

COPYRIGHT LAW

TENTH EDITION

CRAIG JOYCE

TYLER OCHOA

MICHAEL CARROLL

MARSHALL LEAFFER

PETER JASZI

CAROLINA ACADEMIC PRESS

Chapter 2

PREREQUISITES FOR COPYRIGHT PROTECTION

The title of the Statute of Anne provides a simple statement of purpose: Learning is to be encouraged by vesting the copyright “of printed books in the authors” of such works.¹ This purpose continues to be an animating principle of U.S. copyright law even to this day. We see it operative in the threshold requirements for copyrightability that appear early in Title 17. Section 102(a), establishing the two fundamental *prerequisites* for copyright protection, provides:

Copyright protection subsists . . . 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.

Although *originality* and *fixation* are not acknowledged by name in the Statute of Anne, they are recognized implicitly in the introductory phrase conferring protection to *authors* for their *printed books*. The concept of the “author,” as creator, entails the notion of originality. And it is the author who fixes his or her words on the pages of a manuscript (or in digital form, on the hard drive of a computer), which in “printed” form becomes an object of commerce to the benefit of all concerned in the delicate bargain that is copyright law.

The Statute of Anne says little about limits on the scope of protection to be accorded to copyrighted works. These boundaries have been worked out through the years by case law and statutory amendment. The basic limitation is found today in § 102(b), which denies protection to “any idea, procedure, process, system, method of operation, concept, principle, or discovery . . . [that] is described, explained, illustrated, or embodied in” works otherwise satisfying the law’s requirements of originality and fixation.

This chapter examines the meaning of the relevant provisions of modern-day U.S. law in an effort to understand what Congress can (and cannot) do pursuant to its constitutional empowerment “To promote the Progress of Science . . . by

¹ The statute refers also to the “purchasers” of authors’ manuscripts. The purchasers in question were, of course, the “booksellers” of the day (or, as we might say today, the publishers and disseminators of copies of the work). The Copyright Clause of the U.S. Constitution makes no reference to such persons, but their existence, and their importance to the scheme of copyright, received quick acknowledgment in the first copyright act, enacted by Congress in 1790. We will hear more about American publishers and disseminators hereafter. They are the transferees whose interests are the subject of § 4.02 of this casebook (“Transfers of Rights”). For the moment, however, our concern is the central role of “authors” under both the Statute of Anne in England and the Constitution of the United States.

securing for limited Times to Authors . . . the exclusive Right to their . . . Writings . . . ”²

In addition, we examine briefly other considerations — the work’s national origin, and whether it is a “work of the United States Government” — that may, in individual instances, affect protectibility under U.S. law, and we offer a precautionary word about aspects of that law (the so-called “statutory formalities”) on which protection once was, but no longer is, conditioned.

§ 2.01 FIXATION

Under the Copyright Clause of the U.S. Constitution, Congress may make laws to protect the “Writings” of authors. This “Writings” requirement has been construed by the Supreme Court to mean any “physical rendering” of the fruits of the author’s creativity. *Goldstein v. California*, 412 U.S. 546, 561 (1973). Under the terminology of the present statute, a work is incapable of protection under federal law unless it is “fixed” in a “tangible medium of expression.”

The first of the cases that follows — *White-Smith v. Apollo* — is not about copyrightability as such, but it reflects early reluctance to deal with copyright cases involving new modes of information storage. The 1976 Act aimed to correct this tendency by exploiting more fully the potential of the “Writings” requirement. The second case — *Midway v. Artic* — explores some of the ambiguities that still surround the concept of fixation under the statute. As you read the following materials, ask yourself: Why is federal power to confer copyright limited by the “Writings” requirement, and what is the connection between a “writing” and fixation?

Also, putting the constitutional question to one side: Does requiring that a work be physically embodied in order to be protected make sense as a matter of intellectual property policy? Suppose (and it is not so much of a supposition!) that Mozart was able to retain perfectly in his memory numerous compositions, writing them down as a purely ministerial chore whenever he had the spare time. Why should protection for such compositions be denied until Mozart committed them to paper, as distinguished from playing them from memory at a concert?

Or, to take a latter-day example: If you write and send an e-mail message containing an original literary work of real merit, should your copyright protection depend on the vagaries of current computer memory technology — *i.e.*, whether, technically and technologically, the fixation requirement is satisfied?

Assuming we are stuck with the fixation requirement, should Congress and the courts protect authors’ original works even when the means of fixation are

² As to whether the writings of authors must promote “Science” or “useful Arts,” even the Supreme Court has seemed uncertain. In *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903), the Court assumed the latter. But in *Graham v. John Deere Co.*, 383 U.S. 1 (1966), the Court proceeded on the view that, in 18th-Century usage, “Science” (meaning “knowledge”) referred to the works of authors and “useful Arts” to the products of inventors. In light of the order in which the Framers placed both “Authors and Inventors” and “Writings and Discoveries,” the better view is that “Science and useful Arts” have the meanings attributed to them in *Graham*. See, *e.g.*, *Eldred v. Ashcroft*, 537 U.S. 186, 193 (2003). Hence, the usage in the text above.

unfamiliar or new? If so, on what basis? If not, why not? And are the states preempted from according their own protections to such works? (Recall the discussion of “common-law copyright” in Chapter 1. The preemption doctrine is explored systematically in Chapter 11.)

[A] Introduction

Statutory References

1976 Act: §§ 101 (“copies,” “created,” “device, machine, or process,” “fixed,” “phonorecords”), 102(a)

1909 Act: § 4

Legislative History

H.R. REP. NO. 94-1476, 94th Cong., 2d Sess. at 52–53 (1976)¹
reprinted in 1976 U.S.C.C.A.N. 5659, 5664–66

SECTION 102. GENERAL SUBJECT MATTER OF COPYRIGHT

. . . The two fundamental criteria of copyright protection — originality and fixation in tangible form — are restated in the first sentence of this cornerstone provision. . . .

Fixation in tangible form

As a basic condition of copyright protection, the bill [and, as enacted, the Copyright Act of 1976] perpetuates the existing requirement that a work be fixed in a “tangible medium of expression,” and adds that this medium may be one “now known or later developed,” and that the fixation is sufficient if the work “can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.” This broad language is intended to avoid the artificial and largely unjustifiable distinctions, derived from cases such as *White-Smith [Music] Publishing Co. v Apollo Co.*, 209 U.S. 1 (1908), under which statutory copyrightability in certain cases has been made to depend upon the form or medium in which the work is fixed. . . .

[For a fuller excerpt from H.R. Rep. No. 94-1476, see Part Three of the Casebook Supplement.]

[B] Development of Current Law

You may be wondering why we begin our exploration of “fixation” with a case that predates — and was partially overruled by — the 1909 Act, and that didn’t deal with protectibility even when it was good law. The reason is that, although the *outcome* of the case was overruled by the 1909 Act, its *way of thinking* survived until the 1976 Act was passed — and even beyond. The House Report on the 1976 Act cited this case as an example of the “artificial and largely unjustifiable

¹ Hereinafter cited as “H.R. REP. NO. 94-1476.”

distinctions" that the fixation requirement in the 1976 Act was intended to avoid. Nonetheless, the legacy of *White-Smith* lives on in the 1976 Act's otherwise inexplicable distinction between "copies" and "phonorecords."

WHITE-SMITH MUSIC PUBLISHING CO. v. APOLLO CO.
Supreme Court of the United States
209 U.S. 1 (1908)

MR. JUSTICE DAY delivered the opinion of the court:

These cases . . . were brought to restrain infringement of the copyrights of two certain musical compositions, published in the form of sheet music, entitled respectively, "Little Cotton Dolly" and "Kentucky Babe." The appellee, defendant below, is engaged in the sale of . . . player pianos known as the "Apollo," and of perforated rolls of music used in connection therewith. The appellant, as assignee of Adam Geibel, the composer, alleged compliance with the copyright act, and that a copyright was duly obtained by it on or about March 17, 1897. The answer was general in its nature, and upon the testimony adduced a decree was rendered, as stated, in favor of the Apollo Company, defendant below, appellee here.

The action was brought under the provisions of the copyright act, § 4952 (U.S. Comp. Stat. Supp. 1907, p. 1021), giving to the author, inventor, designer, or proprietor of any book, map, chart, dramatic or musical composition the sole liberty of printing, reprinting, publishing, completing, copying, executing, finishing, and vending the same. . . .

Without entering into a detailed discussion of the[ir] mechanical construction . . . , it is enough to say that [the defendant sells] what has become familiar to the public in the form of mechanical attachments to pianos, such as the pianola, and the musical rolls consist of perforated sheets, which are passed over ducts connected with the operating parts of the mechanism in such manner that the same are kept sealed until, by means of perforations in the rolls, air pressure is admitted to the ducts which operate the pneumatic devices to sound the notes. This is done with the aid of an operator, upon whose skill and experience the success of the rendition largely depends. As the roll is drawn over the tracker board the notes are sounded as the perforations admit the atmospheric pressure, the perforations having been so arranged that the effect is to produce the melody or tune for which the roll has been cut. . . .

The learned counsel for the parties to this action advance opposing theories as to the nature and extent of the copyright given by statutory laws enacted by Congress for the protection of copyright, and a determination of which is the true one will go far to decide the rights of the parties in this case. On behalf of the appellant it is insisted that it is the intention of the copyright act to protect the intellectual conception which has resulted in the compilation of notes which, when properly played, produce the melody which is the real invention of the composer. It is insisted that this is the thing which Congress intended to protect, and that the protection covers all means of expression of the order of notes which produce the air or melody which the composer has invented.

Music, it is argued, is intended for the ear as writing is for the eye, and that it is the intention of the copyright act to prevent the multiplication of every means of reproducing the music of the composer to the ear.

On the other hand, it is contended that while it is true that copyright statutes are intended to reward mental creations or conceptions, that the extent of this protection is a matter of statutory law, and that it has been extended only to the tangible results of mental conception, and that only the tangible thing is dealt with by the law, and its multiplication or reproduction is all that is protected by the statute. . . .

Musical compositions have been the subject of copyright protection since the statute of February 3, 1831 . . . , and laws have been passed including them since that time. When we turn to the consideration of the act it seems evident that Congress has dealt with the tangible thing, a copy of which is required to be filed with the Librarian of Congress, and wherever the words are used (copy or copies) they seem to refer to the term in its ordinary sense of indicating reproduction or duplication of the original. . . .

What is meant by a copy? . . .

Various definitions have been given by the experts called in the case. The one which most commends itself to our judgment is perhaps as clear as can be made, and defines a copy of a musical composition to be "a written or printed record of it in intelligible notation." It may be true that in a broad sense a mechanical instrument which reproduces a tune copies it; but this is a strained and artificial meaning. When the combination of musical sounds is reproduced to the ear it is the original tune as conceived by the author which is heard. These musical tones are not a copy which appeals to the eye. In no sense can musical sounds which reach us through the sense of hearing be said to be copies, as that term is generally understood, and as we believe it was intended to be understood in the statutes under consideration. A musical composition is an intellectual creation which first exists in the mind of the composer; he may play it for the first time upon an instrument. It is not susceptible of being copied until it has been put in a form which others can see and read. The statute has not provided for the protection of the intellectual conception apart from the thing produced, however meritorious such conception may be, but has provided for the making and filing of a tangible thing, against the publication and duplication of which it is the purpose of the statute to protect the composer. . . .

After all, what is the perforated roll? The fact is clearly established in the testimony in this case that even those skilled in the making of these rolls are unable to read them as musical compositions, as those in staff notations are read by the performer. It is true that there is some testimony to the effect that great skill and patience might enable the operator to read this record as he could a piece of music written in staff notation. But the weight of the testimony is emphatically the other way, and they are not intended to be read as an ordinary piece of sheet music, which, to those skilled in the art, conveys, by reading, in playing or singing, definite impressions of the melody.



\$10 Puts this Player Piano In Your Home

\$10.00
DOWN
\$15 A Month
No Interest

His Finest Windsor Player Will Delight Two Generations

WINDSOR has been spared to make this magnificent Windsor Player Piano all at you could wish in tone quality, and beauty of finish.

An investment in enjoyment for your family—for your children and their children. Its resonant, sweet singing tone outlast our guarantee. Expression automatic tracking device, balanced for easy playing, fiber-covered metal on every single part is of the best materials and workmanship. Compare any \$600 player and see!

The case is built up layer on layer of thoroughly seasoned wood—it cannot warp. Genuine veneer of mahogany, burl walnut, or quartered oak, rubbed to a French polish. New Empire top. Brass hinges and pedals; genuine ivory keys. Height, 54½ inches; width, 60½ inches; depth, 28 inches. Bench and ten rolls of music included free. See "Estimated Freight Charges" below. Ship. weight, complete, 880 lbs.

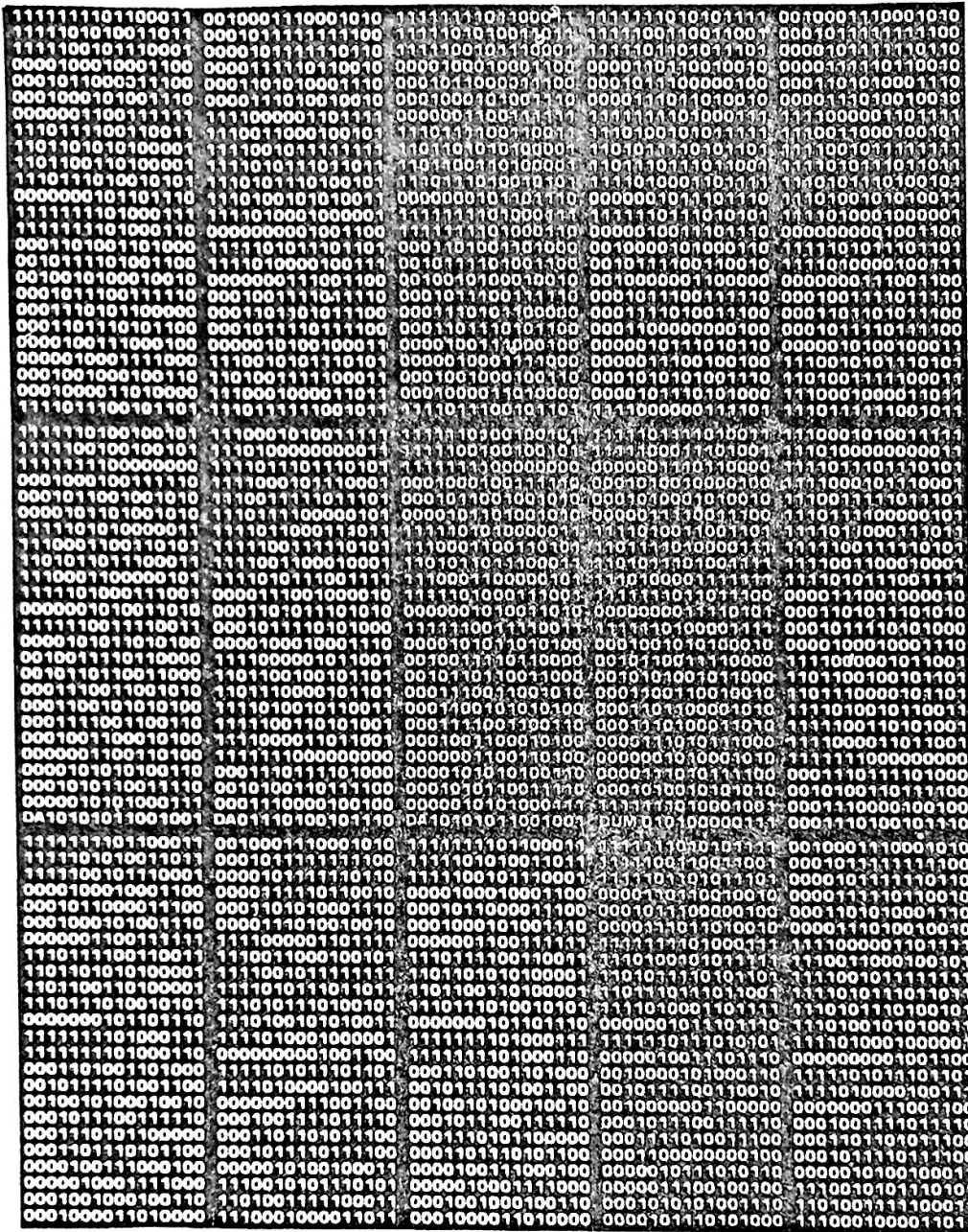
Use Easy Payment Order Blank No. 1 on Page 721.

267 F	68—Mahogany.....	\$485.00
267 F	69—Walnut.....	485.00
267 F	70—Oak.....	485.00

Shipped from Factory near Chicago

Early 20th Century Fixation — The Player Piano
Corbis

These perforated rolls are parts of a machine which, when duly applied and properly operated in connection with the mechanism to which they are adapted, produce musical tones in harmonious combination. But we cannot think that they are copies within the meaning of the copyright act.



Early 21st Century Fixation — The Computer
 Reproduced by courtesy of, and copyrighted by, 3M Company

It may be true that the use of these perforated rolls, in the absence of statutory protection, enables the manufacturers thereof to enjoy the use of musical compositions for which they pay no value. But such considerations properly address themselves to the legislative, and not to the judicial, branch of the government. As the act of Congress now stands we believe it does not include these records as copies or publications of the copyrighted music involved in these cases.

The decrees of the Circuit Court of Appeals are affirmed.

MR. JUSTICE HOLMES, concurring specially.

In view of the facts and opinions in this country and abroad to which my brother Day has called attention, I do not feel justified in dissenting from the judgment of the court, but the result is to give to copyright less scope than its rational significance and the ground on which it is granted seem to me to demand. Therefore I desire to add a few words to what he has said.

The notion of property starts, I suppose, from confirmed possession of a tangible object, and consists in the right to exclude others from interference with the more or less free doing with it as one wills. But in copyright property has reached a more abstract expression. The right to exclude is not directed to an object in possession or owned, but is *in vacuo*, so to speak. It restrains the spontaneity of men where, but for it, there would be nothing of any kind to hinder their doing as they saw fit. It is a prohibition of conduct remote from the persons or tangibles of the party having the right. It may be infringed a thousand miles from the owner and without his ever becoming aware of the wrong. It is a right which could not be recognized or endured for more than a limited time and therefore, I may remark, in passing, it is one which hardly can be conceived except as a product of statute, as the authorities now agree.

The ground of this extraordinary right is that the person to whom it is given has invented some new collocation of visible or audible points, — of lines, colors, sounds, or words. The restraint is directed against reproducing this collocation, although, but for the invention and the statute, anyone would be free to combine the contents of the dictionary, the elements of the spectrum, or the notes of the gamut in any way that he had the wit to devise. The restriction is confined to the specific form, to the collocation devised, of course, but one would expect that, if it was to be protected at all, that collocation would be protected according to what was its essence. One would expect the protection to be coextensive not only with the invention, which, though free to all, only one had the ability to achieve, but with the possibility of reproducing the result which gives to the invention its meaning and worth. A musical composition is a rational collocation of sounds apart from concepts, reduced to a tangible expression from which the collocation can be reproduced either with or without continuous human intervention. On principle anything that mechanically reproduces that collocation of sounds ought to be held a copy, or, if the statute is too narrow, ought to be made so by a further act, except so far as some extraneous consideration of policy may oppose. . . .

NOTES AND QUESTIONS

(1) *Protectibility vs. infringement.* In thinking about copyright problems, keep in mind the difference between copyrightability analysis (which focuses on whether a work or an aspect of a work is protected) and infringement analysis (which is predicated on proof by the claimant of ownership of a valid copyright in the work and focuses on whether a copyright owner's exclusive rights have been violated by a particular act alleged to be an unauthorized use of a protected work). The two kinds of analysis — protectibility and infringement — serve different purposes and proceed along different lines. For example, while the addition of new material to a

preexisting work may entitle the author of the resulting “derivative work” to copyright protection if the preexisting work is in the public domain or its use has been authorized, the unauthorized use of a protected preexisting work is not thereby excused.

The issue of whether the work has been fixed in a tangible medium of expression always must be addressed as part of copyrightability analysis. The issue of fixation also arises in the infringement context because two of the copyright owner’s exclusive rights are to reproduce and distribute fixed “copies” of the work. This issue receives more detailed treatment in § 7.02. For now, it is important to recognize that even where copyrightability analysis and infringement analysis share terms in common, those words may have distinct meanings in the two separate contexts. The term “copy,” so important in *White-Smith*, provides an apt example.

Under the scheme of U.S. copyright laws before the 1976 Act, the attachment of protection under federal copyright law usually occurred when the work was “published” with a proper copyright notice. See the detailed discussion of this point in Chapter 6. “Publication” was accomplished by distributing “copies” of the work to the public. Also, under pre-1978 law as well as today, infringement of copyright could occur when unauthorized “copies” of a protected work were manufactured or sold.

White-Smith addressed the question of whether piano rolls were such “copies” for *infringement* purposes. It does not follow that the *White-Smith* definition of “copy” must (or even should) have been employed in the conceptually distinct setting of *copyrightability* analysis. But in fact, in later cases, that is just what occurred.

(2) *White-Smith and its aftermath*. Justice Day himself does not always seem to be making with perfect clarity the distinction just described. Indeed, he seems to equate a “copy” for infringement purposes with the deposit “copy” that the statute required in order to gain copyright protection. But even assuming, *arguendo*, that a “copy” for one purpose is a “copy” for all, was there any *constitutional* justification for the requirement that it be “in a form which others can see and read”? Isn’t Justice Holmes clearly correct in saying that the result “give[s] to copyright less scope than its rational significance and the ground on which it is granted seem . . . to demand”?

If so, whose job was it to fix the problem that Holmes perceived? Can the result be justified on the ground that Justice Day’s opinion offers — namely, that “such considerations properly address themselves to the legislative, and not to the judicial, branch of the government”? And while Justice Day defers to Congress, Justice Holmes says he defers — concurring rather than dissenting — to other courts in the United States and abroad. Higher courts than his?

(3) In 1909, Congress took some of the sting out of *White-Smith*’s teaching on infringement by enacting the provision codified as § 1(e) of the 1909 Act. Section 1(e) extended copyright protection to cover so-called “mechanical reproductions” of musical compositions (including piano rolls and the then-emergent technology of phonograph recordings), while at the same time providing a “compulsory license”

for mechanical reproduction on terms stipulated by the statute. (Incidentally, this device is preserved in the 1976 Act, as discussed in Chapter 7 below.) But Congress did *not* explicitly overrule *White-Smith's* definition of "copy" itself. As a result, the absence of direct perceptibility continued to be a barrier to the protection of many kinds of works until January 1, 1978. Thus, for example, while motion pictures recorded on film stock were protected, there was a lingering question about the status of works fixed solely on videotape. This ambiguity disappeared only when the 1976 Act's new definition of a "copy" as a "material object . . . in which a work is fixed . . . and from which the work can be perceived, reproduced, or otherwise communicated, *either directly or with the aid of a machine or device*" took effect.

(4) Recall that the legislative history of the 1976 Act referred to *White-Smith* as its primary example of "artificial and largely unjustifiable distinctions" which the courts had created in the fixation area under the 1909 Act and its predecessors. The drafters of the 1976 Act purposefully chose what the House Report calls "broad language" to avoid such line-drawing in judicial construction of the fixation requirement in the new Act. Thus, the current statute provides for protection of fixation in "*any* tangible medium of expression, *now known or later developed*" (emphasis added). As you read through the remainder of this casebook, be on the look-out for instances in which courts seem to carry out, or frustrate, this "open-ended" attitude of Congress toward new technologies.

(5) *The limits of fixation.* Suppose your copyright professor forbids any recording or note-taking in her classes. As it turns out, however, one student has been taping them surreptitiously (for her own use), while another has taken advantage of his "photographic memory" to reproduce and sell the substance of the professor's lectures. When they both are discovered, the professor sues the latter for copyright infringement, alleging that the activities of the former satisfy the fixation requirement. On a motion to dismiss, what result? How sensible is the result you forecast? See Barnett, "*Profiting at My Expense*": *An Analysis of the Commercialization of Professors' Lecture Notes*, 9 J. Intell. Prop. L. 137 (2001).

(6) *Computer software protection.* One area as to which even the 1976 Act failed to resolve issues arising from the constitutional "Writings" requirement was computer programs. Directions for the operation of a computer *can* be written out by their creator in a form "which others can see and read," although there seems to be little point in doing so. But the computer itself requires that these directions be translated into what might be called "machine language" in order to run them. (For a detailed explanation of computer programs, see *Apple Computer, Inc. v Franklin Computer Corp.* in Chapter 3.)

Applying the 1909 Act, one District Court had held that computer programs, because they cannot be deciphered with the naked eye, are not "copies" of the programmers' original directions. On appeal, however, the Seventh Circuit affirmed for reasons seemingly inconsistent with the District Court's view. See *Data Cash Systems, Inc. v JS&A Group, Inc.*, 480 F. Supp. 1063 (N.D. Ill. 1979), *aff'd on other grounds*, 628 F.2d 1038 (7th Cir. 1980).

Section 117 of the 1976 Act, as originally enacted, froze the law as it stood on December 31, 1977 with respect to computer programs, in order to permit further study of the issues by the Congressionally-mandated Commission on New Techno-

logical Uses of Copyrighted Works ("CONTU"). It was not until 1980 that, by enacting present § 117, Congress made the § 101 definition of "copy" applicable to computer programs. The next case in the book introduces the topic of computer software, the fixation requirement, and protectibility. But first, a cautionary note.

(7) The criterion of "perceptibility" laid down in *White-Smith* came to be applied across the board, whenever and however an issue arose as to whether a particular fixation constituted a "copy." Consequently, a decision of fairly restricted immediate importance, involving a technical question of infringement law relating to musical compositions, came to be a barrier to the availability of copyright protection for various kinds of works fixed by means of new technologies. Today, as one court has observed, the "sole purpose of [the] definition of 'copies' and 'fixed' is to explicate" the latter-day embodiment of the "Writings" of the Constitution by "defin[ing] the material objects in which copyrightable and infringing works may be embedded and . . . describ[ing] the requisite fixed nature of that work within the material object." *Matthew Bender & Co., Inc. v. West Publishing Co.*, 158 F.3d 693, 702 (2d Cir. 1998). But this inquiry still is sometimes less than completely straightforward.

**MIDWAY MANUFACTURING CO. v. ARTIC
INTERNATIONAL, INC.**

United States District Court, Northern District of Illinois
547 F. Supp. 999 (1982),
aff'd on other grounds, 704 F.2d 1009 (7th Cir. 1983)

DECKER, DISTRICT JUDGE:

[Midway sued Artic for alleged infringement of Midway's copyrights in two coin-operated video games, Galaxian and Pac-Man. Designed for use in video arcades, the video games operate in two modes: "attract" mode, a fairly short animated sequence which repeats itself until the user deposits a coin or a token; and "play" mode, in which the audiovisual display responds to the operation of the controls by the player. The audiovisual displays of the two video games are generated by computer programs stored on computer chips called ROMs (for "read only memory"). The program instructions, contained in "program ROMs," instruct the microprocessor (or CPU, for "central processing unit") to retrieve images stored in "character ROMs" and to display those images at specified locations on the television screen. The CPU and the ROMs are attached to a printed circuit board inside the game cabinet.]

After a coin is inserted and the game goes into the play mode, the images generated by the character ROMs move on the screen in a finite but enormous number of sequences. . . . If a player were to move the controls of either a Pac-Man or Galaxian video game in exactly the same way in two different plays of the game, the images on the screen would all move in exactly the same way. . . .

The evidence presented at the hearing showed that defendant Artic sells two devices which Midway contends violate its rights in the Galaxian and Pac-Man games. The first of those items is a speed-up kit, which, when attached to the

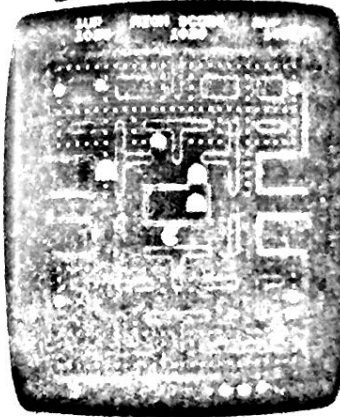
Galaxian game, modifies the way the images move on the screen. . . .

The second item sold by Artic that is of interest in this litigation is a printed circuit board that is used to create a "Puckman" video game. . . .

PAC-MAN™



The player using a single handle control guides the PAC-MAN ghost through the maze scoring points by eating up the Dots in his path. Four Ghost Monsters—Inky, Blinky, Pinky, and Clyde—chase after the PAC-MAN trying to capture and deflate him. The PAC-MAN can counterattack by eating the big Power Capsule that enables him to overpower the Monsters for additional score. After all the Dots are gobbled up the screen is cleared and PAC-MAN continues for another round. Each rack features a special Fruit Target in the maze which if eaten earns Bonus Points. Players start with three PAC-MAN. An additional PAC-MAN is awarded for 10,000 points.



A conventional, full color video game for 1 or 2 players that includes vision and challenges reflexes. Adding to the fun are musical refrains, chomping and action sounds along with amusing cartoons shown between racks.

- HIGH SCORE** - Maximum and frequency of scores.
- PLAYERS SCORE**
- DOTS** - 100 dots = 1 dot
- POWER CAPSULE** - 100,000 points
- GHOST MONSTERS**
- PAC-MAN** - The main character
- ESCAPE Warp TUNNEL** - The only way to escape the maze
- BONUS FRUIT TARGET** - Appears in the maze. Monsters chase after it.
- NUMBER OF SCREENS CLEARED** - 1000 screens cleared = 100,000 points

PAC-MAN REMAINING:

SCORE BIG ON THE COUNTERATTACK

1. Check out the Bonus Power Capsule. (Inky, Blinky, Pinky, Clyde)
2. When the PAC-MAN powers up, the Monsters start to run away.
3. Press double for each Monster caught.

BONUS POINT FRUIT TARGETS

The player is awarded extra Bonus Points for eating the Fruit Targets that appear in the maze.

- 100 Points
- 200 Points
- 300 Points

Or up to a maximum of 8,000 Bonus Points.

PAC-MAN is available in 3 Million models: New Midway Cabinet Table and Standard Arcade.

HEIGHT	WIDTH	DEPTH
50"	18"	34"
140 cm	45 cm	86 cm

MIDWAY MFG. CO.
 A GALE GROUP COMPANY
 10750 West Grand Avenue
 Franklin Park, Illinois 60131
 Phone (312) 451-1300
 For service information—call toll free 800-323-7162

DISTRIBUTED BY

©Copyright 1980 by MIDWAY MFG. CO. All rights reserved.

Printed in U.S.A.

An Advertisement for PAC-MAN®
 © 1980 NAMCO Ltd. All Rights Reserved. Courtesy of Namco Holding Corp.

Discussion

[Among what the court describes as a “massive scattershot of arguments against the validity and application of Midway’s copyrights,”] Artic . . . contends that the audiovisual aspects of Midway’s video games are not “fixed in any tangible medium of expression,” 17 U.S.C. § 102(a), and so do not qualify for copyright protection at all. . . .

Before a copyright can attach in any original work of authorship, the work 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 with the aid of a machine or device.” 17 U.S.C. § 102(a). The phrase is defined in the Copyright Act as follows:

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.

17 U.S.C. § 101.

Artic contends that the audiovisual displays of Midway’s games do not meet that requirement. Artic’s argument is based on the specific technology by which the images that appear on the game screens are generated. Basically, Artic notes that the ROMs in the video game do not contain enough memory to store the entire picture that appears on the game’s screen at any one instant. Rather, the ROMs contain a number of symbols or patterns which are combined in various ways by the microprocessor to make up the images seen on the screen. Artic argues, therefore, that the computer is simply generating a new set of pictures at all times, pictures that are themselves not fixed in any medium.

While Artic’s argument has a certain facial validity, it nonetheless fails. The fixation requirement, as is clear from the statute, does not require that the work be written down or recorded somewhere exactly as it is perceived by the human eye. Rather, all that is necessary for the requirement to be satisfied is that the work is capable of being “reproduced . . . with the aid of a machine or device.” 17 U.S.C. § 102(a). As was amply demonstrated by Midway at the hearing, the audiovisual features of its games may be reproduced over and over again, for extended periods of time. The attract modes of the two games, for instance, repeat themselves over and over again, in identical fashion, for as long as the games are turned on and no one is playing them. The copyrightable aspects of the play mode likewise repeat themselves whenever the game is played.

Artic attempts to draw support for its position from a statement in the Report of the House Judiciary Committee on the Copyright Act. The Judiciary Committee stated:

[T]he definition of “fixation” would exclude from the concept purely evanescent or transient reproductions such as those projected briefly on a screen, shown electronically on a television or other cathode ray tube, or captured momentarily in the “memory” of a computer.

H.R. Rep. No. 94-1476, 94th Cong., 2nd Sess. 53. When read in context, however, the

“purely evanescent or transient reproductions” referred to by Congress are those arising from live telecasts or performances that are nowhere separately recorded. Clearly, the lack of any recording of such events would preclude their ever again being identically reproduced. In the instant case, the copyrighted material is recorded in the ROMs and may be reproduced with the aid of the microprocessor. While the technology of the reproduction is different than that encountered with videotape, Congress has allowed for that eventuality by allowing for fixation in mediums of expression either “now known or later developed.” 17 U.S.C. § 102(a). The technology used in the video games is one such later developed medium of expression. . . .

For the reasons stated above, the court finds that plaintiff has successfully demonstrated that all elements necessary for issuing a preliminary injunction are present in this case. Therefore, plaintiff’s motion for preliminary injunction is granted. . . .

NOTES AND QUESTIONS

(1) *Fixation and new technology, continued.* In an earlier proceeding in the same matter, the District Judge observed: “It seems clear that the framers of the [1976] Copyright Act did not consider the specific problems raised by advanced electronic games.” *Midway Manufacturing Co. v Artic International, Inc.*, 1981 U.S. Dist. LEXIS 16881, at *23 (N.D. Ill. 1981). If this is so, how can the court justify affording the plaintiff the protection of the copyright laws?

(2) In what sense is the plaintiff’s work (assuming, for purposes of this chapter, that videogames qualify as “works” subject to copyright protection) “fixed” in a “tangible medium of expression” from which it can be “perceived, reproduced, or otherwise communicated,” even “with the aid of a machine or device”? Precisely what is it that Midway claims to have fixed? Images? A computer program? And where is it fixed? Is a video screen, for example, a “tangible” medium of expression? The ROM chips?

(3) Shouldn’t the court have paid closer attention to what occurs when the game is in the “play mode” (as distinct from the repetitive “attract mode”)? Specifically, what is the effect of player participation? Does it prevent fixation of the sights and sounds of the game? Should variety in the audiovisual incidents and patterns experienced by a player or players on different occasions affect copyrightability, assuming that all of the sights and sounds are generated by the chip in which the computer program’s creator has embodied the work? The matter is discussed more fully in *Stern Electronics, Inc. v Kaufman*, 669 F.2d 852 (2d Cir. 1982), and *Williams Electronics, Inc. v Artic International, Inc.*, 685 F.2d 870 (3d Cir. 1982).

(4) Does the court deal adequately with Artic’s assertion that the Galaxian and Pac-Man images are not, as required by the definition of “fixed” in § 101, “sufficiently permanent or stable to permit [them] to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration”? What exactly is “transitory duration,” anyway?

One can imagine situations in which the “transitory” nature of a work might be an issue. Is a poem written in the sand “fixed”? Does it matter whether it is above

or below the tide line? What about skywriting? Is a fireworks display “fixed” if it is meticulously scripted in advance? See Hopper, *Sky Power Producers Don’t Take Copyright Law Lightly*, Hous. Chron., Sept. 20, 1998, at 37.

(5) In a more practical vein, the fixation requirement plays an important role in defining which uses of digital technology fix copyrightable works in a tangible medium both for copyrightability and for infringement purposes. The easy cases are copies stored on a hard disk, a flash drive, or on some other digital medium in which they last until the user deletes them. These are sufficiently “permanent or stable to permit [them] to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.” 17 U.S.C. § 101. But, what about all of the temporary copies that personal computers, smart phones, Internet routers, and all other manner of computing devices routinely make as part of their normal operation? The two forms of temporary copies where the fixation issue arises most commonly are with works that exist only in their complete form as temporary copies and works that are temporarily copied into “buffers” as streaming media or as packets of information repeatedly copied by the routers that make Internet communication possible.

Midway is an early case involving the first scenario, in which the constituent elements of a work of authorship are fixed as independent digital files that are then brought together “on the fly” to create a temporary copy of the complete work. The question usually is whether the work is fixed because its constituent elements are fixed or because the temporary copy lasts long enough to meet the definition of fixation. As we will see in other video game cases in § 7.03[B] of this book, this scenario also raises the question of whether these temporary copies infringe the copyright owner’s right to prepare derivative works.

You also create temporary copies on the fly almost every time you surf the World Wide Web. The large majority of web pages are not stored as single complete files on a web server. Instead, many pages are “dynamic” or “active.” When you click on a link to a dynamic web page, your computer receives and acts upon a set of instructions to compose the web page by pulling in content from both the website’s server and, often, third-party advertisers’ machines. Although each element of the web page, such as text, photos, and an advertisement, is independently stored in some lasting form, what about the compilation of these elements into the page you see on the screen? Unless saved to a hard disk, this copy is only temporary because it is stored in your computer’s random access memory (“RAM”). RAM copies are those that the computer can act on, but they are deleted automatically when the device is turned off. (Anyone who has lost work in a word processing program when the computer crashed knows this truth all too painfully!) Whether such temporary copies are “fixed” for infringement purposes has been litigated. See *1-800 Contacts, Inc. v. WhenU.com, Inc.*, 309 F. Supp. 2d 467, 486–87 (S.D.N.Y. 2003) (unwanted pop-up ads don’t infringe a website owner’s copyright), *rev’d on other grounds*, 414 F.3d 400 (2d Cir. 2005).

(6) Whether RAM copies or buffer copies are fixed has received more attention in the infringement context. Initially, in *MAI Systems Corp. v. Peak Computer Inc.*, 991 F.2d 511 (9th Cir. 1993), the court held that the loading of the plaintiff’s copyrighted software into RAM constituted a fixation and qualified as a “copy”

under the Copyright Act for purposes of infringement analysis because the copy could be “perceived, reproduced or communicated.” Although the specific result of *MAI* was overturned in 1998 by Title III (“Computer Maintenance or Repair Copyright Exemption”) of the Digital Millennium Copyright Act (codified at 17 U.S.C. § 117(c)), the court’s reasoning was not rejected by Congress. To the contrary, Congress appeared to accept implicitly the holding of *MAI* in drafting other portions of the DMCA. See, for example, 17 U.S.C. § 512, discussed in § 9.03 of this casebook. Despite academic criticism of the *MAI* decision, courts have consistently accepted its holding that a work can be electronically “fixed” in RAM for purposes of the Act. See, e.g., *Stenograph L.L.C. v. Bossard Associates, Inc.*, 144 F.3d 96, 101–02 (D.C. Cir. 1998); *Tiffany Design, Inc v. Reno-Tahoe Specialty, Inc.*, 55 F. Supp. 2d 1113, 1121 (D. Nev. 1999); *Advanced Computer Services of Michigan, Inc. v. MAI Systems Corp.*, 845 F. Supp. 356, 362–64 (E.D. Va. 1994).

More recently, the Second Circuit held in *Cartoon Network v. CSC Holdings, Inc.*, 536 F.3d 121 (2d Cir. 2008), that a buffer copy of a video stream that lasted for only 1.2 seconds was not fixed because it did not last for “a period of more than a transitory duration.” This case and discussion of the role of “fixation” for copyright law on the Internet is discussed in more detail in §§ 7.02 and 9.03 below.

(7) Is a garden “fixed in a tangible medium of expression”? In *Kelley v. Chicago Park District*, 635 F.3d 290 (7th Cir. 2011), the court acknowledged that the pictorial design of a garden may be “fixed” (when printed on paper or stored in a computer), and that the living plants constituting the garden are “tangible and can be perceived for more than a transitory duration.” Nonetheless, the court held that the garden itself was “not stable or permanent enough to be called ‘fixed’” within the meaning of § 101, because “[s]eeds and plants in a garden are naturally in a state of perpetual change; they germinate, grow, bloom, become dormant, and eventually die. . . . [A garden] may endure from season to season, but its nature is one of dynamic change.” Do you agree? If an elaborate design may be fixed on paper, why is the same design not “fixed” when it is replicated with plants? Is a topiary sculpture “fixed”? If so, why is a garden different?

(8) Is the human body a “tangible medium of expression”? In *Whitmill v. Warner Bros. Entertainment, Inc.*, Civ. No. 11-cv-752 (E.D. Mo., filed Apr. 28, 2011), the plaintiff tattoo artist had “inked” former heavyweight boxer Mike Tyson with an image registered in the Copyright Office as “*Tribal Tattoo*.” In the film *Hangover 2*, produced by the defendant, a character awakens to find that he now has a replica of the Tyson tattoo. Promotional materials for the film also prominently featured the character with the tattoo. The artist had given Tyson a license to be photographed with the tattoo, but Tyson had no rights to authorize other reproductions of the image. Warner Brothers submitted a Declaration from treatise author David Nimmer, who took the position that the human body could not serve as a medium of expression for fixation purposes. At the preliminary injunction hearing, the court allowed the movie to be released but was unimpressed by Warner Brothers’ defense. The parties settled the case soon thereafter.

(9) As we will see in the next chapter, original works of authorship fixed in tangible media of expression may take one of several forms — including, of particular relevance for a discussion of video games, “literary works” (a rubric that

comprehends, perhaps surprisingly, computer programs), and “audiovisual works” (which includes approximately what one would imagine). After *Midway* was decided, the Copyright Office reversed its previous practice of permitting separate registrations for the *display* of an electronic videogame as an audiovisual work, and for the underlying *computer program* as a literary work. The Office now allows only a single registration for display-generating programs: the proprietor must decide whether the “program” aspects or the “audiovisual” aspects predominate, and file for registration accordingly. See *Copyright Office Notice of Registration Decision*, 53 Fed. Reg. 21817 (June 10, 1988).

(10) *Live broadcasts and simultaneous recordings.* The final sentence of the definition of fixation in § 101 of Title 17 states: “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.” What types of works was this sentence intended to reach? You may want to look again at the legislative history reproduced in the Supplement. See also *Swatch Group Mgmt. Servs., Ltd. v. Bloomberg L.P.*, 808 F. Supp. 2d 634 (S.D.N.Y. 2011) (conference call between Swatch executives and outside securities analysts was simultaneously recorded and was “fixed”), *cross-appeal dismissed on other grounds*, 756 F.3d 73 (2d Cir. 2014).

(11) Justifying the “fixation” requirement. In § 1.06, we outlined some ways of thinking and talking about copyright. How successfully can any of these be invoked to explain fixation? Are the utilitarian and natural law rationales for copyright relevant? Is the cult of the Romantic author? Isn’t the fixation requirement in apparent tension with notions of creators’ natural rights? Can’t an unfixed work be misappropriated as thoroughly (and with as much harm to its creator) as a fixed one? What vision (if any) of the public interest is promoted by requiring fixation?

Can the fixation requirement be justified from an economic standpoint? One commentator has observed that, “[i]n the law of real property, physical boundaries are essential to organizing transactions. To have a market, the objects to be bought, sold, and licensed must be clearly identified. Outside the market sphere, boundaries function to keep an owner’s rights within socially tolerable limits.” See Gordon, *An Inquiry into the Merits of Copyright: The Challenges of Consistency, Consent, and Encouragement Theory*, 41 *Stan. L. Rev.* 1343, 1378–84 (1989), for elaboration.

Does the law of copyright impose boundaries that facilitate the organization of a market for copyrighted works and at the same time keep ownership rights within reasonable limits? Is the requirement of fixation one of those boundaries? Does the fixation requirement reduce the costs of litigation by providing evidence relevant to both copyright ownership and infringement? Might such lack of boundaries have influenced the courts in the *Hemingway* and *Falwell* cases described below to deny claims of common-law copyright? As you go through the following chapters, consider the other means by which the 1976 Act sets out boundaries that demarcate and delimit the grant of the statutory monopoly that copyright creates.

(12) *Unfixed works and common-law copyright.* In *Estate of Hemingway v. Random House, Inc.*, 244 N.E.2d 250 (N.Y. 1968), the New York Court of Appeals considered whether to recognize common-law copyright protection for certain “anecdotes, reminiscences, literary opinions and revealing comments” uttered, but never reduced to writing, by the late author Ernest Hemingway. Hemingway’s

estate maintained that the author's utterances constituted "literary property" protectible under New York law, citing the late Prof. Melville B. Nimmer for the proposition that "the underlying rationale for common law copyright (*i.e.*, the recognition that a property right should attach to the fruits of intellectual labor) is applicable regardless of whether such labor assumes tangible form (Nimmer, COPYRIGHT, § 11.1, at 40)." 244 N.E.2d at 254.

Carried to extremes, the plaintiff's theory suggests that each of us (or, at least, every celebrated author) is entitled to legal protection for everything she says in the course of her day. Not surprisingly, *Hemingway* itself was decided on the ground that the author had not indicated an intention to claim the utterances in question as his property by somehow marking them off from the common run of his everyday speech.

See also *Falwell v Penthouse International, Ltd.*, 521 F. Supp. 1204 (W.D. Va. 1981), involving the publication of unauthorized quotations from an interview, and noting that, because there had been "no defined segregation, either by design or by implication of any of plaintiff's expressions of his thoughts and opinions of the subjects discussed, which would aid in identifying plaintiff's purported copyrighted material," the complaint did not fall "within the narrow circumstances where a cause of action involving an oral expression can be sustained under a common law copyright theory." *Id.* at 1208.

How could Hemingway or Falwell have marked off some of their oral expressions as literary property? If they had done so, how should the courts have ruled on the ultimate issue of protectibility? Would a state's rationale(s) for protecting, under the common law, unfixed works — *i.e.*, those which do not qualify as constitutional "Writings" — be the same as the justification(s) for extending copyright to fixed works under federal law? Would protection for unfixed works under state law run afoul of the "preemption doctrine" (explored in Chapter 11 of the book)?

(13) In 1982, California amended its literary property law to extend protection to "any original work of authorship that is not fixed in any tangible medium of expression . . . as against all persons except one who originally and independently creates the same or similar work." Cal. Civ. Code § 980(a)(1) (2009). Are there any policy arguments *against* the California statute?

(14) Discussions of the need for meaningful protection of at least some unfixed works frequently cite the example of jazz improvisations. Can you think of other examples? Consider the following situation.

At a comedy shop called "Politically Inexcusable," various groups regularly perform improvisational political skits lampooning unbeloved figures in government and politics. One evening, Hogge Wilde, a comedy writer attending the performances, copies material presented in a skit by Pigge Sloppe, a competing group. Are the improvisations at "Politically Inexcusable" protected by federal copyright law? If not, and assuming that state law does not protect "improvs" under its statutory or common law, what steps would you advise Pigge Sloppe to take to deal with the situation? See also Olliar & Sprigman, *There's No Free Laugh (Anymore): The Emergence of Intellectual Property Norms and the Transformation of Stand-Up Comedy*, 94 Va. L. Rev. 1787 (2008).

(15) *Fixation, international protection, and "bootlegging."* The American requirement of "fixation" as a precondition for copyright protection is not characteristic of "authors' rights" laws around the world. Many countries protect fixed and unfixed works without differentiation. Neither the Berne Convention, to which the United States acceded effective March 1, 1989, nor the Universal Copyright Convention, to which the United States has been a party since 1955, limits member states to protecting fixed works.

Recall that a work is fixed only when embodied in a tangible medium "by or under the authority of the author." As a result, there are commercially valuable types of cultural artifacts — notably, live musical performances — which are not fixed when recorded without authorization but which the United States has an interest in protecting against unauthorized exploitation. For example, suppose an unauthorized recording (or "bootleg") of a live musical performance by a U.S. performer is made in a foreign country. A mechanical compulsory license fee might be paid for the musical composition, but no permission is sought from, nor royalties paid to, the performers. (Performances are not "works" within the meaning of the Berne Convention, and although the Rome Convention does protect performers, the United States is not a party to the latter.)

In response to international pressures and to fulfill its obligations under the Agreement on Trade-Related Aspects of Intellectual Property Rights ("TRIPS"), the United States amended Title 17 by adding § 1101 *outside* the Copyright Act (Chapters 1-8). The legislation gives performers a civil cause of action for unauthorized fixation of, or trafficking in, live musical performances. Criminal penalties under 18 U.S.C. § 2319A supplement the civil cause of action.

In *United States v. Moghadam*, 175 F.3d 1269 (11th Cir. 1999), the Eleventh Circuit rejected a constitutional challenge to 18 U.S.C. § 2319A, saying "the Copyright Clause does not envision that Congress is positively forbidden from extending copyright-like protection under other constitutional clauses, such as the Commerce Clause, to works of authorship that may not meet the fixation requirement inherent in the term 'Writings.'" *Id.* at 1280. In dicta, however, the decision stated that the "apparently perpetual" protection provided by the statute might prove "fundamentally inconsistent" with the "limited Times" restriction of the Copyright Clause. Because the criminal defendant in *Moghadam* had not raised that issue, the court reserved the question for another day. *Id.* at 1281.

More recently, another court reached the same result as *Moghadam*, but via very different reasoning. In *United States v. Martignon*, 492 F.3d 140, 151 (2d Cir. 2007), the court held that 18 U.S.C. § 2319A does not "secure" an exclusive right within the meaning of the Copyright Clause, because it "does not create and bestow property rights upon authors or inventors or allocate those rights among claimants to them," but instead is only a criminal prohibition. Because the law was therefore not a "copyright" law, it could be upheld under the Commerce Clause. *Id.* at 152-53. The court's reasoning strongly suggests that it might find the civil counterpart, § 1101, to be unconstitutional. *See id.* at 152 n.8 (reserving the question). *But see KISS Catalog v. Passport Int'l Prods.*, 350 F. Supp. 2d 823 (C.D. Cal. 2004), *on reconsideration*, 405 F. Supp. 2d 1169 (C.D. Cal. 2005) (holding on reconsideration that § 1101 is constitutional).

Putting the constitutional question to one side, is “bootlegging” merely commercial piracy that should be the subject of civil and criminal liability? Or is there a legitimate public policy argument to be made in favor of “bootlegging”? See Kozinn, *Bootlegging as a Public Service: No, This Isn't a Joke*, N.Y. TIMES, Oct. 8, 1997, at E3.

§ 2.02 ORIGINALITY

The second prerequisite for federal or statutory copyright protection, based upon the Copyright Clause's provision for protection of the writings of “Authors,” is originality. You will search § 101 of the 1976 Act in vain for any definition of this key term. According to the House Report on the Act (a portion of which is reproduced below), this omission manifests a legislative intention to incorporate into the new statute the meaning of the term that had evolved in the case law construing prior acts. You will see that there are two aspects of originality as developed by the courts and now embodied in § 102(a): independent creation by the author, and a modest quantum of creativity. Another basic principle of copyright developed in the case law holds that copyright protects an author's expression of an idea, but not the idea itself. The Act codifies this latter principle in § 102(b).

What is the basis for these principles, and how have the courts applied them in practice? This section explores these fundamental issues of copyrightability.

[A] Introduction

Statutory References

1976 Act: §§ 101 (“created”), 102(a) and (b)

1909 Act: § 4

Legislative History

H.R. REP. NO. 94-1476 at 51-52, 56-57
reprinted in 1976 U.S.C.C.A.N. 5659, 5664-65, 5670

SECTION 102. GENERAL SUBJECT MATTER OF COPYRIGHT

“Original works of authorship”

. . . 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 [1909 Act]. This standard does not include requirements of novelty, ingenuity, or [a]esthetic merit, and there is no intention to enlarge the standard of copyright protection to require them. . . .

Authors are continually finding new ways of expressing themselves, but it is impossible to foresee the forms that these new expressive methods will take. The bill does not intend either to freeze the scope of copyrightable technology or to allow unlimited expansion into areas completely outside the present congressional intent.

. . .

Nature of copyright

Copyright does not preclude others from using the ideas or information revealed by the author's work. It pertains to the literary, musical, graphic, or artistic form in which the author expressed intellectual concepts. Section 102(b) makes clear that copyright protection does not 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.

[For a fuller excerpt from *H.R. Rep. No. 94-1476*, see *Part Three of the Casebook Supplement*.]

[B] Originality and the Constitution

Recall that the Constitution gives Congress the power to secure to "Authors" the exclusive right in their "Writings" so as to "promote the Progress of Science and useful Arts." We already have seen that by limiting copyrightability to "Writings," this grant of power extends only to works that are fixed in form. What, if any, other limits are implicit in this grant of power?

The Supreme Court has been called upon to consider questions such as: (1) are protectible "Writings" categorically limited to certain forms of expression? (2) is copyrightable expression limited to works that "promote the Progress of Science"? and, most significantly, (3) must the "Writings" of "Authors," to be copyrightable, exhibit some degree of creativity? Keep these questions in mind as you read the following cases.

BURROW-GILES LITHOGRAPHIC CO. 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 [a] 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 finding of facts 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 14, 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.



The Portrait of Oscar Wilde by Napoleon Sarony

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.

[(2)] 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 respect to this latter question[, the Court concludes that] 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. . . . 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, statuary, and models or designs intended to be perfected as works of the fine arts."

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 St. p. 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 St. 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. . . .

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 of 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, engravings, etchings, *etc.*, 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. . . .

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 a 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 that in such case a copyright is no protection. On the question as thus stated we decide nothing. . . .

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 judgment of the circuit court is accordingly affirmed.

NOTES AND QUESTIONS

(1) *Constitutionally protectible expression.* Congress added “photographs” to the list of subject matter eligible for copyright in 1865. 13 Stat. 540. Thus, the principal question before the Court in *Burrow-Giles* was whether photographs fall within the constitutional grant of power to Congress to secure exclusive rights to “Authors” for their “Writings.” How did the Court determine that photographs were within the constitutional meaning of “Writings”? Should the result have been different if photography had been known at the date of Congress’s most recent amendments to the list of copyrightable subject matter, but had not been included?

Over the years, Congress has provided protection to an increasingly long list of types of writings that do not yet encompass everything that might constitute a “Writing” under the Copyright Clause. The current formulation used to describe this list is “works of authorship,” a concept elaborated in § 102(a) of the Copyright Act and further examined in Chapter 3. At this point, however, can you think of any “writings” that may not be copyrightable subject matter?

(2) *Copyrightability and technology.* How should the copyrightability of a photograph be assessed, especially when it was created using what was then a relatively new mechanical technique? The Court notes that the “mental conception” of the image that Sarony wished to create was given “visible” form in a new medium unknown to the Framers of the Copyright Clause and the early copyright acts. “The only reason why photographs were not included . . . in the act of 1802,” says the Court, “is, probably, that they did not exist, as photography, as an art, was then unknown. . . .” But this begs the question of “originality.”

In *Burrow-Giles*, the Court confronted a problem that had plagued courts in the United States and elsewhere during the early years of photography: Did a photograph have a human “author,” or was it, in fact, just the product of a machine? See Farley, *The Lingering Effects of Copyright’s Response to the Invention of Photography*, 65 U. Pitt. L. Rev. 385 (2004). Notice that this issue is the flipside of *White-Smith*. There, the Court considered whether a reproduction designed for a machine (a player piano) was a “copy” of the work. Here, the machine has rendered the copy for direct perception by a human audience. Congress overruled *White-Smith* in favor of expanding copyright to cover copies designed for machines, and *Burrow-Giles*, of course, resolved the problem of “authorship” for photographic works in favor of copyrightability. But the problem of “machine” authorship generally has not gone away.

Suppose, for example, that a *computer* had generated the image from a verbal description of Wilde’s appearance. These days, increasing amounts of authorship can be automated through software or authoring tools. Computers can create respectable-sounding music and poetry, to say nothing of high-quality technical drawings; and they are being used more and more to generate new computer programs to meet stated specifications and requirements. How should these products be regarded for copyright purposes? In 1979, the Congressionally-mandated National Commission on New Technological Uses of Copyrighted Works (“CONTU”) took up the issue of computer-generated works in its *Final Report*, concluding that, in such cases, it is “obvious” that the “author is one who employs the computer,” *id.* at 45, rather than (for example) the author of the program which

drives the computer. Is that conclusion still “obvious”? Is it obvious that such works have *any* “author”?

(3) “*Authors*” and originality — an introduction. Some of the very first items to which Congress accorded copyright protection — for example, the “maps” and “charts” mentioned by the Court in *Burrow-Giles* — seem to exhibit little originality when compared with other items on the protected list, such as “designs” or “engravings.” Where on this spectrum of writings do photographs fall?

(4) What elements of Sarony’s photograph caused the resulting picture to be a sufficiently original “intellectual invention” to justify copyright protection under the challenged statutory provision? Was it the simple act of selecting the subject? The artistic posing of the subject? The decisions concerning costume, lighting, exposure and shutter speed?

It would seem that a photographer can claim copyright protection only for those elements of a photograph over which she exercised creative control. Thus, for example, a photographer generally cannot claim copyright in her choice of subject matter, but she may be accorded protection for such aspects as lighting, shading, timing, angle, and choice of film, where she made those decisions. See *Harney v. Sony Pictures Television, Inc.*, 704 F.3d 173 (1st Cir. 2013) (because the plaintiff’s photograph was not staged, copyright did not protect “the piggyback pose of [the subjects], their clothing, the items they carried, or the [church] shown with bright blue sky behind it”; instead, copyright protects only “the framing of [the subjects] against the background” plus originality in lighting and coloring, which was not substantially similar); *Leigh v. Warner Bros., Inc.*, 212 F.3d 1210 (11th Cir. 2000) (photo of Bird Girl sculpture in Savannah cemetery, used on cover of book “Midnight in the Garden of Good and Evil,” claimed to have been infringed by promotional images for movie based on the book).

What if the photographer merely happens to be in the right place at the right time? See *Time, Inc. v. Bernard Geis Associates*, 293 F. Supp. 130 (S.D.N.Y. 1968), holding that the Zapruder film of President Kennedy’s assassination was sufficiently original, because:

Zapruder selected the kind of camera (movies, not snapshots), the kind of film (color), the kind of lens (telephoto), the area in which the pictures were to be taken, the time they were to be taken, and (after testing several sites) the spot on which the camera would be operated.

Id. at 143. Should the result have been different if Zapruder had been an idle bystander who happened to be carrying a camera? See also *Los Angeles News Service v. Tullo*, 973 F.2d 791 (9th Cir. 1992) (videotape of sites of airplane crash and train wreck sufficiently original); *Los Angeles News Service v. KCAL-TV*, 108 F.3d 1119 (9th Cir. 1997) (videotape “creatively captured the [Reginald] Denny beating in a way that no one else did”).

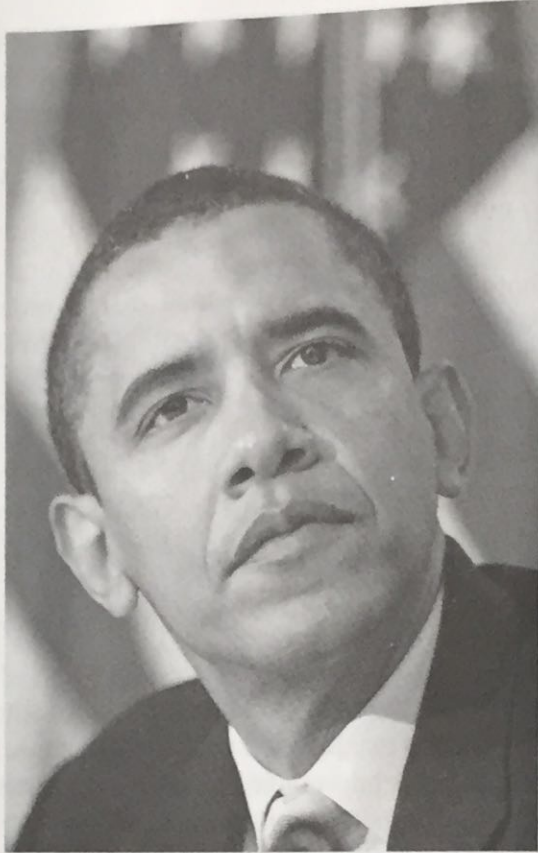
(5) Are all photographs copyrightable, on the basis that, as Judge Learned Hand once famously observed, that “[n]o photograph, however simple, can be unaffected by the personal influence of the author, and no two will be absolutely alike”? *Jewelers’ Circular Publishing Co. v. Keystone Publishing Co.*, 274 F. 932, 934 (S.D.N.Y. 1921), *aff’d*, 281 F. 83 (2d Cir. 1922). Is that true? Can you think of any photographs that do not possess the requisite “minimal degree of creativity”? See, e.g., *Oriental Art Printing, Inc. v. Goldstar Printing Corp.*, 175 F. Supp. 2d 542 (S.D.N.Y. 2001) (photographs of Chinese food dishes on menu not sufficiently original). You may wish to reconsider this question after reading the *Meshwerks* case in § 2.02[E] below. See Hughes, *The Photographer’s Copyright: Photograph as Art, Photograph as Database*, 25 Harv. J. L. & Tech. 327 (2012).

(6) *Classifying the elements of originality in photographs?* In *Mannion v. Coors Brewing Co.*, 377 F. Supp. 2d 444 (S.D.N.Y. 2006), involving a dispute as to whether a billboard for defendant’s Coors Light beer infringed the plaintiff’s copyright in a photograph of basketball star Kevin Garnett, the court described photographs as being capable of originality in three (non-mutually exclusive) respects:

- *Rendition.* This comprises various aspects of the subject’s depiction, including “angle of shot, light and shade, exposure, [and] effects achieved by means of filters [or] developing techniques.” According to the *Mannion* court, “[u]nless a photograph replicates another work with total or near-total fidelity, it will be at least somewhat original in the rendition.”
- *Timing.* This involves the photographer’s decision to seize a moment in time and reduce it to an image (“being at the right place at the right time”). An example is Alfred Eisenstadt’s photo of a sailor kissing a young woman on World War II’s V-J Day in New York’s Times Square.
- *Creation of the Subject.* This aspect of photographic originality consists of contriving or “creat[ing] the scene or subject to be photographed.” For example, the photographer may pose the subject in a particular setting, such as a couple on a park bench with eight puppies on their laps.

Is this typology helpful in explaining the originality in Sarony’s image in *Burrow-Giles*? How about Mannie Garcia’s Associated Press photo of then-candidate Barack Obama, used by artist Shepard Fairey during the 2008 presidential campaign to produce his iconic “Hope” poster? Are there aspects other than those catalogued in *Mannion* that might serve as a proper basis for finding originality in a photograph?

Would it be useful to formalize a multi-part originality analysis for *other types* of works of authorship, such as literary, musical, or architectural works? Or is there something special about photography that lends itself to such analysis?



(7) *The hidden issue of joint authorship.* In *Burrow-Giles*, were all of the relevant elements the result of Sarony's own creative artistry? Might not some of them have been more fairly attributed to the sitter himself? Would acknowledging Wilde's contributions have complicated the analysis or jeopardized its outcome? For a case in which the sitter's contribution is discussed (and dismissed), see *Olan Mills, Inc. v Eckerd Drug of Texas, Inc.*, 1989 U.S. Dist. LEXIS 13768 (N.D. Tex., Apr. 21, 1989). We will reencounter the issue of joint authorship in § 4.01 below.

(8) *Non-human authorship.* Occasionally, disputes have arisen over paintings or photos created by animals. In 2011, for example, photographer David Slater published two "selfie" photos of a macaque monkey, taken by the monkey when it stole his camera. Various websites refused to remove the images on the ground that Slater was not the "author" and did not own the copyright. See, e.g., http://en.wikipedia.org/wiki/Monkey_selfie (visited July 31, 2015). Is there a valid copyright in the photos? If so, who owns it? Slater, who set up the camera (perhaps anticipating the monkeys might take it)? The "owner" of the monkey (if it is a captive animal)? Can the monkey own a copyright? For the view of the U.S. Copyright Office, see COMPENDIUM OF COPYRIGHT OFFICE PRACTICES § 313.2, at 33 (3d ed. 2014) (COMPENDIUM III).

BLEISTEIN v. DONALDSON LITHOGRAPHING CO.

Supreme Court of the United States

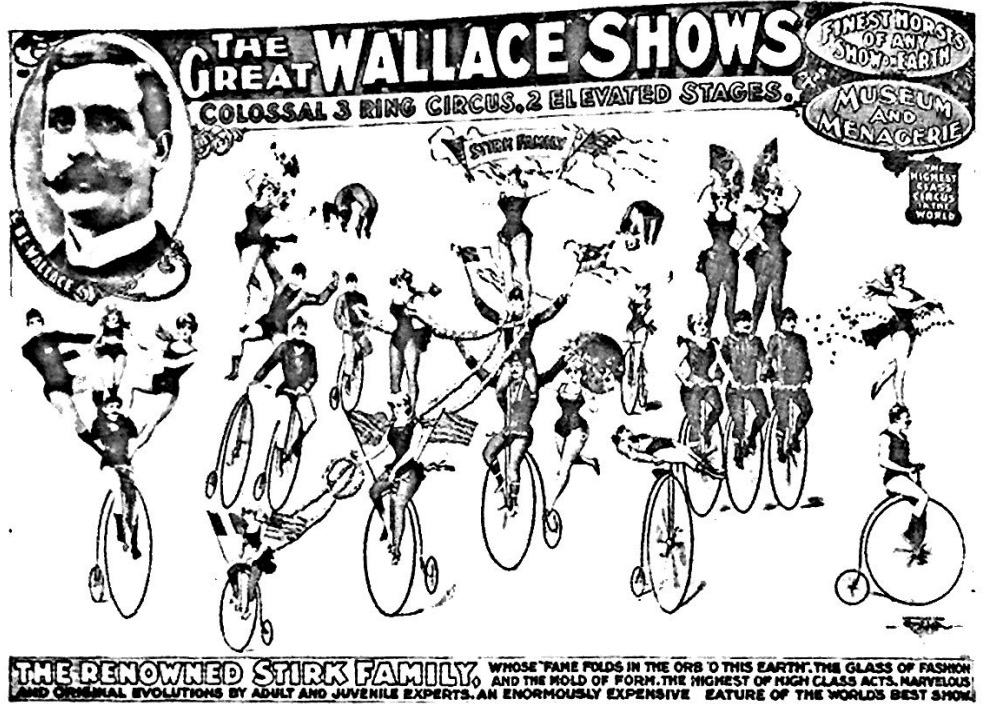
188 U.S. 239 (1903)

MR. JUSTICE HOLMES delivered the opinion of the court.

. . . The alleged infringements consisted in the copying in reduced form of three chromolithographs prepared by employees 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 statues. 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. . . .

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 Lithographing Co. v Sarony*, 111 U.S. 53. It is obvious also that the plaintiff's 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. . . . 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.



An Original Wallace Shows Poster

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. . . . 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*, first 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. . . .

We assume that the construction of Rev. Stat. § 4952 (U.S. Comp. Stat. 1901, p. 3406), allowing a copyright to the "author, designer, or proprietor . . . of any engraving, cut, print . . . [or] chromo" is affected by the act of 1874 (U.S. Comp. Stat. 1901, p. 3412). 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 Müller’s engraving of the Madonna di San Sisto could not be protected today 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 our 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. . . . 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.

MR. JUSTICE HARLAN, 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. . . .

Courier Lithographing Co. v. Donaldson Lithographing Co., 104 F. 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.

NOTES AND QUESTIONS

(1) Justice Holmes writes that "the question of originality" was appropriately decided by the trial court. Must the plaintiff prove that her work is original? For the answer, see *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*, 499 U.S. 340 (1991), following these notes.

(2) *Bleistein and copyrightability generally*. The impact of the decision in *Bleistein* was immediate and profound. As Diane Leenheer Zimmerman has noted, "Lower court judges both understood the case as setting the threshold for copyrightability at a very low level, and appreciated the pragmatic virtues of this approach. . . . [W]ithin thirty years, an appellate court could list dozens of decisions and cite to major treatises all agreeing that *Bleistein* required only 'a low degree of originality and artistic or literary merit' to obtain copyright." Zimmerman, *The Story of Bleistein v. Donaldson Lithographing Company: Originality as a Vehicle for Copyright Inclusivity*, in Intellectual Property Stories 77, 101–02 (J. Ginsburg & R. Dreyfuss eds. 2005) (hereinafter "*Bleistein Story*"), citing *Ansehl v. Puritan Pharmaceutical Co.*, 61 F.2d 131, 136 (8th Cir. 1932).

(3) *Artistic taste and Justice Holmes*. Is it useful, or just fun, to learn that Justice Holmes was fond of visiting art museums and, as a young man, "[h]e himself had created designs for advertising cards to publicize productions of the Hasty Pudding Club at Harvard"? Or that, looking back on the decision, Holmes noted

ironically that “Harlan, that stout old Kentuckian, not exactly an esthete, dissented for high art”? *Bleistein Story* at 95.

(4) *The judiciary and aesthetic non-discrimination.* The proposition for which this case most often is cited — and one of the most famous lines in the annals of copyright jurisprudence — is Justice Holmes’ comment that “[i]t would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations . . . ” This self-effacing observation has been generalized into what is sometimes called (rather grandly) the principle of “aesthetic non-discrimination”: judges evaluating issues of copyrightability should not take into account the aesthetic *quality* of the works under consideration. Like all useful general prescriptions, this one raises certain questions. For example, is it even *possible* to observe the prescription faithfully? As you read the cases in this book, you should ask yourself if judges really do steer clear of making qualitative assessments of works at issue as they go from case to case.

You should ask also whether the general principle of non-discrimination should be subject to any defined exceptions. In *Bleistein*, Justice Holmes continues the statement quoted above with these words: “. . . outside of the narrowest and most obvious limits.” But what are those limits, and how obvious are they in fact? Would it have been possible for Justice Holmes to define a narrowly worded principle of exclusion that denied protection to the posters in *Bleistein* without leading the judiciary into the swamp of aesthetics?

(5) As already noted, Justice Holmes discusses at length the degree of originality required before an author may protect his or her writing under the copyright statute. But is this the real issue in the case? Surely, creation of the poster required much more than the minimal artistic effort that Justice Holmes describes as warranting copyright protection. Notice that the dissent focuses not on the amount of creative effort necessary to produce the poster, but on the argument that the Constitution limits copyrightable expression to that which promotes progress. In the dissent’s view, the sole function of the poster was commercial, and that, apart from its use as an advertisement, the poster had no value. Is the disagreement between the majority and the dissent about the constitutional limits of the Congress’s copyright power or is it about how the asserted “progress” limit on that power should apply to the poster in this case?

(6) *Discrimination on other grounds.* As *Bleistein* demonstrates, commercial speech, although arguably not “promotive of the useful arts” (to use Judge Lurton’s phrase), receives at least a modicum of protection — and perhaps a good deal more than that — under copyright law. Note that the majority and dissenting Justices in *Bleistein* appear to share a dubious construction of the Constitution’s Art. I, § 8, cl. 8. These days, the Copyright Clause is commonly read to mean that copyright is intended “To promote the Progress of Science” (meaning “knowledge” in 18th-Century usage). Does it matter? Or would the lines between majority and dissent have been similarly drawn under this alternative understanding of the constitutional grant of power?

(7) At the trial in *Bleistein*, the defendants objected (unsuccessfully) to one of the Wallace Shows posters (depicting ballet dancers in tights) because it constituted “an immoral picture.” *Bleistein Story* at 87 n.49. Should all forms of expression

receive protection? What if the work can be demonstrated to have “negative social utility” in the eyes of the law, so that it could be successfully prosecuted as, for example, fraudulent, libelous, seditious, or obscene? Although two Courts of Appeals have held that obscenity is not a defense to copyright infringement, *see Jartech, Inc. v Clancy*, 666 F.2d 403 (9th Cir. 1982); *Mitchell Bros. Film Group v Cinema Adult Theater*, 604 F.2d 852 (5th Cir. 1979), some courts remain reluctant to extend copyright protection to such works. *See, e.g., Devils Films, Inc. v Nectar Video*, 29 F. Supp. 2d 174 (S.D.N.Y. 1998) (declining to order seizure of allegedly infringing films on grounds of obscenity). Why isn’t it simply inconsistent to extend copyright protection to works containing material that is outside the zone of speech protected by the First Amendment? *See Bartow, Copyright Law and Pornography*, 91 Or. L. Rev. 1 (2012).

One obvious problem with permitting an “obscenity defense” to claims of copyright infringement is that, under the Supreme Court’s decision in *Miller v California*, 413 U.S. 15 (1973), whether a particular work is obscene is to be decided, in part, according to local community standards. As the Ninth Circuit observed in *Jartech*, “[a]cceptance of an obscenity defense would fragment copyright enforcement, protecting registered materials in a certain community, while, in effect, authorizing pirating in another locale.” 666 F.2d at 406. Would these problems disappear if a national standard were used to determine the copyrightability of obscene works? Or would the result be merely a different form of copyright fragmentation?

(8) A *perhaps* related issue is: Who is competent to make the judgment that works of a particular kind may advance the constitutional purpose, whatever that purpose is? Can a circus poster “Promote the Progress of Science”? Assume that Congress explicitly has made the decision to extend (or deny) protection to a particular class of works. Given the scope of the grant of power in the Copyright Clause, would the courts have any business second-guessing such a legislative choice? Under the language of the Copyright Clause, isn’t Congress impliedly given almost *carte blanche* to make the tough decisions about which works to protect? For a discussion of the scope of Congressional power under the Clause, see the Supreme Court’s opinion in *Eldred v Ashcroft*, reproduced in § 5.01 below.

(9) *Who decides the question of originality?* Another issue at trial in *Bleistein* was whether the plaintiffs had filed the correct paperwork with the Library of Congress. Today, would-be copyright owners sometimes tangle with the Copyright Office during the registration process about whether their works are sufficiently “original.” (The functions of the Office are described in greater detail in § 6.04.) How much deference should the Register of Copyrights be accorded in matters of law which Congress left to the courts? *See Paul Morelli Design, Inc. v Tiffany & Co.*, 200 F. Supp. 2d 482 (E.D. Pa. 2002) (not error for District Court to instruct jury to give “some deference” to Register’s denial of registration). In *Atari Games Corp. v Oman*, 888 F.2d 878 (D.C. Cir. 1989), the majority in the Court of Appeals showed little deference to the Register’s adverse determination, although the District Judge had referred repeatedly to the Office’s “considerable expertise and experience” resulting from “having to make such determinations [of copyrightability] on a daily basis.” What is the proper standard of judicial review in such cases: “abuse of discretion” or something else? *See OddzOn Prods., Inc. v Oman*, 924 F.2d 346

(D.C. Cir. 1991) (affirming Register's denial of registration to a KOOSH ball, "a patented, trademarked product formed of hundreds of floppy, wiggly, elastomeric filaments radiating from a core"). Is your conclusion affected by the fact that, under § 701(e) of the 1976 Act, registration decisions of the Copyright Office are reviewable as "agency actions" under the Administrative Procedure Act, 5 U.S.C. § 501 *et seq.*? Is there any other method by which a denial of registration may effectively be challenged? *See Syntek Semiconductor Co. v. Microchip Technology, Inc.*, 307 F.3d 775 (9th Cir. 2002) (action for declaratory judgment that copyright registration was invalid stayed to refer matter to Register of Copyrights under doctrine of primary jurisdiction).

(10) If courts don't defer extensively to Copyright Office decisions about originality, why do refusals to register matter? Among the most common reasons behind attempts to register claims to copyright is the desire to initiate an infringement action. For U.S. works, § 411(a) of the 1976 Act provides, in part, that "no civil action for infringement of the copyright in any United States work shall be instituted until . . . registration of the copyright claim has been made." *See* Chapter 6. Given this, why doesn't refusal by the Copyright Office to register claims lead more often to court challenges of its registration decisions? *See OddzOn Prods., Inc.*, 924 F.2d at 350 n.6. And are there any other reasons, not related to litigation, why a copyright holder might want to seek registration? *See id.* at 347.

(11) *Originality and the scope of copyright.* At one point in his *Bleistein* opinion, Justice Holmes observes: "Others are free to copy the original. They are not free to copy the copy." What does this mean? Does it mean that, although Burrow-Giles could not reproduce Sarony's photograph of Oscar Wilde, it was free to make its own photograph of Oscar Wilde? What if Burrow-Giles posed Wilde in the same manner as did Sarony? *See Ets-Hokin v. Skyy Spirits, Inc.*, 323 F.3d 763 (9th Cir. 2003) (although plaintiff's photo of a vodka bottle was sufficiently original, the defendant's photo did not infringe under the "merger" doctrine). For more on the merger doctrine, see § 2.02 below.

(12) How should the "rule" quoted in the preceding note be applied when the artist making the second copy is the same person who made the first copy? Is he or she then copying the subject of the original study, or the study itself? Consider the facts of *Gross v. Seligman*, 212 F. 930 (2d Cir. 1914), as stated by the court:

One Rochlitz, an artist, posed a model in the nude, and therefrom produced a photograph, which he named the "Grace of Youth." A copyright was obtained therefor; all the artist's rights being sold and assigned by the complainants. Two years later the same artist placed the same model in the identical pose, with the single exception that the young woman now wears a smile and holds a cherry stem between her teeth. He took a photograph of this pose, which he called "Cherry Ripe."

Id. at 930. The court carefully noted that the second photograph differed from the first, not only with respect to the smile and the cherry stem, but also because of differences in the background and slight changes in the model's figure. All the same, "[t]he identity of the artist and the many close identities of the pose, light, and shade, etc., indicate very strongly that the first picture *was used to produce the second.*" *Id.* at 931 (emphasis added). Had the artist infringed the copyright in the

original photograph? The court held that he had. But what did Rochlitz copy: the copy or the original?



"Grace of Youth"



"Cherry Ripe"

Compare this with *Franklin Mint Corp. v. National Wildlife Art Exchange, Inc.*, 575 F.2d 62 (3d Cir. 1978), in which an artist painted a watercolor entitled "Cardinals on Apple Blossom," sold all rights in it to one of the parties to the eventual lawsuit, and then produced a similar painting, entitled "Cardinal," as part of a series published by the other party. In preparing the latter work, the artist used, among other aids, the same preliminary sketches, photographs, slides and working drawings (but not the "two stuffed cardinal specimens") that he had employed in creating the first work. The court noted that the two paintings contained "obvious similarities" but also "readily apparent dissimilarities." It concluded that the "similarity between the works necessarily reflected the common theme or subject and each painting was a separate artistic effort." *Id.* at 66.

Both of these cases raise the question of whether the *subject matter* of a photograph is subject to copyright protection. This question implicates an important limitation on copyright known as the idea/expression dichotomy, which we will examine in § 2.02[D] below.

(13) *A preview: the work-for-hire doctrine.* It sometimes goes unnoted that in addition to its fruitful pronouncements on the issue of "originality" in copyright, *Bleistein* also marked the first appearance of the rule that the employers should be considered the authors of works made by employees within the scope of their duties — applicable in this case (per Justice Holmes) if the posters were created by "persons employed and paid by the plaintiffs in their establishment to make those very things." 188 U.S. at 248–49. As Professor Zimmerman puts it, "[a]lthough the concept of works made for hire was not formally introduced into American copyright until 1909, modern commentators treat this language in *Bleistein* as the origin of the doctrine. . . ." Zimmerman, *Bleistein* Story at 91–92. For more on the work-for-hire doctrine, see § 4.01 below.

FEIST PUBLICATIONS, INC. v. RURAL TELEPHONE SERVICE COMPANY, INC.

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

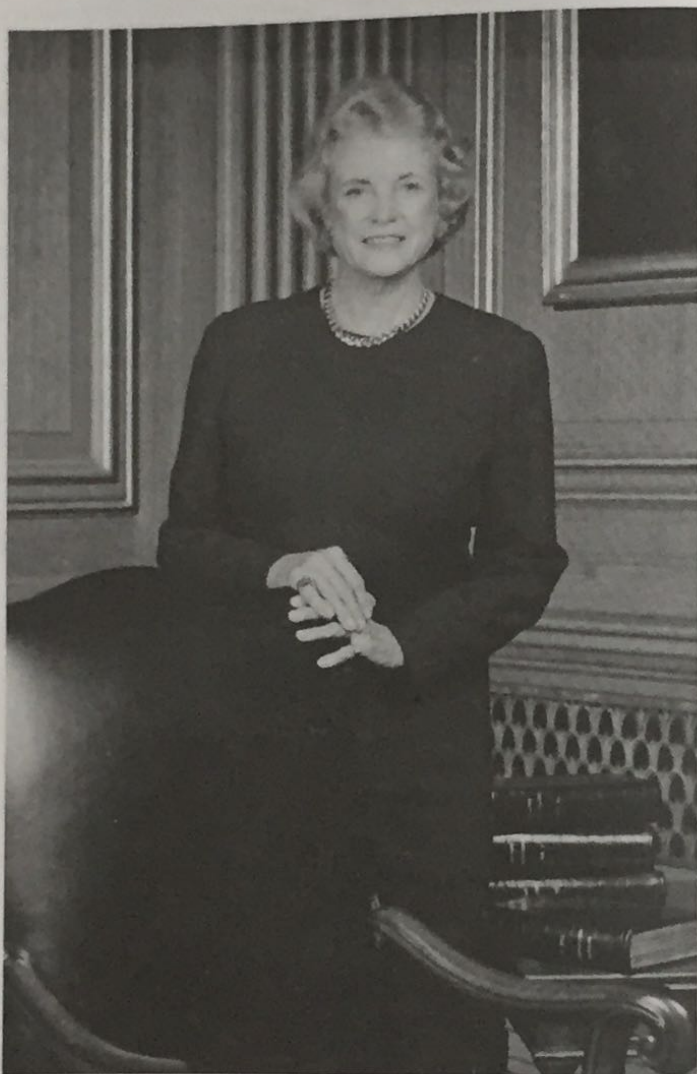
JUSTICE O'CONNOR delivered the opinion of the Court.

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

I.

[Rural Telephone Service Company published a telephone directory covering only listings for the area for which it provided local telephone service. Feist Publications's publication was "area wide," aggregating the telephone listings for 11 different calling areas spread out over 15 counties in northwest Kansas. Feist offered to pay for the right to copy these directories in its publication. All of the other telephone companies except Rural accepted this offer. The facts of the case are set forth more fully in the discussion of copyright in compilations in § 3.02[C].]

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.



JUSTICE SANDRA DAY O'CONNOR

Photograph by Dane Penland

Smithsonian Institution Courtesy of the Supreme Court of the United States

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). . . . 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. . . . 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. . . . 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. . . . 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. . . .

Originality is a constitutional requirement. The source of Congress' power to enact copyright laws is Article I, § 8, cl. 8, of the Constitution, which authorizes Congress to "secur[e] for limited Times to Authors . . . the exclusive Right to their respective Writings." In two decisions from the late 19th Century — *The Trade-Mark Cases*, 100 U.S. 82 (1879); and *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884) — this Court defined the crucial terms "authors" and "writings." In so doing, the Court made it unmistakably clear that these terms presuppose a degree of originality.

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

In *Burrow-Giles*, the Court distilled the same requirement from the Constitution's use of the word "authors." The Court defined "author," in a constitutional sense, to mean "he to whom anything owes its origin; originator; maker." 111 U.S., at 58 (internal quotations 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," *ibid.*, 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.*, 111 U.S., 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, 561-62 (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). . . .

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." [NIMMER ON COPYRIGHT] § 2.11[A], at 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 v. Universal City Studios, Inc.*, 650 F.2d 1365, 1369 [(CA5 1981)].

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, *Monopolizing the Law: The Scope of Copyright Protection for Law Reports and Statutory Compilations*, 36 UCLA L. Rev. 719, 800–802 (1989)]; 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. *Accord Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975). To this end, copyright assures authors the right to their original expression, but encourages others to build freely upon the ideas and information conveyed by a work. *Harper & Row, supra*, at 556–557. This principle, known as the idea/expression or fact/expression dichotomy, applies to all works of authorship. As applied to a factual compilation, assuming the absence of original written expression, only the compiler’s selection and arrangement may be protected; the raw facts may be copied at will. This result is neither unfair nor unfortunate. It is the means by which copyright advances the progress of science and art.

This Court has long recognized that the fact/expression dichotomy limits

severely the scope of protection in fact-based works. [Discussion of *Baker v. Selden*, 101 U.S. 99, 103 (1880), and *Harper & Row, supra*, omitted.]

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

B.

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

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

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

Most courts construed the 1909 Act correctly, notwithstanding the less-than-perfect statutory language. They understood from this Court's decisions that there could be no copyright without originality. See *Patterson & Joyce* 760–761. . . .

But some courts misunderstood the statute. See, e.g., *Leon v. Pacific Telephone & Telegraph Co.*, 91 F.2d 484 (CA9 1937); *Jeweler's Circular Publishing Co. v. Keystone Publishing Co.*, 281 F. 83 (CA2 1922). These courts ignored § 3 and § 4, focusing their attention instead on § 5 of the Act. Section 5, however, was purely technical in nature: it provided that a person seeking to register a work should indicate on the application the type of work, and it listed 14 categories under which the work might fall. One of these categories was "books, including composite and cyclopedic works, directories, gazetteers, and other compilations." § 5(a). Section 5 did not purport to say that all compilations were automatically copyrightable. Indeed, it expressly disclaimed any such function, pointing out that "the subject-matter of copyright is defined in section four." Nevertheless, the fact that factual compilations were mentioned specifically in § 5 led some courts to infer erroneously that directories and the like were copyrightable *per se*, "without any further or precise showing of original — personal — authorship." *Ginsburg* 1895.

Making matters worse, these courts developed a new theory to justify the

protection of factual compilations. Known alternatively as “sweat of the brow” or “industrious collection,” the underlying notion was that copyright was a reward for the hard work that went into compiling facts. The classic formulation of the doctrine appeared in *Jeweler’s Circular Publishing Co.*, 281 F., at 88 (emphasis added):

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[s], acquires material of which he is the author.

The “sweat of the brow” doctrine had numerous flaws, the most glaring being that it extended copyright protection in a compilation beyond selection and arrangement — the compiler’s original contributions — to the facts themselves. Under the doctrine, the only defense to infringement was independent creation. A subsequent compiler was “not entitled to take one word of information previously published,” but rather had to “independently 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 (internal quotations omitted). “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. Recognizing that § 5 of the Act specifically mentioned “periodicals, including newspapers,” § 5(b), the Court acknowledged that news articles were copyrightable. *Id.*, at 234. It flatly rejected, however, the notion that the copyright in an article extended to the factual information it contained: “The news element — the information respecting current events contained in the literary production — is not the creation of the writer, but is a report of matters that ordinarily are *publici juris*; it is the history of the day.” *Id.**

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. *Accord Gorman, Fact or Fancy: The Implications for Copyright*, 29 J. Copyright Soc. 560, 563 (1982). But “sweat of the brow” courts took a contrary view; they handed out proprietary interests in facts and declared that authors are absolutely precluded from saving time and effort by relying upon the facts contained in prior works. In truth, “[i]t is just such wasted effort that the

* The Court ultimately rendered judgment for Associated Press on noncopyright grounds that are not relevant here. See 248 U.S. at 235, 241-42.

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.'"
 . . .

[The remainder of the *Feist* opinion addresses copyright in compilations, and is addressed in § 3.02 below.]

NOTES AND QUESTIONS

(1) *Why originality?* The Court in *Feist* addressed a fundamental question about whether the purpose of copyright is to protect effort or creative contributions. The "sweat of the brow" doctrine, developed by the lower courts and laid to rest in *Feist*, resonates with John Locke's labor theory of property rights discussed in § 1.06 above. On this view, copyright protects effort, not originality. How can requiring a certain standard of originality be justified as a matter of policy? On the basis that we wish to reward only those who have truly enriched society? To protect potential defendants against unwarranted litigation by those claiming copyright in matters with little if any distinction from what society already owns as part of the public domain?

Feist ranks effortlessly as one of the Court's truly great opinions on copyright. In a masterly opinion for a unanimous Court, Justice O'Connor emphatically declared originality to be an inescapable constitutional requirement for copyright protection for all works of authorship.

(2) *Distinguishing originality from novelty.* In § 1.02, we explained that, to obtain a patent, an inventor must demonstrate that his or her invention is novel, nonobvious, and useful. Because patents and copyrights spring from the same constitutional clause, one might think the same requirements would be prescribed for a copyright as well. But as we will explain, the "originality" requirement in copyright law is significantly different from the "novelty" requirement in patent law.

Neither the Constitution nor any of the copyright acts prior to 1976 mention "originality," although the House Report, as we have seen, claims that the 1976 Act, in requiring an "original work of authorship" as a prerequisite to federal copyright, merely "incorporates . . . the standard of originality established by the courts" in construing prior acts. On what basis may it be said that originality is constitutionally mandated as a precondition to statutory protection for intellectual creations? *Feist* locates the originality requirement in the words "Authors" and "Writings" in Art. I, § 8, cl. 8. This conclusion rests in large measure on the concept of the Romantic "author" discussed in § 1.04. Before the Romantic Movement in art and literature, "authors" were lauded not necessarily for their originality, but for their imitation of existing material.

Another possible basis for interpreting the words "authors" and "writings" to require originality is the constitutional phrase "to promote the Progress of Science."

If the purpose of copyright is to promote knowledge by providing an incentive for the creation and publication of new works, then should we require that a purported “author” demonstrate how his or her work improves upon, or is different from, works that have gone before? Such a requirement would be analogous to the novelty requirement in patent law, which, as implemented in the Patent Act of 1790, required an inventor to “distinguish the invention or discovery from other things before known and used.”

(3) In *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951), the defendants argued that “to be valid, a patent must disclose a high degree of uniqueness, ingenuity and inventiveness,” and contended “that the same requirement constitutionally governs copyrights.” *Id.* at 100. The court acknowledged that the word “original” was ambiguous: It *could* mean “startling, novel or unusual, a marked departure from the past.” *Id.* at 102. Nonetheless, the court rejected that interpretation, concluding that “nothing in the Constitution commands that copyrighted matter be strikingly unique or novel.” *Id.* The court reasoned that the First Congress, “legislators peculiarly familiar with the purpose of the Constitutional grant, . . . imposed far less exacting standards in the case of copyrights” than they did for patents. *Id.* at 101. It also contrasted the word “author” with the word “inventor,” saying “the latter carries an implication which excludes the results of only ordinary skill, while nothing of this is necessarily involved in the former.” *Id.* at 102. Rather, it explained:

“Original” in reference to a copyrighted work means that the particular work “owes its origin” to the “author.” 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. . . .”

Thus, in *Situation Mgmt. Sys., Inc. v. ASP Consulting LLC*, 560 F.3d 53 (1st Cir. 2009), the fact that the plaintiff’s work was “filled with generalizations, platitudes, and observations of the obvious,” contained “not-so-stunning revelation[s],” and “at its creative zenith” taught “common-sense” communication skills, did not render the work unoriginal, because “the district court erroneously treated copyright law’s originality requirement as functionally equivalent to a novelty standard.” *See also Kelley v. Chicago Park District*, 635 F.3d 290 (7th Cir. 2011) (holding that the District Court “mistakenly equate[d] originality with novelty” when it determined that Wildflower Works, an arrangement of living plants, 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]”).

(4) *Originality and independent creation.* The distinction between novelty and originality is often explained by saying that if a writer who has never known a previous work somehow creates an exact duplicate of that work or a substantial portion thereof, the second work is nonetheless copyrightable because, even though it is not “novel” or “unique,” it “originated” with the second author. *See, e.g., Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 54 (2d Cir. 1936) (L. Hand, J.) (“it makes no difference how far the [copyrighted work] was anticipated by

works in the public demesne which the plaintiffs did not use”); *Alfred Bell*, 191 F.2d at 103 (“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.”); *Boisson v. Banian, Ltd.*, 273 F.3d 262, 270 (2d Cir. 2001) (“[A]n author is entitled to copyright protection for an independently created original work despite its identical nature to a prior work, because it is independent creation, not novelty, that is required.”).

Except for the most simplistic and obvious writings, however, exact duplication of an entire work without copying is extremely unlikely. It beggars imagination that anyone could independently create an exact replica of Keats’ “Ode On a Grecian Urn,” any more than the proverbial monkey at a typewriter will bang out the Gettysburg Address. Does this mean that the distinction between originality and novelty lacks practical significance? The fact is that courts can, and often do, consider evidence of prior similar works in determining originality. See, e.g., *Acuff-Rose Music, Inc. v. Jostens, Inc.*, 155 F.3d 140 (2d Cir. 1998) (“prior usage of the saying was sufficiently widespread as to make it exceedingly unlikely” that plaintiff originated phrase “You’ve got to stand for something or you’ll fall for anything”); *Paul Morelli Design, Inc. v. Tiffany & Co.*, 200 F. Supp. 2d 482, 487 (E.D. Pa. 2002) (“The jury also had before it evidence of other jewelry which bore on originality and creativity”); *Meade v. United States*, 27 Fed. Cl. 36 (1992) (relying on evidence that similar works “have existed for centuries”). Nevertheless, evidence of prior works will not always negate a finding of originality. See *Ulloa v. Universal Music and Video Distribution Corp.*, 2004 U.S. Dist. LEXIS 6755 (S.D.N.Y. Apr. 19, 2004) (use of melody in which plaintiff claimed copyright in 14 prior works did not defeat copyrightability, because “originality does not signify novelty”). Can you think of other realistic situations in which it makes a difference that only originality, but not novelty, is required for copyright?

(5) *Originality and amount of expression.* How much expression must an author add for her work to be “original”? In *Emerson v. Davies*, 8 F. Cas. 615, 619 (C.C.D. Mass. 1845) (No. 4436), Justice Story offered the following practical reason for applying a low threshold for the originality standard in copyright:

In truth, in literature, in science and in art, there are, and can be, few, if any, things, which, in an abstract sense, are strictly new and original throughout. Every book in literature, science and art, borrows, and must necessarily borrow, and use much which was well known and used before. . . . If no book could be the subject of copyright which was not new and original in the elements of which it is composed, there could be no ground for any copyright in modern times, and we would be obliged to ascend very high, even in antiquity, to find a work entitled to such eminence. Virgil borrowed much from Homer; Bacon drew from earlier as well as contemporary minds; Coke exhausted all the known learning of his profession; and even Shakespeare and Milton . . . would be found to have gathered much from the abundant stores of current knowledge and classical studies in their days.

More than 100 years later, another commentator made the following observation:

[T]o make the copyright turnstile revolve, the author should have to deposit more than a penny in the box, and some like measure ought to apply to infringement. Surely there is danger in trying to fence off small *quanta* of works or other collocations; these pass quickly into the idiom; to allow them copyright, particularly if aided by a doctrine of “unconscious” plagiarism, could set up untoward barriers to expression.

B. Kaplan, AN UNHURRIED VIEW OF COPYRIGHT 46 (1967).

In Chapter 3, we will return to the quantum requirement — the question of exactly how little (and what kind of) new authorship is needed to qualify a work as “original,” especially in the context of copyright protection for “derivative works” (i.e., works like musical arrangements, artistic reproductions, and translations — that are based substantially on preexisting matter). Here, it is enough to note that while the copyright laws exist to encourage creative persons to produce new matter, there remains a narrow area in which admittedly independent efforts by an author are deemed too trivial or insignificant to warrant copyright protection and the rights that flow from it. “The standard of originality is low, but it does exist.” *Feist*, 499 U.S. at 362.

In *Atari Games Corp. v. Oman*, 888 F.2d 878 (D.C. Cir. 1989), then-Judge Ruth Bader Ginsburg noted that even “simple shapes, when selected or combined in a distinctive manner indicating some ingenuity, have been accorded copyright protection” But copyright nevertheless has been denied to short words and phrases, *Dobson v. NBA Properties, Inc.*, 1999 U.S. Dist. LEXIS 1834 (S.D.N.Y. Feb. 19, 1999) (“Repeat Threeppeat” in reference to Michael Jordan and the Chicago Bulls); slogans, *Alberto-Culver Co. v. Andrea Dumon, Inc.*, 466 F.2d 705 (7th Cir. 1972) (“most personal sort of deodorant”); short musical phrases, *Newton v. Diamond*, 204 F. Supp. 2d 1244 (C.D. Cal. 2002) (three-note sequence), *aff’d on other grounds*, 349 F.3d 591 (9th Cir. 2003); slight variations of musical works, *Woods v. Bourne Co.*, 60 F.3d 978 (2d Cir. 1995) (piano-vocal arrangement of existing lead sheet); the insignia of a soccer team, *John Muller & Co. v. New York Arrows Soccer Team, Inc.*, 802 F.2d 989 (8th Cir. 1986); and the title of a song, *Acuff-Rose Music, Inc. v. Jostens, Inc.*, 155 F.3d 140 (2d Cir. 1998) (“You’ve Got to Stand for Something”), as not meeting the *de minimis* standard. See Hughes, *Size Matters (or Should) in Copyright Law*, 74 Fordham L. Rev. 575 (2005). On the other hand, one eminent jurist has suggested that copyright protection would be accorded such lines as “Euclid alone has looked on Beauty bare” and “Twas Brillig and the slithy toves.” *Heim v. Universal Pictures Corp., Inc.*, 154 F.2d 480 (2d Cir. 1946) (Jerome Frank, J.).

(6) *Originality and creativity.* Remember, too, *Feist’s* requirement that an author’s contribution reflect at least some *creativity*. The drafters of the 1976 Act deliberately avoided introducing the term “creativity” into the statute to avoid any suggestion that the new Act somehow increased the standard for copyrightability previously established in the cases. See *Supplementary Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law: 1965 Revision Bill*, 89th Cong., 1st Sess., Copyright Law Revision Part 6, at 3 (House Comm. Print 1965). Nevertheless, “creativity” has become part of the common vocabulary of copyright analysis, suggesting that the inquiry into copyrightability has a qualita-

tive as well as a quantitative dimension — and that some kinds of texts and images just don't count, even if they owe their origins to the person or firm claiming copyright. See *Incredible Techs., Inc. v. Virtual Techs., Inc.*, 400 F.3d 1007 (7th Cir. 2005), where on-screen graphics showing how to operate the controls for a "PGA Golf Tour" video game were deemed to be explanatory and utilitarian, rather than creative, as well as being subject to the *scènes à faire* doctrine (denying protection to features which "are as a practical matter indispensable, or at least standard in the treatment of a given topic," *id.* at 1014), which we consider in more detail in § 8.03.

Decisions about rights in catalogue numbers for replacement parts demonstrate the tendency of courts to discount authorship showing minimal creativity. See *Toro Co. v. R & R Products Co.*, 787 F.2d 1208, 1213 (8th Cir. 1986) (no copyright because "[t]he random and arbitrary use of numbers in the public domain does not evince enough originality to distinguish authorship"); accord *Mitel, Inc. v. Iqtel, Inc.*, 124 F.3d 1366, 1374 (10th Cir. 1997). Copyright protection has also been denied to part numbers that were assigned in a systematic way, rather than in a creative manner. See *Southco, Inc. v. Kanebridge Corp.*, 390 F.3d 276, 283 (3d Cir. 2004) (*en banc*); *ATC Distrib. Group, Inc. v. Whatever It Takes Transmissions & Parts, Inc.*, 402 F.3d 700, 708–09 (6th Cir. 2005). Nevertheless, some numerical classification schemes may still qualify for protection. See *American Dental Ass'n v. Delta Dental Plans Assn.*, 126 F.3d 977 (7th Cir. 1997) (taxonomy classifying dental procedures and assigning numbers to each was an original work of authorship). Is the decision about how to assign page numbers to a compilation of public domain judicial decisions original? See § 3.02 below for the full story.

(7) *Originality as a question of fact or law.* Many courts treat the issue of whether a work is sufficiently original as a question of fact, *Matthew Bender & Co. v. West Publishing Co.*, 158 F.3d 674, 681 (2d Cir. 1998); *Montgomery v. Noga*, 168 F.3d 1282, 1291 n.14 (11th Cir. 1999); *North Coast Indus. v. Jason Maxwell, Inc.*, 972 F.2d 1031, 1034 (9th Cir. 1992); others treat the issue as a question of law, *Superior Form Builders, Inc. v. Dan Chase Taxidermy Supply Co., Inc.*, 74 F.3d 488, 495 (4th Cir. 1996); *Newton v. Diamond*, 204 F. Supp. 2d 1244, 1253 (C.D. Cal. 2002); *Compaq Computer Corp. v. Ergonome, Inc.*, 137 F. Supp. 2d 768, 775 n.3 (S.D. Tex. 2001); and others treat the issue as a mixed question of fact and law, *Los Angeles News Service v. Tullo*, 973 F.2d 791, 793 (9th Cir. 1992); cf. *Bleistein* 188 U.S. at 250 ("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 . . ."). Attempting to harmonize these disparate views, the court in *CMM Cable Rep., Inc. v. Ocean Coast Properties, Inc.*, 97 F.3d 1504, 1517 (1st Cir. 1996), said (using *Feist* as an example):

While we do not dispute that the question of originality can be a question of fact for the jury, it is not necessarily so. . . . [C]ourts clearly may determine the question of originality and, in turn, copyrightability so long as they do so in accord with the familiar rules governing summary judgment: where there are no genuine issues of material fact as to the originality of the work, such that no reasonable trier-of-fact could find originality, then the movant is entitled to judgment as a matter of law.

By contrast, questions of idea versus expression are usually treated as matters of law for the court to decide. *See* § 2.02[D] below.

What practical difference does characterizing the issue as one of fact or law make? First, as noted in *CMM*, it affects the right to a jury trial on the issue of originality. Another consideration is the role of expert witnesses. If the question of originality is one of fact, the opinion testimony of expert witnesses may be appropriate — for example, as to whether the work contains original features. *See, e.g., Paul Morelli Design, Inc. v. Tiffany & Co.*, 200 F. Supp. 2d 482, 486–87 (E.D. Pa. 2002). If the question is one of law, however, expert witnesses may *not* be appropriate, because the issue is one for the court alone. Finally, the characterization may affect the standard of review to be applied by an appellate court in reviewing a trial court's originality determination. *Compare Matthew Bender*, 158 F.3d at 681 (clearly erroneous), *with Los Angeles News Service*, 973 F.2d at 793 (*de novo*).

Which characterization of the originality issue — fact or law — do you think better comports with general principles of law? As you read the cases reproduced in the present section, consider whether the courts are simply resolving factual issues as to originality (as distinguished from novelty), or whether they are making policy determinations as a matter of law.

[C] Originality in the New Millennium

MESHWERKS, INC. v. TOYOTA MOTOR SALES U.S.A., INC. United States Court of Appeals, Tenth Circuit 528 F.3d 1258 (2008)

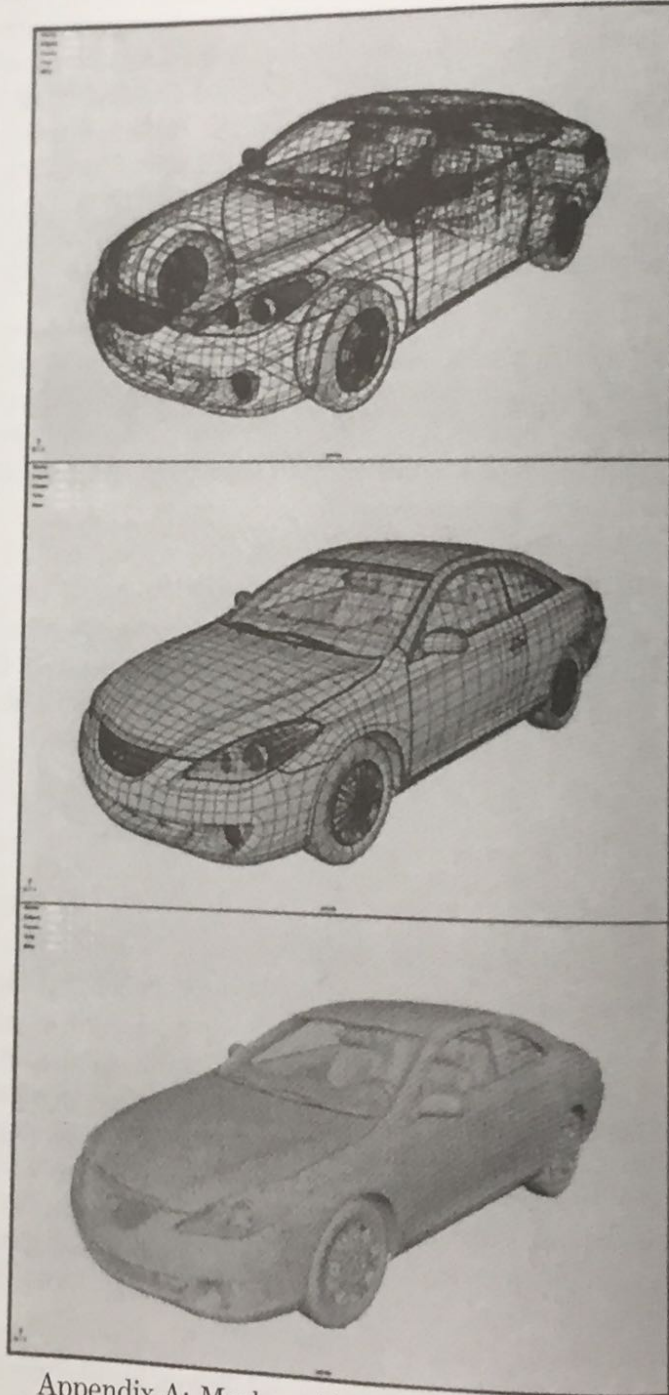
GORSUCH, CIRCUIT JUDGE. . . .

I.A.

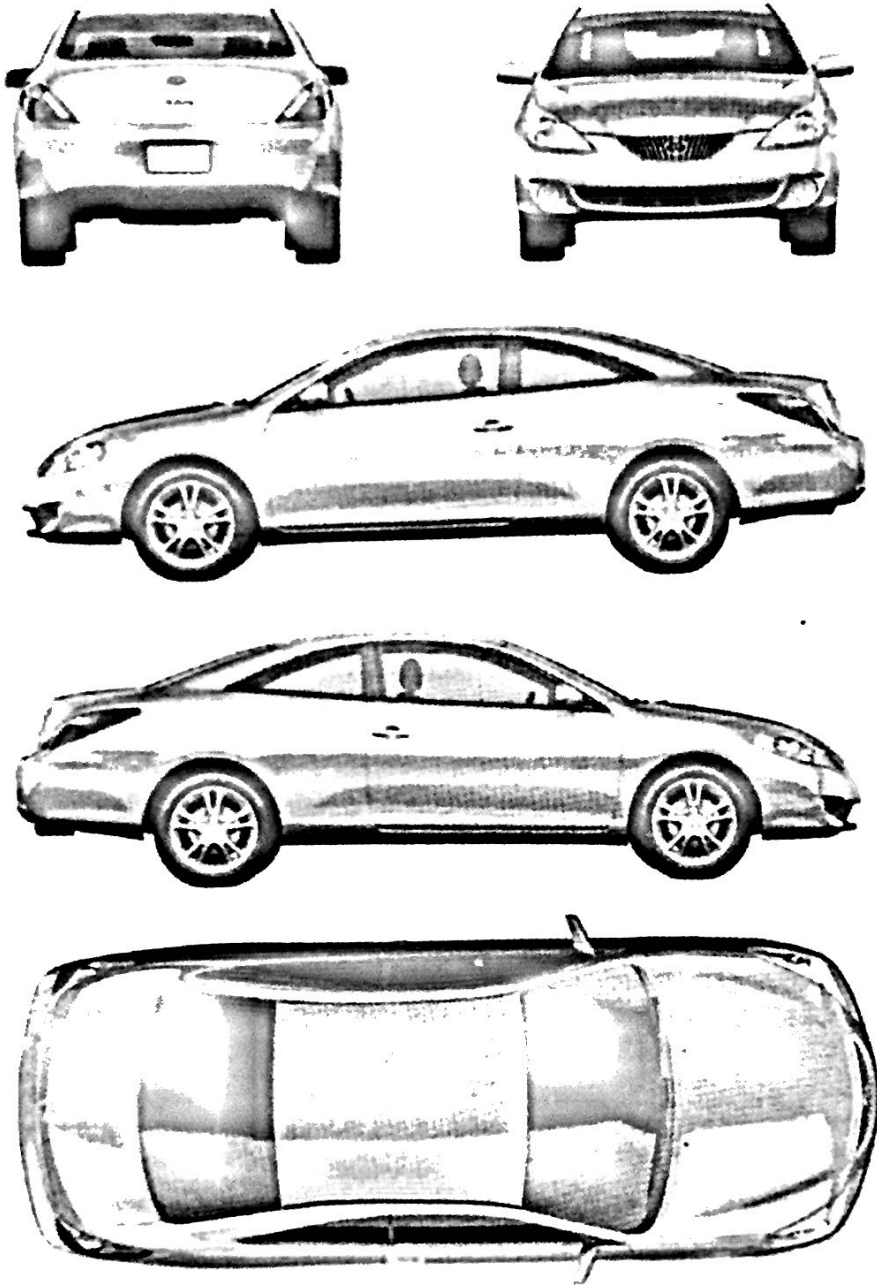
In 2003, and in conjunction with Saatchi & Saatchi, its advertising agency, Toyota began work on its model-year 2004 advertising campaign. Saatchi and Toyota agreed that the campaign would involve, among other things, digital models of Toyota's vehicles for use on Toyota's website and in various other media. These digital models have substantial advantages over the product photographs for which they substitute. With a few clicks of a computer mouse, the advertiser can change the color of the car, its surroundings, and even edit its physical dimensions to portray changes in vehicle styling; before this innovation, advertisers had to conduct new photo shoots of whole fleets of vehicles each time the manufacturer made even a small design change to a car or truck.

To supply these digital models, Saatchi and Toyota hired Grace & Wild, Inc. ("G & W"). In turn, G & W subcontracted with Meshwerks to assist with two initial aspects of the project — digitization and modeling. Digitizing involves collecting physical data points from the object to be portrayed. In the case of Toyota's vehicles, Meshwerks took copious measurements of Toyota's vehicles by covering each car, truck, and van with a grid of tape and running an articulated arm tethered to a

computer over the vehicle to measure all points of intersection in the grid. Based on these measurements, modeling software then generated a digital image resembling a wire-frame model. In other words, the vehicles' data points (measurements) were mapped onto a computerized grid and the modeling software connected the dots to create a "wire frame" of each vehicle.



Appendix A: Meshwerk's Wire-Frame Models



Appendix B: G&W's Work Product

At this point, however, the on-screen image remained far from perfect and manual “modeling” was necessary. Meshwerks personnel fine-tuned or, as the company prefers it, “sculpted,” the lines on screen to resemble each vehicle as closely as possible. Approximately 90 percent of the data points contained in each final model, Meshwerks represents, were the result not of the first-step measurement process, but of the skill and effort its digital sculptors manually expended at the second step. For example, some areas of detail, such as wheels, headlights, door

handles, and the Toyota emblem, could not be accurately measured using current technology; those features had to be added at the second “sculpting” stage, and Meshwerks had to recreate those features as realistically as possible by hand, based on photographs. Even for areas that were measured, Meshwerks faced the challenge of converting measurements taken of a three-dimensional car into a two-dimensional computer representation; to achieve this, its modelers had to sculpt, or move, data points to achieve a visually convincing result. The purpose and product of these processes, after nearly 80 to 100 hours of effort per vehicle, were two-dimensional wire-frame depictions of Toyota’s vehicles that appeared three-dimensional on screen, but were utterly unadorned — lacking color, shading, and other details. . . .

With Meshwerks’ wire-frame products in hand, G & W then manipulated the computerized models by, first, adding detail, the result of which appeared on screen as a “tightening” of the wire frames, as though significantly more wires had been added to the frames, or as though they were made of a finer mesh. Next, G & W digitally applied color, texture, lighting, and animation for use in Toyota’s advertisements. . . . G & W’s digital models were then sent to Saatchi to be employed in a number of advertisements prepared by Saatchi and Toyota in various print, online, and television media.

B.

This dispute arose because, according to Meshwerks, it contracted with G & W for only a single use of its models — as part of one Toyota television commercial — and neither Toyota nor any other defendant was allowed to use the digital models created from Meshwerks’ wire-frames in other advertisements. Thus, Meshwerks contends defendants improperly — in violation of copyright laws as well as the parties’ agreement — reused and redistributed the models created by Meshwerks in a host of other media. In support of the allegations that defendants misappropriated its intellectual property, Meshwerks points to the fact that it sought and received copyright registration on its wire-frame models. Defendants moved for summary judgment on the theory that Meshwerks’ wire-frame models lacked sufficient originality to be protected by copyright. . . . [The court granted summary judgment to the defendants.]

II.A.

. . . What exactly does it mean for a work to qualify as “original”? In *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991), the Supreme Court clarified that the work must be “independently created by the author (as opposed to copied from other works).” *Id.* at 345; see also *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884) (the work for which copyright protection is sought must “owe[] its origin” to the putative copyright holder) (internal quotation omitted). In addition, the work must “possess[] at least some minimal degree of creativity,” *Feist*, 499 U.S. at 345 . . .

The parties focus most of their energy in this case on the question whether Meshwerks’ models qualify as independent creations, as opposed to copies of

Toyota's handiwork. But what can be said, at least based on received copyright doctrine, to distinguish an independent creation from a copy? And how might that doctrine apply in an age of virtual worlds and digital media that seek to mimic the "real" world, but often do so in ways that undoubtedly qualify as (highly) original?

. . . [P]hotography was initially met by critics with a degree of skepticism: a photograph, some said, "copies everything and explains nothing," and it was debated whether a camera could do anything more than merely record the physical world. . . . [In *Burrow-Giles*], the Supreme Court noted that photographs may well sometimes lack originality and are thus not *per se* copyrightable. *Id.* ("the ordinary production of a photograph" may involve "no protection" in copyright). At the same time, the Court held, . . . to the extent a photograph reflects the photographer's decisions regarding pose, positioning, background, lighting, shading, and the like, those elements can be said to "owe their origins" to the photographer, making the photograph copyrightable, at least to that extent. . . .

B.

Applying these principles, evolved in the realm of photography, to the new medium that has come to supplement and even in some ways to supplant it, we think Meshwerks' models are not so much independent creations as (very good) copies of Toyota's vehicles. In reaching this conclusion we rely on (1) an objective assessment of the particular models before us and (2) the parties' purpose in creating them. All the same, we do not doubt for an instant that the digital medium before us, like photography before it, can be employed to create vivid new expressions fully protectable in copyright.

1. Key to our evaluation of this case is the fact that Meshwerks' digital wire-frame computer models depict Toyota's vehicles without any individualizing features: they are untouched by a digital paintbrush; they are not depicted in front of a palm tree, whizzing down the open road, or climbing up a mountainside. Put another way, Meshwerks' models depict nothing more than unadorned Toyota vehicles — the car *as car*. And the unequivocal lesson from *Feist* is that works are not copyrightable to the extent they do not involve any expression apart from the raw facts in the world. . . . [I]n short, its models reflect none of the decisions that can make depictions of things or facts in the world, whether Oscar Wilde or a Toyota Camry, new expressions subject to copyright protection.

The primary case on which Meshwerks asks us to rely actually reinforces this conclusion. In *Ets-Hokin v. Skyy Spirits, Inc.*, 225 F.3d 1068 (9th Cir. 2000) (*Skyy D*), the Ninth Circuit was faced with a suit brought by a plaintiff photographer who alleged that the defendant had infringed on his commercial photographs of a Skyy-brand vodka bottle. The court held that the vodka bottle, as a "utilitarian object," . . . was not itself (at least usually) copyrightable. *Id.* at 1080 (citing 17 U.S.C. § 101). At the same time, the court recognized that plaintiff's photos reflected decisions regarding "lighting, shading, angle, background, and so forth," *id.* at 1078, and to the extent plaintiff's photographs reflected such original contributions the court held they could be copyrighted. In so holding, the Ninth Circuit reversed a

district court's dismissal of the case and remanded the matter for further proceedings.

But *Skyy I* tells only half the story. The case soon returned to the court of appeals, and the court held that the defendant's photos, which differed in terms of angle, lighting, shadow, reflection, and background, did *not* infringe on the plaintiff's copyrights. *Ets-Hokin v Skyy Spirits, Inc.*, 323 F.3d 763, 765 (9th Cir. 2003) (*Skyy II*). Why? The only constant between the plaintiff's photographs and the defendant's photographs was the bottle itself, and an accurate portrayal of the unadorned bottle could not be copyrighted. Facts and ideas are the public's domain and open to exploitation to ensure the progress of science and the useful arts. Only original expressions of those facts or ideas are copyrightable, leaving the plaintiff in the *Skyy* case with an admittedly "thin" copyright offering protection perhaps only from exact duplication by others. *Id.* . . .

The teaching of *Skyy I* and *II*, then, is that the vodka bottle, because it did not owe its origins to the photographers, had to be filtered out to determine what copyrightable expression remained. And, by analogy — though not perhaps the one Meshwerks had in mind — we hold that the unadorned images of Toyota's vehicles cannot be copyrighted by Meshwerks and likewise must be filtered out. To the extent that Meshwerks' digital wire-frame models depict only those unadorned vehicles, having stripped away all lighting, angle, perspective, and "other ingredients" associated with an original expression, we conclude that they have left no copyrightable matter.

Confirming this conclusion as well is the peculiar place where Meshwerks stood in the model-creation pecking order. On the one hand, Meshwerks had nothing to do with designing the appearance of Toyota's vehicles, distinguishing them from any other cars, trucks, or vans in the world. . . . On the other hand, how the models Meshwerks created were to be deployed in advertising — including the backgrounds, lighting, angles, and colors — were all matters left to those (G & W [and] Saatchi) who came *after* Meshwerks left the scene. Meshwerks thus played a narrow, if pivotal, role in the process by simply, if effectively, copying Toyota's vehicles into a digital medium so they could be expressively manipulated by others.

Were we to afford copyright protection in this case, we would run aground on one of the bedrock principles of copyright law namely, that originality . . . means only that the work was independently created by the author (*as opposed to copied from other works*).” *Feist*, 499 U.S. at 345 (emphasis added). . . . See also *ATC Distr. Group, Inc. v Whatever It Takes Transmissions & Parts, Inc.*, 402 F.3d 700, 712 (6th Cir. 2005) (denying copyright protection to catalog illustrations of transmission parts “copied from photographs cut out of competitors’ catalogs”); *Bridgeman Art Library, Ltd. v Corel Corp.*, 36 F. Supp. 2d 191, 197 (S.D.N.Y. 1999) (denying copyright protection to photographs that were “‘slavish copies’ of public domain works of art”). . . .

It is certainly true that what Meshwerks accomplished was a peculiar kind of copying. It did not seek to recreate Toyota vehicles outright — steel, rubber, and all: instead, it sought to depict Toyota's three-dimensional physical objects in a two-dimensional digital medium. But we hold, as many before us have already suggested, that, standing alone, “[t]he fact that a work in one medium has been

copied from a work in another medium does not render it any the less a 'copy.' ” NIMMER ON COPYRIGHT § 8.01[B]. . . After all, the putative creator who merely shifts the medium in which another's creation is expressed has not necessarily added anything beyond the expression contained in the original. . . .

In reaching this conclusion, we do not for a moment seek to downplay the considerable amount of time, effort, and skill that went into making Meshwerks' digital wire-frame models. But, in assessing the originality of a work for which copyright protection is sought, we look only at the final *product*, not the process, and the fact that intensive, skillful, and even creative labor is invested in the process of creating a product does not guarantee its copyrightability. See *Feist*, 499 U.S. at 359-60. . . .

2. Meshwerks' intent in making its wire-frame models provides additional support for our conclusion. “In theory, the originality requirement tests the putative author's state of mind: Did he have an earlier work in mind when he created his own?” PAUL GOLDSTEIN, GOLDSTEIN ON COPYRIGHT § 2.2.1.1. If an artist affirmatively sets out to be unoriginal — to make a copy of someone else's creation, rather than to create an original work — it is far more likely that the resultant product will, in fact, be unoriginal. See Russ VerSteeg, *Intent, Originality, Creativity and Joint Authorship*, 68 Brook. L. Rev. 123, 133 (2002) (“[A] person's intent to copy . . . should be considered strong evidence that what that person has produced is not copyrightable.”). Of course, this is not to say that the accidental or spontaneous artist will be denied copyright protection for not intending to produce art; it is only to say that authorial intent sometimes can shed light on the question of whether a particular work qualifies as an independent creation or only a copy.

In this case, the undisputed evidence before us leaves no question that Meshwerks set out to copy Toyota's vehicles, rather than to create, or even to add, any original expression. The purchase order signed by G & W asked Meshwerks to “digitize and model” Toyota's vehicles, and Meshwerks' invoice submitted to G & W for payment reflects that this is exactly the service Meshwerks performed. . . . Meshwerks itself has consistently described digitization and modeling as an attempt accurately to depict real-world, three-dimensional objects as digital images viewable on a computer screen. . . .

Other courts before us have examined and relied on a putative copyright holder's intent in holding that the resultant work was not original and thus subject to copyright protection. The Sixth Circuit, for example, held that a series of catalog illustrations depicting auto transmission parts were not independently copyrightable. *ATC Distrib. Group, Inc*, 402 F.3d at 712. The drawings had been copied by hand from photographs in a competitor's catalog. In denying copyright protection, the court emphasized that “[t]he illustrations were *intended* to be as accurate as possible in reproducing the parts shown in the photographs on which they were based, a form of slavish copying that is the antithesis of originality.” *Id.* (emphasis added). In *Bridgeman Art Library*, the court examined whether color transparencies of public domain works of art were sufficiently original for copyright protection, ultimately holding that, as “exact photographic copies of public domain works of art,” they were not. 36 F. Supp. 2d at 195. In support of its holding, the court looked to the plaintiff's intent in creating the transparencies: where “the *point of the*

exercise was to reproduce the underlying works with absolute fidelity," the "spark of originality" necessary for copyright protection was absent. *Id.* at 197 (emphasis added). Precisely the same holds true here, where, by design, all that was left in Meshwerks' digital wire-frame models were the designs of Toyota's vehicles.

C.

. . . Digital modeling can be, surely is being, and no doubt increasingly will be used to create copyrightable expressions. Yet, just as photographs *can be*, but are not *per se*, copyrightable, the same holds true for digital models. There's little question that digital models *can* be devised of Toyota cars with copyrightable features, whether by virtue of unique shading, lighting, angle, background scene, or other choices. The problem for Meshwerks in this particular case is simply that the uncontested facts reveal that it wasn't involved in any such process, and indeed contracted to provide completely unadorned digital replicas of Toyota vehicles in a two-dimensional space. For this reason, we do not envision any "chilling effect" on creative expression based on our holding today, and instead see it as applying to digital modeling the same legal principles that have come, in the fullness of time and with an enlightened eye, to apply to photographs and other media.

* * *

Originality is the *sine qua non* of copyright. If the basic design reflected in a work of art does not owe its origin to the putative copyright holder, then that person must add something original to that design, and then only the original addition may be copyrighted. In this case, Meshwerks copied Toyota's designs in creating digital, wire-frame models of Toyota's vehicles. But the models reflect, that is, "express," no more than the depiction of the vehicles *as* vehicles. The designs of the vehicles, however, owe their origins to Toyota, not to Meshwerks, and so we are unable to reward Meshwerks' digital wire-frame models, no doubt the product of significant labor, skill, and judgment, with copyright protection. The judgment of the district court is affirmed, and defendants' request for attorneys' fees is denied.

NOTES AND QUESTIONS

(1) The "digital models" in *Meshwerks* are collections of digital data that represent a three-dimensional object in a way that can be manipulated by computer programs. Such digital models are used to create two-dimensional depictions of the objects that resemble traditional photographs. Unlike a still photograph, however, a digital model can be used to create an infinite variety of depictions of the object from many possible viewpoints.

(2) We discussed the copyrightability of photographs in connection with *Burrow-Giles*. If a photograph of Oscar Wilde is sufficiently original, what about a photograph of a Toyota car? In *Skyy I*, discussed in *Meshwerks*, the court held that photos of a vodka bottle made for a magazine ad were sufficiently original. *See also Schrock v. Learning Curve Int'l, Inc.*, 586 F.3d 513 (7th Cir. 2009) (photos that were "accurate depictions of the three-dimensional 'Thomas and Friends' toys" were sufficiently original) (reprinted in Chapter 3). So, if an "accurate depiction" of a

Toyota car is sufficiently original, why isn't a digital model of a Toyota car original? Is it helpful to focus on the photographer's choices in rendition, timing, or creation of the subject as done in *Mannion v. Coors Brewing Co.*, discussed in the notes following *Burrow-Giles*? Did the digital models in *Meshwerks* possess any of these types of originality? Note also that the court in *Meshwerks* discusses *Skyy II*, in which the court held that another photographer's photo of the same vodka bottle did not infringe. But in *Meshwerks*, the defendants didn't make another digital model of the Toyota car; instead, they admittedly used the plaintiff's digital model. So for what purpose did the *Meshwerks* court discuss *Skyy II*?

(3) The *Meshwerks* court also relies on the plaintiff's intent, noting that the plaintiff "affirmatively set[] out . . . to make a copy of someone else's creation." But are deliberately imitative works always unoriginal? Compare *Meshwerks* with *Alfred Bell v. Catalda Fine Arts* (discussed earlier in connection with the originality/novelty distinction), involving the question of whether eight mezzotint engravings of old masters produced by Bell merited copyright protection. This is how the process of engraving was described by the trial court:

Concededly, the subjects of the eight engravings are paintings by other persons than the mezzotint engravers, all of them being well-known paintings executed in the late eighteenth or early nineteenth centuries and all now in the public domain. The mezzotint method lends itself to a fairly realistic reproduction of oil paintings. It is a tedious process requiring skill and patience . . .

. . . The work of the engraver upon the plate requires the individual conception, judgment and execution by the engraver on the depth and shape of the depressions in the plate to be made by the scraping process in order to produce in this other medium the engraver's concept of the effect of the oil painting. No two engravers can produce identical interpretations of the same oil painting. . . .

74 F. Supp. 973, 974-75 (S.D.N.Y. 1947). On appeal, the Second Circuit applied the constitutional originality standard as follows:

There is evidence that [the engravings] 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. A copyist's bad eyesight or defective musculature, or a shock caused by a clap of thunder, may yield sufficiently distinguishable variations. Having hit upon such a variation unintentionally, the "author" may adopt it as his and copyright it.

191 F.2d 99, 104-05 (2d Cir. 1951).

(4) Many museums charge licensing fees for publication of photographs or transparencies of public domain works of visual art in their collections. Are these photographs sufficiently original to merit copyright protection? This was the issue in *Bridgeman Art Library, Ltd. v. Corel Corp.*, 25 F. Supp. 2d 421 (S.D.N.Y. 1998), *on reconsideration*, 36 F. Supp. 2d 191 (S.D.N.Y. 1999), cited in *Meshwerks*. In its initial opinion, the court explained: "It is uncontested that Bridgeman's images are substantially exact reproductions of public domain works, albeit in a different

medium. The images were copied from the underlying works without any avoidable addition, alteration or transformation. Indeed, Bridgeman strives to reproduce precisely those works of art." 25 F. Supp. 2d at 426. Accordingly, it held that the photographs and digital images were not original under the law of the United Kingdom.

On reconsideration, the court reached the same conclusion under U.S. law:

There is little doubt that many photographs, probably the overwhelming majority, reflect at least the modest amount of originality required for copyright protection. "Elements of originality . . . may include posing the subjects, lighting, angle, selection of film and camera, evoking the desired expression, and almost any other variant involved." But "slavish copying," although doubtless requiring technical skill and effort, does not qualify. As the Supreme Court indicated in *Feist*, "sweat of the brow" alone is not the "creative spark" which is the *sine qua non* of originality. It therefore is not entirely surprising that an attorney for the Museum of Modern Art, an entity with interests comparable to plaintiff's and its clients, not long ago presented a paper acknowledging that a photograph of a two-dimensional public domain work of art "might not have enough originality to be eligible for its own copyright."

In this case, plaintiff by its own admission has labored to create "slavish copies" of public domain works of art. While it may be assumed that this required both skill and effort, there was no spark of originality — indeed, the point of the exercise was to reproduce the underlying works with absolute fidelity. Copyright is not available in these circumstances.

34 F. Supp. 2d at 196-97. Is this consistent with *Alfred Bell*? With *Meshwerks*?

(5) Conversely, does "originality" require an intent on the part of the author to create a work of authorship? In an extensive scholarly treatment of the issue, David Nimmer (son of Melville Nimmer and present author of *NIMMER ON COPYRIGHT*) concludes that the answer is "yes." See *Copyright in the Dead Sea Scrolls: Authorship and Originality*, 38 Hous. L. Rev. 1, 205-06 (2001). Consider the following hypothetical from the article:

After her careless brother breaks an old Barbie doll, Little Jane throws it into the garbage heap. There it sits, amidst bananas and other detritus of the household. By no stretch of the imagination has a copyrightable event occurred.

Christu, the magnificent performance artist, decides to go the field of "readymades" one better: he buys a Barbie doll, smashes it with a hammer, perches it amidst banana peels and other household garbage, and displays the product at the newly refurbished Tate Gallery. Has a derivative work been created? It would seem so. The differing intent underlying Little Jane's and Christu's conduct would seem to vouchsafe their completely different treatment.

For a response contending that in some circumstances randomly-generated expression may warrant copyright protection, see Durham, *The Random Muse: Author*

ship and Indeterminacy, 44 Wm. & Mary L. Rev. 569, 638 (2002): "Creativity can coexist with indeterminacy, and a mixture is probably the rule in authorship, rather than the exception."

(6) In *Kelley v Chicago Park District*, 635 F.3d 290 (7th Cir. 2011), the court held that Wildflower Works, an arrangement of living plants, was "original" because it was "not copied" from any other work and "it plainly possesses more than a little creative spark." Nonetheless, the court held that Wildflower Works "lacks the kind of authorship . . . required to support copyright" because "gardens are planted and cultivated, not authored. . . . 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." Do you agree? Didn't the Supreme Court in *Burrow-Giles* and *Feist* implicitly equate "originality" with "authorship"? Is it possible to have one without the other?

(7) Consider *Meshwerks* in terms of the rationales for copyright that we discussed in Chapter 1. A digital model takes a lot of time, effort, and money to create, and it can be copied easily. Did *Feist* dispose of the "sweat of the brow" doctrine too quickly? Is there an "author" of the digital models who can claim a natural right to profit from their use? What are the arguments against recognizing a copyright in the digital models?

(8) The plaintiff in *Meshwerks* also pleaded a state-law breach of contract claim, but the District Court declined to exercise supplemental jurisdiction over the claim. Can the creator of an unoriginal work successfully restrict copying by contract, or would enforcement of such a provision be preempted? For an analysis of preemption, see § 11.02 below.

[D] The Idea/Expression Dichotomy

BAKER v. SELDEN Supreme Court of the United States 101 U.S. 99 (1880)

MR. JUSTICE BRADLEY delivered the opinion of the court.

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

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

The book or series of books, of which the complainant claims the copyright, consists of an introductory essay explaining the system of book-keeping referred to, to which are annexed certain forms or blanks, consisting of ruled lines and headings, illustrating the system and showing how it is to be used and carried out in practice. This system effects the same results as book-keeping by double entry; but, by a peculiar arrangement of columns and headings, presents the entire operation, of a day, a week or a month, on a single page or on two pages facing each other, in an account-book. The defendant uses a similar plan so far as results are concerned; but makes a different arrangement of the columns, and uses different headings. If the complainant's testator had the exclusive right to the use of the system explained in his book, it would be difficult to contend that the defendant does not infringe it, notwithstanding the difference in his form of arrangement; but if it be assumed that the system is open to public use, it seems to be equally difficult to contend that the books made and sold by the defendant are a violation of the copyright of the complainant's book considered merely as a book explanatory of the system. Where the truths of a science or the methods of an art are the common property of the whole world, any author has the right to express the one, or explain and use the other, in his own way. As an author, Selden explained the system in a particular way. It may be conceded that Baker makes and uses account books arranged on substantially the same system; but the proof fails to show that he has violated the copyright of Selden's book, regarding the latter merely as an explanatory work; or that he has infringed Selden's right in any way, unless the latter became entitled to an exclusive right in the system.

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

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. . . . That is the province of letters patent, not of copyright. . . .

. . . 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. . . .

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 practice 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 account 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 designed 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.

NOTES AND QUESTIONS

(1) *The idea/expression dichotomy.* *Baker v. Selden* generally is celebrated as an early, if quaintly worded, statement of what has become known as the idea/expression dichotomy — although, as will appear below, the relationship between the case and the principle is more complex, and indeed more problematic, than many have realized.

The basic point of the idea/expression dichotomy (or perhaps, more accurately, “distinction”) is this: Copyright protects the expression of an idea, but not the idea itself. Once an author reveals his or her work to the public, any *ideas* contained in the work are released into the public domain, and the author must be content with protection for only the specific way in which he *expressed* those ideas. The protection provided by the copyright on the work as a whole extends only to the specific expressive form in which the author's ideas appear, leaving the substance of the ideas outside the scope of the copyright holder's monopoly. This is so even though the author may have spent vast amounts of time, energy and money developing his idea. There may be a possibility of protecting the *disclosure* of the idea to others under circumstances which suggest a confidential relationship or might imply a contract. But these are possibilities under state intellectual property protections (see Chapter 1), not federal copyright law (see Chapter 11 regarding preemption).

(2) The Supreme Court has identified the idea/expression distinction as one of two major copyright doctrines that protect the values of the First Amendment (the other being “fair use”). See *Eldred v. Ashcroft*, 537 U.S. 186, 219 (2003); *Golan v. Holder*, 132 S. Ct. 873, 890 (2012). Although it is sometimes viewed as a doctrine relating to the *scope* of copyright protection, the idea/expression dichotomy has significant implications for the analysis of *copyrightability* in general (and *originality* in particular). When looking at a work to see if the person claiming authorship contributed enough of, or the right kind of, value, one must concentrate not on ideas but on the way in which they are developed. Even coming up with a genuinely new and unusual idea — for example, by having been the first writer to imagine interplanetary space travel — doesn't count for copyright purposes.

(3) As we will see, Congress adopted and expanded the principle of the idea/expression (or fact/expression) dichotomy in § 102(b) of the 1976 Act. That

provision denies protection to any “procedure, process, system, method of operation, concept, principle or discovery” as well. *See, e.g., Brooks-Ngwenya v Indianapolis Public Schools*, 564 F.3d 804 (7th Cir. 2009) (ideas for better educating students are not protectible); *Hutchins v Zoll Medical Corp.*, 492 F.3d 1377 (Fed. Cir. 2007) (method of treating victims using CPR or instructing others how to use CPR was not protected). For the moment, however, we will concentrate on how the principle plays out in *Baker v Selden*.

(4) *Possible meanings of Baker v. Selden.* Along the way to exculpating *Baker*, the principal case offers us not one but several holdings. The most straightforward is its concluding statement that “blank account books are not the subject of copyright.” Most courts, as well as the U.S. Copyright Office in its Regulations, 37 C.F.R. § 202.1(c) (barring protection for “blank forms . . . which are designed for recording information and do not in themselves convey information”), appear to have accepted this proposition. There are, of course, problems in applying it. Compare *Utopia Provider Systems, Inc. v Pro-Med Clinical Systems, LLC*, 596 F.3d 1313 (11th Cir. 2010) (denying copyright in hospital emergency room charts) and *Bibbero Systems, Inc. v Colwell Systems, Inc.*, 893 F.2d 1104 (9th Cir. 1990) (denying copyright in medical claim forms) with *Kregos v Associated Press*, 937 F.2d 700 (2d Cir. 1991) (blank form for recording nine pitching statistics was subject to copyright). For a comprehensive overview of the blank forms doctrine, see *Advanz Behavioral Management Resources, Inc. v Miraflor*, 21 F. Supp. 2d 1179 (C.D. Cal. 1998).

Where it applies to bar protection, “[t]he Blank Form Doctrine is . . . simply an expression of the basic principle ‘that originality . . . is the touchstone of copyright protection . . . ’ . . . Like the telephone directory white pages at issue in *Feist*, blank forms cannot be copyrighted because they are ‘works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent. . . .’” *Hollister Inc. v Uarco Inc.*, 39 U.S.P.Q. 2d (BNA) 1542 (N.D. Ill. 1996) (quoting *Feist*). In other words, however new and useful *Selden*’s accounting system (the idea) may be, the forms (their expression) don’t measure up.

But does the Supreme Court’s opinion, read in its entirety, bear out the conclusion that this is the actual holding of *Baker*?

(5) Elsewhere in its opinion, the Court seems to assume that *Selden*’s book (consisting in substantial part of forms) was copyrightable. Nevertheless, it concludes that the copyright was not infringed. To explain the outcome, the opinion observes that where the useful information contained in a work is so intertwined with the particular way in which it is expressed that the information cannot be used without “employing the methods and diagrams used to illustrate [it], or such as are similar to them,” then those “methods and diagrams” are free to the public for purposes of “practical application” — but not for the purpose of “publication in other works explanatory of the art.”

This is the famous (or notorious) “use/explanation” distinction of *Baker v Selden*. This distinction has had important ramifications in recent copyright jurisprudence for decisions involving works of utility, particularly those involving computer programs, for reasons that we will see shortly.

(6) *Use/explanation and copyright/patent boundaries.* One possible understanding of the language quoted in the preceding note is that the Court meant to refer to the different rights protected under the patent and copyright laws. Unlike copyright, patent law incorporates no “idea/expression” dichotomy to limit the scope of available protection. Thus, a patent gives the holder a right “to exclude others from making, *using* or selling” a patented invention, *including* its underlying idea, during the 20 years of the patent’s existence. 35 U.S.C. § 154 (emphasis added). A copyright, on the other hand, confers upon its owner a handful of specifically enumerated rights, including the rights to “reproduce the work in copies” or “prepare derivative works,” *see* 17 U.S.C. § 106, none of which encompasses the right to “use” the copyrighted work. According to Pamela Samuelson, the records of the Supreme Court argument suggest that at least one Justice (perhaps Bradley, the opinion’s author) “perceived the case before the Court as an effort [by Selden’s heirs] to misuse the copyrights in his books to get patent-like protection for the bookkeeping system.” *See* Samuelson, *The Story of Baker v. Selden: Sharpening the Distinction Between Authorship and Invention*, in *INTELLECTUAL PROPERTY STORIES* 158, 175 (J. Ginsburg & R. Dreyfuss eds. 2005) (hereinafter “*Baker Story*”). But wasn’t Baker allegedly doing more than simply “using” the Selden system? Wasn’t his publication of a competing form book exactly the kind of activity for which copyright *can* potentially provide redress?

(7) *Use/explanation and works of utility.* A somewhat different understanding of Baker’s “use/explanation” distinction may be stated as follows: Certain kinds of works, intended for practical application, are characterized by a high degree of integration between their ideas and the mode of expression. As to these works, Baker creates an exception to the general scope of copyright protection covering so-called “takings for application or use.” In such instances, allowing the author’s otherwise protected expression to be taken will facilitate utilization of the underlying idea by others. Obviously, this reading of Baker does not apply to copyrighted works across the board, but only to those containing material that can be “practically applied” — two key examples being blank accounting forms and computer programs.

(8) The Nimmer treatise urges restricting Baker to takings for “practical application” in situations “where the use of the ‘art,’ i.e., the idea, which a copyrighted work explains (or embodies) *necessarily* requires a copying of the work itself . . . ” 1 *NIMMER ON COPYRIGHT* § 2.18[B] (2012) (emphasis added). Nimmer’s notion of “necessity” may be summarized as follows. When there is only one way to express a given idea, the plaintiff’s copyright in the work as a whole does not protect the idea against use by others. When, however, there is *more* than one way to express the idea, the author’s precise manner of stating it can be protected (apparently, even if alternative modes of expression are not as straightforward or efficient as the expression chosen by the author of the copyrighted work). Knowing what you know about the facts of Baker, how good a fit is this interpretation?

(9) *Baker's* backstory. In *Baker*, the Court notes that Baker had “use[d] a similar plan so far as results are concerned; but makes a different arrangement of the columns, and uses different headings.” In her recent investigation of *Baker's* “backstory,” Professor Samuelson notes:

The Baker forms were similar to Selden's in some respects, for example, in enabling journal and ledger entries to be made on one page, in having columns for entering the date of a disbursement, its number, the recipient, the disburser, and by whose authorization, and in having space for balances to be carried forward. The principal difference between the Baker and Selden forms was in how they treated accounts. Baker's form featured several blank columns so that bookkeepers could label and then keep track of receipts and disbursements for each type of account; it also had space at the foot of each account column so that bookkeepers could calculate a total period-to-date sum for each account at the foot of the form. With Baker's forms, [the trial record noted that] “you can enter your orders daily and tell just how your accounts stand.” With Selden's forms, there was no space for entering orders sequentially or for calculating interim totals. Selden's system contemplated entering totals for each account at the end of the relevant period, so it was “hard to tell how your accounts [stood] during the month.”

Baker Story at 161. In other words, Baker's system and forms may well have been independent creations rather than slavish copies — borrowing, at most, Selden's general principle of “condensing journal and ledger entries into one form” but displaying no other meaningful similarities. *Id.* at 169. So why wasn't the case dismissed on this ground alone, long before reaching the Supreme Court? (Samuelson's article sheds new light on the answer.)

(10) *Moving on: Baker and the merger doctrine.* One possible understanding of *Baker* remains to be considered. Might the *Baker* Court have decided the case as it did because it recognized intuitively, without saying so expressly, that there are a limited number of configurations of columns, rows and headings by means of which the idea of a week-, month- or year-at-a-glance ledger can be configured? More broadly, if an idea is capable of being expressed in only a few ways, should all such expressions be made nonprotectible on prudential grounds, lest, by copyrighting all usable expressions, an author might effectively copyright the idea itself? Keep reading!