U.S. Copyright Law Casebook
{in development}

by Eric E. Johnson
ericejohnson.com

This part:
Story Arc 2

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Story Arc 2

Material Subject to Copyright

A. Introduction, Key Concepts

A.1. What's the question? What's the topic?

This portion of our exploration of copyright law concerns what can be embraced within the exclusive privilege of copyright. In other words: *What is copyrightable subject matter?*

Another way of putting it is that we are after the answer to the question that 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, it tends to be a mark of someone who is totally unfamiliar with copyright law.)

To be fair, the verb compunction is understandable. The adjective "copyrightable" makes it sound like "copyright" would be a verb. After all, "copyrightable" would seem to mean "capable of being copyrighted," in which case one might reasonably infer there's some way "to copyright" something. Yet that's not right. Though counterintuitive, you must understand that the word "copyrightable," as used by courts and lawyers, does not imply the possibility of undertaking some action.

And that's why "copyright" isn't a verb. "Verbs are action words," said thousands of grade school teachers just last year. And there's no action associated with making a *copyrightable* work into a *copyrighted* work. Crucially,

U.S. copyright law causes something to be copyrighted the instant it is copyrightable.

Thus, "copyrightable" just means "capable of being subject to an exclusive right of copyright law."

And to be "capable of being subject to an exclusive right of copyright law," a thing has to be original, creative expression, authored by a human being that is fixed in some tangible form from which it can be later reproduced or absorbed as a communication by a reader/viewer/listener.

What does "original" mean? What does "creative" mean? "Authored"? "Fixed"?

Well, of course, the answer is: It's complicated.

A.2. A general, non-technical explanation of copyrightable subject matter

Pre-reading notes

The following was cobbled together from text written and published by the U.S. Copyright Office and the Congressional Research Service. The USCO and CRS wrote what they wrote for a non-specialist audience – members of the general public and non-lawyers in government. Thus, this is an accessible synthesis of a complex and sometimes hazy area of law. For law students, it makes for a good introduction to the subject.

Explanation of copyright protection basics

What is copyright?

Copyright is a form of protection provided by the laws of the United States to the authors of "original works of authorship" that are fixed in a tangible form of expression. An original work of authorship is a work that is independently created by a human author and possesses at least some minimal degree of creativity. A work is "fixed" when it is captured (either by or under the authority of an author) in a sufficiently permanent medium such that the work can be perceived, reproduced, or communicated for more than a short time.

Today, copyright protection in the United States exists automatically from the moment the original work of authorship is fixed. (Before 1978, federal copyright was generally secured by publishing a work with an appropriate copyright notice. At that time, publishing without the notice put the work permanently into the public domain.)

Examples of copyrightable works include:

- Literary works
- Musical works, including any accompanying words
- Dramatic works, including any accompanying music
- Pantomimes and choreographic works
- Pictorial, graphic, and sculptural works
- Motion pictures and other audiovisual works
- Sound recordings, which are works that result from the fixation of a series of musical, spoken, or other sounds
- Architectural works

The above categories should be viewed broadly for the purposes of protectability. For example, computer programs and certain "compilations" can be registered as "literary works"; maps and technical drawings can be registered as "pictorial, graphic, and sculptural works."

Copyright does not protect:

- Ideas, procedures, methods, systems, processes, concepts, principles, or discoveries
- Works that are not fixed in a tangible form (such as a choreographic work that has not been notated or recorded or an improvisational speech that has not been written down)
- Titles, names, short phrases, and slogans
- Familiar symbols or designs
- Mere variations of typographic ornamentation, lettering, or coloring
- Mere listings of ingredients or contents

Originality and Fixation Requirements for a Copyrightable Work

To be copyrightable, a work must be original and fixed in some tangible form.

To be original, a work must be independently created (i.e., not copied from another person) and have at least a minimal degree of creativity. For example, neither an unoriginal collection of facts (such as an ordinary telephone number directory) nor a work copied entirely from a previous work is copyrightable.

A work must also be fixed in a tangible medium of expression to be copyrightable. This means that a work has to be recorded in some way so that it can be later perceived, communicated, or reproduced. For instance, a live musical performance is not fixed unless someone records it, such as by taking a video of the performance on a smartphone or by writing it down in musical notation.

In all cases, even if some work is "copyrightable," copyright protection applies only to the work's creative expression. It does not extend to the ideas, processes, systems, discoveries, or methods of operation that may be described in the work. For example, while copyright might prevent others from copying the words in a book verbatim, another person could still explain the idea communicated by the book using different words.

A.3. Statute: 17 U.S.C. §102 – Subject matter of copyright: In general

Pre-reading notes

This statute is the current basic statutory provision on copyrightability. It was originally enacted as part of the Copyright Act of 1976.

In part, §102 is truly *statutory* in nature – as in law that was laid down by the legislature. For instance, the section was amended in 1990 to add "architectural works." And once that amendment was made, the law changed so that architectural works were henceforth susceptible to copyright protection.

But it is also true that §102 provision is large part a vessel for court-made common law. Long before 1976, the federal courts developed doctrine about what is copyrightable and what is not. Now, some of that caselaw about

copyrightability springs from the Constitution itself, and thus Congress couldn't change that law through legislation even if it wanted to. But it is also true that much of the law of copyrightability, as developed by the courts, was meant to be undisturbed by Congress when it re-worked copyright statute. And in this way, §102 represents Congress giving its blessing to the courts to continue to develop the law of copyrightable subject matter. (And that is why cases from the 1800s continue to be important today to understanding what is copyrightable.)

Thus, as you read §102, be aware that this statute, by its language, is the final answer as to some legal questions in this area, but as to other legal questions, it leaves the matter up to the courts.

Statute text

17 U.S.C. §102 – Subject matter of copyright: In general

(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.

A.4. The foundational concepts of copyrightability considered together

From the statute and the explanations above, you can see that there are a number of concepts that are crucial to copyrightability, including "originality," "creativity," "authorship," "fixation," and "expression" – particularly "expression" as distinguished from facts, from ideas, and from procedures/processes/systems/methods and expression.

It would be convenient if each of those were a crisply separate concept, each with its own crisply articulated test. But reality is messier.

These meaning of these concepts – what's in, what's out, and how to know – is not prescribed by statute. Instead, it's left up to the caselaw. And there aren't clear tests that come out of the caselaw. To understand the concepts, you have to understand the cases themselves. That means understanding the facts, knowing the outcome, and understanding how the court reasoned from the facts to the outcome.

What's more, there are multiple cases that are important to understanding each concept. And there are often multiple concepts dealt with in each case. That complicates learning the law in this area, and it complicates the matter of organizing a casebook. If there were a one-to-one correspondence of copyrightability doctrine and controlling U.S. Supreme Court case, that would make things easy. But alas, that's not the situation. Newer cases don't replace older cases in explaining the concepts. Instead, they build upon them and provide an additional layer of articulation.

The concepts foundational to copyrightability are interrelated. Leading cases tend to talk about more than one at a time. It's fair to say the caselaw of copyrightability exists as a giant tangle. But a gentler way of thinking about it is that the cases form a sort of woven braid, one that starts in the 1800s continues through the 1900s, and is being lengthened even today.

So instead of trying to impose rigid order upon the caselaw by forcing them into a compartmented doctrinal schematic, this casebook presents the cases in an order based on where each successive case makes a good follow-on to the case before it. The same way a disc jockey would make a setlist or a BFF would make a mixtape: These three songs go together, and these two go together, and these four work well in a succession – and you try to link them

up in overlapping sets of similarities. That's the explanation for the ordering of the cases, and it works out to being very close to chronological.

Working through the cases this way, you may come to perceive that all these requirements and distinctions – fixation, originality, the idea/expression divide – are all just tools for describing something deeper: a singular, unified, underlying concept of what can qualify as copyrightable subject matter. One potentially useful way to think about the law is this: When a court understands, at some gut level, that a plaintiff is claiming a copyright over something that doesn't fit the copyrightability mold, then court will employ whatever doctrinal concepts there are that are useful to articulating a rationale for rejecting the claim.

A.5. Field guide to copyrightability concepts and terms

Realism about the interrelatedness of copyrightability concepts and cases can be very helpful to understanding. But we don't want to go from clear-eyed to misty-eyed in talking about how copyrightability concepts and cases form some kind of eternal woven torsade of jurisprudence. Lawyers don't want to explain a legal argument in a way that makes a judge's eyes roll.

Inevitably, courts and commentators tend to speak about things like originality, creativity, and authorship, for instance, as independent requirements. Even if arguably they aren't. That's a practical and maybe even a necessary analytical approach for lawyer work – writing a brief, drafting a memo, answering a question from the bench and so on.

Thus, as you go through the case, keep in mind the following doctrines (i.e., developed and relied-upon legal concepts). And use the cases to help you fill out your understanding of how to explain these and use them in forming arguments:

- ***expression*** – To be copyrightable, a work must be an expressive work.
- ***fixation*** – To be copyrightable, a work must be fixed in some tangible medium. This rules in works written on paper, captured on photographic film, recorded to audio tape, or captured as text/video/audio to computer memory. The fixation requirement rules out works solely existing in human memory or those

communicated solely in an ephemeral form such as spoken out loud, said over phone lines, or broadcast over radio without being recorded or captured in some way from which they could be later perceived or reproduced.

- ***originality*** – To be copyrightable, a work must be original – the independent intellectual product of an author reflecting some modicum of creativity.
- ***creativity*** – To be original, a work must have some "modicum of creativity." As the caselaw shows, a "modicum" isn't much.
- ***human authorship*** – To be copyrightable, a work must be a work of authorship, and the author has to be a human one.
- ***fact/expression distinction*** – Facts are not copyrightable; thus, facts must be distinguished from expression, which is copyrightable.
- ***idea/expression distinction*** – Ideas are not copyrightable; thus, ideas must be distinguished from expression, which is copyrightable.

And keep in mind these concepts which go to recurring circumstances and situations encountered in the cases.

- ***works*** – The work is the "thing" of copyrightability. A poem, a film, an illustration, a novel – each of those is a work, and "a copyright" attaches to "a work." The work is distinguished from any material object in which it is fixed. A poem can be printed on paper, but the poem's existence as a work is independent of the paper upon which it may be printed.
- ***collective works*** – A "collective work" is a copyrightable work made up of multiple contributions – each of which constitutes a separate and independent work itself – where those contributions are assembled into a collective whole. Newspaper issues, magazine issues, anthologies, encyclopedias are examples.
- ***compilations*** – A compilation is one kind of work. A compilation is formed by collecting and assembling preexisting materials, facts, points of data, etcetera, and then those things – by virtue of their selection, coordination, or arrangement – end up constituting original work of authorship. An original work of authorship consisting of arrangement of uncopyrightable facts will be a

copyrightable compilation. The term "compilation" embraces collective works. So all collective works are compilations. But not all compilations are collective works. Compilations are copyrightable – but only if they meet the regular requirements of copyrightability. So if something is a compilation, consider issues such as: Is there enough additional copyrightable content in the arrangement to meet the originality requirement? If so, what is it? The answers might narrow or eliminate the scope of the plaintiff's rights.

- ***derivatives*** – A "derivative work" is a work based on one or more preexisting works. Examples include a translation of a literary work into a different language, a new musical arrangements of a preexisting composition, a screenplay based on a book, and a motion picture based on a screenplay that was based on a book. A derivatives of another work is copyrightable itself – though, interestingly, not if it is an unauthorized derivative of a copyrighted work. Even if authorized, however, a derivative work raises important questions similar to those with compilations: Is there enough new copyrightable expression to meet the originality requirement? And if so, what is it? Considering those issues is necessary to understand the scope of the plaintiff's valid copyright entitlement.
- ***copies*** – copies are material, tangible objects in which a work is fixed. Thus, a "copy" is something that exists in the material world. A "work" has an existence independent of the material world.

A.6. Consider the stakes – and copyright's neighbors

In reading cases about copyrightability – cases that are determining whether something will be protected by copyright – it's helpful to think about the stakes. At issue is what the law is going to allow to be the exclusive domain of one person (as their legal entitlement, their "intellectual property") and what's going to be left open and unfenced for humanity at large. Consider that a copyright lasts for about 100 years. If the law, in favoring one particular plaintiff, draws the line in the wrong place, there will be significant consequences. Those consequences may include frustrating everyone's ability

to innovate, to communicate, to learn, and perhaps even to think clearly about certain things.

What's more, just because something isn't "copyrightable" doesn't mean it's not "protectable" or that the creator can't profit from their creation.

Tort law offers protection useful to authors and innovators – defamation claims for slurring their name, and various causes of action for stealing secrets, invading privacy, and betraying confidences.

There's also other intellectual property law. Systems, procedures, methods of operation, and the like may be protectable by a utility patent – if the requirements of patentability set out by Congress are met. Similarly, ornamental designs can be generally protected by design patents. Words, phrases, shapes, and designs – if they serve as an indication of the commercial source of goods or services – can be protected by trademark law. Sometimes, if there's no intellectual property right that fits, you can ask for, and receive one, from Congress. For instance, boat manufacturers did just that a few decades ago and received a niche IP right for vessel hulls.

And IP protection isn't the only way to profit from producing new products of the mind. Writing, publishing, being read, "making an impact" – that's a path to clamoring clients, lucrative job offers, consulting gigs, and even speaking fees. Writing and recording music people love creates demand for live performances. (*Pssst!* Dirty secret: Recording artists tend to make a lot more money from concert ticket sales than from record royalties.) And businesses that are the first to create something new and take it to market generally get a powerful economic incentive with what economists and business-management scholars call "first mover advantage" – even when copyists soon follow. Why buy from the imitator when you can buy from the innovator?

All of that context matters when courts have to decide whether to provide exclusive rights to one plaintiff at the expense of a very long period of exclusion for everybody else.

B. Foundational Cases, 1879–1903

B.1. Lead-in

Three old cases loom large in defining the limits of what is copyrightable. They all start with a B. *Baker v. Selden* (U.S. 1879) held that copyright would not protect a new and clever system of bookkeeping. *Burrow-Giles v. Sarony* (U.S. 1884) held that copyright could protect photographs – as creative works, not merely a factual record of the physical world captured on a light-sensitive plate. And *Bleistein v. Donaldson* (U.S. 1903) upheld copyright in illustrations in circus advertisements, establishing that copyright has no requirement of artistic virtue.

The current copyright law is the Copyright Act of 1976. Thus, as will be as will be obvious from their dates, all three of these cases were not decided under the current law. They weren't even decided under the '76 Act's immediate predecessor, which was the Copyright Act of 1909. Nevertheless, these cases continue to be looked to as the foundation of modern concepts of copyrightability.

B.2. Case: Baker v. Selden (U.S. 1879)

Pre-reading notes

In *Baker v. Selden,* 101 U.S. 99 (1879), the creator of new and useful bookkeeping/accounting system sought to use copyright to so as to be the sole supplier of blank form books using the system. Copyright was denied. From thenceforth to today, tracking expenses has been less of an expense.

Editing notes

The following case abridgement/edit is by EEJ. Many liberalities were taken for readability. It contains many unmarked departures from the original, including – for the convenience of the reader – changing the names and words used to refer to the litigants and other persons. Some edits, however, were marked. Here's a key:

˜ means material deleted (like three dots ... , but meant to be less obtrusive)

< and > set off text taken from footnotes and placed inline in the body text

{ and } denote an insertion (and maybe a co-incident deletion) by the casebook editor (as opposed to the court)

¶ identifies the place of an editor-inserted paragraph break

Opinion

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˜ 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. {Baker} contends on the argument that the matter alleged to be infringed is not a lawful subject of copyright.

The˜ various books of the complainant, as well as those sold and used by Baker, were exhibited before the examiner, and witnesses were examined to both sides. A decree was rendered for the complainant, and Baker 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 banks, 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. Baker uses a similar plan so far as results are concerned; but makes a different arrangement of the columns, and uses different headings.¶

If Selden had the exclusive right to the use of the system explained in his book, it would be difficult to contend that Baker 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 Baker 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 Selden has secured such exclusive right, because no one can use the system without using substantially the same ruled lines and headings which he was 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 or 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.

It cannot be pretended, and indeed it is not seriously urged, that the ruled lines of the complainant's account-book can be claimed under any special class of objects, other than books, named in the law of copyright existing in 1859. The law then in force was that of 1831, and specified only books, maps, charts, musical compositions, prints, and engravings. An account-book, consisting of ruled lines and blank columns, cannot be called by any of these names unless by that of a book.

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 period.¶

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 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.˜

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

B.3. Case: Burrow-Giles v. Sarony (U.S. 1884)

Pre-reading notes

In *Burrow-Giles v. Sarony,* 111 U.S. 53 (1884), the relatively new technology of photography collided with copyright doctrine built around printing presses, moveable type, and engraved plates. Was the photograph just a factual record? Or what is a work of creative authorship? The photographer

won. And a century and a half later, parents are skipping date night again to pay for awkward band photos.

Opinion

Burrow-Giles v. Sarony

Supreme Court of the United States
111 U.S. 53 (1884)

MR. JUSTICE MILLER delivered the opinion of the court.

This is a writ of error to the Circuit Court for the Southern District of New York.

Plaintiff is a lithographer and defendant a photographer, with large business in those lines in the city of New York.

The suit was commenced by an action at law in which Sarony was plaintiff and the lithographic company was defendant, the plaintiff charging the defendant with violating his copyright in regard to a photograph, the title of which is "Oscar Wilde No. 18." A jury being waived, the court made a finding of facts on which a judgment in favor of the plaintiff was rendered for the sum of $600 for the plates and 85,000 copies sold and exposed to sale, and $10 for copies found in his possession, as penalties under section 4965 of the Revised Statutes.

Among the findings of fact made by the court the following presents the principal question raised by the assignment of errors in the case:

"3. That the plaintiff about the month of January, 1882, under an agreement with Oscar Wilde, became and was the author, inventor, designer, and proprietor of the photograph in suit, the title of which is 'Oscar Wilde No. 18,' being the number used to designate this particular photograph and of the negative thereof; that the same is a useful, new, harmonious, characteristic, and graceful picture, and that said plaintiff made the same at his place of business in said city of New York, and within the United States, entirely from his own original mental conception, to which he gave visible form by posing the said Oscar Wilde in front of the camera, selecting and arranging the costume, draperies, and other various accessories in said photograph, arranging the subject so as to present graceful outlines,

arranging and disposing the light and shade, suggesting and evoking the desired expression, and from such disposition, arrangement, or representation, made entirely by the plaintiff, he produced the picture in suit, Exhibit A, April 14th, 1882, and that the terms 'author,' 'inventor,' and 'designer,' as used in the art of photography and in the complaint, mean the person who so produced the photograph."

Other findings leave no doubt that plaintiff had taken all the steps required by the act of Congress to obtain copyright of this photograph, and section 4952 names photographs among other things for which the author, inventor, or designer may obtain copyright, which is to secure him the sole privilege of reprinting, publishing, copying and vending the same. That defendant is liable under that section and section 4965 there can be no question, if those sections are valid as they relate to photographs.

Accordingly, the two assignments of error in this court by plaintiff in error, are:

1. That the court below decided that Congress had and has the constitutional right to protect photographs and negatives thereof by copyright.

The second assignment related to the sufficiency of the words "Copyright, 1882, by N. Sarony," in the photographs, as a notice of the copyright of Napoleon Sarony under the act of Congress on that subject.

With regard to this latter question, it is enough to say, that the object of the statute is to give notice of the copyright to the public, by placing upon each copy, in some visible shape, the name of the author, the existence of the claim of exclusive right, and the date at which this right was obtained.

This notice is sufficiently given by the words "Copyright, 1882, by N. Sarony," found on each copy of the photograph. It clearly shows that a copyright is asserted, the date of which is 1882, and if the name Sarony alone was used, it would be a sufficient designation of the author until it is shown that there is some other Sarony.

When, in addition to this, the initial letter of the Christian name Napoleon is also given, the notice is complete.

The constitutional question is not free from difficulty:

The eighth section of the first article of the Constitution is the great repository of the powers of Congress, and by the eighth clause of that section Congress is authorized:

> "To promote the progress of science and useful arts, by securing, for limited times to authors and inventors, the exclusive right to their respective writings and discoveries."

The argument here is, that a photograph is not a writing nor the production of an author. Under the acts of Congress designed to give effect to this section, the persons who are to be benefited are divided into two classes, authors and inventors. The monopoly which is granted to the former is called a copyright, that given to the latter, letters patent, or, in the familiar language of the present day, *patent right*.

We have, then, copyright and patent right, and it is the first of these under which plaintiff asserts a claim for relief.

It is insisted in argument, that a photograph being a reproduction on paper of the exact features of some natural object or of some person, is not a writing of which the producer is the author.

Section 4952 of the Revised Statutes places photographs in the same class as things which may be copyrighted with "books, maps, charts, dramatic or musical compositions, engravings, cuts, prints, paintings, drawings, statutes, statuary, and models or designs intended to be perfected as works of the fine arts." "According to the practice of legislation in England and America," says Judge Bouvier, 2 Law Dictionary, 363, "the copyright is confined to the exclusive right secured to the author or proprietor of a writing or drawing which may be multiplied by the arts of printing in any of its branches."

The first Congress of the United States, sitting immediately after the formation of the Constitution, enacted that the "author or authors of any map, chart, book or books, being a citizen or resident of the United States, shall have the sole right and liberty of printing, reprinting, publishing and vending the same for the period of fourteen years from the recording of the title thereof in the clerk's office, as afterwards directed." 1 Stat. 124, 1.

This statute not only makes maps and charts subjects of copyright, but mentions them before books in the order of designation. The second section of an act to amend this act, approved April 29, 1802, 2 Stat. 171, enacts that from the first day of January thereafter, he who shall invent and design, engrave, etch or work, or from his own works shall cause to be designed and engraved, etched or worked, any historical or other print or prints shall have the same exclusive right for the term of fourteen years from recording the title thereof as prescribed by law.

By the first section of the act of February 3d, 1831, 4 Stat. 436, entitled an act to amend the several acts respecting copyright, musical compositions and cuts, in connection with prints and engravings, are added, and the period of protection is extended to twenty-eight years. The caption or title of this act uses the word copyright for the first time in the legislation of Congress.

The construction placed upon the Constitution by the first act of 1790, and the act of 1802, by the men who were contemporary with its formation, many of whom were members of the convention which framed it, is of itself entitled to very great weight, and when it is remembered that the rights thus established have not been disputed during a period of nearly a century, it is almost conclusive.

Unless, therefore, photographs can be distinguished in the classification on this point from the maps, charts, designs, engravings, etchings, cuts, and other prints, it is difficult to see why Congress cannot make them the subject of copyright as well as the others.

These statutes certainly answer the objection that books only, or writing in the limited sense of a book and its author, are within the constitutional provision. Both these words are susceptible of a more enlarged definition than this. An author in that sense is "he to whom anything owes its origin; originator; maker; one who completes a work of science or literature." Worcester. So, also, no one would now claim that the word writing in this clause of the Constitution, though the only word used as to subjects in regard to which authors are to be secured, is limited to the actual script of the author, and excludes books and all other printed matter. By writings in that clause is meant the literary productions of those authors, and Congress very properly has declared these to include all forms of writing, printing,

engraving, etching, &c., by which the ideas in the mind of the author are given visible expression. The only reason why photographs were not included in the extended list in the act of 1802 is probably that they did not exist, as photography as an art was then unknown, and the scientific principle on which it rests, and the chemicals and machinery by which it is operated, have all been discovered long since that statute was enacted.

Nor is it to be supposed that the framers of the Constitution did not understand the nature of copyright and the objects to which it was commonly applied, for copyright, as the exclusive right of a man to the production of his own genius or intellect, existed in England at that time, and the contest in the English courts, finally decided by a very close vote in the House of Lords, whether the statute of 8 Anne, chap. 19, which authorized copyright for a limited time, was a restraint to that extent on the common law or not, was then recent. It had attracted much attention, as the judgment of the King's Bench, delivered by Lord Mansfield, holding it was not such a restraint, in Miller v. Taylor, 4 Burrows, 2303, decided in 1769, was overruled on appeal in the House of Lords in 1774. Ibid. 2408. In this and other cases the whole question of the exclusive right to literary and intellectual productions had been freely discussed.

We entertain no doubt that the Constitution is broad enough to cover an act authorizing copyright of photographs, so far as they are representatives of original intellectual conceptions of the author.

But it is said that an engraving, a painting, a print, does embody the intellectual conception of its author, in which there is novelty, invention, originality, and therefore comes within the purpose of the Constitution in securing its exclusive use or sale to its author, while the photograph is the mere mechanical reproduction of the physical features or outlines of some object animate or inanimate, and involves no originality of thought or any novelty in the intellectual operation connected with its visible reproduction in shape of a picture. That while the effect of light on the prepared plate may have been a discovery in the production of these pictures, and patents could properly be obtained for the combination of the chemicals, for their application to the paper or other surface, for all the machinery by which the light reflected from the object was thrown on the prepared plate, and for all

the improvements in this machinery, and in the materials, the remainder of the process is merely mechanical, with no place for novelty, invention or originality. It is simply the manual operation, by the use of these instruments and preparations, of transferring to the plate the visible representation of some existing object, the accuracy of this representation being its highest merit.

This may be true in regard to the ordinary production of a photograph, and, further, that in such case a copyright is no protection. On the question as thus stated we decide nothing.

In regard, however, to the kindred subject of patents for invention, they cannot by law be issued to the inventor until the novelty, the utility, and the actual discovery or invention by the claimant have been established by proof before the Commissioner of Patents; and when he has secured such a patent, and undertakes to obtain redress for a violation of his right in a court of law, the question of invention, of novelty, of originality, is always open to examination. Our copyright system has no such provision for previous examination by a proper tribunal as to the originality of the book, map, or other matter offered for copyright. A deposit of two copies of the article or work with the Librarian of Congress, with the name of the author and its title page, is all that is necessary to secure a copyright. It is, therefore, much more important that when the supposed author sues for a violation of his copyright, the existence of those facts of originality, of intellectual production, of thought, and conception on the part of the author should be proved, than in the case of a patent right.

In the case before us we think this has been done.

The third finding of facts says, in regard to the photograph in question, that it is a "useful, new, harmonious, characteristic, and graceful picture, and that plaintiff made the same . . . entirely from his own original mental conception, to which he gave visible form by posing the said Oscar Wilde in front of the camera, selecting and arranging the costume, draperies, and other various accessories in said photograph, arranging the subject so as to present graceful outlines, arranging and disposing the light and shade, suggesting and evoking the desired expression, and from such disposition, arrangement, or representation, made entirely by plaintiff, he produced the picture in suit."

These findings, we think, show this photograph to be an original work of art, the product of plaintiff's intellectual invention, of which plaintiff is the author, and of a class of inventions for which the Constitution intended that Congress should secure to him the exclusive right to use, publish and sell, as it has done by section 4952 of the Revised Statutes.

The question here presented is one of first impression under our Constitution, but an instructive case of the same class is that of Nottage v. Jackson, 11 Q.B.D. 627, decided in that court on appeal, August, 1883.

The first section of the act of 25 and 26 Victoria, chap. 68, authorizes the author of a photograph, upon making registry of it under the copyright act of 1882, to have a monopoly of its reproduction and multiplication during the life of the author.

The plaintiffs in that case described themselves as the authors of the photograph which was pirated, in the registration of it. It appeared that they had arranged with the captain of the Australian cricketers to take a photograph of the whole team in a group; and they sent one of the artists in their employ from London to some country town to do it.

The question in the case was whether the plaintiffs, who owned the establishment in London, where the photographs were made from the negative and were sold, and who had the negative taken by one of their men, were the authors, or the man who, for their benefit, took the negative. It was held that the latter was the author, and the action failed, because plaintiffs had described themselves as authors.

Brett, M. R., said, in regard to who was the author: "The nearest I can come to, is that it is the person who effectively is as near as he can be, the cause of the picture which is produced, that is, the person who has superintended the arrangement, who has actually formed the picture by putting the persons in position, and arranging the place where the people are to be -- the man who is the effective cause of that."

Lord Justice Cotton said: "In my opinion, 'author' in volves originating, making, producing, as the inventive or master mind, the thing which is to be protected, whether it be a drawing, or a painting, or a photograph;" and Lord Justice Bowen says that photography is to be treated for the purposes of the

act as an art, and the author is the man who really represents, creates, or gives effect to the idea, fancy, or imagination.

The appeal of plaintiffs from the original judgment against them was accordingly dismissed.

These views of the nature of authorship and of originality, intellectual creation, and right to protection confirm what we have already said.

The judgment of the Circuit Court is accordingly affirmed.

B.4. Case: Bleistein v. Donaldson (U.S. 1903)

Pre-reading notes

In *Bleistein v. Donaldson* (U.S. 1903) copyright was claimed in illustrations for circus advertisements. These illustrations – so commercial, so base, so banal, so dissevered from the lofty sphere of the fine arts – could they possibly qualify as works fit for copyright? The court decided that judges of law won't be judges of artistic worth. Copyright for common commercial illustrations upheld. Forever afterward, just because a book, movie, photograph, illustration, or teenage angst poem is terrible – that doesn't make it uncopyrightable.

Plaintiffs' counsel's statements published with opinion

***Mr. Ansley Wilcox* and *Mr. Arthur von Briesen* for plaintiffs in error:**

This action comes here upon writ of error to the Circuit Court of Appeals for the Sixth Circuit, which court heard it on writ of error directed to the United States Circuit Court for the District of Kentucky. The Circuit Court, at the close of plaintiffs' case, instructed the jury to find a verdict for defendant, which was done and judgment entered thereon. The Circuit Court of Appeals affirmed said judgment.

There were three causes of action which were all based upon sec. 4965 of the Revised Statutes, quoted on page 60. By order of the Circuit Court, dated June 10, 1899, the marshal seized 10,590 eight-page prints and 13,205

four-page prints, described in the writ, and also five metal electrotype plates, all of which he found in the defendant's possession (page 13).

The action was tried at Covington, Kentucky, on December 12 and 13, 1899, before Hon. Walter Evans, sitting as Circuit Judge, and a jury.

At the outset of the trial, during the direct examination of the first witness, the court anticipated the question upon which it afterwards took the case away from the jury and decided it, by the following remark: "The real controversy will be whether this is a subject of copyright, whether it comes within the copyright law."

At the close of the plaintiffs' case, defendant moved for "peremptory instructions for the defendant." The court said, "State why, in a word," to which defendant's counsel answered: "In the first place I want to say with reference to the Statuary Exhibit. . . . It is alleged in the petition, and is in fact copyrighted on the 18th of April, and the publication plainly shows it was prior to that. That is a specific objection to that one upon that ground specifically -- that is the Statuary.

"The Court: Now as to the other two.

"Counsel: The specific objection to this one, the Ballet, is that it is an immoral picture.

"And the general objection that I make to them all is that they are none of them subject matter of copyright. They are all mere matter of advertising."

The next day the court delivered a written opinion which concludes as follows:

"The case must turn upon the others (other question), and especially upon the general proposition that the things copyrighted in this case were by no means such as either the Constitution or the legislation of Congress intended to protect by the privilege of copyright. The court cannot bring its mind to yield to the conclusion that such tawdry pictures as these were ever meant to be given the enormous protection of not only the exclusive right to print them, but the additional protection of a penalty of a dollar each for reprints from them.

"As previously stated, they are neither 'pictorial illustrations' nor 'works connected with the fine arts' within the meaning of section 4952. Not being

so, there was no authority to grant the copyrights, whether the Constitution authorizes Congress to promote the fine arts or not.

"The judgment of the court is, that the plaintiffs' on their own showing, are not entitled to recover, and for that reason the motion of defendant will be granted, and Il will instruct the jury to find a verdict for it."

The jury, in accordance with said instruction, returned a verdict for the defendant.

There is no question as to the fact of infringement.

The sheets in evidence, made by defendant, contain reproductions by means of cheap electrotype plates of each of the plaintiffs' designs. These reproductions are not in colors.

The principal questions are:

First. Whether on the question of artistic merit or value of these lithographic prints or chromos, the Circuit Court was justified in taking the case from the jury, and condemning them entirely as not being fit subjects for copyright.

Second. Whether the copyrights were obtained for these prints in accordance with the Constitution and laws of the United States, and are valid copyrights.

The second question involves the inquiries: Whether the copyrights were properly taken out by the plaintiffs, in their trade names of "The Courier Co." and "The Courier Lithographing Co.," and, incidentally, whether plaintiffs have the right to sue in their individual names for infringement of these copyrights; and whether the Statuary Act Design was copyrighted before it was published.

The three pictures in question are show-bills or circus bills, also called posters and, more definitely, picture-posters. They are colored lithographs or chromolithographs, commonly called "chromos." They were designed primarily to be sold to the proprietors of circuses and other shows, and by them to be used for advertising; but they could be sold to any one, or used for any purpose for which they were adapted.

They were made in the plaintiffs' lithographing establishment under a special contract with the proprietor of a circus, by which the plaintiffs agreed to design and get up certain representations of scenes supposed to be exhibited at the show, the plaintiffs reserving rights of design and of copyright, and with the usual understanding that so long as the proprietor of the circus used these designs he had the right to them, but if he ceased to use any of them, the plaintiffs could sell the design or the pictures which embodied it, to any one.

The fundamental question of the right to copyright such show-bills or posters, is a question of great importance, involving the protection of an immense industry. The foundation of the copyright law is in the provision of the Constitution (art. 1, sec. 8), which authorizes Congress --

"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."

It is settled that the words "authors" and "writings," in this section, are not confined to literary writers and their works, but include, among others, designers, engravers and lithographers, as well as photographers. Burrow-Giles Litho. Co. v. Sarony, 111 U.S. 53; Trade Mark Cases, 100 U.S. 82. Picture-posters or show bills, such as these chromolithographs were, are not designed for close inspection or long-continued study, like an oil painting, a steel or wood engraving, or an etching, and they are not to be judged by the same standards. They are intended to catch the eye of the passer on the street, or any one who merely glances at them, and to challenge his attention, -- if possible to compel him to look again, so that he will observe what is the subject of the poster and have this forced upon his mind, and will be attracted by it. Their function is to illustrate something, and to advertise it by appealing quickly to the imagination, and conveying instantly a strong and favorable impression. Thus, to be successful, they require artistic ability, and above all things creativeness or originality of a high order, but peculiar. They must be designed boldly, and executed on broad lines, with not much attention to detail, so that the spirit of the picture will stand out at once, and almost leap at you, and will not be lost in a mass of details and minor features.

Such is the ideal picture-poster, a special and peculiar branch of pictorial art, and one into which many gifted artists, highly successful in other fields, have ventured with greater or less success. Charles Hiatt's work entitled "Picture Posters," published in 1895 by George Bell & Sons, London; "The Modern Poster," by Alexandre and others, published in 1895 by Charles Scribner's Sons.

Certainly it does not lie in the mouth of the pirate, who has stolen and copied them at some expense and considerable risk, to deny that they have merit and value.

I. The designs were proper subjects of copyright and each of these picture-posters was a proper subject of copyright, within the language and the spirit of the copyright law. There was abundant evidence of originality of design, of artistic merit, and of practical value and usefulness, as to each of the pictures.

If any of these qualities was seriously questioned by the defence, it became the duty of the court to send the case to the jury.

All of the pictures are new and original designs and involve new and original conceptions and creations. There was enough evidence on this subject to require to case to be submitted to the jury if any question was raised about it, citing, and in some instances distinguishing, as to definition of author, writings, etc., The Trade Mark Cases, 100 U.S. 82; Lithograph Co. v. Sarony, 111 U.S. 53; Nottage v. Jackson, 11 Q.B. Div. 627; Brightly v. Littleton, 37 Fed. Rep. 103; Carlisle v. Colusa County, 57 Fed. Rep. 979; Drury v. Ewing, Fed. Cases, No. 4095.

If any one of the pictures was sufficiently proved to be new and original, this was enough to carry the case to the jury upon this question; they were all proved to be new and original.

II. As to artistic merit and value. The pictures being original designs, we maintain that they are of sufficient artistic merit and of sufficient value and usefulness to be entitled to copyright. At least there was enough evidence of this to require the case to be submitted to the jury, if any question was raised about it, -- and furthermore no such question was raised by the defence.

"If a copyrighted article has merit and value enough to be the object of piracy, it should also be of sufficient importance to be entitled to protection." Drone on Copyright, p. 212, cited with approval in Henderson v. Tomkins, 60 Fed. Rep. 758, 765; Church v. Linton, 25 Ont. Rep. 121; Hegeman v. Springer, 110 Fed. Rep. 374; Bolles v. Outing Co., 77 Fed. Rep. 966; 175 U.S. 262; Richardson v. Miller, Fed. Cases, No. 11,791.

We have nothing to do with cases involving attempts to copyright mere catalogues or price lists, or labels, sometimes containing pictures, reproduced by photographic or other mechanical processes, of articles intended for sale, but which obviously have no artistic merit or originality. These decisions, whether condemning or upholding such copyrights, do not touch the questions involved in the case at bar. Distinguishing Mott Iron Works v. Clow, 82 Fed. Rep. 216; also citing Yuengling v. Schile, 12 Fed. Rep. 97, 101; Schumaker v. Schwencke, 25 Fed. Rep. 466; Lamb v. Grand Rapids School Furniture Co., 39 Fed. Rep. 474; Drone on Copyright, 164, 165; Grace v. Newman, L.R. 19 Eq. Cases, 623; Maple v. Junior Army & Navy Stores, L.R. 21 Ch. Div. 369; Church v. Linton, 25 Ont. Rep. 131; Carlisle v. Colusa County, 57 Fed. Rep. 979.

"The degree of merit of the copyrighted matter the law is not concerned with. Any is legally enough. To use it or not use it, is voluntary on the part of the public."

III. The copyrights were properly taken out by the plaintiffs in their trade names of "The Courier Co." and "The Courier Litho. co.," and the plaintiffs have the right to sue in their individual names for infringement of these copyrights.

That copartners in business, who are the proprietors of a copyrighted article, may take out a copyright in either of their copartnership or trade names, is well settled. Scribner v. Clark, 50 Fed. Rep. 473; affirmed as Belford v. Scribner, 144 U.S. 488; Callaghan v. Myers, 128 U.S. 617; Scribner v. Allen Co., 49 Fed. Rep. 854; Werckneister v. Springer Lith. Co., 63 Fed. Rep. 808; Rock v. Lazarus, Law Rep. 15 Eq. Cases, 104; Weldon v. Dicks, Law Rep. 10 Ch. Div. 247; Fruit-Cleaning Co. v. Fresno Home Packing Co., 94 Fed. Rep. 845.

Finally, the plaintiffs were the "proprietors" of each of the copyrighted prints, and as such were authorized to take out the copyrights by the express language of the copyright law, Rev. Stat., sec. 4952, which includes "proprietors" with "authors, inventors (and) designers." Colliery Eng. Co. v. United etc., Co., 94 Fed. Rep. 152.

No formal assignment of the right to a copyright is necessary. Consent is sufficient to constitute one the proprietor. Carte v. Evans, 27 Fed. Rep. 861. See also Schumacher v. Schwencke, 25 Fed. Rep. 466; Little v. Gould, Fed. Cases, No. 8395; Lawrence v. Dana, Fed. Cases, No. 8136; Sweet v. Benning, 81 Eng. Com. Law Rep. 459; 16 Com. Bench Rep. 459; Gill v. United States, 160 U.S. 426, 435.

All of the pictures, and particularly the Statuary Act Design, were copyrighted before publication.

The law is well settled that there was no publication of these prints when they were shipped from Buffalo on April 11, or when they were received by Mr. Wallace at Peru, Indiana, on or about April 15. There was no publication until they were exposed to the general public, so that the public, without discrimination as to persons, might enjoy them. This must have been some time after April 15, when the last copyright was surely completed.

Publication is a legal conclusion which follows from certain acts. Drone on Copyright, p. 291; Jewelers Merc. Agency v. Jewelers Pub. Co., 84 Hun (N.Y. Sup. Ct.), 12, 16; Callaghan v. Myers, 128 U.S. 617; Black v. Henry G. Allen Co., 56 Fed. Rep. 764; Belford v. Scribner, 144 U.S. 488; Garland v. Gemmill, 14 Canada Sup. Ct. Rep. 321; Prince Albert v. Strange, 2 De Gex & Smale, 652; 1 MacNaghten & Gorden; 47 Eng. Ch. Rep. 25. The representation of a play upon the stage regularly at a theatre, does not constitute a publication. Tompkins v. Halleck, 133 Massachusetts, 32; Palmer v. De Witt, 47 N.Y. 532; Boucicault v. Hart, Fed. Cases, No. 1692.

The use by a teacher of his manuscript and allowing pupils to make copies for the purpose of obtaining his instruction, does not amount to a publication. Bartlett v. Crittenden, Fed. Cases, Nos. 1076 and 1082. The printing of copies of an operetta and distributing them to artists, for private use only in learning their parts, and the representing of the operetta on the stage, is not a publication. French v. Kreling, 63 Fed. Rep. 621; Reed v.

Carusi, Fed. Cases, No. 11,642; Blume v. Spear, 30 Fed. Rep. 629; Exch. Tel. Co. v. Cent. News, Law Rep. 2 Ch. Div. 48.

Defendant's counsel's statements published with opinion

***Mr. Edmund W. Kittredge*, with whom *Mr. Joseph Wilby* was on the brief, for defendant in error,** contended that the plaintiff in error was not entitled to copyright. The evidence established that these three prints were ordered by B.E. Wallace, proprietor of the circus known as the "Wallace Shows," under contract with him as an advertisement for his show, and they have never been made for anybody else. All of these pictures purported to be representations of acts to be done in the Wallace Shows, and all were made under a representation by Wallace, expressed on the face of the pictures, that his show was going to do these things. All these posters contain reading matter indicating that these were pictures of acts to be done in the Wallace Shows, and they all included pictures of Mr. Wallace himself.

They were prints and the copyright inscription was insufficient. But for the provision in the first clause of this act the inscription, "Copyright, 1898, Courier Litho. Co., Buffalo, N.Y.," would have been fatal to the plaintiffs' right of action. Thompson v. Hubbard, 131 U.S. 123. The inscription prescribed by section 4962 of the Revised Statutes was otherwise indispensable to the maintenance of an action for the infringement of a copyright. The notice given on each one of these pictures was that authorized by the act of June 18, 1874. Having thus availed themselves of the provisions of this act, clearly the plaintiffs are not in position to claim that the pictures are not covered by its provisions. Again, if these pictures were chromos, and not prints, cuts or engravings, then under the allegations of the petition they were not admissible in evidence because they were not in support of the allegations of the petition. As to what a chromo is and how statute should be construed, Yuengling v. Schile, 12 Fed. Rep. 107; Bolles v. Outing Company, 175 U.S. 262; Thornton v. Schreiber, 124 U.S. 612; Rosenbach v. Dreyfuss, 2 Fed. Rep. 217; Ehret v. Pierce, 10 Fed. Rep. 554; S.C., 18 Blatch. 302; Schumacher v. Wogram, 35 Fed. Rep. 210; Higgins v. Kueffel, 140 U.S. 428. As to advertisements and copyrights, citing Cobbett v. Woodward, L.R. 14 Eq. 407, cited with approval by this court in Baker v. Selden, 101 U.S. 106;

Clayton v. Stone & Hall, 2 Paine, 392; Mott Iron Works v. Clow, 82 Fed. Rep. 216.

There was no evidence tending to show that the plaintiffs themselves, or either of them, were the authors of these prints. It was claimed that they were the proprietors because, as they also claimed, the design or conception was that of their employes, working for them, under salaries, and that their designs were the property of the employer. If they were not themselves the authors, then it was incumbent upon them to allege how they acquired title as proprietors from the author, inventor or designer. Lithographic Co. v. Sarony, 111 U.S. 53; Nottage v. Jackson, 11 Q.B.D. 627; Atwell v. Ferret, 2 Blatch. 46; Bimms v. Woodworth, 4 Wash. C.C. Rep. 48; Black v. Allen Co., 42 Fed. Rep. 618; S.C., 56 Fed. Rep. 764; Press Pub. Co. v. Falk, 59 Fed. Rep. 524; Pollard v. Photograph Co., 40 Ch. Div. 345; Moore v. Rugg, 46 N.W. 141; Dielman v. White, 102 Red. Rep. 892; Parton v. Prang, 3 Clifford, 537; Little v. Good, 2 Blatch. 166.

It is incumbent upon the plaintiffs, in a case like this, for the recovery of penalties, to allege and to prove as alleged, every fact essential to the validity of their copyright. Jones v. Van Zandt, 5 How. 372.

The copyright law does not protect what is immoral in its tendency. A print representing unchaste acts of scenes calculated to excite lustful or sensual desires in those whose minds are open to such influences, and to attract them to witness the performance of such scenes, is manifestly of that character. It is the young and immature and those who are sensually inclined who are liable to be influenced by such scenes and representations, and it is their influence upon such persons that should be considered in determining their character. Broder v. Zeno Mauvais Music Co., 88 Fed. Rep. 74; Dunlop v. United States, 165 U.S. 501; Martinetti v. Maguire, Fed. Cases, No. 9173, The Black Crook case.

Opinion

Mr. Justice Holmes delivered the opinion of the court.

This case comes here from the United States Circuit Court of Appeals for the Sixth Circuit by writ of error. Act of March 3, 1891, c. 517, § 6, 26 Stat. 828. It is an action brought by the plaintiffs in error to recover the

penalties prescribed for infringements of copyrights. Rev. Stat. §§ 4952, 4956, 4965, amended by act of March 3, 1891, c. 565, 26 Stat. 1109, and act of March 2, 1895, c. 194, 28 Stat. 965. The alleged infringements consisted in the copying in reduced form of three chromolithographs prepared by employes of the plaintiffs for advertisements of a circus owned by one Wallace. Each of the three contained a portrait of Wallace in the corner and lettering bearing some slight relation to the scheme of decoration, indicating the subject of the design and the fact that the reality was to be seen at the circus. One of the designs was of an ordinary ballet, one of a number of men and women, described as the Stirk family, performing on bicycles, and one of groups of men and women whitened to represent statutes. The Circuit Court directed a verdict for the defendant on the ground that the chromolithographs were not within the protection of the copyright law, and this ruling was sustained by the Circuit Court of Appeals. *Courier Lithographing Co.* v. *Donaldson Lithographing Co*., 104 Fed. Rep. 993.

There was evidence warranting the inference that the designs belonged to the plaintiffs, they having been produced by persons employed and paid by the plaintiffs in their establishment to make those very things. *Gill* v. *United States*, 160 U.S. 426, 435; *Colliery Engineer Company* v. *United Correspondence Schools Company*, 94 Fed. Rep. 152; *Carte* v. *Evans*, 27 Fed. Rep. 861. It fairly might be found also that the copyrights were taken out in the proper names. One of them was taken out in the name of the Courier Company and the other two in the names of the Courier Lithographing Company. The former was the name of an unincorporated joint stock association formed under the laws of New York, Laws of 1894, c. 235, and made up of the plaintiffs, the other a trade variant on that name. *Scribner* v. *Clark*, 50 Fed. Rep. 473, 474, 475; S.C., *sub nom. Belford* v. *Scribner*, 144 U.S. 488.

Finally, there was evidence that the pictures were copyrighted before publication. There may be a question whether the use by the defendant for Wallace was not lawful within the terms of the contract with Wallace, or a more general one as to what rights the plaintiffs reserved. But we cannot pass upon these questions as matter of law; they will be for the jury when the case is tried again, and therefore we come at once to the ground of decision in the

courts below. That ground was not found in any variance between pleading and proof, such as was put forward in argument, but in the nature and purpose of the designs.

We shall do no more than mention the suggestion that painting and engraving unless for a mechanical end are not among the useful arts, the progress of which Congress is empowered by the Constitution to promote. The Constitution does not limit the useful to that which satisfies immediate bodily needs. *Burrow-Giles Lithographi*c *Co.* v. *Sarony*, 111 U.S. 53. It is obvious also that the plaintiffs' case is not affected by the fact, if it be one, that the pictures represent actual groups – visible things. They seem from the testimony to have been composed from hints or description, not from sight of a performance. But even if they had been drawn from the life, that fact would not deprive them of protection. The opposite proposition would mean that a portrait by Velasquez or Whistler was common property because others might try their hand on the same face. Others are free to copy the original. They are not free to copy the copy. *Blunt* v. *Patten*, 2 Paine, 397, 400. See *Kelly* v. *Morris*, L. R. 1 Eq. 697; *Morris* v. *Wright*, L.R. 5 Ch. 279. The copy is the personal reaction of an individual upon nature. Personality always contains something unique. It expresses its singularity even in handwriting, and a very modest grade of art has in it something irreducible, which is one man's alone. That something he may copyright unless there is a restriction in the words of the act.

If there is a restriction it is not to be found in the limited pretensions of these particular works. The least pretentious picture has more originality in it than directories and the like, which may be copyrighted. Drone, Copyright, 153. See *Henderson* v. *Tomkins*, 60 Fed. Rep. 758, 765. The amount of training required for humbler efforts than those before us is well indicated by Ruskin. "If any young person, after being taught what is, in polite circles, called 'drawing,' will try to copy the commonest piece of real *work*,—suppose a lithograph on the title page of a new opera air, or a woodcut in the cheapest illustrated newspaper of the day,—they will find themselves entirely beaten." Elements of Drawing, 1st ed. 3. There is no reason to doubt that these prints in their *ensemble* and in all their details, in their design and particular combinations of figures, lines and colors, are the

original work of the plaintiffs' designer. If it be necessary, there is express testimony to that effect. It would be pressing the defendant's right to the verge, if not beyond, to leave the question of originality to the jury upon the evidence in this case, as was done in *Hegeman* v. *Springer*, 110 Fed. Rep. 374.

We assume that the construction of Rev. Stat. § 4952, allowing a copyright to the "author, inventor, designer, or proprietor . . . of any engraving, cut, print . . . [or] chromo" is affected by the act of 1874, c. 301, § 3, 18 Stat. 78, 79. That section provides that "in the construction of this act the words 'engraving,' 'cut,' and 'print' shall be applied only to pictorial illustrations or works connected with the fine arts." We see no reason for taking the words "connected with the fine arts" as qualifying anything except the word "works," but it would not change our decision if we should assume further that they also qualified "pictorial illustrations," as the defendant contends.

These chromolithographs are "pictorial illustrations." The word "illustrations" does not mean that they must illustrate the text of a book, and that the etchings of Rembrandt or Steinla's engraving of the Madonna di San Sisto could not be protected to-day if any man were able to produce them. Again, the act however construed, does not mean that ordinary posters are not good enough to be considered within its scope. The antithesis to "illustrations or works connected with the fine arts" is not works of little merit or of humble degree, or illustrations addressed to the less educated classes; it is "prints or labels designed to be used for any other articles of manufacture." Certainly works are not the less connected with the fine arts because their pictorial quality attracts the crowd and therefore gives them a real use -- if use means to increase trade and to help to make money. A picture is none the less a picture and none the less a subject of copyright that it is used for an advertisement. And if pictures may be used to advertise soap, or the theatre, or monthly magazines, as they are, they may be used to advertise a circus. Of course, the ballet is as legitimate a subject for illustration as any other. A rule cannot be laid down that would excommunicate the paintings of Degas.

Finally, the special adaptation of these pictures to the advertisement of the Wallace shows does not prevent a copyright. That may be a circumstance

for the jury to consider in determining the extent of Mr. Wallace's rights, but it is not a bar. Moreover, on the evidence, such prints are used by less pretentious exhibitions when those for whom they were prepared have given them up.

It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At the one extreme some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke. It may be more than doubted, for instance, whether the etchings of Goya or the paintings of Manet would have been sure of protection when seen for the first time. At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge. Yet if they command the interest of any public, they have a commercial value -- it would be bold to say that they have not an aesthetic and educational value -- and the taste of any public is not to be treated with contempt. It is an ultimate fact for the moment, whatever may be out hopes for a change. That these pictures had their worth and their success is sufficiently shown by the desire to reproduce them without regard to the plaintiffs' rights. See *Henderson* v. *Tomkins*, 60 Fed. Rep. 758, 765. We are of opinion that there was evidence that the plaintiffs have rights entitled to the protection of the law.

The judgment of the Circuit Court of Appeals is reversed; the judgment of the Circuit Court is also reversed and the cause remanded to that court with directions to set aside the verdict and grant a new trial.

Dissent

Mr. Justice Harlan, with whom concurred Mr. Justice McKenna, dissenting.

Judges Lurton, Day and Severens, of the Circuit Court of Appeals, concurred in affirming the judgment of the District Court. Their views were thus expressed in an opinion delivered by Judge Lurton: "What we hold is this: That if a chromo, lithograph, or other print, engraving, or picture has no other use than that of a mere advertisement, and no value aside from this

function, it would not be promotive of the useful arts, within the meaning of the constitutional provision, to protect the 'author' in the exclusive use thereof, and the copyright statute should not be construed as including such a publication, if any other construction is admissible. If a mere label simply designating or describing an article to which it is attached, and which has no value separated from the article, does not come within the constitutional clause upon the subject of copyright, it must follow that a pictorial illustration designed and useful only as an advertisement, and having no intrinsic value other than its function as an advertisement, must be equally without the obvious meaning of the Constitution. It must have some connection with the fine arts to give it intrinsic value, and that it shall have is the meaning which we attach to the act of June 18, 1874, amending the provisions of the copyright law. We are unable to discover anything useful or meritorious in the design copyrighted by the plaintiffs in error other than as an advertisement of acts to be done or exhibited to the public in Wallace's show. No evidence, aside from the deductions which are to be drawn from the prints themselves, was offered to show that these designs had any original artistic qualities. The jury could not reasonably have found merit or value aside from the purely business object of advertising a show, and the instruction to find for the defendant was not error. Many other points have been urged as justifying the result reached in the court below. We find it unnecessary to express any opinion upon them, in view of the conclusion already announced. The judgment must be affirmed." *Courier Lithographing Co.* v. *Donaldson Lithographing Co*., 104 Fed. Rep. 993, 996.

I entirely concur in these views, and therefore dissent from the opinion and judgment of this court. The clause of the Constitution giving Congress power to promote the progress of science and useful arts, by securing for limited terms to authors and inventors the exclusive right to their respective works and discoveries, does not, as I think, embrace a mere advertisement of a circus.

MR. JUSTICE MCKENNA authorizes me to say that he also dissents.

C. Mid-Century Modern, 1951-1967

C.1. Lead-in

These two cases – *Alfred Bell v. Catalda Fine Arts* (2d Cir. 1951) and *Morrissey v. Procter & Gamble* (1st Cir. 1967) – show copyrightability being pulled in different directions. Both are leading cases, and both are included in many casebooks. Each offers up some picturesque language. *Alfred Bell v. Catalda* has the "clap of thunder." *Morrissey* has the "game of chess."

C.2. Case: Alfred Bell v. Catalda Fine Arts (2d Cir. 1951)

Pre-reading notes

Authored by a famous and revered jurist, Judge Jerome Frank, the case of *Alfred Bell v. Catalda Fine Arts*, 191 F.2d 99 (2d Cir. 1951) stands for copyrightability as having an extremely low threshold for originality in authorship. That low bar is marked by the case's teaching that the even the jostle of a hand caused by a "clap of thunder" is enough to turn a mere copyist into an author.

Opinion

[Footnotes have been omitted, but not the footnote references. –Ed.]

Alfred Bell v. Catalda Fine Arts

United States Court of Appeals for the Second Circuit
191 F.2d 99 (1951)

FRANK, Circuit Judge.

1. Congressional power to authorize both patents and copyrights is contained in Article 1, Sec. 8 of the Constitution.[1] In passing on the validity of patents, the Supreme Court recurrently insists that this constitutional provision governs. On this basis, pointing to the Supreme Court's consequent requirement that, to be valid, a patent must disclose

a high degree of uniqueness, ingenuity and inventiveness, the defendants assert that the same requirement constitutionally governs copyrights. As several sections of the Copyright Act – e.g., those authorizing copyrights of 'reproductions of works of art,' maps, and compilations – plainly dispense with any such high standard, defendants are, in effect, attacking the constitutionality of those sections. But the very language of the Constitution differentiates (a) 'authors' and their 'writings' from (b) 'inventors' and their 'discoveries.' Those who penned the Constitution,[2] of course, knew the difference. The pre-revolutionary English statutes had made the distinction.[3] In 1783, the Continental Congress had passed a resolution recommending that the several states enact legislation to 'secure' to authors the 'copyright' of their books.[4] Twelve of the thirteen states (in 1783-1786) enacted such statutes.[5] Those of Connecticut and North Carolina covered books, pamphlets, maps, and charts.[6]

Moreover, in 1790, in the year after the adoption of the Constitution, the first Congress enacted two statutes, separately dealing with patents and copyrights. The patent statute, enacted April 10, 1790, 1 Stat. 109, provided that patents should issue only if the Secretary of State, Secretary of War and the Attorney General, or any two of them 'shall deem the invention or discovery sufficiently useful and important'; the applicant for a patent was obliged to file a specification 'so particular' as 'to distinguish the invention or discovery from other things before known and used '; the patent was to constitute prima facie evidence that the patentee was 'the first and true inventor or discoverer of the thing so specified.'[7] The Copyright Act, enacted May 31, 1790, 1 Stat. 124, covered 'maps, charts, and books'. A printed copy of the title of any map, chart or book was to be recorded in the Clerk's office of the District Court, and a copy of the map, chart or book was to be delivered to the Secretary of State within six months after publication. Twelve years later, Congress in 1802, 2 Stat. 171, added, to matters that might be copyrighted, engravings, etchings and prints.

Thus legislators peculiarly familiar with the purpose of the Constitutional grant by statute, imposed far less exacting standards in the

case of copyrights. They authorized the copyrighting of a mere map which, patently, calls for no considerable uniqueness. They exacted far more from an inventor. And, while they demanded that an official should be satisfied as to the character of an invention before a patent issued, they made no such demand in respect of a copyright. In 1884, in Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53, 57, the Supreme Court, adverting to these facts said: 'The construction placed upon the constitution by the first act of 1790 and the act of 1802, by the men who were contemporary with its formation, many of whom were members of the convention which framed it, is of itself entitled to very great weight, and when it is remembered that the rights thus established have not been disputed during a period of nearly a century, it is almost conclusive.' Accordingly, the Constitution, as so interpreted, recognizes that the standards for patents and copyrights are basically different.

The defendants' contention apparently results from the ambiguity of the word 'original'. It may mean startling, novel or unusual, a marked departure from the past. Obviously this is not what is meant when one speaks of 'the original package,' or the 'original bill,' or (in connection with the 'best evidence' rule) an 'original' document; none of those things is highly unusual in creativeness. 'Original' in reference to a copyrighted work means that the particular work 'owes its origin' to the 'author.'[8] No large measure of novelty is necessary. Said the Supreme Court in Baker v. Selden, 101 U.S. 99, 102-103: '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.'

In Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, 250 252, the Supreme Court cited with approval Henderson v. Tompkins, C.C., 60 F. 758, where it was said, 60 F.at page 764: 'There is a very broad distinction between what is implied in the word 'author,' found in the constitution, and the word 'inventor.' The latter carries an implication which excludes the results of only ordinary skill, while nothing of this is necessarily involved in the former. Indeed, the statutes themselves make broad distinctions on this point. So much as relates to copyrights is expressed, so far as this particular is concerned, by the mere words, 'author, inventor, designer or proprietor,' with such aid as may be derived from the words 'written, composed or made,' . But a multitude of books rest safely under copyright, which show only ordinary skill and diligence in their preparation. Compilations are noticeable examples of this fact. With reference to this subject, the courts have not undertaken to assume the functions of critics, or to measure carefully the degree of originality, or literary skill or training involved.'[9]

It is clear, then, that nothing in the Constitution commands that copyrighted matter be strikingly unique or novel. Accordingly, we were not ignoring the Constitution when we stated that a 'copy of something in the public domain' will support a copyright if it is a 'distinguishable variation';[10] or when we rejected the contention that 'like a patent, a copyrighted work must be not only original, but new', adding, 'That is not the law as is obvious in the case of maps or compendia, where later

works will necessarily be anticipated.'[11] All that is needed to satisfy both the Constitution and the statute is that the 'author' contributed something more than a 'merely trivial' variation, something recognizably 'his own.'[12] Originality in this context 'means little more than a prohibition of actual copying.'[13] No matter how poor artistically the 'author's' addition, it is enough if it be his own. Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, 250.

On that account, we have often distinguished between the limited protection accorded a copyright owner and the extensive protection granted a patent owner. So we have held that 'independent reproduction of a copyrighted work is not infringement',[14] whereas it is vis a vis a patent. Correlative with the greater immunity of a patentee is the doctrine of anticipation which does not apply to copyrights: The alleged inventor is chargeable with full knowledge of all the prior art, although in fact he may be utterly ignorant of it. The 'author' is entitled to a copyright if he independently contrived a work completely identical with what went before; similarly, although he obtains a valid copyright, he has no right to prevent another from publishing a work identical with his, if not copied from his. A patentee, unlike a copyrightee, must not merely produce something 'original'; he must also be 'the first inventor or discoverer.'[15] 'Hence it is possible to have a plurality of valid copyrights directed to closely identical or even identical works. Moreover, none of them, if independently arrived at without copying, will constitute an infringement of the copyright of the others.'[16]

The difference between patents and copyrights is neatly illustrated in the design patent cases.[17] We have held that such a patent is invalid unless it involves 'a step beyond the prior art', including what is termed 'inventive genius.' A.C. Gilbert Co. v. Shemitz, 2 Cir., 45 F.2d 98, 99. We have noted that, as in all patents, there must be a substantial advance over the prior art. Neufeld-Furst & Co. v. Jay-Day Frocks, 2 Cir.,112 F.2d 715, 716. We have suggested that relief for designers could be obtained if they were permitted to copyright their designs, and that, until there is an amendment to the copyright statute, 'new designs are open to all, unless

their production demands some salient ability.' Nat Lewis Purses v. Carole Bars, 2 Cir., 83 F.2d 475, 476. We have noted that if designers obtained such a statute, it would give them 'a more limited protection and for that reason easier to obtain. ' White v. Leanore Frocks, Inc., 2 Cir.,120 F.2d 113, 115.[18]

2. We consider untenable defendants' suggestion that plaintiff's mezzotints could not validly be copyrighted because they are reproductions of works in the public domain. Not only does the Act include 'Reproductions of a work or art',[19] but- while prohibiting a copyright of 'the original text of any work in the public domain'[20] - it explicitly provides for the copyrighting of 'translations, or other versions of works in the public domain'.[21] The mezzotints were such 'versions.' They 'originated' with those who make them, and- on the trial judge's findings well supported by the evidence- amply met the standards imposed by the Constitution and the statute.[22] There is evidence that they were not intended to, and did not, imitate the paintings they reproduced. But even if their substantial departures from the paintings were inadvertent, the copyrights would be valid.[23] A copyist's bad eyesight or defective musculature, or a shock caused by a clap of thunder, may yield sufficiently distinguishable variations.[24] Having hit upon such a variation unintentionally, the 'author' may adopt it as his and copyright it.[25]

Accordingly, defendants' arguments about the public domain become irrelevant. They could be relevant only in their bearing on the issue of infringement, i.e., whether the defendants copied the mezzotints.[26] But on the findings, again well grounded in the evidence, we see no possible doubt that defendants, who did deliberately copy the mezzotints, are infringers. For a copyright confers the exclusive right to copy the copyrighted work- a right not to have others copy it. Nor were the copyrights lost because of the reproduction of the mezzotints in catalogues.[27]

3. We think the defendants did not establish the anti-trust 'unclean-hands' defense: (1) The Guild's price-fixing provision was explicitly confined to Great Britain and Ireland, and did not affect sales in the

United States. (2) As to the Guild agreement to restrict output,[28] there are some considerations: Of some 600 or 700 members, according to the testimony only 'one or two' are in this country, for all that the slender proof shows, their participation in Guild activities may have been limited to the receipt of Guild catalogues; the plaintiff has no office or assets here, and there is no evidence that it acted here on behalf of the Guild. So far as the evidence discloses, the output restriction was not imposed with sales in the United States in mind. Accordingly, we take it that the restriction was meant to have, and did have, at most, only an incidental, peripheral, reference to sales in the United States of America.[29] All the foregoing is important since recently the Supreme Court, in similar contexts, has given the 'unclean hands' doctrine a somewhat narrowed scope. Kiefer-Stewart Co. v. Joseph E. Seagram & Sons, Inc., 340 U.S. 211, 214,[30] . We have here a conflict of policies: (a) that of preventing piracy of copyrighted matter and (b) that of enforcing the anti-trust laws. We must balance the two, taking into account the comparative innocence or guilt of the parties, the moral character of their respective acts, the extent of the harm to the public interest, the penalty inflicted on the plaintiff if we deny it relief. As the defendants' piracy is unmistakably clear, while the plaintiffs' infraction of the anti-trust laws is doubtful and at most marginal, we think the enforcement of the first policy should outweigh enforcement of the second.[31]

4. The trial judge did not 'abuse' his discretion as to the allowance or amount of attorneys' fees. We agree with his rulings, and his reasons therefor, concerning the items of accounting for profits- with but one exception: We think he erred in allowing defendants to deduct their income taxes. He said, 'The nature of defendants' acts is, of course darkened somewhat by the use of a false copyright label, by sales after notice, and by the defendant Lithograph's apparent unconcern over the validity of the plaintiff's copyright, so long as defendants Catalda Company and Catalda were willing to indemnify Lithograph'; he also said that defendants 'were not innocent of knowledge of the claimed copyright by the plaintiff of the subjects in suit.' Nevertheless, he held that

'their villainy is not of the deepest dye in that the copying was open, and with no attempt at concealment, under a good-faith claim of a right to copy because of the claimed invalidity of the plaintiff's copyright.' With that last conclusion we disagree. Open and unabashed piracy is not a mark of good faith; and we think the 'claimed invalidity' unjustified.[32] In these circumstances, the deduction of the taxes was improper.[33] To that extent only, the judgment is modified; otherwise it is affirmed.

C.3. Case: Morrissey v. P&G (1st Cir. 1967)

Pre-reading notes

This case goes in a completely different direction than *Alfred Bell*. The plaintiff loses their bid to protect their creation through copyright. Not a thunder-clap jostle, nor quite a bit more, will seem to do. In pushing back on easy copyrightability, the *Morrissey* court seems to suggest it is protecting the public from the well-lawyered and the powerful. And maybe so. But this is a one of those little-guy-versus-big-guy cases. A very little guy, in fact, versus a very, very big guy – the mighty Proctor & Gamble, the king of soap and the creator of the disposable diaper, in the prime of its corporate life. And the little guy lost.

Opinion

Morrissey v. Procter & Gamble

United States Court of Appeals for the First Circuit
379 F.2d 675 (1967)

Frank Morrissey, plaintiff and appellant.
The Procter & Gamble Company et al., defendants and appellees.
Before ALDRICH, Chief Judge, McENTEE and COFFIN, Circuit Judges.

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.[1]

> [1] The court did not discuss, nor need we, the additional fact that the almost exact following of plaintiff's wording and format in an area in which there is at least some room for maneuverability, might be found of itself to contradict defendant's denial of access. Cf. Arnstein v. Porter, supra.

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; see Magnat Corp. v. B & B Electroplating Co., 1 Cir., 1966, 358 F.2 794. We have never suggested that such a principle is applicable to a motion for summary judgment, and we do not now.[2] Cf. Robbins v. Milner Enterprises, Inc., 5 Cir., 1960, 278 F.2d 492, 496-497.

> [2] Defendant seeks to attach weight to thirteen letters introduced through its witness who testified he had received them from thirteen other companies in contradiction of plaintiff's testimony that he had sent copies of his rules to them, as well as to the defendant. In the first place, in spite of defendant's elaborate argument, the letters so introduced were rank hearsay as to the truth of their content, in contravention to Rule 56's fundamental requirement that the party's position be sustained by competent and admissible evidence. Fed.R.Civ.P. 56(e). But even more elementary, had they been admissible affidavits of thirteen bishops they could not have varied the principle that issues of fact are not to be resolved on summary judgment.

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}

> '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.'

(Plaintiff's Rule)

{Defendant Proctor & Gamble's Rule 1:}

> '1. Entrants should print name, address and *S*ocial *S*ecurity 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 *S*ocial *S*ecurity 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.'

(Defendant's Rule)

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; 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 ('a stiff standard for proof of infringement.').

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.

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D. Can I Have Your Number? 1990s

D.1. Lead-in

Next is a triplet of cases from the 1990s that all revolve around claims of copyright to numbers – phone numbers, dental procedure codes, and page numbers.

In each case, the facts follow this three-act pattern: Some company (the future plaintiff) assigns the numbers; the numbers then become important because they are crucial to some kind of system that large numbers of people use and depend on; some other company (the soon-to-be-defendant) wants to use the numbers to offer some new service, connected with the system, that offers some new usefulness and value but that the first entity regards as a threat.

The first case is arguably the single most important case in modern copyright jurisprudence: *Feist v. Rural* (U.S. 1991). A copyright infringement claim over phone numbers was rebuffed by the U.S. Supreme Court. Originality was lacking, the court said. Also, the deservingness of the phone company – its hard work and investment in compiling the information and assigning the numbers (aka "sweat of the brow" theory) – was irrelevant to copyrightability.

The next two cases hit the courts soon afterward. They aren't far off in terms of the facts, but they went in different directions from one another. In *ADA v. Delta Dental* (7th Cir. 1997), dental billing codes were held protectable by copyright. In the Star Pagination Case (*Matthew Bender v. West*) (2d Cir. 1998), Westlaw lost its bid to stop rivals – including Lexis – from copying the page numbers in federal court cases it published.

D.2. Case: Feist v. Rural (U.S. 1991)

Pre-reading notes

In *Feist v. Rural,* a small, local phone company – Rural Telephone Service – published a small, local phone book with the names and numbers of its customers. An enterprising publishing company – Feist Publications – copied the numbers out of Rural's directory to help build a competing region-wide phone book. Feist felt it was offering something customers would value: a

phone book that covers not just one locality but also neighboring communities tied together with overlapping business and social relationships.

The local telephone company Rural lost its copyright infringement case against the area-wide publisher Feist.

The U.S. Supreme Court's opinion is hugely important. It is almost impossible to overstate how much *Feist* is looked to and relied upon in defining the basic concepts of copyrightability and drawing its outer boundaries. In particular, Feist is the parapet defending American copyrightability doctrine against its most persistent challenging foe: the "sweat of the brow" theory.

"Sweat of the brow" is shorthand for the argument "I worked hard or invested considerable time and effort into making or putting this together, so I ought to own it."

The *Feist* court's response, if translated and condensed into country-music lyrics, would be: "Here's a quarter, call someone who cares."

Opinion

Feist v. Rural

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

Feist Publications, Inc. v. Rural Telephone Service Co., Inc.
O'Connor, J., delivered the opinion of the Court, in which Rehnquist, C. J., and White, Marshall, Stevens, Scalia, Kennedy, and Souter, JJ., joined.
Blackmun, J., concurred in the judgment.

Justice Sandra Day O'CONNOR:

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. 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 "courts 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." We granted certiorari 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 "no 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 "facts and discoveries, of course, are not themselves subject to copyright protection." 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 "secure 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." The Court explained that originality requires independent creation plus a modicum of creativity: "While 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."

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] ("Originality 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. "They 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: "No matter how much original authorship the work displays, the facts and ideas it exposes are free for the taking. ... The 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 "to promote the Progress of Science and useful Arts." Art. I, § 8, cl. 8.¶

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*:

> "No 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.
>
> "Copyright 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.

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.˜ 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.˜

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).˜ 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.˜ A subsequent compiler was "not entitled to take one word of information previously published," but rather had to "independently work out the matter for himself, so as to arrive at the same result from the same common sources of information." *Id.*, at 88-89. "Sweat of the brow" courts thereby eschewed the most fundamental axiom of copyright law – that no one may copyright facts or ideas.˜

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.˜ {The Court} flatly rejected, however, the notion that the copyright in an article extended to the factual information it contained: "The news element – the information respecting current events contained in the literary production – is not the creation of the writer˜"*

* The Court ultimately rendered judgment for Associated Press on non-copyright grounds that are not relevant here.

Without a doubt, the "sweat of the brow" doctrine flouted basic copyright principles. Throughout history, copyright law has "recognized a greater need to disseminate factual works than works of fiction or fantasy." *Harper & Row*, 471 U.S., at 563.˜ 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, "it 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.

C

"Sweat of the brow" decisions did not escape the attention of the Copyright Office. When Congress decided to overhaul the copyright statute and asked the Copyright Office to study existing problems, the Copyright Office promptly recommended that Congress clear up the confusion in the lower courts as to the basic standards of copyrightability.˜ The Register suggested making the originality requirement explicit.

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.).˜

Congress took another step to minimize confusion by deleting the specific mention of "directories ... and other compilations" in § 5 of the 1909 Act.˜ 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 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 straight-forward 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.˜ 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").˜

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 "the subject matter of copyright ... includes compilations," § 103(a), but˜:

> "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.˜

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.˜

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.

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 "'owe 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 "rules 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. 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. 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. {C}opyright 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.

D.3. Case: ADA v. Delta Dental (7th Cir. 1997)

Pre-reading notes

This case, *American Dental Association v. Delta Dental,* is one of several cases that came along after *Feist* that have involved disputes over systems of numbers . They involve things like dental records codes, page numbers, and automotive part numbers. In all of them, *Feist* obviously looms extremely large as on-point precedent. Yet, interestingly, the cases come out in different ways.

What this means is up for debate. Are the facts of the cases different enough to require different outcomes? Is it that lower courts are inconsistent or sometimes faulty in their analysis and application of *Feist*? Is it that *Feist* is unclear? Is it that, despite *Feist*'s teaching, lower courts continue to be drawn in the direction of the "sweat of the brow"? (Of course, it could be more than one of those. Or all of them. Or maybe something else entirely.)

Consider at least this piece of advice to you as a law-student/lawyer: When it comes to edge cases, it's wise to at least pay attention to the different theory/policy concerns and to consider how they can play into building a persuasive set of arguments for one side or the other.

In this case, the American Dental Association (or "ADA" as they are known on toothpaste tubes) won its battle against Delta Dental – an insurance / dental benefits provider – that the ADA's system of dental procedure codes, used for patient records and billing, was copyrightable subject matter.

Opinion

[In the service of readability and brevity: Text was moved, and the superscript commat @ (aka "at symbol") indicates such points of discontinuity. Paragraph breaks were inserted, and the superscript pilcrow ¶ indicates these. Some citations or portions thereof were removed without notation. Typographical aspects were cleaned up and/or standardized. – Ed.]

ADA v. Delta Dental

United States Court of Appeals for the Seventh Circuit
126 F.3d 977 (7th Cir. 1997)

American Dental Association, Plaintiff-Appellant, v. Delta Dental Plans Association, Defendant-Appellee. Appeal from the United States District Court for the Northern District of Illinois, Eastern Division. James B. Zagel, Judge. No. 92 C 5909.
Before Easterbrook, Ripple, and Manion, Circuit Judges.

Easterbrook, *Circuit Judge*.

This case presents the question whether a taxonomy is copyrightable. The American Dental Association has created the *Code on Dental Procedures and Nomenclature.* The first edition was published in 1969; the Code has been revised frequently since, in response to changes in dental knowledge and technology. All dental procedures are classified into groups; each procedure receives a number, a short description, and a long description. For example, number 04267 has been assigned to the short description "guided tissue regeneration – nonresorbable barrier, per site, per tooth (includes membrane removal)", which is classified with other surgical periodontic services.¶

The Code made its first appearance in the *Journal of the American Dental Association,* covered by a general copyright notice; the 1991 and 1994 versions were submitted for copyright registration, which was granted by the Register of Copyrights. Delta Dental Association has published a work entitled *Universal Coding and Nomenclature* that includes most of the numbering system and short descriptions from the ADA's Code.¶

In this suit for copyright infringement, Delta contends that it is entitled to reprint modified versions of the Code under an express or implied license, as a joint author (Delta participated in the groups that drafted the Code), and as fair use. It contends that by distributing pamphlets containing some of the Code's older versions without copyright notices the ADA has forfeited its copyright.¶

Delta also argues that the Code is not copyrightable subject matter, and the district court granted summary judgment in its favor on this ground without reaching Delta's other arguments.@ {This court vacates the judgment because it concludes the ADA's Code is copyrightable subject matter.} Whether there are other obstacles to the relief the ADA seeks is a subject best left to the district court in the first instance.@

The district court held that the Code cannot be copyrighted because it catalogs a field of knowledge – in other words, that no taxonomy may be copyrighted. A comprehensive treatment cannot be selective in scope or arrangement, the judge believed, and therefore cannot be original either. Taxonomies are designed to be useful. The judge wrote that if "nothing

remains after the 'useful' is taken away – if the primary function is removed from the form – the work is devoid of even that modicum of creativity required for protection, and hence is uncopyrightable."¶

No one would read the ADA's Code for pleasure; it was designed and is used for business (for records of patients' dental history or making insurance claims) rather than aesthetic purposes. The district court added that, as the work of a committee, the Code could not be thought original. Creation by committee is an oxymoron, the judge wrote.

The sweep of the district court's reasoning attracted the attention of many other suppliers of taxonomies. The American Medical Association, the American National Standards Institute, Underwriters Laboratories, and several other groups have filed a brief as *amici curiae* to observe that they, too, produce catalogs of some field of knowledge and depend on the copyright laws to enable them to recover the costs of the endeavor. Other groups or firms might say the same. The manuals issued by the Financial Accounting Standards Board to specify generally accepted accounting practices could not be copyrighted. Nor could the tests and answers devised by the Educational Testing Service. The district court's reasoning logically removes copyright protection from the West Key Number System, which is designed as a comprehensive index to legal topics, and *A Uniform System of Citation* (the *Bluebook*), a taxonomy of legal sources. Very little computer software could receive a copyright if the district judge is correct: no one reads, for pleasure, the source or object code of the word processing program on which this opinion was written, or of the operating system that runs the computer: take away the "useful" elements and these endeavors are worthless. Worse, most commercial software these days is written by committee, and authors receive less public credit than the gaffers on a movie set, whose names at least scroll by at the end after the audience has turned its collective back to head up the aisles. Blueprints for large buildings (more committee work), instruction manuals for repairing automobiles, used car value guides, dictionaries, encyclopedias, maps – all these, and many more, would flunk the district court's test of originality. Yet these items are routinely copyrighted, and challenges to the validity of these copyrights are routinely rejected. E.g., *Educational Testing Services v. Katzman,* 793 F.2d

533 (3d Cir. 1986) (Scholastic Aptitude Test); *CCC Information Services, Inc. v. Maclean Hunter Market Reports, Inc.,* 44 F.3d 61 (2d Cir. 1994) (list of used-car prices); *Lipton v. Nature Co.,* 71 F.3d 464 (2d Cir. 1995) (terms describing groups of animals). See also 17 U.S.C. § 101 (including "architectural plans" within the definition of "pictoral, graphic and sculptural works" that are copyrightable); Paul Goldstein, *Copyright: Principles, Law and Practice* § 2.15.2 (1989) (discussing copyright protection for computer programs). The American Medical Association's copyright in the *Physician's Current Procedural Terminology,* its catalog of medical procedures, was recently sustained, although against a challenge different from the district court's rationale. *Practice Management Information Corp. v. American Medical Association,* 121 F.3d 516 (9th Cir. 1997), slip op. 9323-27. Maps and globes are not only copyrightable, see *Rockford Map Publishers, Inc. v. Directory Service Co*., 768 F.2d 145 (7th Cir. 1985), but also constituted two-thirds of the original scope of copyright. The Copyright Act of 1790 specified three protectable items: maps, charts, and books. Act of May 31, 1790, 1 Stat. 124. Like taxonomies, maps are valued to the extent they offer useful organizations of facts; like the Code, maps are produced by committees. (As are opinions of appellate courts, which despite this handicap, and the judges' effort to produce something useful, might occasionally have a modicum of originality.)

Any original literary work may be copyrighted. The necessary degree of "originality" is low, and the work need not be aesthetically pleasing to be "literary." *Feist Publications, Inc v. Rural Telephone Service Co.,* 499 U.S. 340, 345-46 (1991). Term papers by college sophomores are as much within the domain of copyright as Saul Bellow's latest novel. See *Bleistein v. Donaldson Lithographing Co.,* 188 U.S. 239 (1903). Scholarship that explicates important facts about the universe likewise is well within this domain. Einstein's articles laying out the special and general theories of relativity were original works even though many of the core equations, such as the famous E = mc2, express "facts" and therefore are not copyrightable. Einstein could have explained relativity in any of a hundred different ways; another physicist could expound the same principles differently.

So too with a taxonomy – of butterflies, legal citations, or dental procedures. Facts do not supply their own principles of organization. Classification is a creative endeavor. Butterflies may be grouped by their color, or the shape of their wings, or their feeding or breeding habits, or their habitats, or the attributes of their caterpillars, or the sequence of their DNA; each scheme of classification could be expressed in multiple ways. Dental procedures could be classified by complexity, or by the tools necessary to perform them, or by the parts of the mouth involved, or by the anesthesia employed, or in any of a dozen different ways. The Code's descriptions don't "merge with the facts" any more than a scientific description of butterfly attributes is part of a butterfly. Cf. *Nash v. CBS, Inc.,* 899 F.2d 1537 (7th Cir. 1990) (discussing the fact expression dichotomy). There can be multiple, and equally original, biographies of the same person's life, and multiple original taxonomies of a field of knowledge. Creativity marks the expression even after the fundamental scheme has been devised. This is clear enough for the long description of each procedure in the ADA's Code. The long description is part of the copyrighted work, and original long descriptions make the work as a whole copyrightable. But we think that even the short description and the number are original works of authorship.

Number 04267 reads "guided tissue regeneration – nonresorbable barrier, per site, per tooth" but could have read "regeneration of tissue, guided by nonresorbable barrier, one site and tooth per entry". Or "use of barrier to guide regeneration of tissue, without regard to the number of sites per tooth and whether or not the barrier is resorbable". The first variation is linguistic, the second substantive; in each case the decision to use the actual description is original to the ADA, not knuckling under to an order imposed on language by some "fact" about dental procedures. Blood is shed in the ADA's committees about which description is preferable. The number assigned to any one of the three descriptions could have had four or six digits rather than five; guided tissue regeneration could have been placed in the 2500 series rather than the 4200 series; again any of these choices is original to the author of a taxonomy, and another author could do things differently. Every number in the ADA's Code begins with zero, assuring a large supply of unused numbers for procedures to be devised or reclassified in the future; an author could have elected instead to leave wide gaps inside the sequence.

A catalog that initially assigns 04266, 04267, 04268 to three procedures will over time depart substantively from one that initially assigns 42660, 42670, and 42680 to the same three procedures. So all three elements of the Code – numbers, short descriptions, and long descriptions, are copyrightable subject matter under 17 U.S.C. § 102(a). The *Maroon Book* and the *Bluebook* offer different taxonomies of legal citations; Wotquenne and Helm devised distinct catalogs of C.P.E. Bach's oeuvre; Delta Dental Association could have written its own classification of dental procedures.

Note that we do *not* conclude that the Code is a compilation covered by 17 U.S.C. § 103. It could be a compilation only if its elements existed independently and the ADA merely put them in order. A taxonomy is a way of *describing* items in a body of knowledge or practice; it is not a collection or compilation *of* bits and pieces of "reality". The 1991 and 1994 versions of the Code may be recompilations of earlier editions, but the original Code is covered by § 102(a) as an "original work of authorship", and its amendments by § 106(2) as derivative works.

The district court's contrary conclusion instantiates the adage that where you come out depends on where you go in. The court asked whether the Code would be copyrightable if it were a lamp. This is not quite as foolish as it sounds. Congress permits works of art, including sculptures, to be copyrighted, but does not extend the copyright to industrial design, which in the main falls into the province of patent, trademark, or trade dress law. See 17 U.S.C. §§ 101, 102(a)(5), 113; *W.T. Rogers Co. v. Keene,* 778 F.2d 334 (7th Cir. 1985). When the maker of a lamp – or any other three-dimensional article that serves some utilitarian office – seeks to obtain a copyright for the item as a sculpture, it becomes necessary to determine whether its artistic and utilitarian aspects are separable. If yes, the artistic elements of the design may be copyrighted; if no, the designer must look outside copyright law for protection from imitation. Compare *Hart v. Dan Chase Taxidermy Supply Co.,* 86 F.3d 320 (2d Cir. 1996), which holds that fish mannequins may be copyrighted if they possess artistic features separable from their utilitarian aspects, with *Carol Barnhart Inc. v. Economy Cover Corp.,* 773 F.2d 411 (2d Cir. 1985), which holds that mannequins of human torsos may not be copyrighted. Judge Zagel applied to the ADA's Code the same approach

courts use for three-dimensional articles, found that the Code has no expression separable from its utilitarian aspects, and held that it therefore may not be copyrighted.

Such an inquiry mixes two distinct issues: originality and functionality. A lamp may be entirely original, but if the novel elements are also functional the lamp cannot be copyrighted. This is not a line between intellectual property and the public domain; it is a line among bodies of intellectual-property law. An article with intertwined artistic and utilitarian ingredients may be eligible for a design patent, or the artistic elements may be trade dress protected by the Lanham Act or state law. Yet the district court did not set out to mark the boundaries among copyright, patent, trademark, and state law. Anyway, to restate the obvious, the Code is not a sculpture. The ADA does not make any claim to its protection as a "pictorial, graphic, [or] sculptural" work under § 102(a)(5), and the unique limitations on the protection of that category of works do not extend to the written word. Not only are the issues different – original is not an antonym for utilitarian – but the special question under § 102(a)(5) and § 113 is not one that should be extended. "Of the many fine lines that run through the Copyright Act, none is more troublesome than the line between protectable pictorial, graphic and sculptural works and unprotectible utilitarian elements of industrial design." Goldstein, § 2.5.3 at 99 (footnote omitted). Whether a literary work is original ought to be a question easy to pose and easy to answer, so that people know the status of their intellectual property; it ought not be complicated with a test designed for a completely different problem.

Delta asks us to affirm the judgment on a ground that the district judge did not reach: that the Code is not copyrightable because it is a "system." Section 102(b) tells us that copyright protection even of an original work does not cover "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 what could it mean to call the Code a "system"? This taxonomy does not come with instructions for use, as if the Code were a recipe for a new dish. Cf. *Publications International, Ltd. v. Meredith Corp.,* 88 F.3d 473 (7th Cir. 1996) (holding that recipes are not copyrightable). A dictionary cannot be

called a "system" just because new novels are written using words, all of which appear in the dictionary. Nor is word-processing software a "system" just because it has a command structure for producing paragraphs. The Code is a taxonomy, which may be put to many uses. These uses may be or include systems; the Code is not.

Section 102(b) codifies the fact-expression dichotomy, which we have already considered, as well as the holding of *Baker v. Selden,* 101 U.S. 99 (1879), that blank forms are not copyrightable, even if the structure of the forms captures the essence of an original work of literature. The book was protected as original literary expression, the Court held, but the form was a means of putting the book's ideas into practice – and copyright law, unlike patent law, covers only expression. Someone who buys a book full of ideas for new machines may build and sell one of the machines without infringing the author's copyright; Baker thought that the use of an accounting system described in a book is pretty much the same thing, even if practice of the system entails use of the author's forms. Baker rearranged Selden's forms, but if the original forms were copyrightable then the rearrangements were derivative works, which the original author had an exclusive right to produce. Protecting variations on the forms could have permitted the author of an influential accounting treatise to monopolize the practice of double-entry bookkeeping. Yet copyright law does not permit the author to monopolize the revenues to be derived from an improved system of accounting – or of reporting dental procedures. See William M. Landes & Richard A. Posner, *An Economic Analysis of Copyright Law,* 17 J. Legal Studies 325, 350-53 (1989).

Few "how-to" works are "systems" in *Baker*'s sense.˜ Descriptions of how to build or do something do not facilitate monopoly of the subject-matter being described, so the concern of *Baker* is not activated.˜ What is more, a form that contains instructions for its completion is copyrightable in part (the instructions) and in the public domain in part (the lines and boxes). *Edwin K. Williams & Co. v. Edwin K. Williams & Co.-East,* 542 F.2d 1053, 1061 (9th Cir. 1976); Goldstein at § 2.15.1.b. So far as the ADA is concerned, any dentist, any insurer, anyone at all, may devise and use forms into which the Code's descriptions may be entered. The ADA encourages this use;

standardization of language promotes interchange among professionals. (The fact that Delta used most of the Code but made modifications is the reason ADA objects, for variations salted through a convention impede communication.) Section 102(b) precludes the ADA from suing, for copyright infringement, a dentist whose office files record treatments using the Code's nomenclature. No field of practice has been or can be monopolized, given this constraint. Section 102(b) permits Delta Dental to disseminate forms inviting dentists to use the ADA's Code when submitting bills to insurers. But it does not permit Delta to copy the Code itself, or make and distribute a derivative work based on the Code, any more than Baker could copy Selden's book.

D.4. Case: The "Star Pagination Case" (Matthew Bender v. West), (2d Cir. 1998)

Pre-reading notes

Quick sketch

In this case, legal publisher West (aka Westlaw) tried and failed to use copyright to prevent rival publishers from copying the page numbers that West assigned when it originally published court opinions.

As West's book series functioned as the standard, long-relied-upon source for a large portion of American caselaw, the use of the page numbers within West's books had become effectively impossible to do without for lawyers and courts. Court rules and citation style manuals variously required referencing West's page numbers. And even when not required by rule, the page numbers were a practical necessity for a later case or commentary to talk effectively about a case that had come before.

All of that was, it seems, neither here nor there until new digital technologies came along – namely internet connectivity and digital storage of large volumes of text on compact, durable, inexpensive media (i.e., CD-ROM discs). These new technologies provided a pathway for competing publishers to offer access to the same cases without bulky expensive paper-based books and with the added functionality of clickable hyperlinks and computer-mediated searches for words and phrases. At that point, the legal battle over the page numbers erupted.

Psych up

This is a case that's fascinating for a lot of reasons – starting with the fact that every U.S. law student has ineluctably been swimming around in the facts of this case since the first weeks of law school.

That being said, this case is complicated.

To fully appreciate it, and to head off some needless frustration, more than the usual amount of pre-reading notes are in order.

To really understand what's going on here, it's very helpful to have some background information – at least regarding two topics. One is where this opinion fits into a complex web of litigation involving the parties ("Litigation context") . The other ("The legal publishing business") provides a background

on the industry from which this litigation springs. It's not only helpful to understanding the case and its importance, but every U.S. law student should have some appreciable understanding of the history legal publishing in the UK and USA, and the role of publishing in the functioning of the legal system.

Following that background, some final pre-reading notes attempt to help the reader avoid frustration by contextualizing some of what makes this case so legally and factually complicated.

Litigation context

This case – the "Star Pagination Case" is one of two appellate opinions issued on the same day by the same court with the same caption: "*Matthew Bender & Company, Inc. v. West Publishing Co.*"

West was the long-running publisher of the de facto standard set of books (*Federal Reporter* and *Federal Supplement*) containing judicial opinions of the federal courts other than the U.S. Supreme Court. West's publication series of U.S. Supreme Court opinions, *Supreme Court Reporter*, also was very important, though at least there West's series was less important in the sense that the federal government itself printed the Supreme Court's opinions in an "official" reporter series, *United States Reports.*

Given the centrality of West's book series, when practicing before the federal courts and citing to case law, use of the West reporter volumes was essential.

West's electronic database product, carrying the text of the West reporter volumes, was launched as "Westlaw." Matthew Bender – soon to be absorbed into Lexis – had its own electronic database business and wanted to offer the text of federal cases from the West reporter volumes. Another company, and upstart called Hyperlaw, also entered the fray.

In the "Star Pagination Case," which is reproduced below, Matthew Bender (Lexis) sought a judgment that it could include numbers indicating the pagination of the cases in the West reporter volumes without copyright liability.

In the other case – the "Case Enhancements Case" – Matthew Bender (Lexis) sought a judgment that it could include certain enhancements to the cases added by West – "parallel citations" to cases cited in the text (i.e., pointers to where to find the same case in the volumes of a different publisher),

identity of the attorneys representing the litigants, and where included, information on the case's subsequent procedural history.

Both the Star Pagination Case and the Case Enhancements Case came out in favor of Matthew Bender (Lexis) and against West.

The legal publishing business

It is a feature of the Anglo-American common-law tradition that the common law develops slowly and accretively with no pre-planned structure.

Courts don't affirmatively venture forth to do anything. They wait for a matter to come through the door, and then the court does what it must to dispose of that matter. The common law is very keen on knowing where it's been, but it doesn't much care about where it's going.

The sprawl and lack of anticipating future needs is reflected in the historical development of the publication of court opinions. While Anglo-American courts are keen to access past decisions, the courts historically showed little interest in making arrangements for opinions of the present to be accessible to courts in the future. Thus it is that in the evolving practices of courts and lawyers, the cataloging and publication of court opinions as they were issued generally was taken up by entrepreneurs. There's an extremely long history of rulers, legislatures, and government ministries undertaking the business of printing and distributing their edicts. But the sorting and printing of judicial opinions generally arose and has largely continued as a commercial endeavor. And while the common law may be said to belong to everyone in common, commercial entities like to get paid.

The primary vehicles for the availability of opinions of the federal courts below the level of the Supreme Court has long been the *Federal Reporter* (first volume in 1880) and its offspring, the *Federal Supplement* (1932). Both are publications of West. In the 1970s and '80s, West created Westlaw – an electronic caselaw database.

Matthew Bender & Company started in 1887 as a book store for lawyers. The company subsequently got into the business of publishing legal treatises. In the later 20th Century, as CD-ROMs and internet usage developed and spread, Matthew Bender moved into electronic caselaw databases. As the case mentions, Matthew Bender had a deal with Lexis with regard to caselaw database creation.

LexisNexis traces its history to Henry Butterworth, who started in the law books trade at 15 years old when, in late 1801, he became an apprentice for his uncle's legal publishing house. After Henry was passed up for becoming a partner, he founded Butterworths.

Lexis was started in the United States in the 1970s as an electronic database venture. It started working with Butterworths later that decade. By 1996, Butterworths, Lexis, and other important, separately started legal publishers (Michie, Tolley) were united under the ownership of Reed Elsevier.

In April 1998, the month after this case was argued, Reed Elsevier purchased Matthew Bender & Company to pair with its Lexis business. In 2002, Matthew Bender was renamed LexisNexis Matthew Bender.

Thus, despite the case caption being *Matthew Bender & Company, Inc. v. West Publishing Co.*, it is, in essence, *Lexis v. Westlaw.*

This case is so complicated

The Star Pagination case is very complicated. It will be helpful for you to know that before you start reading it.

If you read this case looking for "the issue" and "the holding" you may drive yourself crazy. It's hard even to say what "the facts" are or what "the claim" of copyright is here.

Is West claiming copyright in the *page numbers* themselves? Or is it the *arrangement* of the cases within a volume? Or is it the *selection* of the cases in a volume?

The answer is yes. Or I'm not sure. Or I've lost track.

What about West's argument that someone could use a competitor's CD-ROM and a printer (plus a whole boatload of ink and paper, presumably), to print out all the same cases in the same order as can be found in a single volume of, for instance, *The Federal Reporter*? No one would really do that, would they?

The way to keep your bearings here is to look at this case the way the litigants would: as a matter of practicality. West's page numbers are something that people need and, if forced, can and will pay a lot of money for. West is a market participant that is, as it is supposed to be in our system, motivated by

money. West's arguments and claims make sense if you think about them from that perspective.

Opinion

[This case bas been edited differently from others. In other cases, publication artifacts like bracketed "star pagination" indicators have been removed as an annoyance and eyesore. But here, since they are actually connected to the facts of the litigation, they have been generally retained. (Nevertheless, putting the text into this casebook has involved the introduction of various formatting and typographical differences.)

Also, for similar aims of flavor, this abridgement occasionally includes the same text reproduced twice where Lexis's and West's transcriptions of that text diverged.

Most footnotes and citations have been left undisturbed. To mark various places where a footnote was in fact removed, a superscript [ƒ] was used. –Ed.]

The Star Pagination Case
(Matthew Bender v. West Publishing)

or, as it appears on Lexis:

Matthew Bender & Co. v. W. Publ. Co.

United States Court of Appeals for the Second Circuit
158 F.3d 693 (2d Cir. 1998)

{The following is from the Lexis retrieval of the case:}

Reporter

158 F.3d 693 *; 1998 U.S. App. LEXIS 28024 **; 48 U.S.P.Q.2D (BNA) 1545; Copy. L. Rep. (CCH) P27,827

MATTHEW BENDER & COMPANY, INC., Plaintiff-Appellee, HYPERLAW, INC., Intervenor-Plaintiff-Appellee, v. WEST PUBLISHING CO.; WEST PUBLISHING CORPORATION, Defendants-Appellants.

Subsequent History: [**1] Certiorari Denied June 1, 1999, Reported at: 1999 U.S. LEXIS 3814.

Prior History: Plaintiffs, who manufacture and market compilations of judicial opinions stored on compact disc-read only memory ("CD-ROM") discs, seek judgment declaring that the insertion of citations within their

versions of judicial opinions to show the location of the particular text in defendants' printed version of the opinions (so-called "star pagination") does not infringe defendants' copyrights in their compilations of judicial opinions. Defendants now appeal from a judgment of the United States District Court for the Southern District of New York (Martin, J.) granting summary judgment to plaintiffs, arguing that star pagination amounts to actionable copying of their protected arrangement of cases.

Disposition: Affirmed.

Counsel: MORGAN CHU, Los Angeles, CA (David Nimmer, Elliot Brown, Perry Goldberg, Irell & Manella LLP, on the brief), for Plaintiff-Appellee.

PAUL J. RUSKIN, Douglaston, NY (Carl J. Hartmann, New York, NY, Lorence L. Kessler, Washington, DC, on the brief), for Intervenor-Plaintiff-Appellee.

ARTHUR R. MILLER, Cambridge, MA (James F. Rittinger, Joshua M. Rubins, Satterlee Stephens Burke & Burke [**2] LLP, New York, NY, on the brief), for Defendants-Appellants.

DAVID SEIDMAN, Attorney, United States Department of Justice, Washington, DC (Joel I. Klein, Assistant Attorney General, Lawrence R. Fullerton, Deputy Assistant Attorney General, Robert B. Nicholson, Attorney, United States Department of Justice, on the brief), for Amicus Curiae United States of America.

Judges: Before: CARDAMONE and JACOBS, Circuit Judges, and SWEET, * District Judge. Judge Sweet dissents in a separate opinion.

* The Honorable Robert W. Sweet, of the United States District Court for the Southern District of New York, sitting by designation.

Opinion by: JACOBS

[*695] JACOBS, *Circuit Judge*:

Defendants-appellants West Publishing Co. and West Publishing Corp. (collectively "West") create and publish printed compilations of federal and state judicial opinions. Plaintiff-appellee Matthew Bender & Company, Inc. and intervenor-plaintiff-appellee HyperLaw, Inc. (collectively "plaintiffs")

manufacture and market compilations of judicial opinions stored on compact disc-read only memory ("CD-ROM") discs, in which opinions they embed (or intend to embed) citations that show the page [**3] location of the particular text in West's printed version of the opinions (so-called "star pagination"). [1] Bender and HyperLaw seek judgment declaring that star pagination will not infringe West's copyrights in its compilations of judicial opinions. West now appeals from a judgment of the United States District Court for the Southern District of New York (Martin, *J.*), granting summary judgment of noninfringement to Bender and partial summary judgment of noninfringement to HyperLaw. [2]

> [1] This cross-reference method is called "star pagination" because an asterisk and citation or page number are inserted in the text of the judicial opinion to indicate when a page break occurs in a different version of the case.
>
> [2] *{{Lexis version of the first several words of footnote 2:}*
>
> The district court granted summary judgment to HyperLaw on the star pagination issue. However. HyperLaw had sought an additional declaration that its duplication of West's version of the captions and text of judicial opinions does not infringe West's copyright.*}*
>
> *{{Westlaw version of the first several words of footnote 2:}*
>
> The district court granted summary judgment to HyperLaw on the star pagination issue. However, HyperLaw had sought an additional declaration that its duplication of West's version of the captions and text of judicial opinions does not infringe West's copyright.*}*
>
> *{{Remainder of footnote 2:}* The district court denied summary judgment on that claim, and ruled for HyperLaw following a bench trial. West appeals from that decision as well and we uphold that ruling in a separate opinion issued today. See Matthew Bender & Co. v. West Publ'g Co., No. 97-7910.*}*

West's primary contention on appeal is that star pagination to West's case reporters allows a user of plaintiffs' CD-ROM discs (by inputting a

series of commands) to "perceive" West's copyright-protected arrangement of cases, and that plaintiffs' products (when star pagination is added) are unlawful copies of [*696] West's arrangement. We reject West's argument for two reasons:

> **A.** Even if plaintiffs' CD-ROM discs (when equipped with star pagination) amounted to unlawful copies of West's arrangement of cases under the Copyright Act, (i) West has conceded that specification of the *initial* page of a West case reporter in plaintiffs' products ("parallel citation") is permissible [**4] under the fair use doctrine, (ii) West's arrangement may be perceived through parallel citation and thus the plaintiffs may lawfully create a copy of West's arrangement of cases, (iii) the incremental benefit of star pagination is that it allows the reader to perceive West's page breaks within each opinion, which are not protected by its copyright, and (iv) therefore star pagination does not *create* a "copy" of any protected elements of West's compilations or infringe West's copyrights.
>
> **B.** In any event, under a proper reading of the Copyright Act, the insertion of star pagination does not amount to infringement of West's arrangement of cases.

BACKGROUND

West creates "case reports" of judicial opinions by combining (i) certain independently authored features, such as syllabi (which summarize each opinion's general holdings), headnotes (which summarize the specific points of law recited in each opinion), and key numbers (which categorize the points of law into different legal topics and subtopics), with (ii) the text of the opinions, to which West adds parallel citations to other reporters, information about the lawyers, and other miscellaneous enhancements. [**5] West then publishes these case reports (first in paperbacked advance sheets, and then in hardbound volumes) in various series of "case reporters." These case reporters are collectively known as West's "National Reporter System," and include (as relevant to this case): the *Supreme Court Reporter*, which contains all Supreme Court opinions and

memorandum decisions; the *Federal Reporter*, which contains all federal court of appeals opinions designated for publication, as well as tables documenting the disposition of cases that are unpublished; the *Federal Rules Decisions* and *Federal Supplement*, which contain selected federal district court opinions; and the *New York Supplement*, which contains selected New York State case reports. [3] Cases appearing in West's case reporters are universally cited by the volume and page number of the case reporter series in which they appear. One citation guide recommends--and some courts require--citation to the West version of federal appellate and trial court decisions and New York State court decisions. *See The Bluebook: A Uniform System of Citation* at 165-67, 200-01 [*697] (16th ed. 1996); *see*, *e.g.*, Third Cir. R. 28.3(a); [**6] Eleventh Cir. R. 28-2(k); *see also The University of Chicago Manual of Legal Citation* 15 (1989) ("When citing to a state case, indicate the volume and first page of the case for both the official and commercial reporters.").

> [3] West's general arrangement of its case reporters is as follows (with each subsequent category dictating the order of cases within the previous category):
>
> Supreme Court Reporter: Cases are organized: (i) by type of opinion (full opinion, then orders and memorandum decisions); (ii) then by order of the filing date; (iii) then by the seniority of the Justice who authored the opinion (per curiam opinions follow opinions authored by individual justices): and (iv) then by docket number.
>
> Federal Reporter: Cases are organized in advance sheets: (i) by court (first the D.C. Circuit, then the numbered Circuits, and finally the Federal Circuit): (ii) then by type of opinion (first opinions and jacketed memoranda, then "sheet memoranda": cases reported in tables are placed together at the end of the advance sheet); and (iii) then chronologically. Two or three advance sheets are then combined in a permanent volume.
>
> Federal Supplement and Federal Rules Decisions: Cases are organized in advance sheets: (i) by circuit; (ii) then alphabetically by state; (iii) then if a state has multiple districts in the following order: Northern, Central, Middle. Eastern,

> Western and Southern; and (iv) then chronologically. The advance sheets are then combined into a bound volume.
>
> New York Supplement: Cases are organized in advance sheets: (i) by format. such as fully headnoted opinions and memorandum decisions; (ii) then by court level: (iii) then by department; and (iv) then chronologically. The advance sheets are then combined into a bound volume.
>
> These general guidelines are subject to specific editorial decisions to publish cases sequentially or in the same volume, or to combine an opinion with a subsequent order amending the opinion or denying rehearing.

Bender markets a series of CD-ROM discs [4] called *Authority from Matthew Bender*. One product in this series--the "New York product"--consists of three elements: (i) "New York Law and Practice" (one disc), which contains New York statutory and treatise materials; (ii) "New York Federal Cases" (three discs), which contains cases from the Second Circuit and New York's federal district courts from 1789 to the present; and (iii) "New York State Cases" (four discs), which contains New York State judicial opinions from 1912 to the present (the New York State Court of Appeals cases begin in 1884). These CD-ROM discs contain published opinions and unpublished opinions and orders from these courts.

> [4] As noted by the parties, CD-ROM publications have several advantages over books, including the capability of: (i) storing large amounts of information in a small amount of space; (ii) locating items in the text using word searches; and (iii) printing out portions of the text or downloading them to disks. In addition, unlike on-line retrieval services which provide some of the same benefits, the CD-ROM user does not incur time charges.

Bender obtains the text of the judicial opinions through a license from LEXIS (an on-line database containing legal and non-legal data), and stores the opinions and orders on the discs arranged by court and date, which is also the order in which they would be seen by a [**7] user who for some reason browses through the discs without sorting the case reports in a search. For each case that appears in West's case reporters, Bender intends to insert (and

in some cases already has inserted) a parallel citation (*e.g.*, 100 F.3d 101) to the West case reporter at the beginning of the opinion and a citation to the successive West page numbers at the points in the opinion where page breaks occur in the West volume (*e.g.*, *104 or 100 F.3d 104).

Bender uses the FOLIO file-retrieval program, which allows a user to access opinions in several ways, including in the order in which they are stored on the disc, or through term searches, or through a West or LEXIS parallel or page citation. In addition, citations appearing within judicial opinions are "hot linked," so that a user may retrieve the cited case by clicking the mouse on the case citation.

West claims (and for the purposes of this summary judgment motion, we accept as true) that the FOLIO retrieval system permits a user of Bender's product to view (and print) judicial opinions in the same order in which they are printed in a West volume by repeating the following steps: (i) [**8] a user activates the jump feature in the program to go to the first page in a West case reporter volume, (ii) pages through to the bottom of the case, (iii) finds the last star pagination reference, and (iv) activates the jump cite feature to retrieve the case beginning on the same or next West page number. [5]

> [5] West's counsel describes the retrieval procedure this way: Using the [Bender] product, I was able to act in all ways as though I had a physical, print copy of volume 628 of West's New York Supplement (Second) series. I typed the West citation "nys2d 628 1," and the product displayed the caption of the case. "in the Matter of Neftali D.," that West chose to arrange as the first case in volume 628. The product indicated that West's headnotes and other material occupied the rest of page 1, because the text of the court's decision begins after the star page 85 N.Y.2d 631, 651 N.E.2d 869, 628 N.Y.S.2d 2 . Reading through the text of the decision, I saw where the text that West had put on page 2 ended and where the text on page 3 began, because there was a marker to show where in mid sentence page 2 ended and page 3 began. The marker was a bold green 628 N.Y.S.2d 3 . Likewise, I saw where page 3 ended, because there was a bold green 628 N.Y.S.2d 4 . From observing the fact that (1) that there was no marker to show

> where page 5 began, and (2) that the amount of text after the page 4 marker was notably less than the amount between page 3 and page 4. I could see that the next case in volume 628 also began on page 4 of the volume. I then entered the West citation "nys2d 628 4" to look at the next case, and continued similarly. I found that I did not even need to type in the West citations if I simply put the cursor at the left hand bracket of the last star page marker of the previous case. With the cursor there, pressing control-d brought up a jump link destination box with the West cite already typed in for inc. such as "nys2d 628 p4." Deleting the 'p," I could then go to the next case as arranged in volume 628 of West's New York Supplement without having to type the full cite.

[*698] HyperLaw markets *Supreme Court on Disc*, an annual CD-ROM disc containing opinions of the United States Supreme Court since 1991, and *Federal Appeals on Disc*, a quarterly CD-ROM disc containing nearly all opinions (published and unpublished) of the federal courts of appeals since January 1993. [6] HyperLaw currently obtains the text of its opinions directly from the courts and includes in its *Federal Appeals* CD-ROM disc many more cases than published by West. The opinions are organized on the CD-ROM disc in an order that is "approximately chronological." HyperLaw includes parallel citations to West's case reporters for all cases appearing in the *Supreme Court Reporter* and the *Federal Reporter*, and intends to add star pagination as well. [7]

> [6] The record seems to indicate that since the commencement of this suit, HyperLaw has combined these two products into one.
>
> [7] HyperLaw claims that its product does not permit users to view cases in the same order as they appear in the West case reporters. However, the district court did not distinguish between Bender's and HyperLaw's display and retrieval capabilities, and because it does not affect the outcome of this case, we will assume that HyperLaw's product has the same retrieval capabilities as the Bender product.

Bender's complaint sought a judgment declaring that star pagination to West's case reporters will not copy West's arrangement [**9] or infringe West's copyright. HyperLaw intervened seeking the same relief. All parties then moved for summary judgment. The district court granted summary judgment to plaintiffs on the star pagination issue, concluding that the insertion of star pagination to West's volumes on the CD-ROM version of the cases would not reproduce any protectable element of West's compilation. The court noted that "the protection extends only to those aspects of the compilation that embody the original creation of the compiler" and that "where and on what particular pages the text of a court opinion appears does not embody any original creation of the compiler, and therefore . . . is not entitled to protection." The court further ruled that star pagination would be permitted under the fair use doctrine even if West's pagination were copyrightable.

DISCUSSION

West's case reporters are compilations of judicial opinions. The Copyright Act defines a "compilation" 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." 17 U.S.C. § 101 [**10] (1994). Compilations are copyrightable, but the copyright "extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work." 17 U.S.C. § 103 (1994).[8] Works of the federal government are not subject to copyright protection, 17 U.S.C. § 105 (1994), although they may be included in a compilation.

[8] Section 103 of the Copyright Act provides:

> (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. 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.
>
> 17 U.S.C. § 103.

Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340, 111 S. Ct. 1282, 113 L. Ed. 2d 358 (1991), is the seminal Supreme Court decision on copyrights in compilations. In *Feist*, the publisher of a telephone book claimed that a competitor had infringed its compilation copyright by copying some of its white pages listings. The Court clarified the scope of a copyright in compilations: "A factual compilation is eligible for copyright if it features an original selection or arrangement of facts, but the [*699] copyright is limited to the particular selection or arrangement. In no event may copyright extend to the facts themselves." *Id.* at 350-51, 111 S. Ct. at 1290. Because of this limitation on protectability, "the copyright [**11] 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." *Id.* at 349, 111 S. Ct. at 1289. The Court expressly rejected the "sweat of the brow" doctrine, which had justified the extension of copyright protection to the facts and other non-original elements of compilations on the basis of the labor invested in obtaining and organizing the information. *Id.* 359-60, 111 S. Ct. at 1295.

Under *Feist*, two elements must be proven to establish infringement: "(1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original." *Id.* at 361, 111 S. Ct. at 1296. Bender and HyperLaw concede that West has proven the first element of infringement, *i.e.*, that West owns a valid copyright in each of its case reporters.

However, as is clear from the second *Feist* element, copyright protection in compilations "may extend only to those components of a work that are original to the author. [**12] " *Id.* at 348, 111 S. Ct. at 1289. The "originality" requirement encompasses requirements both "that the work was independently created . . ., *and* that it possesses at least some minimal degree of creativity." *Id.* at 345, 111 S. Ct. at 1287 (emphasis added); *see also Key Publications, Inc. v. Chinatown Today Publ'g Enters., Inc.*, 945 F.2d 509,

512-13 (2d Cir. 1991) ("Simply stated, original means not copied, and exhibiting a minimal amount of creativity."). At issue here are references to West's volume and page numbers distributed through the text of plaintiffs' versions of judicial opinions. West concedes that the pagination of its volumes--*i.e.*, the insertion of page breaks and the assignment of page numbers--is determined by an automatic computer program, and West does not seriously claim that there is anything original or creative in that process. As Judge Martin noted, "where and on what particular pages the text of a court opinion appears does not embody any original creation of the compiler." Because the internal pagination of West's case reporters does not entail even a modicum of creativity, the volume and page [**13] numbers are not original components of West's compilations and are not themselves protected by West's compilation copyright. [9] *See Feist*, 499 U.S. at 363, 111 S. Ct. at 1297 ("As a constitutional matter, copyright protects only those constituent elements of a work that possess more than a *de minimis* quantum of creativity.").

> [9] The same conclusion can be arrived at using a different chain of reasoning. There is a fundamental distinction under the Copyright Act between the original work of authorship and the physical embodiment of that work in a tangible medium. See H.R. Rep. No 94-1476, at 53 (1976). reprinted in 1976 U.S.C.C.A.N. 5659, 5666 (noting "a fundamental distinction between the 'original work' which is the product of 'authorship' and the multitude of material objects in which it can be embodied. Thus, in the sense of the [Act], a 'book' is not a work of authorship, but is a particular kind of 'copy.' instead, the author may write a 'literary work,' which in turn can be embodied in a wide range of 'copies' and 'phonorecords'). The embedding of the copyrightable work in a tangible medium does not mean that the features of the tangible medium are also copyrightable. Thus, here, the original element of West's compilation, its arrangement of cases, is protectable, while the features of the physical embodiment of the work, i.e., the page numbers, are not.

Because the volume and page numbers are unprotected features of West's compilation process, they may be copied without infringing West's copyright. [10]

> [10] *{{Lexis version of the first several words of footnote 10:}*
>
> The dissent would extend copyright protection to au page numbers because. when inserted into a complete set of opinions appearing in West's case reporters, they reflect the arrangement of those reporters. *}*
>
> *{{Westlaw version of the first several words of footnote 10:}*
>
> The dissent would extend copyright protection to all page numbers because, when inserted into a complete set of opinions appearing in West's case reporters, they reflect the arrangement of those reporters.*}*
>
> *{Remainder of footnote 10:}*
>
> Dissent at page 7541. But such an approach would extend copyright to page numbers which do not represent an exercise of original authorship. Although the arrangement of West's cases may be copyrightable, and although complete star pagination may permit the perception of that arrangement, there is no support for extending copyright protection to an unoriginal element because when completely copied it reveals a protected element rather than copies it.*}*

However, West proffers an alternative argument based on the fact (which West has plausibly demonstrated) [*700] that plaintiffs have inserted or will insert *all* of West's volume and page numbers for certain case reporters. West's alternative argument is that even though the page numbering is not (by itself) a protectable element of West's compilation, (i) plaintiffs' star pagination to West's case reporters embeds West's arrangement of cases in plaintiffs' CD-ROM discs, thereby allowing a user to perceive West's protected arrangement [11] through the plaintiffs' file-retrieval programs, and (ii) that under the Copyright Act's definition of "copies," 17 U.S.C. § 101, a [**14] work that allows the perception of a protectable element of a compilation through the aid of a machine amounts to a copy of the compilation. We reject this argument for two separate reasons. [12]

[11] West claims that its arrangement of cases, see supra note 3, is original and worthy of copyright protection. Hyperlaw (but not Bender) argues that West's arrangement of cases in the Supreme Court Reporter and the Federal Reporter (the case reporters containing the opinions included on HyperLaw's CD-ROM discs) is insufficiently original to be copyrightable. But because we find that West's arrangement has not been copied through the insertion of star pagination to West's case reporters, we can assume without deciding that West's case reporters contain an original and copyrightable arrangement.

[12] Plaintiffs cite *Banks Law Pub. Co. v. Lawyers' Co-op Pub. Co.*, 169 F. 386 (2d Cir. 1909), in arguing that star pagination to case reporters is permissible, and they intimate that Banks held that the arrangement of cases cannot be copyrightable. Banks's holding seems to have rested on the plaintiff's status as an official reporter. See *id*. at 389 (reprint of text of district court opinion) ("A reasonable interpretation of the statute prescribing his duties implies pagination, volumes of uniform size and reasonable thickness, together with a suitable and convenient arrangement of the cases."). True, our opinion in Banks adds that "[i]t is not necessary to discuss so much of the opinion below as deals with the question[] of. . . the right of the official reporter to secure copyrights," *id*. at 391, which could imply either that our holding did not rest on the official status of the reporter but on the lack of originality in the arrangement or that the foregone analysis concerns the copyrightability of elements not dictated by statute. In any event, Bender concedes for the purpose of summary judgment that West's arrangement is sufficiently original to merit copyright protection; Banks does not assist in answering the distinct question of whether star pagination infringes the arrangement of another reporter if the arrangement of the cross-paginated work is copyrightable; and Banks preceded even the effective date of the Copyright Act of 1909. We decline to decide this case on the strength of Banks.

In addition, this opinion will not address any copying by plaintiffs of the selection of cases included in West's case reporters. First, West argued below that Bender had copied West's arrangement of cases, not its selection. Second. it is uncontested that plaintiffs' compilations include many more opinions than West's case reporters. For example, HyperLaw's second quarter 1996 CD-ROM disc contained approximately 36,000 Supreme Court and court of appeals decisions, only 22,000 of which were published by West. The selection of cases for Bender's product also differs from West's: (i) jt contains many unpublished decisions not found in West's reporters, and (ii) unlike West's Federal Reporter, Federal Supplement, and Federal Rules Decisions, Bender's product includes only federal cases decided by New York courts. Accordingly, we cannot find that the selection of cases in plaintiffs' compilations is substantially similar to West's selection. See Tasini v. New York Times Co., 972 F. Supp. 804, 823 (S.D.N.Y. 1997) (Sotomayor, J.) (noting that to find infringement of selection, "the subsequent work cannot differ in selection by 'more than a trivial degree' from the work that preceded it") (citing Kregos v. Associated Press, 937 F.2d 700, 710 (2d Cir. 1991)).

A

West asserts an indirect infringement theory: (i) the embedding of unprotectable volume and page numbers in a CD-ROM disc (so-called "compilation markers" or "tags"), (ii) permits a user to perceive West's arrangement of cases through the aid of a machine, and (iii) this amounts to a copy of the compilation's arrangement under § 101's definition of "copies." Assuming for the moment that West has properly read the Act, *i.e.*, that a copy of the arrangement is created when the arrangement can be perceived with the aid of a user *and* a machine, we think it is clear that the copy is not created by insertion of star pagination.

West concedes that insertion of parallel citations (identifying the volume and first page numbers on which a particular case appears) to West's case reporters in plaintiffs' products (as well as any other compilations of judicial opinions) is permissible under the fair use doctrine. [13] *See* West Reply Brief at 5 n.5 (noting "West's long-held position [*701] [**15] that parallel citation to West case reports by competitors (*without* additional star pagination) is a fair use under 17 U.S.C. § 107--*i.e.*, an *otherwise infringing*

use that, when analyzed under the § 107 factors, is deemed 'fair'"); West's Response to Bender's Rule 3(g) Statement P 32, Joint Appendix at 1581; *see also West Publ'g Co. v. Mead Data Central, Inc.*, 799 F.2d 1219, 1222 (8th Cir. 1986) ("West concedes that citation to the first page of its reports is a noninfringing 'fair use' under 17 U.S.C. § 107."). West admitted at oral argument (as it did in the district court [14]) that these parallel citations already allow a user of plaintiffs' CD-ROM discs to perceive West's arrangement with the aid of a machine and that plaintiffs' CD-ROM discs therefore already have created a lawful "copy" of West's arrangement on their CD-ROM discs--as West defines "copy." [15]

[13] According to Bender and HyperLaw, West has admitted before various courts and congressional panels that West's parallel citation is in the public domain. But these statements were not in the context of a legal proceeding or unequivocal, and there is no evidence that a court has adopted this position in some manner. See *AXA Marine & Aviation Ins. (UK) v. Seajet Indus.*, 84 F.3d 622, 628 (2d Cir. 1996) (noting that "[a] party invoking judicial estoppel) must show that (1) the party against whom judicial estoppel is being asserted advanced an inconsistent factual position in a prior proceeding, and (2) the prior inconsistent position was adopted by the first court in some manner").

[14] The following exchange occurred before the district court:

THE COURT:

Star pagination, though, you say if by using the star pagination they can duplicate through their computer the West system, why can't they do that, why. . . can't they reproduce your compilation simply by using the first page?

MR. MUSILEK [West's Counsel]:

Your Honor, they can. They cannot show where in fact page breaks occur; they cannot show the page numbers associated with those page breaks for finding specific portions of text.

Joint Appendix at 3507.

> [15] A user of plaintiffs' CD-ROM products containing only parallel citation to West's case reporters could use the same method described by West's attorney, see supra note 5, to recreate West's arrangements although it might require some trial and error to locate the exact page where the next West case begins.

Once the copy has thus been created through parallel citation--assuming that anyone would wish to avail themselves of the capability of perceiving this copy--the only incremental data made perceivable (through the aid of a machine) by star pagination is [**16] the location of page breaks within each judicial opinion. But since page breaks do not result from any original creation by West, their location may be lawfully copied. We therefore conclude that star pagination's volume and page numbers merely convey unprotected information, and that their duplication does not infringe West's copyright.

The opposite conclusion was reached by the district court in *Oasis Publishing Co. v. West Publishing Co.*, 924 F. Supp. 918 (D. Minn. 1996), which reasoned that the fair-use copying of parallel citation, which could be used to perceive the arrangement of cases, did not excuse copying interior pagination, which could also be used to perceive arrangement. *See id.* at 926.[16]

> [16] The court noted:
>
> Although with either the parallel cites or an internal cite from each case a user could sort West's cases and determine West's arrangement, the former does not utterly supplant the need for West's product while the latter does.
>
> Conceding parallel citation to the first page of each case as a noninfringing fair use does not diminish West's copyright interest in the subsequent internal pages, which also would independently permit arrangement of the cases by sorting. Having gotten the inch under the conceded fair use of parallel citation to the first page of each case, Oasis is not thereby entitled to take the entire mile in star citation to every page.
>
> *Oasis Publ'g Co.*, 924 F. Supp. at 926.

It is true that copying under the fair use doctrine will not necessarily permit additional uses, and will not excuse additional copying that in the aggregate amounts to infringement. But a compilation has limited protectability; only the original elements of a compilation (*i.e.*, its selection, arrangement, and coordination) are protected from copying. The insertion of parallel citations already creates a "copy" of West's arrangement (at least [**17] as West defines a copy), a copy that is permissible under the fair use doctrine. Star pagination cannot be said to create *another* copy of the same arrangement. Prohibiting star pagination would simply allow West to protect *unoriginal* elements of its compilation that have assumed importance and value. Accordingly, [*702] even were we to agree with West's interpretation of the Copyright Act, we would not find infringement.

B

But our rejection of West's position is even more fundamental. If one browses through plaintiffs' CD-ROM discs from beginning to end, using the computer software that reads and sorts it, the sequence of cases owes nothing to West's arrangement. West's argument is that the CD-ROM discs are infringing copies because a user who manipulates the data on the CD-ROM discs could at will re-sequence the cases (discarding many of them) into the West arrangement. To state West's theory in the statutory words on which West (mistakenly) relies, each of the plaintiffs' CD-ROM discs is a "copy" because West's copyrighted arrangement is "fixed" on the disc in a way that can be "perceived . . . with the aid of a machine or device." 17 U.S.C. § 101 [**18] (1994).

For reasons set forth below {{*much of which has been omitted – Ed.*}}, we conclude that a CD-ROM disc infringes a copyrighted arrangement when a machine or device that reads it perceives the embedded material in the copyrighted arrangement or in a substantially similar arrangement. At least absent some invitation, incentive, or facilitation not in the record here, a copyrighted arrangement is not infringed by a CD-ROM disc if a machine can perceive the arrangement only after another person uses the machine to *re*-arrange the material into the copyrightholder's arrangement.˜

[**24]

˜Substantial Similarity

The question presented--whether an element of West's copyrighted work has been reproduced in a "copy"--is answered by comparing the original and the allegedly infringing works, and inquiring whether the copyrightable elements are substantially similar. Under the facts of this case, the arrangement of the "work" on plaintiffs' CD-ROM discs is the arrangement of cases that is displayed by a CD player reading the information in the order in which it is physically embedded or "fixed" in the discs and not all possible arrangements that can be perceived through the manipulation and rearrangement of the embedded data by a third party user with a machine.

The Supreme Court in *Feist* emphasized that copyright protection for a factual compilation is "thin," and that a compilation containing the same facts or non-copyrightable elements will not infringe unless it "*features* the same selection and arrangement" as the original compilation. *Feist*, 499 U.S. at 349, 111 S. Ct. at 1289 (emphasis added); *see also Key Publications, Inc. v. Chinatown Today Publ'g Enters., Inc.*, 945 F.2d 509, 514 (2d Cir. 1991) (holding that to [**25] establish infringement, a compilation copyright holder must demonstrate "substantial similarity between those elements, and only those elements, that provide copyrightability to the allegedly infringed compilation"). To determine whether two works contain a substantially similar arrangement, courts compare the ordering of material in the two works, finding infringement only when both compilations have featured a very similar literal ordering or format. *See*, *e.g.*, *Lipton v. Nature Co.*, 71 F.3d 464, 472 (2d Cir. 1995) (finding infringement of arrangement when of 25 terms contained in copyrighted work, 21 are listed in same order on allegedly infringing work); *Worth v. Selchow & Righter Co.*, 827 F.2d 569, 573 (9th Cir. 1987) (holding that alphabetical arrangement of factual entries in a trivia encyclopedia was not copied by a copyrighted game that organized the factual entries by subject matter and random arrangement on game cards); *see also* Jane C. Ginsburg, *No "Sweat"? Copyright and Other Protection of Works of Information After Feist v. Rural Telephone*, [*705] 92 Colum. L. Rev. 338, 349 (1992) (noting that under [**26] *Feist*, nothing "short of extensive verbatim copying" will amount to infringement of a compilation). "If the similarity concerns only noncopyrightable elements of [a copyright

holder's] work, or no reasonable trier of fact could find the works substantially similar, summary judgment is appropriate." *Williams v. Crichton*, 84 F.3d 581, 587 (2d Cir. 1996) (internal quotation marks and citations omitted). We agree with plaintiffs and *amicus* United States that West fails to demonstrate the requisite substantial similarity. [20]

> [20] West does not claim that the appearance or layout of the cases on Bender's product reproduces the appearance or layout of West's case reporters. In fact, the layout is quite different; Bender displays its cases in one column with no page breaks, and with footnotes displayed at the end of the case or through a pop-up window that can be accessed by clicking the mouse-button on the footnote number.

West's case reporters contain many fewer cases than plaintiffs' CD-ROM discs, and are arranged according to classification such as court, date, and genre (opinions, per curiam opinions, orders, etc.), subject to certain exceptions characterized by West as features of originality, whereas plaintiffs organize their cases simply by court and date. Comparison of the works reveals that cases that appear adjacent in the West case reporters are separated on plaintiffs' products by many other cases; and even if these other cases are disregarded, the West cases included on plaintiffs' products are not in an order at all resembling West's arrangement.[f] [**27]

Star pagination (in addition to revealing the page location of the text of judicial opinions) may incidentally reveal to the reader how *the reader* could create a copy of West's arrangement by various computer key operations; but by the same token, if the CD-ROM discs were published on paper in the same order as the cases are embedded in the CD-ROM disc, a reader so minded could assemble a "copy" of the West arrangement by use of scissors. *Cf. Horgan v. MacMillan, Inc.*, 789 F.2d 157, 162 (2d Cir. 1986) (noting that "the standard for determining copyright infringement is not whether the original could be recreated from the allegedly infringing copy, but whether the latter is 'substantially similar' to the former").

True, CD-ROM technology is different from paper, for as West points out, the arrangement of judicial opinions in a CD-ROM disc does not correspond necessarily to how the information will be displayed or printed

by the user, because the file-retrieval system allows users to retrieve cases in a variety of ways. *See* Robert C. Denicola, *Copyright in Collections of Facts: A Theory for the Protection of Nonfiction Literary Works*, 81 Colum. L. Rev. 516, 531 (1981) [**28] ("It is often senseless to seek in [electronic databases] a specific, fixed arrangement of data."). But having rejected West's argument under § 101, we can conclude that the arrangement of plaintiffs' work is the sequence of cases as embedded on the plaintiffs' CD-ROM discs and as displayed to the user browsing through plaintiffs' products. That sequence is not substantially similar to West's case reporters. There is no evidence that Bender and HyperLaw's case-retrieval systems allow a user to browse the cases in the West [*706] arrangement without first taking steps to create that arrangement. Thus, an actionable copy of West's sequence of cases, *i.e.*, a work with a substantially similar arrangement fixed in a tangible medium (probably a print-out of the cases), could be created by a user of the CD-ROM discs, but only by using the file-retrieval program as electronic scissors. We cannot find that plaintiffs' products directly infringe West's copyright by inserting star pagination to West's case reporters.˜

Contributory Infringement

Notwithstanding the absence of substantial similarity, a database manufacturer may be liable as a contributory infringer (in certain [**29] circumstances) for creating a product that assists a user to infringe a copyright directly. West has hypothesized that users of Bender and HyperLaw's products, using star pagination and the search functions of the CD-ROM products, will retrieve and print cases in the order in which they appear in West's case reporters. *See* Affidavit of Michael A. Trittipo P 5, Joint Appendix at 1287. A CD-ROM disc user who replicated the West compilation in that way would be an infringer. But West has failed to identify any primary infringer, other than Mr. Trittipo, West's counsel. *See Cable/Home Communication Corp. v. Network Prods., Inc.*, 902 F.2d 829, 845 (11th Cir. 1990) ("Contributory infringement necessarily must follow a finding of direct or primary infringement."); 2 Paul Goldstein, *Copyright* § 6.0 (1996) ("For a defendant to be held contributorily or vicariously liable, a direct infringement must have occurred.").

Assuming there is a class of primary infringers, then˜ {t}wo types of activities that lead to contributory liability are: (i) personal conduct that encourages or assists the infringement; and (ii) provision of machinery or goods that facilitate the infringement.# West argues that Bender and HyperLaw's sale of their CD-ROM products falls within the second category.

However, as *amicus* United States notes, the provision of equipment does not amount to contributory infringement if the equipment is "capable of substantial noninfringing uses," including uses authorized under the fair use doctrine.˜

The arrangement of cases in the West case reporters, however meticulous and thoughtful, is of small assistance to the primary use of these products--searching for cases, and retrieval. After all, the useful order of access is almost always determined by the research goal of each user rather than the publisher's sequencing (a compilation of law cases being not much like a musical medley or a sonnet sequence). And the primary use of West's pagination in plaintiffs' products is to allow the user to refer to the location of a particular text within the West case reporters as has become standard practice in the legal community. West concedes that use of its volume and page numbers for pinpoint citation purposes is at least a fair use (if it even amounts to actionable copying). There is no evidence that plaintiffs have encouraged the users of their products to reproduce West's arrangement. In fact, the CD-ROM products provide no easy means for using the star pagination to create a substantially similar arrangement; a user must retrieve each case, one at a time, in the order in which they appear in the West volume, [**32] and then print each one. What customer would want to perform this thankless toil? We conclude that plaintiffs' products have substantial, if not overwhelming, noninfringing [*707] uses, and that the plaintiffs are not liable as contributory infringers.˜

C

We differ with the Eighth Circuit's opinion in *West Publishing Co. v. Mead Data Central, Inc.*, 799 F.2d 1219 (8th Cir. 1986). In that case, LEXIS (an on-line database provider) announced plans to star paginate its on-line version of cases to West case reporters. West claimed that the star pagination

would allow users to page through cases as if they were reading West volumes, [**34] and in that way copied West's arrangement of cases. *Id.* at 1222. The court held that "West's arrangement is a copyrightable aspect of its compilation of cases, that the pagination of West's volumes reflects and expresses West's arrangement, and that MDC's intended use of West's page numbers infringes West's copyright in the arrangement." *Id.* at 1223. Even if it was not "possible to use LEXIS to page through cases as they are arranged in West volumes," the court said that insertion of comprehensive star pagination amounted to infringement:

> Jump cites to West volumes within a case on LEXIS are infringing because they enable LEXIS users to discern the precise location in West's arrangement of the portion of the opinion being viewed. . . .
>
> With [LEXIS's] star pagination, consumers would no longer need to purchase West's reporters to get every aspect of West's arrangement. Since knowledge of the location of opinions and parts of opinions within West's arrangement is a large part of the reason one would purchase West's volumes, the LEXIS star pagination feature would adversely affect West's market position. "[A] use that supplants any [**35] part of the normal market for a copyrighted work would ordinarily be considered an infringement." S. Rep. No. 473, 94th Cong., 1st Sess. 65 (1975) . . . .

[*708] *Id.*at 1227-28; *see also Oasis Publ'g Co. v. West Publ'g Co.*, 924 F. Supp. 918, 922-25 (D. Minn. 1996) (holding that (i) *West Publishing Co.* had not been overruled by *Feist*'s disavowal of the "sweat of the brow" doctrine, and (ii) that even if it had, "the internal pagination of [West's reporter] is part of West's overall arrangement, and similarly protected").

The Eighth Circuit in *West Publishing Co.* adduces no authority for protecting pagination as a "reflection" of arrangement, and does not explain how the insertion of star pagination creates a "copy" featuring an arrangement of cases substantially similar to West's--rather than a dissimilar arrangement that simply references the location of text in West's case reporters and incidentally simplifies the task of someone who wants to reproduce West's arrangement of cases. It is true that star pagination enables

users to locate (as closely as is useful) a piece of text within the West volume. But this location [**36] does not result in any proximate way from West's original arrangement of cases (or any other exercise of original creation) and may be lawfully copied.

Judge Sweet dissents in a separate opinion.

Dissent

Sweet, D.J. dissenting from majority opinion:

I respectfully dissent.

This appeal from the grant of summary judgment in favor of the appellee Bender presents challenging issues˜.˜ I feel required to dissent, emboldened by the holdings of the three other courts which have considered the issue, *West Pub. Co. v. Mead Data Central, Inc.*, 616 F. Supp. 1571 (D.Minn. 1985), *aff'd*, 799 F.2d 1219 (8th Cir. 1986), *cert. denied*, 479 U.S. 1070, 93 L. Ed. 2d 1010, 107 S. Ct. 962 (1987); *Oasis Pub. Co. v. West Pub. Co.*, 924 F. Supp. 918 (D.Minn. 1996), [**37] and reached conclusions contrary to those stated by the majority. By concluding that page numbers in the context of the West citation system are facts rather than an expression of originality the majority permits the appellee Bender and the intervenor Hyperlaw to appropriate the practical and commercial value of the West compilation.

The West page numbers which are inserted by appellee Bender in the text of each of [*709] its CD-ROM disks[f] by star pagination result from the totality of the West compilation process which includes its concededly original and copyrightable work, *i.e.* attorney description, headnotes, method of citation and emending of parallel or alternate citations. These result in a compilation work with page numbers assigned mechanically. The West page numbers and the corresponding Bender and Hyperlaw star pagination are the keys which open the door to the entire West citation system which as the majority noted is an accepted, and in some instances, a required element for the citation of authorities.

The majority initially assumes the copyrightability of the West work but cites the statement in *Feist Publications, Inc., v. Rural Telephone Service*

Company, Inc., 499 U.S. 340, 113 L. Ed. 2d 358, 111 S. Ct. 1282 (1991), [**38] that "a factual compilation is eligible for copyright if it features an original selection or arrangement of the facts, but the copyright is limited to the particular selection or arrangement. In no event may copyright extend to the facts themselves." 499 U.S. at 350-51, and its conclusion that the compiler's copyright is "thin" permitting a subsequent compiler to use facts "so long as the competing work does not feature the same selection and arrangement." *Id.* By characterizing star pagination as a fact, rather than as an essential part of the selection or arrangement the majority deprives the West pagination of its originality and consequent copyright protection.˜

In my view West's case arrangements, an essential part of which is page citations, are original works of authorship entitled to copyright protection. Comprehensive documentation of West's selection and arrangement of judicial opinions infringes the copyright in that work.

This reasoning is consistent with *Feist*. As discussed above, the majority notes that the compiler's copyright is "thin." *Feist*, 499 U.S. at 350-51. Therefore, "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*." *Id*., at 349 (emphasis added). In this case, allowing plaintiffs to use the page numbers contained in West's publication enables them to feature West's same selection and arrangement.ƒ Indeed, were it not for the ability to reproduce West's arrangement, its pagination would be of limited (if any) use.

According to *Feist*, "the originality requirement [**40] articulated in the The Trade-Mark Cases and Burrow-Giles remains the touchstone of copyright protection today . . . . It is this bedrock principle of copyright that mandates the law's seemingly disparate treatment of facts and factual compilations." 499 U.S. at 347 (citations omitted).

[*710] Here the pagination results from West's arrangements, selections, syllabi, headnotes, key numbering, citations and descriptions. The page number, arbitrarily determined, is the sole result of the West system,

appears nowhere else, and is essential to its coordinated method of citation. It is, so to speak, an original fact resulting from West's creativity.˜

Some of the most seminal developments in copyright law have been driven by technological change. There was a time when people [**42] questioned whether photographs, *see Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 28 L. Ed. 349, 4 S. Ct. 279 (1994), or advertisements, *see Bleistein v. Donaldson Lithographi*ng *Co.*, 188 U.S. 239, 23 S. Ct. 298, 47 L. Ed. 460 (1903), were copyrightable. Here again it is necessary to reconcile technology with pre-electronic principles of law. Clearly, plaintiffs' CD-ROM disks are not "copies" in the traditional sense. Yet, plaintiffs provide the ability for a user to push a button or two and obtain West's exact selection and arrangement. This technological capacity presents a new question. The majority's answer threatens to eviscerate copyright protection for compilations.˜

Finally, the majority dismisses *West Publishing Co.* on which I rely for lack of authority. [*711] [**44] By its *ipse dixit*, that location by star pagination does not result from the concededly original West arrangement of cases, the majority rejects the result obtained by the Eighth Circuit and attributes it to the pre-*Feist*, "now defunct 'sweat of the brow' doctrine," an attribution not warranted by the reliance of the Eighth Circuit upon West's originality. The question of whether or not *Feist* overruled *West* was argued and carefully considered by the *Oasis* court. Creativity was the issue, and I subscribe to Chief Judge Magnuson's view of the interrelationship between *West* and *Feist*.

While the Eighth Circuit did take note of the considerable "labor" exercised by West, it did so in conjunction with a consideration of West's "talent and judgment" in organizing its compilations. *See West Publishing Co.*, 799 F.2d at 1226 (concluding that West's arrangement is the result of "considerable labor, talent and judgment").

The Eighth Circuit applied essentially the same creativity standard articulated and applied in *Feist*. Instead of a mere "sweat of the brow" analysis of West's selection and arrangement of cases in the National Reporter System, [**45] the Court considered the "originality and intellectual

creation" requirements of the arrangement. *West Publishing Co.*, 799 F.2d at 1225-26.

In *West Publishing Co.*, the Eighth Circuit's persuasively reasoned that (i) comprehensive pagination, when linked to the text of a compilation, is copyrightable in terms of originality because it expresses the compiler's expression and arrangement, and (ii) a compilation's selection and arrangement is copied when comprehensive cross-pagination is inserted into an electronic database containing the compilation's text. 799 F.2d at 1227-28.˜

For these reasons I believe the grant of summary judgment granting the declaratory judgment requested by Bender was error, and I therefore dissent from the majority's affirmance of that judgment.

Post-reading notes

Consequences of the Star Pagination Case

In the Star Pagination Case, the court held that Westlaw could not have a monopoly on its *Federal Reporter*, *Federal Supplement*, and *Supreme Court Reporter* page numbers – used by courts and lawyers to pin citations to particular places within sometimes lengthy judicial opinions.

The laws of the market dictate that such a result would lower prices. And presumably it did. Yet access to caselaw continues to be very expensive. The internet has brought the cost of a great deal of government-produced information down to near zero. But the caselaw business has largely evaded the technology's hammering down of margins.

Since the turn of the millennium, numerous free sources have sprung up online offering the text of a great swath of judicial opinions without charge. Yet obtaining comprehensive and easily searchable access to American caselaw – even at a quite basic level, much less to conduct research with sophistication – continues to come at a high price. Pricing depends on circumstances, service level, and dickering, so the cash outlay for access is hard to pin down, but as of 2025 the required outlay seems generally to be in the range of thousands of dollars per year per attorney.

E. By the Book: Copyrightability Blackletter Today

E.1. Lead-in

Here we take a break from reading cases and focus on the words of the current statutory provisions for copyrightability and explanations of key concepts as provided by the U.S. Copyright Office. The view provided by the statute and the law as explained by the copyright office is one of crystalline clarity, where all concerns seem to have been anticipated in advance – with the lines already drawn and any line-drawing difficulties put behind us.

Afterward, we will go back to cases and controversies. As we will see, these continue – whether it's a failure of the line drawers, or a failure of litigants to accept the lines that have been drawn.

E.2. Copyright Office on Copyrightability

This section features expository text about copyrightability written by the United States Copyright Office.

E.2.1. About the U.S. Copyright Office (USCO)

Immediately below, and elsewhere in this book, are readings consisting of written explanations of copyright law produced by the U.S. Copyright Office.

The Copyright Office is the federal agency created by Congress for undertaking the various administrative tasks related to the U.S. copyright system. The Copyright Office is a bit unique in terms of its place within the federal government. It is not part of the executive branch of the government. Instead, it is part of the Library of Congress, which is an arm of the legislature. The reason is historical and goes back to a time when the Library of Congress needed to grow its collection of books. Requiring applicants to deposit copies for copyright registration was leveraged as a powerful means for the Library of Congress to accumulate vast holdings of books.

Useful for lawyers and law students, the Copyright Office has produced a great deal of documentation explaining copyright law. This casebook uses some of it as readings, starting immediately below. You will quickly notice these materials are largely written with attention to the question of what the Copyright Office will *register*. That is because registering copyright is the

Copyright Office's job. Court opinions, on the other hand, rarely speak of what can be registered; instead, they are mostly concerned with infringement liability. Yet many issues – including whether something qualifies as copyrightable subject matter – must be confronted and analyzed whether the ultimate issue is registration or infringement.

E.2.2. Fixation requirement

explanation of the U.S. Copyright Office

{Abridged 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).

• 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). 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).

The Copyright 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.

E.2.3. Authorship requirement

{Abridged 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).

E.2.4. Originality requirement

explanation of the U.S. Copyright Office

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

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).

"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.

E.2.5. Creativity requirement

explanation of the U.S. Copyright Office

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

A work of authorship must possess "some minimal degree of creativity" to sustain a copyright claim. *Feist*, 499 U.S. at 358, 362.

"[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.

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 it is "entirely typical," "garden-variety," or "devoid of even the slightest traces of creativity" does not satisfy the originality requirement. *Feist* 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.

E.2.6. Names, titles, short phrases, typeface, fonts, and lettering

explanation of the U.S. Copyright Office

{Abridged 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 Copyright 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.

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, consult resources from the U.S. Patent and Trademark Office.

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. To register copyrightable content, you should describe the surface decoration or other ornamentation and should explain how it is separable from the typeface characters.

E.3. Copyright Act of 1976 on Copyrightability

About the '76 Act

The current U.S. copyright statute is the Copyright Act of 1976. The '76 Act was a wholesale re-writing of the copyright statute by Congress, undertaken in 1976 with an effective date of January 1, 1978. (The '76 Act replaced the 1909 Act, but that act still has modern relevance for works dating to before 1978.)

The '76 Act has been amended many times since its original passage, but the current statute is still commonly referred to as the 1976 Act even taking into account its later amendments.

The '76 Act was encoded in Title 17 of the United States code, and its section numbering begins at § 101. That section contains definitions of terms that occur throughout later-numbered sections.

Editing notes

For the reader's convenience, words in the statutory text that have corresponding definitions in § 101 have been bolded and underlined. The corresponding statutory definitions then immediately follow.

17 U.S.C. § 102 text and corresponding definitions

§ 102 · Subject matter of copyright: In general

(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.

Definitions from § 101 of terms in § 102

A work is "**fixed**" in a tangible medium of expression when its embodiment in a copy or phonorecord, by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration. A work consisting of sounds, images, or both, that are being transmitted, is "fixed" for purposes of this title if a fixation of the work is being made simultaneously with its transmission.

A "**device**", "**machine**", or "**process**" is one now known or later developed.

"**Literary works**" are works, other than audiovisual works, expressed in words, numbers, or other verbal or numerical symbols or indicia, regardless of the nature of the material objects, such as books, periodicals, manuscripts, phonorecords, film, tapes, disks, or cards, in which they are embodied.

The terms "**including**" and "**such as**" are illustrative and not limitative.

"**Pictorial, graphic, and sculptural works**" include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.

"**Motion pictures**" are audiovisual works consisting of a series of related images which, when shown in succession, impart an impression of motion, together with accompanying sounds, if any.

"**Audiovisual works**" are works that consist of a series of related images which are intrinsically intended to be shown by the use of machines or devices such as projectors, viewers, or electronic equipment, together with accompanying sounds, if any, regardless of the nature of the material objects, such as films or tapes, in which the works are embodied.

"**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.

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.

17 U.S.C. § 103 text and corresponding definitions

§ 103 · Subject matter of copyright: Compilations and derivative works

(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.

Definitions from § 101 of terms in § 103

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.

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".

F. Take a Picture – It'll Last Longer, 2010s

F.1. Lead-in

These cases

These next cases concern art and artists, big public-interfacing institutions that display art, and once friendly relations that have turned sour.

In these cases, contemporary courts confront some factually challenging terrain. Among other things, the facts take on additional complexity in that they involve depth – literally, as in something that must be thought about in three dimensions (width, height, and depth). Questions about originality (including creativity and authorship) get stretched in new ways.

But we don't need new precedent. You will see these courts work to apply the concepts of copyrightability developed in foundational 1800s cases – including, importantly, *Burrow-Giles v. Sarony* and *Bleistein v. Donaldson Lithographing* – while adding the teachings of *Feist v. Rural Telephone* from 1991. And while *Alfred Bell v. Catalda* and *Morrissey v. Procter & Gamble* aren't called out by name, those cases can be felt hovering around the edges as well.

But there's more. While originality continues remain central to copyrightability in these cases, we also start to see the very large role to be played by the requirement of fixation.

This is what's coming up:

In *Harvard v. Steve Elmore* (D.N.M. 2016), a university makes a deal with an author to publish a book about pottery the university keeps in its museum. The deal falls apart, and Harvard decides not to publish the book. When the author publishes elsewhere, Harvard sues the author – claiming the book's images of Harvard's pottery infringe on Harvard's copyrights.

In *Kelley v. Chicago Parks* (7th Cir. 2011), an artist creates a living work of art in the form of a flower garden in a city park. After some years go by, the artist and the city no longer agree on what to do with the garden, and the artist sues to stop the city from making changes with a cause of action that will turn on the copyrightability of the garden as an artwork.

Compared to preceding cases

The preceding cases (*Feist v. Rural Telephone, ADA v. Delta Dental,* and *The Star Pagination Case*) all involved copyright claims over systems of numbers. Those cases arguably busted expectations about what copyright is all about. (No novels? No visual arts? Just numbers?) That made for an interesting question – how do concepts of expressiveness, creativity, and authorship map on to these things?

But in those cases, at least one things seemed pretty straightforward: The motivation of the parties to fight was not hard to understand. All of those cases plausibly involved substantial sums of money.

In these next cases, the subject matter is clearly within the realm of creativity and expressiveness. But the motivation to fight is arguably an interesting question. Was it just about money? Or was it even about money at all? And if not, what was it about?

F.2. Case: Harvard v. Elmore (D.N.M. 2016)

Pre-reading notes

Like many other universities (and especially those in the longevous, affluent elite) Harvard has, alongside its classrooms, laboratories, and libraries, two other accoutrements, which are relevant to this case: a press (i.e., a book publishing operation) and a great accumulation of art and artifacts (existing as multiple collections under the curation of various of the university's museums). Harvard's artifact collections included Hopi pottery of some importance. And expert in the field, Steve Elmore, made a book deal with Harvard. Elmore would write a book that would feature pottery in Harvard's collection and Harvard would publish it.

Elmore wrote the book, but Harvard didn't publish it. The deal went sour somehow. Elmore decided to publish the book with a different press. Needing pictures of pottery from Harvard's collection, Elmore went about that in a way designed to avoid needing to get Harvard's cooperation or permission. But Harvard sued Elmore anyway.

Why?

Good question. It's pretty difficult to believe this case was about money for Harvard. Whatever revenue stream one might hope to get from a book about Hopi pottery would likely get washed out very quickly in an infringement lawsuit – especially fought the way Harvard did it (the docket shows substantial motion practice – including moving for leave to amend its complaint twice!).

Was it anger? Ego? Investing in a don't-mess-with-us reputation? These are all troubling as explanations. Anger is easier to attribute to an individual than a big institution. Ego would seem something Harvard should hardly feel fragile about. And reputation is the most perplexing: What university press would want to be known for its brisk eagerness to sue its authors?

Among other claims (including "false designation of origin"), Harvard accused Elmore of copyright infringement with regard to the book's images of its pottery.

Elmore's plan of obtaining images for his book was clearly well-thought-out for avoiding infringement liability. More than that, arrangements for images appears designed in a way that evinces a solid understanding of copyright doctrine, key cases like *Burrow-Giles v. Sarony* and *Feist v. Rural Telephone*, and the ins and outs of the statutory language.

But that didn't stop Harvard from following Elmore out to the New Mexico desert to chase him down with whatever arguments they could muster.

Opinion

[Headings restyled and de-numbered. Various citations removed without indication. The superscript commat @ (aka "at symbol") indicates text moved from a different place in the document, done in the service of readability and brevity. – Ed.]

Harvard v. Steve Elmore

United States District Court for the District of New Mexico
2016 WL 7494274 (D.N.M. 2016)

President and Fellows of Harvard College, Plaintiff, v. Steve Elmore, Steve Elmore Photography,Inc., d/b/a Steve Elmore Indian Art, and d/b/a Spirit Bird Press, Defendants. No. CIV 15-00472-RB/KK. Memorandum opinion and order. Filed May 19, 2016

Robert C. Brack, United States District Judge

Having reviewed the parties' submissions and arguments, the Court GRANTS Defendant's Motion for Partial Summary Judgment; and DENIES Plaintiff's Cross-Motion for Partial Summary Judgment that Elmore is Liable for Copyright Infringement.

BACKGROUND

Mr. Elmore and Harvard contracted to publish a book, provisionally titled *In Search of Nampeyo: the Apprenticeship of a Great Hopi Artist*. In theory, it was a good deal for both parties. Harvard stood to benefit because the book would discuss pottery in Harvard's Keam collection, which is held in Harvard's Peabody Museum, and potentially attribute much of the artifacts to a renowned Hopi artist, Nampeyo. Mr. Elmore also stood to benefit, because the book would build his credibility as an author and dealer of Hopi pottery. The deal, however, did not go according to plan.

Three and a half years after the agreement, Harvard declined to publish Mr. Elmore's book and returned rights to the manuscript to Mr. Elmore. Undeterred, Mr. Elmore decided to self-publish his manuscript, now entitled *In Search of Nampeyo: The Early Years, 1875–1892*, through Spirit Bird Press, a subsidiary of Steve Elmore Indian Art. Mr. Elmore used, among other illustrations, one photograph of a "Tusayan or Kayenta black on white jar" from the Keam collection (Tusayan Jar) and over 40 images based on photographs in *Historic Hopi Ceramics*, a book published by Harvard's Peabody Museum Press. Mr. Elmore never asked to publish these images.

The photograph of the Tusayan jar was a "conservation image" taken in 1980 "as part of a condition assessment" of the collection. Viewing the facts in a light most favorable to Harvard, Peabody Museum Photographer Hillel Burger took the photograph.˜ Harvard posted the photograph as part of Harvard's online collection. ˜The image is a close-up side view of the Tusayan jar, angled slightly above eye level to show the entire rim of the jar, which shows two chips in the rim, one in the foreground and one on the back side of the rim. The background reveals a pot to the left of the jar and what looks like another pot and a desk with a picture on it to the right of the jar.

Harvard applied for copyright registration of this photograph on February 16, 2016 and the U.S. Copyright Office registered the copyright˜.

Historic Hopi Ceramics was "meant to be a catalog of the Keam [c]ollection[,]" similar to Harvard's online collections. The authors described the book as a "preliminary survey of historic Hopi ceramics from the Keam collection." *Historic Hopi Ceramics* includes photographs of "[t]he majority of decorated Hopi vessels" in the Keam collection, excluding only duplicate artifacts, undecorated bowls, and designs too worn to be captured by a photograph.˜ The images float in space. Someone, the photographer, author, or another collaborator, stripped the background from each photograph and arranged the images in row upon row for examination. Peabody Museum photographer Hillel Burger provided "photographic expertise" for *Historic Hopi Ceramics*, but Kathleen Borie and Allyson Humphry "photographed the objects." Harvard registered a copyright for *Historic Hopi Ceramics* in 1981, the same year the book was published.

Mr. Elmore commissioned Mark Diederichsen to make illustrations for his book based on the photographs in *Historic Hopi Ceramics.* The process was "inelegant." (Mr. Deiderichsen testifying.) ˜Mr. Diedrichsen used the computer program Photoshop to trace over the photographs, fill in the tracings, and erase the photographs. By filling in the patterns, Mr. Diederichsen eliminated the photographs' original gray scale. Mr. Diedrichsen colored the images, using tan, black, and red "[t]o identify the design elements" in the pottery. Mr. Diederichsen "didn't add anything creative" to the illustrations, but instead "clean[ed] up the design" and "defin[ed] the details...." He also lightened numerous images and removed blemishes in the pots.

After Mr. Elmore published his book, Harvard filed suit alleging, among other claims, that Mr. Elmore infringed on Harvard's copyright for *Historic Hopi Ceramics.* Harvard {also} asserted a claim for copyright infringement of the Tusayan jar photograph.˜@

Harvard requested a preliminary injunction to stop Mr. Elmore from distributing his book and using copyrighted photographs, and the Court temporarily enjoined distribution of Mr. Elmore's book.˜@ {T}he Court ruled that Mr. Elmore likely did not infringe on the copyright of the Tusayan

jar photograph for the purpose of the preliminary injunction.˜@ Mr. Elmore and Harvard filed cross motions for partial summary judgment on the copyright infringement claims.˜@

The Court denies Mr. Elmore's Motion to Dismiss the Amended Complaint because˜ service was only six days late and the delay did not prejudice the parties. The Court grants Harvard's Motion for Extension of Time to Respond, because Harvard requested the extension before the deadline ran, Harvard had a reasonable explanation for good cause, and the extension did not delay the case.˜

PARTIAL SUMMARY JUDGMENT

˜Courts consider issues of law and fact to resolve copyright disputes. For example, courts consider "whether, as a factual matter, the defendant copied [the] plaintiff's work" and "as a mixed question of law and fact," the extent to which legally protected elements in the plaintiff's work are "substantially similar" to the defendant's work.˜

Discussion of the Copyright Infringement Claim˜

Factual Copying

This case presents one of those rare circumstances where factual copying of both the *Historic Hopi Ceramics* photographs and the Tusayan jar photographs appears clear. Both Mr. Elmore and Mr. Diederichsen admitted to actions sufficient to show factual copying of the *Historic Hopi Ceramics* photographs. The obvious similarity between Harvard's Tusayan jar photograph and the photograph in Mr. Elmore's book indicates that Mr. Elmore also copied the photograph of the Tusayan jar image.˜ No reasonable juror would doubt that factual copying occurred here˜.˜

Ownership of a Valid Copyright

Copyrights only protect "original works of authorship[,]" 17 U.S.C. § 102, and to be original, a work must be "independently created by the author (as opposed to copied from other works), and ... possess[ ] at least some minimal degree of creativity," *Feist Publ'ns*, 499 U.S. at 345. "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.* (quoting

1 *Nimmer on Copyright* § 1.08 [C][1]). "[P]hotographs are copyrightable, if only to the extent of their original depiction of the subject." *Meshwerks, Inc. v. Toyota Motor Sales U.S.A., Inc.*, 528 F.3d 1258, 1264 (10th Cir. 2008). Whereas the image in a photograph cannot be copyrighted, "the photographer's decisions regarding pose, positioning, background, lighting, shading, and the like ... can be said to 'owe their origins' to the photographer, making the photograph copyrightable, at least to that extent." *Id.* Conversely, illustrations "*intended* to be as accurate as possible in reproducing the [image] on which they were based" constitute only "a form of slavish copying that is the antithesis of originality." *Id.* at 1269 (quoting *ATC Distribution Grp., Inc. v. Whatever It Takes Transmissions & Parts, Inc.*, 402 F.3d 700, 712 (6th Cir. 2005)).˜

Copyright of Tusayan Jar Photograph

To determine whether a work qualifies for registration, the Copyright Office follows its administrative manual, the *Compendium of U.S. Copyright Practices, Third Edition.* U.S. Copyright Office, *Compendium of U.S. Copyright Practices* 1 (3d ed. 2014). The *Compendium* notes that "[a]s with all copyrighted works, a photograph must have a sufficient amount of creative expression to be eligible for registration." *Id.* § 909.1. The *Compendium* specifies that "creativity in a photograph may include the photographer's artistic choices in creating the image, such as the selection of the subject matter, the lighting, any positioning of subjects, the selection of camera lens, the placement of the camera, the angle of the image, and the timing of the picture." *Id.* On the other hand, the *Compendium* instructs the Copyright Office not to register works "if it is clear that the photographer merely used the camera to copy the source work without adding any creative expression to the photo." *Id.* § 909.3.

Case law supports reliance on external evidence to evaluate whether a creative spark exists for copyright protection. In *Schrock v. Learning Curve Int'l, Inc.*, 586 F.3d 513, 516 (7th Cir. 2009), the court considered whether exact copies of a marketing photograph infringed on a copyright where the photographer depicted toys in a scene. The court found sufficient expression in the photograph for "limited" protection based in part on the

photographer's testimony. *Id.* at 520. In capturing the scene, the photographer:

> used various camera and lighting techniques to make the toys look more "life like," "personable," and "friendly." [The photographer] explained how he tried to give the toys "a little bit of dimension" and that it was his goal to make the toys "a little bit better than what they look like when you actually see them on the shelf."

Id. at 519 (quoting the photographer's testimony). Similarly, the court in *SHL Imaging, Inc. v. Artisan House, Inc.*, 117 F. Supp. 2d 301, 301 (S.D.N.Y. 2000), considered photographs of picture and mirror frames taken for a merchant who sold the frames. The photographer made careful decisions regarding the camera, lens and film, and lighting "to fill out the shadows (but not eliminate them) to give a chiaroscuro effect that would wrap around the [frame] and give it depth." *Id.* at 304, 311 (quoting the photographer's affidavit). The court contrasted these photographs with other photographs where "[t]he gilded frames [were] dull and the details [were] obscured by shadows or overexposed." *Id.* at 311. Given the limited, but present, expression, these photographs were protected from "verbatim copying." *Id.*

The photograph of the Tusayan jar lacks a creative spark because it depicts the artifact in an obvious, preordained angle and depth of field to best record the artifact's condition. Any two dimensional depiction of a three dimensional object necessarily captures only one angle and depth of field. Yet the logical result cannot be that any two dimensional depiction of a three dimensional object qualifies for copyright registration.˜ In Harvard's case, the photograph was not part of a study of photography, but rather a "conservation image," taken "as part of a condition assessment." The angle and positioning of the artifact best show the condition of the Tusayan jar. By showing the entire rim in that position, the photograph captures both chips in the artifact's rim. These choices were utilitarian, not creative, made to best copy the three dimensional artifact.

The presence of the background images reinforces this conclusion. Instead of crafting a background to best portray the object, the photographer merely took the photograph where the artifact rested, without any apparent

rationale for including the objects in the background. This happenstance is much more like the default, over-exposed photographs in *SHL Imaging* than the chiaroscuro photographs that received copyright protection. *SHL Imaging*, 117 F. Supp. 2d at 301. Thus, any reasonable juror would determine that the photographer merely used the camera to "copy the source work without adding any creative expression to the photo." U.S. Copyright Office, *Compendium of U.S. Copyright Practices* at § 909.3.

Moreover, Harvard presents no evidence that the photographer intended to achieve any purpose other than to record the condition of the artifact depicted.[4]

> [4] Harvard seeks to introduce an excerpt of a book that quotes Mr. Burger, who allegedly took the photograph of the Tusayan jar and provided "photographic expertise" for *Historic Hopi Ceramics*. For his part, Mr. Elmore seeks to introduce an article by one of the authors of *Historic Hopi Ceramics*, Lea S. McChesney. Both statements are inadmissible hearsay. See Fed. R. Evid. 801(c), 802. Harvard asserts that Mr. Burger's statements are admissible under Federal Rule of Evidence 804(b)(6). Harvard's citation to Rule 804(b)(6) was likely in error, because this rule only allows statements "offered against a party that wrongfully caused ... the declarant's unavailability as a witness, and did so intending that result." Likely, Harvard sought to invoke the residual exception, Federal Rule of Civil Procedure 807(a), instead. This rule does not apply either, because Harvard provides no examples of "equivalent circumstantial guarantees of trustworthiness...."~

{C}ourts require evidence of "a minimal degree of creativity" to determine that a work is protected by copyright. *Feist Publ'ns*, 499 U.S. at 345. Absent evidence in the work itself, extrinsic evidence can help identify creative decisions. *See Schrock*, 586 F.3d at 516; *SHL Imaging*, 117 F. Supp. 2d at 301. The requirement for creativity, however it is shown, defines the substantive rights of the parties. *See Feist Publ'ns*, 499 U.S. at 345. Harvard can provide no evidence of intentional decision-making, and thus Harvard does not own a valid copyright of the Tusayan jar photograph. The Court

grants Mr. Elmore's claim for summary judgment on the infringement claim for the Tusayan jar.

Copyright of Historic Hopi Ceramics *Photographs*

The copyright for *Historic Hopi Ceramics* was registered in 1981, thus establishing prima facie evidence of a valid copyright.˜ Admittedly, it's a stretch to say that the photographs in *Historic Hopi Ceramics* contain significant creativity. The angle and positioning is unimaginative, as are the repetitive shots of each artifact. The description of the overall work as a "catalog" and a "preliminary survey" reinforces the sense that the photographer intended these photographs to reproduce the images as accurately as possible.

Even so, the decision to capture each artifact in the same manner, while evidence of very little creativity, demonstrates a spark beyond slavish copying. Resolving all inferences in a light most favorable to Harvard, the photographers also chose the position of the artifacts to depict, which for the pots required selecting one out of a circumference of options. Each artifact had to be posed in the exact same way, and each background stripped, to emphasize the impact of the collection as a whole rather than the intricacies of each individual piece. The authors' decision to show first the interiors of all pots and then the exteriors to portray "separate design systems" emphasizes this creative decision. Tellingly, Mr. Elmore made his own decisions in grouping the photographs, sometimes electing not to follow the same approach. Lastly, some "photographic expertise" contributed to the photographs' creation. While expertise on its own is insufficient to show creativity, the expertise combined with the selection of positions and decision to portray the artifacts in a manner that emphasized the collection as a whole indicates a "minimal degree of creativity"—if only a humble spark.

Protected Elements of Historic Hopi Ceramics

Even if a work is copyrighted, the copyright may not protect "every element of the work." *Feist Publ'ns*, 499 U.S. at 348. {W}orks that lack even a spark of originality exist at one end of the spectrum and receive no copyright protection at all. *See Meshwerks*, 528 F.3d at 1269. Similarly, if a work depicts a subject susceptible to "only a narrow range of expression (for

example, there are only so many ways to paint a red bouncy ball on blank canvas), then copyright protection is thin and a work must be 'virtually identical' to infringe." *Mattel, Inc. v. MGA Entm't, Inc.*, 616 F.3d 904, 914 (9th Cir. 2010); *see also Feist Publ'ns*, 499 U.S. at 349 (factual compilations). The less original the plaintiff's work, the more the defendant must copy to infringe on the plaintiff's copyright. 4 *Nimmer on Copyright* § 13.03[A][4].[5]

> [5] Harvard argues that direct copying of any work results in copyright infringement. ("Others are free to copy the original. They are not free to copy the copy.") (quoting *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 249 (1903)).) *Bleistein* addresses a distinct context: exact copies of illustrated advertisements. *Id.* at 248. The Court in *Bleistein* notes the extent of the original creation, including the ensemble of subjects, details in the scenes, color choices, and freehand drawing. *Id.* at 250. That copyright protected all of these creative decisions, and an exact copy would violate that protection. The situation may be different where the copyright protects less of the work and the copying is less exact.

Here, the copyright for *Historic Hopi Ceramics* does not protect against copying the most prominent features in the works: the intricate pottery designs and forms achieved by a Hopi potter, perhaps Nampeyo. Instead, the issue is whether Mr. Elmore's images are substantially similar to the protected but less obvious aspects of the *Historic Hopi Ceramics. See Meshwerks*, 528 F.3d at 1269. Given the minimal creativity in the compilation and arrangement of the artifacts, the protected content of the *Historic Hopi Ceramics* photographs is incredibly limited. Thus, the copyright protects only against copies that achieve the same emphasis on the condition of the collection as a whole, basically verbatim copies.

The *Historic Hopi Ceramics* images in Mr. Elmore's book are not verbatim copies and do not achieve the same effect.˜ Mr. Diederichsen˜ removed the lighting from the images by changing them from grayscale to line art. He added color to highlight design elements. He even decreased the effect of the photographers' selection of the pots' positions by˜ cleaning up designs, and defining details. Although the absence of a background remains, the overall effect shifts the emphasis from the collection of artifacts in their

current condition, to the design elements as originally depicted on the artifacts. Considering only the protected elements in the *Historic Hopi Ceramic* photographs and Mr. Elmore's images, reasonable minds could not find substantial similarity between the two. Consequently, the images based on the *Historic Hopi Ceramic* photographs do not infringe on Harvard's copyright, and summary judgment for Mr. Elmore is appropriate.˜

THEREFORE,

IT IS ORDERED˜ that Mr. Elmore's Motion for Partial Summary Judgment is GRANTED; and Harvard's Cross-Motion for Partial Summary Judgment that Elmore is Liable for Copyright Infringement is DENIED.

F.3. Case: Kelley v. Chicago Parks (7th Cir. 2011)

Pre-reading notes

This case is a fantastic vehicle for simultaneously exploring multiple aspects of copyrightability doctrine. But it has an atypical procedural posture. The plaintiff, Chapman Kelley, is an artist who created a garden display as an art installation in a Chicago park. Kelley and the parks department had a falling out, and Kelley sued. But he didn't sue for copyright infringement. Instead, he sued under the Visual Artists Rights Act of 1990 ("VARA"), which allows artists, under certain circumstances, to sue with regard to their "right of integrity" in their artwork. Because of the way Congress wrote VARA, a pre-requisite to proving a VARA violation is proving the copyrightability over the artwork sued upon.

Here, Kelley loses his lawsuit because the court determines his garden-as-artwork fails to meet two requirements for copyrightability: authorship and fixation.

Opinion

[The superscript hash symbol # has been used to indicate certain places where citations were removed. –Ed.]

Chapman Kelley v. Chicago Park District

United States Court of Appeals for the Seventh Circuit
635 F.3d 290 (7th Cir. 2011)

SYKES, Circuit Judge.

Chapman Kelley is a nationally recognized artist known for his representational paintings of landscapes and flowers – in particular, romantic floral and woodland interpretations set within ellipses. In 1984 he received permission from the Chicago Park District to install an ambitious wildflower display at the north end of Grant Park, a prominent public space in the heart of downtown Chicago. "Wildflower Works" was thereafter planted: two enormous elliptical flower beds, each nearly as big as a football field, featuring a variety of native wildflowers and edged with borders of gravel and steel.

Promoted as "living art," Wildflower Works received critical and popular acclaim, and for a while Kelley and a group of volunteers tended the vast garden, pruning and replanting as needed. But by 2004 Wildflower Works had deteriorated, and the City's goals for Grant Park had changed. So the Park District dramatically modified the garden, substantially reducing its size, reconfiguring the oval flower beds into rectangles, and changing some of the planting material.

Kelley sued the Park District for violating his "right of integrity" under the Visual Artists Rights Act of 1990 ("VARA"), 17 U.S.C. § 106A, and also for breach of contract. The contract claim is insubstantial; the main event here is the VARA claim, which is novel and tests the boundaries of copyright law. Congress enacted this statute to comply with the nation's obligations under the Berne Convention for the Protection of Literary and Artistic Works. VARA amended the Copyright Act, importing a limited version of the civil-law concept of the "moral rights of the artist" into our intellectual-property law. In brief, for certain types of visual art – paintings, drawings, prints, sculptures, and exhibition photographs – VARA confers upon the artist certain rights of attribution and integrity. The latter include the right of the artist to prevent, during his lifetime, any distortion or modification of his work that would be "prejudicial to his ... honor or reputation," and to

recover for any such intentional distortion or modification undertaken without his consent.

The district court held a bench trial˜. The court rejected Kelley's moral-rights claim˜. {The trial court judge held that Wildflower Works lacked eligibility} for copyright, a foundational requirement in the statute.˜

{The district court} was right to reject this claim; for reasons relating to copyright's requirements of expressive authorship and fixation, a living garden like Wildflower Works is not copyrightable.

I. Background

Kelley is a painter noted for his use of bold, elliptical outlines to surround scenes of landscapes and flowers. In the late-1970s and 1980s, he moved from the canvas to the soil and created a series of large outdoor wildflower displays that resembled his paintings. He planted the first in 1976 alongside a runway at the Dallas–Fort Worth International Airport and the second in 1982 outside the Dallas Museum of Natural History. The wildflower exhibit at the museum was temporary; the one at the airport just "gradually petered out."

In 1983 Kelley accepted an invitation from Chicago-based oil executive John Swearingen and his wife, Bonnie – collectors of Kelley's paintings – to come to Chicago to explore the possibility of creating a large outdoor wildflower display in the area. He scouted sites by land and by air and eventually settled on Grant Park, the city's showcase public space running along Lake Michigan in the center of downtown Chicago. This location suited Kelley's artistic, environmental, and educational mission; it also provided the best opportunity to reach a large audience. Kelley met with the Park District superintendent to present his proposal, and on June 19, 1984, the Park District Board of Commissioners granted him a permit to install a "permanent Wild Flower Floral Display" on a grassy area on top of the underground Monroe Street parking garage in Daley Bicentennial Plaza in Grant Park. Under the terms of the permit, Kelley was to install and maintain the exhibit at his own expense. The Park District reserved the right to terminate the installation by giving Kelley "a 90 day notice to remove the planting."

Kelley named the project "Chicago Wildflower Works I." The Park District issued a press release announcing that "a new form of 'living' art" was coming to Grant Park – "giant ovals of multicolored wildflowers" created by Kelley, a painter and "pioneer in the use of natural materials" who "attracted national prominence for his efforts to incorporate the landscape in artistic creation." The announcement explained that "[o]nce the ovals mature, the results will be two breathtaking natural canvases of Kelley-designed color patterns."

In the late summer of 1984, Kelley began installing the two large-scale elliptical flower beds at the Grant Park site; they spanned 1.5 acres of parkland and were set within gravel and steel borders. A gravel walkway bisected one of the ovals, and each flower bed also accommodated several large, preexisting air vents that were flush with the planting surface, providing ventilation to the parking garage below. For planting material Kelley selected between 48 and 60 species of self-sustaining wildflowers native to the region. The species were selected for various aesthetic, environmental, and cultural reasons, but also to increase the likelihood that the garden could withstand Chicago's harsh winters and survive with minimal maintenance. Kelley designed the initial placement of the wildflowers so they would blossom sequentially, changing colors throughout the growing season and increasing in brightness towards the center of each ellipse. He purchased the initial planting material – between 200,000 and 300,000 wildflower plugs – at a cost of between $80,000 and $152,000. In September of 1984, a battery of volunteers planted the seedlings under Kelley's direction.

When the wildflowers bloomed the following year, Wildflower Works was greeted with widespread acclaim. Chicago's mayor, the Illinois Senate, and the Illinois Chapter of the American Society of Landscape Artists issued commendations. People flocked to see the lovely display – marketed by the Park District as "living landscape art" – and admiring articles appeared in national newspapers. Wildflower Works was a hit.˜

For the next several years, Kelley's permit was renewed and he and his volunteers tended the impressive garden. They pruned and weeded and regularly planted new seeds, both to experiment with the garden's

composition and to fill in where initial specimen had not flourished. Of course, the forces of nature – the varying bloom periods of the plants; their spread habits, compatibility, and life cycles; and the weather – produced constant change. Some wildflowers naturally did better than others. Some spread aggressively and encroached on neighboring plants. Some withered and died. Unwanted plants sprung up from seeds brought in by birds and the wind. Insects, rabbits, and weeds settled in, eventually taking a toll. Four years after Wildflower Works was planted, the Park District decided to discontinue the exhibit. On June 3, 1988, the District gave Kelley a 90–day notice of termination.

Kelley responded by suing the Park District in federal court, claiming the termination of his permit violated the First Amendment. The parties quickly settled; in exchange for dismissal of the suit, the Park District agreed to extend Kelley's permit for another year. On September 14, 1988, the Park District issued a "Temporary Permit" to Kelley and Chicago Wildflower Works, Inc., a nonprofit organization formed by his volunteers.˜

The Park District formally extended this permit each succeeding year through 1994. After that point Kelley and his volunteers continued to cultivate Wildflower Works without a permit, and the Park District took no action, adverse or otherwise, regarding the garden's future. In March 2004 Kelley and Jonathan Dedmon, president of Wildflower Works, Inc., attended a luncheon to discuss the 20th anniversary of Wildflower Works. At the luncheon Dedmon asked Park District Commissioner Margaret Burroughs if Wildflower Works needed a new permit. Commissioner Burroughs responded, "You're still there, aren't you? That's all you need to do."

Three months later, on June 10, 2004, Park District officials met with Kelley and Dedmon to discuss problems relating to inadequate maintenance of the garden and forthcoming changes to Grant Park necessitated by the construction of the adjacent Millennium Park. The officials proposed reconfiguring Wildflower Works – decreasing its size from approximately 66,000 square feet to just under 30,000 square feet and remaking its elliptical flower beds into rectangles.˜ Kelley objected to the proposed changes˜ A week later the Park District proceeded with its plan and reduced Wildflower

Works to less than half its original size. The elliptical borders became rectilinear, weeds were removed, surviving wildflowers were replanted in the smaller-scale garden, and some new planting material was added. Dedmon sent a letter of protest to the Park District.

Kelley then sued the Park District for violating his moral rights under VARA. He claimed that Wildflower Works was both a painting and a sculpture and therefore a "work of visual art" under VARA, and that the Park District's reconfiguration of it was an intentional "distortion, mutilation, or other modification" of his work and was "prejudicial to his ... honor or reputation."˜ On the VARA claim Kelley sought compensation for the moral-rights violation, statutory damages, and attorney's fees˜. He later quantified his damages, ˜requesting a staggering $25 million for the VARA violation.˜

The case proceeded to a bench trial, and the district court entered judgment for the Park District on the VARA claim˜.

Kelley appealed˜.

II. Discussion

This case comes to us from a judgment entered after a bench trial; we review the district court's factual findings for clear error and its conclusions of law de novo.# In this circuit, questions of copyright eligibility are issues of law subject to independent review.#

A. Kelley's Moral–Rights Claim Under the Visual Artists Rights Act of 1990

˜Is Wildflower Works copyrightable?

To merit copyright protection, Wildflower Works must be an "original work [ ] of authorship fixed in a[ ] tangible medium of expression ... from which [it] can be perceived, reproduced, or otherwise communicated." 17 U.S.C. § 102(a).˜

The district court took the position that Wildflower Works was not original˜ because Kelley was not "the first person to ever conceive of and express an arrangement of growing wildflowers in ellipse-shaped enclosed area [s]." *Kelley,* 2008 WL 4449886, at *6. This mistakenly equates

originality with novelty; the law is clear that a work can be original even if it is not novel. *Feist,* 499 U.S. at 345˜.˜

The real impediment to copyright here is not that Wildflower Works fails the test for originality (understood as "not copied" and "possessing some creativity") but that a living garden lacks the kind of authorship and stable fixation normally required to support copyright. Unlike originality, authorship and fixation are *explicit* constitutional requirements; the Copyright Clause empowers Congress to secure for "authors" exclusive rights in their "writings." U.S. Const. art 1, § 8, cl. 8#. The originality requirement is implicit in these express limitations on the congressional copyright power. *See Feist,* 499 U.S. at 346 (The constitutional reference to "authors" and "writings" "presuppose[s] a degree of originality."). The Supreme Court has "repeatedly construed all three terms in relation to one another [or] perhaps has collapsed them into a single concept"; therefore, "[w]ritings are what authors create, but for one to be an author, the writing has to be original." 2 Patry § 3:20.

"Without fixation," moreover, "there cannot be a 'writing.' " *Id.* § 3:22.˜ A work is "fixed" in a tangible medium of expression "when its embodiment in a copy or phonorecord ... is 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. As William Patry explains:

> Fixation serves two basic roles: (1) easing problems of proof of creation and infringement, and (2) providing the dividing line between state common law protection and protection under the federal Copyright Act, since works that are not fixed are ineligible for federal protection but may be protected under state law. The distinction between the intangible intellectual property (the work of authorship) and its fixation in a tangible medium of expression (the copy) is an old and fundamental and important one. The distinction may be understood by examples of multiple fixations of the same work: A musical composition may be embodied in sheet music, on an audio-tape, on a compact disc, on a computer hard drive or server, or as part of a motion picture soundtrack. In

> each of the fixations, the intangible property remains a musical composition.

2 Patry § 3:22 (internal quotation marks omitted).

Finally, "authorship is an entirely human endeavor." *Id.* § 3:19 (2010). Authors of copyrightable works must be human; works owing their form to the forces of nature cannot be copyrighted. *Id.* § 3:19 n. 1; *see also* U.S. Copyright Office, Compendium II: Copyright Office Practices § 503.03(a) ("[A] work must be the product of human authorship" and not the forces of nature.) (1984); *id.* § 202.02(b).

Recognizing copyright in Wildflower Works presses too hard on these basic principles. We fully accept that the artistic community might classify Kelley's garden as a work of postmodern conceptual art. We acknowledge as well that copyright's prerequisites of authorship and fixation are broadly defined. But the law must have some limits; not all conceptual art may be copyrighted. In the ordinary copyright case, authorship and fixation are not contested; most works presented for copyright are unambiguously authored and unambiguously fixed. But this is not an ordinary case. A living garden like Wildflower Works is neither "authored" nor "fixed" in the senses required for copyright.[#]

Simply put, gardens are planted and cultivated, not authored. A garden's constituent elements are alive and inherently changeable, not fixed. Most of what we see and experience in a garden – the colors, shapes, textures, and scents of the plants – originates in nature, not in the mind of the gardener. At any given moment in time, a garden owes most of its form and appearance to natural forces, though the gardener who plants and tends it obviously assists. All this is true of Wildflower Works, even though it was designed and planted by an artist.

Of course, a human "author" – whether an artist, a professional landscape designer, or an amateur backyard gardener – determines the initial arrangement of the plants in a garden. This is not the kind of authorship required for copyright. To the extent that seeds or seedlings can be considered a "medium of expression," they originate in nature, and natural forces – not the intellect of the gardener – determine their form, growth, and appearance. Moreover, a garden is simply too changeable to satisfy the

primary purpose of fixation; its appearance is too inherently variable to supply a baseline for determining questions of copyright creation and infringement. If a garden can qualify as a "work of authorship" sufficiently "embodied in a copy," at what point has fixation occurred? When the garden is newly planted? When its first blossoms appear? When it is in full bloom? How – and at what point in time – is a court to determine whether infringing copying has occurred?

In contrast, when a landscape designer conceives of a plan for a garden and puts it in writing – records it in text, diagrams, or drawings on paper or on a digital-storage device – we can say that his intangible intellectual property has been embodied in a fixed and tangible "copy." This writing is a sufficiently permanent and stable copy of the designer's intellectual expression and is vulnerable to infringing copying, giving rise to the designer's right to claim copyright. The same cannot be said of a garden, which is not a fixed copy of the gardener's intellectual property. Although the planting material is tangible and can be perceived for more than a transitory duration, it is not stable or permanent enough to be called "fixed." Seeds and plants in a garden are naturally in a state of perpetual change; they germinate, grow, bloom, become dormant, and eventually die. This life cycle moves gradually, over days, weeks, and season to season, but the real barrier to copyright here is not *temporal* but *essential.* The essence of a garden is its vitality, not its fixedness. It may endure from season to season, but its nature is one of dynamic change.˜

Because Kelley's garden is neither "authored" nor "fixed" in the senses required for basic copyright, it cannot qualify for moral-rights protection under VARA.˜

G. Monkeys and Machines, 2016-2025

G.1. Lead-in

And now the path leads us right up to the present. Here we have two new factual situations: Authorship by animals, and authorship by artificial intelligence.

But, again, we won't need new statute or caselaw.

If you look back at the road we've traveled to get here – including, in particular: *Burrow-Giles v. Sarony*, *Feist v. Rural Telephone*, and *Kelley v. Chicago Parks* – it really does seem clear that these case could not have come out any other way. But professional photographers, AI investors, and, apparently, monkeys, can be a stubborn bunch.

In the end, the outcome is what it always had to be: The requirement of human authorship means exactly that. Human authorship.

Not everyone is happy with that. But as a famous "non-human" expression goes: Resistance is futile.

Futile, yes. But instructive nonetheless.

G.2. Cases/Saga: The "Monkey Selfie" and Naruto v. Slater (N.D. Cal. 2016)

G.2.1. Pre-reading notes

There's a lot going on here. There's a monkey, a camera, a professional photographer, and Wikipedia. And then PETA (People for the Ethical Treatment of Animals) gets involved.

Essentially this is one saga with two cases: The first case is the professional photographer against Wikipedia. That case is fought only in the court of public opinion (and perhaps also through the intra-office mail at the U.S. Copyright Office). Then the second case is the monkey against the professional photographer. That case gets fought in a court court.

Only so much more can be usefully said by way of introduction. We'll just have to head off into the rain forest.

G.2.2. Facts of the taking of the "Monkey Selfie" photograph

According to a July 4, 2011 article published by *The Telegraph,* photographer David J Slater of Gloucestershire, England was in a national park in Indonesia with a local guide for the purpose of photographing crested black macaques. Slater obtained the assistance of a local guide to help in his quest to photograph the creatures, who were members of a study group of the animals observed by a nearby-stationed team of scientists from the Netherlands.

Slater, as quoted in the article, describes walking with the monkeys "for about three days in a row." Slater said the monkeys "befriended" him and his companion "and showed absolutely no aggression - they were just interested in the things I was carrying." Slater went on to state that macaques "aren't known for being particularly clever like chimps, just inquisitive." And Slater also said the monkeys "probably never" had "any contact with humans before" – which Slater speculated was the reason he could walk along with the group.

At some point, one macaque got hold of a camera of Slater's.

As quoted by the *Telegraph,* this is Slater's account of the particular factual circumstances of the taking of the photos:

> "One of them must have accidentally knocked the camera and set it off because the sound caused a bit of a frenzy. At first there was a lot of grimacing with their teeth showing because it was probably the first time they had ever seen a reflection. They were quite mischievous jumping all over my equipment, and it looked like they were already posing for the camera when one hit the button. The sound got his attention and he kept pressing it. At first it scared the rest of them away but they soon came back – it was amazing to watch. He must have taken hundreds of pictures by the time I got my camera back, but not very many were in focus. He obviously hadn't worked that out yet."

G.2.3. The Monkey Selfie and its reception

The image

One particular photo that resulted from this occasion happened to be a fantastic image.

In terms of the technical aspects (focus, exposure, white balance) and otherwise (lighting, color, composition, and subject matter) the photo is a brilliant gem. The frame-filling face of a monkey flashes a goofy, toothy grin as it peers into the lens. There are no inconvenient shadows – just some soft shading that accentuates macaque's prominent brow and brings out the tight echelons of arcing crinkle-lines that evidence the effort the monkey is expending in grinning. The monkey's face is framed by the brilliant green of a softly out-of-focus jungle canopy. It suggests a paradisal setting.

The perspective of the photo implies that the camera is held by the self-same monkey within its bent-arms grasp. That is to say, the photography is instantly recognizable as a monkey "selfie."

But as received by us, it's more. It is a sentient creature of unspoilt nature playfully teasing us harried humans with a postcard from Eden itself.

It goes viral

The monkey selfie went viral. It made headlines around the world. According to an August 6, 2014 *Telegraph* article, Slater appeared "on websites, newspapers, magazines and television shows around the world."

And Slater netted a handsome monetary payoff. "It was like a year of work, really," he said according to *The Telegraph*.

Apparently media outlets, when re-publishing the photo, were routinely paying Slater and crediting Slater. As if he were the photographer. As if owned the copyright.

For instance, the 2011 and 2014 *Telegraph* articles referenced above ran the picture with the credit: "Photo: David J Slater/Caters".

In the credit, "Caters" refers to a UK photographic agency. That is to say an agency in the vein of a talent agency or modeling agency – an entity that represents photographers and negotiates deals.

G.2.4. Slater's claims of copyright to the Monkey Selfie; ensuing copyright dispute with Wikimedia; attempted copyright registration

Wikipedia – the massive free and open-source encyclopedia – is owned and operated by the non-profit Wikimedia Foundation.

Wikimedia maintains the basic platform. They have paid staff, for instance, that keep the servers running. (No mean feat.) But the real workforce is what Wikimedia calls "the community."

Wikimedia doesn't pay for content. Authors and editors are all volunteers – members of the community. And Wikimedia doesn't pay for the images that illustrate Wikipedia. That's up to volunteers as well.

Wikimedia has cultivated its own massive repository of free imagery called Wikimedia Commons. Legions of illustrators, animators, and photographers release their visual works to the public under free/open-source licenses. And, of course, the community is always on the lookout for images that are in the public domain. And there's a fair bit of copyright knowledge among Wikimedia's vast army of volunteer caretakers.

Thus it was inevitable that someone would upload the Monkey Selfie to the Wikimedia Commons.

The tag with the image says:

> "This file is in the public domain because, as the work of a non-human animal, it has no human author in whom copyright is vested."

David J Slater was not fine with this.

In its August 2014 coverage, *The Telegraph* reported:

> "Mr Slater is now facing a legal battle with Wikimedia after the organisation added the image to its collection of royalty-free images online. ... The Gloucestershire-based photographer now claims that the decision is jeopardising his income as anyone can take the image and publish it for free, without having to pay him a royalty. He complained To Wikimedia that he owned the copyright of the image, but ... editors decided that Mr Slater has no claim on the image as the monkey itself took the picture."

Slater tried to obtain a copyright registration on the photo – perhaps as a first step in attempting legal action against Wikimedia – but the U.S. Copyright Office refused the application.

Subsequent to David J Slater's rejected application for copyright registration the Monkey Selfie, the agency memorialized the matter as an example in its *Compendium of U.S. Copyright Office Practices*.

G.2.5. Copyright Office on lack of human authorship

The *Compendium of U.S. Copyright Office Practices* "is the administrative manual of the Register of Copyrights concerning Title 17 of the United States Code and Chapter 37 of the Code of Federal Regulations. It provides instruction to agency staff regarding their statutory duties and provides expert guidance to copyright applicants, practitioners, scholars, the courts, and members of the general public regarding institutional practices and related principles of law."

Here is what the manual says about human authorship and the lack thereof:

Compendium of U.S. Copyright Office Practices, Third Edition, §§ 306 & 313.2

Effective date December 22, 2014. Updated January 28, 2021.

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). For representative examples of works that do not satisfy this requirement, see Section 313.2 below.

313.2 Works That Lack Human Authorship

As discussed in Section 306, the Copyright Act protects "original works of *authorship*." 17 U.S.C. § 102(a) (emphasis added). To qualify as a work of "authorship" a work must be created by a human being. *See Burrow-Giles Lithographic Co.*, 111 U.S. at 58. Works that do not satisfy this requirement are not copyrightable.

The U.S. Copyright Office will not register works produced by nature, animals, or plants.˜

Examples:

- A photograph taken by a monkey.
- A mural painted by an elephant.
- A claim based on the appearance of actual animal skin.
- A claim based on driftwood that has been shaped and smoothed by the ocean.
- A claim based on cut marks, defects, and other qualities found in natural stone.˜

Similarly, the Office will not register works produced by a machine or mere mechanical process that operates randomly or automatically without any creative input or intervention from a human author. The crucial question is "whether the 'work' is basically one of human authorship, with the computer [or other device] merely being an assisting instrument, or whether the traditional elements of authorship in the work (literary, artistic, or musical expression or elements of selection, arrangement, etc.) were actually conceived and executed not by man but by a machine." " U.S. COPYRIGHT OFFICE, REPORT TO THE LIBRARIAN OF CONGRESS BY THE REGISTER OF COPYRIGHTS 5 (1965).

Examples:

- Reducing or enlarging the size of a preexisting work of authorship.
- Making changes to a preexisting work of authorship that are dictated by manufacturing or materials requirements.
- Converting a work from analog to digital format, such as transferring a motion picture from VHS to DVD.
- Declicking or reducing the noise in a preexisting sound recording or converting a sound recording from monaural to stereo sound.
- Transposing a song from B major to C major.
- Medical imaging produced by x-rays, ultrasounds, magnetic resonance imaging, or other diagnostic equipment.

• A claim based on a mechanical weaving process that randomly produces irregular shapes in the fabric without any discernible pattern.

G.2.6. The "who owns it" question; enter PETA

Interestingly, *The Telegraph* couldn't seem to quite wrap its head around the idea that the photograph might be unowned. "Who owns the monkey selfie?" asked a section heading.

The newspaper then quoted Slater: "If the monkey took it, it owns copyright, not me, that's their basic argument."

An NPR headline the same month asked: "If A Monkey Takes A Photo, Who Owns The Copyright?"

It's interesting to consider what this means. Do persons untrained in copyright tend to assume that for every photograph there must be some owner? If so, why?

But Slater himself clearly appreciated that monkey ownership wasn't the only possible legal outcome. In an another quote in the *Telepgraph* article Slater addressed the public domain issue, by way of staking a basis for his own claim: "{T}hey've got no right to say that its public domain. A monkey pressed the button, but I did all the setting up."

(Hmmm. Does "all the setting up" mean Slater is claiming authorial creativity? Or is he talking about sweat of the brow?)

Either way, this seems to be one place where the monkey and Slater could agree to agree: Nix the public domain. It's you or me, monkey.

Except that monkeys don't generally file lawsuits or choose legal stances to take. Unless they have a friend to help them. And this monkey – who we soon were told is named "Naruto" – found a friend in People for the Ethical Treatment of Animals (or "PETA") a storied animal-rights activist organization and a seasoned litigant to boot. Coming to help PETA and the monkey was the Los Angeles law firm of Irell & Manella. (That's the same firm that pursued and beat Westlaw in the Star Pagination Case. But Irell didn't fare as well for the monkey.)

G.2.7. Opinion

[Headings were restyled.]

Naruto v. Slater

United States District Court for the Central District of California
2016 WL 362231
(N.D. Cal. 2016)

Naruto, et al., Plaintiffs, v. David John Slater, et al., Defendants. 15-cv-04324-WHO 2016; "Order Granting Motions to Dismiss Re: Dkt. Nos. 24, 28" signed January 28, 2016.

WILLIAM H. ORRICK, United States District Judge

Introduction

This case arises out of allegations that Naruto, a six-year-old crested macaque, took multiple photographs of himself (the "Monkey Selfies") using defendant David John Slater's camera. The complaint, filed by the People for the Ethical Treatment of Animals ("PETA") and Antje Engelhardt as "Next Friends," alleges that defendants Slater, Blurb, Inc. (the "publisher" of a book by Slater containing the Monkey Selfies), and Wildlife Personalities, Ltd. (a United Kingdom company that, along with Slater, "falsely" claims authorship of the Monkey Selfies) violated Naruto's copyright by displaying, advertising, and selling copies of the Monkey Selfies. On January 6, 2016, I heard argument on the defendants' motions to dismiss that assert that Naruto does not have standing and cannot state a claim under the Copyright Act. Because the Copyright Act does not confer standing upon animals like Naruto, defendants' motions to dismiss are GRANTED.

Background

I accept the allegations in the complaint as true for purposes of the motions to dismiss. Naruto is a six-year old crested macaque who lives in a reserve on the island of Sulawesi, Indonesia. He is "highly intelligent" and possesses "grasping hands and opposable thumbs with the ability to move his fingers independently." Because the reservation where he lives is immediately adjacent to a human village, Naruto has encountered tourists and photographers throughout his life. He was "accustomed to seeing cameras, observing cameras being handled by humans, hearing camera mechanisms being operated, and experienced cameras being used by humans without danger or harm to him and his community." "On information and belief,

Naruto authored the Monkey Selfies sometime in or around 2011" by "independent, autonomous action" in examining and manipulating Slater's unattended camera and "purposely pushing" the shutter release multiple times, "understanding the cause-and-effect relationship between pressing the shutter release, the noise of the shutter, and the change to his reflection in the camera lens."

The Next Friends allege that Slater has repeatedly infringed on Naruto's copyright on the Monkey Selfies by "falsely claiming to be the photographs' authors and by selling copies of the images" for profit. They claim that defendants have violated sections 106 and 501 of the Copyright Act of 1976, by displaying, advertising, reproducing, distributing, offering for sale, and selling copies of the Monkey Selfies. They allege that Naruto is entitled to defendants' profits from the infringement and seek to permanently enjoin defendants from copying, licensing, or "otherwise exploiting" the Monkey Selfies and to permit Next Friends to "administer and protect" Naruto's authorship of and copyright in the Monkey Selfies.˜

Discussion

Defendants argue the complaint should be dismissed for lack of standing under Article III and the Copyright Act of 1976.˜ The Ninth Circuit has stated that Article III "does not compel the conclusion that a statutorily authorized suit in the name of an animal is not a 'case or controversy.'" *Cetacean Cmty. v. Bush*, 386 F.3d 1169, 1175 (9th Cir. 2004). I need not discuss Article III standing further, because regardless of whether Naruto fulfills the requirements of Article III, he must demonstrate standing under the Copyright Act for his claim to survive under Rule 12(b)(6).˜

"[T]he starting point for interpreting a statute is the language of the statute itself." *Consumer Prod. Safety Comm'n v. GTE Sylvania, Inc.*, 447 U.S. 102, 108 (1980). The Copyright Act protects "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." 17 U.S.C. § 102(a). The "fixing" of the work in the tangible medium of expression must be done "by or under the authority of the author." 17 U.S.C. § 101. The Copyright Act defines neither "works of authorship" nor

"author." The Ninth Circuit has observed that the Act "purposefully left 'works of authorship' undefined to provide for some flexibility." *Garcia v. Google, Inc*., 786 F.3d 733, 741 (9th Cir. 2015).

Defendants argue that the Copyright Act confers no rights upon animals such as Naruto. Next Friends respond that the Act has "no definitional limitation." They contend that standing under the Copyright Act is available to anyone, including an animal, who creates an "original work of authorship." They argue that they have sufficiently alleged that Naruto is the author of the Monkey Selfies and are not required to allege "anything else" to demonstrate his standing.

I disagree with Next Friends and follow the rationale of *Cetacean*. In that case, the Cetacean Community (the "Cetaceans"), created by the "self-appointed attorney for all of the world's whales, porpoises, and dolphins," filed suit on behalf of the Cetaceans for violations of the Endangered Species Act, the Marine Mammal Protection Act, and the National Environmental Policy Act. Reviewing the district court's order granting dismissal, the Ninth Circuit examined the language of each statute to assess whether it evidenced congressional intent to confer standing on animals. None did. The court held that "if Congress and the President intended to take the extraordinary step of authorizing animals as well as people and legal entities to sue, they could, and should, have said so plainly." (internal quotation marks, citations, and modifications omitted).

Here, the Copyright Act does not "plainly" extend the concept of authorship or statutory standing to animals. To the contrary, there is no mention of animals anywhere in the Act. The Supreme Court and Ninth Circuit have repeatedly referred to "persons" or "human beings" when analyzing authorship under the Act. *See, e.g., Aalmuhammed v. Lee*, 202 F.3d 1227, 1234 (9th Cir. 2000) ("[A]n author superintends the work by exercising control. This will likely be a *person* who has actually formed the picture by putting the persons in position, and arranging the place where the people are to be.") (internal quotation marks, citations and modifications omitted) (emphasis added); *Urantia Foundation v. Maaherra*, 114 F.3d 955, 958 (9th Cir. 1997) ("For copyright purposes, however, a work is copyrightable if copyrightability is claimed by the first *human beings* who

compiled, selected, coordinated, and arranged [the work].") (emphasis added); *Cmty. for Creative Non-Violence v. Reid*, 490 U.S. 730, 737 (1989) ("As a general rule, the author is the party who actually creates the work, that is the *person* who translates an idea in a fixed, tangible expression entitled to copyright protection.") (emphasis added). Despite Next Friends' assertion that declining to grant a monkey copyright to a photograph "would depart from well-established norms," Next Friends have not cited, and I have not found, a single case that expands the definition of authors to include animals.

Moreover, the Copyright Office agrees that works created by animals are not entitled to copyright protection. It directly addressed the issue of human authorship in the Compendium of U.S. Copyright Office Practices issued in December 2014 (the "Compendium"). "When interpreting the Copyright Act, [the courts] defer to the Copyright Office's interpretations in the appropriate circumstances." *Inhale, Inc. v. Starbuzz Tobacco, Inc*., 755 F.3d 1038, 1041 (9th Cir. 2014); *see also Garcia*, 786 F.3d at 741-42 (describing an expert opinion by the Copyright Office as reflecting a "body of experience and informed judgment to which courts and litigants may properly resort for guidance") (internal quotation marks and citations omitted). In section 306 of the Compendium, entitled "The Human Authorship Requirement," the Copyright Office relies on citations from *Trade-Mark Cases*, 101 U.S. 94 (1879) and *Burrow-Giles* to conclude that it "will register an original work of authorship, provided that the work was created by a human being." *Compendium of the U.S. Copyright Office Practices* § 306 (3d ed.). Similarly, in a section titled "Works That Lack Human Authorship," the Compendium states that, "[t]o qualify as a work of 'authorship' a work must be created by a human being. Works that do not satisfy this requirement are not copyrightable." (internal citations omitted). Specifically, the Copyright Office will not register works produced by "nature, animals, or plants" including, by specific example, a "photograph taken by a monkey."

Naruto is not an "author" within the meaning of the Copyright Act. Next Friends argue that this result is "antithetical" to the "tremendous [public] interest in animal art." Perhaps. But that is an argument that should be made to Congress and the President, not to me.˜

Conclusion

Defendants' motions to dismiss are GRANTED.˜

IT IS SO ORDERED

G.2.8. Slater and PETA's settlement and attempt at erasure

So with the District Court's 2016 decision, Naruto lost – or at least Naruto's "friend" PETA lost. But the reason – that animal-created works are not entitled to copyright protection – wasn't one that worked for David J Slater.

Meanwhile, the case was appealed to the Ninth Circuit. But if the outcome of the litigation was that neither Slater nor Naruto owned a copyright to the photo – since neither qualified as an author, and since without authorship the photo was uncopyrightable – what then?

Well then both sides would lose. And copyright law being what it was, that precise outcome was arguably foreordained. Of course, one can always argue for a change in the law, but surely the uncopyrightability of the photo could not have caught the human litigants by surprise.

In the summer of 2017, when argued at the Ninth Circuit in San Francisco, the human litigants appear to have finally come to grips with where their litigation journey was headed. It appeared that uncopyrightability would be the outcome and that both sides did not want that precedent in the caselaw. That set up a situation ripe for the warring parties to suddenly agree on what they should both do together, immediately: hold hands, bail out together, and trigger the self-destruct sequence on their way out the door.

A later Ninth Circuit opinion explains, in its view, what happened:

> PETA appears to have failed to live up to the title of "friend." After seeing the proverbial writing on the wall at oral argument, PETA and Appellees filed a motion asking this court to dismiss Naruto's appeal and to vacate the district court's adverse judgment, representing that PETA's claims against Slater had been settled. It remains unclear what claims PETA purported to be "settling," since the court was under the impression this lawsuit was about Naruto's claims, and per PETA's motion, Naruto was "not a party to the settlement," nor were Naruto's claims settled therein. Nevertheless, PETA apparently obtained

> something from the settlement with Slater, although not anything that would necessarily go to Naruto: As "part of the arrangement," Slater agreed to pay a quarter of his earnings from the monkey selfie book "to charities that protect the habitat of Naruto and other crested macaques in Indonesia." See Settlement Reached: 'Monkey Selfie' Case Broke New Ground For Animal Rights, PETA. But now, in the wake of PETA's proposed dismissal, Naruto is left without an advocate, his supposed "friend" having abandoned Naruto's substantive claims in what appears to be an effort to prevent the publication of a decision adverse to PETA's institutional interests. Were he capable of recognizing this abandonment, we wonder whether Naruto might initiate an action for breach of confidential relationship against his (former) next friend, PETA, for its failure to pursue his interests before its own. Puzzlingly, while representing to the world that "animals are not ours to eat, wear, experiment on, use for entertainment, or abuse in any other way," PETA seems to employ Naruto as an unwitting pawn in its ideological goals. *{citations omitted}*

G.3. Monkey, Meet Machine

Did Naruto care about having a copyright? That seems unlikely (from a practical perspective). And maybe unknowable (from a philosophical perspective).

As to whether Naruto could be an author? At least philosophically that question seems safely unsettled. Grad students can keep going late into the night with a double-espresso-fueled dialectic on epistemic virtues and animal minds. Legally, however, the summer of 2017 seems to have brought that issue to a close. For all animal kind.

But something else happened that summer. Researchers at Google posted a paper online titled "Attention Is All You Need." The authors were Ashish Vaswani, Llion Jones, Noam Shazeer, Aidan N. Gomez, Niki Parmar, Jakob Uszkoreit, Łukasz Kaiser, and Illia Polosukhin.

The authors claimed to have made a breakthrough (though they didn't use that word) by creating a new computing architecture for language-handling tasks. They dubbed their new system the "transformer" model. With just a small fraction of the training costs lavished on previous models, the transformer model turned out record-setting performance at English to German translation.

In fact, they trained their model over just three and a half days using one machine with eight Nvidia graphics processors. That is, very roughly, the computing resources that would be used by a Boy Scout troop playing first-person-shooter video games over a holiday weekend. And the Google researchers figured their architecture was capable of more. "We are excited about the future of attention-based models and plan to apply them to other tasks," they wrote. (One of the first things they tried was generating fictitious Wikipedia articles. Their transformer model was good at it!) They posted the code they used to train their models on GitHub – so anybody could download it and try it out for themselves.

People did. In late 2022 a chatbot based on the transformer model was released. It was called "ChatGPT," and it became a sensation. The next year, in 2023, everyone was asking. Machine-authored works (*soooo* many sonnets about light sabers, but lots of other things too), were they copyrightable?

Back to the macaque: Hadn't Naruto already gotten the answer?

Copyright lawyers knew. Of course he had.

But people kept asking anyway.

G.4. USCO Report: Artificial Intelligence and Copyrightability

Pre-reading notes

The following excerpt of a report by the U.S. Copyright Office on AI is a nice reading to come to after having gone through the case law on copyrightability from 1879 to the present. It confirms how well you can master about the law of copyrightability by carefully going the leading cases and working through the statutory text.

Generative AI may be a new factual situation, but understanding copyrightability in this context seems to require no new law. One cannot with certitude exclude the possibility of clever new arguments being posed that could introduce matters of legitimate legal controversy. But at least to a very large extent – and perhaps entirely – the careful application of what is already on the books will answer whatever questions one might have about the copyrightability of AI-created works.

Report

Copyright and Artificial Intelligence, Part 2: Copyrightability

A Report of the Register of Copyrights
U.S. Copyright Office
January 2025

from the "Executive Summary"

This second Part of the Copyright Office's Report on Copyright and Artificial Intelligence ("AI") addresses the copyrightability of outputs generated by AI systems. It analyzes the type and level of human contribution sufficient to bring these outputs within the scope of copyright protection in the United States.

Of the more than 10,000 comments the Office received in response to its Notice of Inquiry ("NOI"), approximately half addressed copyrightability. The vast majority of commenters agreed that existing law is adequate in this area and that material generated wholly by AI is not copyrightable.

Commenters differed, however, as to protection for generative AI outputs that involve some form of human contribution. They expressed divergent views on what types and amounts of contribution could constitute authorship under existing law. Many also stressed the desirability of greater clarity in this area, including with respect to the use of AI as a tool in the creative process.

As a matter of policy, some argued that extending protection to materials created by generative AI would encourage the creation of more works of authorship, furthering progress in culture and knowledge to the benefit of the public. The Office also heard concerns that an increased proliferation of AI-generated outputs would undermine incentives for humans to create.˜

Based on an analysis of copyright law and policy, informed by the many thoughtful comments in response to our NOI, the Office makes the following conclusions and recommendations:

- Questions of copyrightability and AI can be resolved pursuant to existing law, without the need for legislative change.
- The use of AI tools to assist rather than stand in for human creativity does not affect the availability of copyright protection for the output.
- Copyright protects the original expression in a work created by a human author, even if the work also includes AI-generated material.
- Copyright does not extend to purely AI-generated material, or material where there is insufficient human control over the expressive elements.
- Whether human contributions to AI-generated outputs are sufficient to constitute authorship must be analyzed on a case-by-case basis.
- Based on the functioning of current generally available technology, prompts do not alone provide sufficient control.
- Human authors are entitled to copyright in their works of authorship that are perceptible in AI-generated outputs, as well as the creative selection, coordination, or arrangement of material in the outputs, or creative modifications of the outputs.
- The case has not been made for additional copyright or *sui generis* protection for AI-generated content.

The Office will continue to monitor technological and legal developments to determine whether any of these conclusions should be revisited.˜

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Z. *hoc supra:* Foundational Cases

This section contains text that belongs earlier in this chapter. (The phrase "hoc supra" is Latin for "put this above.")

Z.1. *hoc supra B.1':* Head's up on old terminology in the Constitution and cases

Head's up: The *Baker v. Selden* case and cases coming along afterward use some old terminology to describe art, technology, and patents. Taking a moment now to explain that may avoid some frustration.

"Letters-patent"

Where the court says "letters-patent" it just means "patents."

The word "patent" means "open," so a "letter-patent" is an "open letter." Long ago, a letter-patent was a letter from the king or queen letting everyone know that a certain so-and-so had a monopoly with regard to whatever the letter specified.

"Charts," as in "maps and charts"

Courts often mention "maps and charts" together as categories of copyrightable works. In this sense, "chart" refers to a map of the sea, usable by ships for navigation.

"Science" and "art"

Another point of potential confusion for the modern reader is usage of the terms "science" and "art" to mean something quite different from how the terms are used in common parlance today.

This turns out to be quite important, because the historical usage of these terms has relevance throughout the study of intellectual property law. The words "science" and "arts" are used in the Constitution's grant of power to Congress (i.e., the Progress Clause) to enact copyright and patent laws. And many important cases – early ones and more recent ones as well – employ these terms in their older senses.

Counterintuitively, "science" is associated with general knowledge and with copyrights, while "arts" is associated with technology and with patents.

Today, we tend to associate "science" with certain academic fields –like chemistry, biology, meteorology – that are oriented around a rigorously

applied objective empirical method, heavy on experiments, math, and data. But in older usages concerning intellectual property law, "science" does not signify anything so narrow or constrained. Rather, the use of the word tends to be closer to its Latin origins in the word "scientia," meaning "knowledge," which is from "scire," meaning "know."

So when looking at the Constitution or older cases, you can generally translate "science" as "knowledge" as in the kind of book-learning you could get from a library. That might be about history, business, physics, math, biology, law, or things that today we call "art" – like sculpture and portraiture.

Meanwhile, the Constitution, *Baker v. Selden,* and other legal authorities use the term "art" to mean something like "technology" – although broader. The old use of "art" would include everything we mean when we use the word "technology," but other things as well. Here's a relevant dictionary definition that's helpful: "a skill at doing a specified thing, typically one acquired through practice: the art of conversation."

Thus, when the court in *Baker v. Selden* says "the truths of a science," an example could be a philosophical theory of beauty. And when the *Baker* court says "the methods of an art," an example could be the invention of the electric motor.

This follows how the terms are employed in the U.S. Constitution. Take a look at the text of the Progress Clause – Article I, section 8, clause 8:

> "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."

In that phrase, "Progress of Science," "Authors," and "Writings" can be understood to go together and to be about Congress's power to establish copyright law.

Meanwhile, "Progress of ... useful Arts," "Inventors," and "Discoveries" can be grouped as concerning the power of Congress to create a system of granting patents.

The sense of "arts" being associated with cleverness in manufacturing machines, tools, and the like pops up in contemporary usage when we say "state of the art."

The older meaning of "art" also survives – at least sort of – in the modern use of the term "artisan," which means someone who has honed special skills in producing useful objects.

I say sort of, because these days people use the word "artisinal" quite freely as a means of claiming a product has a higher level of quality justifying a higher price. Based on search engine auto-completion suggestions, a common word-pairing is "artisinal jams." That, apparently, just means gourmet fruit preserves. (Although I can't help thinking it could be a great trademark for a deejay.)

Z.2. *hoc supra B.2:* Feist v. Rural

Pre-reading notes (additional)

Legal importance

Baker v. Selden is foundational to American copyright. It is probably the single most fundamental piece of the U.S. copyright caselaw.

Its importance is not merely historical. *Baker v. Selden* defines what is perhaps the most fundamental principle of the copyright system: that copyright protects only the author's expression, and the rights that come with owning a copyright do not and cannot create a monopoly on anything more than the author's expression.

That restriction of the copyright entitlement to an author's expression means, among other things, that a copyright does not provide a monopoly on a method, system, or idea.

Factual context

In this case, a person named Charles Selden of Southern Ohio created a new method of bookkeeping – i.e., a business's record-keeping or accounting of transactions, goods sold, money owed, money received, and so forth. Apparently, Selden's system was quite clever and useful. From various bits of the story, one can surmise that Selden thought it was a master stroke that would bring him a fortune. (The story of the facts surrounding the case is excellently told by Pamela Samuelson in *The Story of* Baker v. Selden: *Sharpening the Distinction Between Authorship and Invention*, INTELLECTUAL PROPERTY STORIES (Rochelle C. Dreyfuss & Jane C. Ginsburg, eds. 2006).

Coming up with a brilliant new invention and it making you rich is among the most hallowed versions of American Dream. But it's a story that generally has getting a patent as a *scène à faire* – i.e., an expected, almost obligatory aspect of the story. Patents are issued to provide exclusive rights for inventions that are new, useful, and that represent a nonobvious advance over the state of the art. Thereby obtaining a limited-term monopoly, the inventor can appropriate financial rewards to the fullest extent of the value of the invention because, without competitors, the inventor can command the very highest prices desirous customers are willing to pay.

But Selden held not a patent, but a copyright. Selden's copyrighted book provided a full explanation of the bookkeeping system and a set blank forms with which to use it. That would be the basis for claiming an exclusive legal right to use far and wide against any unlicensed rivals. And a rival did surface: W.C.M. Baker, who came out with books using a similar – arguably essentially identical – system, emerged right there in Southern Ohio, where Selden had been laboring to build his business. The copyright infringement lawsuit was on.

Baker won. The copyright claim failed. In *Baker v. Selden*, the Supreme Court explained that where an author has written an explanation of an entirely new method, system, or idea, then the copyright provides exclusive rights only with regard to the author's expression in the explanation. The copyright does not provide any exclusive rights over what was explained. Others can write and publish their own explanations. The method, system, or idea itself is free to be copied – at least as far as copyright law is concerned.

Head's up on the identity of the parties

A final note to keep things straight in the case: There's some complications in terms of exactly who is being referred to on the plaintiff/appellant side. Charles Selden is the inventor of the bookkeeping system and the author of books explaining it, and the holder of the original copyright thereto. Selden died. The copyrights were then in the decedent's estate. As the litigation arrived at the Supreme Court, the "complainant" is the plaintiff and appellant, seeking to uphold the successor's interest in the copyright and the financial reward they hope it will entail.

So "complainant" and "Selden" refer to the same side in the litigation – the plaintiff/appellant/seeking-to-use-copyright-to-stop-competitors side.

Baker is the upstart, the alleged copyist, the defendant/appellee, the guy seeking to bring consumer choice to a market thirsty for blank transaction journals.

After many years of reading cases, I find that I often help myself keeping the parties and facts straight by making a little cheat sheet for myself at the top of the case. For *Baker v. Selden,* here's mine:

> Selden = inventor = plaintiff = appellant = complainant = testator of complainant = inventor of bookkeeping system = two different people in actuality
>
> Baker = rival = defendant = appellee = rival bookkeeping book supplier = Selden's competitor = upstart = alleged copier = alleged infringer

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END OF PART 2
("Story Arc 2")
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