Columbia Law School
Scholarship Archive

Faculty Scholarship | Faculty Publications

2020

Intellectual Property Law and Redressive Autonomy

Shyamkrishna Balganesh
Columbia Law School, sbalganesh@law.columbia.edu

Follow this and additional works at: https://scholarship.law.columbia.edu/faculty_scholarship

 Part of the Intellectual Property Law Commons, and the International Law Commons

Recommended Citation

Shyamkrishna Balganesh, *Intellectual Property Law and Redressive Autonomy*, OXFORD STUDIES IN PRIVATE LAW THEORY, VOLUME 1, PAUL B. MILLER & JOHN OBERDIEK (EDS.), OXFORD UNIVERSITY PRESS (2020).
Available at: https://scholarship.law.columbia.edu/faculty_scholarship/4236

This Book Chapter is brought to you for free and open access by the Faculty Publications at Scholarship Archive. It has been accepted for inclusion in Faculty Scholarship by an authorized administrator of Scholarship Archive. For more information, please contact scholarshiparchive@law.columbia.edu.

7

Intellectual Property Law and Redressive Autonomy

Shyamkrishna Balganesh

I. Introduction

The idea that intellectual property law is a form of private law has come under serious attack over the course of the last century, at least in the United States. Much of this has to do with intellectual property's increased reliance on statutes and administrative agencies, and with it the infusion of collectivist goals and ideals into its functioning.[1] Somewhat ironically though, despite the serial addition of new normative goals and objects into its working, the basic analytical structure of intellectual property law has remained constant, over both time and context. This analytical structure, as I argue in this essay, ties intellectual property to a form of autonomy that is characteristic of much (if not all) of private law, best termed "redressive autonomy." Redressive autonomy anchors intellectual property in private law, such that any serious transformation of intellectual property into a public law subject will require a comprehensive modification of its basic analytical structure.

All of the principal forms of intellectual property law—patent, copyright, trademark, and trade secret[2]—exhibit a common basic structure, despite their myriad differences. They each grant someone a set of exclusive rights over an intangible, which simulates the functioning of property rights to varying degrees. A form of *de jure* exclusivity thus replaces the *de facto* excludability traditionally associated with tangible property. This *de jure* exclusivity is

[1] For a general account of this transformation and its causes within copyright law, see Shyamkrishna Balganesh, "Copyright as Legal Process: The Transformation of American Copyright" (2020) U. Pa. L. Rev. (forthcoming). See also Megan M. La Belle, "Patent Law as Public Law" (2012) Geo. Mason L. Rev. 41 (making an argument for treating patent infringement litigation as public law litigation). For a more direct argument along these lines, specifically from within the Australian context see Robert French, "A Public Law Perspective on Intellectual Property" (2014) 17 JWIP 61.

[2] Other areas that might be fruitfully added to this list of mainstream intellectual property rights include: rights of publicity, misappropriation, and design patent rights.

Shyamkrishna Balganesh, *Intellectual Property Law and Redressive Autonomy* In: *Oxford Studies in Private Law Theory: Volume 1*. Edited by: Paul B. Miller and John Oberdiek, Oxford University Press (2020). © The Several Contributors.
DOI: 10.1093/oso/9780198851356.003.0007

Downloaded from https://academic.oup.com/book/39683/chapter/339678070 by Milbank Memorial Library user on 05 December 2023

however realized in a very particular way: through the vesting of a claim right in the relevant individual, with a correlative duty that operates *in rem*.

Since the maintenance and control of exclusivity is central to the very existence of any intellectual property regime, the claim right that it relies on is critical to its functioning. Intellectual property chooses to maintain the right–duty relationship (and with it the exclusivity) by vesting in the right-holder a (secondary) private right to seek redress when the right–duty relationship is interfered with, that is, when a defendant violates the exclusivity. To be sure, there is nothing internal to the idea (or nature) of the exclusivity at issue or the primary right–duty relationship that mandates its realization through this secondary right of redress; and yet it has remained a constant feature of intellectual property since time immemorial. By steadfastly relying on a private right of redress to ensure the maintenance of the primary right–duty relationship, intellectual property law might be seen as committing itself to a particular form of autonomy, one that sees the maintenance of the exclusivity and with it the law's very need for protection as subject to the right-holder's subjective choices in constructing his or her identity through a privately initiated form of public redress.[3]

In this essay, I argue that this "redressive autonomy" is key to understanding the analytical structure of intellectual property, and its foundation as a form of private law. Redressive autonomy sheds light on a key facet of all intellectual property that has remained constant ever since the emergence of the institution centuries ago. Attempts to understand the connection between intellectual property and private law based on similarities between intellectual property and other private law areas (such as torts, property, and unjust enrichment) remain analytically incomplete without an account of redressive autonomy. Indeed, as the analysis below suggests, redressive autonomy forms an important element of all private law regimes and suggests the possibility that areas of law previously seen as outside the domain of private law might be fruitfully understood as firmly within it from this perspective.

This essay is divided into two sections following this introductory section. Section II breaks down the structure of intellectual property regimes to show how they all revolve around three central ideas: exclusivity, a primary

[3] To be clear, my use of the term "public" to describe the redress here is to contrast it to the private initiation of the mechanism and embodies three facets: (i) it is vertical, in that the final redress—as opposed to its initiation—comes from the state, (ii) as a process, it is open for all of the world to see, which has important expressive effects, and (iii) its final resolution is publicly memorialized. My continued use of the phrase "private redress" is not to be contrasted with this but is indeed synonymous and is merely a short form for "privately-initiated redress."

Downloaded from https://academic.oup.com/book/39683/chapter/339678070 by Milbank Memorial Library user on 05 December 2023

right–duty relationship, and the vesting of a secondary private right of redress in the primary right-holder. Section III then focuses on redressive autonomy. It first disaggregates the secondary right of redress to develop the idea of redressive autonomy and its various attributes as they manifest themselves in intellectual property, then shows how it sheds light on more than just the enforcement framework of intellectual property law, and finally shows how redressive autonomy is central to much of private law thinking, even though it assumes a special form within the context of intellectual property. A brief conclusion follows.

II. The Basic Structure of Intellectual Property Law

The term "intellectual property" today encompasses a myriad of different regimes, each of which functions by creating entitlements in intangibles. Traditionally, the areas of patent law, copyright law, and trademark law have been seen as paradigmatic of the area, even though they each focus on different intangible subject matter: patents on inventions, copyright on expression, and trademark on source identifiers. To understand the common minimum structure that these regimes embody, consider the following three hypotheticals, each of which provides a barebones picture of the regime that is analytically salient for the rest of the argument that follows.

> *N* is a novelist who writes a wholly original work of fiction. The work is lawfully printed, published, and made publicly available. *I* decides to make and sell copies of the novel without *N*'s permission. *N* considers an action for copyright infringement against *I*, but when offered a sum of money by *I*, chooses not to initiate the action.
>
> *P* is an individual inventor who develops a new, useful, and non-obvious invention. *P* applies for, and receives, a patent for the invention. After the issuance of the patent, *I* begins selling products that contain *P*'s patented invention, without *P*'s permission. *P* commences an action for patent infringement against *I* and obtains an injunction.
>
> *T* is an individual who manufactures and sells children's toys under the brand name Tizio. *T* registers the mark "Tizio" with the Trademark Office, which finds it to be sufficiently distinctive. After *T*'s entry into the market, *I* begins to sell children's toys, under the name "Teezio." *T* commences an action for trademark infringement against *I*, but midway through the action decides to abandon it realizing that *I* is not financially profitable.

Downloaded from https://academic.oup.com/book/39683/chapter/339678070 by Milbank Memorial Library user on 05 December 2023

Taken together, these three illustrations reveal a common analytical structure that enables us to make sense of intellectual property and its commitment to private redress.

A. Exclusivity and Excludability

A central feature of all intellectual property law is its effort to simulate the working of traditional tangible property by creating a form of exclusivity over an identified intangible.[4] In other words, each intellectual property regime seeks to ensure that the identified claimant (or owner) is the only one entitled to perform a set of actions in relation to the identified intangible, subject of course to a few important exceptions. In this crucial respect, intellectual property attempts to follow the lead of tangible property which grants owners exclusive use privileges in relation to a tangible object, except that tangible property deals with resources that are both rival (incapable of identical simultaneous use) and excludable (physically capable of excluding certain uses). Intangible resources are both non-rival and non-excludable, which makes intellectual property law's ability to rely entirely on the working of tangible property problematic.[5]

An important respect in which intellectual property takes the property baseline as a given lies in its reliance on excludability.[6] With traditional property, excludability is capable of both physical and conceptual realization. The former entails the owner's ability to perform a set of actions in relation to the protected resource (e.g., the construction of a fence, or the locking up of an object) in order to exclude others from it.[7] These exclusionary use-privileges are in turn given recognition and protection by property law, their conceptual equivalent. In intellectual property, exclusionary privileges are of limited functional utility, given the non-rival and non-excludable nature of the resource. Whereas a piece of law can be walled off or a ring can be protected by a lockbox, a novel or an invention cannot be similarly disseminated and controlled. Excludability—if it

[4] For leading theoretical work examining this connection, see Henry E. Smith, "Intellectual Property as Property: Delineating Entitlements in Information" (2007) 116 Yale LJ 1742; Richard A. Epstein, "The Disintegration of Intellectual Property? A Classical Liberal Response to a Premature Obituary" (2010) 62 Stan. L. Rev. 455.

[5] Smith (n 4) 1795.

[6] See Christopher S. Yoo, "Copyright and Public Good Economics: A Misunderstood Relationship" (2007) 155 U. Pa. L. Rev. 635, 644–45.

[7] See generally Wesley Hohfled, "Some Fundamental Legal Conceptions as Applied in Judicial Reasoning" (1913) 23 Yale LJ 16, 34–36 (discussing use privileges with the famous "shrimp salad" example).

Downloaded from https://academic.oup.com/book/39683/chapter/339678070 by Milbank Memorial Library user on 05 December 2023

needs to form the law's baseline in intellectual property—thus requires an alternative basis for its realization.

Intellectual property finds this alternative in its *legal* declaration of exclusivity. Each of these regimes replicates the physical attribute of excludability by declaring a set of actions relating to the intangible at issue to be "exclusive" to an identified individual—the author, inventor, or mark-holder—in the sense that the identified individual is given the sole entitlement to do something in relation to the intangible. Legally declared exclusivity thus steps in for physical excludability. The precise contours of the exclusivity may vary from one regime to another, yet it remains conceptually central.

Returning to our illustrations, *C* therefore gets a set of "exclusive rights" to copy, distribute, perform, display, and adapt the novel.[8] *P* gets the exclusive "right to exclude" others from making, selling, or using the invention that forms the subject of the patent.[9] And finally, *T* would under trademark law obtain the "exclusive right to use" the mark Tizio in commerce.[10]

B. Primary Right–Duty Correlativity

ıntellectual property law however does more than just declare a set of actions to be exclusive to an individual. It further instantiates such exclusivity through a somewhat precise mechanism involving the imposition of an obligation (duty) on the world at large, and vesting a correlative right in the individual creator, inventor, or mark-holder.[11]

In this respect, intellectual property functions in almost identical terms to tangible property. Whereas property rights operationalize their excludability through *in rem* duties of "abstention" or "non-interference" the correlative of which is a right vested in the owner, intellectual property gives effect to its concept of exclusivity by obligating others to refrain from performing the acts covered by the law's declaration of exclusivity.[12] Thus, when copyright law declares that *C* is to have the exclusive right to reproduce the work in copies, it is simultaneously imposing an obligation on all others: to refrain from reproducing the work without *C*'s permission. It then vests the correlative of this right in *C*,

[8] US Copyright Act of 1976, 17 USC, § 106.
[9] US Patent Act of 1952, 35 USC, § 154(a)(1).
[10] US Lanham Act of 1946, 15 USC § 1057(b).
[11] Hohfeld (n 7) 31–32.
[12] For scholarship identifying the duty of abstention or non-interference, see J. E. Penner, *The Idea of Property in Law* (Hart 1997) 128; Thomas W. Merrill and Henry E. Smith, "What Happened to Property in Law and Economics?" (2001) 111 Yale LJ 357, 359.

Downloaded from https://academic.oup.com/book/39683/chapter/339678070 by Milbank Memorial Library user on 05 December 2023

commonly referred to as *C*'s right to exclude. It is important to appreciate that as a claim-right, the right to exclude is but a correlative to the duty of abstention rather than a secondary right or power, a point to which we will return.

The right–duty correlativity may seem superfluous to the idea of exclusivity here, but it is important to understand that it is hardly so. Having committed itself to the notion of exclusivity, intellectual property law could have chosen an alternative route (or multiple alternative routes) to rendering such exclusivity functional. One obvious method would have been through a mechanism of direct state enforcement, such as criminal law.[13] In this alternative universe, the law might have chosen to operationalize exclusivity by declaring it and simultaneously rendering violations of it punishable in some form. The right to enforce the exclusivity would now be vested in the state, rendering it *public* in an important sense. The decision to root the exclusivity in a right–duty correlative, much like with property law, is therefore one of some significance. The claim right that intellectual property law vests in the creator/inventor/markholder is thus a primary right.

C. The Secondary Right of Redress

Intellectual property law's claim right that forms part of the right–duty relationship instantiating exclusivity is a *passive* right, in the sense that its existence is not contingent on the capacity of its rights-holder to do something with it, nor on the automatic existence of an avenue for its functional realization.[14] Converting it into an active component thus forms the analytical next step for intellectual property law, something that it does through the creation of a secondary right (or in strict Hohfeldian terms, a combination of a privilege and a power[15]). This secondary right of redress entitles its holder to a mechanism of civil recourse whenever the primary right is violated (through a breach of its corresponding duty).[16]

[13] To be sure, intellectual property statutes do commonly embody criminal law provisions. All the same, they are heavily dependent on private action and define the offense in terms of an "infringement," which in turn relates back to the private action. In short, criminal actions are parasitic on private redress. See Irina D. Manta, "The Puzzle of Criminal Sanctions for Intellectual Property Infringement" (2011) 24 Harv. JL & Tech. 469.

[14] See David Frydrych, "Hohfeld Vs. The Legal Realists" (2018) 24 Legal Theory 291, 295. (drawing the active/passive distinction and noting how Hohfeld's framework does not make the distinction clear).

[15] Civil recourse theory makes this point forcefully. See Benjamin Zipursky, "Rights, Wrongs, and Recourse in the Law of Torts" (1998) 51 Vand. L. Rev. 1, 5.

[16] The primary/secondary distinction was adopted by Hohfeld. See Frydrych (n 14) 299–305.

Downloaded from https://academic.oup.com/book/39683/chapter/339678070 by Milbank Memorial Library user on 05 December 2023

In approaching a court with a claim of infringement, *C*, *P*, and *T* is each exercising a right of redress that the law invests in each of them the moment *I* (in each case) commits the act that interferes with the law's grant of exclusivity. Again, it is crucial to appreciate that this form of private/civil recourse is hardly self-evident or necessary as an adjunct to the exclusivity or the primary right–duty relationship. It is instead intellectual property law's *deliberately chosen* model of operation, wherein it treats the interference with its original grant of exclusivity as a private wrong and offers up an avenue of recourse for its vindication and remediation. The model of civil recourse, elaborately developed and expounded by John Goldberg and Ben Zipursky, finds direct application in the working of intellectual property law.[17]

Building on what Goldberg and Zipursky say about recourse in tort law, it is crucial to recognize that the law does not automatically initiate any reparation or remediation when an infringement occurs. Nor does it indeed mandate or require such remediation. Instead, the law merely "empowers" the original holder of the primary right to initiate an action against the putative infringer in order to invoke the machinery of the state to remediate (or prevent) the infringement.[18] Straightforward and obvious as it may seem, it is within this simple reality that the area's anchoring in private law lies. For with it, intellectual property law is effectively outsourcing and delegating decisions that it analytically revolves around, to the primary right-holder.

Most obviously, these include the decisions *whether*, *when*, and *how* to commence an action for infringement, that is, to exercise the secondary right of redress. It also includes the decision whether to terminate the infringement action, once actually commenced. And intellectual property law does nothing to scrutinize the primary right-holder's reasons behind these decisions, however idiosyncratic or irrational they may be. Indeed, such is the delegation that when intellectual property law decides—as a normative matter—to attempt such scrutiny, the analytical structure of the entitlement disallows it.[19]

The creation of a secondary right of redress is of course hardly unique to intellectual property. Yet, it is of particular salience to intellectual property law

[17] See Zipursky (n 15); Benjamin Zipursky, "Civil Recourse, Not Corrective Justice" (2003) 91 Geo. LJ 695; John C. P. Goldberg and Benjamin Zipursky, "Torts as Wrongs" (2010) 88 Tex. L. Rev. 917; John C. P. Goldberg and Benjamin Zipursky, "The Moral of MacPherson" (1998) 146 U. Pa. L. Rev. 1733.

[18] Zipursky (n 15) 5.

[19] The recent controversy surrounding copyright trolls illustrates this problem. Trolls are copyright plaintiffs who have acquired no more than the right to sue and have played no role in the creation or dissemination of the work. Their business derives entirely from litigation, which courts have come to see as problematic. Yet, the law really has no firm basis on which to allow courts (and defendants) to impugn a plaintiff's reasons for initiating the infringement. See Shyamkrishna Balganesh, "The Uneasy Case Against Copyright Trolls" (2013) 86 S. Cal. L. Rev. 723.

Downloaded from https://academic.oup.com/book/39683/chapter/339678070 by Milbank Memorial Library user on 05 December 2023

for two interconnected reasons having to do with the centrality of exclusivity to the structure of intellectual property. First, as previously discussed exclusivity in intellectual property has no independent epistemic existence in the way in which it does in tangible property, where resources are rival. In other words, the fact that something is the subject of exclusivity is ordinarily incapable of being discerned for intellectual property, which is usually not the case with land and chattels. And second, the passive nature of the primary right makes the active secondary right functionally significant such that it introduces a good degree of normative continuity between the two rights.[20] Consequently, the discretionary exercise of the secondary right of redress (at the hands of the primary right-holder) in intellectual property poses a serious threat to the nature and form of exclusivity that the regime revolves around.

Each time the primary right-holder decides not to exercise the right of redress when an action obviously interferes with the zone of exclusivity defined by the primary right, it calls into question the existence and domain of such presumptive exclusivity. (Of course, it does so too—but to a lesser extent—when the right is not exercised because the right-holder has failed to detect the violation.) This is the continuity produced by the superimposition of an active right over a passive one. By failing to act to redress the incursion, the primary right-holder can be plausibly understood as abandoning the primary right as well—even if not in its entirety, at least in limited form. Thus, when a patent holder chooses not to pursue a competitor that is infringing its patent, or when a copyright owner decides not to act to redress non-commercial uses, the question that routinely arises is whether the original entitlement, that is, the primary right–duty relationship embodying the regime's idea exclusivity, continues to persist as well.

Several well-known intellectual property doctrines embody this dynamic, representative of the overbearing significance of the secondary right. In trademark law, a right-holder's "failure to police" the trademark can over time result in a finding that the mark has become generic or abandoned.[21] In other words, a failure to exercise the secondary (policing) right is treated as capable of vitiating the primary right. In copyright law, a willing forbearance from initiating an infringement action produces what some scholars have

[20] There is a sense in which the idea of continuity here builds on the "continuity thesis" developed and defended by John Gardner within the domain of corrective justice. According to Gardner, secondary obligations take their normative content ("rational echo") in significant part—though not entirely—from the primary obligation, making them continuous, but not identical. John Gardner, "What is Tort Law for? Part 1: The Place of Corrective Justice" (2011) 30 Law & Phil. 1, 28.

[21] J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition* (4th ended., Thomson Reuters 2012) § 17:8; Lanham Act of 1946, 15 USC, § 1127.

Downloaded from https://academic.oup.com/book/39683/chapter/339678070 by Milbank Memorial Library user on 05 December 2023

termed a "tolerated use."[22] Tolerated uses do not vitiate the entire primary right; but they certainly affect its scope. Patent law has been less ready to fully incorporate this dynamic.

Interestingly, none of these doctrines treat the primary and secondary rights as perfectly contiguous in the sense that a non-enforcement is seen as automatically vitiating the underlying primary right. Instead, they recognize that it casts the primary right into something of a gray area, which then has to be unraveled contextually. And intellectual property law then goes to extraordinary lengths to unravel the two when applying each of these doctrines in practice, primarily to preserve the discretion underlying the exercise of the secondary right.[23]

Given the centrality of exclusivity to intellectual property, a more efficient (and likely more effective) mechanism of avoiding the continuity dynamic between primary and secondary right would have been easy to realize—a bright line rule disaggregating the two, a bright line rule rendering the two fully contiguous, or a mechanism of public enforcement wherein the state is allowed to step in and enforce the violation of the primary right on behalf of the primary right-holder when the latter forebears. Yet, intellectual property rejects these options and tolerates the right-holder's discretion in exercising the right of redress. And my claim here is that it does so in recognition of an important normative ideal: preserving the primary right-holder's autonomy in addressing and correcting interferences with its grant of exclusivity.

An important caveat is in order here. The analytical features identified here for the secondary right of redress are far from being unique to intellectual property. Secondary rights of redress accompany a vast range of primary entitlements; indeed, intellectual property draws on their ubiquity across other areas of law in incorporating them into its functioning. All the same, what distinguishes them here is (a) their relationship to the primary right, and (b) the disproportionate influence they exert on the analytical structure of the entitlement.

The primary right-holder's power to determine the appropriate course of action for a redressal is no simple procedural/adjectival by-product of the intellectual property system. It is instead a defining feature of the area, one which grounds it in private law, a point which the next section further unbundles.

[22] Tim Wu, "Tolerated Use" (2007) 31 Colum. JL & Arts 617.

[23] Unraveling them through a fact-intensive scrutiny of the right-holder's motives and of the systemic effects of treating the primary right as vitiated.

Downloaded from https://academic.oup.com/book/39683/chapter/339678070 by Milbank Memorial Library user on 05 December 2023

III. Redressive Autonomy

While intellectual property is commonly analogized to property and tort law, the basis of that analogy is often glossed over. Instead, if one understands property and tort law to embody a common structure (of a primary directive enveloped by a secondary right of redress), the analytical basis of the similarity to intellectual property starts becoming clear. The right of redress forms an essential part of intellectual property law's analytical structure, a feature that is as old as the institution itself and one that the law has never once sought to abandon over time, even when inefficient.

But why is the right of redress so essential to intellectual property law that it has continued to maintain its existence over time and context, and refused to replace it with other mechanisms? The answer, I argue, lies in the fact that the right of redress allows intellectual property law to instantiate the ideal of personal autonomy into its functioning in a very real way. Property and contract law have come to be understood as fundamentally autonomy-enhancing owing to the levels of choice and customizability that they each offer right-holders. Property law places some limits on the ability of right-holders to customize the entitlement, but offers holders an infinite set of use privileges in relation to a resource.[24] As Hanoch Dagan and Michael Heller show in new work, contract law revolves around the foundational ideal of autonomy, by enhancing the domain of choices that people have in shaping their interpersonal arrangements.[25]

Intellectual property law does something very similar, but through the right of redress. In privileging the right-holder's choices about when, whether, and how to enforce violations of the primary right as well as the possibility that a decision to not enforce might modify the primary right, the law is recognizing and prioritizing the right-holder's power to enter into and shape a relationship through the avenue of enforcement. It might well seem odd at first to describe the plaintiff–defendant (or right-holder and infringer) arrangement as a relationship, given that only one party initiates it, often times involuntarily. Yet a closer scrutiny of the secondary right of redress in intellectual property reveals this to be less problematic than it might initially seem.

[24] The infinite nature of these privileges is what Penner describes pejoratively as the "disaggregative" view of the bundle of rights conception of property, wherein each privilege is treated as a freestanding property right. See J. E. Penner, "The 'Bundle of Rights' Picture of Property" (1996) 43 UCLA L. Rev. 711, 734.

[25] Hanoch Dagan and Michael Heller, *The Choice Theory of Contracts* (CUP 2017).

Downloaded from https://academic.oup.com/book/39683/chapter/339678070 by Milbank Memorial Library user on 05 December 2023

In reality what the secondary right of redress grants the primary right-holder is a privilege to initiate a claim to simultaneously (i) vindicate the existence of the primary right—of exclusivity, and (ii) redress its infraction through an appropriate remedy. It is not a pure power in the sense of affording its holder the ability to unilaterally alter someone else's legal status.[26] This is important, because what it does then is to initiate a mediated bilateral negotiation with the other party, during which the other party *qua* defendant will introduce arguments to challenge the existence and scope of the primary right, its putative violation, and the form of remediation sought. The *initiation* of the lawsuit is therefore no guarantee that the right will be either vindicated or enforced. And this is hardly problematic—as it might perhaps be elsewhere[27]—once we recognize that intellectual property infringement is not a moral wrong, but instead a straightforward legal wrong. Intellectual property is entirely a creation of law, such that the infraction of the exclusivity that it creates partakes of a *malum prohibitum* (i.e., wrong because it is prohibited) rather than a *malum in se* (or wrong because it is intrinsically so).[28] Consequently, there is little that is morally constraining in the exercise of the secondary right, beyond of course the general morality of law. Once we acknowledge this reality, the idea that intellectual property's secondary right (of redress) exists to enable the primary right-holder to shape and direct relationships around the primary grant of exclusivity, begins to make both analytical and normative sense. Therein emerges the commitment to redressive autonomy, which the remainder of this section fleshes out further.

A. Redressive Autonomy and its Forms in Intellectual Property

The relationship between private law and autonomy has been the subject of previous scholarly examination, most directly in the work of Hanoch Dagan.[29]

[26] For more on Hohfeldian powers, see Andrew Halpin, "The Concept of a Legal Power" (1996) 16 OJLS 129.

[27] As scholars have pointed out, this poses a problem for corrective justice theories of private law, which focus on the realization of justice (an outcome) through the private action rather than just its initiation and invocation by the right-holder. When a court decides against the primary right-holder, or when the primary right-holder withdraws the lawsuit, the principal normative objective of the regime is never realized.

[28] For a general account of the distinction, see Susan Dimock, "The Malum prohibitum—Malum in se Distinction and the Wrongfulness Constraint on Criminalization" (2016) 55 Dialogue 9.

[29] Hanoch Dagan, "Pluralism and Perfectionism in Private Law" (2012) 112 Colum. L. Rev. 1409, 1424; Hanoch Dagan, "Autonomy, Pluralism, and Contract Law Theory" (2013) 76 Law & Contemp. Probs. 19; Hanoch Dagan, "Autonomy and Pluralism in Private Law" in Andrew Gold et al. (eds.), *Oxford Handbook of the New Private Law* (OUP 2019).

Downloaded from https://academic.oup.com/book/39683/chapter/339678070 by Milbank Memorial Library user on 05 December 2023

Dagan sees in all of private law an autonomy-enhancing goal, reflected most prominently in the area's creation of power-conferring (as opposed to merely duty-creating) rules. Property law, in its emphasis on alienability, and contract law in its allowance for the creation of myriad reciprocal obligations, are seen to allow actors to realize the self-determination that is critical to the concept of autonomy.

The idea of autonomy inheres in the ability of individuals to determine the normative trajectory of their lives through a series of successive decisions over which they may legitimately claim self-authorship. Private law, in helping shape individuals' interpersonal relationships, actively facilitates this self-authorship. Yet in Dagan's view, private law's autonomy-enhancing goal finds primary instantiation in its power-conferring rules, and only secondarily in its duty-creating ones.[30]

While Dagan's argument connecting private law and autonomy is persuasive, it is not clear why the claim needs to be limited in the manner in which he does. Rights of redress are power-conferring rules (even if couched as rights), but they are fundamentally different from the ones that Dagan's argument focuses. Unlike alienability (in property) and contractual freedom, the right of redress derives its analytical and normative content from a primary right, that in turn operates through a correlative duty. Turning to intellectual property, we may go one step further and say that as a purely legal institution that often deviates from common social morality, the power-conferring right of redress exists principally to maintain the substratum of primary duties relating to exclusivity that the law erects. In other words, while the power and duty are no doubt analytically distinct in intellectual property law, it is hardly the case that they are unconnected at a normative level. To the contrary, the reasons for creating the primary duty in the first instance inform the law's creation of the secondary power (right) of redressal.

A friendly extension of Dagan's core idea entails recognizing the autonomy-enhancing function of the secondary right of redress in intellectual property. In delegating a multiplicity of choices about enforcement to the primary right-holder, often at significant cost, the law is recognizing a value inherent in that right-holder's decision to operationalize and enforce the exclusivity underlying the entitlement. That value, in turn, emerges from a fundamental belief that when and how the coercive power of the state ought to be invoked (even if not actually obtained) in aid of an individual is a matter of judgement that is personal to that individual, and which implicates a variety of subjective

[30] Dagan (n 29).

Downloaded from https://academic.oup.com/book/39683/chapter/339678070 by Milbank Memorial Library user on 05 December 2023

considerations not all of which are capable of objective rationalization. *T*'s decision to not commence an action against *I* for infringement, even if motivated exclusively by sympathy and pity, is just as worth protecting as *N*'s decision to abandon the infringement lawsuit against *I* because of a favorable settlement.

To be clear, invoking the assistance of the state via a right of redress (*N*'s decision whether to sue *I*) is fundamentally different from invoking it in the abstract through a general directive (*N*'s decision whether to claim an exclusive right in the novel to begin with). While both entail the exercise of self-authorship, they differ in important respects that implicates the notion of autonomy. Invoking the state's power to obtain a declaration of exclusivity in an intangible no doubt generates a legal relationship in so far as it imposes a duty on all others; yet it does so in the abstract and impersonally. On the other hand, invoking the coercive power of the state to try and enforce that obligation entails identifying an individual and scrutinizing that individual's actions in a way that is far more specific and inter-personal.

Both sets of choices are autonomy-enhancing in contributing to the agent's self-determination. All the same, it is only the second one—relating to redress—that is specific to intellectual property law (as opposed to the general legal system). This is more than just about boundaries and categories. In exercising the choice of whether to obtain intellectual property protection (i.e., exclusivity) for an intangible, an actor is choosing from a variety of different options afforded to him or her by the law. The freedom to so choose is therefore hardly an artifact of the inner machinations of intellectual property but rather the working of power-conferring rules in the law more generally. By contrast, in invoking the right of redress once the intangible is indeed protected, a primary right-holder is making a choice internal to intellectual property. *Internal* not in the formal (and potentially circular) sense of being afforded by intellectual property doctrine, but internal in the sense of entailing a consideration of what enforcing intellectual property law's grant of exclusivity against a particular individual will entail.

N deciding to assert and obtain copyright protection in his original novel is thus no doubt making an important decision. Here *N* chooses among multiple options: secrecy and non-dissemination, contractual protection through confidentiality, or indeed no protection at all, among others. Similarly, when *P* chooses to patent her invention, she is choosing among options: trade secret protection, contractual idea protection, or indeed no protection at all, of different options. The basis of this choice is something that the law confers on individuals more generally. This is in contrast to *N* choosing to initiate a copyright infringement action against *I*, or *P* choosing to bring a patent infringement

Downloaded from https://academic.oup.com/book/39683/chapter/339678070 by Milbank Memorial Library user on 05 December 2023

claim against *I*. In each of these choices, *N* and *P* have to grapple with what it means to allege a violation of the law's grant of exclusivity against *I*, knowing what they do about *I* and his motivations for the infringement. And that choice will in turn be presumptively driven by what it means to allege (and possibly obtain a finding of) copyright—or patent—infringement against a specifically identified individual. Intellectual property law wants *N* and *P* to make that choice even after its grant of exclusivity in the relevant intangible, recognizing the interpersonal element inherent in it.

The autonomy inherent in the decision to seek redress is an essential component of how intellectual property law operates, a reality that is often forgotten when the analysis stops at the creation and delineation of rights. That decision in intellectual property law is in turn multi-layered, with each reflecting a different component of redressive autonomy.

1. Cognizance

The idea of redress in intellectual property begins with the identification of an infraction, that is, an interference with the law's grant of exclusivity that it instantiates through the right–duty structure previously described. Unlike with tangible property and a variety of other infractions, the infringement of intellectual property is almost never self-evident. This prompted Justice Holmes to once retort that intellectual property:

> [R]estrains the spontaneity of men where but for it there would be nothing of any kind to hinder their doing as they saw fit. It is a prohibition of conduct remote from the persons or tangibles of the party having the right. It may be infringed a thousand miles from the owner and without his ever becoming aware of the wrong.[31]

This observation rings very true in so far as it notes the difficulty inherent in *detecting* an infraction of the law's grant of exclusivity. All the same the flowery rhetoric hides an additional layer of nuance. Even if and when an infraction is detected and identified, the primary right-holder (i.e., the intellectual property owner) has complete discretion over whether to take cognizance of it and treat it as an infraction. While this is of course true of all rights of redress, it is particularly salient with intellectual property because the very identification of the infraction is often cumbersome (and costly). In other words, an intellectual property owner may expend a significant amount of time, effort, and

[31] *White-Smith Music Publishing Co. v. Apollo Co.*, [1908] 209 US 1, 19 (SC).

Downloaded from https://academic.oup.com/book/39683/chapter/339678070 by Milbank Memorial Library user on 05 December 2023

resources to detect and locate infringements of the right, and then—for some or no reason—simply choose to seek redress for some, all, or none of them through the secondary right.

Put another way, intellectual property law actively delegates to the primary right-holder the decision of whether to treat an interference with its grant of exclusivity as a wrong. This is perhaps true to varying degrees of several other cause of action as well. All the same, general tort law has come to focus on what Goldberg and Zipursky call the "injury inclusive conception of wrong" wherein the injury/result sustained by a plaintiff from the defendant's conduct is critical to triggering a right of redress.[32] Intellectual property law on the other hand comes close to embodying a "pure-conduct conception of wrong"[33] wherein an actor's mere commission of an act can trigger the secondary right of redress. None of the major intellectual property regimes demand a showing of injury for a redress; to the contrary they make it available even when the defendant's conduct produces a benefit.

The point is not whether intellectual property law differs from other actions that adopt a conduct-based conception, but rather that in so doing, intellectual property law—along with these other tort actions that might adopt a similar conception—is delegating an all-important normative decision to the primary right-holder. The decision is not merely whether to commence an action for redressing a wrong, but whether to treat the defendant's conduct as legally cognizable, that is, as a wrong to begin with. When the primary right-holder decides not to seek redress for an infraction of the exclusivity (as opposed to not knowing about the infraction), that decision occupies a unique middle ground between a negation of the primary right and being a mere omission (of no normative consequence). Instead, it generates what may be best described as a *secondary immunity* in the defendant, an immunity (from liability) that is triggered by the primary right-holder's affirmative behavior. It modifies and dilutes, albeit in a very limited way, the law's directive of exclusivity (by making the right exclusive to the right-holder plus the defendant).

Another way of understanding this dynamic is through the idea of "substantive standing" drawn from the working of antitrust law and featured prominently in the work of civil recourse theorists. Substantive standing refers to the law's requirement that for conduct to be actionable it must relate to the plaintiff's injury—that is, be wrongful—in a very particular way. Most areas of law recognize that creating a mechanism of civil redress embodies a requirement

[32] Goldberg and Zipursky, "Torts as Wrongs" (n 17) 935.
[33] Ibid.

Downloaded from https://academic.oup.com/book/39683/chapter/339678070 by Milbank Memorial Library user on 05 December 2023

of substantive standing. Intellectual property law is singularly vague about its requirement of substantive standing. The defendant's conduct is deemed actionable the moment it violates the directive of exclusivity granted to the primary right-holder. The plaintiff need merely be the holder of the primary right, which is the closest we get to its substantive standing.[34] But if that is all there is in intellectual property law's conception of substantive standing, we can begin to appreciate the broad latitude that it affords the primary right-holder in defining the existence of a wrong that merits redress. We will return to this point later in this essay.

In short, the primary right-holder in intellectual property is vested with the unilateral power to decide whether the defendant's conduct constitutes a legal wrong, even when it meets the law's formal requirements of an infringement.

2. Initiation and Termination

Once the primary right-holder has identified an infraction of the exclusivity as a wrong and decided to pursue an avenue of redress against the putative infringer, intellectual property law does not delineate a well-defined avenue for the right-holder to pursue. Here again, the law defers quite significantly to the right-holder's choices.

To begin with, the right-holder need not commence the action right away but may choose to instead initiate a negotiation in the shadow of the potential exercise of this right. In other words, the law contemplates the right of redress being actively used as a bargaining device without a direct invocation of the state's coercive power. Then, out of deference to the right-holder's will, the law allows the right-holder to wait as long as he/she wants to initiate the action, subject of course to the statute of limitations.[35] But within that period, intellectual property law has stood relatively firm that the right-holder's reasons to delay commencing the infringement action is not open to scrutiny. The primary right-holder may thus wait until he/she is ready—a purely subjective determination—to commence the lawsuit and the court is obligated to respect

[34] One might see a similar problem with causes of action relating to tangible property as well. According to civil recourse theory, the substantive standing for such actions is the "possessory interest" that the plaintiff must establish as a precondition of the redress. Benjamin C. Zipursky, "Substantive Standing, Civil Recourse, and Corrective Justice" (2011) 39 Fla. St. L. Rev. 299, 304. This comes close to the conception suggested here, except that the possessory interest might be seen as a stand-in for an actual or likely dispossession or possessory interference, injuries that have an epistemic existence. This would not be the case for a rule of substantive standing that did nothing more than ask if the plaintiff was the right-holder—either as original grantee or a transferee of the right.

[35] The equitable defense of "laches," wherein courts examine the motives for a plaintiff's delay in commencing an action even within the formal statute of limitations, is thus taken off the table.

Downloaded from https://academic.oup.com/book/39683/chapter/339678070 by Milbank Memorial Library user on 05 December 2023

that decision.[36] Finally, at just about any time after commencement and for any reason, the right-holder is allowed to terminate the lawsuit and the chosen avenue of redress. When this occurs, it is treated as the equivalent of the right-holder never having exercised the right of redress and taken cognizance of the infraction.

At each of these points in the exercise of the secondary right of redress, intellectual property law enables the right-holder to commandeer the mere availability of the state's coercive power toward a desired result. It is crucial to note (again) that the law does not guarantee the deployment of its coercive power in the form desired by the right-holder. However, it is perfectly fine with the probabilistic availability of that power forming the basis of the right-holder's engagement with the defendant.

By making available to the right-holder a set of unrestricted entry and exit points related to redress, intellectual property law affords the plaintiff (right-holder) a vast amount of discretion over shaping the invocation of the state's coercive power. The non-automaticity of the state's intervention and the discretion vested in the right-holder over it, both evince a commitment to a non-dogmatic conception of redress, one where the primary right-holder is free to use the right of redress to shape and direct his or her interpersonal interactions as they relate to the intangible involved.

3. Remediation

The final and perhaps most consequential domain in the right of redress where intellectual property law affords the right-holder significant discretion lies in the choice of remedy underlying the redress. Paralleling the multiple motives and rationales that a primary right-holder might have in seeking to redress an infraction of the right, the law offers plaintiffs a fairly long menu of choices and mechanisms to remediate the infraction, if indeed that is what the right-holder seeks. These remedies range from the usual—damages and injunctive relief—to the more complex, seizure/destruction of infringing articles, obtaining attorney's fees and legal costs, and other one-off remedies that the court (in consultation with the plaintiff) sees fit.[37]

Beyond giving the plaintiff a great degree of choice during the actual proceedings, the extensive menu of remedial options that the law provides right-holders with serves the additional function of supporting and reinforcing

[36] *Petrella v. Metro-Goldwyn-Mayer, Inc.*, [2014] 134 S. Ct. 1962 (SC); *SCA Hygiene v. First Quality Baby Products*, (2017) 137 S. Ct. 954.

[37] For an overview, see Terence Ross, *Intellectual Property Law: Damages and Remedies* (Lexis Nexis 2000).

Downloaded from https://academic.oup.com/book/39683/chapter/339678070 by Milbank Memorial Library user on 05 December 2023

any form of connection (or lack thereof) between the parties that the plaintiff may well seek. A more limited choice would have served as a blunt edged instrument, limiting the right-holder's ability to use the redress as an avenue of negotiation.

A remedial "choice" that is routinely ignored in discussions of intellectual property is indeed the decision to not obtain a formal remedy as such. Interestingly, this is not an actual choice that intellectual property statutes delineate. Rather, it emerges through a combination of the right-holder's power to terminate the action at any stage and the procedure that courts often follow in intellectual property adjudications. In a bifurcated trial, the court commonly separates its adjudication on the existence of the right and its violation on the one hand, from its calculation of damages or award of other remedy on the other, once a violation has been found. Consequently, a right-holder/plaintiff is able to terminate the action once the first stage has ended, which would in effect do no more than vindicate the existence of the right and its infraction by the defendant's actions. Again, this produces an important dynamic for the primary right-holder to shape various relationships around the intangible at issue, and forms an important choice that the law makes available.

* * *

Redressive autonomy thus manifests itself as an important element at multiple stages in the potential exercise of the law's right of redress. The key to appreciating its significance lies in recognizing that as a *power* to initiate the state's role in affirming its primary grant, it enables the primary right-holder to make a series of important self-defining decisions relating to the intangible subject matter involved. At issue is thus the *right of* redress rather than redress as such, and it is in that difference that law embodies its commitment to autonomy by emphasizing the primacy of the right-holder's will in shaping, directing, and utilizing the *right* interpersonally.

B. Redress and Harm in Intellectual Property

An issue of significant debate in intellectual property thinking is its conception of *harm*, and the normative characteristic of the particular interest that triggers the right of redress. We have thus far characterized that interest in principally analytical terms as a violation of the law's grant of exclusivity. Yet, that incursion on the exclusivity is capable of being understood as driven by a variety of different normative considerations.

Downloaded from https://academic.oup.com/book/39683/chapter/339678070 by Milbank Memorial Library user on 05 December 2023

To the economically minded, the law's grant of exclusivity is a market-based grant wherein intellectual property is seen to carve out a domain of market exclusivity for the intangible, and incursions upon that exclusivity are rendered actionable because of the actual or potential market harm that is produces.[38] To Kantian thinkers (at least within copyright), violations of the exclusivity are problematic not for market reasons, but instead because it interferes with the communicative freedom of the primary right-holder, that is, the creator.[39] Both perspectives have continued to subsist within intellectual property's common law analytical structure, resulting in many scholars concluding that intellectual property has an incoherent—or at best, underdeveloped—conception of harm that it relies on.

Much of the confusion in this debate emerges from the obvious imprecision underlying the use of "harm" as an idea. On the one hand, it is used to signify the damage (or loss) that is seen as essential to trigger actionability in some forms of tort (e.g., negligence); while on the other, it is treated as equivalent to the notion of "injury," seen as a relationally constructed trigger that specifically empowers the plaintiff's right of redress. The latter has long been considered crucial to the law (*injuria sine damno*) while the former is seen as normatively irrelevant in certain contexts when unaccompanied by an injury (*damnum absque injuria*).[40]

The damage conception of harm has often been seen as irrelevant within intellectual property, with the recognition that infringement is for the most part a "strict liability" action.[41] Conceding the obvious equivocation underlying that term, the point is that infringement actions are never dependent on a plaintiff's assertion of any loss, economic or otherwise. Conduct that generates a particular result is enough to trigger the action.[42] Consequently, the incoherence is usually ascribed to copyright's conception of injury, which is described in either economic or deontic terms.

Ironically, both conceptions of intellectual property injury suffer from serious flaws. Neither adequately explains the full gamut of intellectual property law's functioning. A large swath of intellectual property infringement claims

[38] See generally William M. Landes and Richard A. Posner, *The Economic Structure of Intellectual Property Law* (2d ed. HUP 2003).

[39] See Abraham Drassinower, *What's Wrong with Copying?* (HUP 2015); Anne Barron, "Kant, Copyright, and Communicative Freedom" (2012) 31 Law & Phil. 1.

[40] See Herbert Broom, *Commentaries on the Common Law* (4th ed. 1873) 75–77 (discussing the distinction and its application in the common law).

[41] Shyamkrishna Balganesh, "The Obligatory Structure of Copyright Law" (2012) 125 Harv. L. Rev. 1664, 1682; Patrick R. Goold, "Is Copyright Infringement a Strict Liability Tort?" (2015) 30 Berkeley Tech. LJ 305.

[42] Balganesh (n 41) 1682.

Downloaded from https://academic.oup.com/book/39683/chapter/339678070 by Milbank Memorial Library user on 05 December 2023

are brought with absolutely no economic motivation behind them, or relating to the underlying work itself. Similarly, it is hard to identify violations of communicative freedom for intellectual property claims beyond a narrow domain of copyright infringement claims, and even within copyright the expansion of protectable subject matter (e.g., software) has resulted in this grounding becoming even more tenuous. Focusing on the role of redress (and redressive autonomy therein) within intellectual property law offers a firmer basis to make sense of these competing conceptions of injury.

As traditionally understood, the concept of "redress" stands for the setting right of a wrong, a distinctively remedial notion. Underlying this traditional understanding is therefore the intuition that a form or avenue of redress emerges once there is a wrong, which is in turn a violation of a right. Indeed this is what makes redress a "secondary" right/power, as previously discussed. The analytical scheme of right-wrong-redress (or recourse) is thus the traditional way of understanding how redress functions. All the same, it is not the only way of understanding the idea of redress.

To the late Peter Birks, the connections between right and wrong on the one hand, and wrong and redress (or "remedy" as he put it) were hardly uncontroversial.[43] As he argued, the usual sequence failed to capture the working of specific performance in contract law, but more importantly also the fundamental structure of unjust enrichment and some "proprietary rights." In these situations ("not-wrongs"), Birks argued that a set of factual circumstances generated a right that on its own enabled its holder to invoke the machinery of the state (i.e., the courts) without needing to identify a wrong, strictly speaking. The plaintiff, in Birks' words, is standing on the primary right in court—no more, no less.[44]

Birks' model does not of course carry over seamlessly to intellectual property law, where the law clearly delineates a primary right in structuring its grant of exclusivity. Yet his model identifies the possibility of a natural continuum between the primary right and redress that obviates the necessity of identifying a "wrong" under all circumstances. In other words, when an intellectual property plaintiff approaches a court (i.e., seeks redress) in an infringement action, it is plausible to analyze that situation as the plaintiff's attempt to vindicate the primary right—of exclusivity—which is functionally meaningless without the state's intervention. Just as the situation of a mistaken payment for money, the paradigmatic case for unjust enrichment, triggers an avenue of

[43] Peter Birks, "Rights, Wrongs, and Remedies" (2000) 20 OJLS 1.
[44] Ibid. 28–29.

Downloaded from https://academic.oup.com/book/39683/chapter/339678070 by Milbank Memorial Library user on 05 December 2023

redress independent of a wrong (but nevertheless dependent on a primary entitlement to the said money), a putative intellectual property defendant's actions can be understood as triggering an avenue of redress, wherein the plaintiff is asking the court to make good on the law's initial grant of exclusivity. In this "not-wrong" mode of analysis, the defendant's actions need not be seen as a wrong, nor as an independent basis of liability *until* the redress is triggered by the plaintiff.

The not-wrong conception of intellectual property law is not as far-fetched as it may initially seem. In all of intellectual property, the law merely makes a grant of exclusivity to an identified claimant. The law itself says nothing of correlative obligations, which have been analytically derived from the initially grant. If the exclusive right is instead understood as an "exclusive privilege," the correlative of which is merely a no-right (in that no one has a right to stop the exclusive use of the intangible), the idea of a duty recedes in importance.[45] In this scenario, an infringement claim (the redress) is little more than an attempted direct enforcement of the exclusivity underlying the privilege rather than a corrective for a wrong.

This not-wrong conception is indeed far removed from our traditional understanding of intellectual property infringement as a wrong. All the same, Birks' formulation of the problem highlights how the idea of "redress" is capable of being unmoored from a purely corrective/remedial understanding of the term that is related to a wrong, which is in turn dependent on an underlying normative rationale. It represents not just the remediation of a wrong, but also the enforcement of a right and while the two may ordinarily go together they need not always do so. Alternatively, they may go together through the mere pairing—by legal declaration or implication—of the two. It is this latter category that constitutes a purely "legal wrong," wherein something is a wrong merely because it is treated by the law as a violation of an analytically prior right, no more and no less.

The last point bears emphasis, for it suggests that the law's construction of a wrong while analytically crucial to the structure of a regime, may nevertheless be devoid of independent normative content. Or put another way, the "wrong" in the right-wrong-redress formulation when applied to intellectual property law is a mere connector of sorts.[46]

[45] Hohfeld (n 7) 34–36.

[46] A strong parallel to the idea of a "connector" is to be seen in Birks' criticism of Kit Barker's position on unjust enrichment, which refuses to accept the idea of direct enforcement. Barker instead argues that even if the set of facts that trigger a potential claim of unjust enrichment do not qualify as a wrong, they nevertheless constitute a "primary injustice," which the law then attempts to redress through a

Downloaded from https://academic.oup.com/book/39683/chapter/339678070 by Milbank Memorial Library user on 05 December 2023

This in turn brings us back to the conflicting normative criteria that are thought to underlie the idea of an intellectual property infringement. The legal injury underlying the wrong of an infringement—its wrongfulness or "substantive standing" so to speak—is purposely undertheorized by the law. The putative infraction of the right, that is, the defendant's conduct, automatically triggers the availability of an avenue of redress without there needing to be any direct connection to the plaintiff, beyond the latter being the grantee of the state's promise of exclusivity, or an assignee thereof. This underdeveloped conception of injury is neither a sign of the law's incoherence nor an unresolved mystery. It is instead best understood as intellectual property law's fundamental commitment to a form of normative pluralism. By refusing to specify the circumstances under which a right-holder is injured, the law allows the right-holder to examine the nature and consequences of a defendant's conduct and decide whether they merit the invocation of the redress for reasons specific and subjective to the right-holder. And those reasons might in turn be consequentialist/economic, purely moral, or indeed firmly idiosyncratic and incapable of classification.

The key is thus that intellectual property law embeds its conception of legal injury behind a firm commitment to the right-holder's autonomy. Very importantly, this is not the same as suggesting that its understanding of injury inheres in a negation of the right-holder's autonomy, as is frequently done for real property. The autonomy at issue is not the autonomy inhering in the exercise of the primary right or a set of use privileges surrounding the protected resource. It is instead an autonomy embedded within the right of redress, which empowers the right-holder to choose among potentially competing (and incommensurable) normative values, in invoking the coercive power of the state.[47]

Redressive autonomy thus goes beyond just explaining the enforcement framework surrounding intellectual property law. It additionally helps make sense of intellectual property law's concept of harm and injury, and the rather unique structure of the infringement action, which focuses almost entirely on the defendant's conduct to the exclusion of its effect on the plaintiff.

secondary right. As Birks forcefully points out, this recharacterization does little to add content to the initial set of triggering facts. Birks (n 43) 29–30.

[47] For a similar point about the value pluralism inherent in recognizing the autonomy of agents to make their own decisions, see Dagan, "Pluralism and Perfectionism in Private Law" (n 29) 1423–24.

Downloaded from https://academic.oup.com/book/39683/chapter/339678070 by Milbank Memorial Library user on 05 December 2023

C. Redressive Autonomy and Private Law

The idea of redress underlying intellectual property law is hardly unique to that area. To the contrary, it is a staple of almost all private law institutions with important variations, a point that has been forcefully made by civil recourse theory.[48] According to civil recourse theory, private law operates by providing actors with an avenue of private recourse—to invoke the coercive power of the state—for violations of wrongs. Each of contract law, property law, tort law, and the law of unjust enrichment operate by providing a private (as opposed to state/public) right-holder with an avenue of redress for either the remediation of a wrong, or the enforcement of a primary right.

With subtle variations, all forms of private redress embody a conception of autonomy that is in large measure identical to the one described herein as contained within the working of intellectual property law. They each afford a primary right-holder a mechanism by which to invoke the coercive power of the state to enforce a primary right or remedy a wrong. And in so doing, they allow the right-holder to make important normative decisions about deploying the mechanism that are entirely personal and originate from the individual motivations and desires of the right-holder, subjective and of questionable rationality as they may be. Underlying much—if not all—of private law is therefore a core commitment to redressive autonomy.

In important new work, Andrew Gold has attempted to show that civil recourse theory embodies a form of justice that is distinct from corrective justice, which he describes as "redressive justice."[49] The distinctiveness of redressive justice lies in its focus on the actions of the right-holder rather than the duty-holder in correcting ("allocating back") the wrong.[50] In this conception, the court is acting as the agent of the right-holder rather than on behalf of the wrongdoer. In expounding the theory behind redressive justice, Gold alludes to a crucial aspect underlying the salience of the focus on the right-holder: the importance of "authorship."[51] The reason why a focus on the right-holder rather than the duty-bearer/wrong-doer matters is because it recognizes the authorship of the right-holder in initiating the claim of redress and invoking the state's power to that end. This authorship of action is morally significant in that it shapes the individual's (i.e., right-holder's) self-identity, or put another

[48] See Benjamin C. Zipursky, "Philosophy of Private Law" in Jules Coleman and Scott Shapiro (eds.), *The Oxford Handbook of Jurisprudence and Philosophy of Law* (OUP 2002) 623.
[49] Andrew S. Gold, "A Theory of Redressive Justice" (2014) 64 UTLJ 159.
[50] Ibid. 184–86.
[51] Ibid. 192–95.

Downloaded from https://academic.oup.com/book/39683/chapter/339678070 by Milbank Memorial Library user on 05 December 2023

way, it recognizes the autonomy of the right-holder. Redressive autonomy is therefore a critical aspect of redressive justice, both of which emanate rather seamlessly from the civil recourse theory of private law.

In short then, redressive autonomy may be understood as a *sine qua non* of private law. To characterize or classify a body of law as private law is to recognize the centrality of a private mechanism of redress being afforded by that body to an individual right-holder, with minimal constraints on the invocation, exercise, and use of that mechanism. We now hopefully begin to see how and why intellectual property law is legitimately and firmly a body of private law, despite numerous public-regarding ideals and normative goals being ascribed to it. By rooting the idea of private law in the autonomy accompanying the private right of redress, we also are able to disengage private law from its exclusive focus on the common law (judge-made law), since private forms of redress are not the sole prerogative of the common law but may instead be developed and created by legislation as well.[52]

Once we accept the idea that private redress and redressive autonomy are indeed core features of any private law institution, we encounter the obvious problem of determining when and how an area of law is to be characterized as a body of private law. This exercise may indeed encounter the obvious preliminary question: what really turns on this classification? The answer to that question is that identifying (and characterizing) an area as a branch of private law results in its mechanism of redress being seen as non-contingent and imparting an additional set of normative ideals into the functioning of the institution. This requires further elaboration.

An emergent trend in recent public law scholarship has been the use of the idea of a "private attorney general."[53] The term refers to situations where (a) a legal regime—usually statutory—is constructed around a particular set of policy-focused goals, then (b) in order to realize those goals, the regime creates a private cause of action, wherein (c) it identifies a primary right and empowers private individuals to invoke the state's power for infractions of that right. In this construction, the private individual and the private cause of action created are treated as mere mechanisms chosen by the law from a multitude of options, to realize its ultimate policy goals.[54] In other words, they contribute nothing

[52] See Shyamkrishna Balganesh, "Private Law Statutory Interpretation" (2019) 93 S. Cal. L. Rev. 949.

[53] Trevor W. Morrison, "Private Attorneys General and the First Amendment" (2005) 103 Mich. L. Rev. 589.

[54] This approach to analysis is particularly prominent in legal literature influence by political science. For recent work in this direction, see Sean Farhang, *The Litigation State: Public Regulation and Private Lawsuits in the U.S.* (Princeton UP 2010); Robert Kagan, *Adversarial Legalism: The American Way of Law* (HUP 2003).

Downloaded from https://academic.oup.com/book/39683/chapter/339678070 by Milbank Memorial Library user on 05 December 2023

on their own to the normative basis of the institution involved. The state "commandeers" private individuals in furtherance of its public goals; and these individuals are private attorneys general.[55] One famous public law scholar put the point most directly, when he described them as "non-Hohfeldian plaintiffs," suggesting that they were triggering a mechanism of redress purely to vindicate/enforce a public interest rather than one in which they had a personal stake.[56]

The federal anti-discrimination statute (Title VII) is taken as a prime example of this approach.[57] The state is seen to have constructed a regime that is driven by public-regarding goals and thereafter created a set of carrots and sticks for private individuals to realize those goals via litigation. In quite literally treating private actors as pawns in this overall framework, the model altogether disregards the vast amount of control and authorship that litigants have over the claim, which is in turn driven by considerations of interpersonal morality. Redressive autonomy is the conceptual anti-thesis of the private attorney general idea.

The private attorney general model readily presumes that the statutory origin of an area of law infuses it with collectivist goals, which renders it a body of public law regardless of the substance of the rights and duties created. Yet, creating a mechanism of private redress and delegating normatively salient decisions to a right-holder introduce important private-regarding considerations into the regime, all of which emanate from the autonomous nature of the individual making decisions. The decision whether to treat an action as discriminatory *and* do so publicly through a mechanism of private redress is a deeply interpersonal one, inevitably driven by subjective considerations that the law is perfectly fine with countenancing.[58] The idea of a private attorney general eliminates this nuance.

Now, this is not to suggest that statutory regimes with private enforcement mechanisms ought to be treated as pure private law areas where public-regarding goals have no influence whatsoever. The choice need not be a purely binary one. Instead, it is sufficient if the analysis recognizes that normative role that a mechanism of private redress plays in the structuring of a regime, and the unique interpersonal values and goals that it introduces into the law.

[55] Hanoch Dagan and Avihay Dorfman, "Just Relationships" (2016) 116 Colum. L. Rev. 1395, 1430.

[56] Louis L. Jaffe, "The Citizen as Litigant in Public Actions: The Non-Hohfeldian or Ideological Plaintiff" (1968) 116 U. Pa. L. Rev. 1033.

[57] For an early example, see Robert J. Affeldt, "Title VII in the Federal Courts—Private or Public Law" (1969) 14 Villanova L. Rev. 664. See also Farhang (n 54) 85.

[58] See Sophia Moreau, "What is Discrimination?" (2010) 38 Phil. & Pub. Affs. 143; Dagan and Dorfman (n 55) 1423 n 125.

Downloaded from https://academic.oup.com/book/39683/chapter/339678070 by Milbank Memorial Library user on 05 December 2023

IV. Conclusion

Redressive autonomy is an integral part of private law. While private law does affirm a plurality of normative considerations, its commitment to a form of personal autonomy undergirding the mechanism of private redress has remained steadfast. In delegating to individuals the decision of *whether*, *when*, *how*, and *against whom* to invoke the state's coercive power in recognizing and enforcing a primary right, private law recognizes the connection between this power and the ability to shape one's interpersonal relationships, in turn a critical part of individual self-identity. The decision is in turn a deeply normative one, since it embodies a preliminary determination of whether a primary right exists and has indeed been violated by the defendant's conduct.

Intellectual property law is structured around the mechanism of private redress, which holds its basic framework of exclusivity together. Perhaps more so than several other areas of law, the redressive autonomy undergirding intellectual property is functionally significant to the very existence of the institution, given the oddities of the subject matter at issue. Redress and redressive autonomy are thus constitutive of the law's very construction of intellectual property, a reality that is often ignored in incomplete attempts to analogize the area to other doctrines, and in the innumerable attempts to construct grand explanatory/justificatory theories for its existence.

Recognizing the role of redressive autonomy in intellectual property should serve to emphasize its fundamental roots in private law. Modern analyses of the subject have overlooked these roots and instead treated it as little more than a regulatory mechanism, with its analytical structure coming to be seen as altogether contingent and adding nothing of normative significance. Discussions of the subject would be well advised to reconsider this myopia.

Downloaded from https://academic.oup.com/book/39683/chapter/339678070 by Milbank Memorial Library user on 05 December 2023