaman, Ryan Vacca, Deepa Varadarajan, and Sam Williams. Additionally, special thanks go to Blaykleigh Smythe for her excellent research assistance on this project.

ABSTRACT

In the United States, the various intellectual property ("IP") systems take fundamentally different approaches to invention, authorship, or creation (collectively "creatorship") of the protected intangibles. With respect to patents and copyrights, ownership initially vests with the creator and so establishing creatorship is a path to establishing ownership. Once ownership applies to an IP asset, the ownership can be protected (by enforcing the IP rights), transferred, or licensed. The connection between ownership and creatorship is currently of significant importance as our IP systems wrestle with the implications of non-human creations, such as the outputs of artificial intelligence ("AI") systems.

On the trade secrets side of things, creatorship does not lead necessarily to ownership in trade secrets law the way it does in patents and copyrights, therefore making creatorship largely irrelevant to ownership. Instead, ownership of trade secrets vests in whomever meets the three statutory requirements of secrecy, independent economic value, and reasonable efforts. The creator certainly could be the owner, but in the modern corporate world, it is much more likely that the trade secrets are owned initially by an employer, rather than the employee or creator. Similar to trade secrets, trademark creatorship does not result in an ownership interest for purposes of trademark law. Instead, trademark rights arise upon use in commerce, which use may or may not be by the original creator. Accordingly, there is no clear incentive to specify trademark creatorship interests under existing trademark law.

This Article traces the historical connection between creatorship and ownership in U.S. intellectual property law in order to set the stage for a discussion of the implications of this connection, or disconnection, for our overall intellectual property system. In particular, traditional theoretical justifications for having an intellectual property system apply differently, and maybe not at all, to disconnected systems. Moreover, referring to disconnected systems as intellectual property systems at all could be a mischaracterization. Finally, this Article explores whether even connected systems are becoming more

disconnected as time passes, which could create significant challenges for how we conceptualize, maintain, and update our intellectual property systems over time. This may also have a significant impact on how we evolve our understanding of the correct treatment of non-human or AI-created innovation in our IP systems.

INTRODUCTION

The existence of intellectual property rights are often associated with the notion of some creator or innovator contributing to the public store of things like knowledge, art, and technology.[1] Through this lens, the granting of exclusive rights in their creations can be seen as furthering one or more of several potential societal goals, including incentivizing creation, rewarding creators (independent of the incentive rationale), protecting a moral interest creators have in their creations, and regulating market dynamics.[2] All of these societal goals (except possibly the last) rely on some connection between the creator and the exclusive rights granted. As an example, if the societal goal of incentivizing creation is going to be effective, it is the creators that need to be incentivized.[3]

Another key aspect of a functioning intellectual property system is the notion of an owner, or more specifically, the person or entity that owns the exclusive rights the system provides with respect to a particular piece of intellectual property.[4] Without an owner that is in

1. For an excellent exploration of public perception of creators versus creative reality, *see* JESSICA SILBEY, THE EUREKA MYTH: CREATORS, INNOVATORS, AND EVERYDAY INTELLECTUAL PROPERTY (2015). Throughout the rest of this Article, the concept of innovators and creators, and innovations and creations, will be merged for simplicity, and reference will simply be made to creators and creations with the understanding that these terms are also intended to include innovators and innovations, generally.

2. *See, e.g.*, PETER S. MENELL ET AL., INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE: *2022*, at 21–23 (2022) (providing an overview of various theoretical justifications for intellectual property rights).

3. This assertion is not intended to overlook the possibility that the incentives could be indirect (e.g., by incentivizing a non-creator with the intent that the non-creator would then somehow flow those incentives down to creators). It should also be appreciated that incentives do not necessarily need to be economic; they could be reputational, intellectual/emotional, or tied to professional advancement.

4. On this point, it is worth noting that each of the federal statutory schemes for patents, copyrights, trademarks, and trade secrets make at least some reference to the concept of an "owner" and two of these specifically define the term owner. *See* 35 U.S.C. § 261 (addressing ownership and assignments of patents); 17 U.S.C. § 101 (defining "copyright owner"); 15 U.S.C. § 1127 (providing definitions for various trademark terms, many of which reference the "owner" of the mark); 18 U.S.C. § 1839(4) (defining the "owner" of a trade secret). However, for purposes of this

a position to enforce their exclusive rights, an intellectual property right would not have anything other than nominal value. This nominal value would likely not be sufficient to accomplish any of the previously mentioned societal goals, at least not more effectively than a simple right of attribution. Thus, having (and designating) an owner is an important aspect of any intellectual property system that is intended to further the types of societal goals listed above.

Intuitively, we understand the idea that in order for there to be creation, there must be a creator.[5] Less intuitive perhaps is the notion that there must be an owner. The concept of an owner does not necessarily flow directly from the idealized notion of creation discussed above, but if pressed, it is likely that most would acknowledge the assumption that the creator is the owner, at least as an initial matter. In other words, people may simply assume that intellectual property systems automatically connect creation with ownership.[6] In light of this assumption, what would it mean to have an intellectual property system where there was no connection between creatorship and ownership? This Article explores that question.

As discussed below, the disconnect between creatorship and ownership in some forms of intellectual property has been long-standing or has developed over a relatively long period of time.[7] Consequently, this disconnect is not a new issue. However, this issue has taken on new importance as our intellectual property systems wrestle with how to handle non-human creations.[8] Although the in-apt named "Monkey Selfie" case is becoming somewhat long in the tooth, its resolution on

---

discussion, ownership is used in the broad sense stated in the text, rather than as defined in any particular statute.

5. These terms are being used in their ordinary sense, without any religious or metaphysical connotation. In other words, "creation" should be understood to be simply the "act of creating." *Creation*, MERRIAM-WEBSTER, https://www.merriam-webster.com/dictionary/creation (last visited Aug. 5, 2024) (on file with the Syracuse Law Review). Creator should be understood to be the "one that creates." *Creator*, MERRIAM-WEBSTER, https://www.merriam-webster.com/dictionary/creator (last visited Aug. 5, 2024) (on file with the Syracuse Law Review) .

6. This assumption of course is based upon a particular European/American cultural construct of rights and ownership and does not necessarily hold true in other cultural contexts. *See, e.g.*, Trevor Reed, *Creative Sovereignties: Should Copyright Apply on Tribal Lands?*, 67 J. COPYRIGHT SOC'Y U.S.A. 313, 351–56 (2020) (describing the Hopi people's views on ownership of creative works).

7. *See infra* Parts I–IV.

8. This notion of "non-human" is intended to be just a colloquial generalization and not as an entry point for a larger conversation about what it means to be human. For a lengthier discussion of that issue within the context of Lockean philosophy, *see generally* Jeremy Waldron, *Species and the Shape of Equality*, *in God, Locke, and Equality* 44 (2002).

the copyright creatorship issue continues to provide fodder for academic inquiry.[9] Artificial intelligence ("AI") systems are the latest (and perhaps last) players on this stage.[10] Thus, the question of connection between creatorship and ownership is both long-standing and timely.

The important point to note about the emerging and/or ongoing discussions about non-human creators is that the end goal is not to establish creatorship for its own sake. Rather, the goal is to establish creatorship as a path to ownership. In connected systems,[11] this makes perfect sense, as establishing creatorship may be the only viable path to establishing ownership, and the failure to identify a legal creator may foreclose the possibility of establishing a legal owner of a particular creation.[12] In the absence of an owner, the particular creation may simply become a part of the public domain with no exclusive rights preventing the creation from being exploited by anyone. On the other hand, in disconnected systems, there is no need to establish creatorship because establishing a legal creator is not necessary to establish a legal owner. Instead, ownership arises through some other mechanism that is not strictly connected to creatorship.[13] Consequently, the connection, or lack thereof, between creatorship and ownership is an

9. *See, e.g.*, Paul T. Babie, *The Monkey Selfies: Reflections on Copyright in Photographs of Animals*, 52 U.C. DAVIS L. REV. 103 (2018–2019); Nathan Hakimi, *Monkey Business: Copyright, Stunt Litigation, & New Visions in Animal Law*, 9 J. ANIMAL & ENV'T. L. 1 (2017); Jonathan Siderits, *The Case for Copywriting Monkey Selfies*, 84 U. CIN. L. REV. 327 (2018); Joshua Jowitt, *Monkey See, Monkey Sue: Gewirth's Principle of Generic Consistency and Rights for Non-Human Agents*, 19 TRINITY COLL. L. REV. 71 (2016). There is no shortage of scholarly articles mentioning this case, but these articles are cited due to their significant engagement with the underlying issues relevant to this Article.

10. *See, e.g.*, Kalin Hristov, *Artificial Intelligence and the Copyright Dilemma*, 57 IDEA 431 (2017); Shlomit Yanisky-Ravid, *Generating Rembrandt: Artificial Intelligence, Copyright, and Accountability in the 3A Era—The Human-like Authors Are Already Here—A New Model*, 2017 MICH. ST. L. REV. 659 (2017); W. Michael Schuster, *Artificial Intelligence and Patent Ownership*, 75 WASH. & LEE L. REV. 1945 (2018); Mimi S. Afshar, *Artificial Intelligence and Inventorship - Does the Patent Inventor Have to Be Human?*, 13 HASTINGS SCI. & TECH. L.J. 55 (2022); David S. Levine, *Generative Artificial Intelligence and Trade Secrecy*, 3 J. FREE SPEECH L. 559 (2023); Timothy Murphy, *Do Androids Dream of Economic Incentives?*, 57 AKRON L. REV. 253 (2024).

11. In this Article, the term "connected systems" will be used to refer to intellectual property systems where ownership is connected to creatorship, typically by initial ownership vesting in the creator. Similarly, the term "disconnected systems" will be used to refer to systems where ownership is not connected to creatorship. These concepts will be built out further in the following parts of the Article.

12. *See infra* Parts I, II.

13. *See infra* Parts III, IV.

important threshold matter when considering the ownership of non-human generated creations.

This Article explores connection, and disconnection, in the four primary intellectual property systems under U.S. law: patents, copyrights, trademarks, and trade secrets. Parts I through IV of this Article review the history and current state of each of the U.S. systems through the lens of the connection between ownership and creatorship. Part III offers an in-depth discussion of the trade secret system due to its broad subject matter coverage and increasing importance in the modern workplace.[14] Finally, Part V explores various repercussions of the disconnect between creatorship and ownership in disconnected systems. The last Section in this Part looks to how the trend towards disconnection might make disputes over non-human creatorship a largely academic discussion without practical legal significance.

I. INVENTORS & OWNERS UNDER PATENT LAW

The U.S. patent system has maintained a close legal connection between inventorship and ownership since its inception.[15] Although not directly creating any individual patent rights, the Constitution states that "[t]he Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."[16] This language suggests that if Congress chooses

14. With respect to increasing importance, it is worth noting that employer-employee claims constitute the majority of trade secrets claims in the modern era. *See* David S. Almeling et al., *A Statistical Analysis of Trade Secret Litigation in Federal Courts*, 45 GONZ. L. REV. 291, 299–300, 302 (2009) (providing statistical analysis of trade secrets cases in federal court and concluding that most cases are by employers against employees); *see also* Dennis Crouch, *Trade Secret Filings*, PATENTLY-O (Oct. 28, 2022), https://patentlyo.com/patent/2022/10/trade-secret-filings.html (compiling litigant information from ten recent trade secrets cases) (on file with the Syracuse Law Review). Moreover, increasing reliance on trade secrets law is expected in the wake of national and state-level efforts to weaken or eradicate employee non-compete agreements. *See FTC Proposes Rule to Ban Noncompete Clauses, Which Hurt Workers and Harm Competition*, FED. TRADE COMM'N (Jan. 5, 2023), https://www.ftc.gov/news-events/news/press-releases/2023/01/ftc-proposes-rule-ban-noncompete-clauses-which-hurt-workers-harm-competition (on file with the Syracuse Law Review).

15. For purposes of this discussion, the "creator" for patent purposes will simply be understood to be the same as the "inventor" under existing patent law. The emphasis in this sentence should be on the word "legal" because, as discussed later, the modern patent system may suffer from significant "practical" disconnection. *See infra* Part V.D. The use of the term "legal connection" indicates connection created by statute or common law and does not necessarily reflect a particular practical reality.

16. U.S. CONST. art. I, § 8, cl. 8.

to create a system to protect discoveries (actually, inventions, in our modern parlance[17]) those rights will be bestowed on the inventor(s). This notion that patent rights would be awarded to inventors is also consistent with Thomas Jefferson's writings from the time.[18]

The first Patent Act[19] codified the notion that patent rights would initially be granted to inventors.[20] Specifically, the statute said:

> [U]pon the petition of any person or persons to the Secretary of State, . . . setting forth, that he, she, or they, hath or have invented or discovered any useful art, manufacture, engine, machine, or device, or any improvement therein not before known or used, and praying that a patent may be granted therefor, it shall and may be lawful to and for the Secretary of State, . . . if they shall deem the invention or discovery sufficiently useful and important, to cause letters patent to be made out in the name of the United States . . . granting to such petitioner or petitioners, his, her or their heirs, administrators or assigns for any term not exceeding fourteen years, the sole and exclusive right and liberty of making, constructing, using and vending to others to be used, the said invention or discovery.[21]

Interestingly, the language of the Act supports the argument that the patent could initially be granted to an inventor's "assigns."[22] However, there is no indication that a patent was ever granted under this statute directly to an "assign" of the inventor, without recognizing the initial interest in the inventor themselves.[23] Moreover, even if the

17. For a thorough discussion of the extent to which the concept of "invention" in the Patent Act is consistent with the Constitution's use of the term "discoveries," *see* Seán M. O'Connor, *The Overlooked French Influence on the Intellectual Property Clause*, 82 U. CHI. L. REV. 733, 733–830 (2015).

18. *See* Graham v. John Deere Co., 383 U.S. 1, 8 (1966) (quoting various correspondence from Jefferson, including "Art. 9. Monopolies may be allowed to persons for their own productions in literature, & their own inventions in the arts, for a term not exceeding _ _ years but for no longer term & no other purpose" and "[c]ertainly an inventor ought to be allowed a right to the benefit of his invention for some certain time").

19. *See* Patent Act of 1790, ch. 7, 1 Stat. 109.

20. *See id.* at § 1.

21. *Id.*

22. *See id.*

23. There are a good number of patent cases in the 1800s dealing with issues of assignment, but I did not find any that recognized an initial patent right in an assignee that was not connected to initial ownership by the inventor. *See, e.g.*, Littlefield v. Perry, 88 U.S. 205, 225 (1874) (dealing with pre-patent invention assignment); Shaw Relief Valve Co. v. New Bedford, 19 F. 753, 753 (C.C.D. Mass. 1884) (dealing with

patent was granted to an assignee, presumably the original inventor would still be named as the inventor and the assignee would need to show some chain of title leading from the inventor to themselves. The very notion of an "assign" obtaining rights means that the rights must exist initially in the assignor because otherwise, the assignment agreement would not have any consideration sufficient to form a valid agreement.[24]

The Patent Act of 1836 continued the practice of granting patents to inventors,[25] while leaving open the possibility that the grant could go to assignees, and reads as follows:

> Every such patent shall contain a short description or title of the invention or discovery, correctly indicating its nature and design, and in its terms grant to the applicant or applicants, his or their heirs, administrators, executors, or assigns, for a term not exceeding fourteen years, the full and exclusive right and liberty of making, using, and vending to others to be used, the said invention or discovery.[26]

This Act also included the requirement that the inventor(s) supply an "oath or affirmation" that they are the original inventor of the invention for which a patent is sought.[27] Again, even though the statute seems to contemplate the ability of "assigns" to obtain patents directly,

---

patent disposition after death of inventor). Conceptually, the issue was much more interesting in the nineteenth century than it is today because patents were subject to a renewal term and so courts had to decide whether an assignment or license during the first term was still effective during the renewal term. *See* Woodworth v. Curtis, 30 F. Cas. 565, 566 (C.C.D. Mass. 1847).

24. *See* Regan Vapor-Engine Co. v. Pac. Gas-Engine Co., 49 F. 68, 71 (9th Cir. 1892) (distinguishing valid patent assignments and "mere quitclaims").

25. "[A]ny person or persons having discovered or invented any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement . . . not known or used by others before his or their discovery or invention thereof, and not, at the time of his application for a patent, in public use or on sale, with his consent or allowance, as the inventor or discoverer; and shall desire to obtain an exclusive property therein, may make application in writing to the Commissioner of Patents, expressing such desire, and the Commissioner, on due proceedings had, may grant a patent therefor. But before any inventor shall receive a patent for any such new invention or discovery, he shall . . . ." Patent Act of 1836, ch. 357, § 6, 5 Stat. 117, 119.

26. *Id.* at § 5.

27. *See id.* at § 6 ("The applicant shall also make oath or affirmation that he does verily believe that he is the original and first inventor or discoverer of the art, machine, composition, or improvement, for which he solicits a patent, and that he does not know or believe that the same was ever before known or used; and also of what country he is a citizen; which oath or affirmation may be made before any person authorized by law to administer oaths.").

there is not any indication that this was ever done in such a way that would have derogated original ownership in the inventor.[28] Note that under this statute any attempt to obtain the patent directly by an "assign" would have required the cooperation of the inventor(s) in order to meet the oath or affirmation requirement.[29]

One innovative aspect of the 1836 Act is the inclusion of a specific section on assignment of patent rights.[30] This Section confirms that patents are assignable at law and imposes various requirements and administrative procedures on such assignments.[31] Notably, this Section of the 1836 Act does not address assignment of any pre-application invention or any pending application; it appears, instead, to simply address assignment of granted patents. The case law from this time period confirms the view that patent rights vest initially in the inventor and are then subject to valid assignments under general contracts principles and the specific statutory requirements.[32]

The final major revision to the Patent Act for purposes of this discussion was the Patent Act of 1952.[33] Under the modern Act

---

28. *See, e.g.*, *Littlefield* 88 U.S. at 225; *Shaw Relief Valve Co.*, 19 F. at 753. *Woodworth*, 30 F. Cas. at 566.

29. The 1836 Act does account for the situation where an inventor dies before a patent is granted, but it does not deal with the situation where an invention is simply assigned through contract. *See* Patent Act of 1836 at § 10.

30. *See id.* at § 11.

31. *See id.*

32. *See, e.g.*, Hapgood v. Hewitt, 119 U.S. 226, 233 (1886) (affirming that, absent an agreement to the contrary, employee was not required to assign patent to employer); United States v. Berdan Fire-Arms Mfg. Co., 156 U.S. 522, 566 (1895) ("[T]he prior inventor is the one who, under the statutes, is entitled to the monopoly. Rev. Stat. §§ 4884–4886. 'For any one invention but one valid patent can exist; and of several distinct inventors of the same invention one only is entitled to receive a grant of the exclusive right.'" (quoting WILLIAM C. ROBINSON, *Patent Privilege Conferred only on the First and Original Inventor*, *in* THE LAW OF PATENTS FOR USEFUL INVENTIONS 91, 91–93 (1890))); Niagara Radiator Co. v. Meyers, 40 N.Y.S. 572, 574 (Sup. Ct. 1896) (in the absence of an agreement to the contrary with the employer, employee was free to file for a patent in their own name using the materials that were created during their employment); Crown Die & Tool Co. v. Nye Tool & Mach. Works, 261 U.S. 24, 36–37 (1923) (deciding the validity of a patent assignment); Woodbridge v. United States, 263 U.S. 50, 55 (1923) ("The purpose of the clause of the Constitution concerning patents is in terms to promote the progress of science and the useful arts, and the plan adopted by Congress in exercise of the power has been to give one who makes a useful discovery or invention a monopoly in the making, use and vending of it for a limited number of years.").

33. *See* Pub. L. No. 82-593, 66 Stat. 792. The Patent Act was again significantly amended through the America Invents Act of 2011 ("AIA"), but those amendments did not significantly alter portions of the statute relevant to this discussion. *See* Pub. L. No. 112-29, 125 Stat. 284. Any amendments that are relevant will be noted in this Section.

"[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title"[34] and "[t]he term 'inventor' means the individual or, if a joint invention, the individuals collectively who invented or discovered the subject matter of the invention."[35] The statute goes on to clarify that "[a] person shall be entitled to a patent unless . . ."[36] when setting the requirements for patentability and that "[a]n application for patent shall be made, or authorized to be made, by the inventor . . ."[37] when addressing application requirements. Like the previous version of the statute, the modern version addresses oaths and declarations by requiring that "each individual who is the inventor or a joint inventor of a claimed invention in an application for patent shall execute an oath or declaration in connection with the application."[38]

With respect to assignments, the 1952 Act permits application directly by the assignee,[39] but again, even this portion of the statute

34. 35 U.S.C. § 101.

35. *Id.* at § 100(f).

36. *Id.* at § 102(a). Section 102 was significantly rewritten under the AIA, but the quoted language was not changed. *See* Pub. L. No. 112-29, sec. 3(b)(1), § 102, 125 Stat. 284, 285–87.

37. 35 U.S.C. § 111(a)(1).

38. *Id.* § 115(a). Note that this section was modified by the America Invents Act, but not in a substantive way that impacts the arguments here. The 1952 Act simply states: "The applicant shall make oath that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition of matter, or improvement thereof, for which he solicits a patent; and shall state of what country he is a citizen." Pub. L. No. 82-593, § 115, 66 Stat. 792, 799. The post-AIA version also addresses some practical problems that can arise when requiring inventors' oaths, such as uncooperative or missing inventors. *See* 35 U.S.C. §§ 115(d)(2), 116(b) ("A substitute statement under paragraph (1) is permitted with respect to any individual who . . . (B) is under an obligation to assign the invention but has refused to make the oath or declaration," and "If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor.").

39. *See* 35 U.S.C. § 118 ("A person to whom the inventor has assigned or is under an obligation to assign the invention may make an application for patent. A person who otherwise shows sufficient proprietary interest in the matter may make an application for patent on behalf of and as agent for the inventor on proof of the pertinent facts and a showing that such action is appropriate to preserve the rights of the parties. If the Director grants a patent on an application filed under this section by a person other than the inventor, the patent shall be granted to the real party in interest and upon such notice to the inventor as the Director considers to be sufficient."). This section was a significant rewrite of the 1952 Act provision, which stated: "Whenever an inventor refuses to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom the inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent

contemplates some type of transfer from the inventor in whom ownership rights would initially vest.[40] Case law in the modern era supports this view of patent ownership.[41] Thus, similar to earlier versions of the Patent Act, the modern Act dictates that the initial ownership vests with the inventor and some assignment meeting the statutory requirements is required to transfer that ownership to someone, or something, else. The consequence of this is that to establish ownership of a patent, the purported owner either needs to be the named inventor or produce a chain of title to the original inventor.[42]

---

on behalf of and as agent for the inventor on proof of the pertinent facts and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage; and the Commissioner may grant a patent to such inventor upon such notice to him as the Commissioner deems sufficient, and on compliance with such regulations as he prescribes." Patent Act of 1952, Pub. L. No. 82-593, § 118, 66 Stat. 792, 799–800. However, the differences between the two versions are not relevant to the discussion here.

40. *See* 35 U.S.C. § 152 ("Patents may be granted to the assignee of the inventor of record in the Patent and Trademark Office, upon the application made and the specification sworn to by the inventor, except as otherwise provided in this title."); *see also* Patent Act of 1952, Pub. L. No. 82-593, § 261 ("Applications for patent, patents, or any interest therein, shall be assignable in law by an instrument in writing. The applicant, patentee, or his assigns or legal representatives may in like manner grant and convey an exclusive right under his application for patent, or patents, to the whole or any specified part of the United States."). In my view, this provision does not undercut the legal connection between inventor and owner because it addresses the narrow situation in which an inventor is for some reason unable/unwilling to file the patent application.

41. *See, e.g.*, Teets v. Chromalloy Gas Turbine Corp., 83 F.3d 403, 407 (Fed. Cir. 1996) ("Ownership springs from invention. The patent laws reward individuals for contributing to the progress of science and the useful arts. *See* U.S. CONST. art. I, § 8. As part of that reward, an invention presumptively belongs to its creator." (citing Beech Aircraft Corp. v. EDO Corp., 990 F.2d 1237, 1248 (Fed. Cir. 1993))); Arachnid, Inc. v. Merit Indus., Inc., 939 F.2d 1574, 1578 (Fed. Cir. 1991) ("At the outset, we note that although the act of invention itself vests an inventor with a common law or 'natural' right to make, use and sell his or her invention absent conflicting patent rights in others (and in certain circumstances, may similarly vest such rights in an employer of the inventor), a patent on that invention is something more. A patent in effect enlarges the natural right, adding to it the right to exclude others from making, using or selling the patented invention." (citing Six Wheel Corp. v. Sterling Motor Truck Co., 50 F.2d 568, 571 (9th Cir. 1931))).

42. *See, e.g.*, Abraxis Bioscience, Inc. v. Navinta LLC, 625 F.3d 1359, 1360–61 (Fed. Cir. 2010) (defective assignment agreement breaks the chain to title between original inventor and subsequent assignee); Mayfair Wireless LLC v. Celico P'ship, No. 11-772, 2013 U.S. Dist. LEXIS 124206, at *15–35 (D. Del. Aug. 30, 2013), report and recommendation adopted, No. 11-772, 2014 U.S. Dist. LEXIS 75237, at *1–2 (D. Del. June 3, 2014), *aff'd sub nom.*, Mayfair Wireless LLC v. Cellco P'ship, 595 F. App'x 997, 997 (Fed. Cir. 2015) (analyzing multiple alleged gaps in the chain of title to ensure patent plaintiff has standing to sue for infringement); Sky Techs. LLC v. SAP AG, 576 F.3d 1374, 1380 (Fed. Cir. 2009) (holding

Despite the statutory requirement that ownership initially vests in inventors, most modern inventions are owned by the inventors' employers instead.[43] This shift from presumptive inventor ownership to recognition of ubiquitous assignee ownership corresponds with the change in the way research and development occurred and in the way the employee/employer relationship was viewed in the context of invention.[44] Throughout the nineteenth century, inventors were presumed to be the owners of their inventions even if the inventions were made as part of their employment, subject to some minor caveats.[45] Those caveats came in the form of Shop Rights and the Hired-to-Invent doctrine.[46] However, in the early twentieth century, courts increasingly embraced the notion that employers would own inventions that were created by their employees within the scope of their employment, relying upon explicit contracts to that effect when they were available and quasi-contract when they were not.[47]

In the modern workplace, the ability of inventors to own their inventions made in the workplace is largely overridden by contract law.[48] Even in states where the issue of employee inventions have been addressed through legislation, these statutes recognize ownership of employee inventions unless the invention was made on the employee's own time and/or with their own resources.[49] Accordingly, assignee ownership is typical in workplace situations, but it does require a valid assignment agreement. Even this system, however, recognizes that ownership initially vests in the inventor, although possibly for a

---

that transfer by operation of law was sufficient to maintain chain of title and provide standing for infringement plaintiff).

43. *See* Robert P. Merges, *One Hundred Years of Solicitude: Intellectual Property Law, 1900-2000*, 88 CALIF. L. REV. 2187, 2215–16 (2000) ("In 1885, only 12 percent of patents were issued to corporations. Slightly more than one hundred years later, the proportions had completely reversed: by 1998, only 12.5 percent of patents were issued to independent inventors.").

44. *See id.* at 2216; Catherine L. Fisk, *Removing the 'Fuel of Interest' from the 'Fire of Genius': Law and the Employee Inventor, 1830-1930*, 65 U. CHI. L. REV. 1127, 1130–31 (1998).

45. *See generally* Catherine L. Fisk, *Working Knowledge: Trade Secrets, Restrictive Covenants in Employment, and the Rise of Corporate Intellectual Property, 1800-1920*, 52 HASTINGS L.J. 441 (2001) (detailing the relationship between employers and employee with respect to employee inventions during the 1800s).

46. *See* Fisk, *supra* note 44, at 1151–80 (detailing the development of shop rights and hired-to-invent treatment of employee inventions).

47. *See id.* at 1131–33.

48. *See* Merges *supra* note 43, at 2217–18 (discussing the shift toward corporate ownership of employee inventions facilitated through contracts).

49. *See, e.g.*, N.Y. LAB. LAW § 203-f (McKinney 2025); CAL. LAB. CODE § 2870 (West 2025).

metaphysically short period of time.[50] This means that, within the patent system, there is, and always has been, a connection between creatorship and ownership, even if the benefit of this connection to inventors is commonly overridden through contract.

II. AUTHORS & OWNERS UNDER COPYRIGHT LAW

Similar to the patent system, the U.S. copyright system has also maintained a close connection between creatorship (authorship) and ownership since its beginning.[51] As mentioned above, the Constitution states that, "The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."[52] This language suggests that any protection Congress chooses to create for "writings" would accrue to the "authors."

The Copyright Act of 1790 was Congress's first codification of the constitutional provision.[53] The 1790 Act stated:

> [T]he author and authors of any map, chart, book or books already printed within these United States . . . his or their executors, administrators or assigns . . . shall have the sole right and liberty of printing, reprinting, publishing and vending such map, chart, book or books, for the term of fourteen years from the recording the title thereof in the clerk's office.[54]

This language seems to contemplate that copyright rights could be granted to "assigns," but similar to the patent situation discussed above, there do not appear to be any cases in which the copyright was granted to an assign without recognizing the initial ownership in the

50. This is evidenced by the fact that, were a pre-filing assignment agreement to be found to be defective and the assignment voided, the patent ownership would revert back to the inventor, rather than just disappearing into the ether. *See, e.g.*, Bd. of Trs. of Leland Stanford Junior Univ. v. Roche Molecular Sys., Inc., 563 U.S. 776, 793 (2011) (defective assignment agreement left patent rights with inventors and so subsequent effective assignment to different assignee was valid).

51. For purposes of this discussion, the "creator" for copyright purposes will be considered to be the same as the "author" under existing copyright law. It is worth mentioning that the historical roots of copyright law prior to the U.S. Constitution demonstrate a focus on protecting publishers, not authors. *See* L. Ray Patterson, *Copyright and "the Exclusive Right" of Authors*, 1 J. INTELL. PROP. L. 1, 9–14 (1993).

52. U.S. CONST. art. I, § 8, cl. 8.

53. *See* Copyright Act of 1790, ch. 15, 1 Stat. 124.

54. *Id.* at § 1.

author.[55] Accordingly, the initial Copyright Act recognized the connection between ownership and authorship.[56]

The first major revision came in the form of the Copyright Act of 1909. However, the changes in the 1909 Act did not have any significant impact on the provisions of the statute related to authorship or ownership. Throughout this time, it remained well-established that ownership initially vests with the author, even in employment situations.[57]

In 1976, there was a major overhaul of the Copyright Act.[58] The relevant provisions to authorship and ownership in the 1976 Act remain essentially unchanged today. Unlike the Patent Act, as of the 1976 revisions, the Copyright Act now includes specific statutory

55. This assertion is based on a fairly exhaustive review of published cases in the 1800s, but I do have to acknowledge the possibility that a case could exist, of which I am not aware.

56. *See, e.g.*, Little v. Gould, 15 F. Cas. 612, 612 (C.C.N.D.N.Y. 1852) (No. 8,395) ("The act of congress passed February 3, 1831 (4 Stat. 436), confers the proprietorship of a book upon any citizen of the United States, or resident therein, who shall be its author, and who shall have complied with the requisites of the act, and upon the executors, administrators or legal assigns of such person. This act was passed in pursuance of the eighth clause of the eighth section of the first article of the constitution of the United States, which declares that congress shall have power 'to promote the progress of science and useful arts, by securing, for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries.'"); Paige v. Banks, 80 U.S. 608, 614 (1871) ("Independent of any statutory provision the right of an author in and to his unpublished manuscripts is full and complete. It is his property, and, like any other property, is subject to his disposal. He may assign a qualified interest in it, or make an absolute conveyance of the whole interest."); Boucicault v. Hart, 3 F. Cas. 983, 984 (C.C.S.D.N.Y. 1875) (No. 1,692) ("The constitution, in section eight, article one, gives to congress power 'to promote the progress of science and useful arts, by securing, for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries.' The first act of congress upon this subject was passed May 31st, 1790. 1 Stat. 124. The first section of that act secured to the author the sole right of printing, publishing, and vending his map, chart, or book, for the term of fourteen years 'from the recording the title thereof in the clerk's office, as is hereinafter directed.'").

57. *See* Jon Clark, *Copyright Law and Work for Hire: A Critical History*, 40 COPYRIGHT L. SYMP. 129, 134 (1990–1991) ("In *Dewitt v. Brooks* it was held that '[a] person who hires another to write a book, and gives him the description and scope of the work, is not the author. The literary man who writes the book and prepares it for publication is the author, and the copyright is intended to protect him, and not the person who employed him.' And, in *Boncicault v. Fox* it was held that '[a] man's intellectual productions are peculiarly his own, and although they may have been brought forth by the author while in the general employment of another, yet he will not be deemed to have parted with his right and transferred it to his employer, unless a valid agreement to that effect is adduced.'" (footnotes omitted)).

58. *See* Pub. L. No. 94-553, 90 Stat. 2541.

provisions addressing initial ownership and transfers.[59] In particular, the Copyright Act states "Copyright in a work protected under this title vests initially in the author or authors of the work" and "[t]he ownership of a copyright may be transferred in whole or in part by any means of conveyance or by operation of law, and may be bequeathed by will or pass as personal property by the applicable laws of intestate succession."[60] Accordingly, this statute makes clear that ownership initially vests in the author, even if there is an existing assignment. Of course, if there is an existing assignment, the initial ownership is metaphysically short but does exist (by statute).[61]

The key piece of the 1976 Act addressing ownership by authors in the modern workplace is the Works Made for Hire ("WMFH") provision.[62] Specifically, the statute provides that "[i]n the case of a work made for hire, the employer or other person for whom the work was prepared is considered the author for purposes of this title."[63] Works Made for Hire are defined to include "a work prepared by an employee within the scope of his or her employment."[64] The significant conceptual aspect of these provisions is that they do not simply recognize ownership divorced from creatorship in the way the Patent Act does. Instead, they establish the employer as the author for purposes of copyright law. However, even in the face of this explicit recognition of employer ownership, modern companies are encouraged to obtain assignment agreements from employees anyway, rather than relying on the WMFH provision.[65]

---

59. *See* 17 U.S.C. § 201.

60. *Id.* at § 201(a), (d)(1).

61. It is also worth mentioning that, even when there is a valid assignment, the author has the right to terminate that assignment after thirty-five years. *See* 17 U.S.C. § 203. Again, this emphasizes the strong legal connection between authors and owners even if, practically speaking, very few assignment terminations are actually done.

62. *See* 17 U.S.C. § 201(b). The idea that an employer would own the creative works of their employees was not new, however. *See generally* Clark, *supra* note 57.

63. 17 U.S.C. § 201(b).

64. *Id.* at § 101.

65. *See, e.g.*, *Common Misconceptions about the "Work For Hire" Doctrine*, OUTSIDE GEN. COUNS. (Dec. 8, 2021), https://www.outsidegc.com/blog/common-misconceptions-about-the-work-for-hire-doctrine (on file with the Syracuse Law Review); Tristain Kaisharis, *IP Assignment Agreements: Protecting Your Company Today and Saving Yourself from Headaches Tomorrow*, JD SUPRA (July 19, 2024), https://www.jdsupra.com/legalnews/ip-assignment-agreements-protecting-2685857/ (on file with the Syracuse Law Review). *See also* Tom Kulik, *When You Don't Get What You Pay For: The 3 Biggest Misconceptions About Ownership of 'Work(s)-Made-For-Hire'*, ABOVE THE LAW (Aug. 21, 2017, 17:03 ET), https://abovethelaw.com/2017/08/when-you-dont-get-what-you-pay-for-the-3-

Even taking account of the WMFH doctrine, copyright law requires an author and the author is the original owner of the rights.[66] Similar to patents, a copyright owner wishing to sue for copyright infringement will need to show a chain of title to an author (whether that be an individual or an employer via WMFH).[67] Accordingly, the close connection between the creator and the owner is maintained in copyright law in a manner similar to patent law.

III. CREATORS & OWNERS UNDER TRADE SECRETS LAW

Unlike the other areas of intellectual property law discussed above, trade secrets law has developed largely through common law cases. Trade secrets law in the United States came from England, with the first U.S. case being in 1837.[68] The Uniform Trade Secrets Act ("UTSA"), which is the wellspring for most state trade secrets law, was not promulgated until 1979.[69] It took several decades for some states to adopt the UTSA, and it was not until 2016 that the DTSA was enacted at the federal level.[70] Accordingly, most of the development

biggest-misconceptions-about-ownership-of-works-made-for-hire/ (on file with the Syracuse Law Review). In this author's view, the use of employment copyright assignment agreements is likely just a belt-and-suspenders approach that potentially avoids litigation over the nuanced aspects of the WMFH provision and that does not add any significant administrative burden when employees are going to be expected to sign invention assignment and confidentiality agreements at the time of hire. For an example of the challenges that one might face in enforcing WMFH ownership of a copyrighted work, see Cmty. for Creative Non-Violence v. Reid, 490 U.S. 730, 737–53 (1989).

66. One might posit that the inclusion of the WMFH doctrine in the Copyright Act breaks the connection between creatorship and ownership. However, my view is that, because the WMFH provision relies on an employment relationship, including components of direction and control, the employer-author is at least analogous to the individual author-creator, as I have defined them. *See Reid*, 490 U.S. at 751.

67. *See, e.g.*, Peer Int'l Corp. v. Latin Am. Music Corp., 161 F. Supp. 2d 38, 45 (D.P.R. 2001) (discussing evidentiary import of registration certificate with respect to chain of title); Motta v. Samuel Weiser, Inc., 768 F.2d 481, 484 (1st Cir. 1985) ("If a plaintiff is not the author of the copyrighted work then he or she must establish a proprietary right through the chain of title in order to support a valid claim to the copyright. Absent this showing, a plaintiff does not have standing to bring an action under the Copyright Act." (citing Bell v. Combined Registry Co., 397 F. Supp. 1241, 1245 (N.D. Ill. 1975))).

68. *See* Vickery v. Welch, 36 Mass. (19 Pick.) 523 (1837).

69. *See* Ramon A. Klitzke, *The Uniform Trade Secrets Act*, 64 MARQ. L. REV. 277, 277 (1980). A significant revision of the UTSA was promulgated in 1985. *See also* James C. Lydon, *The Deterrent Effect of the Uniform Trade Secrets Act*, 69 J. PAT. & TRADEMARK OFF. SOC'Y 427, 427–28 (1987).

70. The primary result of the Defend Trade Secrets Act was to add the availability of civil proceedings to the pre-existing Economic Espionage Act, which is codified at 18 U.S.C. §§ 1831–1839.

relevant to creatorship and ownership happened through case law. This development is discussed in Section A. The impact of the UTSA and DTSA on the issue of creatorship and ownership is explored in Section B below.[71]

A. The Historical Connection Between Creation & Ownership Under Common Law

In early trade secrets cases, the trade secrets owner was the creator of the secret information.[72] It is worth noting, however, that these early courts did not address the issue of creatorship in terms of being necessary to establish trade secrets rights and instead typically just mentioned it in passing.[73] The one class of cases in which creatorship did begin to matter, though, was with respect to employee-created secrets.[74] However, this recognition of the importance of creatorship in trade secret information did not last long into the twentieth century.[75]

A major milestone in the common law development of trade secrets law was the promulgation of the Restatement (First) of Torts

71. For purposes of this discussion, the "creator" of a trade secret will be considered to be the person or persons who either generated the associated information (through mental effort) or who compiled the information. This is not the only possible conception of creatorship of a trade secret, however. For example, the person or entity that first meets the three requirements for protection of particular information, could be viewed as the "creator" of the trade secret, but that would simply collapse the two concepts of creatorship and ownership into one. Consequently, that would not be a productive approach for the issues discussed in this Article.

72. *See, e.g.*, *Vickery*, 36 Mass. (19 Pick.) at 524 (1837) (dispute over secret recipe for chocolate and owners' obligation to assign "what I have gained by my skill and experience" in connection with a sale of the associated business); Peabody v. Norfolk, 98 Mass. 452, 452 (1868) (dispute over secret manufacturing process with the plaintiff "having built a mill and furnished it with machinery secretly invented by himself for making gunny cloth by a secret process also of his invention"); Cincinnati Bell Foundry Co. v. Dodds, 10 Ohio Dec. Reprint 154, 154–55 (Super. Ct. 1887) ("[H]e who discovers and keeps secret a process of manufacture, whether a proper subject for a patent or not, has a property in it which a court of equity will protect against one who in violation of contract and breach of confidence undertakes to apply it to his own use, or to disclose it to third persons . . . . [I]t is settled that such a secret is a legal subject of property and that a bond to convey it may be legally enforced, thus fully recognizing that the inventor of a secret process may sell or assign it to another.").

73. *See, e.g.*, *Vickery*, 36 Mass. (19 Pick.) at 525–26; *Peabody*, 98 Mass. at 452; *Dodds*, 10 Ohio Dec. Reprint at 154–55. In this regard, *see also* O. & W. Thum Co. v. Tloczynski, 72 N.W. 140, 140–41 (Mich. 1897) (discussing the measures the trade secrets owner used to protect the secret, but not discussing who created the secret).

74. *See* Fisk, *supra* note 45, at 483–523 (detailing early recognition of employee rights in their creations and the subsequent shift to employer-ownership of such creations).

75. *See id.* at 493–523.

("First Restatement"), which had three sections devoted to the issue of protecting secret information.[76] To the extent the issue of who created the trade secret at issue had any relevance in the early common law development, the First Restatement did not incorporate that relevance. Instead, the First Restatement focused on the conduct of the alleged mis-appropriator, rather than the creation of the information.[77] In defining a trade secret, the First Restatement did open the possibility that creatorship could be relevant by considering "the amount of effort or money expended by [the plaintiff] in developing the information," but this is only one of six "factors to be considered in determining whether given information is one's trade secret."[78] As courts primarily relied upon the First Restatement factors for determining whether information constituted a trade secret through the 1940s, 50s, 60s, and 70s, they did not discuss the issue of creatorship outside of a smattering of cases arising in the employment context.[79]

Despite that early common law cases were brought by the actual creators of the trade secret information, the common law never

76. *See* RESTATEMENT (FIRST) OF TORTS §§ 757–759 (A.L.I. 1939).

77. *See id.* at § 757 (stating the circumstance under which a person would be liable for unauthorized disclosure of another's information). Comment a to the First Restatement makes passing reference to the "originator" of the trade secret when comparing trade secrets protection to patents, copyrights and trademarks, but this reference is best understood as designating the person from whom the trade secret was acquired, rather than the person who created it. *See id.* at cmt. a.

78. *Id.* at cmt. b.

79. *See, e.g.*, *Trade Secrets – Trade Secret Developed by Employee in the Course of Authorized Research May Be Used in Competing With Former Employer. – Wexler v. Greenberg (Pa. 1960)*, 74 HARV. L. REV. 1473, 1475 (1961) (reviewing a particular trade secrets case decision and hypothesizing that the court may have based its decision on concerns that an injunction would prevent the employee from gaining further employment using his general skills); Frederic B. Schramm, *Bases for Protection of Intellectual Property other than Patents, Trademarks and Copyrights*, 44 J. PAT. OFF. SOC'Y 75, 85 (1962) ("[W]here the employee is under no contract of secrecy, there is no bar to his use of knowledge and experience gained by him during employment."); Douglas S. Liebhafsky, *Industrial Secrets and the Skilled Employee*, 38 N.Y.U. L. REV. 324, 334–47 (1963) (reviewing employee trade secret cases where liability depended on whether the employee developed the purported trade secrets); Andrew J. Kopko, *Protection of Trade Secrets in the Employer-Employee Relationship*, 39 NOTRE DAME L. REV. 200, 201–02 (1964) (discussing protectable trade secrets against employee general knowledge). It is important to note in these cases that the courts did not use the issue of creatorship to resolve competing claims to trade secrets ownership. Instead, the courts simply found that the employer did not have a protectable trade secret with respect to the employee that was alleged to have misappropriated it. These courts did not go on to hold that the employee owned the trade secret and instead, often found that the information constituted the employees' general skills or knowledge that was not protectable as a trade secret at all.

developed a robust doctrine tying trade secret rights to creation of the associated information. The one, but quite limited, exception was in the context of employee-created inventions, but even these cases did not resolve competing claims for trade secrets ownership and instead resolved whether a former employee would be liable for reusing information that they had created at their previous employment. Accordingly, there was no robust doctrine of creation leading to trade secret ownership or rights during the common law period of trade secrets development. Instead, the more consistent argument would be that ownership flowed from possession of the information itself, not its creation.

B. Creation & Ownership in the Statutory Period

Among widespread calls for more uniformity in trade secrets law, the Uniform Law Commission promulgated the Uniform Trade Secrets Act ("UTSA") in 1979.[80] Several aspects of the common law existing at the time were not incorporated into the UTSA.[81] However, the UTSA does carry forward the absence of a requirement connecting creatorship and ownership.[82] The closest the UTSA comes to recognizing any party in interest in a trade secrets case is in the definition of misappropriation where it references trade secrets "of another."[83] The foil for the "of another" plaintiff in the UTSA is simply a

80. *See generally* Sharon K. Sandeen, *The Evolution of Trade Secret Law and Why Courts Commit Error When They Do Not Follow the Uniform Trade Secrets Act*, 33 HAMLINE L. REV. 493 (2010) (detailing the development history of the UTSA).

81. Some examples include the traditional exclusion of general knowledge, skills, and experience, *see generally* Camilla A. Hrdy, *The General Knowledge, Skill, and Experience Paradox*, 60 B.C. L. REV. 2409 (2019), the special treatment of employee remembered information, *see generally* Timothy E. Murphy, *Memorizing Trade Secrets*, 57 U. RICH. L. REV. 533 (2023), and the traditional multi-factor definition of trade secrets, *see generally* Sandeen, *supra* note 80.

82. The UTSA defines trade secret broadly, but the definition does not make any reference to a creator or owner. *See* UNIF. TR. SECRETS ACT § 1(4) (UNIF. L. COMM'N 1979) ("'Trade secret' means information, including a formula, pattern, compilation, program, device, method, technique, or process, that: (i) derives independent economic value, actual or potential, from not being generally known to, and not being readily ascertainable by proper means by, other persons who can obtain economic value from its disclosure or use, and (ii) is the subject of efforts that are reasonable under the circumstances to maintain its secrecy.").

83. *See id*. at § 1(2) ("'Misappropriation' means: (i) acquisition of a trade secret *of another* by a person who knows or has reason to know that the trade secret was acquired by improper means; or (ii) disclosure or use of a trade secret *of another* without express or implied consent by a person who…"). (emphasis added)).

"person."[84] Accordingly, the UTSA only speaks of the relevant parties at the most general level, with the potential plaintiff simply understood most reasonably as an owner and the defendant being just about any entity that is capable of being sued. For purposes of this discussion, the important part to recognize is that the UTSA does not contemplate a creator at all, much less one that is linked in some way to the party alleging misappropriation.[85]

The Defend Trade Secrets Act ("DTSA") was enacted in 2016 and essentially federalized trade secrets law (but not in a preemptory way).[86] Despite that the DTSA largely copies the UTSA, there is a notable difference with respect to ownership. The DTSA states that "[a]n owner of a trade secret that is misappropriated may bring a civil action."[87] Thus, the DTSA requires specifically that an "owner" is the party that can allege misappropriation, while the UTSA did not specify

84. *See id*. at § 1(3) ("'Person' means a natural person, corporation, business trust, estate, trust, partnership, association, joint venture, government, governmental subdivision or agency, or any other legal or commercial entity.").

85. *See* Charles T. Graves, *Curiosities of Standing in Trade Secret Law*, 20 NW. J. TECH. & INTELL. PROP 159, 159 (2023) ("Instead of requiring ownership or license rights as a condition to sue, courts often find that mere possession of an asserted trade secret suffices for standing, even when the provenance of the information is murky."); Highland Consulting Grp., Inc. v. Soule, 74 F.4th 1352, 1358 (11th Cir. 2023) (holding that internal marking of documents with the company name was sufficient for a jury to find that the trade secrets therein were owned by the company). *See also* Dennis Crouch, *Legal Fictions and the Corporation as an Inventive Artificial Intelligence*, *in* RESEARCH HANDBOOK ON INTELLECTUAL PROPERTY AND ARTIFICIAL INTELLIGENCE 356, 363–64 (Ryan Abbott, ed., 2022) (discussing corporate ownership of employee-created trade secrets without the requirement of a creator).

86. *See* Patrick J. Manion, *Two Steps Forward, One Step Back: The Defend Trade Secrets Act of 2016 and Why the Computer Fraud and Abuse Act of 1984 Still Matters for Trade Secret Misappropriation*, 43 J. LEGIS. 289, 300–01 (2016) (discussing the goals and structure of the DTSA); Brittany S. Bruns, *Criticism of the Defend Trade Secrets Act of 2016: Failure to Preempt*, 32 BERKELEY TECH. L. J. 469, 480–91 (2018) (discussing same); Kaylee Beauchamp, *The Failures of Federalizing Trade Secrets: Why the Defend Trade Secrets Act of 2016 Should Preempt State Law*, 86 MISS. L.J. 1031, 1067–69 (2017) (discussing the impact of the lack of preemption of state law in the DTSA).

87. 18 U.S.C. § 1836. *See also id.* at § 1839(4) ("[T]he term 'owner', with respect to a trade secret, means the person or entity in whom or in which rightful legal or equitable title to, or license in, the trade secret is reposed."); *id.* § 1839(3) ("[T]he term 'trade secret' means all forms and types of financial, business, scientific, technical, economic, or engineering information . . . if—(A) the owner thereof has taken reasonable measures to keep such information secret; and (B) the information derives independent economic value, actual or potential, from not being generally known to, and not being readily ascertainable through proper means by, another person who can obtain economic value from the disclosure or use of the information." (emphasis added)).

this requirement.[88] Nevertheless, in applying the DTSA courts have largely equated ownership with possession, rather than requiring some chain of title to the creator of the trade secret information.[89]

Because ownership is not connected to creatorship under statutory trade secrets law, mere possession in such a way that the three requirements are met is sufficient to bring suit for misappropriation (assuming the requirements for a misappropriation have been met). As an example, one who finds a trade secret in a document lying on the sidewalk is just as capable (legally) of bringing a misappropriation claim as one who spends years in researching and developing the idea, assuming the three requirements are met in each case. Further evidence of this disconnect is the widespread use of exceedingly broad employee non-disclosure agreements that attribute ownership of employee-created information without any need for disclosure to the

88. There is a bit of ambiguity happening with the definitions in the DTSA. The definition of "owner" specifies that the owner is anyone that holds legal or equitable title to the trade secret, but the trade secret definition requires that information can only be a trade secret if the owner meets three requirements (secrecy, reasonable efforts and economic value). *See* 18 U.S.C. § 1839(3)–(4). Thus, the requirement of legal or equitable title does not really have any meaning because the only one that can own the trade secret is the one that meets the three requirements with respect to the particular information. It is also worth noting that at least some states do not require "ownership" of a trade secret to bring a misappropriation claim and that "possession" is sufficient. *See, e.g.*, Advanced Fluid Sys., Inc. v. Huber, 958 F.3d 168, 177 (3d Cir. 2020) ("[W]e, like the District Court, agree with the Fourth Circuit's cogent explanation of why lawful possession of a trade secret can, under circumstances like this, be sufficient to maintain a misappropriation claim, even absent ownership."); Gaedeke Holdings VII LTD v. Baker, 683 F. App'x 677, 683 (10th Cir. 2017) ("Like many other states, Oklahoma has adopted the Uniform Trade Secrets Act. Nothing in Oklahoma's Act defines ownership of the trade secret as an element of a claim for misappropriation of trade secrets. And no court reviewing Oklahoma law has included ownership as an element of a claim for misappropriation of trade secrets." (citing OKLA. STAT. tit. 78, §§ 85, 88(A) (2025))).

89. *See, e.g.*, Beluca Ventures LLC v. Einride Aktiebolag, 660 F. Supp. 3d 898, 907 (N.D. Cal. 2023) ("'To prove ownership of a trade secret, plaintiffs must identify the trade secrets and carry the burden of showing they exist.' Although a plaintiff 'need not "spell out the details of the trade secret,"' a plaintiff 'should describe the subject matter of the trade secret with *sufficient particularity* to separate it from matters of general knowledge in the trade or of special knowledge of those persons . . . skilled in the trade.'" (first quoting Inteliclear, LLC v. ETC Global Holdings, Inc., 978 F.3d 653, 658 (9th Cir. 2020); then quoting Autodesk, Inc. v. ZWCAD Software Co., No. 14-cv-01409, 2015 U.S. Dist. LEXIS 63610, at *13 (N.D. Cal. May 13, 2015); and then quoting *Inteliclear LLC*, 978 F.3d at 658)); Credit Sage LLC v. Credit Wellness LLC, No. 23-CV-110, 2024 U.S. Dist. LEXIS 6124, at *22–23 (D. Wyo. Jan. 9, 2024) (allegations that particular information was "proprietary" and subject to limited access were sufficient to survive motion to dismiss on ownership issue under DTSA).

employer or even a record of the creative history of the particular secret.[90] Additionally, because the system is disconnected, the existence of a trade secret may not even be determinable until a misappropriation claim is brought. At this point, the important timing is simply that the three requirements for a valid trade secret are met at the time of the alleged misappropriation, not the timing of the creation of the trade secret.[91]

Under modern statutory trade secrets law, ownership is closely aligned with possession and the requirements for information to be a trade secret, rather than with any notion of creatorship. Accordingly, trade secrets law as it exists today does not have any legal connection between ownership and creatorship.

IV. CREATORS & OWNERS UNDER TRADEMARK LAW

In many ways, the creatorship situation with trademarks is not significantly different than it is with trade secrets.[92] For essentially all of the time that trademarks have been recognized as a legally protectable interest in the U.S., courts have recognized that trademark rights arise through use, not through creation.[93] The current version of the

90. *See generally* Camilla A. Hrdy & Christopher B. Seaman, *Beyond Trade Secrecy: Confidentiality Agreements that Act Like Noncompetes*, 133 YALE L.J. 669 (2024) (discussing broad employee confidentiality agreements that act effectively as non-compete agreements). For a discussion of the different approaches employers take to employee NDAs versus business-to-business NDAs, *see* Timothy Murphy, *Can't Get It out of My Head: Trade Secrets Liability for Remembered Information*, 2023 WIS. L. REV. 1929, 1976–83 (2023).

91. *See* John Villasenor, *Artificial Intelligence, Trade Secrets, and the Challenge of Transparency*, 25 N.C. J.L. & TECH. 495, 508–10 (2024) (discussing the timing element of trade secrets existence within the context of artificial intelligence information).

92. For purposes of this discussion, the creator of a trademark will be considered to be the person or persons who originated the word, design, or other symbol that ultimately becomes the protected trademark. In other words, the person(s) who did the intellectual labor to create the word, design, or symbol is considered the creator. Similar to the trade secret situation discussed previously in footnote 71, other conceptions of trademark creatorship are possible but are beyond the scope of this Article. In particular, some might take issue with the idea that a trademark is created before there is use in commerce, which is a valid point, but it ignores the intellectual labor aspect of this particular form of intellectual property.

93. *See, e.g.*, Canal Co. v. Clark, 80 U.S. (13 Wall.) 311, 322 (1871) ("Undoubtedly words or devices may be adopted as trademarks which are not original inventions of him who adopts them, and courts of equity will protect him against any fraudulent appropriation or imitation of them by others."); McLean v. Fleming, 96 U.S. 245, 252 (1877) ("In such cases, the question is not whether the complainant was the original inventor or proprietor of the article made by him, and on which he puts his trade-mark, nor whether the article made and sold under his trade-mark by the respondent is equal to his own in value or quality, but the court proceeds on the

ground that the complainant has a valuable interest in the good-will of his trade or business, and, having adopted a particular label, sign, or trade-mark, indicating to his customers that the article bearing it is made or sold by him or by his authority, or that he carries on business at a particular place, he is entitled to protection against one who attempts to deprive him of his trade or customers by using such labels, signs, or trade-mark without his knowledge or consent." (citing Coats v. Holbrook, 2 Sand. Ch. 586, 594–98 (N.Y. Ch. 1845))); Trade-Mark Cases, 100 U.S. 82, 94 (1879) ("The trade-mark may be, and generally is, the adoption of something already in existence as the distinctive symbol of the party using it. At common law the exclusive right to it grows out of its use, and not its mere adoption."); MacMahan Pharmacal Co. v. Denver Chem. Mfg. Co., 113 F. 468, 471–72 (1901) ("The right to a trade-mark at common law, independent of the registration statute, is not created by invention or priority of adoption alone. A word, symbol, or device, to be a valid trade-mark constituting a right of property, must have been used by the owner in connection with the sale of his goods for such length of time, and under such circumstances, as indicates to the trade that the goods in connection with which it appears are his goods, as distinguished from those of other manufacturers or dealers. The mere adoption of such word, symbol, or device, unaccompanied by such a use, is not sufficient to create an exclusive right thereto."); United Drug Co. v. Theodore Rectanus Co., 248 U.S. 90, 97–98 (1918) ("[T]he right to a particular mark grows out of its use, not its mere adoption; its function is simply to designate the goods as the product of a particular trader and to protect his good will against the sale of another's product as his; and it is not the subject of property except in connection with an existing business. The owner of a trade-mark may not, like the proprietor of a patented invention, make a negative and merely prohibitive use of it as a monopoly." (citing Hanover Star Milling Co. v. Metcalf, 240 U.S. 403, 412–14 (1916))); *In re* Wella A.G., 787 F.2d 1549, 1554 (Fed. Cir. 1986) (Nies, J., concurring) ("[T]he one entity which *controls* the nature and quality of the goods sold under the mark is the owner." (citing 1 J. THOMAS MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 18:14, at 830 (2d ed. 1984); U.S. PAT. & TRADEMARK OFF., TRADEMARK MANUAL OF EXAMINING PROCEDURE, §§ 1201.01–1201.04(b) (1983)); Duraco Prods. v. Joy Plastic Enters., 40 F.3d 1431, 1446 (3d Cir. 1994) ("Of course, it is not the purpose of unfair competition law, under the guise of either consumer protection or the protection of business good will, to implement a policy of encouraging innovative designs by protecting them once designed." (citing Melissa R. Gleiberman, Note, *From Fast Cars to Fast Food: Overbroad Protection of Product Trade Dress Under Section 43(a) of the Lanham Act*, 45 STAN. L. REV. 2037, 2056–57 (1993); Jay Dratler, Jr., *Trademark Protection for Industrial Designs*, 1988 U. ILL. L. REV. 887, 990 (1988))); Sengoku Works Ltd. v. RMC Int'l, Ltd., 96 F.3d 1217, 1219 (9th Cir. 1996) ("To acquire ownership of a trademark it is not enough to have invented the mark first or even to have registered it first; the party claiming ownership must have been the first to actually use the mark in the sale of goods or services." (citing *McCarthy 3d ed.*)); EMI Catalogue P'shp v. Hill, Holliday, Connors, Cosmopulos Inc., No. 99-7922, 2000 U.S. App. LEXIS 30761, at *16–17 (2d Cir. Sep. 15, 2000) ("The Supreme Court has stressed that there are 'fundamental differences between copyright law and trademark law.'. . . [A] trademark, by way of contrast, grows out of the adoption and use of a distinctive symbol by the party using it. Its function 'is simply to designate the goods as the product of a particular trader and to protect his good will against the sale of another's product as his.'" (first quoting Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417, 440 (1984); and then quoting *United Drug Co.*, 248 U.S. at 97)).

Lanham Act makes no reference to the concept of a creator of a trademark, and instead only addresses the "owner" of the trademark.[94] The Act then goes on to specify the information required for registration, and none of the requirements include any consideration of who created the trademark.[95]

The current disconnect with creatorship in trademark law is not necessarily fully reflective of trademark law's origin story. Just looking to the common law history,[96] early trademark law had two primary purposes: source identification and promoting fair competition.[97] Source identification was important in the pre-industrial era where individual artisans were the primary users of trademark law and the marks essentially identified an individual.[98] However, after the

94. *See* 15 U.S.C. § 1051(a)(1) ("The owner of a trademark used in commerce may request registration of its trademark on the principal register."). As relevant to the discussion here, this provision has not substantively changed since the Lanham Act's original enactment. Technically speaking, the Lanham Act is simply a registration statute that builds upon underlying state law. *See also* Vidal v. Elster, 602 U.S. 286, 291 (2024). However, even when viewed solely as establishing the requirements for registration, one would expect that creatorship would be addressed if it was necessary to establish ownership.

95. *See* 15 U.S.C. § 1051(a)(2) ("The application shall include specification of the applicant's domicile and citizenship, the date of the applicant's first use of the mark, the date of the applicant's first use of the mark in commerce, the goods in connection with which the mark is used, and a drawing of the mark."). The application does require a verification statement that the applicant believes themselves to be the owner of the mark, but again, there is no indication that creatorship is required to establish ownership. *See id.* § 1051(a)(3) ("The statement shall be verified by the applicant and specify that—(A) the person making the verification believes that he or she, or the juristic person in whose behalf he or she makes the verification, to be the owner of the mark sought to be registered.").

96. In some form, trademark law has existed for many centuries. *See* Beverly W. Pattishall, *The Constitutional Foundations of American Trademark Law*, 78 TRADEMARK REP. 456, 457–58 (1988) (discussing the origins of U.S. trademark law). However, that extended history is not particularly useful for the issues discussed in this Article.

97. *See* Gilmore Oil Co. v. Wolverine-Empire Refin. Co., 69 F.2d 532, 534 (C.C.P.A. 1934) ("We have repeatedly held that the general purpose of the law of trade-marks is to prevent one person from trading on the good will of another, and to prevent confusion, mistake, and deceit."); Am. Steel Foundries v. Robertson, 269 U.S. 372, 380 (1926) ("'The [sic] law of trade-marks is but a part of the broader law of unfair competition,' the general purpose of which is to prevent one person from passing off his goods or his business as the goods or business of another." (quoting *Hanover Star Milling Co.*, 240 U.S. at 413)).

98. *See generally* Pattishall, *supra* note 96 (discussing the origins of U.S. trademark law). It is worth mentioning, though, that the individual artisans did not need to establish creatorship of the mark to have a protectable mark. It is likely that in most cases that the artisan did in fact create the mark that they used on their wares, but that was not a requirement for protection, as commercial use was the key to protection.

industrial revolution and the rise of corporate manufacturing, trademarks lost their close connection to individual artisans, decreasing (or eradicating) any lingering connection between creatorship and ownership.[99] Even in the period before the Lanham Act, any type of connection between the creator and the owner was primarily relegated to special cases like "personal marks" that are closely tied to the identity of an individual.[100] When ownership disputes do arise in trademark law, they are not decided based upon who was the original creator of the mark. Instead, they turn on who was first to use the mark in commerce.[101]

The fact that a creator is not required to be identified in trademark law does not mean that they do not exist. Obviously, someone must have come up with the idea to use a particular word, symbol or other device in connection with the sale of particular goods or services and done the intellectual work to instantiate that idea.[102] That person may even have some rights in their creation, but unless they are the one to actually commercially use the creation, any such rights will be relegated to the province of copyright law, or perhaps some type of

99. *See* Jennifer E. Rothman, *Navigating the Identity Thicket: Trademark's Lost Theory of Personality, the Right of Publicity, and Preemption*, 135 HARV. L. REV. 1271, 1276–77 (2022) ("With the Industrial Revolution's technological advancements, particularly the rise of mass production and the ability to distribute goods far from where they were produced, marks shifted from primarily indicating particular individuals and known sources to more commonly indicating 'single, though anonymous, source[s].'" (alteration in original)).

100. *See id*. at 1317–23 (discussing the status of personal marks under modern trademark law).

101. *See Sengoku Works Ltd.*, 96 F.3d at 1219 ("It is axiomatic in trademark law that the standard test of ownership is priority of use. To acquire ownership of a trademark it is not enough to have invented the mark first or even to have registered it first; the party claiming ownership must have been the first to actually use the mark in the sale of goods or services." (citing *McCarthy 3d ed.*)). It is worth noting that the *Sengoku* court states that one factor to consider in an ownership dispute is "which party invented and first affixed the mark onto the product," *id.* at 1220, but this statement cannot be taken at face value for a couple of reasons. First, the purported source of this factor, *Wrist-Rocket Mfg. Co. v. Saunders Archery Co.*, only explicitly supports the second part of this factor (first fixation), not the first (first invention). 516 F.2d 846, 849–51 (8th Cir. 1975). Second, in its own analysis, the *Sengoku* court gives no weight to first invention and looks solely to first fixation. *See Sengoku*, 96 F.3d at 1219. Moreover, even among courts citing *Sengoku* for this proposition, I have not found any that held that first invention was sufficient to override first use.

102. The "obviousness" of this assertion may wane with time as automated and/or artificial intelligence systems take a more active role in business decision making. However, for the time being, it seems to be a safe assertion that some human is involved at the creatorship stage, even if it is just a prompt to an AI system requesting a candidate mark for use in a particular business.

publicity right.[103] Accordingly, much like trade secrets law, trademark law is a primarily disconnected system when it comes to creatorship and ownership.

V. THE SIGNIFICANCE OF THE CREATOR/OWNER DISCONNECT

At first glance, one might conclude that the disconnect between creatorship and ownership in the intellectual property system has no practical importance. However, I argue that this disconnect is important for several reasons and that it has important implications for how we think about intellectual property and its role in our society. From a theoretical justification perspective, this disconnect has significant impact on the validity of these various justifications. This issue is explored in Section A. The question of whether intellectual property regimes that disconnect creatorship from ownership can be properly characterized as IP systems is explored in Section B. Section C discusses how IP rights in disconnected systems rise and fall with the commercial context, rather than being determined by creatorship. Finally, Section D explores the extent to which the overall U.S. intellectual property system is becoming more disconnected, particularly in those areas where the historical connection was strongest.

A. The Validity of Theoretical Justifications in a Disconnected System

Over the years, several theoretical justifications have been advanced and discussed as providing valid justifications for various IP systems.[104] In the United States, incentives to innovate are often cited as the primary justification at least for the patent and copyright systems.[105] The basic principle is that, in exchange for a period of

103. *See* Rothman, *supra* note 99, at 1273–75 (discussing the intersection of trademark law and rights of publicity laws).

104. *See* Menell et al., *supra* note 2, at 22–25 (2022) (surveying various theoretical justifications for intellectual property laws).

105. *See, e.g.*, WWMAP, LLC v. Birth Your Way Midwifery, 711 F. Supp. 3d 1313, 1318 (N.D. Fla. 2024) ("American law recognizes that the protection of trade secrets results in substantial benefits to businesses and society. By protecting commercial entities from theft of their trade secrets, the law encourages individuals to invest in processes and technologies which presumably will benefit consumers . . . . Absent the protection of trade secrets, enterprises would have little or no incentive to invest more than nominal sums in knowledge or methods that could be purloined with impunity. Ultimately, consumers would suffer from a resulting reluctance to invest in trade secrets."). *See generally* WILLIAM M. LANDES & RICHARD A. POSNER, THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY LAW 294–96, 300–02 (2003); Dan L. Burk & Mark A. Lemley, *Policy Levers in Patent Law*, 89 VA. L. REV. 1575 (2003) (discussing theoretical justifications for patent law).

exclusivity, innovators will be encouraged to create new innovations and/or disclose their innovations to the public.[106] This is a primarily economic rationale that accounts for the fact that in an open competitive environment, free riders would undercut the profitability of new innovation (because they do not have to bear the creation costs, only the go-to-market costs) and so potential innovators will not invest in innovation.[107] This theory assumes that innovation is a social good and thus this theory is primarily utilitarian in nature. The applicability of this theory to the various IP systems is discussed in Section 1.

Other theories that have been advanced to justify IP rights include several theories that could be categorized as individualized theories. These are perspectives like Lockean labor theory, Hegelian personhood theory, and Kantian personal autonomy theory. Each of these theories justifies IP rights from the perspective of the creations' connection to the creator. The applicability of these theories to various IP systems is discussed in Section 2.

The final group of approaches focus on market regulation and include ideas like enforcing commercial morality, restricting unfair competition, and managing information asymmetry. As expected, these theories are most applicable to market participation and are less concerned with creatorship. These approaches are discussed in Section 3.

As presented in this Part, the justifications based on incentives to innovate and individualized theories apply best to connected systems and apply very weakly to the disconnected systems. Consequently, any significant justification for the disconnected systems must come from commerce- or market-focused theories, assuming there is a valid theoretical justification for these systems.

1. In Disconnected Systems, Traditional Justifications for IP Protection Do Not Play Their Traditional Role

Can you incentivize creation without incentivizing creators, or at least not incentivizing them directly? This Section explores the different ways in which incentives to innovate apply in connected versus disconnected systems.

---

106. This notion of public disclosure is used in its broadest sense and can include a host of activities, like bringing a product incorporating the innovation to market, submitting a patent application describing the innovation, or publishing a book, song, or other artistic work.

107. *See* LANDES & POSNER, *supra* note 105, at ch. 1 (discussing the economics of *intellectual* property).

In the patent system, why do we care about inventors? We care about inventors because our underlying theories that justify providing patent protection are focused on inventors. The common justification for having a patent system is that it creates incentives to innovate.[108] If the exclusive rights granted under the patent system did not go to the innovators, then the incentives would not have their desired effect.[109] Accordingly, the patent system grants initial ownership of inventions to the creators themselves and then the creators are free to distribute those rights as they see fit.[110] Of course, enterprises are also incentivized to create innovation, but typically those incentives come from the need to maintain or grow a business's profitability.[111] In that case, any incentives provided by the patent system are in tandem with the business incentives.[112] Moreover, because corporations cannot be inventors (in the United States), patents are originally owned by the inventors and so the enterprise will likely have to pass down some of

108. This justification arguably springs from the U.S. Constitution itself because it grants Congress the power to create patent rights "for the progress of science and the useful arts." U.S. CONST. art. I, § 8, cl. 8. *See generally* David S. Olson, *Taking the Utilitarian Basis for Patent Law Seriously: The Case for Restricting Patentable Subject Matter*, 82 TEMP. L. REV. 181 (2009) (discussing the utilitarian argument for the U.S. patent system).

109. This is probably only true to the first order effect, however. One could imagine a system that incentivized non-inventors to then provide second order economic incentives to inventors with the non-inventor being the owner of the resulting exclusive right. However, such a system would likely have significant detrimental consequences because it empowers those few with financial resources to determine what innovation gets funded and therefor gets created. An analog to the problems likely to exist in such a system can be seen in the current approach to venture funding and its widespread inequity. *See* Janhvi Patel, *Achieving Gender Equality in Venture Capital: The Case for Federal Regulatory Intervention*, 15 WM. & MARY BUS. L. REV. 625, 627–28 (2024) (reviewing literature on existence and causes of inequity in venture capital).

110. *See* 35 U.S.C. § 261 ("Applications for patent, patents, or any interest therein, shall be assignable in law by an instrument in writing. The applicant, patentee, or his assigns or legal representatives may in like manner grant and convey an exclusive right under his application for patent, or patents, to the whole or any specified part of the United States.").

111. One counterargument on these points is that, when companies are incentivized, that is essentially the same as incentivizing individual creators within those companies. *See* ROBERT P. MERGES, *Property in the Digital Era*, *in* JUSTIFYING INTELLECTUAL PROPERTY 237, 237–69 (2011). Having worked for many years in one such corporate environment, I have some skepticism of this view. *See* Timothy Murphy, *Theoretical Justifications for Trade Secrets Protection of Routine Business Information*, 72 BUFF. L. REV. 1177, 1220 (2024).

112. The extent to which one incentive is more primary than the other likely depends on the type of business, the industry that it participates in, and a host of other factors. In any case, there will be few businesses that seek issuance of patents solely for the sake of having the patents and without any other business justification.

the system's incentives to the individual inventors in the form of increased salary, bonuses, and the like if the incentives are actually going to do any work.[113]

A similar approach applies in the copyright system. Exclusive rights are granted to the authors who are then free to utilize (or alienate) those rights as they see fit. Thus, the system provides incentives to creators directly. There is, however a big caveat in the copyright system — the works-made-for-hire provision. At its root, though, the WMFH provision simply modifies who is considered legally to be the author and the initial rights are granted to that author, even if it is the actual creator's employer. Although not as strict as the patent system in this regard, the copyright system still incentivizes creation either independently or in tandem with business incentives.

In the two disconnected systems, trade secrets and trademarks, the incentives to innovate rationale is on less certain ground. In trade secrets law, the creator is the individual (or group of individuals) that created the trade secret information.[114] However, this individual does not actually have any trade secret rights in the resulting information. Trade secret rights do not arise until someone or something takes additional steps to establish or maintain the secrecy of the information, and even that effort will only result in trade secrets protection if the information has independent economic value due to its secrecy.[115] These additional requirements could be met by the original creator, but that is not necessary, nor is it typical.[116] Thus, existence of trade secret rights does not incentivize the creation of information, or at least not all information. Instead, it incentivizes, at best, only the creation of information that has independent economic value and that can be

113. This assumes that inventors are in demand and have at least some employment bargaining power. In the United States, there is no legal requirement that employers provide incentives to employees for their innovations.

114. Note that the idea of creating information is used in a very broad sense here because trade secret rights can be obtained on information that is not newly created but instead is simply compiled or aggregated. *See* 18 U.S.C. § 1839(3) ("[T]he term 'trade secret' means all forms and types of financial, business, scientific, technical, economic, or engineering information, including . . . compilations."). In other words, in the trade secret space, creation simply refers to the act that results in information that could be protectable. I am avoiding the metaphysical question of when a trade secret comes into existence, but statutorily, up until the point the three requirements are met, information is merely secret, not trade secret. That distinction does not change the current analysis other than on a semantic level.

115. *See id*. at § 1839(3)(A)–(B).

116. This is evidenced by the overwhelming proportion of trade secrets cases that are brought by employers against current or former employees. *See supra* note 14.

kept secret during the period of exploitation. Moreover, it also incentivizes secrecy and active steps to maintain secrecy, which may undercut the very foundations of the incentives to innovate rationale (e.g., encouraging public disclosure).[117] Finally, because the scope of information that is protectable under trade secrets law is so large, there is likely a large class of information that would be created irrespective of any trade secrets law incentives and so, with respect to this class of information, trade secrets law only provides incentives for secrecy, not incentives for innovation.[118] In sum, the incentives to innovate rationale does not provide a solid justification for trade secrets law as it currently exists.

Similarly, the creator of a particular trademark (i.e., a word, design, or other symbol) does not necessarily become the owner of the trademark.[119] Instead, the owner of the trademark is the person or entity that actually uses the symbol in commerce.[120] Consequently, the creation of trademarks is not incentivized on an individualized basis. Instead, the utilization of trademarks in a business is what is incentivized.[121] This has no necessary connection to the original creator of the trademark beyond the practical business connection (for example, the employer-employee relationship). Accordingly, trademark law does not incentivize the creation of trademarks beyond that necessary to accomplish the business objectives of establishing brand presence in the market.

From a purely utilitarian perspective though, there are incentives being produced here; it is just that they are not exclusively directed to creation. In disconnected systems, the rights flow to owners, not necessarily creators. Thus, the incentives to create are only valid for those subsets of creators who can somehow capitalize on their creation through selling it to someone else that can obtain the rights or who can take the additional steps necessary to secure those rights themselves. And even in that context, only those innovations that can create economic value (either through secrecy or through commercial success)

117. The issues with incentivizing secrecy over a broad range of information have been discussed at length by others. *See, e.g.*, Jamillah Bowman Williams, *Diversity as a Trade Secret*, 107 GEO. L.J. 1685, 1685 (2019) (discussing companies using trade secrets to shield diversity information of their workforce from disclosure); Christopher J. Morten, *Publicizing Corporate Secrets*, 171 U. PA. L. REV. 1319, 1378–90 (2023) (discussing trade secrets in regulatory health information).

118. *See, e.g.*, Murphy, *supra* note 111, at 1204–07.

119. *See supra* Part IV.

120. *See id*.

121. *See* Rothman, *supra* note 99, at 1289–91 (discussing the incentives, rewards, and consumer protection rationales for trademark law).

will be incentivized. Thus, the creation incentive is weak, at best. Moreover, because it only applies to economically valuable creations, it is not clear why the economic value is not a sufficient incentive for the creation of these innovations without the additional incentive of IP rights.[122]

The incentives to innovate justification for intellectual property rights provides the strongest justification for connected systems in which innovators will be incentivized either directly or indirectly. Conversely, the justification is very weak in the disconnected systems because creation is not incentivized beyond that necessary to accomplish the commercial goals necessary to establish the IP rights.

2. Individual-Focused Justifications are not Applicable in Disconnected Systems

In addition to the economic incentives rationale, other individualist theories have been proposed as providing a sufficient rationale for exclusive rights.[123] These include Lockean labor theory, Hegelian personhood theory, and Kantian personal autonomy theory.[124] Although these are all fundamentally different theories, they share a focus on the individual's connection to their creative outputs. Lockean labor theory posits that the act of doing work creates a property interest in the outputs of that work.[125] Hegelian personhood theory posits a close connection between personhood and property ownership, including the property that is a result of a person's creative outputs.[126] Kantian personal autonomy argues that it is morally wrong to appropriate the creative outputs of another and therefore, such appropriation should be prevented.[127]

122. To be clear on this point, I am not suggesting that the protection of trade secrets does not have value in protecting information once it is created. I am simply saying that it's not clear that the existence of trade secrets law creates additional incentives beyond the business necessity for creating the information.

123. *See* MENELL ET AL., *supra* note 2.

124. *See id.*

125. *See* JOHN LOCKE, TWO TREATISES OF GOVERNMENT ch. 5, § 27 (Thomas Cook ed., Hafner Pub. Co. 1947) (1690).

126. *See* MENELL ET AL., *supra* note 2, at 9–10.

127. *See, e.g.*, Anne Barron, *Kant, Copyright and Communicative Freedom*, 31 L. & PHIL. 1, 5–7 (2012) (discussing Kant's philosophical principles). Kant's work on intellectual property issues was primarily in the copyright space. However, for simplicity, the concepts will be assumed to be generalizable for the discussion here.

These various theories map reasonably well onto both patents and copyrights.[128] Because these regimes connect creatorship and ownership of the work, theories recognizing rights in creative output and personal connections to creative outputs can provide a valid theoretical justification for these systems, irrespective of whether those rights arise from some form of natural right, morality, or autonomy basis.

Natural rights justifications do not work as well for disconnected systems like trademarks and trade secrets. The disconnect means that any justification based on individualized rights or interests is not applicable other than in the very narrow set of cases where the creator is the owner. Labor theory does not seem to provide a valid justification because corporate labor is a purely economic transaction.[129] Moral rights, which also work on an individual basis, do not extend well to these systems because these systems primarily protect corporate or business interests, not individual interests. Any moral rights that a creator might have are converted to economic interests at the individual/corporate interface and in disconnected systems, this conversion occurs before any intellectual property rights attach. Accordingly, individualized justifications for IP rights do not provide a sufficient justification for disconnected IP systems.

3. Commerce-Focused Justifications are Most Applicable to Disconnected Systems

While incentives theory and the various deontological approaches struggle with justifying disconnected systems of intellectual property protection, commerce-based theories seem to apply best to

128. *See, e.g.*, Barron, *supra* note 127; Kim Treiger-Bar-Am, *Kant on Copyright: Rights on Transformative Authorship*, 25 CARDOZO ARTS & ENT. L.J. 1059, 1060–64 (2008) (discussing Kantian theory in the context of copyrighted works); Christopher S. Yoo, *Rethinking Copyright and Personhood*, 2019 U. ILL. L. REV. 1039, 1045–64 (2019) (analyzing personhood theories' applicability to copyright law); Jeanne L. Schroeder, *Unnatural Rights: Hegel and Intellectual Property*, 60 U. MIAMI L. REV. 453, 484–502 (2006) (analyzing Hegelian philosophy with respect to intellectual property). Arguably, copyright law is closer to the moral core of theoretical justifications because the types of works that copyright law protects are generally considered to be expressive works (and so, expressive of the author's personality) compared to patentable inventions, which are functional innovations that may not have a strong connection to the inventor's personality. However, in the modern era, it could be argued that copyright law is so broad that a significant portion of the covered works do not fit well into a deontological frame and are better suited to utilitarian frameworks. The upshot is that it is increasingly difficult to talk about copyright as a singular concept. Some works like literary works, sculptures, music, and the like may be closer to the creative core, while other works like software, databases, compilations, and the like may be closer to the functional/economic edge.

129. *But see* MERGES, *supra* note 111, at 255.

disconnected systems. Two primary justifications for trade secrets law are the maintenance of commercial morality[130] and preventing economic waste through reduced licensing or increased fencing.[131] For trademarks, there is the primary goal of preventing unfair competition.[132] Neither theory relies on any connection to the creator of the protected right.

In trade secrets, commercial morality is maintained by having a robust notion of improper means, that includes means that are not, in and of themselves, illegal.[133] This ensures that commercial actors conform their conduct not just to the bare dictates of the law, but to a higher standard that includes additional legal, but commercially problematic, conduct.[134] The improper means inquiry focuses on the acts undertaken by the alleged mis-appropriator, not by the owner or creator of the trade secret. Accordingly, the disconnect between the creator and the owner in trade secrets law does not impact the validity of the commercial morality justification.

With respect to economic waste theories, the argument is that, in the absence of intellectual property protection, innovators will engage in fencing strategies to prevent the loss of value in their innovations and will not engage in licensing transactions with others for fear of losing exclusivity to their innovations,[135] both of which would otherwise increase economic productivity or increase knowledge dissemination.[136] It is worth noting that both of these theories look to what an owner of a trade secret might do, or not do, in the absence of trade secrets protection. They do not bear any relationship to who the creator of the information is. Accordingly, these theories are also not impacted by the creatorship/ownership disconnect.

---

130. *See* Lynda J. Oswald, *The Role of "Commercial Morality" in Trade Secret Doctrine*, 96 NOTRE DAME L. REV. 125, 164–70 (2020) (discussing the development and importance of the notion of commercial morality in trade secrets law).

131. *See* MENELL ET AL., *supra* note 2, at 36.

132. *See* Rothman, *supra* note 99, at 1291–92 (2022) ("[I]t is recognized that trademark and unfair competition laws also have as a goal the broader objective to foster fair competition." (internal quotations omitted)).

133. *See* E.I. duPont deNemours & Co. v. Christopher, 431 F.2d 1012, 1016 (5th Cir. 1970) (analyzing the scope of improper means in trade secrets law).

134. This includes things like "bribery, misrepresentation, breach or inducement of a breach of a duty to maintain secrecy, or espionage through electronic or other means." 18 U.S.C. § 1839(6)(A).

135. *See* MENELL ET AL., *supra* note 2, at 18–25.

136. *See, e.g.*, Kewanee Oil Co. v. Bicron Corp., 416 U.S. 470, 485 (1974) (discussing increased "self-help" and reduced licensing transactions in the absence of trade secrets protection).

In trademarks law, unfair competition is prevented by prohibiting the use of a protected mark (or a confusingly similar version) by later users.[137] This prevents later trademark users from free riding off the goodwill created by the original user and from confusing consumers.[138] This justification also has no connection to the creator of the original trademark. In fact, even if the second user created the trademark wholly independently from the original user, without any knowledge of the original use, the second user can still be prevented from using the trademark. Consequently, the disconnect between creatorship and ownership also has no impact on the unfair competition justification for trademarks law.

4. The Validity of Theoretical Justifications for IP Systems Depends on the Connectedness of the Systems

In the absence of intellectual property laws, individuals (or companies) would be free to use any knowledge or information that they can acquire for any lawful purpose. Intellectual property systems restrict this unfettered right to use information by providing exclusive rights to some, at the expense of the public generally. Accordingly, various theoretical justifications are advanced and studied to determine whether the IP systems are justified and/or whether the scope of protection under these systems strikes the right balance between the public's interest in free access and use of information and the exclusive rights being granted. As discussed in this Section, the justifications based on incentives to innovate and individualized theories are most applicable to those systems that have a close connection between the creator and the owner (i.e., the patent and copyright systems). Those justifications are, at best, weakly applicable to the disconnected systems (i.e., the trade secret and trademark systems). Accordingly, justification for these disconnected systems must come from commerce or market-focused theories, if the systems are to be justified at all.

137. *See* New Kids on the Block v. News Am. Publ'g, Inc., 971 F.2d 302, 305 (9th Cir. 1992) (describing the historical origins of trademarks law and its purposes).

138. *See* Vidal v. Elster, 602 U.S. 286, 299 (2024) (discussing the historical foundations of trademark law and its primary function of preventing consumer confusion).

B. Are Exclusive Rights Granted in Disconnected Systems Properly Characterized as Intellectual Property Rights?

There is no single definition of intellectual property, but a reasonable starting place for describing the class of things that would be included in the concept is the idea of intangibles that are created through some mental/intellectual or creative endeavor.[139] Accordingly, for the purposes of this Article, I will use the term intellectual property as referring to intangibles arising from mental effort.

Patents and copyrights both protect intangible ideas that have been embodied in some form.[140] Patents provide exclusive rights to inventions that have been reduced to practice, either constructively or actually.[141] Copyrights protect creative or artistic ideas that have been fixed in a tangible medium.[142] However, in both of these cases, it is the underlying inventive or creative idea that is the intellectual property, as that term is used here. Accordingly, in the connected systems

139. Surveying a variety of sources yields definitions of the term "intellectual property" including: "non-physical property that is the product of original thought," *Intellectual Property*, STAN. ENCYC. OF PHIL. (Aug. 18, 2022), https://plato.stanford.edu/entries/intellectual-property/ (on file with the Syracuse Law Review), "creations of the mind, such as inventions; literary and artistic works; designs; and symbols, names and images used in commerce," *What is Intellectual Property?*, WORLD INTELL. PROP. ORG., https://www.wipo.int/about-ip/en/ (last visited Sep. 28, 2025) (on file with the Syracuse Law Review), "[c]reations of the mind—creative works or ideas embodied in a form that can be shared or can enable others to recreate, emulate, or manufacture them," *Glossary*, U.S. PAT. & TRADEMARK OFF., https://www.uspto.gov/learning-and-resources/glossary#sec-I (last visited Sep. 28, 2025) (on file with the Syracuse Law Review), and "property (such as a concept, idea, invention, or work) that derives from the effort of the mind or intellect," *Intellectual Property*, MERRIAM-WEBSTER, https://www.merriam-webster.com/dictionary/intellectual%20property (last visited Sep. 28, 2025) (on file with the Syracuse Law Review). Note that the intention here is not to ignore the fact that the term intellectual property is often used to refer to the actual granted patent or the copyright itself. However, these functional references to the tangible artifacts of the IP system are not useful in considering the issues addressed here.

140. Note that in the case of patents, the conception is the intellectual property (or gives rise to the intellectual property) as used here and the further reduction to practice is simply the formality that is required to obtain the exclusive rights in the intellectual property. Similarly in the case of copyrights, the original idea is the intellectual property and the fixation is a further formality that is required to obtain the exclusive rights. It is also worth mentioning that because of these requirements of reduction to practice and fixation, the full scope of the intellectual property may not be protectable through the exclusive rights granted.

141. *See* Cooper v. Goldfarb, 154 F.3d 1321, 1327 (Fed. Cir. 1998) (discussing conception and reduction to practice with constructive reduction to practice occurring upon the filing of a patent application).

142. *See* 17 U.S.C. § 102(a) ("Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression.").

in which creatorship gives rise to ownership, classifying the associated intangibles as intellectual property logically follows.

The logical connection in the disconnected systems is less clear. With respect to trade secrets, the broad scope of protectable information means that there is a large portion of protected information that does not necessarily arise from intellectual or creative effort. Customer lists are a good example of this issue. Customer lists have been a staple of trade secrets cases beginning in the earliest days.[143] But classifying customer lists as intellectual property is challenging for at least two reasons: they stretch the definition of intangible and they are likely to be the product of traditional labor, not intellectual labor. In the modern era, one would expect that customer lists are embodied in tangible form somewhere.[144] Moreover, it is not clear what "intangible" is represented by a customer list in the first place. Is it the idea that having customers is a successful way to run a business? Or perhaps the idea that businesses should keep lists of their customers to further business purposes? In either case, these do not seem to be the types of intangibles that would qualify as intellectual property because we would expect people engaged in a business to simply understand these concepts intuitively.[145]

As for the second issue with customer lists, one could imagine a scenario where a business owner sits at their desk and wracks their brain to determine who would be a good customer for their business. However, the more likely scenario is that the individual engages in traditional work to find customers, such as working through local business directories, engaging in personal meetings with potential customers, networking in the industry and ecosystem, and marketing/advertising. These efforts bear little in common with the type of inventive or creative intellectual endeavors protected by the connected systems discussed above.

---

143. *See, e.g.*, Empire Steam Laundry v. Lozier, 130 P. 1180, 1181 (Cal. 1913) (early employee trade secret case where secrets at issue were customer lists); Messenger Publ'g Co. v. Mokstad, 257 Ill. App. 161, 163 (1930) (discussing the same subject matter as *Empire*).

144. For purposes of this discussion, I am considering information that is stored electronically to be tangible even though, by some definitions, electronically stored information would be considered intangible. The distinction I am making is between information that is intangible because it exists in the mind of the relevant individuals and information that is intangible simply because it is being stored electronically, rather than on paper.

145. It is also worth mentioning that when trade secret misappropriation claims are brought with respect to customer lists, the claim is that the actual customer list was taken, not the idea of having a customer list.

To be fair, the previous discussion with respect to customer lists is not generalizable across all of the information that could be protected as a trade secret. Customer lists fit into a category that I have previously characterized as "routine business information"[146] and for which there used to be a distinction.[147] However, there is undoubtedly some information that is protectable as a trade secret that also fits into the categories of information that are protectable under patent or copyright law.[148] It is not clear why trade secrets law should provide an additional avenue for protection of these more traditional intangibles, though. The Supreme Court decided long ago that trade secrets law was not preempted by patent law, but the factual basis underpinning that decision was slim at best.[149] Were it to be decided at some point that trade secrets protection of otherwise patentable and/or copyrightable information is preempted[150] or no longer available due to legislative or common law changes, it would be tough to characterize what is left as intellectual property if that term is to be understood as covering intangibles that result from intellectual, rather than physical or traditional, labor.[151]

With respect to trademarks, it is not actually the creation that trademark law protects — it is the commercial use of the creation that is protected.[152] Mental effort in the form of creativity is neither a sufficient nor a necessary condition for protection. For example, trademark rights can be obtained for descriptive marks and even for marks that are the same as an existing mark but used in a different geography

146. *See* Murphy, *supra* note 111, at 1181.

147. *See* RESTATEMENT (FIRST) OF TORTS §§ 757, 759 (A.L.I. 1939).

148. One might wonder whether preemption should apply (or more accurately, should have applied during the period of state-law-only trade secrets law) to such information, but that question was answered in the negative many years ago. *See* Kewanee Oil Co. v. Bicron Corp., 416 U.S. 470, 490 (1974) (deciding that state trade secrets law was not preempted by federal patent law). *See also* Sharon K. Sandeen, *Kewanee Revisited: Returning to First Principles of Intellectual Property Law to Determine the Issue of Federal Preemption*, 12 MARQ. INTELL. PROP. L. REV. 299 (2008) (providing detailed analysis of the *Kewanee* decision).

149. *See* Sandeen, *supra* note 148, at 342.

150. This is essentially no longer possible as a complete change to trade secrets law after enactment of the DTSA, but preemption could be applied to state statutes.

151. The primary effort that is being rewarded in this scenario must come down to the owner's efforts in establishing and maintaining secrecy. This includes things like maintaining secure infrastructure (whether virtual or physical), limiting internal and external disclosures, and the like. In other words, these efforts are not as tangible as using a shovel to dig a hole, they are clearly closer to traditional labor than innovative intellectual labor.

152. *See supra* Part IV.

or for different goods or services.[153] On the other hand, commercial use is a necessary (and, in some cases at least, sufficient) condition for protection. Accordingly, the activity that gives rise to the exclusive rights are commercial in nature, not intellectual.

It is not clear why the results of such commercial efforts should be characterized as intellectual property or protected under an intellectual property system.[154] If a startup business invests one million dollars entering the market, the business has no protection against another competing business entering and completely consuming the market. On the other hand, if a business spends an hour of employee time (for the sake of argument, I will value that at thirty dollars) creating a trademark and the business begins using the trademark in commerce, the business now has protection against any other business using a confusingly similar mark. In the first case, substantial investment is completely unprotected; in the second case, minimal investment is maximally protected. If the goal is to protect something more than mere business expectancies, this distinction might make sense, but as described above, it is not clear what this something more actually is. It is not an incentive to innovate. It is not some personal or natural law interest. At best, it is some notion of commercial morality or market regulation against deceptive practices. Unfortunately, neither of the disconnected systems requires intent on the part of the alleged wrongdoers to establish liability.[155] So, again, it seems to point to a simple

153. *See, e.g.*, DeGidio v. W. Grp. Corp., 355 F.3d 506, 510 (6th Cir. 2004) (descriptive trademarks are protectable if the mark owner can establish secondary meaning); Savin Corp. v. Savin Grp., 391 F.3d 439, 462 (2d Cir. 2004) (affirming finding of no likelihood of confusion where essentially same mark was used on different goods and services); Dawn Donut Co. v. Hart's Food Stores, Inc., 267 F.2d 358, 365 (2d Cir. 1959) (finding no likelihood of confusion where parties use the same mark but in different geographic regions).

154. The question of whether trademarks should be considered intellectual property is not a new one, although I am not aware of any prior work based around the connection between creatorship and ownership that is explored here. *See, e.g.*, Laura Slezinger, *What Makes Trademarks "Intellectual" Property?*, 19 J. CONTEMP. LEGAL ISSUES 7, 7–13 (2010), and references cited therein.

155. In trademark law, the intent of the alleged infringer is just one of many factors to consider. *See, e.g.*, AMF Inc. v. Sleekcraft Boats, 599 F.2d 341, 348 (9th Cir. 1979), *abrogated by* Mattel, Inc. v. Walking Mountain Prods., 353 F.3d 792 (9th Cir. 2003) (listing several factors relevant to likelihood of confusion, one of which is "defendant's intent in selecting the mark."); Polaroid Corp. v. Polarad Elecs. Corp., 287 F.2d 492, 495 (2d Cir. 1961) (listing several factors relevant to likelihood of confusion, one of which is "the reciprocal of defendant's good faith in adopting its own mark"). In trade secrets law, misappropriation is closely tied to the concept of improper means of acquisition, but the improper means of acquisition do not require intentional misconduct by the alleged misappropriator. *See* 18 U.S.C. § 1839(5)–(6) (defining "misappropriation" and "improper means").

decision about which commercial interests will be named intellectual property and protected as such, and which ones will not. Thus, the naming of the thing is what is determinative, not the nature of the thing itself.

One could argue that the intangible being protected by the trademark regime is either or both the business goodwill associated with the trademark and the reduction in consumer search costs due to the trademark. However, each of these has its own challenges with respect to the notion of intellectual property, as defined here. Business goodwill certainly would seem to be an intangible (in the sense that it does not exist in physical form), but it is primarily the result of traditional commercial efforts, not intellectual labor, or at least no more than any other business function constitutes intellectual labor.[156] Similarly, the reduction in consumer search costs is an intangible, but here, this is an intangible that is not the result of intellectual effort on the part of the owner. It is an intangible that manifests in the minds of consumers and is primarily the result of the commercial efforts of the owner, rather than intellectual efforts. Accordingly, neither of these intangibles provides a sufficient basis to consider a trademark intellectual property as defined here.

To the extent that intellectual property is understood as referring to intangibles arising from mental effort, as proposed in this Section, the connected systems (patents and copyrights) seem to be solidly protecting intellectual property. In the disconnected systems, however, the things being protected are not so clearly characterized as intellectual property. Trade secrets protect ordinary or general commercial efforts, including efforts expended to create and maintain secrecy. Trademarks also protect general commercial efforts, primarily efforts directed at creating market acceptance and consumer goodwill. Neither of these disconnected systems are protecting intangibles arising from mental effort beyond normal commercial labor. Accordingly, the classification of these disconnected systems as intellectual property systems does not seem accurate when viewed through the lens of connection between creators and owners.

156. In this case, I am thinking of business functions like human resources management, supply chain organization, internal manufacturing optimizing, and the like. All these things certainly have an intellectual component because some human decision-maker is involved, but if that is the level of intellectual effort required to establish the results as intellectual property, the result of every human activity, however trivial, now becomes intellectual property.

C. Rights in Disconnected Systems Rise or Fall with the Commercial Context

One consequence of the disconnect between creatorship and ownership is that rights in disconnected systems are extinguished when the commercial requirements giving rise to them cease. In the patent and copyright systems, there is always a creator at the end of the chain of title. Accordingly, if an owner other than the creator chooses to relinquish their right, or has their right terminated in some other way (other than a determination that the original right was invalid), the right can revert to the creator. As an example, when an employer takes an assignment to a patent right, but the assignment is ultimately determined to be defective, the right reverts to the creator.[157] A similar result obtains under copyright law.[158]

There is no such possibility of reversion in the disconnected systems. Instead, if the owner of a trademark or trade secret loses their right, either voluntarily or involuntarily, the right does not revert to the creator. Instead, the right is simply lost.[159] Consider the example of an employee assignment agreement with respect to either trademarks or trade secrets.[160] If the employer chooses not to protect the secrecy of the information or to use the trademark in commerce, there are no rights that revert back to the employee. Instead, the rights are either

157. *See, e.g.*, Bd. of Trs. of Leland Stanford Junior Univ. v. Roche Molecular Sys., Inc., 583 F.3d 832, 841 (Fed. Cir. 2009), *aff'd*, 563 U.S. 776, 793 (2011) (defective assignment agreement left patent rights with inventors and so subsequent effective assignment to different assignee was valid).

158. *See* Cmty. for Creative Non-Violence v. Reid, 490 U.S. 730, 753 (1989) (holding that sculpture was not work made for hire and thus sculptor was author for purposes of copyright, subject to the possibility of joint authorship).

159. This does not mean, of course, that a new right could subsequently arise by establishing the three requirements for trade secrets protection (in the case of a trade secrets right) or commencing use in commerce (in the case of trademark rights). An owner could prevent this result through copyright abandonment, but that is a purely common law doctrine and is pretty narrow. *See, e.g.*, Micro Star v. FormGen Inc., 154 F.3d 1107, 1114 (9th Cir. 1998) (holding that a software developer may have abandoned some portion of its copyright rights by distributing free software, but not necessarily all of its rights).

160. One might reasonably posit that an agreement purporting to assign any trademark or trade secrets an employee creates on the job is not actually assigning anything because, presumably, the employee does not meet the requirements for trade secret protection of information they create on the job (independent economic value and reasonable efforts, in particular) or for trademarks they create (the requirement of use in commerce). Really, these agreements are best seen as simply providing a quit claim to any rights someone might have in information they create, but in our modern system, it is not clear that individual employees (or anyone for that matter) has any rights in information they create other than under patent, copyright, trademark, or trade secrets law.

lost completely (through discontinuation of secrecy efforts or commercial use, for example) or they never arose in the first place (because the employer never met the requirements for protection). This is not to say that a failed assignment agreement from one owner to the next would never result in a reversion of rights to the previous owner. This is possible, but such a reversion would never fall back to the creator unless, by chance, the creator happened to be the previous owner.

The upshot of this situation is that rights in the disconnected systems are transitory in a way that they are not in the connected systems. More particularly, the rights in the disconnected systems rely critically on the commercial context for their existence, while the rights in the connected systems are not dependent on the commercial context.[161] With respect to trade secrets, the rights only exist so long as the three requirements are met and each of the requirements relies on either commercial effort (reasonable efforts) or the commercial environment (economic value and readable ascertainability). Similarly, trademark rights only exist during the period of commercial use.[162] The transitory nature of these rights is in sharp contrast to the defined terms of the patent right (approximately 20 years from application filing for utility patents) and the copyright rights (either fixed term or a term spanning a fixed number of years beyond the author's life, depending on the type of work), which include a possibility of reversion to the original creator for any remaining term.

The critical link between the rights in the disconnected systems and the commercial context raises the obvious question of why an intellectual property system should apply to these disconnected systems and provide protection over and above the business profits obtained from the information itself. If the information (whether it be a trade secret or a trademark) is associated with revenue generation for the business, it is not clear why the owner should derive additional, court-enforced benefits beyond that revenue.[163] Moreover, if the information is not associated with revenue generation for the business, it is not clear why there should be any court-enforced benefits directed at that information. In other words, if the rights themselves exist only within a particular commercial context, and have no reversion to any original

161. Certainly, the value of the right may critically depend on the commercial context in the connected systems, but the existence of the right does not depend on the commercial context.

162. For purposes of this discussion, I am ignoring intent-to-use rights and the potential carry-over period before the presumption of abandonment applies.

163. Such benefits could include, for example, limitations on competitive efforts by others and decreased employee turnover.

creator, arguably the rights should not exist in the first place, and the owner should be left to reap whatever commercial benefits they can from the information and nothing more.

D. Is the Intellectual Property System Becoming More Disconnected?

So far in this Article, the patent and copyright systems have been presented as connected systems in which creatorship and ownership are connected primarily through initial ownership vesting in the creator. While that characterization is certainly true in the patent system (at this time), it comes with an important caveat in the copyright system through the works-made-for-hire provision.[164] An important issue that this characterization ignores however, is the trend line of this connection in the patent and copyright systems. This Section will look at that trend line and discuss possible repercussions of the trends in these connected systems.

As detailed above, early trademark and trade secrets law could be viewed as, from a practical perspective, connected systems, not necessarily because the systems were designed to be connected but instead because the owners of the associated rights tended to be the creators of the associated creations. Over time, the practical situation grew to largely match the legal situation and so today, these systems are completely disconnected legally and almost completely disconnected practically. Presumably there will always be some level of creators that obtain exclusive rights over their creations (and ownership of those rights) through either trademark law or trade secrets law. But because those practical scenarios where the creator and owner are linked do not carry legal significance, they have no bearing on issues that turn on ownership by non-creators (or non-humans).

The patent system is in a different situation, however. Since the earliest days, ownership of patent rights has been connected with creatorship. This connection even applied both practically and legally in the employment context. While the legal situation has not changed (i.e., the patent system is completely connected), the practical situation has changed dramatically. In particular, the inventor of a patentable invention is still presumptively the initial owner of any patent that issues on that invention and so legally, the situation has not changed since the first Patent Act. Practically though, the widespread use (and predictable enforceability) of invention assignment agreements has diminished the strength of the connection because patents are routinely

164. *See supra* Part II.

assigned before application (even before invention) and so the inventor never has a true ownership interest in the patent (other than as a possibility of reversion, as discussed above).[165] Thus, the legal connection between creatorship and ownership is still present, but in many or most cases from a practical perspective, the connection is so weak as to almost be non-existent.

The copyright system sits in somewhat of a middle ground between the completely disconnected trade secrets and trademark systems and the completely connected (legally) patent system. Copyright law always has, and continues to, provide a complete legal connection between the author and the owner, with initial ownership of the copyright being in the author. The caveat comes in the form of the works-made-for-hire doctrine and its designation of the employer as the author in certain situations. Of course, the authorship that the employer is getting credit for is actually the work of the individual employees, who would be the actual creators in the way that I have presented that concept here. Accordingly, the works-made-for-hire doctrine is one way in which the connection between creatorship and ownership is less absolute in copyright law. Irrespective of the automatic transfer provided by the WMFH statute, companies may choose to include copyright assignments in their standard form employee paperwork along with (or as part of) the invention assignment agreement.[166] Similar to the patent situation discussed above, these automatic assignment agreements are another way in which, even if the legal

165. *See, e.g.*, DLA PIPER, *Employee proprietary information and inventions assignment agreements: what they do, and what could happen without them*, https://www.dlapiperaccelerate.com/knowledge/2017/employee-proprietary-information-and-inventions-assignment-agreements.html. (last visited Aug. 29, 2025) (on file with the Syracuse Law Review) (discussing the substance and effect of employee proprietary information and invention assignment agreements used at "nearly all companies in most industries"). *See also* Ann Bartow, *Inventors of the World, Unite! A Call for Collective Action by Employee-Inventors*, 37 SANTA CLARA L. REV. 673, 674–75 (1997) (discussing the use of "pre-invention assignment agreements" in modern employment situations); Orly Lobel, *The New Cognitive Property: Human Capital Law and the Reach of Intellectual Property*, 93 TEX. L. REV. 789, 813–15 (2015) (discussing the use of "pre-innovation assignment agreements" in modern employment situations); Syndicated Servs., Inc. v. Yarbrough, No. 16 CVS 20912, 2017 NCBC LEXIS 13, at *4–5 (N.C. Super. Ct. Feb. 15, 2017) (complaint alleges "All of the Corporation's employees were required to sign a Confidentiality and NonCircumvention Agreement . . . . Execution of the Confidentiality Agreement was a condition precedent to Defendant's employment by the Corporation.").

166. *See* DLA PIPER, *supra* note 165 (discussing the copyright provisions of employment assignment agreements).

connection is strong, the practical connection is weak or non-existent in the copyright system.[167]

It is worth reiterating that the practical disconnect in the patent and copyright systems is not a fundamental aspect of these systems and instead arose over time as employers gained more rights and control over the creative outputs of their employees. In other words, there was not a discrete, identifiable decision to disconnect creatorship and ownership in these systems; it was a result that developed over years of judicial decisions. As more and more creators become employees, rather than individual innovators, the share of innovation that is practically disconnected correspondingly increases. If this trend toward disconnection were to result in a legal change in the patent and copyright systems to align the systems with the practical reality,[168] disputes about non-human creation would become largely irrelevant or unnecessary. If obtaining a patent (and ownership of the patent), for example, could be accomplished without establishing any legal creator, then there would be no practical legal reason to dispute inventorship[169] or to deny a patent because the inventor was not a human.[170] While this result certainly avoids some vectors of conflict, it would move the patent and copyright systems away from their intellectual property foundations and more toward a pure commercial tort-type regime. Further, it would make all the other issues raised in this Article with respect to disconnected systems, now applicable to the patent and copyright systems, as well.

---

167. Despite this practical disconnect, the legal connection in both the patent and copyright systems at least maintains something akin to a right of attribution to the original creator, which some may consider an important right on its own.

168. This could happen in multiple ways. For example, a WMFH doctrine could be created in patent law, much like it was created in copyright law. As another example, either or both of patent or copyright law could be modified such that initial ownership of the protected creations vests in the applicant, rather than the creator.

169. The result of such a system can already be seen on the copyright side, where some disputes (those relating to works-made-for-hire) turn on whether the claimant is an employee rather than whether they are a creator. *See* Cmty. for Creative Non-Violence v. Reid, 490 U.S. 730, 751 (1989).

170. *See*, *e.g.*, Thaler v. Vidal, 43 F.4th 1207, 1209 (Fed. Cir. 2022), *cert. denied*, 143 S. Ct. 1783 (2023) (denying certiorari on the question of who or what can create under the Patent Act). *See also* Joe McKendrick, *Who Ultimately Owns Content Generated by ChatGPT and Other AI Platforms?,* FORBES (Feb. 22, 2023, at 13:26 ET), https://www.forbes.com/sites/joemckendrick/2022/12/21/who-ultimately-owns-content-generated-by-chatgpt-and-other-ai-platforms/?sh=34c956905423.

CONCLUSION

In U.S. intellectual property systems, ownership is a fundamental aspect that determines protectability, enforceability, and potentially longevity. In the connected systems (patent and copyright), creatorship is a precondition for ownership and so a purported owner must establish a chain of title from the creator in order to exercise the exclusive rights these systems provide. In the disconnected systems (trademark and trade secret), there is no necessary connection between creatorship and ownership and so purported owners are free to establish rights in the protected IP without any provenance to, or authorization from, the creator of the underlying intangibles.

This difference between connected and disconnected systems has important implications for how we think about several aspects of the overall intellectual property system. First, to the extent the theoretical justifications for the IP system rest upon utilitarian or personhood theories, these theories do not provide sufficient justification for the disconnected systems because the ultimate rights being enforced or protected are not necessarily linked to the creator of the associated intangibles. Thus, these systems must look to commercial regulation types of rationales, rather than the classical philosophical justifications. Second, because the protected intangibles in disconnected systems are not linked to the actual intellectual labor of individual creators, it is not clear that the rights granted under these systems can fairly be characterized as intellectual property rights. Third, the rights in the disconnected systems have an ephemeral or indeterminate lifetime that is more closely aligned with the commercial context of the particular intangible than any type of public interest balancing of competing interests that we would expect in IP systems. Finally, even the connected systems may be becoming more disconnected over time, which could have important implications for how we think about the role of intellectual property systems in our society going forward and particularly with respect to the ability of non-humans to participate in those systems.