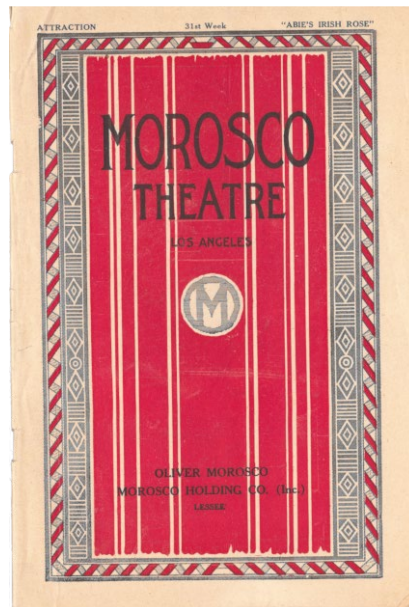


INTELLECTUAL PROPERTY SURVEYOR

IP Surveyor

Volume: Copyright

VERSION 1.0
MUSEUM EDITION



An open casebook anthology
compiled and edited by Eric E. Johnson



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Intellectual Property

Surveyor

Volume: Copyright

VERSION 1.02

MUSEUM EDITION

an open casebook anthology

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–EEJ

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Chapter C-1: Copyrightable Subject Matter: Fixation, Authorship, Originality, Creativity, and the Fact/Expression Dichotomy

This chapter was made in its current form by Eric E. Johnson by starting with Chapter 3, “Copyrightable subject matter and the requirements of originality and fixation,” of *Introduction To Intellectual Property Cases and Questions Fall 2021 Edition* authored by **Jason Rantanen**, and then changing some things and adding substantial material. Please see “Rights, Licensing, Attribution, Disclaimers, and More” at the end of this chapter.

Prof. EEJ’s notes on copyrightable subject matter

This chapter and the next concern what can be embraced within the exclusive privilege of copyright. In other words, these chapters concern what is *copyrightable subject matter*.

Stated differently, this chapter and the next concern the answer to the question laypersons often phrase as, “Can that be copyrighted?” But please don’t phrase the question like that yourself. There’s a whole slew of problems that come with using “copyright” as a verb. (Also the verb usage will make you

sound like you don't know what you're talking about.) Now, I appreciate that the adjective "copyrightable" makes it sound like you can use "copyright" as a verb – after all, it seems sensible to think "copyrightable" must mean "capable of being copyrighted." But the word "copyrightable," as used by courts and lawyers, does not imply the possibility of undertaking some action; instead, it just means "capable of being subject to an exclusive right of copyright law."

Okay, let's move on to talk about another point that's both semantics and substance. The most important word—and the most important concept—with regard to copyright subject matter is "expression." For something to be potentially copyrightable, it's got to be *expression*.

What are some things that are expression? Essays. Oil paintings. Poems. Choreography. Musical compositions. Speeches. Those things are potentially copyrightable.

What are some things that are not expression? Ideas. Facts. Words. Short phrases. Alphanumeric characters. Systems. Methods of operation. Procedures. Those things aren't copyrightable.

Here's a good question: What's the difference between facts and expression? Distinguishing between the two is frequently called the "fact/expression dichotomy," and fleshing that out has been the subject of important case law. The most important case explaining the concept is *Feist v. Rural* (U.S. 1991). That case is reproduced in this chapter.

And how about the difference between ideas and expression? Another good question. That's frequently called the "idea/expression dichotomy," and figuring that out has been the subject of crucial case law as well. The divide between ideas and expression will be tackled in the next chapter, and that chapter includes the most important case on the idea/expression dichotomy, *Baker v. Selden* (U.S. 1879).

The concept of expression is crucial to understanding what's copyrightable. But something being expression is not enough. More is required.

For something to be copyrightable, it must be an "original work[] of authorship fixed in [a] tangible medium of expression[.]" That's from 17 U.S.C. § 102. From just that statutory phrase, you can see from that for

something to fall within copyright subject matter, it must be original, a work of authorship, and fixed in a tangible medium.

Courts and commentators frequently speak about those three things as independent requirements. And I'd agree that's a useful way to approach it from an analytical perspective. But there's a sense in which those three requirements—along with the concepts of creativity and expression, including the distinguishing of expression from ideas and facts—are all just tools for describing a singular, unified, underlying concept of what can qualify as copyrightable subject matter.

It's helpful to think about the stakes. What we are getting at here is what the law is going to allow to be the exclusive domain of one person (as their "intellectual property") and what's going to be left open and unfenced for humanity at large. And consider that a copyright lasts for about 100 years. If the law draws the line in the wrong place, it will really screw things up, frustrating everyone's ability to innovate, to communicate, to learn—and even to think clearly.

Now, if it is true that there's a deep, unifying concept at work with copyrightable subject matter, then it would be helpful for us to tackle all of the subtopics of copyrightable subject matter together in just one chapter. Unfortunately, however, that's just too much to bite off. So this chapter concentrates on fixation, authorship, originality, creativity, and the fact/expression dichotomy. The next chapter focuses on the idea/expression dichotomy.

Copyright Office on fixation

from Compendium of the U.S. Copyright Office Practices, Third Edition, §305

The Fixation Requirement

To be copyrightable, a work of authorship must be "fixed in any tangible medium of expression, now known or later developed, from which [it] can be perceived, reproduced, or otherwise communicated, either directly or indirectly with the aid of a machine or device." 17 U.S.C. § 102(a). Specifically, the work must be fixed in a copy or phonorecord "by or under the authority of the author" and the work must be "sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration." 17 U.S.C. § 101 (definition of "fixed").

The terms “copy” and “phonorecord” are very broad. They cover “all of the material objects in which copyrightable works are capable of being fixed,” H.R. REP. NO. 94-1476, at 53 (1976), *reprinted in* 1976 U.S.C.C.A.N 5659, 5666.[footnote omitted]

- Copies are “material objects, other than phonorecords, in which a work is fixed by any method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device,” including the material object “in which the work is first fixed.” 17 U.S.C. § 101.

- Phonorecords are “material objects in which sounds, other than those accompanying a motion picture or other audiovisual work, are fixed by any method now known or later developed, and from which the sounds can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device,” including “the material object in which the sounds are first fixed.” 17 U.S.C. § 101.

There are countless ways that a work may be fixed in a copy or phonorecord and “it makes no difference what the form, manner, or medium of fixation may be.” H.R. REP. NO. 94-1476, at 52 (1976), *reprinted in* 1976 U.S.C.C.A.N. at 5666. For example, a work may be expressed in “words, numbers, notes, sounds, pictures, or any other graphic or symbolic indicia” and the author’s expression may be fixed “in a physical object in written, printed, photographic, sculptural, punched, magnetic, or any other stable form.” *Id.*

Most works are fixed by their very nature, such as an article printed on paper, a song recorded in a digital audio file, a sculpture rendered in bronze, a screenplay saved in a data file, or an audiovisual work captured on film. Nevertheless, some works of authorship may not satisfy the fixation requirement, such as an improvisational speech, sketch, dance, or other performance that is not recorded in a tangible medium of expression. Other works may be temporarily embodied in a tangible form, but may not be sufficiently permanent or stable to warrant copyright protection, such as “purely evanescent or transient reproductions such as those projected briefly on a screen, shown electronically on a television,... or captured momentarily in the memory of a computer.” H.R. REP. NO. 94-1476, at 53 (1976), *reprinted in* 1976 U.S.C.C.A.N. at 5666 (internal quotations marks omitted).

The Office rarely encounters works that do not satisfy the fixation requirement because the Office requires applicants to submit copies or phonorecords that contain a visually or aurally perceptible copy of the work. However, the Office may communicate with the applicant or may refuse registration if the work or the medium of expression only exists for a transitory period of time, if the work or the medium is constantly changing, or if the medium does not allow the specific elements of the work to be perceived, reproduced, or otherwise communicated in a consistent and uniform manner.

Copyright Office on authorship

from Compendium of the U.S. Copyright Office Practices, Third Edition, §306

The Human Authorship Requirement

The U.S. Copyright Office will register an original work of authorship, provided that the work was created by a human being.

The copyright law only protects “the fruits of intellectual labor” that “are founded in the creative powers of the mind.” *Trade-Mark Cases*, 100 U.S. 82, 94 (1879). Because copyright law is limited to “original intellectual conceptions of the author,” the Office will refuse to register a claim if it determines that a human being did not create the work. *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884).

Copyright Office on originality

from Compendium of the U.S. Copyright Office Practices, Third Edition, §308

The Originality Requirement

Originality is “the bedrock principle of copyright” and “the very premise of copyright law.” *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*, 499 U.S. 340, 347 (1991) (citation omitted).

“To qualify for copyright protection, a work must be original to the author,” which means that the work must be “independently created by the author” and it must possess “at least some minimal degree of creativity.” *Id.* at 345 (citations omitted).

Copyright Office on creativity

from Compendium of the U.S. Copyright Office Practices, Third Edition, §308.2

Creativity

A work of authorship must possess “some minimal degree of creativity” to sustain a copyright claim. *Feist*, 499 U.S. at 358, 362 (citation omitted).

“[T]he requisite level of creativity is extremely low.” Even a “slight amount” of creative expression will suffice. “The vast majority of works make the grade quite easily, as they possess some creative spark, ‘no matter how crude, humble or obvious it might be.’” *Id.* at 346 (citation omitted).

An author’s expression does not need to “be presented in an innovative or surprising way,” but it “cannot be so mechanical or routine as to require no creativity whatsoever.” A work that is “entirely typical,” “garden-variety,” or “devoid of even the slightest traces of creativity” does not satisfy the originality requirement. *Feist*, 499 U.S. at 362. “[T]here is nothing remotely creative” about a work that merely reflects “an age-old practice, firmly rooted in tradition and so commonplace that it has come to be expected as a matter of course.” *Id.* at 363. Likewise, a work “does not possess the minimal creative spark required by the Copyright Act” if the author’s expression is “obvious” or “practically inevitable.” *Id.* at 363.

Although the creativity standard is low, it is not limitless. *Id.* at 362. “There remains a narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent. Such works are incapable of sustaining a valid copyright.” *Id.* at 359 (citations omitted).

Copyright Office on names, titles, short phrases, typeface, fonts, and lettering

from Circular 33: Works Not Protected by Copyright, revised 03/2021

Names, Titles, Short Phrases

Words and short phrases, such as names, titles, and slogans, are uncopyrightable because they contain an insufficient amount of authorship. The Office will not register individual words or brief combinations of words, even if the word or short phrase is novel, distinctive, or lends itself to a play on words.

C-1: COPYRIGHTABLE SUBJECT MATTER: FIXATION, AUTHORSHIP, ORIGINALITY,
CREATIVITY, AND THE FACT/EXPRESSION DICHOTOMY

Examples of names, titles, or short phrases that do not contain a sufficient amount of creativity to support a claim in copyright include

- The name of an individual (including pseudonyms, pen names, or stage names)
- The title or subtitle of a work, such as a book, a song, or a pictorial, graphic, or sculptural work
- The name of a business or organization
- The name of a band or performing group
- The name of a product or service
- A domain name or URL
- The name of a character
- Catchwords or catchphrases
- Mottos, slogans, or other short expressions

Under certain circumstances, names, titles, or short phrases may be protectable under federal or state trademark laws. For information about trademark laws, visit the U.S. Patent and Trademark Office website or call 1-800-786-9199.

Typeface, Fonts, and Lettering

Copyright law does not protect typeface or mere variations of typographical ornamentation or lettering. A typeface is a set of letters, numbers, or other characters with repeating design elements that is intended to be used in composing text or other combinations of characters, including calligraphy. Generally, typeface, fonts, and lettering are building blocks of expression that are used to create works of authorship. The Office cannot register a claim to copyright in typeface or mere variations of typographic ornamentation or lettering, regardless of whether the typeface is commonly used or unique. There are some very limited cases where the Office may register some types of typeface, typefont, lettering, or calligraphy. For more information, see chapter 900, section 906.4 of the Compendium. To register copyrightable content, you should describe the surface decoration or other ornamentation and should explain how it is separable from the typeface characters.

Notes from Prof. Rantanen

A fundamental question in intellectual property law is whether the subject matter over which a legal right is being asserted is the kind of stuff that is within the scope of a given intellectual property right. This question matters because it effectuates a policy decision that a given legal right will only apply to certain types of human-created intangibles. *Feist v. Rural* exemplifies this issue. It involves a claim of copyright infringement over a telephone directory—or, at least, the contents of that directory.

To understand the issue of subject matter and the problem posed in *Feist v. Rural*, you will first necessary to have a background knowledge of the relevant provisions of the Copyright Act.~

Then, as you read this opinion, ask yourself the following questions:

- What underlying policies are at play in this opinion? How do those policies manifest themselves in the law?
- What is the primary legal issue in this case? How and why does the Court draw the line that it does?
- Based on this opinion, how would you determine whether something is or is not subject to copyright?
- Would the outcome of this case be the same if it involved a directory of businesses that was organized by business type instead of alphabetically (i.e.: a “yellow pages”)? What if businesses had to pay to be included in that directory?
- What is meant by “thin” copyright protection?

Relevant statutes to read regarding copyrightable subject matter

17 U.S.C. §101. Definitions (2010)

...

A “collective work” is a work, such as a periodical issue, anthology, or encyclopedia, in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole.

...

C-1: COPYRIGHTABLE SUBJECT MATTER: FIXATION, AUTHORSHIP, ORIGINALITY,
CREATIVITY, AND THE FACT/EXPRESSION DICHOTOMY

A "compilation" is a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship. The term "compilation" includes collective works.

...

"Copies" are material objects, other than phonorecords, in which a work is fixed by any method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. The term "copies" includes the material object, other than a phonorecord, in which the work is first fixed.

...

A "derivative work" is a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a "derivative work".

17 U.S.C. §102. Subject matter of copyright: In general (1990)

(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

- (1) literary works;
- (2) musical works, including any accompanying words;
- (3) dramatic works, including any accompanying music;
- (4) pantomimes and choreographic works;
- (5) pictorial, graphic, and sculptural works;
- (6) motion pictures and other audiovisual works;
- (7) sound recordings; and
- (8) architectural works.

(b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

17 U.S. Code § 103. Subject matter of copyright: Compilations and derivative works (1976)

(a) The subject matter of copyright as specified by section 102 includes compilations and derivative works, but protection for a work employing preexisting material in which copyright subsists does not extend to any part of the work in which such material has been used unlawfully.

(b) The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.

Prof. EEJ's notes on *Feist v. Rural*

You're about to read *Feist*. Cases come to casebooks in a variety of forms. Some are examples of the law being applied clearly and correctly. Some are examples of the law being applied poorly. Some are presented just to be puzzles. But *Feist* isn't any of those. *Feist* is THE LAW. You can read it with that peace of mind.

Case: *Feist v. Rural*

Feist Publications, Inc. v. Rural Telephone Service

Supreme Court of the United States
499 U.S. 340 (1991)

JUSTICE O'CONNOR delivered the opinion of the Court.

This case requires us to clarify the extent of copyright protection available to telephone directory white pages.

I

Rural Telephone Service Company, Inc., is a certified public utility that provides telephone service to several communities in northwest Kansas. It is subject to a state regulation that requires all telephone companies operating in Kansas to issue annually an updated telephone directory. Accordingly, as a condition of its monopoly franchise, Rural publishes a typical telephone directory, consisting of white pages and yellow pages. The white pages list in alphabetical order the names of Rural's subscribers, together with their towns and telephone numbers. The yellow pages list Rural's business subscribers alphabetically by category and feature classified advertisements of various sizes. Rural distributes its directory free of charge to its subscribers, but earns revenue by selling yellow pages advertisements.

Feist Publications, Inc., is a publishing company that specializes in area-wide telephone directories. Unlike a typical directory, which covers only a particular calling area, Feist's area-wide directories cover a much larger geographical range, reducing the need to call directory assistance or consult multiple directories. The Feist directory that is the subject of this litigation covers 11 different telephone service areas in 15 counties and contains 46,878 white pages listings—compared to Rural's approximately 7,700 listings. Like Rural's directory, Feist's is distributed free of charge and includes both white pages and yellow pages. Feist and Rural compete vigorously for yellow pages advertising.

As the sole provider of telephone service in its service area, Rural obtains subscriber information quite easily. Persons desiring telephone service must apply to Rural and provide their names and addresses; Rural then assigns them a telephone number. Feist is not a telephone company, let alone one with monopoly status, and therefore lacks independent access to any subscriber information. To obtain white pages listings for its area-wide directory, Feist approached each of the 11 telephone companies operating in northwest Kansas and offered to pay for the right to use its white pages listings.

Of the 11 telephone companies, only Rural refused to license its listings to Feist. Rural's refusal created a problem for Feist, as omitting these listings would have left a gaping hole in its area-wide directory, rendering it less attractive to potential yellow pages advertisers. In a decision subsequent to that which we review here, the District Court determined that this was precisely the

reason Rural refused to license its listings. The refusal was motivated by an unlawful purpose “to extend its monopoly in telephone service to a monopoly in yellow pages advertising.” *Rural Telephone Service Co. v. Feist Publications, Inc.*, 737 F. Supp. 610, 622 (Kan. 1990).

Unable to license Rural’s white pages listings, Feist used them without Rural’s consent. Feist began by removing several thousand listings that fell outside the geographic range of its area-wide directory, then hired personnel to investigate the 4,935 that remained. These employees verified the data reported by Rural and sought to obtain additional information. As a result, a typical Feist listing includes the individual’s street address; most of Rural’s listings do not. Notwithstanding these additions, however, 1,309 of the 46,878 listings in Feist’s 1983 directory were identical to listings in Rural’s 1982-1983 white pages. App. 54 (¶ 15-16), 57. Four of these were fictitious listings that Rural had inserted into its directory to detect copying.

Rural sued for copyright infringement in the District Court for the District of Kansas taking the position that Feist, in compiling its own directory, could not use the information contained in Rural’s white pages. Rural asserted that Feist’s employees were obliged to travel door-to-door or conduct a telephone survey to discover the same information for themselves. Feist responded that such efforts were economically impractical and, in any event, unnecessary because the information copied was beyond the scope of copyright protection. The District Court granted summary judgment to Rural, explaining that “[c]ourts have consistently held that telephone directories are copyrightable” and citing a string of lower court decisions. 663 F. Supp. 214, 218 (1987). In an unpublished opinion, the Court of Appeals for the Tenth Circuit affirmed “for substantially the reasons given by the district court.” App. to Pet. for Cert. 4a, judgt. order reported at 916 F. 2d 718 (1990). We granted certiorari, 498 U. S. 808 (1990), to determine whether the copyright in Rural’s directory protects the names, towns, and telephone numbers copied by Feist.

II

A

This case concerns the interaction of two well-established propositions. The first is that facts are not copyrightable; the other, that compilations of facts generally are. Each of these propositions possesses an impeccable

pedigree. That there can be no valid copyright in facts is universally understood. The most fundamental axiom of copyright law is that “[n]o author may copyright his ideas or the facts he narrates.” *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U. S. 539, 556 (1985). Rural wisely concedes this point, noting in its brief that “[f]acts and discoveries, of course, are not themselves subject to copyright protection.” Brief for Respondent 24. At the same time, however, it is beyond dispute that compilations of facts are within the subject matter of copyright. Compilations were expressly mentioned in the Copyright Act of 1909, and again in the Copyright Act of 1976.

There is an undeniable tension between these two propositions. Many compilations consist of nothing but raw data— *i.e.*, wholly factual information not accompanied by any original written expression. On what basis may one claim a copyright in such a work? Common sense tells us that 100 uncopyrightable facts do not magically change their status when gathered together in one place. Yet copyright law seems to contemplate that compilations that consist exclusively of facts are potentially within its scope.

The key to resolving the tension lies in understanding why facts are not copyrightable. The *sine qua non* of copyright is originality. To qualify for copyright protection, a work must be original to the author. See *Harper & Row, supra*, at 547-549. Original, as the term is used in copyright, means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity. 1 M. Nimmer & D. Nimmer, Copyright §§ 2.01[A], [B] (1990) (hereinafter Nimmer). To be sure, the requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, “no matter how crude, humble or obvious” it might be. *Id.*, § 1.08[C][1]. Originality does not signify novelty; a work may be original even though it closely resembles other works so long as the similarity is fortuitous, not the result of copying. To illustrate, assume that two poets, each ignorant of the other, compose identical poems. Neither work is novel, yet both are original and, hence, copyrightable. See *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F. 2d 49, 54 (CA2 1936).

Originality is a constitutional requirement. The source of Congress’ power to enact copyright laws is Article I, § 8, cl. 8, of the Constitution, which authorizes Congress to “secur[e] for limited Times to Authors . . . the exclusive

Right to their respective Writings.” In two decisions from the late 19th century—*The Trade-Mark Cases*, 100 U. S. 82 (1879); and *Burrow-Giles Lithographic Co. v. Sarony*, 111 U. S. 53 (1884)—this Court defined the crucial terms “authors” and “writings.” In so doing, the Court made it unmistakably clear that these terms presuppose a degree of originality.

In *The Trade-Mark Cases*, the Court addressed the constitutional scope of “writings.” For a particular work to be classified “under the head of writings of authors,” the Court determined, “originality is required.” 100 U. S., at 94. The Court explained that originality requires independent creation plus a modicum of creativity: “[W]hile the word *writings* may be liberally construed, as it has been, to include original designs for engraving, prints, &c., it is only such as are *original*, and are founded in the creative powers of the mind. The writings which are to be protected are *the fruits of intellectual labor*, embodied in the form of books, prints, engravings, and the like.” *Ibid.* (emphasis in original).

In *Burrow-Giles*, the Court distilled the same requirement from the Constitution’s use of the word “authors.” The Court defined “author,” in a constitutional sense, to mean “he to whom anything owes its origin; originator; maker.” 111 U. S., at 58 (internal quotation marks omitted). As in *The Trade-Mark Cases*, the Court emphasized the creative component of originality. It described copyright as being limited to “original intellectual conceptions of the author,” 111 U. S., at 58, and stressed the importance of requiring an author who accuses another of infringement to prove “the existence of those facts of originality, of intellectual production, of thought, and conception.” *Id.*, at 59-60.

The originality requirement articulated in *The Trade-Mark Cases* and *Burrow-Giles* remains the touchstone of copyright protection today. See *Goldstein v. California*, 412 U. S. 546, 561-562 (1973). It is the very “premise of copyright law.” *Miller v. Universal City Studios, Inc.*, 650 F. 2d 1365, 1368 (CA5 1981). Leading scholars agree on this point. As one pair of commentators succinctly puts it: “The originality requirement is *constitutionally mandated* for all works.” Patterson & Joyce, *Monopolizing the Law: The Scope of Copyright Protection for Law Reports and Statutory Compilations*, 36 UCLA L. Rev. 719, 763, n. 155 (1989) (emphasis in original) (hereinafter Patterson & Joyce). Accord, *id.*, at 759-760, and n. 140; Nimmer § 1.06[A] (“[O]riginality is a statutory as well as a constitutional

requirement”); *id.*, § 1.08[C][1] (“[A] modicum of intellectual labor . . . clearly constitutes an essential constitutional element”).

It is this bedrock principle of copyright that mandates the law’s seemingly disparate treatment of facts and factual compilations. “No one may claim originality as to facts.” *Id.*, § 2.11[A], p. 2-157. This is because facts do not owe their origin to an act of authorship. The distinction is one between creation and discovery: The first person to find and report a particular fact has not created the fact; he or she has merely discovered its existence. To borrow from *Burrow-Giles*, one who discovers a fact is not its “maker” or “originator.” 111 U. S., at 58. “The discoverer merely finds and records.” Nimmer § 2.03[E]. Census takers, for example, do not “create” the population figures that emerge from their efforts; in a sense, they copy these figures from the world around them. Denicola, *Copyright in Collections of Facts: A Theory for the Protection of Nonfiction Literary Works*, 81 Colum. L. Rev. 516, 525 (1981) (hereinafter Denicola). Census data therefore do not trigger copyright because these data are not “original” in the constitutional sense. Nimmer § 2.03[E]. The same is true of all facts—scientific, historical, biographical, and news of the day. “[T]hey may not be copyrighted and are part of the public domain available to every person.” *Miller, supra*, at 1369.

Factual compilations, on the other hand, may possess the requisite originality. The compilation author typically chooses which facts to include, in what order to place them, and how to arrange the collected data so that they may be used effectively by readers. These choices as to selection and arrangement, so long as they are made independently by the compiler and entail a minimal degree of creativity, are sufficiently original that Congress may protect such compilations through the copyright laws. Nimmer §§ 2.11[D], 3.03; Denicola 523, n. 38. Thus, even a directory that contains absolutely no protectible written expression, only facts, meets the constitutional minimum for copyright protection if it features an original selection or arrangement. See *Harper & Row*, 471 U. S., at 547. Accord, Nimmer § 3.03.

This protection is subject to an important limitation. The mere fact that a work is copyrighted does not mean that every element of the work may be protected. Originality remains the *sine qua non* of copyright; accordingly, copyright protection may extend only to those components of a work that are original to the author. Patterson & Joyce 800-802; Ginsburg, *Creation and Commercial Value: Copyright Protection of Works of Information*, 90

Colum. L. Rev. 1865, 1868, and n. 12 (1990) (hereinafter Ginsburg). Thus, if the compilation author clothes facts with an original collocation of words, he or she may be able to claim a copyright in this written expression. Others may copy the underlying facts from the publication, but not the precise words used to present them. In *Harper & Row*, for example, we explained that President Ford could not prevent others from copying bare historical facts from his autobiography, see 471 U. S., at 556-557, but that he could prevent others from copying his “subjective descriptions and portraits of public figures.” *Id.*, at 563. Where the compilation author adds no written expression but rather lets the facts speak for themselves, the expressive element is more elusive. The only conceivable expression is the manner in which the compiler has selected and arranged the facts. Thus, if the selection and arrangement are original, these elements of the work are eligible for copyright protection. See Patry, Copyright in Compilations of Facts (or Why the “White Pages” Are Not Copyrightable), 12 Com. & Law 37, 64 (Dec. 1990) (hereinafter Patry). No matter how original the format, however, the facts themselves do not become original through association. See *Patterson & Joyce* 776.

This inevitably means that the copyright in a factual compilation is thin. Notwithstanding a valid copyright, a subsequent compiler remains free to use the facts contained in another’s publication to aid in preparing a competing work, so long as the competing work does not feature the same selection and arrangement. As one commentator explains it: “[N]o matter how much original authorship the work displays, the facts and ideas it exposes are free for the taking . . . [T]he very same facts and ideas may be divorced from the context imposed by the author, and restated or reshuffled by second comers, even if the author was the first to discover the facts or to propose the ideas.” Ginsburg 1868.

It may seem unfair that much of the fruit of the compiler’s labor may be used by others without compensation. As JUSTICE BRENNAN has correctly observed, however, this is not “some unforeseen byproduct of a statutory scheme.” *Harper & Row*, 471 U. S., at 589 (dissenting opinion). It is, rather, “the essence of copyright,” *ibid.*, and a constitutional requirement. The primary objective of copyright is not to reward the labor of authors, but “[t]o promote the Progress of Science and useful Arts.” Art. I, § 8, cl. 8. Accord, *Twentieth Century Music Corp. v. Aiken*, 422 U. S. 151, 156 (1975). To this end, copyright assures authors the right to their original expression, but

encourages others to build freely upon the ideas and information conveyed by a work. *Harper & Row, supra*, at 556-557. This principle, known as the idea/expression or fact/expression dichotomy, applies to all works of authorship. As applied to a factual compilation, assuming the absence of original written expression, only the compiler's selection and arrangement may be protected; the raw facts may be copied at will. This result is neither unfair nor unfortunate. It is the means by which copyright advances the progress of science and art.

This Court has long recognized that the fact/expression dichotomy limits severely the scope of protection in fact-based works. More than a century ago, the Court observed: "The very object of publishing a book on science or the useful arts is to communicate to the world the useful knowledge which it contains. But this object would be frustrated if the knowledge could not be used without incurring the guilt of piracy of the book." *Baker v. Selden*, 101 U. S. 99, 103 (1880). We reiterated this point in *Harper & Row*:

"[N]o author may copyright facts or ideas. The copyright is limited to those aspects of the work—termed 'expression'—that display the stamp of the author's originality.

"[C]opyright does not prevent subsequent users from copying from a prior author's work those constituent elements that are not original—for example . . . facts, or materials in the public domain—as long as such use does not unfairly appropriate the author's original contributions." 471 U. S., at 547-548 (citation omitted).

This, then, resolves the doctrinal tension: Copyright treats facts and factual compilations in a wholly consistent manner. Facts, whether alone or as part of a compilation, are not original and therefore may not be copyrighted. A factual compilation is eligible for copyright if it features an original selection or arrangement of facts, but the copyright is limited to the particular selection or arrangement. In no event may copyright extend to the facts themselves.

B

As we have explained, originality is a constitutionally mandated prerequisite for copyright protection. The Court's decisions announcing this rule predate the Copyright Act of 1909, but ambiguous language in the 1909 Act caused some lower courts temporarily to lose sight of this requirement.

The 1909 Act embodied the originality requirement, but not as clearly as it might have. See Nimmer § 2.01. The subject matter of copyright was set out in §§ 3 and 4 of the Act. Section 4 stated that copyright was available to “all the writings of an author.” 35 Stat. 1076. By using the words “writings” and “author”—the same words used in Article I, § 8, of the Constitution and defined by the Court in *The Trade-Mark Cases* and *Burrow-Giles*—the statute necessarily incorporated the originality requirement articulated in the Court’s decisions. It did so implicitly, however, thereby leaving room for error.

Section 3 was similarly ambiguous. It stated that the copyright in a work protected only “the copyrightable component parts of the work.” It thus stated an important copyright principle, but failed to identify the specific characteristic—originality—that determined which component parts of a work were copyrightable and which were not.

Most courts construed the 1909 Act correctly, notwithstanding the less-than-perfect statutory language. They understood from this Court’s decisions that there could be no copyright without originality. See *Patterson & Joyce* 760-761. As explained in the Nimmer treatise: “The 1909 Act neither defined originality, nor even expressly required that a work be ‘original’ in order to command protection. However, the courts uniformly inferred the requirement from the fact that copyright protection may only be claimed by ‘authors’ . . . It was reasoned that since an author is ‘the . . . creator, originator’ it follows that a work is not the product of an author unless the work is original.” Nimmer § 2.01 (footnotes omitted) (citing cases).

But some courts misunderstood the statute. See, e. g., *Leon v. Pacific Telephone & Telegraph Co.*, 91 F. 2d 484 (CA9 1937); *Jeweler’s Circular Publishing Co. v. Keystone Publishing Co.*, 281 F. 83 (CA2 1922). These courts ignored §§ 3 and 4, focusing their attention instead on § 5 of the Act. Section 5, however, was purely technical in nature: It provided that a person seeking to register a work should indicate on the application the type of work, and it listed 14 categories under which the work might fall. One of these categories was “[b]ooks, including composite and cyclopædic works, directories, gazetteers, and other compilations.” § 5(a). Section 5 did not purport to say that all compilations were automatically copyrightable. Indeed, it expressly disclaimed any such function, pointing out that “the subject-matter of copyright [i]s defined in section four.” Nevertheless, the fact that factual compilations were mentioned specifically in § 5 led some courts to infer

erroneously that directories and the like were copyrightable *per se*, “without any further or precise showing of original—personal—authorship.” Ginsburg 1895.

Making matters worse, these courts developed a new theory to justify the protection of factual compilations. Known alternatively as “sweat of the brow” or “industrious collection,” the underlying notion was that copyright was a reward for the hard work that went into compiling facts. The classic formulation of the doctrine appeared in *Jeweler’s Circular Publishing Co.*, 281 F., at 88:

“The right to copyright a book upon which one has expended labor in its preparation does not depend upon whether the materials which he has collected consist or not of matters which are *publici juris*, or whether such materials show literary skill *or originality*, either in thought or in language, or anything more than industrious collection. The man who goes through the streets of a town and puts down the names of each of the inhabitants, with their occupations and their street number, acquires material of which he is the author” (emphasis added).

The “sweat of the brow” doctrine had numerous flaws, the most glaring being that it extended copyright protection in a compilation beyond selection and arrangement—the compiler’s original contributions—to the facts themselves. Under the doctrine, the only defense to infringement was independent creation. A subsequent compiler was “not entitled to take one word of information previously published,” but rather had to “independently wor[k] out the matter for himself, so as to arrive at the same result from the same common sources of information.” *Id.*, at 88-89 (internal quotation marks omitted). “Sweat of the brow” courts thereby eschewed the most fundamental axiom of copyright law—that no one may copyright facts or ideas. See *Miller v. Universal City Studios, Inc.*, 650 F. 2d, at 1372 (criticizing “sweat of the brow” courts because “ensur[ing] that later writers obtain the facts independently . . . is precisely the scope of protection given . . . copyrighted matter, and the law is clear that facts are not entitled to such protection”).

Decisions of this Court applying the 1909 Act make clear that the statute did not permit the “sweat of the brow” approach. The best example is *International News Service v. Associated Press*, 248 U. S. 215 (1918). In that

decision, the Court stated unambiguously that the 1909 Act conferred copyright protection only on those elements of a work that were original to the author. International News Service had conceded taking news reported by Associated Press and publishing it in its own newspapers. Recognizing that § 5 of the Act specifically mentioned “periodicals, including newspapers,” § 5(b), the Court acknowledged that news articles were copyrightable. *Id.*, at 234. It flatly rejected, however, the notion that the copyright in an article extended to the factual information it contained: “[T]he news element— the information respecting current events contained in the literary production—is not the creation of the writer, but is a report of matters that ordinarily are *publici juris*; it is the history of the day.” *Ibid.*

Without a doubt, the “sweat of the brow” doctrine flouted basic copyright principles. Throughout history, copyright law has “recognize[d] a greater need to disseminate factual works than works of fiction or fantasy.” *Harper & Row*, 471 U. S., at 563. Accord, Gorman, Fact or Fancy: The Implications for Copyright, 29 J. Copyright Soc. 560, 563 (1982). But “sweat of the brow” courts took a contrary view; they handed out proprietary interests in facts and declared that authors are absolutely precluded from saving time and effort by relying upon the facts contained in prior works. In truth, “[i]t is just such wasted effort that the proscription against the copyright of ideas and facts . . . [is] designed to prevent.” *Rosemont Enterprises, Inc. v. Random House, Inc.*, 366 F. 2d 303, 310 (CA2 1966), cert. denied, 385 U. S. 1009 (1967). “Protection for the fruits of such research . . . may in certain circumstances be available under a theory of unfair competition. But to accord copyright protection on this basis alone distorts basic copyright principles in that it creates a monopoly in public domain materials without the necessary justification of protecting and encouraging the creation of ‘writings’ by ‘authors.’” Nimmer § 3.04, p. 3-23 (footnote omitted).

C

“Sweat of the brow” decisions did not escape the attention of the Copyright Office. When Congress decided to over-haul the copyright statute and asked the Copyright Office to study existing problems, see *Mills Music, Inc. v. Snyder*, 469 U. S. 153, 159 (1985), the Copyright Office promptly recommended that Congress clear up the confusion in the lower courts as to the basic standards of copyrightability. The Register of Copyrights explained in his first report to Congress that “originality” was a “basic requisit[e]” of

copyright under the 1909 Act, but that “the absence of any reference to [originality] in the statute seems to have led to misconceptions as to what is copyrightable matter.” Report of the Register of Copyrights on the General Revision of the U. S. Copyright Law, 87th Cong., 1st Sess., p. 9 (H. Judiciary Comm. Print 1961). The Register suggested making the originality requirement explicit. *Ibid.*

Congress took the Register's advice. In enacting the Copyright Act of 1976, Congress dropped the reference to “all the writings of an author” and replaced it with the phrase “original works of authorship.” 17 U. S. C. § 102(a). In making explicit the originality requirement, Congress announced that it was merely clarifying existing law: “The two fundamental criteria of copyright protection [are] originality and fixation in tangible form The phrase ‘original works of authorship,’ which is purposely left undefined, is intended to incorporate without change *the standard of originality established by the courts under the present [1909] copyright statute.*” H. R. Rep. No. 94-1476, p. 51 (1976) (emphasis added) (hereinafter H. R. Rep.); S. Rep. No. 94-473, p. 50 (1975) (emphasis added) (hereinafter S. Rep.). This sentiment was echoed by the Copyright Office: “Our intention here is to maintain the *established standards* of originality. . . .” Supplementary Report of the Register of Copyrights on the General Revision of U. S. Copyright Law, 89th Cong., 1st Sess., pt. 6, p. 3 (H. Judiciary Comm. Print 1965) (emphasis added).

To ensure that the mistakes of the “sweat of the brow” courts would not be repeated, Congress took additional measures. For example, § 3 of the 1909 Act had stated that copyright protected only the “copyrightable component parts” of a work, but had not identified originality as the basis for distinguishing those component parts that were copyrightable from those that were not. The 1976 Act deleted this section and replaced it with § 102(b), which identifies specifically those elements of a work for which copyright is not available: “In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.” Section 102(b) is universally understood to prohibit any copyright in facts. *Harper & Row, supra*, at 547, 556. Accord, Nimmer § 2.03[E] (equating facts with “discoveries”). As with § 102(a), Congress emphasized that § 102(b) did not change the law, but merely clarified it: “Section 102(b) in no way enlarges or

contracts the scope of copyright protection under the present law. Its purpose is to restate . . . that the basic dichotomy between expression and idea remains unchanged.” H. R. Rep., at 57; S. Rep., at 54.

Congress took another step to minimize confusion by deleting the specific mention of “directories . . . and other compilations” in § 5 of the 1909 Act. As mentioned, this section had led some courts to conclude that directories were copyrightable *per se* and that every element of a directory was protected. In its place, Congress enacted two new provisions. First, to make clear that compilations were not copyrightable *per se*, Congress provided a definition of the term “compilation.” Second, to make clear that the copyright in a compilation did not extend to the facts themselves, Congress enacted § 103.

The definition of “compilation” is found in § 101 of the 1976 Act. It defines a “compilation” in the copyright sense as “a work formed by the collection and assembling of preexisting materials or of data *that* are selected, coordinated, or arranged *in such a way that* the resulting work as a whole constitutes an original work of authorship” (emphasis added).

The purpose of the statutory definition is to emphasize that collections of facts are not copyrightable *per se*. It conveys this message through its tripartite structure, as emphasized above by the italics. The statute identifies three distinct elements and requires each to be met for a work to qualify as a copyrightable compilation: (1) the collection and assembly of pre-existing material, facts, or data; (2) the selection, coordination, or arrangement of those materials; and (3) the creation, by virtue of the particular selection, coordination, or arrangement, of an “original” work of authorship. “[T]his tripartite conjunctive structure is self-evident, and should be assumed to ‘accurately express the legislative purpose.’” Patry 51, quoting *Mills Music*, 469 U. S., at 164.

At first glance, the first requirement does not seem to tell us much. It merely describes what one normally thinks of as a compilation—a collection of pre-existing material, facts, or data. What makes it significant is that it is not the *sole* requirement. It is not enough for copyright purposes that an author collects and assembles facts. To satisfy the statutory definition, the work must get over two additional hurdles. In this way, the plain language indicates that not every collection of facts receives copyright protection. Otherwise, there would be a period after “data.”

The third requirement is also illuminating. It emphasizes that a compilation, like any other work, is copyrightable only if it satisfies the originality requirement (“an *original* work of authorship”). Although § 102 states plainly that the originality requirement applies to all works, the point was emphasized with regard to compilations to ensure that courts would not repeat the mistake of the “sweat of the brow” courts by concluding that fact-based works are treated differently and measured by some other standard. As Congress explained it, the goal was to “make plain that the criteria of copyrightable subject matter stated in section 102 apply with full force to works . . . containing preexisting material.” H. R. Rep., at 57; S. Rep., at 55.

The key to the statutory definition is the second requirement. It instructs courts that, in determining whether a fact-based work is an original work of authorship, they should focus on the manner in which the collected facts have been selected, coordinated, and arranged. This is a straightforward application of the originality requirement. Facts are never original, so the compilation author can claim originality, if at all, only in the way the facts are presented. To that end, the statute dictates that the principal focus should be on whether the selection, coordination, and arrangement are sufficiently original to merit protection.

Not every selection, coordination, or arrangement will pass muster. This is plain from the statute. It states that, to merit protection, the facts must be selected, coordinated, or arranged “in such a way” as to render the work as a whole original. This implies that some “ways” will trigger copyright, but that others will not. See Patry 57, and n. 76. Otherwise, the phrase “in such a way” is meaningless and Congress should have defined “compilation” simply as “a work formed by the collection and assembly of preexisting materials or data that are selected, coordinated, or arranged.” That Congress did not do so is dispositive. In accordance with “the established principle that a court should give effect, if possible, to every clause and word of a statute,” *Moskal v. United States*, 498 U. S. 103, 109-110 (1990) (internal quotation marks omitted), we conclude that the statute envisions that there will be some fact-based works in which the selection, coordination, and arrangement are not sufficiently original to trigger copyright protection.

As discussed earlier, however, the originality requirement is not particularly stringent. A compiler may settle upon a selection or arrangement that others have used; novelty is not required. Originality requires only that the

author make the selection or arrangement independently (*i. e.*, without copying that selection or arrangement from another work), and that it display some minimal level of creativity. Presumably, the vast majority of compilations will pass this test, but not all will. There remains a narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent. See generally *Bleistein v. Donaldson Lithographing Co.*, 188 U. S. 239, 251 (1903) (referring to “the narrowest and most obvious limits”). Such works are incapable of sustaining a valid copyright. Nimmer § 2.01[B].

Even if a work qualifies as a copyrightable compilation, it receives only limited protection. This is the point of § 103 of the Act. Section 103 explains that “[t]he subject matter of copyright . . . includes compilations,” § 103(a), but that copyright protects only the author’s original contributions—not the facts or information conveyed:

“The copyright in a compilation . . . extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material.” § 103(b).

As § 103 makes clear, copyright is not a tool by which a compilation author may keep others from using the facts or data he or she has collected. “The most important point here is one that is commonly misunderstood today: copyright . . . has no effect one way or the other on the copyright or public domain status of the preexisting material.” H. R. Rep., at 57; S. Rep., at 55. The 1909 Act did not require, as “sweat of the brow” courts mistakenly assumed, that each subsequent compiler must start from scratch and is precluded from relying on research undertaken by another. See, *e. g.*, *Jeweler’s Circular Publishing Co.*, 281 F., at 88-89. Rather, the facts contained in existing works may be freely copied because copyright protects only the elements that owe their origin to the compiler—the selection, coordination, and arrangement of facts.

In summary, the 1976 revisions to the Copyright Act leave no doubt that originality, not “sweat of the brow,” is the touchstone of copyright protection in directories and other fact-based works. Nor is there any doubt that the same was true under the 1909 Act. The 1976 revisions were a direct response to the Copyright Office’s concern that many lower courts had misconstrued this basic principle, and Congress emphasized repeatedly that the purpose of the

revisions was to clarify, not change, existing law. The revisions explain with painstaking clarity that copyright requires originality, § 102(a); that facts are never original, § 102(b); that the copyright in a compilation does not extend to the facts it contains, § 103(b); and that a compilation is copyrightable only to the extent that it features an original selection, coordination, or arrangement, § 101.

The 1976 revisions have proven largely successful in steering courts in the right direction. A good example is *Miller v. Universal City Studios, Inc.*, 650 F. 2d, at 1369-1370: “A copyright in a directory . . . is properly viewed as resting on the originality of the selection and arrangement of the factual material, rather than on the industriousness of the efforts to develop the information. Copyright protection does not extend to the facts themselves, and the mere use of information contained in a directory without a substantial copying of the format does not constitute infringement” (citation omitted). Additionally, the Second Circuit, which almost 70 years ago issued the classic formulation of the “sweat of the brow” doctrine in *Jeweler’s Circular Publishing Co.*, has now fully repudiated the reasoning of that decision. See, e. g., *Financial Information, Inc. v. Moody’s Investors Service, Inc.*, 808 F. 2d 204, 207 (CA2 1986), cert. denied, 484 U. S. 820 (1987); *Financial Information, Inc. v. Moody’s Investors Service, Inc.*, 751 F. 2d 501, 510 (CA2 1984) (Newman, J., concurring); *Hoehling v. Universal City Studios, Inc.*, 618 F. 2d 972, 979 (CA2 1980). Even those scholars who believe that “industrious collection” should be rewarded seem to recognize that this is beyond the scope of existing copyright law. See Denicola 516 (“[T]he very vocabulary of copyright is ill suited to analyzing property rights in works of nonfiction”); *id.*, at 520-521, 525; Ginsburg 1867, 1870.

III

There is no doubt that Feist took from the white pages of Rural’s directory a substantial amount of factual information. At a minimum, Feist copied the names, towns, and telephone numbers of 1,309 of Rural’s subscribers. Not all copying, however, is copyright infringement. To establish infringement, two elements must be proven: (1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original. See *Harper & Row*, 471 U. S., at 548. The first element is not at issue here; Feist appears to concede that Rural’s directory, considered as a whole, is subject to a valid copyright because it contains some foreword text, as well as

original material in its yellow pages advertisements. See Brief for Petitioner 18; Pet. for Cert. 9.

The question is whether Rural has proved the second element. In other words, did Feist, by taking 1,309 names, towns, and telephone numbers from Rural's white pages, copy anything that was "original" to Rural? Certainly, the raw data does not satisfy the originality requirement. Rural may have been the first to discover and report the names, towns, and telephone numbers of its subscribers, but this data does not "ow[e] its origin" to Rural. *Burrow-Giles*, 111 U. S., at 58. Rather, these bits of information are uncopyrightable facts; they existed before Rural reported them and would have continued to exist if Rural had never published a telephone directory. The originality requirement "rule[s] out protecting . . . names, addresses, and telephone numbers of which the plaintiff by no stretch of the imagination could be called the author." *Patterson & Joyce* 776.

Rural essentially concedes the point by referring to the names, towns, and telephone numbers as "preexisting material." Brief for Respondent 17. Section 103(b) states explicitly that the copyright in a compilation does not extend to "the preexisting material employed in the work."

The question that remains is whether Rural selected, coordinated, or arranged these uncopyrightable facts in an original way. As mentioned, originality is not a stringent standard; it does not require that facts be presented in an innovative or surprising way. It is equally true, however, that the selection and arrangement of facts cannot be so mechanical or routine as to require no creativity whatsoever. The standard of originality is low, but it does exist. See *Patterson & Joyce* 760, n. 144 ("While this requirement is sometimes characterized as modest, or a low threshold, it is not without effect") (internal quotation marks omitted; citations omitted). As this Court has explained, the Constitution mandates some minimal degree of creativity, see *The Trade-Mark Cases*, 100 U. S., at 94; and an author who claims infringement must prove "the existence of . . . intellectual production, of thought, and conception." *Burrow-Giles*, *supra*, at 59-60.

The selection, coordination, and arrangement of Rural's white pages do not satisfy the minimum constitutional standards for copyright protection. As mentioned at the outset, Rural's white pages are entirely typical. Persons desiring telephone service in Rural's service area fill out an application and

Rural issues them a telephone number. In preparing its white pages, Rural simply takes the data provided by its subscribers and lists it alphabetically by surname. The end product is a garden-variety white pages directory, devoid of even the slightest trace of creativity.

Rural's selection of listings could not be more obvious: It publishes the most basic information—name, town, and telephone number—about each person who applies to it for telephone service. This is “selection” of a sort, but it lacks the modicum of creativity necessary to transform mere selection into copyrightable expression. Rural expended sufficient effort to make the white pages directory useful, but insufficient creativity to make it original.

We note in passing that the selection featured in Rural's white pages may also fail the originality requirement for another reason. Feist points out that Rural did not truly “select” to publish the names and telephone numbers of its subscribers; rather, it was required to do so by the Kansas Corporation Commission as part of its monopoly franchise. See 737 F. Supp., at 612. Accordingly, one could plausibly conclude that this selection was dictated by state law, not by Rural.

Nor can Rural claim originality in its coordination and arrangement of facts. The white pages do nothing more than list Rural's subscribers in alphabetical order. This arrangement may, technically speaking, owe its origin to Rural; no one disputes that Rural undertook the task of alphabetizing the names itself. But there is nothing remotely creative about arranging names alphabetically in a white pages directory. It is an age-old practice, firmly rooted in tradition and so commonplace that it has come to be expected as a matter of course. See Brief for Information Industry Association et al. as *Amici Curiae* 10 (alphabetical arrangement “is universally observed in directories published by local exchange telephone companies”). It is not only unoriginal, it is practically inevitable. This time-honored tradition does not possess the minimal creative spark required by the Copyright Act and the Constitution.

We conclude that the names, towns, and telephone numbers copied by Feist were not original to Rural and therefore were not protected by the copyright in Rural's combined white and yellow pages directory. As a constitutional matter, copyright protects only those constituent elements of a work that possess more than a *de minimis* quantum of creativity. Rural's white pages, limited to basic subscriber information and arranged alphabetically, fall

short of the mark. As a statutory matter, 17 U. S. C. § 101 does not afford protection from copying to a collection of facts that are selected, coordinated, and arranged in a way that utterly lacks originality. Given that some works must fail, we cannot imagine a more likely candidate. Indeed, were we to hold that Rural's white pages pass muster, it is hard to believe that any collection of facts could fail.

Because Rural's white pages lack the requisite originality, Feist's use of the listings cannot constitute infringement. This decision should not be construed as demeaning Rural's efforts in compiling its directory, but rather as making clear that copyright rewards originality, not effort. As this Court noted more than a century ago, "great praise may be due to the plaintiffs for their industry and enterprise in publishing this paper, yet the law does not contemplate their being rewarded in this way." *Baker v. Selden*, 101 U. S., at 105.

The judgment of the Court of Appeals is

Reversed.

JUSTICE BLACKMUN concurs in the judgment.

Rights, Licensing, Attribution, Disclaimers, and More

The following was written by Eric E. Johnson:

This chapter (Chapter C-1, "Copyrightable Subject Matter: Fixation, Authorship, Originality, Creativity, and the Fact/Expression Dichotomy") was made in its current form by Eric E. Johnson by making changes and additions to the text of Chapter 3, "Copyrightable subject matter and the requirements of originality and fixation," of *Introduction To Intellectual Property Cases and Questions Fall 2021 Edition* authored and published by **Jason Rantanen**. © 2021 Jason Rantanen, licensed under the Creative Commons Attribution-Noncommercial 4.0 International License (CC BY-NC 4.0), available at <https://creativecommons.org/licenses/by-nc/4.0/>. That license contains a disclaimer of warranties and a statement of limitation of liability. The original work is available at <http://ssrn.com/abstract=3883500>. A printed version is available on Amazon.

Starting with Professor Rantanen's chapter, I changed some things and added substantial material. Throughout, I made formatting changes, including to typography, pagination, paragraph styling, heading styles, etc., including replacing double spaces with single spaces. The chapter title is different. I added the "Prof. EEJ notes on" and "Copyright Office on" portions. I omitted the

learning objectives portion of Chapter 3. I added “Notes from Prof. Rantanen” as a header to mark expository text authored by Professor Rantanen and to highlight the fact that it is his. From his text, I omitted a sentence directing students to read certain statutory sections and replaced it with a superscript tilde (~), which I used to indicate an ellipsis. I added the heading “Relevant statutes to read regarding copyrightable subject matter.” I removed statutory text from tables and formatted it as regular text. I added the header “Case: Feist v. Rural” and in the information about the case, I added “Supreme Court of the United States.”

In the original book, the following appeared (paragraph breaks have been omitted): “Copyright © 2021 Jason Rantanen. This work is licensed under a Creative Commons Attribution-Noncommercial 4.0 International License. Contact jason-rantanen@uiowa.edu to request additional permissions. No copyright is claimed to works in the public domain.”

I am very grateful to Jason Rantanen for his generosity in sharing his excellent materials!

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–EEJ

Chapter C-2: Copyrightable Subject Matter: Distinguishing Expression from Ideas, Methods, Systems, Etc.

This chapter was made in its current form by Eric E. Johnson by starting with Chapter 3, “Copyrightable subject matter and the requirements of originality and fixation,” of *Introduction To Intellectual Property Cases and Questions Fall 2021 Edition* authored by **Jason Rantanen**, and then changing some things and adding substantial material. Please see “Rights, Licensing, Attribution, Disclaimers, and More” at the end of this chapter.

Prof. EEJ’s notes on distinguishing expression from ideas, methods, etc.

This is the second chapter on copyright subject matter—the question of what is potentially copyrightable. As discussed in my notes in the prior chapter, to be copyrightable subject matter, something must be fixed in a tangible medium, it must have authorship, originality, a minimal degree of creativity, and it must be expression (as opposed to facts and ideas). The previous chapter covered all of that except what is often called the “idea/expression dichotomy,” which is the subject of this chapter.

C-2: COPYRIGHTABLE SUBJECT MATTER: DISTINGUISHING EXPRESSION
FROM IDEAS, METHODS, SYSTEMS, ETC.

The phrase “idea/expression dichotomy” is a bit misleading, because the doctrine in this area does not merely distinguish expression from what we think of as a mere “idea” in ordinary language. More generally, we are talking about the exclusion of things that are too abstract to constitute “expression.” Among those things excluded: methods of operation, procedures, inventions, recipes, etc.

The ’76 Copyright Act § 102(b) provides the following: “In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.” But note that that is a statutory formulation of a much older line of doctrine from copyright case law that gets at the conceptual core of copyright.

As I mentioned in my notes at the beginning of the last chapter, it can be useful to think about all these concepts of copyrightable subject matter as independent requirements. But it is also useful to think about them as different conceptual tools for trying to draw lines around a single deep, unified concept that’s hard to put into words.

And to reiterate from my prior notes, it can be particularly illuminating to think about the stakes – the essential policy choice that’s at the bottom of all of this: What are we going to allow people to “own” and exclude others from for approximately a hundred years? What are we going to keep wild and free for everyone to work with and play with?

Copyright Office on ideas, systems, and methods

from Circular 33: Works Not Protected by Copyright, revised 03/2021

Ideas, Methods, and Systems

Copyright law expressly excludes copyright protection for “any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied.” The Office may, however, register a literary, graphic, or artistic description, explanation, or illustration of an idea, procedure, process, system, or method of operation, provided that the work contains a sufficient amount of original authorship. However, copyright protection will extend only to the

original expression in that work and not to the underlying idea, methods, or systems described or explained.

Inventions

You can register a technical drawing or a written description of an invention when the drawing or description contains a sufficient amount of authorship. However, the registration extends only to the original expression contained in the drawing or description and does not apply to the underlying invention. Inventions meeting certain requirements may be patentable. For information about patent laws, visit the U.S. Patent and Trademark Office website or call 1-800-786-9199.

Example:

An author writes a book explaining a new system for food processing. The copyright in the book prevents others from copying or distributing the text and illustrations describing the author's system as expressed in the book, but it does not give the author the right to prevent others from employing the system or from using any procedures, processes, or methods described in the book. [Nor does it prevent others from describing the same system in different words. –EEJ]

Recipes

A recipe is a statement of the ingredients and procedure required for making a dish of food. A mere listing of ingredients or contents, or a simple set of directions, is uncopyrightable. As a result, the Office cannot register recipes consisting of a set of ingredients and a process for preparing a dish. In contrast, a recipe that creatively explains or depicts how or why to perform a particular activity may be copyrightable. A registration for a recipe may cover the written description or explanation of a process that appears in the work, as well as any photographs or illustrations that are owned by the applicant. However, the registration will not cover the list of ingredients that appear in each recipe, the underlying process for making the dish, or the resulting dish itself. The registration will also not cover the activities described in the work that are procedures, processes, or methods of operation, which are not subject to copyright protection.

Example[]:

Jules Kinder submits an application to register a cookbook, *Pie in the Sky*. In the “Author Created” field of the application, Kinder asserts a claim in “text, photographs, and compilation of ingredients.” Each recipe contains a list of ingredients, instructions for making a pie, and a photograph of the finished product. The claim in a “compilation of ingredients” will not be accepted because there is no copyrightable authorship in a mere listing of ingredients. Since this claim is not acceptable, the Office may communicate with Jules Kinder to limit the extent of the registration to the text and photographs only.~

Copyright Office on layout, design, blank forms, and applications with a uncopyrightable subject matter

from Circular 33: Works Not Protected by Copyright, revised 03/2021

Layout and Design

As a general rule, the Office will not accept a claim to copyright in “format” or “layout.” The general layout or format of a book, page, book cover, slide presentation, web page, poster, or form is uncopyrightable because it is a template for expression. Copyright protection may be available for the selection, coordination, or arrangement of the specific content that is selected and arranged in a sufficiently creative manner. The claim, however, would be limited to the selection and arrangement of that specific content, not to the selection and arrangement of any content in that particular manner.

Blank Forms

Blank forms typically contain empty fields or lined spaces as well as words or short phrases that identify the content that should be recorded in each field or space. Blank forms that are designed for recording information and do not themselves convey information are uncopyrightable.

Similarly, the ideas or principles behind a blank form, the systems or methods implemented by a form, or the form’s functional layout are not protected by copyright. A blank form may incorporate images or text that is sufficiently creative to be protected by copyright. For example, bank checks may be registered if they contain pictorial decoration that is sufficiently creative. Contracts, insurance policies, and other documents with “fill-in” spaces may also be registered if there is sufficient literary authorship that is not

standard or functional. In all cases, the registration covers only the original textual or pictorial expression that the author contributed to the work, but does not cover the blank form or other uncopyrightable elements that the form may contain.

Examples of blank forms include

- Time cards
- Graph paper
- Account books
- Diaries
- Bank checks
- Scorecards
- Address books
- Report forms
- Order forms
- Date books and schedulers

Registration of Works with Copyrightable and Uncopyrightable Subject Matter

When completing an application for a work with a significant amount of uncopyrightable subject matter, you should focus your claim specifically on the copyrightable subject matter. When completing the “Author Created” field in the online application, use words identifying copyrightable subject matter such as “text,” “photograph,” or “drawing.” Avoid words referring to material that is not subject to copyright protection, such as “idea,” “device,” “process,” “format,” or “layout.” Also, avoid using vague language, such as “design” or “entire work.”

Prof. Rantanen’s notes about idea/expression and *Baker*

[Previously] we discussed the idea that copyright is limited to material that possesses the requisite “originality,” and does not extend to facts. Rather, copyrightable subject matter is limited to creative expression.

Today, we will explore another key limit on copyrightable subject matter: the idea/expression dichotomy. *Baker v. Selden*, involves copyright over blank

forms in a book describing an accounting system and long predates our modern copyright act. (The most relevant provision of the Copyright Act of 1831 is provided below.) However, it is frequently referred to as a foundational authority for the distinction between expression, which can be copyrighted, and ideas, which cannot. After reading *Baker*, you should look at the way that this “idea/expression dichotomy” has been articulated in contemporary statutory law at 17 U.S.C. § 102(b). As we discuss this dichotomy, we will also talk about situations where there is only one or a few ways to express a particular idea.

As you read *Baker*, ask yourself the following questions:

- What underlying policies are at play in this opinion? How do those policies manifest themselves in the law?
- What is the primary legal issue in this case? How and why does the Court draw the line where it does?
- Based on this opinion, how would you determine whether something is or is not copyrightable?
- What challenges do you foresee with the application of the idea/expression dichotomy?

Copyright Act of 1831

Be it enacted by the Senate and House of Representatives of the United States of America, in Congress assembled, That from and after the passing of this act, any person or persons, being a citizen or citizens of the 15 United States or resident therein, who shall be the author or authors of any book or books, map, chart, or musical composition, which may be now made or composed, and not printed and published, or shall hereafter be made or composed, or who shall invent, design, etch, engrave, work, or cause to be engraved, etched, or worked from his own design, any print or engraving, and the executors, administrators, or legal assigns of such person or persons, shall have the sole right and liberty of printing, reprinting, publishing, and vending such book or books, map, chart, musical composition, print, cut, or engraving, in whole or in part, for the term of twenty-eight years from the time of recording the title thereof, in the manner hereinafter directed.

(The full text of the act can be found at:

https://www.copyright.gov/history/Copyright_Enactments_1783-1973.pdf)

17 U.S.C. §102. Subject matter of copyright: In general (1990)

(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

- (1) literary works;
- (2) musical works, including any accompanying words;
- (3) dramatic works, including any accompanying music;
- (4) pantomimes and choreographic works;
- (5) pictorial, graphic, and sculptural works;
- (6) motion pictures and other audiovisual works;
- (7) sound recordings; and
- (8) architectural works.

(b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

Prof. EEJ's notes on *Baker v. Selden*

You're about to read *Baker*. This is an old case, and it refers to statute that Congress has long since replaced. But when it comes to describing the idea/expression dichotomy, *Baker* remains the leading case, and it is very much a part of contemporary law.

Case: Baker v. Selden

Baker v. Selden

Supreme Court of the United States
101 U.S. 99 (1879)

MR. JUSTICE BRADLEY delivered the opinion of the court.

Charles Selden, the testator of the complainant in this case, in the year 1859 took the requisite steps for obtaining the copyright of a book, entitled "Selden's Condensed Ledger, or Book-keeping Simplified," the object of which was to exhibit and explain a peculiar system of book-keeping. In 1860 and 1861, he took the copyright of several other books, containing additions to and improvements upon the said system. The bill of complaint was filed against the defendant, Baker, for an alleged infringement of these copyrights. The latter, in his answer, denied that Selden was the author or designer of the books, and denied the infringement charged, and contends on the argument that the matter alleged to be infringed is not a lawful subject of copyright.

The parties went into proofs, and the various books of the complainant, as well as those sold and used by the defendant, were exhibited before the examiner, and witnesses were examined on both sides. A decree was rendered for the complainant, and the defendant appealed.

The book or series of books of which the complainant claims the copyright consists of an introductory essay explaining the system of book-keeping referred to, to which are annexed certain forms or blanks, consisting of ruled lines, and headings, illustrating the system and showing how it is to be used and carried out in practice. This system effects the same results as book-keeping by double entry; but, by a peculiar arrangement of columns and headings, presents the entire operation, of a day, a week, or a month, on a single page, or on two pages facing each other, in an account-book. The defendant uses a similar plan so far as results are concerned; but makes a different arrangement of the columns, and uses different headings. If the complainant's testator had the exclusive right to the use of the system explained in his book, it would be difficult to contend that the defendant does not infringe it, notwithstanding the difference in his form of arrangement; but if it be assumed that the system is open to public use, it seems to be equally difficult to contend that the books made and sold by the defendant are a

violation of the copyright of the complainant's book considered merely as a book explanatory of the system. Where the truths of a science or the methods of an art are the common property of the whole world, any author has the right to express the one, or explain and use the other, in his own way. As an author, Selden explained the system in a particular way. It may be conceded that Baker makes and uses account-books arranged on substantially the same system; but the proof fails to show that he has violated the copyright of Selden's book, regarding the latter merely as an explanatory work; or that he has infringed Selden's right in any way, unless the latter became entitled to an exclusive right in the system.

The evidence of the complainant is principally directed to the object of showing that Baker uses the same system as that which is explained and illustrated in Selden's books. It becomes important, therefore, to determine whether, in obtaining the copyright of his books, he secured the exclusive right to the use of the system or method of book-keeping which the said books are intended to illustrate and explain. It is contended that he has secured such exclusive right, because no one can use the system without using substantially the same ruled lines and headings which he has appended to his books in illustration of it. In other words, it is contended that the ruled lines and headings, given to illustrate the system, are a part of the book, and, as such, are secured by the copyright; and that no one can make or use similar ruled lines and headings, or ruled lines and headings made and arranged on substantially the same system, without violating the copyright. And this is really the question to be decided in this case. Stated in another form, the question is, whether the exclusive property in a system of book-keeping can be claimed, under the law of copyright, by means of a book in which that system is explained? The complainant's bill, and the case made under it, are based on the hypothesis that it can be.

There is no doubt that a work on the subject of book-keeping, though only explanatory of well-known systems, may be the subject of a copyright; but, then, it is claimed only as a book. Such a book may be explanatory either of old systems, or of an entirely new system; and, considered as a book, as the work of an author, conveying information on the subject of book-keeping, and containing detailed explanations of the art, it may be a very valuable acquisition to the practical knowledge of the community. But there is a clear distinction between the book, as such, and the art which it is intended to

illustrate. The mere statement of the proposition is so evident, that it requires hardly any argument to support it. The same distinction may be predicated of every other art as well as that of book-keeping. A treatise on the composition and use of medicines, be they old or new; on the construction and use of ploughs, or watches, or churns; or on the mixture and application of colors for painting or dyeing; or on the mode of drawing lines to produce the effect of perspective, — would be the subject of copyright; but no one would contend that the copyright of the treatise would give the exclusive right to the art or manufacture described therein. The copyright of the book, if not pirated from other works, would be valid without regard to the novelty, or want of novelty, of its subject-matter. The novelty of the art or thing described or explained has nothing to do with the validity of the copyright. To give to the author of the book an exclusive property in the art described therein, when no examination of its novelty has ever been officially made, would be a surprise and a fraud upon the public. That is the province of letters-patent, not of copyright. The claim to an invention or discovery of an art or manufacture must be subjected to the examination of the Patent Office before an exclusive right therein can be obtained; and it can only be secured by a patent from the government.

The difference between the two things, letters-patent and copyright, may be illustrated by reference to the subjects just enumerated. Take the case of medicines. Certain mixtures are found to be of great value in the healing art. If the discoverer writes and publishes a book on the subject (as regular physicians generally do), he gains no exclusive right to the manufacture and sale of the medicine; he gives that to the public. If he desires to acquire such exclusive right, he must obtain a patent for the mixture as a new art, manufacture, or composition of matter. He may copyright his book, if he pleases; but that only secures to him the exclusive right of printing and publishing his book. So of all other inventions or discoveries.

The copyright of a book on perspective, no matter how many drawings and illustrations it may contain, gives no exclusive right to the modes of drawing described, though they may never have been known or used before. By publishing the book, without getting a patent for the art, the latter is given to the public. The fact that the art described in the book by illustrations of lines and figures which are reproduced in practice in the application of the art, makes no difference. Those illustrations are the mere language employed by the author to convey his ideas more clearly. Had he used words of description

instead of diagrams (which merely stand in the place of words), there could not be the slightest doubt that others, applying the art to practical use, might lawfully draw the lines and diagrams which were in the author's mind, and which he thus described by words in his book.

The copyright of a work on mathematical science cannot give to the author an exclusive right to the methods of operation which he propounds, or to the diagrams which he employs to explain them, so as to prevent an engineer from using them whenever occasion requires. The very object of publishing a book on science or the useful arts is to communicate to the world the useful knowledge which it contains. But this object would be frustrated if the knowledge could not be used without incurring the guilt of piracy of the book. And where the art it teaches cannot be used without employing the methods and diagrams used to illustrate the book, or such as are similar to them, such methods and diagrams are to be considered as necessary incidents to the art, and given therewith to the public; not given for the purpose of publication in other works explanatory of the art, but for the purpose of practical application.

Of course, these observations are not intended to apply to ornamental designs, or pictorial illustrations addressed to the taste. Of these it may be said, that their form is their essence, and their object, the production of pleasure in their contemplation. This is their final end. They are as much the product of genius and the result of composition, as are the lines of the poet or the historian's periods. On the other hand, the teachings of science and the rules and methods of useful art have their final end in application and use; and this application and use are what the public derive from the publication of a book which teaches them. But as embodied and taught in a literary composition or book, their essence consists only in their statement. This alone is what is secured by the copyright. The use by another of the same methods of statement, whether in words or illustrations, in a book published for teaching the art, would undoubtedly be an infringement of the copyright.

Recurring to the case before us, we observe that Charles Selden, by his books, explained and described a peculiar system of book-keeping, and illustrated his method by means of ruled lines and blank columns, with proper headings on a page, or on successive pages. Now, whilst no one has a right to print or publish his book, or any material part thereof, as a book intended to convey instruction in the art, any person may practise [sic] and use the art itself which he has described and illustrated therein. The use of the art is a totally

different thing from a publication of the book explaining it. The copyright of a book on book-keeping cannot secure the exclusive right to make, sell, and use account-books prepared upon the plan set forth in such book. Whether the art might or might not have been patented, is a question which is not before us. It was not patented, and is open and free to the use of the public. And, of course, in using the art, the ruled lines and headings of accounts must necessarily be used as incident to it.

The plausibility of the claim put forward by the complainant in this case arises from a confusion of ideas produced by the peculiar nature of the art described in the books which have been made the subject of copyright. In describing the art, the illustrations and diagrams employed happen to correspond more closely than usual with the actual work performed by the operator who uses the art. Those illustrations and diagrams consist of ruled lines and headings of accounts; and it is similar ruled lines and headings of accounts which, in the application of the art, the book-keeper makes with his pen, or the stationer with his press; whilst in most other cases the diagrams and illustrations can only be represented in concrete forms of wood, metal, stone, or some other physical embodiment. But the principle is the same in all. The description of the art in a book, though entitled to the benefit of copyright, lays no foundation for an exclusive claim to the art itself. The object of the one is explanation; the object of the other is use. The former may be secured by copyright. The latter can only be secured, if it can be secured at all, by letters-patent.

Another case, that of *Page v. Wisden* (20 L.T.N.S. 435), which came before Vice-Chancellor Malins in 1869, has some resemblance to the present. There a copyright was claimed in a cricket scoring-sheet, and the Vice-Chancellor held that it was not a fit subject for copyright, because “to say that a particular mode of ruling a book constituted an object for a copyright is absurd.”

The conclusion to which we have come is, that blank account-books are not the subject of copyright; and that the mere copyright of Selden’s book did not confer upon him the exclusive right to make and use account-books, ruled and arranged as designated by him and described and illustrated in said book.

The decree of the Circuit Court must be reversed, and the cause remanded with instructions to dismiss the complainant’s bill; and it is

So ordered.

Case: Morrissey v. Procter & Gamble

Morrissey v. Procter & Gamble Co.

U.S. Court of Appeals for the First Circuit
379 F.2d 675 (1st Cir. 1967)

ALDRICH, Chief Judge.

This is an appeal from a summary judgment for the defendant. The plaintiff, Morrissey, is the copyright owner of a set of rules for a sales promotional contest of the 'sweepstakes' type involving the social security numbers of the participants. Plaintiff alleges that the defendant, Procter & Gamble Company, infringed, by copying, almost precisely, Rule 1. In its motion for summary judgment, based upon affidavits and depositions, defendant denies that plaintiff's Rule 1 is copyrightable material, and denies access. The district court held for the defendant on both grounds.

Taking the second ground first, the defendant offered affidavits or depositions of all of its allegedly pertinent employees, all of whom denied having seen plaintiff's rules. Although the plaintiff, by deposition, flatly testified that prior to the time the defendant conducted its contest he had mailed to the defendant his copyrighted rules with an offer to sell, the court ruled that the defendant had 'proved' nonaccess, and stated that it was 'satisfied that no material issue as to access *** lurks *** (in the record.)'

The court did not explain whether it considered defendant's showing to have constituted proof overcoming the presumption of receipt arising from plaintiff's testimony of mailing, or whether it felt there was an unsatisfied burden on the plaintiff to show that the particularly responsible employees of the defendant had received his communication. Either view would have been error. A notice to the defendant at its principal office, as this one assertedly was, is proper notice. There is at least an inference that the letter reached its proper destination. Even if we assume that if, at the trial of the case, it should be found that the particular employees of the defendant responsible for the contest were in fact without knowledge of plaintiff's rules, defendant would be free of a charge of copying, cf. *Pinci v. Twentieth Century-Fox Film Corp.*, S.D.N.Y., 1951, 95 F.Supp. 884; *Dezendorf v. Twentieth Century-Fox Film Corp.*, S.D.Cal., 1940, 32 F.Supp. 359, *aff'd*, 9 Cir., 118 F.2d 561, on a motion for summary judgment a plaintiff should not have to go to the point of

showing that every employee of a corporate defendant received his notification. Nor can it be said that no issue of fact as to access 'lurks' merely because it seems to the court that plaintiff's own proof has been satisfactorily contradicted. Nothing is clearer than this on a motion for summary judgment; if a party has made an evidentiary showing warranting a favorable inference, contradiction cannot eliminate it. Summary judgment may not be granted where there is the 'slightest doubt as to the facts.' *Peckham v. Ronrico Corp.*, 1 Cir., 1948, 171 F.2d 653, 657; *Arnstein v. Porter*, 2 Cir., 1946, 154 F.2d 464, 468. Defendant's argument misreads *Dressler v. MV Sandpiper*, 2 Cir., 1964, 331 F.2d 130. The presumption arising from mailing remained in the case.~

It is true that we have, on rare occasion, held that even though there is some slight evidence favoring a plaintiff, the evidence contrary may be so overpowering that a verdict for the plaintiff cannot be permitted, and judgment must be ordered for the defendant. *Dehydrating Process Co. v. A. O. Smith Corp.*, 1 Cir., 1961, 292 F.2d 653, cert. den. 368 U.S. 931, 82 S.Ct. 368, 7 L.Ed.2d 194; see *Magnat Corp. v. B & B Electroplating Co.*, 1 Cir., 1966, 358 F.2d 794. We have never suggested that such a principle is applicable to a motion for summary judgment, and we do not now.~ Cf. *Robbins v. Milner Enterprises, Inc.*, 5 Cir., 1960, 278 F.2d 492, 496-497.

The second aspect of the case raises a more difficult question. Before discussing it we recite plaintiff's Rule 1, and defendant's Rule 1, the italicizing in the latter being ours to note the defendant's variations or changes.

[Plaintiff Morrissey's rule:]

'1. Entrants should print name, address and social security number on a boxtop, or a plain paper. Entries must be accompanied by * * * boxtop or by plain paper on which the name * * * is copied from any source. Official rules are explained on * * * packages or leaflets obtained from dealer. If you do not have a social security number you may use the name and number of any member of your immediate family living with you. Only the person named on the entry will be deemed an entrant and may qualify for prize.

'Use the correct social security number belonging to the person named on entry * * * wrong number will be disqualified.'~

[Defendant Procter & Gamble's rule for the Tide Sweepstakes:]

'1. Entrants should print name, address and Social Security number on a Tide boxtop, or *on* (a) plain paper. Entries must be accompanied by Tide boxtop (*any size*) or by plain paper on which the name 'Tide' is copied from any source. Official rules are *available* on Tide Sweepstakes packages, or *on* leaflets at Tide dealers, or you can send a stamped, self-addressed envelope to: Tide 'Shopping Fling' Sweepstakes, P.O. Box 4459, Chicago 77, Illinois.

'If you do not have a Social Security number, you may use the name and number of any member of your immediate family living with you. Only the person named on the entry will be deemed an entrant and may qualify for a prize.

'Use the correct Social Security number, belonging to the person named on *the* entry— wrong numbers will be disqualified.'

The district court, following an earlier decision, *Gaye v. Gillis*, D.Mass., 1958, 167 F.Supp. 416, took the position that since the substance of the contest was not copyrightable, which is unquestionably correct, *Baker v. Selden*, 1879, 101 U.S. 99, 25 L.Ed. 841; *Affiliated Enterprises v. Gruber*, 1 Cir., 1936, 86 F.2d 958; *Chamberlin v. Uris Sales Corp.*, 2 Cir., 1945, 150 F.2d 512, and the substance was relatively simple, it must follow that plaintiff's rule sprung directly from the substance and 'contains no original creative authorship.' 262 F.Supp. at 738. This does not follow. Copyright attaches to form of expression, and defendant's own proof, introduced to deluge the court on the issue of access, itself established that there was more than one way of expressing even this simple substance. Nor, in view of the almost precise similarity of the two rules, could defendant successfully invoke the principle of a stringent standard for showing infringement which some courts apply when the subject matter involved admits of little variation in form of expression. E.g., *Dorsey v. Old Surety Life Ins. Co.*, 10 Cir., 1938, 98 F.2d 872, 874, 119 A.L.R. 1250 ('a showing of appropriation in the exact form or substantially so.');

Continental Casualty Co. v. Beardsley, 2 Cir., 1958, 253 F.2d 702, 705, cert. denied, 358 U.S. 816, 79 S.Ct. 25, 3 L.Ed.2d 58 ('a stiff standard for proof of infringement.').

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FROM IDEAS, METHODS, SYSTEMS, ETC.

Nonetheless, we must hold for the defendant. When the uncopyrightable subject matter is very narrow, so that ‘the topic necessarily requires,’ *Sampson & Murdock Co. v. Seaver-Radford Co.*, 1 Cir., 1905, 140 F. 539, 541; cf. Kaplan, *An Unhurried View of Copyright*, 64-65 (1967), if not only one form of expression, at best only a limited number, to permit copyrighting would mean that a party or parties, by copyrighting a mere handful of forms, could exhaust all possibilities of future use of the substance. In such circumstances it does not seem accurate to say that any particular form of expression comes from the subject matter. However, it is necessary to say that the subject matter would be appropriated by permitting the copyrighting of its expression. We cannot recognize copyright as a game of chess in which the public can be checkmated. Cf. *Baker v. Selden*, *supra*.

Upon examination the matters embraced in Rule 1 are so straightforward and simple that we find this limiting principle to be applicable. Furthermore, its operation need not await an attempt to copyright all possible forms. It cannot be only the last form of expression which is to be condemned, as completing defendant’s exclusion from the substance. Rather, in these circumstances, we hold that copyright does not extend to the subject matter at all, and plaintiff cannot complain even if his particular expression was deliberately adopted.

Affirmed.

Rights, Licensing, Attribution, Disclaimers, and More

The following was written by Eric E. Johnson:

This chapter (Chapter C-2, “Copyrightable Subject Matter: Distinguishing Expression from Ideas, Methods, Systems, Etc.”) was made in its current form by Eric E. Johnson by starting with Chapter 4, “The idea/expression dichotomy” of *Introduction To Intellectual Property Cases and Questions Fall 2021 Edition* authored and published by **Jason Rantanen**. © 2021 Jason Rantanen, licensed under the Creative Commons Attribution-Noncommercial 4.0 International License (CC BY-NC 4.0), available at <https://creativecommons.org/licenses/by-nc/4.0/>. That license contains a disclaimer of warranties and a statement of limitation of liability. The original work is available at <http://ssrn.com/abstract=3883500>. A printed version is available on Amazon.

Starting with Professor Rantanen’s chapter, I changed some things, removed some material, and added substantial material. Throughout, I made formatting changes, including to typography, pagination, paragraph styling, heading styles, etc., including replacing double spaces with single spaces. The chapter title is different. I added “Notes from Prof. Rantanen” as a header to mark expository text authored by Professor Rantanen and to highlight the fact that it is his. Within that text, I omitted the learning objectives and replaced “In a previous class” with “Previously,” which I set off in square brackets. I removed statutory text from tables and formatted it as regular text. I added the header “Case: Baker v. Selden” and in the information about the case, I added “Supreme Court of the United States.”

I added the “Prof. EEJ notes on” and “Copyright Office on” portions. I added the Morrissey case.

In Professor Rantanen’s original book, the following appeared (paragraph breaks have been omitted): “Copyright © 2021 Jason Rantanen. This work is licensed under a Creative Commons Attribution-Noncommercial 4.0 International License. Contact jason-rantanen@uiowa.edu to request additional permissions. No copyright is claimed to works in the public domain.”

I am very grateful to Jason Rantanen for his generosity in sharing his excellent materials!

Note on editing marks: The superscript tilde (~) indicates omitted material – including, for instance, whether that text is from Professor Rantanen, the Copyright Office, or a court. I used square brackets to indicate insertions, which may also include a corresponding deletion in the same place.

For my own separately copyrightable contributions to this chapter and the resulting chapter as a whole: © 2022 Eric E. Johnson. I license this chapter

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FROM IDEAS, METHODS, SYSTEMS, ETC.

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-EEJ

Chapter C-3: Copyright Registration, Notice, Duration, and the Public Domain

This chapter was authored by Eric E. Johnson.
Please see “Rights, Licensing, Etc.” at the end
of this chapter.

Judicial explanation of when copyright registration is necessary

*from Fourth Est. Pub. Benefit Corp. v. Wall-Street.com, LLC, 139 S. Ct. 881, 887-88
(U.S. 2019)*

Under the Copyright Act of 1976, as amended, copyright protection attaches to “original works of authorship”—prominent among them, literary, musical, and dramatic works—“fixed in any tangible medium of expression.” 17 U.S.C. § 102(a). An author gains “exclusive rights” in her work immediately upon the work’s creation, including rights of reproduction, distribution, and display. See § 106; *Eldred v. Ashcroft*, 537 U.S. 186, 195, 123 S.Ct. 769, 154 L.Ed.2d 683 (2003) (“[F]ederal copyright protection ... run[s] from the work’s creation.”). The Copyright Act entitles a copyright owner to institute a civil action for infringement of those exclusive rights. § 501(b).

Before pursuing an infringement claim in court, however, a copyright claimant generally must comply with § 411(a)’s requirement that “registration of the copyright claim has been made.” § 411(a). Therefore, although an owner’s rights exist apart from registration, see § 408(a), registration is akin to an administrative exhaustion requirement that the owner must satisfy before suing to enforce ownership rights, see Tr. of Oral Arg. 35.

In limited circumstances, copyright owners may file an infringement suit before undertaking registration. If a copyright owner is preparing to distribute a work of a type vulnerable to predistribution infringement—notably, a movie or musical composition—the owner may apply for preregistration. § 408(f)(2); 37 CFR § 202.16(b)(1) (2018). The Copyright Office will “conduct a limited review” of the application and notify the claimant “[u]pon completion of the preregistration.” § 202.16(c)(7), (c)(10). Once “preregistration ... has been made,” the copyright claimant may institute a suit for infringement. 17 U.S.C. § 411(a). Preregistration, however, serves only as “a preliminary step prior to a full registration.” Preregistration of Certain Unpublished Copyright Claims, 70 Fed. Reg. 42286 (2005). An infringement suit brought in reliance on preregistration risks dismissal unless the copyright owner applies for registration promptly after the preregistered work’s publication or infringement. § 408(f)(3)–(4). A copyright owner may also sue for infringement of a live broadcast before “registration ... has been made,” but faces dismissal of her suit if she fails to “make registration for the work” within three months of its first transmission. § 411(c). Even in these exceptional scenarios, then, the copyright owner must eventually pursue registration in order to maintain a suit for infringement.

Copyright Office on copyright notices

from Circular 3: Copyright Notice, revised 03/2021

[Synopsis/sidebar:]

Copyright notice provides information to the public regarding copyright ownership. Notice is optional for works created after March 1, 1989, but is generally required for works created before that date.

[Main text:]

Copyright notice is a statement placed on copies or phonorecords of a work to inform the public that a copyright owner is claiming ownership of it. A notice consists of three elements that generally appear as a single continuous statement:

- The copyright symbol © (or for phonorecords, the symbol ℗); the word “copyright”; or the abbreviation “copr.”;
- The year of first publication of the work; and

- The name of the copyright owner.

Example: © 2017 John Doe

The use of a copyright notice is the responsibility of the copyright owner and does not require permission from, or registration with, the Copyright Office.

Copyright notice was required for all works first published before March 1, 1989, subject to some exceptions discussed below. If the notice was omitted or a mistake was made in using copyright notice, the work generally lost copyright protection in the United States. Copyright notice is optional for works published on or after March 1, 1989, unpublished works, and foreign works; however, there are legal benefits for including notice on your work.

Works Requiring Notice

Different laws govern works first published before January 1, 1978, and works first published between January 1, 1978, and February 28, 1989.

Copies That Must Display Notice

In general, for works first published before March 1, 1989, the copyright owner was required to place an effective notice on all publicly distributed “visually perceptible” copies. A visually perceptible copy is one that can be seen or read, either directly or with the aid of a machine. Examples of visually perceptible copies include a book, sheet music, a photograph, or film. A visually perceptible copy does not include a CD, a vinyl record, or an .MP3 recording of a literary, dramatic, or musical work.

When a copyright owner published a phonorecord that embodied a sound recording, an effective notice had to appear on all publicly distributed phonorecords. The phonorecord symbol—Ⓢ—was needed only for publicly distributed copies of a sound recording embodied in a phonorecord.

Form of Notice

An effective notice includes three general elements, as described above, as a single continuous statement. It was permissible to omit the year of publication for works reproduced on greeting cards, postcards, stationary, jewelry, dolls, toys, or any useful article. See the following sections of chapter 2200 of the Compendium for specific issues regarding the elements of notice:

- Section 2204.4 for variations on the © or ® symbol, or the word “copyright”
- Section 2205.1 for variations on the year of publication
- Section 2205.2 for variations on the name of the copyright owner

Placement of Notice

The copyright notice had to be placed on copies or phonorecords in a way that was permanently legible to an ordinary user of the work and could not be concealed from view upon reasonable examination. The Office adopted specific regulations for the placement of notice on [various types of works, including literary works, contributions to collective works, musical works, sound recordings, motion pictures, pictorial/graphic/sculptural works, and machine-readable copies of works].

Omission of Notice and Errors of Notice

An omission or mistake in using a copyright notice may not have invalidated the copyright to works published between January 1, 1978 and March 1, 1989, if

- The notice was omitted from no more than a relatively small number of copies or phonorecords distributed to the public;
- The work was registered before or within five years after the publication without notice and a reasonable effort was made to add notice to all copies or phonorecords distributed in the United States after the omission was discovered;
- The omission violated an express written agreement to include proper notice as a condition of public distribution of copies or phonorecords; or,
- The notice was removed from the copies or phonorecords without the authorization of the copyright owner.

When Notice Is Optional

Copyright notice is optional for unpublished works, foreign works, or works published on or after March 1, 1989. When notice is optional, copyright owners can use any form of notice they wish. However, works first published after March 1, 1989, may need to comply with statutory formalities to prevent a defendant from invoking an innocent infringement defense in a copyright infringement action.

Unpublished Works

A copyright notice has never been required for unpublished works. The Copyright Office will register an unpublished work that does not bear a notice, regardless of whether the work was created before or after March 1, 1989. Nonetheless, because the dividing line between a preliminary distribution and actual publication is sometimes difficult to determine, copyright owners may want to place copyright notices on copies or phonorecords that leave their control to indicate that rights are claimed in a work. For example, an appropriate notice for an unpublished work is “Unpublished Letters of John Doe © 2017 John Doe,” where 2017 refers to the year the work was created.

Foreign Works and the Uruguay Round Agreements Act

For certain foreign works, the Uruguay Round Agreements Act (URAA) of 1994 modifies the effect of publication without notice. The URAA restored copyrights for foreign works that lost copyright protection in the United States for failure to comply with notice requirements prior to March 1, 1989. They include (a) works created by an author who, at the time of the work’s creation, was a citizen of, or domiciled in, a country that had entered into a copyright treaty with the United States, and (b) works first published, or sound recordings first fixed, in a country that had entered into a copyright treaty with the United States. Although restoration is automatic in eligible works, the URAA directs the owner of a restored work to notify reliance parties if the owner plans to enforce his or her rights in the work. For more information, see Copyright Restoration Under the URAA (Circular 38B).

Advantages to Using a Copyright Notice

Although notice is optional for unpublished works, foreign works, or works published on or after March 1, 1989, using a copyright notice carries the following benefits:

- Notice makes potential users aware that copyright is claimed in the work.
- In the case of a published work, a notice may prevent a defendant in a copyright infringement action from attempting to limit his or her liability for damages or injunctive relief based on an innocent infringement defense.

- Notice identifies the copyright owner at the time the work was first published for parties seeking permission to use the work.
- Notice identifies the year of first publication, which may be used to determine the term of copyright protection in the case of an anonymous work, a pseudonymous work, or a work made for hire.

Copyright Office on copyright duration

from Circular 15A: Duration of Copyright, revised 01/2022

The provisions of copyright law dealing with duration are complex. Different standards apply depending on whether federal statutory copyright protection was secured before or on or after January 1, 1978, the date the current law—the Copyright Act of 1976—took effect. In addition, several amendments enacted since January 1, 1978, affect duration. This circular describes the changes to the law that affect duration and gives details about terms of protection for copyrights secured and renewed on certain dates.

Works First Securing Federal Statutory Protection on or after January 1, 1978

For works securing federal statutory protection for the first time on or after January 1, 1978, the Copyright Act of 1976, as amended in 1998, establishes a single copyright term and different methods for computing the duration of a copyright. Works of this kind fall into two categories.

Works Created on or after January 1, 1978

The law automatically protects a work that is created and fixed in a tangible medium of expression on or after January 1, 1978, from the moment of its creation and gives it a term lasting for the author’s life plus an additional 70 years. For a “joint work prepared by two or more authors who did not work for hire,” the term lasts for 70 years after the last surviving author’s death. For works made for hire and anonymous and pseudonymous works, the duration of copyright is 95 years from first publication or 120 years from creation, whichever is shorter (unless the author’s identity is later revealed in Copyright Office records, in which case the term becomes the author’s life plus 70 years). For more information about works made for hire, see Circular 9, Works Made for Hire under the 1976 Copyright Act. For details about pseudonymous works, see fl 101, Pseudonyms.

Works in Existence but Not Published or Copyrighted on January 1, 1978

The law automatically gives federal copyright protection to works that were created but neither published nor registered before January 1, 1978. The duration of copyright in these works is generally computed the same way as for works created on or after January 1, 1978: life plus 70 years or 95 or 120 years, depending on the nature of authorship. However, all works in this category are guaranteed at least 25 years of statutory protection. The law specifies that in no case would copyright in a work in this category have expired before December 31, 2002. In addition, if a work in this category was published before that date, the term extends another 45 years, through the end of 2047.

Works Already Under Statutory Protection before 1978

For works that had already secured statutory copyright protection before January 1, 1978, the 1976 Copyright Act retains the system in the previous copyright law—the Copyright Act of 1909—for computing the duration of protection, but with some changes.

Duration under 1909 Act

Federal standards for copyright duration differ substantially under the 1909 act compared with the 1976 act because of the renewal term contained in the 1909 act. Under the 1909 act, federal copyright was secured on the date a work was published or, for unpublished works, on the date of registration. A copyright lasted for a first term of 28 years from the date it was secured. The copyright was eligible for renewal during the final, that is, 28th year, of the first term. If renewed, the copyright was extended for a second, or renewal, term of 28 years. If it was not renewed, the copyright expired at the end of the first 28-year term, and the work is no longer protected by copyright. The term of copyright for works published with a year date in the notice that is earlier than the actual date of publication is computed from the year date in the copyright notice.

Effect of 1976 Act on Length of Subsisting Copyrights

The 1976 Copyright Act carried over the system in the 1909 Copyright Act for computing copyright duration for works protected by federal statute before January 1, 1978, with one major change: the length of the renewal term was increased to 47 years. The 1998 Copyright Term Extension Act increased

the renewal term another 20 years to 67 years. Thus the maximum total term of copyright protection for works already protected by January 1, 1978, has been increased from 56 years (a first term of 28 years plus a renewal term of 28 years) to 95 years (a first term of 28 years plus a renewal term of 67 years). Applying these standards, all works published in the United States before January 1, 1927, are in the public domain.

Automatic Extension for Works in Renewal Term

Works originally copyrighted after 1922 and renewed before 1978. These works were automatically given a longer copyright term. Copyrights that had already been renewed and were in their second term at any time between December 31, 1976, and December 31, 1977, inclusive, do not need to be renewed again. They have been automatically extended to last for a total term of 95 years (a first term of 28 years plus a renewal term of 67 years) from the end of the year in which they were originally secured. For more information about renewal of copyright, see Circular 6A, Renewal of Copyright.

Copyright Extensions before 1976 Act

Before passage of the 1976 Copyright Act, Congress enacted a series of nine acts that provided interim extensions for works whose copyright protection began between September 19, 1906, and December 31, 1918, if they were in their renewal terms. Without these interim extensions, copyrights commencing during that time would have expired after 56 years, at the end of their renewal terms, between September 19, 1962, and December 31, 1976.

Example: A work that first secured federal copyright protection on October 5, 1907, and was renewed in 1935, would have fallen into the public domain after October 5, 1963. The first act extended the copyright to December 31, 1965; the second act extended it to December 31, 1967; the third act extended it to December 31, 1968; the fourth act extended it to December 31, 1969; the fifth act extended it to December 31, 1970; the sixth act extended it to December 31, 1971; the seventh act extended it to December 31, 1972; the eighth act extended it to December 31, 1974; the ninth extended it to December 31, 1976; and the 1976 Copyright Act extended the copyright through the end of 1982 (75 years from the end of the year in which the copyright was originally secured).

Mandatory Renewal

Works originally copyrighted between January 1, 1950, and December 31, 1963. Copyrights in their first 28-year term on January 1, 1978, still had to be renewed to be protected for the second term. If a valid renewal registration was made at the proper time, the second term will last for 67 years. However, if renewal registration for these works was not made within the statutory time limits, a copyright originally secured between 1950 and 1963 expired on December 31 of its 28th year, and protection was lost permanently.

Automatic Renewal and Voluntary Registration

Works originally copyrighted between January 1, 1964, and December 31, 1977. Congress amended the copyright law on June 26, 1992, to automatically renew the copyright in these works and to make renewal registration for them optional. Their copyright term is still divided between a 28-year original term and a 67-year renewal term, but a renewal registration is not required to secure the renewal copyright. The renewal vests on behalf of the appropriate renewal claimant upon renewal registration or, if there is no renewal registration, on December 31 of the 28th year. For details about the benefits of making a renewal registration, see Circular 6A, Renewal of Copyright.

Year-End Expiration of Copyright Terms

The 1976 Copyright Act provides that all terms of copyright will run through the end of the calendar year in which they expire. This provision affects the duration of all copyrights, including those in either their first or their second term on January 1, 1978. For works eligible for renewal, the renewal filing period begins on December 31 of the 27th year of the copyright term.

Restoration of Copyright in Certain Foreign Works

Under the provisions of the Uruguay Round Agreements Act (URAA), certain foreign works whose U.S. copyright protection had been lost because of noncompliance with formalities of U.S. law, were restored as of January 1, 1996. Among the informalities subject to restoration is failure to renew. Restoration occurs automatically, and the duration of the restored term is based on the term of protection the work would have had without the informality. For details, see Circular 38b, Highlights of Copyright Amendments Contained in the URAA.

Statutory law excluding federal government works from copyright

17 U.S.C. § 105 – Subject matter of copyright: United States Government works

(a) In General.—

Copyright protection under this title is not available for any work of the United States Government, but the United States Government is not precluded from receiving and holding copyrights transferred to it by assignment, bequest, or otherwise.

(b) Copyright Protection of Certain of Works.—

Subject to subsection (c), the covered author of a covered work owns the copyright to that covered work.

(c) Use by Federal Government.—

The Secretary of Defense may direct the covered author of a covered work to provide the Federal Government with an irrevocable, royalty-free, world-wide, nonexclusive license to reproduce, distribute, perform, or display such covered work for purposes of the United States Government.

(c)[*sic*; This is the second of two subsections “(c)” as enacted by Congress. –EEJ] Definitions.—In this section:

(1) The term “covered author” means a civilian member of the faculty of a covered institution.

(2) The term “covered institution” means the following:

(A) National Defense University.

(B) United States Military Academy.

(C) Army War College.

(D) United States Army Command and General Staff College.

(E) United States Naval Academy.

(F) Naval War College.

(G) Naval Post Graduate School.

(H) Marine Corps University.

(I) United States Air Force Academy.

(J) Air University.

(K) Defense Language Institute.

(L) United States Coast Guard Academy.

(3) The term “covered work” means a literary work produced by a covered author in the course of employment at a covered institution for publication by a scholarly press or journal.

Case: Georgia v. Public.Resource.Org

Georgia v. Public.Resource.Org, Inc.

U.S. Supreme Court

April 27, 2020

140 S.Ct. 1498 (2020)

ROBERTS, C.J., delivered the opinion of the Court, in which SOTOMAYOR, KAGAN, GORSUCH, and KAVANAUGH, JJ., joined. THOMAS, J., filed a dissenting opinion, in which ALITO, J., joined, and in which BREYER, J., joined in part. GINSBURG, J., filed a dissenting opinion, in which BREYER, J., joined.

[Note: All italicization and footnotes are omitted in this excerpt. –EEJ]

Chief Justice ROBERTS delivered the opinion of the Court.

The Copyright Act grants potent, decades-long monopoly protection for “original works of authorship.” 17 U.S.C. § 102(a). The question in this case is whether that protection extends to the annotations contained in Georgia’s official annotated code.

We hold that it does not. Over a century ago, we recognized a limitation on copyright protection for certain government work product, rooted in the Copyright Act’s “authorship” requirement. Under what has been dubbed the government edicts doctrine, officials empowered to speak with the force of law cannot be the authors of—and therefore cannot copyright—the works they create in the course of their official duties.

We have previously applied that doctrine to hold that non-binding, explanatory legal materials are not copyrightable when created by judges who possess the authority to make and interpret the law. See *Banks v. Manchester*,

128 U.S. 244, 9 S.Ct. 36, 32 L.Ed. 425 (1888). We now recognize that the same logic applies to non-binding, explanatory legal materials created by a legislative body vested with the authority to make law. Because Georgia’s annotations are authored by an arm of the legislature in the course of its legislative duties, the government edicts doctrine puts them outside the reach of copyright protection.

I

A

The State of Georgia has one official code—the “Official Code of Georgia Annotated,” or OCGA. The first page of each volume of the OCGA boasts the State’s official seal and announces to readers that it is “Published Under Authority of the State.”

The OCGA includes the text of every Georgia statute currently in force, as well as various non-binding supplementary materials. At issue in this case is a set of annotations that appear beneath each statutory provision. The annotations generally include summaries of judicial decisions applying a given provision, summaries of any pertinent opinions of the state attorney general, and a list of related law review articles and similar reference materials. In addition, the annotations often include editor’s notes that provide information about the origins of the statutory text, such as whether it derives from a particular judicial decision or resembles an older provision that has been construed by Georgia courts. See, e.g., OCGA §§ 51–1–1, 53–4–2 (2019).

The OCGA is assembled by a state entity called the Code Revision Commission. In 1977, the Georgia Legislature established the Commission to recodify Georgia law for the first time in decades. The Commission was (and remains) tasked with consolidating disparate bills into a single Code for reenactment by the legislature and contracting with a third party to produce the annotations. A majority of the Commission’s 15 members must be members of the Georgia Senate or House of Representatives. The Commission receives funding through appropriations “provided for the legislative branch of state government.” OCGA § 28–9–2(c) (2018). And it is staffed by the Office of Legislative Counsel, which is obligated by statute to provide services “for the legislative branch of government.” §§ 28–4–3(c)(4), 28–9–4. Under the Georgia Constitution, the Commission’s role in compiling the statutory text and accompanying annotations falls “within the sphere of legislative

authority.” *Harrison Co. v. Code Revision Comm'n*, 244 Ga. 325, 330, 260 S.E.2d 30, 34 (1979).

Each year, the Commission submits its proposed statutory text and accompanying annotations to the legislature for approval. The legislature then votes to do three things: (1) “enact[]” the “statutory portion of the codification of Georgia laws”; (2) “merge[]” the statutory portion “with [the] annotations”; and (3) “publish[]” the final merged product “by authority of the state” as “the ‘Official Code of Georgia Annotated.’” OCGA § 1-1-1 (2019); see *Code Revision Comm'n v. Public.Resource.Org, Inc.*, 906 F.3d 1229, 1245, 1255 (CA11 2018); Tr. of Oral Arg. 8.

The annotations in the current OCGA were prepared in the first instance by Matthew Bender & Co., Inc., a division of the LexisNexis Group, pursuant to a work-for-hire agreement with the Commission. The agreement between Lexis and the Commission states that any copyright in the OCGA vests exclusively in “the State of Georgia, acting through the Commission.” App. 567. Lexis and its army of researchers perform the lion's share of the work in drafting the annotations, but the Commission supervises that work and specifies what the annotations must include in exacting detail. See 906 F.3d at 1243–1244; App. 269–278, 286–427 (Commission specifications). Under the agreement, Lexis enjoys the exclusive right to publish, distribute, and sell the OCGA. In exchange, Lexis has agreed to limit the price it may charge for the OCGA and to make an unannotated version of the statutory text available to the public online for free. A hard copy of the complete OCGA currently retails for \$412.00.

B

Public.Resource.Org (PRO) is a nonprofit organization that aims to facilitate public access to government records and legal materials. Without permission, PRO posted a digital version of the OCGA on various websites, where it could be downloaded by the public without charge. PRO also distributed copies of the OCGA to various organizations and Georgia officials.

In response, the Commission sent PRO several cease-and-desist letters asserting that PRO's actions constituted unlawful copyright infringement. When PRO refused to halt its distribution activities, the Commission sued PRO on behalf of the Georgia Legislature and the State of Georgia for copyright infringement. The Commission limited its assertion of copyright to

the annotations described above; it did not claim copyright in the statutory text or numbering. PRO counterclaimed, seeking a declaratory judgment that the entire OCGA, including the annotations, fell in the public domain.

The District Court sided with the Commission. The Court acknowledged that the annotations in the OCGA presented “an unusual case because most official codes are not annotated and most annotated codes are not official.” *Code Revision Comm’n v. Public.Resource.Org, Inc.*, 244 F.Supp.3d 1350, 1356 (ND Ga. 2017). But, ultimately, the Court concluded that the annotations were eligible for copyright protection because they were “not enacted into law” and lacked “the force of law.” *Ibid.* In light of that conclusion, the Court granted partial summary judgment to the Commission and entered a permanent injunction requiring PRO to cease its distribution activities and to remove the digital copies of the OCGA from the internet.

The Eleventh Circuit reversed. 906 F.3d 1229. The Court began by reviewing the three 19th-century cases in which we articulated the government edicts doctrine. See *Wheaton v. Peters*, 8 Pet. 591, 8 L.Ed. 1055 (1834); *Banks v. Manchester*, 128 U.S. 244, 9 S.Ct. 36, 32 L.Ed. 425 (1888); *Callaghan v. Myers*, 128 U.S. 617, 9 S.Ct. 177, 32 L.Ed. 547 (1888). The Court understood those cases to establish a “rule” based on an interpretation of the statutory term “author” that “works created by courts in the performance of their official duties did not belong to the judges” but instead fell “in the public domain.” 906 F.3d at 1239. In the Court’s view, that rule “derive[s] from first principles about the nature of law in our democracy.” *Ibid.* In a democracy, the Court reasoned, “the People” are “the constructive authors” of the law, and judges and legislators are merely “draftsmen ... exercising delegated authority.” *Ibid.* The Court therefore deemed the “ultimate inquiry” to be whether a work is “attributable to the constructive authorship of the People.” *Id.*, at 1242. The Court identified three factors to guide that inquiry: “the identity of the public official who created the work; the nature of the work; and the process by which the work was produced.” *Id.*, at 1254. The Court found that each of those factors cut in favor of treating the OCGA annotations as government edicts authored by the People. It therefore rejected the Commission’s assertion of copyright, vacated the injunction against PRO, and directed that judgment be entered for PRO.

We granted certiorari. 588 U.S. ----, 139 S.Ct. 2746, 204 L.Ed.2d 1130 (2019).

II

We hold that the annotations in Georgia's Official Code are ineligible for copyright protection, though for reasons distinct from those relied on by the Court of Appeals. A careful examination of our government edicts precedents reveals a straightforward rule based on the identity of the author. Under the government edicts doctrine, judges—and, we now confirm, legislators—may not be considered the “authors” of the works they produce in the course of their official duties as judges and legislators. That rule applies regardless of whether a given material carries the force of law. And it applies to the annotations here because they are authored by an arm of the legislature in the course of its official duties.

A

We begin with precedent. The government edicts doctrine traces back to a trio of cases decided in the 19th century. In this Court's first copyright case, *Wheaton v. Peters*, 8 Pet. 591, 8 L.Ed. 1055 (1834), the Court's third Reporter of Decisions, Wheaton, sued the fourth, Peters, unsuccessfully asserting a copyright interest in the Justices' opinions. *Id.*, at 617 (argument). In Wheaton's view, the opinions “must have belonged to some one” because “they were new, original,” and much more “elaborate” than law or custom required. *Id.*, at 615. Wheaton argued that the Justices were the authors and had assigned their ownership interests to him through a tacit “gift.” *Id.*, at 614. The Court unanimously rejected that argument, concluding that “no reporter has or can have any copyright in the written opinions delivered by this court” and that “the judges thereof cannot confer on any reporter any such right.” *Id.*, at 668 (opinion).

That conclusion apparently seemed too obvious to adorn with further explanation, but the Court provided one a half century later in *Banks v. Manchester*, 128 U.S. 244, 9 S.Ct. 36, 32 L.Ed. 425 (1888). That case concerned whether Wheaton's state-court counterpart, the official reporter of the Ohio Supreme Court, held a copyright in the judges' opinions and several non-binding explanatory materials prepared by the judges. *Id.*, at 249–251, 9 S.Ct. 36. The Court concluded that he did not, explaining that “the judge who, in his judicial capacity, prepares the opinion or decision, the statement of the case and the syllabus or head note” cannot “be regarded as their author or their proprietor, in the sense of [the Copyright Act].” *Id.*, at 253, 9 S.Ct. 36.

Pursuant to “a judicial consensus” dating back to *Wheaton*, judges could not assert copyright in “whatever work they perform in their capacity as judges.” *Banks*, 128 U.S. at 253, 9 S.Ct. 36 (emphasis in original). Rather, “[t]he whole work done by the judges constitutes the authentic exposition and interpretation of the law, which, binding every citizen, is free for publication to all.” *Ibid.* (citing *Nash v. Lathrop*, 142 Mass. 29, 6 N.E. 559 (1886)).

In a companion case decided later that Term, *Callaghan v. Myers*, 128 U.S. 617, 9 S.Ct. 177, 32 L.Ed. 547 (1888), the Court identified an important limiting principle. As in *Wheaton* and *Banks*, the Court rejected the claim that an official reporter held a copyright interest in the judges' opinions. But, resolving an issue not addressed in *Wheaton* and *Banks*, the Court upheld the reporter's copyright interest in several explanatory materials that the reporter had created himself: headnotes, syllabi, tables of contents, and the like. *Callaghan*, 128 U.S. at 645, 647, 9 S.Ct. 177. Although these works mirrored the judge-made materials rejected in *Banks*, they came from an author who had no authority to speak with the force of law. Because the reporter was not a judge, he was free to “obtain[] a copyright” for the materials that were “the result of his [own] intellectual labor.” 128 U.S. at 647, 9 S.Ct. 177.

These cases establish a straightforward rule: Because judges are vested with the authority to make and interpret the law, they cannot be the “author” of the works they prepare “in the discharge of their judicial duties.” *Banks*, 128 U.S. at 253, 9 S.Ct. 36. This rule applies both to binding works (such as opinions) and to non-binding works (such as headnotes and syllabi). *Ibid.* It does not apply, however, to works created by government officials (or private parties) who lack the authority to make or interpret the law, such as court reporters. Compare *ibid.* with *Callaghan*, 128 U.S. at 647, 9 S.Ct. 177.

The animating principle behind this rule is that no one can own the law. “Every citizen is presumed to know the law,” and “it needs no argument to show ... that all should have free access” to its contents. *Nash*, 142 Mass. at 35, 6 N.E. at 560 (cited by *Banks*, 128 U.S. at 253–254, 9 S.Ct. 36). Our cases give effect to that principle in the copyright context through construction of the statutory term “author.” *Id.*, at 253, 9 S.Ct. 36. Rather than attempting to catalog the materials that constitute “the law,” the doctrine bars the officials responsible for creating the law from being considered the “author[s]” of “whatever work they perform in their capacity” as lawmakers. *Ibid.* (emphasis added). Because these officials are generally empowered to make and interpret

law, their “whole work” is deemed part of the “authentic exposition and interpretation of the law” and must be “free for publication to all.” *Ibid.*

If judges, acting as judges, cannot be “authors” because of their authority to make and interpret the law, it follows that legislators, acting as legislators, cannot be either. Courts have thus long understood the government edicts doctrine to apply to legislative materials. See, e.g., *Nash*, 142 Mass. at 35, 6 N.E. at 560 (judicial opinions and statutes stand “on substantially the same footing” for purposes of the government edicts doctrine); *Howell v. Miller*, 91 F. 129, 130–131, 137–138 (CA6 1898) (Harlan, J., Circuit Justice, joined by then-Circuit Judge Taft) (analyzing statutes and supplementary materials under *Banks* and *Callaghan* and concluding that the materials were copyrightable because they were prepared by a private compiler).

Moreover, just as the doctrine applies to “whatever work [judges] perform in their capacity as judges,” *Banks*, 128 U.S., at 253, 9 S.Ct. 36, it applies to whatever work legislators perform in their capacity as legislators. That of course includes final legislation, but it also includes explanatory and procedural materials legislators create in the discharge of their legislative duties. In the same way that judges cannot be the authors of their headnotes and syllabi, legislators cannot be the authors of (for example) their floor statements, committee reports, and proposed bills. These materials are part of the “whole work done by [legislators],” so they must be “free for publication to all.” *Ibid.*

Under our precedents, therefore, copyright does not vest in works that are (1) created by judges and legislators (2) in the course of their judicial and legislative duties.

B

1

Applying that framework, Georgia’s annotations are not copyrightable. The first step is to examine whether their purported author qualifies as a legislator.

As we have explained, the annotations were prepared in the first instance by a private company (Lexis) pursuant to a work-for-hire agreement with Georgia’s Code Revision Commission. The Copyright Act therefore deems the Commission the sole “author” of the work. 17 U.S.C. § 201(b). Although Lexis expends considerable effort preparing the annotations, for purposes of

copyright that labor redounds to the Commission as the statutory author. Georgia agrees that the author is the Commission. Brief for Petitioners 25.

The Commission is not identical to the Georgia Legislature, but functions as an arm of it for the purpose of producing the annotations. The Commission is created by the legislature, for the legislature, and consists largely of legislators. The Commission receives funding and staff designated by law for the legislative branch. Significantly, the annotations the Commission creates are approved by the legislature before being “merged” with the statutory text and published in the official code alongside that text at the legislature’s direction. OCGA § 1–1–1; see 906 F.3d at 1245, 1255; Tr. of Oral Arg. 8.

If there were any doubt about the link between the Commission and the legislature, the Georgia Supreme Court has dispelled it by holding that, under the Georgia Constitution, “the work of the Commission; i.e., selecting a publisher and contracting for and supervising the codification of the laws enacted by the General Assembly, including court interpretations thereof, is within the sphere of legislative authority.” *Harrison Co.*, 244 Ga. at 330, 260 S.E.2d at 34 (emphasis added). That holding is not limited to the Commission’s role in codifying the statutory text. The Commission’s “legislative authority” specifically includes its “codification of ... court interpretations” of the State’s laws. *Ibid.* Thus, as a matter of state law, the Commission wields the legislature’s authority when it works with Lexis to produce the annotations. All of this shows that the Commission serves as an extension of the Georgia Legislature in preparing and publishing the annotations. And it helps explain why the Commission brought this suit asserting copyright in the annotations “on behalf of and for the benefit of” the Georgia Legislature and the State of Georgia. App. 20.

2

The second step is to determine whether the Commission creates the annotations in the “discharge” of its legislative “duties.” *Banks*, 128 U.S. at 253, 9 S.Ct. 36. It does. Although the annotations are not enacted into law through bicameralism and presentment, the Commission’s preparation of the annotations is under Georgia law an act of “legislative authority,” *Harrison Co.*, 244 Ga. at 330, 260 S.E.2d at 34, and the annotations provide commentary and resources that the legislature has deemed relevant to understanding its laws. Georgia and Justice GINSBURG emphasize that the

annotations do not purport to provide authoritative explanations of the law and largely summarize other materials, such as judicial decisions and law review articles. See post, at 1523 – 1524 (dissenting opinion). But that does not take them outside the exercise of legislative duty by the Commission and legislature. Just as we have held that the “statement of the case and the syllabus or head note” prepared by judges fall within the “work they perform in their capacity as judges,” *Banks*, 128 U.S. at 253, 9 S.Ct. 36, so too annotations published by legislators alongside the statutory text fall within the work legislators perform in their capacity as legislators.

In light of the Commission’s role as an adjunct to the legislature and the fact that the Commission authors the annotations in the course of its legislative responsibilities, the annotations in Georgia’s Official Code fall within the government edicts doctrine and are not copyrightable.

III

Georgia resists this conclusion on several grounds. At the outset, Georgia advances two arguments for why, in its view, excluding the OCGA annotations from copyright protection conflicts with the text of the Copyright Act. Both are unavailing.

First, Georgia notes that § 101 of the Act specifically lists “annotations” among the kinds of works eligible for copyright protection. While the reference to “annotations” in § 101 may help explain why supplemental, explanatory materials are copyrightable when prepared by a private party, or a non-lawmaking official like the reporter in *Callaghan*, it does not speak to whether those same materials are copyrightable when prepared by a judge or a legislator. In the same way that judicial materials are ineligible for protection even though they plainly qualify as “[l]iterary works ... expressed in words,” *ibid.*, legislative materials are ineligible for protection even if they happen to fit the description of otherwise copyrightable “annotations.”

Second, Georgia draws a negative inference from the fact that the Act excludes from copyright protection “work[s] prepared by an officer or employee of the United States Government as part of that person’s official duties” and does not establish a similar rule for the States. § 101; see also § 105. But the bar on copyright protection for federal works sweeps much more broadly than the government edicts doctrine does. That bar applies to works created by all federal “officer[s] or employee[s],” without regard for the nature

of their position or scope of their authority. Whatever policy reasons might justify the Federal Government's decision to forfeit copyright protection for its own proprietary works, that federal rule does not suggest an intent to displace the much narrower government edicts doctrine with respect to the States. That doctrine does not apply to non-lawmaking officials, leaving States free to assert copyright in the vast majority of expressive works they produce, such as those created by their universities, libraries, tourism offices, and so on.

More generally, Georgia suggests that we should resist applying our government edicts precedents to the OCGA annotations because our 19th-century forebears interpreted the statutory term author by reference to “public policy”—an approach that Georgia believes is incongruous with the “modern era” of statutory interpretation. Brief for Petitioners 21 (internal quotation marks omitted). But we are particularly reluctant to disrupt precedents interpreting language that Congress has since reenacted. As we explained last Term in *Helsinn Healthcare S. A. v. Teva Pharmaceuticals USA, Inc.*, 586 U.S. ———, 139 S.Ct. 628, 202 L.Ed.2d 551 (2019), when Congress “adopt[s] the language used in [an] earlier act,” we presume that Congress “adopted also the construction given by this Court to such language, and made it a part of the enactment.” *Id.*, at ———, 139 S.Ct., at 634 (quoting *Shapiro v. United States*, 335 U.S. 1, 16, 68 S.Ct. 1375, 92 L.Ed. 1787 (1948)). A century of cases have rooted the government edicts doctrine in the word “author,” and Congress has repeatedly reused that term without abrogating the doctrine. The term now carries this settled meaning, and “critics of our ruling can take their objections across the street, [where] Congress can correct any mistake it sees.” *Kimble v. Marvel Entertainment, LLC*, 576 U.S. 446, 456, 135 S.Ct. 2401, 192 L.Ed.2d 463 (2015).

Moving on from the text, Georgia invokes what it views as the official position of the Copyright Office, as reflected in the Compendium of U.S. Copyright Office Practices (Compendium). But, as Georgia concedes, the Compendium is a non-binding administrative manual that at most merits deference under *Skidmore v. Swift & Co.*, 323 U.S. 134, 65 S.Ct. 161, 89 L.Ed. 124 (1944). That means we must follow it only to the extent it has the “power to persuade.” *Id.*, at 140, 65 S.Ct. 161. Because our precedents answer the question before us, we find any competing guidance in the Compendium unpersuasive.

In any event, the Compendium is largely consistent with our decision.~

Georgia also appeals to the overall purpose of the Copyright Act to promote the creation and dissemination of creative works. Georgia submits that, without copyright protection, Georgia and many other States will be unable to induce private parties like Lexis to assist in preparing affordable annotated codes for widespread distribution. That appeal to copyright policy, however, is addressed to the wrong forum. As Georgia acknowledges, “[I]t is generally for Congress, not the courts, to decide how best to pursue the Copyright Clause’s objectives.” *Eldred v. Ashcroft*, 537 U.S. 186, 212, 123 S.Ct. 769, 154 L.Ed.2d 683 (2003). And that principle requires adherence to precedent when, as here, we have construed the statutory text and “tossed [the ball] into Congress’s court, for acceptance or not as that branch elects.” *Kimble*, 576 U.S. at 456, 135 S.Ct. 2401.

Turning to our government edicts precedents, Georgia insists that they can and should be read to focus exclusively on whether a particular work has “the force of law.” Brief for Petitioners 32 (capitalization deleted). Justice THOMAS appears to endorse the same view. See post, at 1515. But that framing has multiple flaws.

Most obviously, it cannot be squared with the reasoning or results of our cases—especially *Banks*. *Banks*, following *Wheaton* and the “judicial consensus” it inspired, denied copyright protection to judicial opinions without excepting concurrences and dissents that carry no legal force. 128 U.S. at 253, 9 S.Ct. 36 (emphasis deleted). As every judge learns the hard way, “comments in [a] dissenting opinion” about legal principles and precedents “are just that: comments in a dissenting opinion.” *Railroad Retirement Bd. v. Fritz*, 449 U.S. 166, 177, n. 10, 101 S.Ct. 453, 66 L.Ed.2d 368 (1980). Yet such comments are covered by the government edicts doctrine because they come from an official with authority to make and interpret the law.

Indeed, *Banks* went even further and withheld copyright protection from headnotes and syllabi produced by judges. 128 U.S. at 253, 9 S.Ct. 36. Surely these supplementary materials do not have the force of law, yet they are covered by the doctrine. The simplest explanation is the one *Banks* provided: These non-binding works are not copyrightable because of who creates them—judges acting in their judicial capacity. See *ibid*.

The same goes for non-binding legislative materials produced by legislative bodies acting in a legislative capacity. There is a broad array of such

works ranging from floor statements to proposed bills to committee reports. Under the logic of Georgia's "force of law" test, States would own such materials and could charge the public for access to them.

Furthermore, despite Georgia's and Justice THOMAS's purported concern for the text of the Copyright Act, their conception of the government edicts doctrine has less of a textual footing than the traditional formulation. The textual basis for the doctrine is the Act's "authorship" requirement, which unsurprisingly focuses on—the author. Justice THOMAS urges us to dig deeper to "the root" of our government edicts precedents. *Post*, at 1515. But, in our view, the text is the root. The Court long ago interpreted the word "author" to exclude officials empowered to speak with the force of law, and Congress has carried that meaning forward in multiple iterations of the Copyright Act. This textual foundation explains why the doctrine distinguishes between some authors (who are empowered to speak with the force of law) and others (who are not). Compare *Callaghan*, 128 U.S. at 647, 9 S.Ct. 177, with *Banks*, 128 U.S. at 253, 9 S.Ct. 36. But the Act's reference to "authorship" provides no basis for Georgia's rule distinguishing between different categories of content with different effects.

Georgia minimizes the OCGA annotations as non-binding and non-authoritative, but that description undersells their practical significance. Imagine a Georgia citizen interested in learning his legal rights and duties. If he reads the economy-class version of the Georgia Code available online, he will see laws requiring political candidates to pay hefty qualification fees (with no indigency exception), criminalizing broad categories of consensual sexual conduct, and exempting certain key evidence in criminal trials from standard evidentiary limitations—with no hint that important aspects of those laws have been held unconstitutional by the Georgia Supreme Court. See OCGA §§ 21-2-131, 16-6-2, 16-6-18, 16-15-9 (available at www.legis.ga.gov). Meanwhile, first-class readers with access to the annotations will be assured that these laws are, in crucial respects, unenforceable relics that the legislature has not bothered to narrow or repeal. See §§ 21-2-131, 16-6-2, 16-6-18, 16-15-9 (available at <https://store.lexisnexis.com/products/official-code-of-georgia-annotated-skuSKU6647> for \$412.00).

If everything short of statutes and opinions were copyrightable, then States would be free to offer a whole range of premium legal works for those who can afford the extra benefit. A State could monetize its entire suite

of legislative history. With today's digital tools, States might even launch a subscription or pay-per-law service.

There is no need to assume inventive or nefarious behavior for these concerns to become a reality. Unlike other forms of intellectual property, copyright protection is both instant and automatic. It vests as soon as a work is captured in a tangible form, triggering a panoply of exclusive rights that can last over a century. 17 U.S.C. §§ 102, 106, 302. If Georgia were correct, then unless a State took the affirmative step of transferring its copyrights to the public domain, all of its judges' and legislators' non-binding legal works would be copyrighted. And citizens, attorneys, nonprofits, and private research companies would have to cease all copying, distribution, and display of those works or risk severe and potentially criminal penalties. §§ 501–506. Some affected parties might be willing to roll the dice with a potential fair use defense. But that defense, designed to accommodate First Amendment concerns, is notoriously fact sensitive and often cannot be resolved without a trial. Cf. *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 552, 560–561, 105 S.Ct. 2218, 85 L.Ed.2d 588 (1985). The less bold among us would have to think twice before using official legal works that illuminate the law we are all presumed to know and understand.

Thankfully, there is a clear path forward that avoids these concerns—the one we are already on. Instead of examining whether given material carries “the force of law,” we ask only whether the author of the work is a judge or a legislator. If so, then whatever work that judge or legislator produces in the course of his judicial or legislative duties is not copyrightable. That is the framework our precedents long ago established, and we adhere to those precedents today.

* * *

For the foregoing reasons, we affirm the judgment of the Eleventh Circuit.

It is so ordered.

[Dissenting opinions are omitted.]

Rights, Licensing, Etc.

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Note on editing marks: The superscript tilde (~) indicates omitted material. I used square brackets to indicate insertions, which may also include a corresponding deletion in the same place.

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–EEJ

Chapter C-4A: Copyright Ownership: Works Made for Hire

This chapter was made in its current form by Eric E. Johnson by starting with Chapter 5, “Ownership of Copyrights,” of *Introduction To Intellectual Property Cases and Questions Fall 2021 Edition* authored by **Jason Rantanen**, and then changing some things and adding substantial material. Please see “Rights, Licensing, Attribution, Disclaimers, and More” at the end of this chapter.

Prof. EEJ’s notes on the copyright ownership chapters

This is the first of three chapters on questions of ownership in copyright.

Let’s start with this question: When a copyrighted work comes into existence, who is the owner?

The answer under the law is clear and easy: The author is. Section 201(a) of the ’76 Copyright Act says, “Copyright in a work protected under this title vests initially in the author or authors of the work. The authors of a joint work are coowners of copyright in the work.”

And yup, I totally agree that Congress should have used a hyphen so it was written as “co-owners.”

But let’s get to the more urgent question: Who counts as an author? This is, it turns out, where things can get complicated.

This chapter, C-4A, concerns “works made for hire,” situations where one party (the “hirer”) hires another party (the “hired”), the hired creates a copyrighted work, and the hirer is considered the author—and therefore the owner—under copyright law.

The next chapter, C-4B, concerns questions of joint authorship. What is the dividing line between helping an author create a copyrighted work and being a coauthor of that work?

After that, chapter C-4C concerns assignments—where one party transfers copyright ownership to another.

Copyright Office on works made for hire

from Circular 30: Works Made for Hire, revised 03/2021

[Synopsis/sidebar:]

A copyrightable work is “made for hire” in two situations:

- **When it is created by an employee as part of the employee’s regular duties**
- **When a certain type of work is created as a result of an express written agreement between the creator and a party specially ordering or commissioning it**

When a work is made for hire, the hiring or commissioning party is considered the author and the copyright owner.

[Main text:]

To register a work with the U.S. Copyright Office, you generally must identify the author or authors of that work. In addition, you must identify the party that owns the copyright in the work. Ordinarily, the author is the person or persons who actually created the work you intend to register. “Works made for hire” are an exception to this rule. For legal purposes, when a work is a “work made for hire,” the author is not the individual who actually created the work. Instead, the party that hired the individual is considered both the author and the copyright owner of the work.

Whether a work is a work made for hire is determined by facts in existence at the time the work is created. There are two situations in which a work made for hire is produced:

(1) when the work is created by an employee as part of the employee's regular duties and (2) when a certain type of work is created as a result of an express written agreement between the creator and a party specially ordering or commissioning the work. When a work is produced under these conditions, the employer or the party ordering or commissioning the work is considered the author and copyright owner.

The work made for hire concept can be complicated and has serious consequences for both the individual who creates a work and the hiring party who is considered to be the author and copyright owner of that work. This circular draws on the Copyright Act and judicial interpretation to provide a general introduction to this topic and answer common questions. For more information, see chapter 500, section 506 or chapter 600, section 614 of the Compendium of U.S. Copyright Office Practices.

Definition in the Copyright Law

The definition of work made for hire in the Copyright Act applies to works created on or after January 1, 1978. For works created prior to 1978, see chapter 2100 of the Compendium of U.S. Copyright Office Practices. Section 101 of the Copyright Act defines a "work made for hire" as

A. A work prepared by an employee within the scope of his or her employment

or

B. A work specially ordered or commissioned for use

1. as a contribution to a collective work,
2. as a part of a motion picture or other audiovisual work,
3. as a translation,
4. as a supplementary work,
5. as a compilation,
6. as an instructional text,
7. as a test,
8. as answer material for a test, or
9. as an atlas,

if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire.

A “collective work” is a work, such as a periodical, anthology, or encyclopedia, in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole.

A “motion picture” is an audiovisual work consisting of a series of related images that, when shown in succession, impart an impression of motion, together with accompanying sounds, if any.

An “audiovisual work” is a work consisting of a series of related images that are intrinsically intended to be shown by the use of machines or devices, together with accompanying sounds, if any. This definition holds regardless of the nature of the material objects in which the work is embodied.

A “supplementary work” is a work prepared for publication as a secondary adjunct to a work by another author for the purpose of introducing, concluding, illustrating, explaining, revising, commenting upon, or assisting in the use of the other work, such as forewords, afterwords, pictorial illustrations, maps, charts, tables, editorial notes, musical arrangements, answer material for tests, bibliographies, appendixes, and indexes.

A “compilation” is a work formed by the collection and assembling of preexisting material or data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship.

An “instructional text” is a literary, pictorial, or graphic work prepared for publication and intended for use in systematic instructional activities.

“Scope of Employment”

For an employee’s work to be considered a work made for hire, the work must be created within the employee’s “scope of employment.” The Copyright Act does not define the terms “employee,” “employer,” or “scope of employment.” In its decision in *Community for Creative Non-Violence v. Reed*[sic; the actual name of the respondent is Reid –EEJ], the U.S. Supreme Court held that Congress intended these terms “to be understood in light of agency law,” which governs employer-employee relationships, and that the courts should rely “on the general common law of agency, rather than on the

law of any particular [s]tate, to give meaning to these terms.” Questions you may need to consider include:

- What skill was required to create the work?
- Where was the work created? Did the hiring party provide the space, materials, or tools to create the work?
- How long was the relationship between the parties? Did the hiring party have the right to assign other projects besides the one under review? Could the hiring party direct the creator when and how long to work?
- How was the creator paid? Did the hiring party offer employee benefits? Did the hiring party remove taxes from the creator’s pay?
- Does the creator have his or her own business? Was the creator able to hire and pay assistants?
- Was the work created as part of the regular business hours of the hiring party? Was the work created pursuant to the creator’s usual tasks? Was the work created during the creator’s authorized work time?

Specially Ordered or Commissioned Works

A specially ordered or commissioned work is considered a work made for hire if it satisfies all of the following four criteria:

1. The work must fall within one of the nine categories of works listed above that are eligible to be specially ordered or commissioned as works made for hire.
2. There must be a written agreement between the party that ordered or commissioned the work and individual(s) who actually created the work.
3. In the written agreement, the parties must expressly agree that the work is to be considered a work made for hire.
4. The agreement must be signed by all parties.

If a work fails to satisfy any of these requirements, it is not a work made for hire.

Copyright in Works Made for Hire

A work's status as a work made for hire affects the authorship, copyright ownership, copyright term, and termination rights in that work.

Authorship

If a work is a work made for hire, the employer or the party that specially ordered or commissioned that work is the author of that work.

Copyright Ownership

If a work is made for hire, the employer or the party that specially ordered or commissioned that work is the initial owner of the copyright in the work unless the employer or the commissioning party has signed a written agreement to the contrary with the work's creator.

Copyright Term

The term of copyright protection in a work made for hire is 95 years from the date of publication or 120 years from the date of creation, whichever expires first. For information about copyright term, see Duration of Copyright (Circular 15A).

Termination Rights

Under certain circumstances, an author or the author's heirs can terminate an exclusive or nonexclusive transfer or license of the copyright in a particular work under sections 203, 304(c), and/or 304(d) of the Copyright Act. These termination provisions, however, do not apply to works made for hire. For more information, see chapter 2300, section 2310 of the Compendium.

Registration

When you apply to register a work, you, not the Copyright Office, must determine whether the work is a work made for hire. You should base your determination on the facts that existed when the work was created. The examiner will generally accept your representation that a work is a work made for hire unless your representation is contradicted by information known to the examiner or available in the registration materials or the Office's records. If your claim appears unusual or implausible, the examiner may communicate with you or refuse registration. For more information, see chapter 500, section 506, and chapter 600, section 614, of the Compendium.

Questionnaire

The parties involved must determine whether or not a work is a work made for hire. The Copyright Office cannot provide legal advice about the status of a work. However, the following questions may help you decide if a work created on or after January 1, 1978, fits within the law's definition of a work made for hire. The questions are derived from chapter 500, section 506, of the Compendium, which contains examples illustrating some of the factors that indicate whether a work does or does not qualify as a work made for hire.

QUESTION 1: Was the work created by an employee?

Yes? Proceed to Question 2.

No? Proceed to Question 3.

QUESTION 2: Did the employee create the work while acting within the scope of employment?

Yes? The work is a work made for hire.

No? Proceed to Question 3.

QUESTION 3: Is there a written agreement between the commissioning party and the creator of the work?

Yes? Proceed to Question 4.

No? The work is not a work made for hire.

QUESTION 4: Was the written agreement signed by the commissioning party?

Yes? Proceed to Question 5.

No? The work is not a work made for hire.

QUESTION 5: Was the written agreement signed by the creator of the work?

Yes? Proceed to Question 6.

No? The work is not a work made for hire.

QUESTION 6: Did the parties expressly agree that the work shall be considered a "work made for hire"?

Yes? Proceed to Question 7.

No? The work is not a work made for hire.

QUESTION 7: Does the work fall into one or more of the following categories?

- An atlas
- A test
- Answer material for a test

- A translation
- A part of a motion picture or other audiovisual work
- A compilation
- A contribution to a collective work
- A supplementary work
- An instructional test

Yes? The work is a work made for hire.

No? The work is not a work made for hire.

NOTE

1. This circular is intended as an overview of works made for hire. The authoritative source for U.S. copyright law is the Copyright Act, codified in Title 17 of the United States Code. Copyright Office regulations are codified in Title 37 of the Code of Federal Regulations. Copyright Office practices and procedures are summarized in the third edition of the Compendium of U.S. Copyright Office Practices, cited as the Compendium. The copyright law, regulations, and the Compendium are available on the Copyright Office website at www.copyright.gov.

Notes from Prof. Rantanen

Assuming that a work is subject to copyright, the next question is “who owns the copyright.” The simple answer—the individual who created the work—is intuitive but not always correct. Under 17 U.S.C. § 201(a), it is true that the initial owner of a work is its author or authors. However, copyrights may be, and are, frequently transferred to another, as permitted by § 201(d). In addition, under the “works made for hire” doctrine, codified at 17 U.S.C. § 201(b), an employer may be deemed the “author” of the work under certain circumstances. *CCNV v. Reid* involves these issues. Before reading *CCNV v. Reid*, read 17 U.S.C. § 201. You should also be sure to look at the definition of “work made for hire” in 17 U.S.C. § 101.

As you read *CCNV v. Reid*, ask yourself the following questions:

- What is the primary legal issue in this case? How and why does the court draw the line where it does?
- Based on this opinion, how would you determine who initially owns a copyright in a work?

- The term “work” is used multiple times in the statutes and opinions you’ve read. What do you think a “work” is?
- Would the outcome of this case be different if the subject matter was a movie rather than a statue?

17 U.S.C. §101. Definitions (2010)

...

A “work made for hire” is –

(1) a work prepared by an employee within the scope of his or her employment; or

(2) a work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas, if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire. For the purpose of the foregoing sentence, a “supplementary work” is a work prepared for publication as a secondary adjunct to a work by another author for the purpose of introducing, concluding, illustrating, explaining, revising, commenting upon, or assisting in the use of the other work, such as forewords, afterwords, pictorial illustrations, maps, charts, tables, editorial notes, musical arrangements, answer material for tests, bibliographies, appendixes, and indexes, and an “instructional text” is a literary, pictorial, or graphic work prepared for publication and with the purpose of use in systematic instructional activities.

17 U.S. Code § 201. Ownership of copyright (1978)

(a) Initial Ownership.— Copyright in a work protected under this title vests initially in the author or authors of the work. The authors of a joint work are coowners of copyright in the work.

(b) Works Made for Hire.— In 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, and, unless the parties have expressly agreed otherwise in a written instrument signed by them, owns all of the rights comprised in the copyright.

Case: CCNV v. Reid

Community for Creative Non-Violence v. Reid

Supreme Court of the United States
490 U.S. 730 (1989)

[Editing marks: Superscript right- and left-pointing descending arrows enclose footnote material that has been incorporated into above-the-line text. A superscript tilde ~ indicates an ellipsis. A superscript carat ^ indicates a footnote omitted. -EEJ]

JUSTICE MARSHALL delivered the opinion of the Court.

In this case, an artist and the organization that hired him to produce a sculpture contest the ownership of the copyright in that work. To resolve this dispute, we must construe the “work made for hire” provisions of the Copyright Act of 1976 (Act or 1976 Act), 17 U. S. C. §§ 101 and 201(b), and in particular, the provision in § 101, which defines as a “work made for hire” a “work prepared by an employee within the scope of his or her employment” (hereinafter § 101(1)).

I

Petitioners are the Community for Creative Non-Violence (CCNV), a nonprofit unincorporated association dedicated to eliminating homelessness in America, and Mitch Snyder, a member and trustee of CCNV. In the fall of 1985, CCNV decided to participate in the annual Christmastime Pageant of Peace in Washington, D.C., by sponsoring a display to dramatize the plight of the homeless. As the District Court recounted:

“Snyder and fellow CCNV members conceived the idea for the nature of the display: a sculpture of a modern Nativity scene in which, in lieu of the traditional Holy Family, the two adult figures and the infant would appear as contemporary homeless people huddled on a streetside steam grate. The family was to be black (most of the homeless in Washington being black); the figures were to be life-sized, and the steam grate would be positioned atop a platform ‘pedestal,’ or base, within which special-effects equipment would be enclosed to emit simulated ‘steam’ through the grid to swirl about the figures. They also settled upon a title for the work — ‘Third World America’ — and a legend for

the pedestal: ‘and still there is no room at the inn.’” 652 F. Supp. 1453, 1454 (DC 1987).

Snyder made inquiries to locate an artist to produce the sculpture. He was referred to respondent James Earl Reid, a Baltimore, Maryland, sculptor. In the course of two telephone calls, Reid agreed to sculpt the three human figures. CCNV agreed to make the steam grate and pedestal for the statue. Reid proposed that the work be cast in bronze, at a total cost of approximately \$100,000 and taking six to eight months to complete. Snyder rejected that proposal because CCNV did not have sufficient funds, and because the statue had to be completed by December 12 to be included in the pageant. Reid then suggested, and Snyder agreed, that the sculpture would be made of a material known as “Design Cast 62,” a synthetic substance that could meet CCNV’s monetary and time constraints, could be tinted to resemble bronze, and could withstand the elements. The parties agreed that the project would cost no more than \$15,000, not including Reid’s services, which he offered to donate. The parties did not sign a written agreement. Neither party mentioned copyright.

After Reid received an advance of \$3,000, he made several sketches of figures in various poses. At Snyder’s request, Reid sent CCNV a sketch of a proposed sculpture showing the family in a crechelike setting: the mother seated, cradling a baby in her lap; the father standing behind her, bending over her shoulder to touch the baby’s foot. Reid testified that Snyder asked for the sketch to use in raising funds for the sculpture. Snyder testified that it was also for his approval. Reid sought a black family to serve as a model for the sculpture. Upon Snyder’s suggestion, Reid visited a family living at CCNV’s Washington shelter but decided that only their newly born child was a suitable model. While Reid was in Washington, Snyder took him to see homeless people living on the streets. Snyder pointed out that they tended to recline on steam grates, rather than sit or stand, in order to warm their bodies. From that time on, Reid’s sketches contained only reclining figures.

Throughout November and the first two weeks of December 1985, Reid worked exclusively on the statue, assisted at various times by a dozen different people who were paid with funds provided in installments by CCNV. On a number of occasions, CCNV members visited Reid to check on his progress and to coordinate CCNV’s construction of the base. CCNV rejected Reid’s proposal to use suitcases or shopping bags to hold the family’s personal

belongings, insisting instead on a shopping cart. Reid and CCNV members did not discuss copyright ownership on any of these visits.

On December 24, 1985, 12 days after the agreed-upon date, Reid delivered the completed statue to Washington. There it was joined to the steam grate and pedestal prepared by CCNV and placed on display near the site of the pageant. Snyder paid Reid the final installment of the \$15,000. The statue remained on display for a month. In late January 1986, CCNV members returned it to Reid's studio in Baltimore for minor repairs. Several weeks later, Snyder began making plans to take the statue on a tour of several cities to raise money for the homeless. Reid objected, contending that the Design Cast 62 material was not strong enough to withstand the ambitious itinerary. He urged CCNV to cast the statue in bronze at a cost of \$35,000, or to create a master mold at a cost of \$5,000. Snyder declined to spend more of CCNV's money on the project.

In March 1986, Snyder asked Reid to return the sculpture. Reid refused. He then filed a certificate of copyright registration for "Third World America" in his name and announced plans to take the sculpture on a more modest tour than the one CCNV had proposed. Snyder, acting in his capacity as CCNV's trustee, immediately filed a competing certificate of copyright registration.

Snyder and CCNV then commenced this action against Reid and his photographer, Ronald Purtee, seeking return of the sculpture and a determination of copyright ownership. The District Court granted a preliminary injunction, ordering the sculpture's return. After a 2-day bench trial, the District Court declared that "Third World America" was a "work made for hire" under § 101 of the Copyright Act and that Snyder, as trustee for CCNV, was the exclusive owner of the copyright in the sculpture. 652 F. Supp., at 1457. The court reasoned that Reid had been an "employee" of CCNV within the meaning of § 101(1) because CCNV was the motivating force in the statue's production. Snyder and other CCNV members, the court explained, "conceived the idea of a contemporary Nativity scene to contrast with the national celebration of the season," and "directed enough of [Reid's] effort to assure that, in the end, he had produced what they, not he, wanted." *Id.*, at 1456.

The Court of Appeals for the District of Columbia Circuit reversed and remanded, holding that Reid owned the copyright because "Third World

America” was not a work for hire. 270 U. S. App. D. C. 26, 35, 846 F. 2d 1485, 1494 (1988). Adopting what it termed the “literal interpretation” of the Act as articulated by the Fifth Circuit in *Easter Seal Society for Crippled Children & Adults of Louisiana, Inc. v. Playboy Enterprises*, 815 F. 2d 323, 329 (1987), cert. denied, 485 U. S. 981 (1988), the court read § 101 as creating “a simple dichotomy in fact between employees and independent contractors.” 270 U. S. App. D. C., at 33, 846 F. 2d, at 1492. Because, under agency law, Reid was an independent contractor, the court concluded that the work was not “prepared by an employee” under § 101(1). *Id.*, at 35, 846 F. 2d, at 1494. Nor was the sculpture a “work made for hire” under the second subsection of § 101 (hereinafter § 101(2)): sculpture is not one of the nine categories of works enumerated in that subsection, and the parties had not agreed in writing that the sculpture would be a work for hire. *Ibid.* The court suggested that the sculpture nevertheless may have been jointly authored by CCNV and Reid, *id.*, at 36, 846 F. 2d, at 1495, and remanded for a determination whether the sculpture is indeed a joint work under the Act, *id.*, at 39-40, 846 F. 2d, at 1498-1499.

We granted certiorari to resolve a conflict among the Courts of Appeals over the proper construction of the “work made for hire” provisions of the Act.¹ 488 U. S. 940 (1988). We now affirm.

II

A

The Copyright Act of 1976 provides that copyright ownership “vests initially in the author or authors of the work.” 17 U. S. C. § 201(a). As a general rule, the author is the party who actually creates the work, that is, the

¹ Compare *Easter Seal Society for Crippled Children & Adults of Louisiana, Inc. v. Playboy Enterprises*, 815 F. 2d 323 (CA5 1987), (agency law determines who is an employee under § 101), cert. denied, 485 U. S. 981 (1988), with *Brunswick Beacon, Inc. v. Schock-Hopchas Publishing Co.*, 810 F. 2d 410 (CA4 1987) (supervision and control standard determines who is an employee under § 101); *Evans Newton, Inc. v. Chicago Systems Software*, 793 F. 2d 889 (CA7) (same), cert. denied, 479 U. S. 949 (1986); and *Aldon Accessories Ltd. v. Spiegel, Inc.*, 738 F. 2d 548 (CA2) (same), cert. denied, 469 U. S. 982 (1984). See also *Dumas v. Gommerman*, 865 F. 2d 1093 (CA9 1989) (a multifactor formal, salaried employee test determines who is an employee under § 101).

person who translates an idea into a fixed, tangible expression entitled to copyright protection. § 102. The Act carves out an important exception, however, for “works made for hire.”² If the work is for hire, “the employer or other person for whom the work was prepared is considered the author” and owns the copyright, unless there is a written agreement to the contrary. § 201(b). Classifying a work as “made for hire” determines not only the initial ownership of its copyright, but also the copyright’s duration, § 302(c), and the owners’ renewal rights, § 304(a), termination rights, § 203(a), and right to import certain goods bearing the copyright, § 601(b)(1). See 1 M. Nimmer & D. Nimmer, *Nimmer on Copyright* § 5.03 [A], pp. 5-10 (1988). The contours of the work for hire doctrine therefore carry profound significance for freelance creators — including artists, writers, photographers, designers, composers, and computer programmers — and for the publishing, advertising, music, and other industries which commission their works.³

Section 101 of the 1976 Act provides that a work is “for hire” under two sets of circumstances:

- “(1) a work prepared by an employee within the scope of his or her employment; or
- (2) a work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas, if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire.”⁴

² We use the phrase “work for hire” interchangeably with the more cumbersome statutory phrase “work made for hire.”

³ As of 1955, approximately 40 percent of all copyright registrations were for works for hire, according to a Copyright Office study. See Varmer, *Works Made for Hire and On Commission*, in *Studies Prepared for the Subcommittee on Patents, Trademarks, and Copyrights of the Senate Committee on the Judiciary*, Study No. 13, 86th Cong., 2d Sess., 139, n. 49 (Comm. Print 1960) (hereinafter *Varmer, Works Made for Hire*). The Copyright Office does not keep more recent statistics on the number of work for hire registrations.

⁴ Section 101 of the Act defines each of the nine categories of “specially ordered or commissioned” works.

Petitioners do not claim that the statue satisfies the terms of § 101(2). Quite clearly, it does not. Sculpture does not fit within any of the nine categories of “specially ordered or commissioned” works enumerated in that subsection, and no written agreement between the parties establishes “Third World America” as a work for hire.

The dispositive inquiry in this case therefore is whether “Third World America” is “a work prepared by an employee within the scope of his or her employment” under § 101(1). The Act does not define these terms. In the absence of such guidance, four interpretations have emerged. The first holds that a work is prepared by an employee whenever the hiring party⁵ retains the right to control the product. See *Peregrine v. Lauren Corp.*, 601 F. Supp. 828, 829 (Colo. 1985); *Clarkstown v. Reeder*, 566 F. Supp. 137, 142 (SDNY 1983). Petitioners take this view. Brief for Petitioners 15; Tr. of Oral Arg. 12. A second, and closely related, view is that a work is prepared by an employee under § 101(1) when the hiring party has actually wielded control with respect to the creation of a particular work. This approach was formulated by the Court of Appeals for the Second Circuit, *Aldon Accessories Ltd. v. Spiegel, Inc.*, 738 F. 2d 548, cert. denied, 469 U. S. 982 (1984), and adopted by the Fourth Circuit, *Brunswick Beacon, Inc. v. Schock-Hopchas Publishing Co.*, 810 F. 2d 410 (1987), the Seventh Circuit, *Evans Newton, Inc. v. Chicago Systems Software*, 793 F. 2d 889, cert. denied, 479 U. S. 949 (1986), and, at times, by petitioners, Brief for Petitioners 17. A third view is that the term “employee” within § 101(1) carries its common-law agency law meaning. This view was endorsed by the Fifth Circuit in *Easter Seal Society for Crippled Children & Adults of Louisiana, Inc. v. Playboy Enterprises*, 815 F. 2d 323 (1987), and by the Court of Appeals below. Finally, respondent and numerous *amici curiae* contend that the term “employee” only refers to “formal, salaried” employees. See, e. g., Brief for Respondent 23-24; Brief for Register of Copyrights as *Amicus Curiae* 7. The Court of Appeals for the Ninth Circuit recently adopted this view. See *Dumas v. Gommerman*, 865 F. 2d 1093 (1989).

The starting point for our interpretation of a statute is always its language. *Consumer Product Safety Comm’n v. GTE Sylvania, Inc.*, 447 U. S. 102, 108 (1980). The Act nowhere defines the terms “employee” or “scope of

⁵ By “hiring party,” we mean to refer to the party who claims ownership of the copyright by virtue of the work for hire doctrine.

employment.” It is, however, well established that “[w]here Congress uses terms that have accumulated settled meaning under . . . the common law, a court must infer, unless the statute otherwise dictates, that Congress means to incorporate the established meaning of these terms.” *NLRB v. Amax Coal Co.*, 453 U. S. 322, 329 (1981); see also *Perrin v. United States*, 444 U. S. 37, 42 (1979). In the past, when Congress has used the term “employee” without defining it, we have concluded that Congress intended to describe the conventional master-servant relationship as understood by common-law agency doctrine. See, e. g., *Kelley v. Southern Pacific Co.*, 419 U. S. 318, 322-323 (1974); *Baker v. Texas & Pacific R. Co.*, 359 U. S. 227, 228 (1959) (*per curiam*); *Robinson v. Baltimore & Ohio R. Co.*, 237 U. S. 84, 94 (1915). Nothing in the text of the work for hire provisions indicates that Congress used the words “employee” and “employment” to describe anything other than “the conventional relation of employer and employe [sic].” *Kelley*, *supra*, at 323, quoting *Robinson*, *supra*, at 94; cf. *NLRB v. Hearst Publications, Inc.*, 322 U. S. 111, 124-132 (1944) (rejecting agency law conception of employee for purposes of the National Labor Relations Act where structure and context of statute indicated broader definition). On the contrary, Congress’ intent to incorporate the agency law definition is suggested by § 101(1)’s use of the term, “scope of employment,” a widely used term of art in agency law. See Restatement (Second) of Agency § 228 (1958) (hereinafter Restatement).

In past cases of statutory interpretation, when we have concluded that Congress intended terms such as “employee,” “employer,” and “scope of employment” to be understood in light of agency law, we have relied on the general common law of agency, rather than on the law of any particular State, to give meaning to these terms. See, e. g., *Kelley*, 419 U. S., at 323-324, and n. 5; *id.*, at 332 (Stewart, J., concurring in judgment); *Ward v. Atlantic Coast Line R. Co.*, 362 U. S. 396, 400 (1960); *Baker*, *supra*, at 228. This practice reflects the fact that “federal statutes are generally intended to have uniform nationwide application.” *Mississippi Band of Choctaw Indians v. Holyfield*, *ante*, at 43. Establishment of a federal rule of agency, rather than reliance on state agency law, is particularly appropriate here given the Act’s express objective of creating national, uniform copyright law by broadly pre-empting state statutory and common-law copyright regulation. See 17 U. S. C. § 301(a).

We thus agree with the Court of Appeals that the term “employee” should be understood in light of the general common law of agency.

In contrast, neither test proposed by petitioners is consistent with the text of the Act. We therefore conclude that the language and structure of § 101 of the Act do not support either the right to control the product or the actual control approaches. We also reject the suggestion that the § 101(1) term “employee” refers only to formal salaried employees[;] the language of § 101(1) cannot support it. The structure of § 101 indicates that a work for hire can arise through one of two mutually exclusive means, one for employees and one for independent contractors, and ordinary canons of statutory interpretation indicate that the classification of a particular hired party should be made with reference to agency law.

This reading of the undefined statutory terms finds considerable support in the Act’s legislative history. Cf. *Diamond v. Chakrabarty*, 447 U. S. 303, 315 (1980). The Act, which almost completely revised existing copyright law, was the product of two decades of negotiation by representatives of creators and copyright-using industries, supervised by the Copyright Office and, to a lesser extent, by Congress. See *Mills Music, Inc. v. Snyder*, 469 U. S. 153, 159 (1985); Litman, *Copyright, Compromise, and Legislative History*, 72 Cornell L. Rev. 857, 862 (1987). Despite the lengthy history of negotiation and compromise which ultimately produced the Act, two things remained constant. First, interested parties and Congress at all times viewed works by employees and commissioned works by independent contractors as separate entities. Second, in using the term “employee,” the parties and Congress meant to refer to a hired party in a conventional employment relationship. These factors militate in favor of the reading we have found appropriate.

In 1955, when Congress decided to overhaul copyright law, the existing work for hire provision was § 62 of the 1909 Copyright Act, 17 U. S. C. § 26 (1976 ed.) (1909 Act). It provided that “the word ‘author’ shall include an employer in the case of works made for hire.”⁶ Because the 1909 Act did not

⁶ The concept of works made for hire first arose in controversies over copyright ownership involving works produced by persons whom all parties agreed were employees. See, e. g., *Colliery Engineer Co. v. United Correspondence Schools Co.*, 94 F. 152 (CC SDNY 1899); *Little v. Gould*, 15 F. Cas. 612 (No. 8,395) (CC NDNY 1852). This Court first took note of the work for hire doctrine in *Bleistein v.*

define “employer” or “works made for hire,” the task of shaping these terms fell to the courts. They concluded that the work for hire doctrine codified in § 62 referred only to works made by employees in the regular course of their employment. As for commissioned works, the courts generally presumed that the commissioned party had impliedly agreed to convey the copyright, along with the work itself, to the hiring party.⁷

In 1961, the Copyright Office’s first legislative proposal retained the distinction between works by employees and works by independent contractors.⁷ After numerous meetings with representatives of the affected parties, the Copyright Office issued a preliminary draft bill in 1963. Adopting the Register’s recommendation, it defined “work made for hire” as “a work prepared by an employee within the scope of the duties of his employment, but not including a work made on special order or commission.” Preliminary Draft for Revised U. S. Copyright Law and Discussions and Comments on the Draft, 88th Cong., 2d Sess., Copyright Law Revision, Part 3, p. 15, n. 11 (H. R. Judiciary Comm. Print 1964) (hereinafter Preliminary Draft).

In response to objections by book publishers that the preliminary draft bill limited the work for hire doctrine to “employees,”⁷ the 1964 revision bill

Donaldson Lithographing Co., 188 U. S. 239, 248 (1903), where we found that an employer owned the copyright to advertisements that had been created by an employee in the course of his employment. *Bleistein* did not, however, purport to define “employee.”

⁷ See, e. g., Preliminary Draft, at 259 (statement of Horace S. Manges, Joint Committee of the American Book Publishers Council and the American Textbook Publishers Institute) (“There would be a necessity of putting people on the payroll whom the employers wouldn’t want to put on the payroll, and where the employees would prefer to work as independent contractors”); *id.*, at 272 (statement of Saul N. Rittenberg, MGM) (“[T]he present draft has given more emphasis to formalism than necessary. If I commission a work from a man, ordering a work specially for my purposes, and I pay for it, what difference does it make whether I put him under an employment contract or establish an independent contractor relationship?”); *id.*, at 260 (statement of John R. Peterson, American Bar Association) (“I don’t think there is any valid philosophical or economic difference between the situation in which you have a man on a continuing basis of orders which justifies placing him on your payroll, and the situation in which you give him a particular order for a particular job”).

expanded the scope of the work for hire classification to reach, for the first time, commissioned works. The bill's language, proposed initially by representatives of the publishing industry, retained the definition of work for hire insofar as it referred to "employees," but added a separate clause covering commissioned works, without regard to the subject matter, "if the parties so agree in writing." S. 3008, H. R. 11947, H. R. 12354, 88th Cong., 2d Sess., § 54 (1964), reproduced in 1964 Revision Bill with Discussions and Comments, 89th Cong., 1st Sess., Copyright Law Revision, pt. 5, p. 31 (H. R. Judiciary Comm. Print 1965). Those representing authors objected that the added provision would allow publishers to use their superior bargaining position to force authors to sign work for hire agreements, thereby relinquishing all copyright rights as a condition of getting their books published. See Supplementary Report, at 67.

In 1965, the competing interests reached a historic compromise, which was embodied in a joint memorandum submitted to Congress and the Copyright Office,⁸ incorporated into the 1965 revision bill, and ultimately enacted in the same form and nearly the same terms 11 years later, as § 101 of the 1976 Act. The compromise retained as subsection (1) the language referring to "a work prepared by an employee within the scope of his employment." However, in exchange for concessions from publishers on provisions relating to the termination of transfer rights, the authors consented to a second subsection which classified four categories of commissioned works as works for hire if the parties expressly so agreed in writing: works for use "as a contribution to a collective work, as a part of a motion picture, as a translation, or as supplementary work." S. 1006, H. R. 4347, H. R. 5680, H. R. 6835, 89th Cong., 1st Sess., § 101 (1965). The interested parties selected these categories because they concluded that these commissioned works, although not prepared by employees and thus not covered by the first subsection, nevertheless should be treated as works for hire because they were ordinarily prepared "at the instance, direction, and risk of a publisher or producer."

⁸ The parties to the joint memorandum included representatives of the major competing interests involved in the copyright revision process: publishers and authors, composers, and lyricists. See Copyright Law Revision: Hearings on H. R. 4347, 5680, 6831, 6835 before Subcommittee No. 3 of the House Committee on the Judiciary, 89th Cong., 1st Sess., pt. 1, p. 134 (1965).

Supplementary Report, at 67. The Supplementary Report emphasized that only the “four special cases specifically mentioned” could qualify as works made for hire; “[o]ther works made on special order or commission would not come within the definition.” *Id.*, at 67-68.

In 1966, the House Committee on the Judiciary endorsed this compromise in the first legislative Report on the revision bills. See H. R. Rep. No. 2237, 89th Cong., 2d Sess., 114, 116 (1966). Retaining the distinction between works by employees and commissioned works, the House Committee focused instead on “how to draw a statutory line between those works written on special order or commission that should be considered as works made for hire, and those that should not.” *Id.*, at 115. The House Committee added four other enumerated categories of commissioned works that could be treated as works for hire: compilations, instructional texts, tests, and atlases. *Id.*, at 116. With the single addition of “answer material for a test,” the 1976 Act, as enacted, contained the same definition of works made for hire as did the 1966 revision bill, and had the same structure and nearly the same terms as the 1966 bill.⁹ Indeed, much of the language of the 1976 House and Senate Reports was borrowed from the Reports accompanying the earlier drafts. See, *e. g.*, H. R. Rep. No. 94-1476, p. 121 (1976); S. Rep. No. 94-473, p. 105 (1975).

Thus, the legislative history of the Act is significant for several reasons. First, the enactment of the 1965 compromise with only minor modifications demonstrates that Congress intended to provide two mutually exclusive ways for works to acquire work for hire status: one for employees and the other for independent contractors. Second, the legislative history underscores the clear import of the statutory language: only enumerated categories of commissioned

⁹ An attempt to add “photographic or other portrait[s],” S. Rep. No. 94-473, p. 4 (1975), to the list of commissioned works eligible for work for hire status failed after the Register of Copyrights objected:

“The addition of portraits to the list of commissioned works that can be made into ‘works made for hire’ by agreement of the parties is difficult to justify. Artists and photographers are among the most vulnerable and poorly protected of all the beneficiaries of the copyright law, and it seems clear that, like serious composers and choreographers, they were not intended to be treated as ‘employees’ under the carefully negotiated definition in section 101.” Second Supplementary Report of the Register of Copyrights on the General Revision of the U. S. Copyright Law: 1975 Revision Bill, Chapter XI, pp. 12-13.

works may be accorded work for hire status. The hiring party’s right to control the product simply is not determinative. See Note, *The Creative Commissioner: Commissioned Works Under the Copyright Act of 1976*, 62 N. Y. U. L. Rev. 373, 388 (1987). Indeed, importing a test based on a hiring party’s right to control, or actual control of, a product would unravel the “carefully worked out compromise aimed at balancing legitimate interests on both sides.” H. R. Rep. No. 2237, *supra*, at 114, quoting Supplemental Report, at 66.¹⁰

We do not find convincing petitioners’ contrary interpretation of the history of the Act. They contend that Congress, in enacting the Act, meant to incorporate a line of cases decided under the 1909 Act holding that an employment relationship exists sufficient to give the hiring party copyright ownership whenever that party has the right to control or supervise the artist’s work.~ In support of this position, petitioners note: “Nowhere in the 1976 Act or in the Act’s legislative history does Congress state that it intended to jettison the control standard or otherwise to reject the pre-Act judicial approach to identifying a work for hire employment relationship.” Brief for Petitioners 20, citing *Aldon Accessories*, 738 F. 2d, at 552.

We are unpersuaded. Ordinarily, “Congress’ silence is just that — silence.” *Alaska Airlines, Inc. v. Brock*, 480 U. S. 678, 686 (1987). Petitioners’ reliance on legislative silence is particularly misplaced here because the text and structure of § 101 counsel otherwise.~

Finally, petitioners’ construction of the work for hire provisions would impede Congress’ paramount goal in revising the 1976 Act of enhancing predictability and certainty of copyright ownership. See H. R. Rep. No. 94-1476, *supra*, at 129. In a “copyright marketplace,” the parties negotiate with an expectation that one of them will own the copyright in the completed work. *Dumas*, 865 F. 2d, at 1104-1105, n. 18. With that expectation, the parties at the outset can settle on relevant contractual terms, such as the price for the work and the ownership of reproduction rights.

¹⁰ Strict adherence to the language and structure of the Act is particularly appropriate where, as here, a statute is the result of a series of carefully crafted compromises. See *Rodriguez v. Compass Shipping Co.*, 451 U. S. 596, 617 (1981); *United States v. Sisson*, 399 U. S. 267, 291, 298 (1970).

To the extent that petitioners endorse an actual control test,¹¹ CCNV's construction of the work for hire provisions prevents such planning. Because that test turns on whether the hiring party has closely monitored the production process, the parties would not know until late in the process, if not until the work is completed, whether a work will ultimately fall within § 101(1). Under petitioners' approach, therefore, parties would have to predict in advance whether the hiring party will sufficiently control a given work to make it the author. "If they guess incorrectly, their reliance on 'work for hire' or an assignment may give them a copyright interest that they did not bargain for." *Easter Seal Society*, 815 F. 2d, at 333; accord, *Dumas, supra*, at 1103. This understanding of the work for hire provisions clearly thwarts Congress' goal of ensuring predictability through advance planning. Moreover, petitioners' interpretation "leaves the door open for hiring parties, who have failed to get a full assignment of copyright rights from independent contractors falling outside the subdivision (2) guidelines, to unilaterally obtain work-made-for-hire rights years after the work has been completed as long as they directed or supervised the work, a standard that is hard not to meet when one is a hiring party." Hamilton, *Commissioned Works as Works Made for Hire Under the 1976 Copyright Act: Misinterpretation and Injustice*, 135 U. Pa. L. Rev. 1281, 1304 (1987).

In sum, we must reject petitioners' argument. Transforming a commissioned work into a work by an employee on the basis of the hiring party's right to control, or actual control of, the work is inconsistent with the language, structure, and legislative history of the work for hire provisions. To determine whether a work is for hire under the Act, a court first should ascertain, using principles of general common law of agency, whether the work was prepared by an employee or an independent contractor. After making this determination, the court can apply the appropriate subsection of § 101.

B

We turn, finally, to an application of § 101 to Reid's production of "Third World America." In determining whether a hired party is an employee under the general common law of agency, we consider the hiring party's right

¹¹ Petitioners concede that, as a practical matter, it is often difficult to demonstrate the existence of a right to control without evidence of the actual exercise of that right. See *Murray v. Gelderman*, 566 F. 2d 1307, 1310-1311 (CA5 1978).

to control the manner and means by which the product is accomplished. Among the other factors relevant to this inquiry are the skill required;^ the source of the instrumentalities and tools;^ the location of the work;^ the duration of the relationship between the parties;^ whether the hiring party has the right to assign additional projects to the hired party;^ the extent of the hired party's discretion over when and how long to work;^ the method of payment;^ the hired party's role in hiring and paying assistants;^ whether the work is part of the regular business of the hiring party;^ whether the hiring party is in business;^ the provision of employee benefits;^ and the tax treatment of the hired party.^ See Restatement § 220(2) (setting forth a nonexhaustive list of factors relevant to determining whether a hired party is an employee).^ No one of these factors is determinative.~

Examining the circumstances of this case in light of these factors, we agree with the Court of Appeals that Reid was not an employee of CCNV but an independent contractor. 270 U. S. App. D. C., at 35, n. 11, 846 F. 2d, at 1494, n. 11. True, CCNV members directed enough of Reid's work to ensure that he produced a sculpture that met their specifications. 652 F. Supp., at 1456. But the extent of control the hiring party exercises over the details of the product is not dispositive. Indeed, all the other circumstances weigh heavily against finding an employment relationship. Reid is a sculptor, a skilled occupation. Reid supplied his own tools. He worked in his own studio in Baltimore, making daily supervision of his activities from Washington practicably impossible. Reid was retained for less than two months, a relatively short period of time. During and after this time, CCNV had no right to assign additional projects to Reid. Apart from the deadline for completing the sculpture, Reid had absolute freedom to decide when and how long to work. CCNV paid Reid \$15,000, a sum dependent on "completion of a specific job, a method by which independent contractors are often compensated." *Holt v. Winpisinger*, 258 U. S. App. D. C. 343, 351, 811 F. 2d 1532, 1540 (1987). Reid had total discretion in hiring and paying assistants. "Creating sculptures was hardly 'regular business' for CCNV." 270 U. S. App. D. C., at 35, n. 11, 846 F. 2d, at 1494, n. 11. Indeed, CCNV is not a business at all. Finally, CCNV did not pay payroll or Social Security taxes, provide any employee benefits, or contribute to unemployment insurance or workers' compensation funds.

Because Reid was an independent contractor, whether “Third World America” is a work for hire depends on whether it satisfies the terms of § 101(2). This petitioners concede it cannot do. Thus, CCNV is not the author of “Third World America” by virtue of the work for hire provisions of the Act. However, as the Court of Appeals made clear, CCNV nevertheless may be a joint author of the sculpture if, on remand, the District Court determines that CCNV and Reid prepared the work “with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole.” 17 U. S. C. § 101. In that case, CCNV and Reid would be co-owners of the copyright in the work. See § 201(a).

For the aforesaid reasons, we affirm the judgment of the Court of Appeals for the District of Columbia Circuit.

It is so ordered.

Rights, Licensing, Attribution, Disclaimers, and More

The following was written by Eric E. Johnson:

This Chapter C-4A, “Copyright Ownership: Works Made for Hire,” was made by Eric E. Johnson starting with Chapter 5, “Ownership of Copyrights,” of *Introduction To Intellectual Property Cases and Questions Fall 2021 Edition* authored and published by **Jason Rantanen**. © 2021 Jason Rantanen, licensed under the Creative Commons Attribution-Noncommercial 4.0 International License (CC BY-NC 4.0), available at <https://creativecommons.org/licenses/by-nc/4.0/>. That license contains a disclaimer of warranties and a statement of limitation of liability. The original work is available at <http://ssrn.com/abstract=3883500>. A printed version is available on Amazon.

Starting with Professor Rantanen’s chapter, I changed some things, removed some material, and added substantial material. Throughout, I made formatting changes, including to typography, pagination, paragraph styling, heading styles, etc., including replacing double spaces with single spaces. The chapter title is different. I added “Notes from Prof. Rantanen” as a header to mark expository text authored by Professor Rantanen and to highlight the fact that it is his. I removed statutory text from tables and formatted it as regular text. I added the header “Case: CCNV v. Reid” and in the information about the case, I added “Supreme Court of the United States.” In the case text, I corrected a couple of

typos that had crept in. And I made various deletions, indicated with editing marks as noted.

I added the “Prof. EEJ notes on” and “Copyright Office on” portions.

In Professor Rantanen’s original book, the following appeared (paragraph breaks have been omitted): “Copyright © 2021 Jason Rantanen. This work is licensed under a Creative Commons Attribution-Noncommercial 4.0 International License. Contact jason-rantanen@uiowa.edu to request additional permissions. No copyright is claimed to works in the public domain.”

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–EEJ

Chapter C-4B: Copyright Ownership: Joint Authorship

This chapter was put together by Eric E. Johnson using text from Chapter 4.B.2 of *Patterns of Information Law: Intellectual Property Done Right* (version 1.1, August 2017) authored by **James Grimmelmann**.

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Statutory law on “joint work”:

17 U.S.C. § 101 – Definitions

~A “joint work” is a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole.~

Case: Thomson v. Larson

Thomson v. Larson

U.S. Court of Appeals for the Second Circuit
147 F.3d 195 (2d Cir. 1998)

[Editing notes: Superscript right- and left-pointing descending arrows^{↖ ↗} enclose footnote material that has been incorporated into above-the-line text. All italicization has been omitted from the text. –EEJ]

Plaintiff-appellant Lynn Thomson claims that, along with principal playwright Jonathan Larson, she co-authored a “new version” of the critically acclaimed Broadway musical *Rent*.

BACKGROUND

Rent, the Pulitzer Prize and Tony Award-winning Broadway modern musical based on Puccini’s opera *La Bohème*, began in 1989 as the joint project of Billy Aronson and composer Jonathan Larson. Aronson and Larson collaborated on the work until their amicable separation in 1991. At that time, Larson obtained Aronson’s permission to develop the play on his own.

In the summer of 1992, Larson’s *Rent* script was favorably received by James Nicola, Artistic Director of the New York Theatre Workshop (“NYTW”), a non-profit theater company in the East Village. Larson continued to develop and revise the “workshop version” of his *Rent* script. In the spring of 1993, Nicola urged Larson to allow the NYTW to hire a playwright or a bookwriter to help revamp the storyline and narrative structure of the play.

In May 1995, in preparation for *Rent*’s off-Broadway opening scheduled for early 1996, Larson agreed to the NYTW’s hiring of Lynn Thomson, a professor of advanced playwrighting at New York University, as a dramaturg to assist him in clarifying the storyline of the musical. “Dramaturgs provide a range of services to playwrights and directors in connection with the production and development of theater pieces. According to Thomson’s testimony, the role of the dramaturg “can include any number of the elements that go into the crafting of a play,” such as “actual plot elements, dramatic structure, character details, themes, and even specific language.””

Thomson signed a contract with the NYTW, in which she agreed to provide her services with the workshop production from May 1, 1995, through the press opening, scheduled for early February of 1996. The agreement stated that Thomson’s “responsibilities shall include, but not be limited to: Providing dramaturgical assistance and research to the playwright and director.” In exchange, the NYTW agreed to pay “a fee” of \$2000, “[i]n full consideration of the services to be rendered” and to provide for billing credit for Thomson as “Dramaturg.” The Thomson/NYTW agreement was silent as to any copyright interests or any issue of ownership with respect to the final work.

In the summer and fall of 1995, Thomson and Larson worked extremely intensively together on the show. For the most part, the two worked on the script alone in Larson's apartment. Thomson testified that revisions to the text of *Rent* didn't begin until early August 1995. Larson himself entered all changes directly onto his computer, where he kept the script, and Thomson made no contemporaneous notes of her specific contributions of language or other structural or thematic suggestions. Thomson alludes to the "October Version" of *Rent* as the culmination of her collaborative efforts with Larson. That new version was characterized by experts as "a radical transformation of the show."

A "sing-through" of the "October Version" of *Rent* took place in early November 1995. And on November 3, 1995, Larson signed a contract with the NYTW for ongoing revisions to *Rent*. This agreement identified Larson as the "Author" of *Rent* and made no reference to Thomson. The contract incorporated by reference an earlier draft author's agreement that set forth the terms that would apply if the NYTW opted to produce *Rent*. The earlier draft author's agreement gave Larson approval rights over all changes in text, provided that any changes in text would become his property, and assured him billing as "sole author."

The final dress rehearsal was held on January 24, 1996. Just hours after it ended, Larson died suddenly of an aortic aneurysm. Over the next few weeks, Nicola, Greif, Thomson, and musical director Tim Weil worked together to fine-tune the script. The play opened off-Broadway on February 13, 1996, to rave reviews. On February 23, *Rent*'s move to Broadway was announced. Since its opening on Broadway on April 29, 1996, the show has been "an astounding critical, artistic, and commercial success."

Before the Broadway opening, Thomson, in view of her contributions to *Rent*, sought compensation and title page dramaturgical credit from the Broadway producers. And on April 2, 1996, she signed a contract in which the producers agreed to pay her \$10,000 plus a nominal \$50/ week for her dramaturgical services. Around the same time, upon the producers' advice, Thomson approached Allan S. Larson, Nanette Larson, and Julie Larson McCollum ("Larson Heirs"), the surviving members of Jonathan Larson's family, to request a percentage of the royalties derived from the play. In a letter to the Larson family, dated April 8, 1996, Thomson stated that she believed Larson, had he lived, would have offered her a "small percentage of his

royalties to acknowledge the contribution I made.” In reply, the Larson Heirs offered Thomson a gift of 1% of the author’s royalties. Negotiations between Thomson and the Larson Heirs, however, broke down.

After the parties failed to reach a settlement, Thomson brought suit against the Larson Heirs, claiming that she was a co-author of *Rent* and that she had never assigned, licensed, or otherwise transferred her rights. Thomson sought declaratory relief and a retroactive and on-going accounting under the Copyright Act. Specifically, she asked that the court declare her a “co-author” of *Rent* and grant her 16% of the author’s share of the royalties. “Thomson claims that she seeks 16% of the proceeds “because of her respect for Larson’s role as the principal creator of the work.” Thomson derives the 16% figure in the following way: she alleges that 48% of the *Rent* script is new in relation to the 1994 Workshop version (prior to her involvement); as co-author, she is, therefore, entitled to 50% of this part (or 24% of the total revenues); but since there are three components to *Rent* (book, lyrics, and music) and she did not contribute to one (music), she is entitled to 2/3, or 16% of the total revenues. Thomson also sought the right to quote freely from various versions of *Rent* in a book that she planned to write.”

THOMSON’S CO-AUTHORSHIP CLAIM

The Copyright Act defines a “joint work” as “a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole.” 17 U.S.C. § 101 (1994). The touchstone of the statutory definition is the intention at the time the writing is done that the parts be absorbed or combined into an integrated unit.

Joint authorship entitles the co-authors to equal undivided interests in the whole work – in other words, each joint author has the right to use or to license the work as he or she wishes, subject only to the obligation to account to the other joint owner for any profits that are made.

In *Childress v. Taylor*, our court interpreted this section of the Act and set forth “standards for determining when a contributor to a copyrighted work is entitled to be regarded as a joint author” where the parties have failed to sign any written agreement dealing with coauthorship. While the Copyright Act states only that co-authors must intend that their contributions “be merged

into ... a unitary whole,” Judge Newman explained why a more stringent inquiry than the statutory language would seem to suggest is required:

An inquiry so limited would extend joint author status to many persons who are not likely to have been within the contemplation of Congress. For example, a writer frequently works with an editor who makes numerous useful revisions to the first draft, some of which will consist of additions of copyrightable expression. Both intend their contributions to be merged into inseparable parts of a unitary whole, yet very few editors and even fewer writers would expect the editor to be accorded the status of joint author, enjoying an undivided half interest in the copyright in the published work.

The potential danger of allowing anyone who makes even a minimal contribution to the writing of a work to be deemed a statutory co-author – as long as the two parties intended the contributions to merge — motivated the court to set forth a two-pronged test. A co-authorship claimant bears the burden of establishing that each of the putative co-authors (1) made independently copyrightable contributions to the work; and (2) fully intended to be co-authors.

1. Independently Copyrightable Contributions

Childress held that collaboration alone is not sufficient to establish joint authorship. Rather, the contribution of each joint author must be independently copyrightable.

Without making specific findings as to any of Thomson’s claims regarding lyrics or other contributions, the district court concluded that Thomson “made at least some non-de minimis copyrightable contribution,” and that Thomson’s contributions to the Rent libretto were “certainly not zero.” Once having said that, the court decided the case on the second *Childress* prong – mutual intent of co-authorship. It hence did not reach the issue of the individual copyrightability of Thomson’s varied alleged contributions (plot developments, thematic elements, character details, and structural components).

2. Intent of the Parties

Childress mandates that the parties “entertain in their minds the concept of joint authorship.” This requirement of mutual intent recognizes that, since

coauthors are afforded equal rights in the coauthored work, the “equal sharing of rights should be reserved for relationships in which all participants fully intend to be joint authors.”

Childress and its progeny, however, do not explicitly define the nature of the necessary intent to be co-authors. The court stated that “[i]n many instances, a useful test will be whether, in the absence of contractual arrangements concerning listed authorship, each participant intended that all would be identified as co-authors.” But it is also clear that the intention standard is not strictly subjective.

i. Decisionmaking Authority

An important indicator of authorship is a contributor’s decisionmaking authority over what changes are made and what is included in a work. See, e.g., *Erickson v. Trinity Theatre, Inc.* (an actor’s suggestion of text does not support a claim of co-authorship where the sole author determined whether and where such contributions were included in the work); *Maruel v. Smith* (claimant had a contractual right to control the contents of the opera).

The district court determined that Larson “retained and intended to retain at all times sole decision-making authority as to what went into Rent.” In support of its conclusion, the court relied upon Thomson’s statement that she was “flattered that [Larson] was asking [her] to contribute actual language to the text” and found that this statement demonstrated that even Thomson understood “that the question whether any contribution she might make would go into the script was within Mr. Larson’s sole and complete discretion.” Moreover, as the court recognized, the November agreement between Larson and the NYTW expressly stated that Larson had final approval over all changes to Rent and that all such changes would become Larson’s property.

ii. Billing

In discerning how parties viewed themselves in relation to a work, Childress also deemed the way in which the parties bill or credit themselves to be significant. As the district court noted, “billing or credit is ... a window on the mind of the party who is responsible for giving the billing or the credit.” And a writer’s attribution of the work to herself alone is “persuasive proof ... that she intended this particular piece to represent her own individual

authorship” and is “prima facie proof that [the] work was not intended to be joint.” *Weissmann v. Freeman Thomson* claims that Larson’s decision to credit her as “dramaturg” on the final page of *Rent* scripts reflected some co-authorship intent. Thomson concedes that she never sought equal billing with Larson, but argues that she did not need to do so in order to be deemed a statutory co-author.

The district court found, instead, that the billing was unequivocal: Every script brought to [the court’s] attention says “*Rent*, by Jonathan Larson.” In addition, Larson “described himself in the biography he submitted for the playbill in January 1996, nine days before he died, as the author/composer, and listed Ms. Thomson on the same document as dramaturg.” And while, as Ms. Thomson argues, it may indeed have been highly unusual for an author/composer to credit his dramaturg with a byline, we fail to see how Larson’s decision to style her as “dramaturg” on the final page in *Rent* scripts reflects a co-authorship intent on the part of Larson. The district court properly concluded that “the manner in which [Larson] listed credits on the scripts strongly supports the view that he regarded himself as the sole author.”

iii. Written Agreements with Third Parties

Just as the parties’ written agreements with each other can constitute evidence of whether the parties considered themselves to be co-authors, so the parties’ agreements with outsiders also can provide insight into co-authorship intent, albeit to a somewhat more attenuated degree.

The district court found that Larson “listed himself or treated himself as the author in the November 1995 revisions contract that he entered into with the NYTW, which in turn incorporated the earlier draft author’s agreement that had not been signed.” That agreement identifies Larson as *Rent*’s “Author” and does not mention Thomson. It also incorporates the terms of a September 1995 draft agreement (termed “Author’s Agreement”) that states that Larson “shall receive billing as sole author.” The district court commented, moreover, that

“[t]he fact that [Larson] felt free to enter into the November 1995 contract on his own, without the consent of and without any reference to Ms. Thomson quite apart from whatever the terms of the agreements are, indicates that his intention was to be the sole author.”

CONCLUSION

Based on all of the evidence, the district court concluded that “Mr. Larson never regarded himself as a joint author with Ms. Thomson.” We believe that the district court correctly applied the Childress standards to the evidence before it and hold that its finding that Larson never intended co-authorship was not clearly erroneous.

Judicial explanation of copyright co-owners’ rights and duties

from Greene v. Ablon, 794 F.3d 133 (1st Cir. 2015)

Authors who create a joint work co-own the copyright in that work. Joint authors share equal undivided interests in the whole work – in other words, each joint author has the right to use or to license the work as he or she wishes, subject only to the obligation to account to the other joint author for any profits that are made. Even if it is clear that one co-author has contributed more to the work than another co-author, they are nevertheless equal owners of the copyright in the absence of an agreement to the contrary.

A co-owner must account to other co-owners for any profits he earns from licensing or use of the copyright. The duty to account comes from equitable doctrines relating to unjust enrichment and general principles of law governing the rights of co-owners. We acknowledge the theoretical appeal of the notion that if one owner permits free use of the copyright, that owner incurs a debt to his co-owner because the use, paid-for or not, partially depletes the value of the copyright. However, the duty to account is for profits, not value.

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The following was written by Eric E. Johnson:

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For the material I took from Professor Grimmelmann’s book, I made formatting changes, including to typography, pagination, paragraph styling, etc. I used Professor Grimmelmann’s selection and edit of the *Thomson v. Larson* case, and made edits as indicated with editing mark and as explained in a bracketed note at the beginning of the case. For the section I titled “Judicial explanation of copyright co-owners’ rights and duties,” I used the text Professor Grimmelmann provided as a case reading for *Greene v. Ablon*.

Also, we both used some statutory text from 17 U.S.C. § 101 regarding the definition of “joint work,” although given the subject matter, it would be hard not to.

I am very grateful to James Grimmelmann for his generosity in sharing his excellent materials!

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–EEJ

Chapter C-4C: Copyright Ownership: Assignment

This chapter—for what it’s worth, there’s not much to it—was authored by Eric E. Johnson. Please see “Rights, Licensing, Etc.” at the end of this chapter.

Key statutory law regarding ownership and transfer of copyright

17 U.S.C. § 201 Ownership of copyright

(a) Initial Ownership.—Copyright in a work protected under this title vests initially in the author or authors of the work. The authors of a joint work are coowners of copyright in the work.

(b) Works Made for Hire.—In 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, and, unless the parties have expressly agreed otherwise in a written instrument signed by them, owns all of the rights comprised in the copyright.

(c) Contributions to Collective Works.—Copyright in each separate contribution to a collective work is distinct from copyright in the collective work as a whole, and vests initially in the author of the contribution. In the absence of an express transfer of the copyright or of any rights under it, the owner of copyright in the collective work is presumed to have acquired only the privilege of reproducing and distributing the contribution as part of that particular collective work, any revision of that collective work, and any later collective work in the same series.

(d) Transfer of Ownership.—

(1) The 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. (2) Any of the exclusive rights comprised in a copyright, including any subdivision of any of the rights specified by section 106, may be transferred as provided by clause (1) and owned separately. The owner of any particular exclusive right is entitled, to the extent of that right, to all of the protection and remedies accorded to the copyright owner by this title.

(e) Involuntary Transfer.—When an individual author’s ownership of a copyright, or of any of the exclusive rights under a copyright, has not previously been transferred voluntarily by that individual author, no action by any governmental body or other official or organization purporting to seize, expropriate, transfer, or exercise rights of ownership with respect to the copyright, or any of the exclusive rights under a copyright, shall be given effect under this title, except as provided under title 11.

17 U.S.C. § 202 Ownership of copyright as distinct from ownership of material object

Ownership of a copyright, or of any of the exclusive rights under a copyright, is distinct from ownership of any material object in which the work is embodied. Transfer of ownership of any material object, including the copy or phonorecord in which the work is first fixed, does not of itself convey any rights in the copyrighted work embodied in the object; nor, in the absence of an agreement, does transfer of ownership of a copyright or of any exclusive rights under a copyright convey property rights in any material object.

17 U.S.C. § 203 Termination of transfers and licenses granted by the author

(a) Conditions for Termination.—In the case of any work other than a work made for hire, the exclusive or nonexclusive grant of a transfer or license of copyright or of any right under a copyright, executed by the author on or after January 1, 1978, otherwise than by will, is subject to termination under the following conditions:

(1) In the case of a grant executed by one author, termination of the grant may be effected by that author or, if the author is dead, by the person or

persons who, under clause (2) of this subsection, own and are entitled to exercise a total of more than one-half of that author's termination interest. In the case of a grant executed by two or more authors of a joint work, termination of the grant may be effected by a majority of the authors who executed it; if any of such authors is dead, the termination interest of any such author may be exercised as a unit by the person or persons who, under clause (2) of this subsection, own and are entitled to exercise a total of more than one-half of that author's interest.

(2) Where an author is dead, his or her termination interest is owned, and may be exercised, as follows:

(A) The widow or widower owns the author's entire termination interest unless there are any surviving children or grandchildren of the author, in which case the widow or widower owns one-half of the author's interest.

(B) The author's surviving children, and the surviving children of any dead child of the author, own the author's entire termination interest unless there is a widow or widower, in which case the ownership of one-half of the author's interest is divided among them.

(C) The rights of the author's children and grandchildren are in all cases divided among them and exercised on a per stirpes basis according to the number of such author's children represented; the share of the children of a dead child in a termination interest can be exercised only by the action of a majority of them.

(D) In the event that the author's widow or widower, children, and grandchildren are not living, the author's executor, administrator, personal representative, or trustee shall own the author's entire termination interest.

(3) Termination of the grant may be effected at any time during a period of five years beginning at the end of thirty-five years from the date of execution of the grant; or, if the grant covers the right of publication of the work, the period begins at the end of thirty-five years from the date of publication of the work under the grant or at the end of forty years from the date of execution of the grant, whichever term ends earlier.

(4) The termination shall be effected by serving an advance notice in writing, signed by the number and proportion of owners of termination

interests required under clauses (1) and (2) of this subsection, or by their duly authorized agents, upon the grantee or the grantee's successor in title.

(A) The notice shall state the effective date of the termination, which shall fall within the five-year period specified by clause (3) of this subsection, and the notice shall be served not less than two or more than ten years before that date. A copy of the notice shall be recorded in the Copyright Office before the effective date of termination, as a condition to its taking effect.

(B) The notice shall comply, in form, content, and manner of service, with requirements that the Register of Copyrights shall prescribe by regulation.

(5) Termination of the grant may be effected notwithstanding any agreement to the contrary, including an agreement to make a will or to make any future grant.

(b) Effect of Termination.—Upon the effective date of termination, all rights under this title that were covered by the terminated grants revert to the author, authors, and other persons owning termination interests under clauses (1) and (2) of subsection (a), including those owners who did not join in signing the notice of termination under clause (4) of subsection (a), but with the following limitations:

(1) A derivative work prepared under authority of the grant before its termination may continue to be utilized under the terms of the grant after its termination, but this privilege does not extend to the preparation after the termination of other derivative works based upon the copyrighted work covered by the terminated grant.

(2) The future rights that will revert upon termination of the grant become vested on the date the notice of termination has been served as provided by clause (4) of subsection (a). The rights vest in the author, authors, and other persons named in, and in the proportionate shares provided by, clauses (1) and (2) of subsection (a).

(3) Subject to the provisions of clause (4) of this subsection, a further grant, or agreement to make a further grant, of any right covered by a terminated grant is valid only if it is signed by the same number and proportion of the owners, in whom the right has vested under clause (2) of this subsection, as are required to terminate the grant under clauses (1) and (2) of subsection (a). Such further grant or agreement is effective with respect to all of the persons in whom the right it covers has vested under clause (2) of this

subsection, including those who did not join in signing it. If any person dies after rights under a terminated grant have vested in him or her, that person's legal representatives, legatees, or heirs at law represent him or her for purposes of this clause.

(4) A further grant, or agreement to make a further grant, of any right covered by a terminated grant is valid only if it is made after the effective date of the termination. As an exception, however, an agreement for such a further grant may be made between the persons provided by clause (3) of this subsection and the original grantee or such grantee's successor in title, after the notice of termination has been served as provided by clause (4) of subsection (a).

(5) Termination of a grant under this section affects only those rights covered by the grants that arise under this title, and in no way affects rights arising under any other Federal, State, or foreign laws.

(6) Unless and until termination is effected under this section, the grant, if it does not provide otherwise, continues in effect for the term of copyright provided by this title.

17 U.S.C. § 204 Execution of transfers of copyright ownership

(a) A transfer of copyright ownership, other than by operation of law, is not valid unless an instrument of conveyance, or a note or memorandum of the transfer, is in writing and signed by the owner of the rights conveyed or such owner's duly authorized agent.

(b) A certificate of acknowledgment is not required for the validity of a transfer, but is prima facie evidence of the execution of the transfer if—

(1) in the case of a transfer executed in the United States, the certificate is issued by a person authorized to administer oaths within the United States; or
(2) in the case of a transfer executed in a foreign country, the certificate is issued by a diplomatic or consular officer of the United States, or by a person authorized to administer oaths whose authority is proved by a certificate of such an officer.

17 U.S.C. § 205 · Recordation of transfers and other documents

(a) Conditions for Recordation.—Any transfer of copyright ownership or other document pertaining to a copyright may be recorded in the Copyright Office if the document filed for recordation bears the actual signature of the person who executed it, or if it is accompanied by a sworn or official certification that it is a true copy of the original, signed document. A sworn or official certification may be submitted to the Copyright Office electronically, pursuant to regulations established by the Register of Copyrights.

Rights, Licensing, Etc.

This Chapter C-4C, “Copyright Ownership: Assignment,” was authored and published by Eric E. Johnson in 2022. © 2022 Eric E. Johnson. There’s really not much to this chapter – it’s a selection of federal statutes. But, at any rate, the author hereby licenses this chapter the Creative Commons Attribution NonCommercial ShareAlike 4.0 International License (CC BY-NC-SA 4.0), available at <https://creativecommons.org/licenses/by-nc-sa/4.0/legalcode>. Attribution should be to Eric E. Johnson, with a link to <http://ericejohnson.com/ipsurveyor/>.

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–EEJ

Chapter C-5: Copyright Infringement Analysis

This chapter was made in its current form by Eric E. Johnson by starting with Chapter 7, “Introduction to Copyright Infringement,” of *Introduction To Intellectual Property Cases and Questions Fall 2021 Edition* authored by **Jason Rantanen**, and then changing some things and adding substantial material. Please see “Rights, Licensing, Attribution, Disclaimers, and More” at the end of this chapter.

Prof. EEJ’s notes on copyright infringement

As is generally true with “intellectual property rights,” owning a copyright really doesn’t give you the affirmative “right” to do anything. In that sense, it is strange and potentially misleading to refer to copyright as a “right.”

The “right of free speech” in the United States is a straightforward “right” in the classic sense. The right of free speech under the First Amendment is “a moral or legal entitlement to have or obtain something or to act in a certain way,” which is how my laptop’s dictionary defines “right.” I can speak my mind, and the government can’t stop me. Procedurally, that essentially manifests as a defense that would be used by a litigation defendant.

But copyright is not a “right” like that. It’s really a privilege to bring actions in court against others to stop them from doing things in the future and to get a court-ordered award of money from them for things they already did. In other words, copyright is an entitlement to sue people, and it is helpful

to think about it that way. Now, what can you sue them for? The answer is *infringement*.

In the language of copyright law, you can sue someone for infringement when they have exercised one of the “exclusive rights” provided to you under copyright law. But again, even though the statute phrases these things as your “rights,” the statute really doesn’t give you the affirmative right to do these things. The more illuminating word to focus on is “exclusive.” What the statute is really saying is that if someone else does something that within your “exclusive rights,” you can bring an infringement action against them.

Now this is important: There are many different “exclusive rights” within copyright that can form the basis for an infringement action.

The archetypal exclusive right is the *reproduction right*. (See 17 U.S.C. § 106(1), below.) That there would be an exclusive right to reproduce the copyrighted work makes a lot of sense—that’s the “copy” in “copyright.” If someone reproduces your copyrighted work, they are—subject to various limitations and exceptions—infringing on your copyright.

But you don’t have to copy to infringe a copyright! There are other exclusive rights—including distribution to the public, public display, and public performance. Read them all in §106, below.

Key statutory law regarding infringement of copyright

17 U.S.C. § 106 – Exclusive rights in copyrighted works

Subject to sections 107 through 122, the owner of copyright under this title has the exclusive rights to do and to authorize any of the following:

- (1) to reproduce the copyrighted work in copies or phonorecords;
- (2) to prepare derivative works based upon the copyrighted work;
- (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;
- (4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly;

(5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and

(6) in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.

17 U.S.C. § 501 – Infringement of copyright

(a) Anyone who violates any of the exclusive rights of the copyright owner as provided by sections 106 through 122 or of the author as provided in section 106A(a), or who imports copies or phonorecords into the United States in violation of section 602, is an infringer of the copyright or right of the author, as the case may be. For purposes of this chapter (other than section 506), any reference to copyright shall be deemed to include the rights conferred by section 106A(a).

As used in this subsection, the term “anyone” includes any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this title in the same manner and to the same extent as any nongovernmental entity.

(b) The legal or beneficial owner of an exclusive right under a copyright is entitled, subject to the requirements of section 411, to institute an action for any infringement of that particular right committed while he or she is the owner of it. The court may require such owner to serve written notice of the action with a copy of the complaint upon any person shown, by the records of the Copyright Office or otherwise, to have or claim an interest in the copyright, and shall require that such notice be served upon any person whose interest is likely to be affected by a decision in the case. The court may require the joinder, and shall permit the intervention, of any person having or claiming an interest in the copyright.

(c) For any secondary transmission by a cable system that embodies a performance or a display of a work which is actionable as an act of infringement under subsection (c) of section 111, a television broadcast station holding a copyright or other license to transmit or perform the same version of

that work shall, for purposes of subsection (b) of this section, be treated as a legal or beneficial owner if such secondary transmission occurs within the local service area of that television station.

(d) For any secondary transmission by a cable system that is actionable as an act of infringement pursuant to section 111(c)(3), the following shall also have standing to sue: (i) the primary transmitter whose transmission has been altered by the cable system; and (ii) any broadcast station within whose local service area the secondary transmission occurs.

(e) With respect to any secondary transmission that is made by a satellite carrier of a performance or display of a work embodied in a primary transmission and is actionable as an act of infringement under section 119(a)(3), a network station holding a copyright or other license to transmit or perform the same version of that work shall, for purposes of subsection (b) of this section, be treated as a legal or beneficial owner if such secondary transmission occurs within the local service area of that station.

(f)(1) With respect to any secondary transmission that is made by a satellite carrier of a performance or display of a work embodied in a primary transmission and is actionable as an act of infringement under section 122, a television broadcast station holding a copyright or other license to transmit or perform the same version of that work shall, for purposes of subsection (b) of this section, be treated as a legal or beneficial owner if such secondary transmission occurs within the local market of that station.

(2) A television broadcast station may file a civil action against any satellite carrier that has refused to carry television broadcast signals, as required under section 122(a)(2), to enforce that television broadcast station's rights under section 338(a) of the Communications Act of 1934.

Notes from Prof. Rantanen on infringement

To this point, we have studied questions relating to the existence and ownership of copyright. Now, we will turn to the right itself—in particular, the legal rights that it conveys to a copyright owner. The basic set of rights is set out in 17 U.S.C. § 106.

Analyzing copyright infringement is, at heart, a difficult question—and is made more so by the proliferation of human-created works of creative

expression, each of which is both a copyrighted work in itself and subject to copyrights in other works. The complexity of these interrelationships is, in short, staggering. Mostly, though, copyright infringement disputes tend to focus on economically significant activities.

Although coming from a time that predates much of the proliferation of copyrighted works, *Nichols v. Universal Pictures* is frequently referred to for its description of an analytical framework to use for dealing with a common problem that arises in claims of copyright infringement: what to do about nonliteral copying? Nonliteral copying is copying that does not simply reproduce the work verbatim, such as on a photocopier, but instead copies only elements or pieces of the protected work. *Nichols* addresses two fundamental questions: (1) Can such conduct be considered copyright infringement, and (2) if so, at what point does nonliteral copying from a work cease to be copyright infringement?

Prof. EEJ's notes on Nichols

This case is a giant in copyright caselaw with great precedential value. At the time of this writing, it has been cited by courts 374, including twice by the U.S. Supreme Court.

Case: Nichols v. Universal Pictures

Nichols v. Universal Pictures

U.S. Court of Appeals for the Second Circuit
45 F.2d 119 (2d Cir. 1930)

L. HAND, Circuit Judge.

The plaintiff is the author of a play, "Abie's Irish Rose," which it may be assumed was properly copyrighted under section five, subdivision (d), of the Copyright Act, 17 USCA § 5(d). The defendant produced publicly a motion picture play, "The Cohens and The Kellys," which the plaintiff alleges was taken from it. As we think the defendant's play too unlike the plaintiff's to be an infringement, we may assume, *arguendo*, that in some details the defendant used the plaintiff's play, as will subsequently appear, though we do not so decide. It therefore becomes necessary to give an outline of the two plays.

“Abie’s Irish Rose” presents a Jewish family living in prosperous circumstances in New York. The father, a widower, is in business as a merchant, in which his son and only child helps him. The boy has philandered with young women, who to his father’s great disgust have always been Gentiles, for he is obsessed with a passion that his daughter-in-law shall be an orthodox Jewess. When the play opens the son, who has been courting a young Irish Catholic girl, has already married her secretly before a Protestant minister, and is concerned to soften the blow for his father, by securing a favorable impression of his bride, while concealing her faith and race. To accomplish this he introduces her to his father at his home as a Jewess, and lets it appear that he is interested in her, though he conceals the marriage. The girl somewhat reluctantly falls in with the plan; the father takes the bait, becomes infatuated with the girl, concludes that they must marry, and assumes that of course they will, if he so decides. He calls in a rabbi, and prepares for the wedding according to the Jewish rite.

Meanwhile the girl’s father, also a widower, who lives in California, and is as intense in his own religious antagonism as the Jew, has been called to New York, supposing that his daughter is to marry an Irishman and a Catholic. Accompanied by a priest, he arrives at the house at the moment when the marriage is being celebrated, but too late to prevent it, and the two fathers, each infuriated by the proposed union of his child to a heretic, fall into unseemly and grotesque antics. The priest and the rabbi become friendly, exchange trite sentiments about religion, and agree that the match is good. Apparently out of abundant caution, the priest celebrates the marriage for a third time, while the girl’s father is inveigled away. The second act closes with each father, still outraged, seeking to find some way by which the union, thus trebly insured, may be dissolved.

The last act takes place about a year later, the young couple having meanwhile been abjured by each father, and left to their own resources. They have had twins, a boy and a girl, but their fathers know no more than that a child has been born. At Christmas each, led by his craving to see his grandchild, goes separately to the young folks’ home, where they encounter each other, each laden with gifts, one for a boy, the other for a girl. After some slapstick comedy, depending upon the insistence of each that he is right about the sex of the grandchild, they become reconciled when they learn the truth, and that each child is to bear the given name of a grandparent. The curtain falls

as the fathers are exchanging amenities, and the Jew giving evidence of an abatement in the strictness of his orthodoxy.

“The Cohens and The Kellys” presents two families, Jewish and Irish, living side by side in the poorer quarters of New York in a state of perpetual enmity. The wives in both cases are still living, and share in the mutual animosity, as do two small sons, and even the respective dogs. The Jews have a daughter, the Irish a son; the Jewish father is in the clothing business; the Irishman is a policeman. The children are in love with each other, and secretly marry, apparently after the play opens. The Jew, being in great financial straits, learns from a lawyer that he has fallen heir to a large fortune from a great-aunt, and moves into a great house, fitted luxuriously. Here he and his family live in vulgar ostentation, and here the Irish boy seeks out his Jewish bride, and is chased away by the angry father. The Jew then abuses the Irishman over the telephone, and both become hysterically excited. The extremity of his feelings makes the Jew sick, so that he must go to Florida for a rest, just before which the daughter discloses her marriage to her mother.

On his return the Jew finds that his daughter has borne a child; at first he suspects the lawyer, but eventually learns the truth and is overcome with anger at such a low alliance. Meanwhile, the Irish family who have been forbidden to see the grandchild, go to the Jew’s house, and after a violent scene between the two fathers in which the Jew disowns his daughter, who decides to go back with her husband, the Irishman takes her back with her baby to his own poor lodgings. The lawyer, who had hoped to marry the Jew’s daughter, seeing his plan foiled, tells the Jew that his fortune really belongs to the Irishman, who was also related to the dead woman, but offers to conceal his knowledge, if the Jew will share the loot. This the Jew repudiates, and, leaving the astonished lawyer, walks through the rain to his enemy’s house to surrender the property. He arrives in great dejection, tells the truth, and abjectly turns to leave. A reconciliation ensues, the Irishman agreeing to share with him equally. The Jew shows some interest in his grandchild, though this is at most a minor motive in the reconciliation, and the curtain falls while the two are in their cups, the Jew insisting that in the firm name for the business, which they are to carry on jointly, his name shall stand first.

It is of course essential to any protection of literary property, whether at common-law or under the statute, that the right cannot be limited literally to the text, else a plagiarist would escape by immaterial variations. That has never

been the law, but, as soon as literal appropriation ceases to be the test, the whole matter is necessarily at large, so that, as was recently well said by a distinguished judge, the decisions cannot help much in a new case. *Fendler v. Morosco*, 253 N. Y. 281, 292, 171 N. E. 56. When plays are concerned, the plagiarist may excise a separate scene [*Daly v. Webster*, 56 F. 483 (C. C. A. 2); *Chappell v. Fields*, 210 F. 864 (C. C. A. 2); *Chatterton v. Cave*, L. R. 3 App. Cas. 483]; or he may appropriate part of the dialogue (*Warne v. Seeborn*, L. R. 39 Ch. D. 73). Then the question is whether the part so taken is “substantial,” and therefore not a “fair use” of the copyrighted work; it is the same question as arises in the case of any other copyrighted work. *Marks v. Feist*, 290 F. 959 (C. C. A. 2); *Emerson v. Davies*, Fed. Cas. No. 4436, 3 Story, 768, 795-797. But when the plagiarist does not take out a block in situ, but an abstract of the whole, decision is more troublesome. Upon any work, and especially upon a play, a great number of patterns of increasing generality will fit equally well, as more and more of the incident is left out. The last may perhaps be no more than the most general statement of what the play is about, and at times might consist only of its title; but there is a point in this series of abstractions where they are no longer protected, since otherwise the playwright could prevent the use of his “ideas,” to which, apart from their expression, his property is never extended. *Holmes v. Hurst*, 174 U. S. 82, 86, 19 S. Ct. 606, 43 L. Ed. 904; *Guthrie v. Curlett*, 36 F.2d 694 (C. C. A. 2). Nobody has ever been able to fix that boundary, and nobody ever can. In some cases the question has been treated as though it were analogous to lifting a portion out of the copyrighted work (*Rees v. Melville*, MacGillivray’s Copyright Cases [1911-1916], 168); but the analogy is not a good one, because, though the skeleton is a part of the body, it pervades and supports the whole. In such cases we are rather concerned with the line between expression and what is expressed. As respects plays, the controversy chiefly centers upon the characters and sequence of incident, these being the substance.

We did not in *Dymow v. Bolton*, 11 F. (2d) 690, hold that a plagiarist was never liable for stealing a plot; that would have been flatly against our rulings in *Dam v. Kirk La Shelle Co.*, 175 F. 902, 41 L. R. A. (N. S.) 1002, 20 Ann. Cas. 1173, and *Stodart v. Mutual Film Co.*, 249 F. 513, affirming my decision in (D. C.) 249 F. 507; neither of which we meant to overrule. We found the plot of the second play was too different to infringe, because the most detailed pattern, common to both, eliminated so much from each that its content went

into the public domain; and for this reason we said, “this mere subsection of a plot was not susceptible of copyright.” But we do not doubt that two plays may correspond in plot closely enough for infringement. How far that correspondence must go is another matter. Nor need we hold that the same may not be true as to the characters, quite independently of the “plot” proper, though, as far as we know, such a case has never arisen. If *Twelfth Night* were copyrighted, it is quite possible that a second comer might so closely imitate Sir Toby Belch or Malvolio as to infringe, but it would not be enough that for one of his characters he cast a riotous knight who kept wassail to the discomfort of the household, or a vain and foppish steward who became amorous of his mistress. These would be no more than Shakespeare’s “ideas” in the play, as little capable of monopoly as Einstein’s Doctrine of Relativity, or Darwin’s theory of the Origin of Species. It follows that the less developed the characters, the less they can be copyrighted; that is the penalty an author must bear for marking them too indistinctly.

In the two plays at bar we think both as to incident and character, the defendant took no more — assuming that it took anything at all — than the law allowed. The stories are quite different. One is of a religious zealot who insists upon his child’s marrying no one outside his faith; opposed by another who is in this respect just like him, and is his foil. Their difference in race is merely an obbligate to the main theme, religion. They sink their differences through grandparental pride and affection. In the other, zealotry is wholly absent; religion does not even appear. It is true that the parents are hostile to each other in part because they differ in race; but the marriage of their son to a Jew does not apparently offend the Irish family at all, and it exacerbates the existing animosity of the Jew, principally because he has become rich, when he learns it. They are reconciled through the honesty of the Jew and the generosity of the Irishman; the grandchild has nothing whatever to do with it. The only matter common to the two is a quarrel between a Jewish and an Irish father, the marriage of their children, the birth of grandchildren and a reconciliation.

If the defendant took so much from the plaintiff, it may well have been because her amazing success seemed to prove that this was a subject of enduring popularity. Even so, granting that the plaintiff’s play was wholly original, and assuming that novelty is not essential to a copyright, there is no monopoly in such a background. Though the plaintiff discovered the vein, she

could not keep it to herself; so defined, the theme was too generalized an abstraction from what she wrote. It was only a part of her “ideas.”

Nor does she fare better as to her characters. It is indeed scarcely credible that she should not have been aware of those stock figures, the low comedy Jew and Irishman. The defendant has not taken from her more than their prototypes have contained for many decades. If so, obviously so to generalize her copyright, would allow her to cover what was not original with her. But we need not hold this as matter of fact, much as we might be justified. Even though we take it that she devised her figures out of her brain *de novo*, still the defendant was within its rights.

There are but four characters common to both plays, the lovers and the fathers. The lovers are so faintly indicated as to be no more than stage properties. They are loving and fertile; that is really all that can be said of them, and anyone else is quite within his rights if he puts loving and fertile lovers in a play of his own, wherever he gets the cue. The plaintiff’s Jew is quite unlike the defendant’s. His obsession is his religion, on which depends such racial animosity as he has. He is affectionate, warm and patriarchal. None of these fit the defendant’s Jew, who shows affection for his daughter only once, and who has none but the most superficial interest in his grandchild. He is tricky, ostentatious and vulgar, only by misfortune redeemed into honesty. Both are grotesque, extravagant and quarrelsome; both are fond of display; but these common qualities make up only a small part of their simple pictures, no more than any one might lift if he chose. The Irish fathers are even more unlike; the plaintiff’s a mere symbol for religious fanaticism and patriarchal pride, scarcely a character at all. Neither quality appears in the defendant’s, for while he goes to get his grandchild, it is rather out of a truculent determination not to be forbidden, than from pride in his progeny. For the rest he is only a grotesque hobbledohoy, used for low comedy of the most conventional sort, which any one might borrow, if he chanced not to know the exemplar.

The defendant argues that the case is controlled by my decision in *Fisher v. Dillingham* (D. C.) 298 F. 145. Neither my brothers nor I wish to throw doubt upon the doctrine of that case, but it is not applicable here. We assume that the plaintiff’s play is altogether original, even to an extent that in fact it is hard to believe. We assume further that, so far as it has been anticipated by earlier plays of which she knew nothing, that fact is immaterial. Still, as we have already said, her copyright did not cover everything that might be drawn from

her play; its content went to some extent into the public domain. We have to decide how much, and while we are as aware as any one that the line, wherever [sic] it is drawn, will seem arbitrary, that is no excuse for not drawing it; it is a question such as courts must answer in nearly all cases. Whatever may be the difficulties a priori, we have no question on which side of the line this case falls. A comedy based upon conflicts between Irish and Jews, into which the marriage of their children enters, is no more susceptible of copyright than the outline of Romeo and Juliet.

The plaintiff has prepared an elaborate analysis of the two plays, showing a “quadrangle” of the common characters, in which each is represented by the emotions which he discovers. She presents the resulting parallelism as proof of infringement, but the adjectives employed are so general as to be quite useless. Take for example the attribute of “love” ascribed to both Jews. The plaintiff has depicted her father as deeply attached to his son, who is his hope and joy; not so, the defendant, whose father’s conduct is throughout not actuated by any affection for his daughter, and who is merely once overcome for the moment by her distress when he has violently dismissed her lover. “Anger” covers emotions aroused by quite different occasions in each case; so do “anxiety,” “despondency” and “disgust.” It is unnecessary to go through the catalogue for emotions are too much colored by their causes to be a test when used so broadly. This is not the proper approach to a solution; it must be more ingenuous, more like that of a spectator, who would rely upon the complex of his impressions of each character.

We cannot approve the length of the record, which was due chiefly to the use of expert witnesses. Argument is argument whether in the box or at the bar, and its proper place is the last. The testimony of an expert upon such issues, especially his cross-examination, greatly extends the trial and contributes nothing which cannot be better heard after the evidence is all submitted. It ought not to be allowed at all; and while its admission is not a ground for reversal, it cumpers the case and tends to confusion, for the more the court is led into the intricacies of dramatic craftsmanship, the less likely it is to stand upon the firmer, if more naïve, ground of its considered impressions upon its own perusal. We hope that in this class of cases such evidence may in the future be entirely excluded, and the case confined to the actual issues; that is, whether the copyrighted work was original, and whether the defendant copied it, so far as the supposed infringement is identical.

The defendant, “the prevailing party,” was entitled to a reasonable attorney’s fee (section 40 of the Copyright Act [17 USCA § 40]).

Decree affirmed.

Prof. EEJ’s notes on Design Basics

Most of the cases reproduced in this volume for you to read have great precedential weight, and they have been included for their value in providing authoritative exposition about current copyright doctrine. The following case, on the other hand, is provided as an example of a court working to apply leading caselaw, including cases you’ve now read, in the very modern context of lawsuit brought by a so-called “copyright troll.”

Case: Design Basics v. Signature Construction

Design Basics, LLC v. Signature Construction, Inc.

U.S. Court of Appeals for the Seventh Circuit

April 23, 2021

2021 WL 1584668 (7th Cir. 2021)

Sykes, Chief Judge.

Copyright law strikes a practical balance between the intellectual-property rights of authors and the public interest in preserving the free flow of ideas and information and encouraging creative expression, all in furtherance of the constitutional purpose to “promote the Progress of Science and useful Arts.” U.S. CONST. art. 1, § 8, cl. 8; *see generally Google LLC v. Oracle Am., Inc.*, --- U.S. ----, 141 S. Ct. 1183, 1195, --- L.Ed.2d ---- (2021). Copyright trolls—opportunistic holders of registered copyrights whose business models center on litigation rather than creative expression—disrupt this balance by inhibiting future creativity with negligible societal benefit. “Like the proverbial troll under the bridge, these firms try to extract rents from market participants who must choose between the cost of settlement and the costs and risks of litigation.” *Design Basics, LLC v. Lexington Homes, Inc.*, 858 F.3d 1093, 1097 (7th Cir. 2017).

Plaintiff Design Basics, LLC, is a copyright troll. *Id.* at 1096–97. The firm holds registered copyrights in thousands of floor plans for suburban, single-family tract homes, and its employees trawl the Internet in search of

targets for strategic infringement suits of questionable merit. The goal is to secure “prompt settlements with defendants who would prefer to pay modest or nuisance settlements rather than be tied up in expensive litigation.” *Id.* at 1097. As we explained in *Lexington Homes*, “[t]his business strategy is far removed from the goals of the Constitution’s intellectual property clause.” *Id.* Instead, it amounts to an “intellectual property shakedown.” *Id.* at 1096.

This appeal involves yet another Design Basics infringement action, one of more than 100 such suits in the last decade or so. *Id.* at 1097. When Design Basics was last before this court in *Lexington Homes*, we were guided by two well-established copyright doctrines—*scènes à faire* and merger—that constrain the ability of infringement plaintiffs to claim expansive intellectual-property rights in a manner that impedes future creativity. Applying these doctrines, we held that Design Basics’ copyright in its floor plans is thin. *Id.* at 1101–05. The designs consist mainly of unprotectable stock elements—a few bedrooms, a kitchen, a great room, etc.—and much of their content is dictated by functional considerations and existing design conventions for affordable, suburban, single-family homes. When copyright in an architectural work is thin, only a “strikingly similar” work will give rise to a possible infringement claim. *Id.* at 1105. Applying this standard, we held that no reasonable jury could find for Design Basics and affirmed a summary judgment against it. *Id.*

This latest appeal meets the same fate. Design Basics sued Signature Construction, Inc., and related companies, accusing them of copying ten of its registered floor plans for suburban, single-family homes. The district court entered summary judgment for the defendants based largely on the reasoning of *Lexington Homes*.

Design Basics asks us to overrule *Lexington Homes*. We decline to do so. And we take this opportunity to restate and clarify the elements of a prima facie case of infringement, both as a general matter and more particularly in cases involving works of this type in which copyright protection is thin. For this category of claims, only extremely close copying is actionable as unlawful infringement. Put more precisely, this type of claim may move forward only if the plaintiff’s copyrighted design and the allegedly infringing design are virtually identical. That standard is not satisfied here, so we affirm.

I. Background

We described Design Basics' business strategy in *Lexington Homes*; a brief summary will suffice for present purposes. Design Basics holds registered copyrights in thousands of floor plans for suburban, single-family homes. *Lexington Homes*, 858 F.3d at 1096. The plans are not technical construction drawings. Rather, they are basic schematic designs, largely conceptual in nature, and depict layouts for one- and two-story single-family homes that include the typical rooms: a kitchen, a dining area, a great room, a few bedrooms, bathrooms, a laundry area, a garage, stairs, assorted closets, etc.

More than a decade ago, Patrick Carmichael and Myles Sherman bought Design Basics "as an investment opportunity." *Id.* at 1096. Since then, litigation proceeds have become "a principal revenue stream" for the firm. *Id.* at 1097. Indeed, Design Basics incentivizes its employees to search the Internet for litigation targets by paying a finder's fee—a percentage of net recovery—if they locate a prospective infringement defendant. This is the core of the firm's business model. *Id.*

The firm maintains an easily accessible website displaying 2,847 floor plans. It also regularly sends mass mailings of its designs to members of the National Association of Home Builders. Over the years the firm has sent millions of publications containing its floor plans to home builders. When it initiates litigation, it hopes—indeed, expects—to find these designs in the defendant's files.

This case has its genesis in that business model. In 2014 Paul Foresman, Director of Business Development at Design Basics, emailed Carmichael with the subject line: "A gift for you." Foresman told Carmichael that by using the Internet Archive's Wayback Machine, he discovered that a firm called "Signature Homes" may have copied some of Design Basics' home designs. Carmichael was initially confused because Design Basics was *already* asserting infringement claims against a firm by that name, but Foresman clarified that *this* Signature Homes—based in Illinois—was a different company. Pleased with Foresman's discovery, Carmichael wrote back: "Wow very nice gift my friend."

This infringement suit followed. In 2016 Design Basics sued Signature Construction and related companies,[^] alleging that they infringed ten of its floor plans. During discovery, Design Basics learned that Signature's files

contained photocopies of four of its plans: “Ainsley,” “2461 Shawnee,” “2963 Columbus,” and “9169 Kempton Court.” The photocopies were found in Signature’s files for homes labeled “Carlisle,” “Lot 119 Lake Falls,” “Lot 63 Sommer Place,” and “Lot 309 Stonegate,” respectively. The photocopy of Design Basics’ 2461 Shawnee floor plan had red markings on it, indicating modifications to the plan. John Tanner, a draftsman at Signature, testified that he received the marked-up image from Steve Meid, a Signature partner, and understood that the markings were modifications that Meid wanted him to make.

At the end of lengthy discovery, Signature moved for summary judgment, relying heavily on our ruling against Design Basics in *Lexington Homes*. As we explained in that opinion, under the *scènes à faire* and merger doctrines, Design Basics’ copyright protection in its floor plans is thin, *id.* at 1101–05, and therefore only a “strikingly similar” plan would give rise to an infringement claim, *id.* at 1105. Using this standard, we held that no reasonable jury could find infringement. *Id.* Along the way to this conclusion, we noted that Design Basics had not submitted expert testimony to support its claim, relying instead on a conclusory declaration from one of its draftsmen. *Id.* at 1104.

Design Basics tried to avoid that same criticism here by submitting an affidavit from a third-party expert in opposition to Signature’s summary-judgment motion. The witness, Matthew McNicholas, is an architect and has served as an outside expert for Design Basics in at least 13 lawsuits. McNicholas asserted that Signature “unquestionably infringed” Design Basics’ home plans.

To support that opinion, McNicholas produced a 103-page report. The first 30 pages cover his qualifications and explain his general views on architectural copyright law. Pages 32–85 are descriptions of the ten copyrighted floor plans at issue in this case. This section of his report contains narrative descriptions of the features of each Design Basics floor plan, but the descriptions are remarkably similar to one another. Indeed, some parts are almost word-for-word identical.

A few examples will illustrate. For the Design Basics floor plan called “The Linden,” McNicholas wrote: “The idea behind the plan of The Linden focuses on creating a home for entertaining guests, and whose spaces are flexible

enough to meet the needs of a broad range of potential homeowner[s].” One of the features he analyzed is the front door:

From the perspective of a guest, the sheltered front door is a welcome area, not just with the covered stoop, but also composed with walls to either side of the entry, which shelter against wind and driving rain. This consideration for waiting guests reinforces the entertainment value of this design decision.

His description of the floor plan called “The Manning” is similarly generic: “The concept driving the plan of the Manning centers around creating a home focused on entertainment, but with enough flexibility to evolve into multiple solutions as the homeowner needs, while maximizing privacy.” Again, McNicholas described the front door:

From the perspective of a guest, the sheltered front door is a welcome area, not just with the covered stoop, but also arranged with the long wall of the Living Room as a shelter against driving wind and rain, while waiting for the door to open. This consideration for waiting guests reinforces the entertainment value of this design decision.

His analysis of “The Paterson” is likewise almost identical: “The idea behind the plan of The Paterson focuses on creating a home for entertaining guests, and whose spaces are flexible enough to meet the needs of a broad range of potential homeowner[s].” Regarding the front door, McNicholas wrote:

From the perspective of a guest, the sheltered front door is not just a welcome area, but with walls to either side of the entry—which shelter against wind and driving rain—it is a considerate space. Further, the sidelight at the door allows for transparency between the interior and exterior, and this thoughtfulness for waiting guests reinforces the entertainment value of this design decision.

In short, the McNicholas report purports to separately analyze the distinguishing features of each of the copyrighted plans at issue here, but the descriptions are so ordinary and interchangeable as to be virtually meaningless.

The McNicholas report ends with a visual section containing side-by-side comparisons of the Signature floor plans and the Design Basics plans they are alleged to infringe. As the district judge described this section of the report, the expert “employed extensive color-filling” to depict parallel rooms in the

copyrighted and accused plans in matching colors in an effort “to make the plans seem more similar.” The judge rejected this technique as an attempt “to manipulate and enhance the appearance of similarity.” To control for this problem, the judge extracted the line drawings from the plans without the color-filling enhancements and confined his analysis accordingly.

Comparing the unenhanced drawings, the judge determined as a matter of law that no unlawful copying occurred. He noted multiple categories of dissimilarity between the copyrighted and accused plans:

Room dimensions are different. Some plans have more rooms than the plans they are alleged to infringe. Ceilings are of different heights, and/or are of different styles (i.e., cathedral versus flat versus tray). Exterior dimensions are different. Bathrooms are in different locations. Sinks, tubs, toilets, and showers are in different locations within bathrooms. Garages are of different sizes and/or are in a different orientation to the rest of the house.

Based on these observations and applying *Lexington Homes*, the judge had no difficulty concluding that Signature’s plans “are dissimilar enough to avoid infringing the thin copyright” in the Design Basics plans. The judge entered final judgment for Signature, and Design Basics appealed.

II. Discussion

A. Proving Copyright Infringement

“Copyright and patents, the Constitution says, are 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.’” *Google*, 141 S. Ct. at 1195 (quoting U.S. CONST. art. I, § 8, cl. 8). To that end, the Copyright Act, 17 U.S.C. §§ 101 *et seq.*, establishes the prerequisites for copyright and sets limits on its scope. *Google*, 141 S. Ct. at 1195–96 (explaining that Congress weighs “the advantages and disadvantages” of copyright protection and establishes “its boundaries and conditions, the existence of exceptions and exemptions, all by exercising its own constitutional power to write a copyright statute”).

The basic prerequisites are these: “Copyright protection subsists ... in original works of authorship fixed in any tangible medium of expression” 17 U.S.C. § 102(a). “Originality is a constitutional requirement” arising by

implication from the Constitution’s reference to “authors” and “writings.” *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 346, 111 S.Ct. 1282, 113 L.Ed.2d 358 (1991). The threshold for originality is low: “Original, as the term is used in copyright, means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity.” *Id.* at 345, 111 S.Ct. 1282 (citing 1 MELVILLE B. NIMMER AND DAVID NIMMER, NIMMER ON COPYRIGHT § 2.01[A], [B] (1990)).

The Act lists categories of works that qualify for copyright protection, including “literary works,” “musical works,” “dramatic works,” and “pictorial, graphic, and sculptural works,” among others. § 102(a)(1), (2), (3), (5). “Architectural plans” and “technical drawings” are included in the statutory definition of “pictorial, graphic, and sculptural works” and can be copyrighted in this category. § 101. Until 1990, however, architectural works were not included in § 102(a) as a stand-alone category of protected works. That left some uncertainty about the status of constructed designs—i.e., the buildings themselves—among other complexities in this corner of copyright law. 1 NIMMER ON COPYRIGHT § 2A.09[A] (Rev. ed. 2020); 2 WILLIAM F. PATRY, PATRY ON COPYRIGHT § 3:101–3:107, Westlaw (database updated March 2021).

In 1990 Congress amended the Act to create a separate category of “architectural works” in the § 102(a) list, implementing our nation’s obligations under the Berne Convention for the Protection of Literary and Artistic Works. *See Architectural Works Copyright Protection Act*, Pub. L. No. 101-650, §§ 701–706, 104 Stat. 5133 (1990) (codified at 17 U.S.C. § 102(a)(8)). The 1990 legislation added the following definition for the new statutory term “architectural work”:

An “architectural work” is the design of a building as embodied in any tangible medium of expression, including a building, architectural plans, or drawings. The work includes the overall form as well as the arrangement and composition of spaces and elements in the design, but does not include individual standard features.

Id. § 702 (codified at 17 U.S.C. § 101).

Importantly, the Act limits the scope of copyright protection even for “works that the definitional provisions might otherwise include.” *Google*, 141

S. Ct. at 1196. One prominent limitation captures the traditional copyright principle known as the “idea/expression dichotomy”—the line that separates copyrightable expression from noncopyrightable ideas and facts. *Golan v. Holder*, 565 U.S. 302, 328, 132 S.Ct. 873, 181 L.Ed.2d 835 (2012). Section 102(b) codifies this principle: “In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.”

The Act creates a cause of action for infringement and provides as a general matter that “[a]nyone who violates any of the exclusive [statutory] rights of the copyright owner ... is an infringer.” 17 U.S.C. § 501(a); *see also id.* § 501(b) (providing a cause of action). This generalization doesn’t shed much light on what it takes to prove a claim, but the courts have developed and explained the plaintiff’s burden of proof. The doctrine begins with this statement from the Supreme Court: “To establish infringement, two elements must be proven: (1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original.” *Feist*, 499 U.S. at 361, 111 S.Ct. 1282. This concise formulation obscures a good deal of complexity beneath the surface, but it provides a basic framework for the claim.

The first element—ownership of a valid copyright—is not contested here. Design Basics registered its floor plans with the United States Copyright Office, and Signature does not dispute its ownership or the validity of the copyrights. We therefore assume, as we did in *Lexington Homes*, “that Design Basics owns the plans and that the plans are entitled to some copyright protection, i.e., they were created independently and possess a modicum of creativity” to satisfy the minimal originality requirement. 858 F.3d at 1099.

This litigation turns on the second element, as many infringement cases do. At this step of the general framework, the plaintiff must prove that the defendant “cop[ied] ... constituent elements of the [copyrighted] work that are original.” *Feist*, 499 U.S. at 361, 111 S.Ct. 1282. This element actually encompasses two distinct questions, although our caselaw hasn’t always neatly separated them. The first question is whether, as a factual matter, the defendant copied the plaintiff’s protected work (as opposed to independently creating a similar work); the second question is whether the copying “went so far as to constitute an improper appropriation.” *Atari, Inc. v. N. Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 614 (7th Cir. 1982); *see also* 4 NIMMER

ON COPYRIGHT § 13.01[B] (Rev. ed. 2020) (explaining the two components of the second element in the *Feist* framework).

The Ninth Circuit refers to these distinct subsidiary elements as “copying” and “unlawful appropriation.” *Rentmeester v. Nike, Inc.*, 883 F.3d 1111, 1117 (9th Cir. 2018). The Second Circuit uses the terms “copying” and “wrongful copying.” *Zalewski v. Cicero Builder Dev., Inc.*, 754 F.3d 95, 100 (2d Cir. 2014). Whatever the nomenclature, the point is to capture the important differences between the two.

In all infringement cases, the plaintiff must prove, as a factual matter, that the defendant *actually copied* his work. *Lexington Homes*, 858 F.3d at 1099. “Proof of copying by the defendant is necessary because independent creation is a complete defense to copyright infringement.” *Rentmeester*, 883 F.3d at 1117. For “[n]o matter how similar the plaintiff’s and the defendant’s works are, if the defendant created his independently, without knowledge of or exposure to the plaintiff’s work, the defendant is not liable for infringement.” *Id.*

Importantly, proof of actual copying is necessary but not sufficient to establish liability for infringement. “Not all copying ... is copyright infringement,” *Feist*, 499 U.S. at 361, 111 S.Ct. 1282, so the plaintiff must *also* prove that the defendant’s copying was wrongful—i.e., that the defendant took enough of his protected expression (as opposed to unprotectable ideas, concepts, facts, etc.) to constitute unlawful appropriation of his expressive work. *Rentmeester*, 883 F.3d at 1117; *Zalewski*, 754 F.3d at 100–01.

The first of these subsidiary elements—let’s call it “actual copying” or “copying in fact”—can be proved either directly or indirectly. Direct evidence is rare, so many cases turn on inferences to be drawn from circumstantial evidence. A circumstantial case of actual copying requires: (1) evidence that the defendant had access to the plaintiff’s copyrighted work (enough to support a reasonable inference that the defendant had an *opportunity* to copy); and (2) evidence of a substantial similarity between the plaintiff’s work and the defendant’s work (enough to support a reasonable inference that copying *in fact* occurred). *Lexington Homes*, 858 F.3d at 1099; *see also Rentmeester*, 883 F.3d at 1117; *Zalewski*, 754 F.3d at 100–01.

We have acknowledged the possibility that an accused work may bear such “an uncanny resemblance” to a copyrighted work that copying is “the

only plausible explanation” for the similarity. *Lexington Homes*, 858 F.3d at 1100. In such a case, “further proof of access may not be required.” *Id.* But the exception is “rare” and reserved for “unusual cases.” *Id.* Ordinarily, “to prove a circumstantial case of copyright infringement, the plaintiff must separately prove both access and similarity.” *Id.*

Confusion sometimes arises because the test for unlawful appropriation—a distinct inquiry—*also* looks for substantial similarity between the defendant’s work and the plaintiff’s work. As the Second Circuit has explained, “a close similarity between two works is often relevant to proving *both* actual copying and wrongful copying.” *Zalewski*, 754 F.3d at 101 (emphasis added). Accordingly, the cases often use “the same term—‘substantial similarity’—to describe both the degree of similarity relevant to proof of copying and the degree of similarity necessary to establish unlawful appropriation.” *Rentmeester*, 883 F.3d at 1117. But “[t]he term means different things in those two contexts.” *Id.*

The difference hinges on the distinction between the protected and unprotected elements in the plaintiff’s work. *Id.*; *see also Zalewski*, 754 F.3d at 101. When used as a test for actual copying in a circumstantial case, the requirement of “substantial similarity” is not limited to the protected elements of the plaintiff’s work. Similarities that relate to either the protected *or* unprotected elements of the plaintiff’s work may be probative of actual copying; the inquiry simply looks for the kind and degree of similarity that “one would not expect to arise if the two works had been created independently.” *Rentmeester*, 883 F.3d at 1117. Put somewhat differently, in a circumstantial case, the plaintiff has the burden to show that the two works are so similar that copying is a better explanation for the similarities than pure coincidence.

But “similarity that relates to *unprotected* elements is probative only of [actual] copying—not wrongful copying.” *Zalewski*, 754 F.3d at 101 (emphasis added). *Wrongful* copying—unlawful appropriation—requires substantial similarities between the defendant’s work and *protected elements* in the plaintiff’s copyrighted work. *Rentmeester*, 883 F.3d at 1117. “When an original work contains many *unprotected* elements, ... a close similarity between it and a copy may prove only copying, not wrongful copying.” *Zalewski*, 754 F.3d at 101.

To preserve the distinction between these two concepts, we will follow the Second Circuit’s lead and use the term “probative similarity” to refer to the degree of similarity necessary to support an inference of actual copying and the term “substantial similarity” to refer to the test for wrongful copying or unlawful appropriation. *Id.*

Our circuit, like most others, uses the “ordinary observer” test for unlawful appropriation: “whether the accused work is so similar to the plaintiff’s work that an ordinary reasonable person would conclude that the defendant unlawfully appropriated the plaintiff’s protect[a]ble expression by taking material of substance and value.” *Wildlife Express Corp. v. Carol Wright Sales, Inc.*, 18 F.3d 502, 508–09 (7th Cir. 1994) (quoting *Atari*, 672 F.2d at 614).[^]

B. *Scènes à Faire* and Merger

In *Lexington Homes* we explained at length that under the *scènes à faire* and merger doctrines, Design Basics holds only thin copyright protection in its floor plans. Just a brief recap is needed here.

Standard elements in a genre—called *scènes à faire* in copyright law—get no copyright protection. “French for “scenes for action.” *Scènes à faire*, BLACK’S LAW DICTIONARY (11th ed. 2019).⁷ *Scènes à faire* are “so rudimentary, commonplace, standard, or unavoidable that they do not serve to distinguish one work within a class of works from another.” *Bucklew v. Hawkins, Ash, Baptie & Co.*, 329 F.3d 923, 929 (7th Cir. 2003). If standard elements received copyright protection, then the creation of a single work in a genre would prevent others from contributing to that genre because the copyright owner would have exclusive rights in all of the genre’s basic elements.

We explained in *Lexington Homes* that Design Basics’ floor plans largely consist of *scènes à faire*. 858 F.3d at 1102–03. Every plan has a kitchen, a great room or living room, a dining room, bedrooms, bathrooms, and so forth. The arrangements of the rooms are also largely *scènes à faire*. The kitchen is always close to the dining room; the bedrooms will usually be clumped together and near a bathroom; the door from the garage into the house usually leads to the kitchen rather than the great room or living room.

What accounts for these familiar arrangements? Convention in this genre, certainly, which brings this particular type of architectural work within the

scènes à faire doctrine. “Recall as well that under the definition of an architectural work, “individual standard features” are not protected. 17 U.S.C. § 101.” But the arrangements are also dictated by functionality. The kitchen is near the dining room so that food can easily be moved between the two rooms. The bedrooms aren’t near the front hall because guests don’t venture into the bedrooms.

The functionality of the room arrangements is where the doctrine of merger comes in. Merger arises from § 102(b), which, as we’ve explained, codifies the idea–expression dichotomy and specifies that copyright never extends to an idea, procedure, principle, or concept. Copyright protects only expression; patent law is the proper instrument for protecting functionality. *See Eldred v. Ashcroft*, 537 U.S. 186, 217, 123 S.Ct. 769, 154 L.Ed.2d 683 (2003).

Merger doctrine prevents the use of copyright to protect an idea or procedure. If an idea or procedure can be expressed in only a few ways, it is easy to copyright every form in which the idea can be expressed, indirectly protecting the idea itself. 4 NIMMER ON COPYRIGHT § 13.03[B][3]; *see also Morrissey v. Procter & Gamble Co.*, 379 F.2d 675, 678–79 (1st Cir. 1967). To guard against this kind of overprotection, when an idea can be expressed in only limited ways, courts say that the expression “merges” into the idea and cannot receive copyright protection. *Lexington Homes*, 858 F.3d at 1102. For example, the forms used to implement a particular method of accounting are an expression of the accounting method and cannot be copyrighted. *Baker v. Selden*, 101 U.S. 99, 25 L.Ed. 841 (1879). The same is true for the rules of a sweepstakes competition: because there are a limited number of ways to explain the rules, the expression of the rules receives little, if any, copyright protection. *Morrissey*, 379 F.2d at 678–79.

Merger also applies to the Design Basics home plans. The functional requirements of living spaces dictate that particular rooms be placed close together. And the general concept of the affordable, multipurpose, suburban, single-family home also contributes to the design. This isn’t to say that there is only *one* way to arrange the rooms in this home-design genre. But there are only a limited number of possible floor plans, and by creating more than 2,800 of these plans, Design Basics has attempted to occupy the entire field. We wondered in *Lexington Homes* if “there is any blueprint for a single-family home anywhere in the country that Design Basics could not match to one of

its own designs.” 858 F.3d at 1103. If Design Basics held any more than thin copyright protection in its floor plans, it would own nearly the entire field of suburban, single-family home design.

The McNicholas report reinforces our holding in *Lexington Homes* that the copyright in the Design Basics floor plans is thin. Although McNicholas set out to demonstrate the unique nature of the ten plans at issue here, his report demonstrates just the opposite. As we’ve explained, the report describes each floor plan in generic and often nearly identical language. The report shows that each floor plan uses the same design features to accomplish the same ends.

Accordingly, although Design Basics asks us to revisit our decision in *Lexington Homes*, we see no reason to do so. To the contrary, we reiterate our conclusion that Design Basics holds only thin copyright in its floor plans. *Id.* at 1101–02. And in this particular architectural genre in which copyright protection is thin, proving unlawful appropriation takes more than a substantial similarity between the plaintiff’s work and the defendant’s work. Instead, only a virtually identical plan infringes the plaintiff’s copyrighted plan. *Incredible Techs., Inc. v. Virtual Techs., Inc.*, 400 F.3d 1007, 1013–14 (7th Cir. 2005).

C. Application

We can make short work of applying these principles to this record. Except for the 2461 Shawnee plan, Design Basics has no direct evidence of actual copying. For the remaining nine plans, it must rely on circumstantial proof of actual copying, which requires evidence of both access and probative similarity.

We can safely skip the issue of access. The district judge aptly observed that the Signature plans are dissimilar in material respects from the plans they are alleged to infringe. They have different room dimensions, ceiling heights and styles, and exterior dimensions. Some have a different number of rooms, and the garages are sometimes placed at different angles to the homes. These differences are enough as a matter of law to preclude an inference of actual copying.

For the same reason, even if we assume that actual copying occurred in the case of the 2461 Shawnee floor plan, no reasonable jury could find unlawful appropriation. Signature’s Lot 119 Lake Falls floor plan is not virtually

identical to the 2461 Shawnee. Though both designs depict a one-story ranch with a kitchen, breakfast room, great room, dining room, three bedrooms, and two bathrooms in the same general locations, *see* Appendix, the Signature plan is different from the 2461 Shawnee in some notable ways. It has greater square footage, and the room dimensions are subtly different. The ceilings have different heights, and the two homes have different aspect ratios. The 2461 Shawnee has a two-car garage and its walls are parallel to the home, while the Lot 119 Lake Falls plan features a three-car garage placed at an angle to the rest of the home. Although most of the rooms are located in the same relative positions, some are not: where the 2461 Shawnee plan places a bathroom, the Lot 119 Lake Falls plan has a walk-in closet.

In a field unconstrained by convention and functionality, the similarity of the overall layouts of the two floor plans would be noticeable. But suburban, single-family housing is a field with many standard elements and limited possibilities for creativity, so the Lot 119 Lake Falls plan must be virtually identical to the 2461 Shawnee to infringe Design Basics' thin copyright. Under this standard, Signature's plan is noninfringing as a matter of law.

Finally, we note for completeness that we find no flaw in the district judge's conclusion that Signature's plans are dissimilar enough to preclude liability even under ordinary substantial-similarity analysis. As we explained when discussing probative similarity, each Signature plan features different room dimensions, ceiling styles and heights, and exterior dimensions than the Design Basics plan it is alleged to infringe. The number and placement of rooms is sometimes different, as is the size and (in some cases) the location of the garage. Accordingly, the judge correctly concluded that the Signature plans are noninfringing under conventional substantial-similarity analysis; the plans are certainly not virtually identical to the Design Basics plans they are alleged to infringe. Summary judgment for Signature was proper.

AFFIRMED

Rights, Licensing, Attribution, Disclaimers, and More

The following was written by Eric E. Johnson:

This chapter (Chapter C-5, "Copyright Infringement Analysis") was produced by making changes and additions to the text of Chapter 7,

“Introduction to Copyright Infringement,” of *Introduction To Intellectual Property Cases and Questions Fall 2021 Edition* authored and published by **Jason Rantanen**. © 2021 Jason Rantanen, licensed under the Creative Commons Attribution-Noncommercial 4.0 International License (CC BY-NC 4.0), available at <https://creativecommons.org/licenses/by-nc/4.0/>. That license contains a disclaimer of warranties and a statement of limitation of liability. The original work is available at <http://ssrn.com/abstract=3883500>. A printed version is available on Amazon.

Starting with Professor Rantanen’s chapter, I changed some things and added substantial material. Throughout, I made formatting changes, including to typography, pagination, paragraph styling, heading styles, etc., including replacing double spaces with single spaces. I reformatted text in a table as regular body text. The chapter title is different. I deleted material, indicated by a superscript tilde (~).

I added various things, including the *Design Basics* case, § 501, and the “Prof. EEJ notes on ...” portions. I also added some headers, including “Notes from Prof. Rantanen ...” to mark expository text authored by Professor Rantanen and to highlight the fact that it is his. And I added “U.S. Court of Appeals for the Second Circuit” in the information at the top of the *Nichols* case.

In Professor Rantanen’s original book, the following appeared (paragraph breaks have been omitted): “Copyright © 2021 Jason Rantanen. This work is licensed under a Creative Commons Attribution-Noncommercial 4.0 International License. Contact jason-rantanen@uiowa.edu to request additional permissions. No copyright is claimed to works in the public domain.”

I am very grateful to Jason Rantanen for his generosity in sharing his excellent materials!

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–EEJ

Chapter C-6A: Limits on Copyright Infringement: First Sale

This chapter was put together by Eric E. Johnson using text from Chapter 4.F.1 of *Patterns of Information Law: Intellectual Property Done Right* (version 1.1, August 2017) authored by **James Grimmelmann**. Please see “Rights, Licensing, Attribution, Disclaimers, and More” at the end of this chapter.

Judicial explanation of the first-sale defense

from UMG Recordings, Inc. v. Augusto, 628 F.3d 1175 (9th Cir. 2011)

Notwithstanding its distinctive name, the first sale doctrine applies not only when a copy is first sold, but when a copy is given away or title is otherwise transferred without the accouterments of a sale. The seminal illustration of the principle is found in *Bobbs-Merrill Co. v. Straus*, where a copyright owner unsuccessfully attempted to restrain the resale of a copyrighted book by including in it the following notice: “The price of this book at retail is \$1 net. No dealer is licensed to sell it at a less price, and a sale at less price will be treated as an infringement of the copyright.” The Court noted that the statutory grant to a copyright owner of the “sole right of vending” the work did not continue after the first sale of a given copy. “The purchaser of a book, once sold by authority of the owner of the copyright, may sell it again, although he could not publish a new edition of it.” The attempt to limit resale below a certain price was therefore held invalid.

The rule of *Bobbs-Merrill* remains in full force, enshrined as it is in § 109(a) of the Act: a copyright owner who transfers title in a particular copy to a purchaser or donee cannot prevent resale of that particular copy. We have recognized, however, that not every transfer of possession of a copy transfers title. Particularly with regard to computer software, we have recognized that copyright owners may create licensing arrangements so that users acquire only a license to use the particular copy of software and do not acquire title that permits further transfer or sale of that copy without the permission of the copyright owner.

Prof. EEJ's notes on the first-sale defense

At first glance, the first sale defense seems like a bit of a footnote to copyright law. Something of minor importance. But it would be a different world without it. Imagine what publishers would do if they could put restrictions on what you could do with a copy of a book you legally purchased. The next case provides one illustration.

Case: Doan v. American Book

Doan v. American Book Co.

U.S. Court of Appeals for the Seventh Circuit
105 F. 772 (7th Cir. 1901)

We think the right of repair with respect to a copyrighted book sold, to the extent to which that right is here claimed, may not properly be denied. These books had been in use by school children. Some were written upon and defaced; some were soiled and torn; the covers of some were wholly or partially destroyed, and the binding had become imperfect. To render these books serviceable for use or sale, it became necessary to clean them, to trim the edges of the leaves, and to rebind them. We think that, so far as respects the copyright laws of the United States, no legal right of the appellee was invaded by so doing.

Prof. EEJ's notes on the first-sale defense, part two

Above, I asked you to imagine what publishers would do if they could put restrictions on what you could do with a copy of a book you'd legally purchased. And I suggested it would be a different world if they could do that.

But: Amazon Kindle. And Amazon Prime Video's service allowing you to "buy" a movie. And similar things from other companies. That's increasingly the world we live in – where a "purchase" is really just a notation in a digital register that when a particular request is made, a device you've signed into should be permitted to decrypt and display a stored file, or stream content from a server to your device for viewing and/or listening.

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The following was written by Eric E. Johnson:

This Chapter C-6A, "Limits on Copyright Infringement: First Sale," was put together by Eric E. Johnson mostly by using text from Chapter 4.F.1 of *Patterns of Information Law: Intellectual Property Done Right* (version 1.1, August 2017) authored by **James Grimmelmann**. I did not find a copyright notice in the book, but I believe the correct one is: © 2017 James Grimmelmann. The book is licensed under the Creative Commons Attribution International License 4.0 (CC-BY 4.0) license, available at <https://creativecommons.org/licenses/by/4.0/>. That license contains a disclaimer of warranties and a statement of limitation of liability. The original work is available at <https://james.grimmelmann.net/ipbook/>.

On page 34, Professor Grimmelmann writes: "All of my own contributions to these materials – including any original writing, edits to existing materials, and the selection and arrangement of those materials – are hereby made available for free reuse under the terms of the Creative Commons Attribution 4.0 International license. Credit is not important to me, but I do care that you preserve the license notice if you redistribute these materials."

For the material I took from Professor Grimmelmann's book, I made formatting changes, including to typography, pagination, paragraph styling, etc. For the section I titled "Judicial explanation of the first-sale defense," I used two paragraphs from the text Professor Grimmelmann provided as a case reading for the *UMG Recordings, Inc. v. Augusto* case. And I

used his entire edit of the *Doan* case, although the header and informational text above the case differs.

I am very grateful to James Grimmelmann for his generosity in sharing his excellent materials!

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-EEJ

Chapter C-6B: Limits on Copyright Infringement: Fair Use

This chapter is a re-working by Eric E. Johnson of Chapter 4.F.2 of *Patterns of Information Law: Intellectual Property Done Right* (version 1.1, August 2017) authored by **James Grimmelmann**.

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Statutory law on fair use

17 U.S.C. § 107 – Limitations on exclusive rights: Fair use

Notwithstanding the provisions of sections 106 and 106A, the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and

(4) the effect of the use upon the potential market for or value of the copyrighted work.

The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors.

Prof. James Grimmelmann's fair use checklist

The four fair use factors are a checklist of questions to ask about the facts in a given case, not a majority vote. As you see from the readings, they interrelate, and they are not all of equal importance. I find it helpful to break the factors down into a slightly more detailed checklist:

- Factor one (“purpose and character of the [defendant’s] use”):
 - Is the use for criticism, comment, or another use specifically mentioned in the flush text at the start of section 107?
 - Is the use commercial or noncommercial?
 - Is the use transformative?
- Factor two (“nature of the [plaintiff’s] copyrighted work”):
 - Is the work primarily informational or primarily expressive?
 - Is the work published or unpublished?
- Factor three (“amount and substantiality of the portion used”):
 - How much did the defendant copy quantitatively from the plaintiff’s work?
 - How qualitatively important were the copied portions to the plaintiff’s work?
 - How extensive was the defendant’s copying in light of any proffered justifications?
- Factor four (“effect of the use upon the potential market”):
 - What is the relevant market, and is it one the plaintiff can legitimately claim a right to?
 - Did the plaintiff suffer losses because the defendant’s work substituted for her own, or for some other reason?
- Miscellaneous:
 - Did the defendant give appropriate attribution to the plaintiff’s work as a source?

- Did either party engage in any dishonest or illegal conduct that bears directly on the copying?
- Is there anything else significant in the facts not already accounted for?

Case: Harper & Row v. Nation

Harper & Row Publishers, Inc. v. Nation Enterprises

Supreme Court of the United States
471 U.S. 539 (1985)

In February 1977, shortly after leaving the White House, former President Gerald R. Ford contracted with petitioners Harper & Row and Reader's Digest, to publish his as yet unwritten memoirs. In addition to the right to publish the Ford memoirs in book form, the agreement gave petitioners the exclusive right to license prepublication excerpts, known in the trade as "first serial rights." Two years later, as the memoirs were nearing completion, petitioners negotiated a prepublication licensing agreement with *Time*, a weekly news magazine. *Time* agreed to pay \$25,000, \$12,500 in advance and an additional \$12,500 at publication, in exchange for the right to excerpt 7,500 words from Mr. Ford's account of the Nixon pardon. The issue featuring the excerpts was timed to appear approximately one week before shipment of the full length book version to bookstores. Exclusivity was an important consideration; Harper & Row instituted procedures designed to maintain the confidentiality of the manuscript, and *Time* retained the right to renegotiate the second payment should the material appear in print prior to its release of the excerpts.

Two to three weeks before the *Time* article's scheduled release, an unidentified person secretly brought a copy of the Ford manuscript to Victor Navasky, editor of *The Nation*, a political commentary magazine. Mr. Navasky knew that his possession of the manuscript was not authorized and that the manuscript must be returned quickly to his "source" to avoid discovery. He hastily put together what he believed was "a real hot news story" composed of quotes, paraphrases, and facts drawn exclusively from the manuscript. Mr. Navasky attempted no independent commentary, research or criticism, in part because of the need for speed if he was to "make news" by "publish[ing] in advance of publication of the Ford book." The 2,250-word article, reprinted in

the Appendix to this opinion, appeared on April 3, 1979. As a result of *The Nation*'s article, *Time* canceled its piece and refused to pay the remaining \$12,500.

[Harper & Row sued for copyright infringement.]

The Nation has admitted to lifting verbatim quotes of the author's original language totaling between 300 and 400 words and constituting some 13% of *The Nation* article. In using generous verbatim excerpts of Mr. Ford's unpublished manuscript to lend authenticity to its account of the forthcoming memoirs, *The Nation* effectively arrogated to itself the right of first publication, an important marketable subsidiary right. For the reasons set forth below, we find that this use of the copyrighted manuscript, even stripped to the verbatim quotes conceded by *The Nation* to be copyrightable expression, was not a fair use within the meaning of the Copyright Act.

III

A

Fair use was traditionally defined as "a privilege in others than the owner of the copyright to use the copyrighted material in a reasonable manner without his consent." The statutory formulation of the defense of fair use in the Copyright Act reflects the intent of Congress to codify the common-law doctrine. Section 107 requires a case-by-case determination whether a particular use is fair, and the statute notes four nonexclusive factors to be considered. This approach was intended to restate the pre-existing judicial doctrine of fair use, not to change, narrow, or enlarge it in any way."

As early as 1841, Justice Story gave judicial recognition to the doctrine in a case that concerned the letters of another former President, George Washington.

"[A] reviewer may fairly cite largely from the original work, if his design be really and truly to use the passages for the purposes of fair and reasonable criticism. On the other hand, it is as clear, that if he thus cites the most important parts of the work, with a view, not to criticise, but to supersede the use of the original work, and substitute the review for it, such a use will be deemed in law a piracy."

Folsom v. Marsh, 9 F. Cas. 342 (CC Mass. 1841). As Justice Story’s hypothetical illustrates, the fair use doctrine has always precluded a use that “supersede[s] the use of the original.”

Perhaps because the fair use doctrine was predicated on the author’s implied consent to “reasonable and customary” use when he released his work for public consumption, fair use traditionally was not recognized as a defense to charges of copying from an author’s as yet unpublished works. This absolute rule, however, was tempered in practice by the equitable nature of the fair use doctrine. In a given case, factors such as implied consent through de facto publication on performance or dissemination of a work may tip the balance of equities in favor of prepublication use. But it has never been seriously disputed that “the fact that the plaintiff’s work is unpublished is a factor tending to negate the defense of fair use.” *Id.* Publication of an author’s expression before he has authorized its dissemination seriously infringes the author’s right to decide when and whether it will be made public, a factor not present in fair use of published works.

B

Respondents, however, contend that First Amendment values require a different rule under the circumstances of this case. The thrust of the decision below is that the scope of fair use is undoubtedly wider when the information conveyed relates to matters of high public concern. Respondents advance the substantial public import of the subject matter of the Ford memoirs as grounds for excusing a use that would ordinarily not pass muster as a fair use – the piracy of verbatim quotations for the purpose of “scooping” the authorized first serialization. Respondents explain their copying of Mr. Ford’s expression as essential to reporting the news story it claims the book itself represents. In respondents’ view, not only the facts contained in Mr. Ford’s memoirs, but “the precise manner in which [he] expressed himself [were] as newsworthy as what he had to say.” Respondents argue that the public’s interest in learning this news as fast as possible outweighs the right of the author to control its first publication.

Respondents’ theory, however, would expand fair use to effectively destroy any expectation of copyright protection in the work of a public figure. Absent such protection, there would be little incentive to create or profit in financing such memoirs, and the public would be denied an important source

of significant historical information. The promise of copyright would be an empty one if it could be avoided merely by dubbing the infringement a fair use “news report” of the book.

Nor do respondents assert any actual necessity for circumventing the copyright scheme with respect to the types of works and users at issue here. Where an author and publisher have invested extensive resources in creating an original work and are poised to release it to the public, no legitimate aim is served by pre-empting the right of first publication. The fact that the words the author has chosen to clothe his narrative may of themselves be “newsworthy” is not an independent justification for unauthorized copying of the author’s expression prior to publication.

IV

Whether *The Nation* article constitutes fair use under § 107 must be reviewed in light of the principles discussed above. The factors enumerated in the section are not meant to be exclusive: Since the doctrine is an equitable rule of reason, no generally applicable definition is possible, and each case raising the question must be decided on its own facts. The four factors identified by Congress as especially relevant in determining whether the use was fair are: (1) the purpose and character of the use; (2) the nature of the copyrighted work; (3) the substantiality of the portion used in relation to the copyrighted work as a whole; (4) the effect on the potential market for or value of the copyrighted work. We address each one separately.

Purpose of the Use. The Second Circuit correctly identified news reporting as the general purpose of *The Nation*’s use. News reporting is one of the examples enumerated in § 107 to give some idea of the sort of activities the courts might regard as fair use under the circumstances. This listing was not intended to be exhaustive, or to single out any particular use as presumptively a “fair” use. The drafters resisted pressures from special interest groups to create presumptive categories of fair use, but structured the provision as an affirmative defense requiring a case-by-case analysis. The fact that an article arguably is “news” and therefore a productive use is simply one factor in a fair use analysis.

We agree with the Second Circuit that the trial court erred in fixing on whether the information contained in the memoirs was actually new to the public. Courts should be chary of deciding what is and what is not news. *The*

Nation has every right to seek to be the first to publish information. But *The Nation* went beyond simply reporting uncopyrightable information and actively sought to exploit the headline value of its infringement, making a “news event” out of its unauthorized first publication of a noted figure’s copyrighted expression.

The fact that a publication was commercial as opposed to non-profit is a separate factor that tends to weigh against a finding of fair use. Every commercial use of copyrighted material is presumptively an unfair exploitation of the monopoly privilege that belongs to the owner of the copyright. In arguing that the purpose of news reporting is not purely commercial, *The Nation* misses the point entirely. The crux of the profit/nonprofit distinction is not whether the sole motive of the use is monetary gain but whether the user stands to profit from exploitation of the copyrighted material without paying the customary price.

In evaluating character and purpose we cannot ignore *The Nation*’s stated purpose of scooping the forthcoming hard-cover and *Time* abstracts. *The Nation*’s use had not merely the incidental effect but the intended purpose of supplanting the copyright holder’s commercially valuable right of first publication. Also relevant to the “character” of the use is the propriety of the defendant’s conduct. “Fair use presupposes good faith and fair dealing. The trial court found that *The Nation* knowingly exploited a purloined manuscript.

Unlike the typical claim of fair use, *The Nation* cannot offer up even the fiction of consent as justification. Like its competitor newsweekly, it was free to bid for the right of abstracting excerpts from “A Time to Heal.” Fair use “distinguishes between a true scholar and a chiseler who infringes a work for personal profit.” *Wainwright Securities Inc. v. Wall Street Transcript Corp.* 558 F. 2d 91 (2d Cir. 1977).

Nature of the Copyrighted work. Second, the Act directs attention to the nature of the copyrighted work. “A Time to Heal” may be characterized as an unpublished historical narrative or autobiography. The law generally recognizes a greater need to disseminate factual works than works of fiction or fantasy. See Gorman, *Fact or Fancy? The Implications for Copyright*, 29 J. Copyright Soc. 560 (1982):

“Even within the field of fact works, there are gradations as to the relative proportion of fact and fancy. One may move from sparsely embellished maps and directories to elegantly written biography. The extent to which one must permit expressive language to be copied, in order to assure dissemination of the underlying facts, will thus vary from case to case.”

Some of the briefer quotes from the memoirs are arguably necessary adequately to convey the facts; for example, Mr. Ford’s characterization of the White House tapes as the “smoking gun” is perhaps so integral to the idea expressed as to be inseparable from it. But *The Nation* did not stop at isolated phrases and instead excerpted subjective descriptions and portraits of public figures whose power lies in the author’s individualized expression. Such use, focusing on the most expressive elements of the work, exceeds that necessary to disseminate the facts.

The fact that a work is unpublished is a critical element of its “nature.” Our prior discussion establishes that the scope of fair use is narrower with respect to unpublished works. While even substantial quotations might qualify as fair use in a review of a published work or a news account of a speech that had been delivered to the public or disseminated to the press, see House Report, at 65, the author’s right to control the first public appearance of his expression weighs against such use of the work before its release. The right of first publication encompasses not only the choice whether to publish at all, but also the choices of when, where, and in what form first to publish a work.

In the case of Mr. Ford’s manuscript, the copyright holders’ interest in confidentiality is irrefutable; the copyright holders had entered into a contractual undertaking to “keep the manuscript confidential” and required that all those to whom the manuscript was shown also “sign an agreement to keep the manuscript confidential.” While the copyright holders’ contract with *Time* required *Time* to submit its proposed article seven days before publication, *The Nation*’s clandestine publication afforded no such

opportunity for creative or quality control. It was hastily patched together and contained “a number of inaccuracies.” App. 300b-300c (testimony of Victor Navasky). A use that so clearly infringes the copyright holder’s interests in confidentiality and creative control is difficult to characterize as “fair.”

Amount and Substantiality of the Portion Used. Next, the Act directs us to examine the amount and substantiality of the portion used in relation to the copyrighted work as a whole. In absolute terms, the words actually quoted were an insubstantial portion of “A Time to Heal.” The District Court, however, found that “[T]he Nation took what was essentially the heart of the book.” We believe the Court of Appeals erred in overruling the District Judge’s evaluation of the qualitative nature of the taking. A *Time* editor described the chapters on the pardon as “the most interesting and moving parts of the entire manuscript.” The portions actually quoted were selected by Mr. Navasky as among the most powerful passages in those chapters. He testified that he used verbatim excerpts because simply reciting the information could not adequately convey the “absolute certainty with which [Ford] expressed himself”; or show that “this comes from President Ford,”; or carry the “definitive quality” of the original. In short, he quoted these passages precisely because they qualitatively embodied Ford’s distinctive expression.

As the statutory language indicates, a taking may not be excused merely because it is insubstantial with respect to the infringing work. As Judge Learned Hand cogently remarked, “no plagiarist can excuse the wrong by showing how much of his work he did not pirate.” *Sheldon*. Conversely, the fact that a substantial portion of the infringing work was copied verbatim is evidence of the qualitative value of the copied material, both to the originator and to the plagiarist who seeks to profit from marketing someone else’s copyrighted expression.

Stripped to the verbatim quotes, the direct takings from the unpublished manuscript constitute at least 13% of the infringing article. *The Nation* article is structured around the quoted excerpts which serve as its dramatic focal points. In view of the expressive value of the excerpts and their key role in the infringing work, we cannot agree with the Second Circuit that the “magazine took a meager, indeed an infinitesimal amount of Ford’s original language.”

Effect on the Market. Finally, the Act focuses on “the effect of the use upon the potential market for or value of the copyrighted work.” This last

factor is undoubtedly the single most important element of fair use. “Fair use, when properly applied, is limited to copying by others which does not materially impair the marketability of the work which is copied.” The trial court found not merely a potential but an actual effect on the market. *Time’s* cancellation of its projected serialization and its refusal to pay the \$12,500 were the direct effect of the infringement. The Court of Appeals rejected this factfinding as clearly erroneous, noting that the record did not establish a causal relation between *Time’s* nonperformance and respondents’ unauthorized publication of Mr. Ford’s expression as opposed to the facts taken from the memoirs. We disagree. Rarely will a case of copyright infringement present such clear-cut evidence of actual damage. Petitioners assured *Time* that there would be no other authorized publication of any portion of the unpublished manuscript prior to April 23, 1979. Any publication of material from chapters 1 and 3 would permit *Time* to renegotiate its final payment. *Time* cited *The Nation’s* article, which contained verbatim quotes from the unpublished manuscript, as a reason for its nonperformance.

More important, to negate fair use one need only show that if the challenged use should become widespread, it would adversely affect the potential market for the copyrighted work. This inquiry must take account not only of harm to the original but also of harm to the market for derivative works. “If the defendant’s work adversely affects the value of any of the rights in the copyrighted work (in this case the adaptation [and serialization] right) the use is not fair.” *Nimmer* §13.05[B].

The Nation conceded that its verbatim copying of some 300 words of direct quotation from the Ford manuscript would constitute an infringement unless excused as a fair use. Because we find that *The Nation’s* use of these verbatim excerpts from the unpublished manuscript was not a fair use, the judgment of the Court of Appeals is reversed, and the case is remanded for further proceedings consistent with this opinion.

Case: Campbell v. Acuff-Rose

Campbell v. Acuff-Rose Music, Inc.

Supreme Court of the United States
510 U.S. 569 (1994)

In 1964, Roy Orbison and William Dees wrote a rock ballad called “Oh, Pretty Woman” and assigned their rights in it to respondent Acuff-Rose Music, Inc. Petitioners Luther R. Campbell, Christopher Wongwon, Mark Ross, and David Hobbs are collectively known as 2 Live Crew, a popular rap music group. In 1989, Campbell wrote a song entitled “Pretty Woman,” which he later described in an affidavit as intended, “through comical lyrics, to satirize the original work.” On July 5, 1989, 2 Live Crew’s manager informed Acuff-Rose that 2 Live Crew had written a parody of “Oh, Pretty Woman,” that they would afford all credit for ownership and authorship of the original song to Acuff-Rose, Dees, and Orbison, and that they were willing to pay a fee for the use they wished to make of it. Enclosed with the letter were a copy of the lyrics and a recording of 2 Live Crew’s song. Acuff-Rose’s agent refused permission, stating that “I am aware of the success enjoyed by ‘The 2 Live Crews’, but I must inform you that we cannot permit the use of a parody of ‘Oh, Pretty Woman.’” Nonetheless, in June or July 1989, 2 Live Crew released records, cassette tapes, and compact discs of “Pretty Woman” in a collection of songs entitled “As Clean As They Wanna Be.” The albums and compact discs identify the authors of “Pretty Woman” as Orbison and Dees and its publisher as Acuff-Rose.

Almost a year later, after nearly a quarter of a million copies of the recording had been sold, Acuff-Rose sued 2 Live Crew and its record company, Luke Skywalker Records, for copyright infringement.

The first factor in a fair use enquiry is “the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes.” § 107(1). The central purpose of this investigation is to see, in Justice Story’s words, whether the new work merely “supersede[s] the objects” of the original creation, *Folsom*, or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message; it asks, in other words, whether and to what extent the new work is “transformative.” Pierre Leval, *Toward a Fair Use Standard*. Although such transformative use is not absolutely necessary for a finding of

fair use,¹¹ the goal of copyright, to promote science and the arts, is generally furthered by the creation of transformative works. Such works thus lie at the heart of the fair use doctrine's guarantee of breathing space within the confines of copyright, and the more transformative the new work, the less will be the significance of other factors, like commercialism, that may weigh against a finding of fair use.

[Footnote 11:]⁷ The obvious statutory exception to this focus on transformative uses is the straight reproduction of multiple copies for classroom distribution.⁷

Suffice it to say now that parody has an obvious claim to transformative value, as Acuff-Rose itself does not deny. Like less ostensibly humorous forms of criticism, it can provide social benefit, by shedding light on an earlier work, and, in the process, creating a new one. We thus line up with the courts that have held that parody, like other comment or criticism, may claim fair use under § 107. *See, e.g., Fisher v. Dees*, 794 F.2d 432 (9th Cir. 1986) (“When Sonny Sniffs Glue,” a parody of “When Sunny Gets Blue,” is fair use); *Elsmere Music, Inc. v. National Broadcasting Co.* 482 F.Supp. 741 (S.D.N.Y. 1980) (“I Love Sodom,” a “Saturday Night Live” television parody of “I Love New York,” is fair use). The germ of parody lies in the definition of the Greek *parodeia*, as “a song sung alongside another.” Modern dictionaries accordingly describe a parody as a “literary or artistic work that imitates the characteristic style of an author or a work for comic effect or ridicule,” or as a “composition in prose or verse in which the characteristic turns of thought and phrase in an author or class of authors are imitated in such a way as to make them appear ridiculous.” For the purposes of copyright law, the nub of the definitions, and the heart of any parodist’s claim to quote from existing material, is the use of some elements of a prior author’s composition to create a new one that, at least in part, comments on that author’s works. If, on the contrary, the commentary has no critical bearing on the substance or style of the original composition, which the alleged infringer merely uses to get attention or to avoid the drudgery in working up something fresh, the claim to fairness in borrowing from another’s work diminishes accordingly (if it does not vanish), and other factors, like the extent of its commerciality, loom larger. Parody needs to mimic an original to make its point, and so has some claim to use the creation of its victim’s (or collective victims’) imagination, whereas satire can stand on its own two feet and so requires justification for the very act of borrowing.

The fact that parody can claim legitimacy for some appropriation does not, of course, tell either parodist or judge much about where to draw the line.

We have less difficulty in finding that critical element in 2 Live Crew's song than the Court of Appeals did, although having found it we will not take the further step of evaluating its quality. The threshold question when fair use is raised in defense of parody is whether a parodic character may reasonably be perceived. Whether, going beyond that, parody is in good taste or bad does not and should not matter to fair use. As Justice Holmes explained, "It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of [a work], outside of the narrowest and most obvious limits. At the one extreme some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke." *Bleistein*; cf. *Yankee Publishing Inc. v. News America Publishing, Inc.* 809 F. Supp. 267 (S.D.N.Y. 1992) (Leval, J.) ("First Amendment protections do not apply only to those who speak clearly, whose jokes are funny, and whose parodies succeed").

While we might not assign a high rank to the parodic element here, we think it fair to say that 2 Live Crew's song reasonably could be perceived as commenting on the original or criticizing it, to some degree. 2 Live Crew juxtaposes the romantic musings of a man whose fantasy comes true, with degrading taunts, a bawdy demand for sex, and a sigh of relief from paternal responsibility. The later words can be taken as a comment on the naivete of the original of an earlier day, as a rejection of its sentiment that ignores the ugliness of street life and the debasement that it signifies. It is this jolter of reference and ridicule that marks off the author's choice of parody from the other types of comment and criticism that traditionally have had a claim to fair use protection as transformative works.¹⁸

[Footnote 18:]¹⁸ Finally, regardless of the weight one might place on the alleged infringer's state of mind, compare *Harper & Row* (fair use presupposes good faith and fair dealing) (quotation marks omitted), with *Folsom* (good faith does not bar a finding of infringement); Leval, *Toward a Fair Use Standard* (good faith irrelevant to fair use analysis), we reject Acuff-Rose's argument that 2 Live Crew's request for permission to use the original should be weighed against a finding of fair use. Even if good faith were central to fair use, 2 Live Crew's actions do not necessarily suggest that they believed their

version was not fair use; the offer may simply have been made in a good-faith effort to avoid this litigation. If the use is otherwise fair, then no permission need be sought or granted. Thus, being denied permission to use a work does not weigh against a finding of fair use.⁷

APPENDIX A TO OPINION OF THE COURT

“Oh, Pretty Woman” by Roy Orbison and William Dees

Pretty Woman, walking down the street,
Pretty Woman, the kind I like to meet,
Pretty Woman, I don't believe you, you're not the truth,
No one could look as good as you Mercy
Pretty Woman, won't you pardon me,
Pretty Woman, I couldn't help but see,
Pretty Woman, that you look lovely as can be Are you lonely just like me?
Pretty Woman, stop a while,
Pretty Woman, talk a while,
Pretty Woman give your smile to me
Pretty Woman, yeah, yeah, yeah
Pretty Woman, look my way,
Pretty Woman, say you'll stay with me
'Cause I need you, I'll treat you right
Come to me baby, Be mine tonight
Pretty Woman, don't walk on by,
Pretty Woman, don't make me cry,
Pretty Woman, don't walk away,
Hey, O. K.
If that's the way it must be, O. K.
I guess I'll go on home, it's late
There'll be tomorrow night, but wait!
What do I see
Is she walking back to me?
Yeah, she's walking back to me!
Oh, Pretty Woman.

APPENDIX B TO OPINION OF THE COURT

“Pretty Woman” as Recorded by 2 Live Crew

Pretty woman walkin' down the street
Pretty woman girl you look so sweet
Pretty woman you bring me down to that knee
Pretty woman you make me wanna beg please
Oh, pretty woman
Big hairy woman you need to shave that stuff
Big hairy woman you know I bet it's tough
Big hairy woman all that hair it ain't legit
'Cause you look like 'Cousin It'
Big hairy woman
Bald headed woman girl your hair won't grow
Bald headed woman you got a teeny weeny afro
Bald headed woman you know your hair could look nice
Bald headed woman first you got to roll it with rice
Bald headed woman here, let me get this hunk of biz for ya
Ya know what I'm saying you look better than rice a roni
Oh bald headed woman
Big hairy woman come on in
And don't forget your bald headed friend
Hey pretty woman let the boys Jump in
Two timin' woman girl you know you ain't right
Two timin' woman you's out with my boy last night
Two timin' woman that takes a load off my mind
Two timin' woman now I know the baby ain't mine
Oh, two timin' woman
Oh pretty woman

Rights, Licensing, Attribution, Disclaimers, and More

The following was written by Eric E. Johnson:

This Chapter C-6B, “Limits on Copyright Infringement: Fair Use,” is a re-working, with various changes, of a portion of Chapter 4.F.2., beginning on page 364 of *Patterns of Information Law: Intellectual Property Done Right* (version 1.1, August 2017) authored by **James Grimmelmann**. I did not find a copyright notice in the book, but I believe the correct one is: © 2017 James Grimmelmann. The book is licensed under the Creative Commons Attribution International License 4.0 (CC-BY 4.0) license, available at <https://creativecommons.org/licenses/by/4.0/>. That license contains a disclaimer of warranties and a statement of limitation of liability. The original work is available at <https://james.grimmelmann.net/ipbook/>.

On page 34, Professor Grimmelmann writes: “All of my own contributions to these materials – including any original writing, edits to existing materials, and the selection and arrangement of those materials – are hereby made available for free reuse under the terms of the Creative Commons Attribution 4.0 International license. Credit is not important to me, but I do care that you preserve the license notice if you redistribute these materials.”

I made various changes, additions, and deletions to Professor Grimmelmann’s text. The chapter title is mine. The typography and formatting is changed. I changed the wording of a header, added headers, and added material to make this chapter more like others in the anthology of which I’ve made this a part.

In particular, I added “Prof. James Grimmelmann’s” to the header “Prof. James Grimmelmann’s fair use checklist” to highlight that that content was his.

For instance, I added “Supreme Court of the United States” under the caption of cases, where applicable. Professor Grimmelmann put a lot of information in the side margins in his book—I either omitted that text or worked it into the body text, occasionally doing things with punctuation to make that work. Hyphenated word breaks across lines have been repaired. Quotation marks may have been re-set. (In particular, when I was moving text from the PDF of the book, some of the curly quotes ended up backwards. I’m not sure if that was an artifact of the original, but I fixed those.). I added “APPENDIX A” and “APPENDIX B” to the edit of the Campbell case. (My direct source for the appendix text was Jason Rantanen’s casebook.).

Finally, I omitted all the material from Chapter 4.F.2 after the Campbell opinion.

I am very grateful to James Grimmelmann for his generosity in sharing his excellent materials!

My own separately copyrightable contributions in this chapter are minimal, and any copyright is thin, but to the extent I have such a copyright interest, it is: © 2022 Eric E. Johnson. I license this chapter and its separately copyrightable contributions under the Creative Commons Attribution NonCommercial ShareAlike 4.0 International License (CC BY-NC-SA 4.0), available at <https://creativecommons.org/licenses/by-nc-sa/4.0/legalcode>. Attribution should be to Eric E. Johnson, with a link to <http://ericejohnson.com/ipsurveyor/>. (Note that my choice to use the non-commercial restriction is to keep this chapter's licensing consistent with other chapters in the broader anthology.)

-EEJ

Chapter C-7: Copyright and Music

This chapter was assembled by Eric E. Johnson from public domain sources and some text from *Patterns of Information Law: Intellectual Property Done Right* (version 1.1, August 2017) authored by **James Grimmelmann**.

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Some key statutory law on on compositions and sound recordings

from 17 U.S.C. § 101 – Definitions

To “perform” a work means to recite, render, play, dance, or act it, either directly or by means of any device or process or, in the case of a motion picture or other audiovisual work, to show its images in any sequence or to make the sounds accompanying it audible.

A “performing rights society” is an association, corporation, or other entity that licenses the public performance of nondramatic musical works on behalf of copyright owners of such works, such as the American Society of Composers, Authors and Publishers (ASCAP), Broadcast Music, Inc. (BMI), and SESAC, Inc.

“Phonorecords” are material objects in which sounds, other than those accompanying a motion picture or other audiovisual work, are fixed by any method now known or later developed, and from which the sounds can be perceived, reproduced, or otherwise communicated, either directly or with the

aid of a machine or device. The term “phonorecords” includes the material object in which the sounds are first fixed.~

To perform or display a work “publicly” means—

(1) to perform or display it at a place open to the public or at any place where a substantial number of persons outside of a normal circle of a family and its social acquaintances is gathered; or

(2) to transmit or otherwise communicate a performance or display of the work to a place specified by clause (1) or to the public, by means of any device or process, whether the members of the public capable of receiving the performance or display receive it in the same place or in separate places and at the same time or at different times.~

“Sound recordings” are works that result from the fixation of a series of musical, spoken, or other sounds, but not including the sounds accompanying a motion picture or other audiovisual work, regardless of the nature of the material objects, such as disks, tapes, or other phonorecords, in which they are embodied.

17 U.S.C. § 106 – Exclusive rights in copyrighted works

Subject to sections 107 through 122, the owner of copyright under this title has the exclusive rights to do and to authorize any of the following:

(1) to reproduce the copyrighted work in copies or phonorecords;

(2) to prepare derivative works based upon the copyrighted work;

(3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending; (4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly;

(5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and

(6) in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.

17 U.S.C. § 114 – Scope of exclusive rights in sound recordings

(a) The exclusive rights of the owner of copyright in a sound recording are limited to the rights specified by clauses (1), (2), (3) and (6) of section 106, and do not include any right of performance under section 106(4).

(b) The exclusive right of the owner of copyright in a sound recording under clause (1) of section 106 is limited to the right to duplicate the sound recording in the form of phonorecords or copies that directly or indirectly recapture the actual sounds fixed in the recording. The exclusive right of the owner of copyright in a sound recording under clause (2) of section 106 is limited to the right to prepare a derivative work in which the actual sounds fixed in the sound recording are rearranged, remixed, or otherwise altered in sequence or quality. The exclusive rights of the owner of copyright in a sound recording under clauses (1) and (2) of section 106 do not extend to the making or duplication of another sound recording that consists entirely of an independent fixation of other sounds, even though such sounds imitate or simulate those in the copyrighted sound recording. The exclusive rights of the owner of copyright in a sound recording under clauses (1), (2), and (3) of section 106 do not apply to sound recordings included in educational television and radio programs (as defined in section 397 of title 47) distributed or transmitted by or through public broadcasting entities (as defined by section 118(f)): Provided, That copies or phonorecords of said programs are not commercially distributed by or through public broadcasting entities to the general public.

(c) This section does not limit or impair the exclusive right to perform publicly, by means of a phonorecord, any of the works specified by section 106(4).

(d) Limitations on Exclusive Right.—Notwithstanding the provisions of section 106(6)— *[Here the statute begins to recite some extremely detailed provisions designed to allow various kinds of services to continue to function legally after the introduction of the public performance right for sound recordings, which was a new exclusive right added to copyright law with the addition of § 106(6) in the mid-1990s. (That is to say, previously, there had been no public performance right for sound recordings.) The complicated provisions of § 114(d)–(j) concern things such as terrestrial broadcast radio and television stations, interactive digital streaming services, satellite radio, cable systems*

retransmitting broadcast signals, transmissions within business establishments, and more. And there are statutory licensing provisions and procedures for setting royalty rates so that content owners can get paid yet can't threaten to shut down music streaming services, broadcasters, satellite radio, cable systems, and other businesses. –EEJ]

Copyright Office on copyright and music

from Circular 56A: Copyright Registration of Musical Compositions and Sound Recordings, revised 03/2021

Sound recordings and musical compositions are considered two separate works for copyright purposes. Even though a sound recording is a derivative work of the underlying musical composition, a copyright in a sound recording is not the same as, or a substitute for, copyright in the underlying musical composition. The chart that follows demonstrates the differences between these two types of works.

	<i>Musical Compositions</i>	<i>Sound Recordings</i>
<i>What is it?</i>	Music (melody, rhythm, and/ or harmony expressed in a system of musical notation) and accompanying words (lyrics)	Fixation of a series of sounds (e.g., a particular performance)
<i>Who is the author?</i>	Composers Lyricists Songwriters	Performers Producers Sound Engineers
<i>How is it fixed?</i>	Copy (sheet music, either print or digital such as pdf) Phonorecord (mp3, CD, LP)	Phonorecord (mp3, CD, LP)
<i>Does the owner have the exclusive right to...</i>	<i>Musical Compositions</i>	<i>Sound Recordings</i>
<i>reproduce the work?</i>	Yes	Yes
<i>prepare derivative works?</i>	Yes	Yes

<i>distribute the copies or phonorecords of the work to the public by sale or other transfer of ownership, or by rental, lease, or lending?</i>	Yes	Yes
<i>perform the work publicly?</i>	Yes	Only by means of a digital audio transmission
<i>display the work publicly?</i>	Yes	No

A registration for a musical composition covers the music and lyrics (if any) embodied in that composition, but it does not cover a recorded performance of that composition. Likewise, a registration for a sound recording of a performance does not cover the underlying musical composition. For example, the composition “Respect” and a recording of Aretha Franklin singing “Respect” are two distinct works. The composition itself (i.e., the music and lyrics) is a musical composition, and a recording of an artist performing that composition is a sound recording.

Determining Whether a Musical Composition and a Sound Recording Can Be Registered with One Application

Since a musical composition and a sound recording are distinct works, separate registration applications generally should be submitted for each work. However, you may use one standard application to register a sound recording and an underlying musical composition when (1) the musical composition and sound recording are embodied in the same phonorecord and (2) the claimant for both the musical composition and sound recording are the same.

Examples

- When an artist performs and records a composition owned by someone else, the artist or artist’s label (if appropriate) would submit an application for the recording only. For specific guidance, see Copyright Registration of Sound Recordings (Circular 56).
- When a songwriter creates a composition that someone else records, the songwriter or songwriter’s publisher (if appropriate) would submit an application for the musical composition only. For specific guidance, see Copyright Registration of Musical Compositions (Circular 50).

- When a songwriter performs and records the songwriter's own composition, the songwriter may submit one application for both the composition and recording.
- When a record company owns both a composition and a recording of that composition, it may submit one application for both the composition and recording.
- When a record company owns both a composition and a recording of that composition, and distributes the works to the public as both sheet music and an album at the time of registration, it should submit two separate applications, with a sheet music deposit for the music composition and a recording deposit for the sound recording.~

Case: Newton v. Diamond

Newton v. Diamond

U.S. Court of Appeals for the Ninth Circuit
388 F.3d 1189 (9th Cir. 2004)

The plaintiff and appellant in this case, James W. Newton, is an accomplished avant-garde jazz flutist and composer. In 1978, he composed the song "Choir," a piece for flute and voice intended to incorporate elements of African-American gospel music, Japanese ceremonial court music, traditional African music, and classical music, among others. According to Newton, the song was inspired by his earliest memory of music, watching four women singing in a church in rural Arkansas. In 1981, Newton performed and recorded "Choir" and licensed all rights in the sound recording to ECM Records for \$5,000. The license covered only the sound recording, and it is undisputed that Newton retained all rights to the composition of "Choir." Sound recordings and their underlying compositions are separate works with their own distinct copyrights.

The defendants and appellees include the members of the rap and hip-hop group Beastie Boys, and their business associates. In 1992, Beastie Boys obtained a license from ECM Records to use portions of the sound recording of "Choir" in various renditions of their song "Pass the Mic" in exchange for a one-time fee of \$1,000. Beastie Boys did not obtain a license from Newton to use the underlying composition.

Pursuant to their license from ECM Records, Beastie Boys digitally sampled the opening six seconds of Newton's sound recording of "Choir." Beastie Boys repeated or "looped" this six-second sample as a background element throughout "Pass the Mic," so that it appears over forty times in various renditions of the song.

The portion of the composition at issue consists of three notes, C—D flat—C, sung over a background C note played on the flute. The score to "Choir" also indicates that the entire song should be played in a "largo/senza-misura" tempo, meaning "slowly/without-measure."

Because the defendants were authorized to use the sound recording, our inquiry is confined to whether the unauthorized use of the composition itself was substantial enough to sustain an infringement claim. Therefore, we may consider only Beastie Boys' appropriation of the song's compositional elements and must remove from consideration all the elements unique to Newton's performance. Stated another way, we must "filter out" the licensed elements of the sound recording to get down to the unlicensed elements of the composition, as the composition is the sole basis for Newton's infringement claim. In filtering out the unique performance elements from consideration, and separating them from those found in the composition, we find substantial assistance in the testimony of Newton's own experts, [who] reveal the extent to which the sound recording of "Choir" is the product of Newton's highly developed performance techniques, rather than the result of a generic rendition of the composition. As a general matter, according to Newton's expert Dr. Christopher Dobrian, "the contribution of the performer is often so great that s/he in fact provides as much musical content as the composer." This is particularly true with works like "Choir," given the improvisational nature of jazz performance and the minimal scoring of the composition. Indeed, as Newton's expert Dr. Oliver Wilson explained:

The copyrighted score of "Choir", as is the custom in scores written in the jazz tradition, does not contain indications for all of the musical subtleties that it is assumed the performer-composer of the work will make in the work's performance. The function of the score is more mnemonic in intention than prescriptive.

And it is clear that Newton goes beyond the score in his performance. For example, Dr. Dobrian declared that "Mr. Newton blows and sings in such a

way as to emphasize the upper partials of the flute's complex harmonic tone, although such a modification of tone color is not explicitly requested in the score." Dr. Dobrian also concludes that Newton "uses breath control to modify the timbre of the sustained flute note rather extremely" and "uses portamento to glide expressively from one pitch to another in the vocal part." Dr. Dobrian concedes that these elements do not appear in the score, and that they are part of Newton's performance of the piece.

A crucial problem with the testimony of Newton's experts is that they continually refer to the "sound" produced by the "Newton technique." A sound is protected by copyright law only when it is "fixed in a tangible medium." 17 U.S.C. § 102(a). Here, the only time any sound was fixed in a tangible medium was when a particular performance was recorded. Newton's copyright extends only to the elements that he fixed in a tangible medium – those that he wrote on the score. Thus, regardless of whether the average audience might recognize the "Newton technique" at work in the sampled sound recording, those performance elements are beyond consideration in Newton's claim for infringement of his copyright in the underlying composition.

On the undisputed facts of this record, no reasonable juror could find the sampled portion of the composition to be a quantitatively or qualitatively significant portion of the composition as a whole. Quantitatively, the three-note sequence appears only once in Newton's composition. When played, the segment lasts six seconds and is roughly two percent of the four-and-a-half-minute "Choir" sound recording licensed by Beastie Boys. Qualitatively, this section of the composition is no more significant than any other section. Indeed, with the exception of two notes, the entirety of the scored portions of "Choir" consist of notes separated by whole and half-steps from their neighbors and is played with the same technique of singing and playing the flute simultaneously; the remainder of the composition calls for sections of improvisation that range between 90 and 180 seconds in length.

On the undisputed facts of this case, we conclude that an average audience would not discern Newton's hand as a composer, apart from his talent as a performer, from Beastie Boys' use of the sample. The copying was not significant enough to constitute infringement.

Commentary from Prof. Grimmelmann about *Newton v. Diamond*:

The court seems to be either assuming or asserting that Newton’s *musical work* copyright is coextensive with what is in the *written score*. Is that right? Note that musical works can be fixed in sheet music, in phonorecords, or as part of an audiovisual work (e.g. a movie), and the Copyright Office will allow any of these to be used as a deposit copy.⁷ Would Newton have been better off never writing out sheet music for “Choir” at all?

Copyright Office on compulsory licenses to record cover versions

from Circular 73A: Compulsory License for Making and Distributing Phonorecords Other Than Digital Phonorecord Deliveries, revised 09/2019

[Synopsis/sidebar:]

Copyright law provides a compulsory license for making and distributing phonorecords of certain nondramatic musical works. This circular addresses the compulsory license for phonorecords other than digital phonorecord deliveries (DPDs).

It covers:

- When a compulsory license can be used
- Activities covered by the compulsory license
- How to obtain a compulsory license
- When royalties must be paid

For information on the compulsory license for DPDs, see *Compulsory License for Making and Distributing Digital Phonorecord Deliveries and Limitations on Liability Prior to the License Availability Date, January 21, 2021 (Circular 73B)*.

[Main text:]

Under section 115 of the Copyright Act, an individual or entity, subject to certain terms and conditions, may make and distribute “non-DPD phonorecords”— phonorecords of nondramatic musical works made by means other than digital phonorecord deliveries—if the nondramatic musical works have been distributed as phonorecords to the public in the United States

under the authority of the copyright owner. As discussed below, this compulsory license includes the right to authorize others to engage in the making and distribution of phonorecords.

NOTE: A nondramatic musical work is an original work of authorship consisting of music—the succession of pitches and rhythm—and any accompanying lyrics not created for use in a motion picture or dramatic work.

On October 11, 2018, the Orrin G. Hatch–Bob Goodlatte Music Modernization Act updated section 115 to establish a new blanket license for **digital** music providers to engage in specific covered activities, namely, permanent downloads, limited downloads, and interactive streaming.

The new law, however, maintains the process for obtaining a compulsory license for non-DPD phonorecords, which still operates on a per-work, song-by-song basis.

This circular provides an introduction to legal concepts and Office practice related to the compulsory license for distributing non-DPD phonorecords. For full information regarding the procedures that must be followed to operate under a compulsory license, visit the Office’s website or refer to sections 201.18 and 210 of Office regulations.

What Is a Phonorecord?

A phonorecord is a material object in which sounds are fixed by any method now known or later developed and from which the sounds can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Examples include a cassette tape, a vinyl disc, or a compact disc. Digital phonorecords are types of phonorecords. A phonorecord does not include sounds accompanying a motion picture or other audiovisual work.

What Is a Digital Phonorecord Delivery?

A digital phonorecord delivery (DPD) is the individual digital transmission of a sound recording resulting in a specifically identifiable reproduction by or for a recipient, regardless of whether the digital transmission is also a public performance of the sound recording or any underlying non-dramatic musical work. The reproduction must be sufficiently permanent or stable to permit to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration. The

reproduction may be permanent or available to the recipient for a limited period of time or for a specified number of performances. A DPD includes all phonorecords that are made for the purpose of making the delivery. Permanent downloads, limited downloads, and interactive streams are DPDs.

The compulsory license for making and distributing DPDs is addressed further in Compulsory License for Making and Distributing Digital Phonorecord Deliveries and Limitations on Liability Prior to the License Availability Date, January 21, 2021 (Circular 73B).

Does a Compulsory License Cover Making and Reproducing a Sound Recording?

No. Section 115 does not cover sound recordings. Rather, it covers the reproduction and distribution of nondramatic musical works. You can use the musical work to make your own sound recording.

A musical work and a sound recording are two separate works for copyright purposes. The author of a musical work is generally the composer and any lyricist. A sound recording, on the other hand, is the fixation of a series of musical spoken, or other sounds, often of a musical work. The author(s) of a sound recording is generally the performer(s) whose performance is fixed and/or the producer(s) who captures and processes the performance to make the final recording.

Licenses generally must be obtained separately from the copyright owners of the sound recording and the underlying musical work. Copyright in a sound recording is not the same as, or a substitute for, copyright in the underlying musical work.

For more general information about these works, see Copyright Registration for Musical Compositions (Circular 50), Copyright Registration for Sound Recordings (Circular 56), and Copyright Registration of Musical Compositions and Sound Recordings (Circular 56A).

Must I Use a Compulsory License?

No. Anyone wishing to make and distribute non-DPD phonorecords of a nondramatic musical work can negotiate directly with the copyright owner or his or her agent. But if the copyright owner is unwilling to negotiate, or if the copyright owner cannot be contacted, the person intending to record the work

or reproduce and distribute non-DPD phonorecords of the work may be eligible to use the compulsory license.

When Can a Compulsory License Be Used?

A compulsory license to reproduce and distribute non-DPD phonorecords is available to anyone as soon as phonorecords of a nondramatic musical work have been distributed to the public in the United States and its territories under the authority of the copyright owner.

What Can I Do With a Compulsory License?

If you meet the statutory requirements, including payment of required royalties, you may engage in the following activities with the compulsory license:

- Make and distribute phonorecords of the eligible nondramatic musical work, where the primary purpose is distribution to the public for private use, as opposed to a public performance.
- Authorize others to engage in the making and distributing of the phonorecords.
- Make a musical arrangement of the work to the extent necessary to conform it to the style or manner of interpretation of the performance involved.

You cannot engage in the following activities with the compulsory license. You will need to seek permission from the copyright owner to:

- Make, reproduce, or distribute a sound recording publicly distributed in phonorecords.
- Distribute phonorecords intended for use in background music systems, jukeboxes, broadcasting, or any other public use.
- Change the basic melody or fundamental character of the work in the arrangement.
- Claim copyright protection in your arrangement as a derivative work.

Rights, Licensing, Attribution, Disclaimers, and More

This Chapter C-7, “Copyright and Music,” was authored and published by Eric E. Johnson in 2022. © 2022 Eric E. Johnson using public domain sources, and it takes the edit of the *Newton* case and the note on that case from Chapter 5.A of *Patterns of Information Law: Intellectual Property Done Right* (version 1.1, August 2017) authored by **James Grimmelmann**. I did not find a copyright notice in the book, but I believe the correct one is: © 2017 James Grimmelmann. The book is licensed under the Creative Commons Attribution International License 4.0 (CC-BY 4.0) license, available at <https://creativecommons.org/licenses/by/4.0/>. That license contains a disclaimer of warranties and a statement of limitation of liability. The original work is available at <https://james.grimmelmann.net/ipbook/>.

On page 34, Professor Grimmelmann writes: “All of my own contributions to these materials – including any original writing, edits to existing materials, and the selection and arrangement of those materials – are hereby made available for free reuse under the terms of the Creative Commons Attribution 4.0 International license. Credit is not important to me, but I do care that you preserve the license notice if you redistribute these materials.”

For the material I took from Professor Grimmelmann’s book, I made formatting changes, including to typography, pagination, paragraph styling, etc. Header and informational text above the case differs. Quotation marks may have been re-set. (In particular, when I was moving text from the PDF of the book, some of the curly quotes ended up backwards. I’m not sure if that was an artifact of the original, but I fixed those.). The portion I titled “Commentary from Prof. Grimmelmann about *Newton v. Diamond*” was in a sidebar in Professor Grimmelmann’s book.

I am very grateful to James Grimmelmann for his generosity in sharing his excellent materials!

For the copyright on the chapter as a whole and my copyrightable contributions within it: © 2022 Eric E. Johnson. I license this chapter and its separately copyrightable contributions under the Creative Commons Attribution NonCommercial ShareAlike 4.0 International License (CC BY-NC-SA 4.0), available at <https://creativecommons.org/licenses/by-nc-sa/4.0/legalcode>. Attribution should be to Eric E. Johnson, with a link to <http://ericejohnson.com/ipsurveyor/>. (Note that my choice to use the non-commercial restriction is to keep this chapter’s licensing consistent with other chapters in the broader anthology.)

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Note on editing marks: The superscript tilde (~) indicates omitted material. I used brackets to indicate insertions of mine.

Contact information is available at ericejohnson.com.

–EEJ

Volume Revision Notes

All version numbers beginning with “1.0” (e.g., 1.00, 1.01, and 1.02) are interchangeable from a teaching/learning/assigning standpoint. Only minor typo-level errors are corrected, and there are no changes to pagination. In support of the point about interchangeability, a tedious accounting is now provided.

REVISIONS FROM 1.00 TO 1.01: Changes were extremely minor—primarily exorcizing character- and word-level annoyances. There were no changes to pagination and almost none to line breaks. **Changes:** Pages 3 and 4: Version number changed from 1.00 to 1.01. Page 14: “with” changed to “that” in last line. Page 44: “doctrine in this are” changed to “doctrine in this area”; “exclude others for” changed to “exclude others from for”. Pages 58, 72, 74, 76–82: various number artifacts (star pagination numbers, footnote reference numbers, and a headnote reference number) were removed from the case text. Page 71: “*All italicization has been omitted in this excerpt.*” changed to “*All italicization and footnotes are omitted in this excerpt.*” Page 176: “*threaten to shut music*” changed to “*threaten to shut down music*”. Page 187: The revision notes you are reading now were added. **Note:** The file initially posted as “1.01” omitted to include the changed version number on page 3; that is now corrected.

REVISIONS FROM 1.01 TO 1.02: Changes were, again, extremely minor. There were no changes to pagination and few to line breaks. **Changes:** The biggest changes were on page 163, where the second paragraph repeated the text of the first paragraph (the blockquote). That was fixed. Then a missing opening quotation mark was added to the beginning of the blockquote on page 163. On page 122, a missing paragraph break was inserted into the statutory text. Errantly backward-facing quotation marks were made to face the right way on pages 157, 166-168, 179 & 180. Errant paragraph breaks were removed from pages 93, 115 & 162. Awkward line breaks where small elements (a numeral in parentheses, a closing quotation mark) were stranded at the beginning of a line were fixed on pages 142, 157 & 161. Italicization of case names added on page 168. A missing period was added to the end of a sentence on page 176. An extra space was removed from page 182. On various pages, a section symbol and its number that had become stranded across a line break were reunited, including pages 38, 92, 98, 100, 103, 106, 108 & 153. Also, non-breaking spaces were inserted elsewhere in ways that would be invisible to readers but will help section symbols stay with their associated numbers in subsequent revisions. On pages 86, 157, 161 & 173:

VOLUME REVISION NOTES

Various number artifacts (footnote reference numbers and headnote reference numbers) were removed from the case text. In making sure that no pagination changes (i.e., where page breaks fall) would result from accomplishing the version 1.02 changes, various jerry-rigging changes were made to the typography, including leading and the insertion of non-breaking spaces. On pages 3 & 4: The version number was changed from 1.01 to 1.02. And on page 4 the boxed paragraph was added, and a parenthetical was added about the 1.02 version being posted in 2023. The Volume Revision Notes (that you are reading now, pages 187 & 188) were updated, and the paragraph at the beginning of the section (with a lot of big, bold type) was added.

[The remainder of this page is left intentionally blank.]