C. At the boundary between covered and uncovered

MATTHEW BENDER & CO. v. WEST PUBLISHING CO., 158 F.3d 674 (2nd Cir. 1998)

Before: CARDAMONE and JACOBS, Circuit Judges, and SWEET, District Judge.

JACOBS, Circuit Judge.

[1] West Publishing Co. and West Publishing Corp. (collectively "West") publish compilations of reports of judicial opinions ("case reports"). Each case report consists of the text of the judicial opinion with enhancements that for the purposes of this case can be put in two categories: (i) independently composed features, such as a syllabus (which digests and heralds the opinion's general holdings), headnotes (which summarize the specific points of law recited in each opinion), and key numbers (which categorize points of law into different legal topics and subtopics), and (ii) additions of certain factual information to the text of the opinions, including parallel or alternative citations to cases, attorney information, and data on subsequent procedural history. HyperLaw, Inc. publishes compact disc-read only memory ("CD-ROM") compilations of Supreme Court and United States Court of Appeals decisions, and intervened as a plaintiff to seek a judgment declaring that the individual West case reports that are left after redaction of the first category of alterations (i.e., the independently composed features), do not contain copyrightable material. West now appeals from a judgment of the United States District Court for the Southern District of New York (Martin, J.), following a bench trial, granting declaratory judgment in favor of HyperLaw.

Matthew Bender & Co. v. West Publ'g Co., No. 94 Civ. 0589, 1997 WL 266972 (S.D.N Y May 19, 1997).

[2] It is true that neither novelty nor invention is a requisite for copyright protection, but minimal creativity is required. Aside from its syllabi, headnotes and key numbers - none of which HyperLaw proposes to copy - West makes four different types of changes to judicial opinions that it claimed at trial are copyrightable: (i) rearrangement of information specifying the parties, court, and date of decision; (ii) addition of certain information concerning counsel; (iii) annotation to reflect subsequent procedural developments such as amendments and denials of rehearing; and (iv) editing of parallel and alternate citations to cases cited in the opinions in order to redact ephemeral and obscure citations and to add standard permanent citations (including West reporters). All of West's alterations to judicial opinions involve the addition and arrangement of facts, or the rearrangement of data already included in the opinions, and therefore any creativity in these elements of West's case reports lies in West's selection and arrangement of this information. In light of accepted legal conventions and other external constraining factors, West's choices on selection and arrangement can reasonably be viewed as obvious, typical, and lacking even minimal creativity. Therefore, we cannot conclude that the district court clearly erred in finding that those elements that HyperLaw seeks to copy from West's case reports are not copyrightable, and affirm.
[3] West obtains the text of judicial opinions directly from courts. It alters these texts as described above to create a case report, and then publishes these case reports (first in advance sheets, then in bound volumes) in different series of "case reporters." These case reporter series cover all state and federal courts and are collectively known as West's "National Reporter System." Two series of case reporters are at issue in this case: the Supreme Court Reporter, which contains, inter alia, all Supreme Court opinions and memorandum decisions; and the Federal Reporter, which contains, inter alia, all United States Court of Appeals opinions designated for publication, as well as tables showing the disposition of unpublished cases.

[4] HyperLaw markets two compilations that cover approximately the same ground: Supreme Court on Disc, an annual CD-ROM disc containing opinions of the United States Supreme Court starting from 1990; and Federal Appeals on Disc, a quarterly CD-ROM disc containing nearly all opinions (published and unpublished) of the United States Courts of Appeals from January 1993 on. Currently, HyperLaw obtains the text of the opinions directly from the courts. However, HyperLaw intends to expand its CD-ROM product to include any recent cases it could not obtain directly from the courts (and attorney information that is omitted from slip opinions by certain circuits), as well as pre-1990 Supreme Court cases and pre-1993 court of appeals cases that are cited in recent Supreme Court and court of appeals cases (so that users can jump to those cases). HyperLaw intends to achieve this expansion by copying West's case reports (after redacting the syllabi, headnotes and key numbers) from the Supreme Court Reporter and the Federal Reporter. The total number of opinions HyperLaw intends to copy is unclear; but HyperLaw's President Alan Sugarman testified that in time it could reach 50 percent of Supreme Court and court of appeals decisions published by West.

[5] Following the commencement of suit by Matthew Bender & Co. in the United States District Court for the Southern District of New York seeking a judgment declaring that Bender's insertion of star pagination to West's case reporters in its CD-ROM version of judicial opinions did not infringe West's copyright, HyperLaw intervened and requested the same relief. In addition, HyperLaw sought a declaration that HyperLaw's redacted versions of West's case reports contain no copyrightable material and thus may be copied without infringement. On the star pagination issue, the district court granted summary judgment to Bender and HyperLaw, and final judgment was entered pursuant to Fed. R. Civ. P. 54(b). (We affirm that ruling in a separate opinion issued today. See Matthew Bender & Co. v. West Pub'g Co., No. 97-7430.) But the district court denied summary judgment allowing HyperLaw to copy redacted versions of West's case reports, and conducted a bench trial on this issue.

[6] The principal trial witness was Donna Bergsgaard, the manager of West's manuscript department. She specified four kinds of alterations made by West to the opinions that it publishes in the Supreme Court Reporter and Federal Reporter and that HyperLaw intends to copy: (i) the arrangement of prefatory information, such as parties, court, and date of decision; (ii) the selection and arrangement of the attorney information; (iii) the arrangement of information relating to subsequent procedural developments; and (iv) the selection of parallel and alternative citations.

[7] Following the bench trial, the district court ruled that West's revisions to judicial opinions were merely trivial variations from the public domain works, and that West's case reports were therefore not copyrightable as derivative works. Matthew Bender & Co., 1997 WL 266972, at *4. In reaching this conclusion, the district court reviewed each type of alteration and found that "West does not have a protectible interest in any of the portions of the opinions that HyperLaw copies or intends to copy" because West's alterations lack even minimal creativity. Id.

DISCUSSION

Copyright 2003: Topic 2-60
I.

* * * 

II.

[13] Works of the federal government are not subject to copyright protection; the text of judicial decisions may therefore be copied at will. 17 U.S.C. § 105. Federal judicial opinions may, however, form part of a compilation. The Copyright Act defines "compilation" as "a work formed by the collection and assembling of pre-existing materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship." 17 U.S.C. § 101. West has filed a certificate of copyright registration for every paper-backed advance sheet and bound permanent volume of the Supreme Court Reporter and Federal Reporter, and each certificate characterizes the copyrighted work as a "compilation." Under Feist Publications, Inc. v. Rural Telephone Serv. Co., 499 U.S. 340, 111 S.Ct. 1282 (1991), an infringement claim for a compilation has two elements: "(1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original." Id. at 361; 111 S.Ct. at 1296.

[14] But HyperLaw has not signaled its intent to copy the text of every case included in particular volumes of West case reporters or the case reporters' selection and arrangement of cases.[n3] HyperLaw's intent is to copy particular, though numerous, individual [p*680] case reports. HyperLaw seeks a declaratory judgment that these case reports - after removal of the syllabus, headnotes, and key numbers - contain no copyrightable material.

A.

[15] HyperLaw contends that each case report should be analyzed as a derivative work, which is defined under the Copyright Act as, inter alia, "[a] work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship." 17 U.S.C. § 101. The district court adopted this view and analyzed the individual case report as a derivative work, but found it wanting in the requisite originality. West contends that each case report is a compilation, i.e., a collection of facts that have been distinctively selected and arranged. No one claims that a case report is anything other than a derivative work or a compilation.

[16] The House Report on the 1976 Copyright Act distinguishes between a derivative work and a compilation:

"Between them the terms . . . comprehend every copyrightable work that employs pre-existing material or data of any kind. There is necessarily some overlapping between the two, but they basically represent different concepts. A "compilation" results from a process of selecting, bringing together, organizing, and arranging previously existing material of all kinds, regardless of whether the individual items in the material have been or ever could have been subject to copyright. A "derivative work," on the other hand, requires a process of recasting, transforming, or adapting "one or more pre-existing works"; the "pre-existing work" must come within the general subject matter of copyright set forth in section 102, regardless of whether it is or was ever copyrighted." H.R. Rep. No. 94-1476, at 57 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5670; see also 1 Melville B. Nimmer & David Nimmer, Nimmer on Copyright § 3.02, at 3-5 (1998) ("[W]hile a compilation consists merely of the selection and arrangement of pre-existing material without any internal changes in such material, a derivative work involves recasting or transformation, i.e., changes in the pre-existing material, whether or not it is juxtaposed in an arrangement with other pre-existing materials.").

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[17] We think that West's case reports have elements of both types of works. West compiles (and selects) the factual information it includes in each case report - the type of task usually involved in creating a compilation. On the other hand, West rearranges prefatory and citation information included in judicial opinions, steps that tend toward the making of a derivative work rather than a compilation. In addition, all of West's decisions are constrained by West's main project, which is to enhance the judicial opinions without altering their texts in any substantive or appreciable way.

[18] We need not categorize West's case reports as either derivative works or compilations in order to decide this case. Copyright protection is unavailable for both derivative works and compilations alike unless, when analyzed as a whole, they display sufficient originality so as to amount to an "original work of authorship." See 17 U.S.C. § 101 (defining a "derivative work", inter alia, as a work containing alterations "which, as a whole, represent an original work of authorship"); id. (defining a compilation as requiring that "the resulting work as a whole constitutes an original work of authorship"). The originality required for copyright protection is essentially the same. See Feist, 499 U.S. at 358, 111 S.Ct. at 1294 ("Originality requires only that the author make the selection or arrangement independently . . . and that it display some minimal level of creativity."); L. Batlin & Son, Inc. v. Snyder, 536 F.2d 486, 490-91 (2d Cir. 1976) (in banc) ("[W]hile a copy of something in the public domain will not, if it be merely a copy, support a copyright, a distinguishable variation will. * * * [T]o support a copyright there must be at least some substantial variation, not merely a trivial variation such as might occur in the translation to a different medium."). As West and HyperLaw seemingly agree, the question presented is whether West's alterations to the case reports, when considered collectively, demonstrate sufficient originality and creativity to be copyrightable. [p*681]

B.

[19] The district court found that the elements of the West case reports for which West seeks copyright protection lack sufficient originality or creativity to be protectable - whether considered separately or together. Because we treat the question of whether particular elements of a work demonstrate sufficient originality and creativity to warrant copyright protection as a question for the factfinder - here the judge - we will not reverse the district court's findings unless clearly erroneous. See, e.g., Victor Lalli Enters., Inc. v. Big Red Apple, Inc., 336 F.2d 671, 673 (2d Cir. 1991) (per curiam) ("Generally, we review a district court's determination of whether a work is sufficiently original to merit copyright protection under the clearly erroneous standard."); Financial Info., Inc. v. Moody's Investors Serv., Inc., 808 F.2d 204, 207-08 (2d Cir. 1986) (same); see also Woods v. Bourne Co., 60 F.3d 978, 991 (2d Cir. 1995) (noting that our review of originality determination is for clear error); Weissmann v. Freeman, 868 F.2d 1313, 1322 (2d Cir. 1989) (holding that the district court's finding of lack of originality or variation in derivative work was reviewable for clear error). The dissent (at [page 1], footnote 1) argues that de novo review would be more appropriate, and that our precedents to the contrary are doubtful in light of Feist. Feist, however, did not address standard of review, and the clear error standard retains vitality in our precedents, both before and after Feist. In 1995, we acknowledged that the question of copyrightability entails the kind of conclusion that would often justify de novo review, but that most courts, including this Court, review for clear error. See Woods, 60 F.3d at 991 (Feinberg, J.) (citing 1 William F. Patry, Copyright Law and Practice 145 n. 106 (1994) (cataloguing cases)).
According to West, the required originality and creativity inhere in four elements of the case reports that HyperLaw intends to copy:

"(i) the arrangement of information specifying the parties, court, and date of decision;"

"(ii) the selection and arrangement of the attorney information;"

"(iii) the arrangement of information relating to subsequent procedural developments such as amendments and denials of rehearing; and"

"(iv) the selection of parallel and alternative citations."[n4]

Each element either adds or rearranges pre-existing facts, in themselves unprotectable, and so West is not entitled to protection for these elements of its case reports unless it demonstrates creativity in the selection or arrangement of those facts. See Feist, 499 U.S. at 348, 111 S.Ct. at 1289. Because many of the cases relating to compilations assess the creativity involved in selecting and arranging information, we look to those cases for guidance.

The Copyright Act protects original and minimally creative selection of pre-existing, unprotected materials (such as facts) for inclusion in a work, as well as original and creative arrangement of those materials. See Eckes v. Card Prices Update, 736 F.2d 859, 863 (2d Cir. 1984) ("[S]electivity in including otherwise non-protected information can be protected expression."); 1 Nimmer, supra, § 3.04[B][2], at 3-31 ("If originally combined, a selection or arrangement of underlying materials that are themselves unoriginal may support copyright protection."). Feist tells us:

"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." Feist, 499 U.S. at 348, 111 S.Ct. at 1289 (citations omitted).[n5] However, not every such compilation or decision on selection or arrangement is sufficiently creative to be protected.

The creative spark is missing where: (i) industry conventions or other external factors so dictate selection that any person composing a compilation of the type at issue would necessarily select the same categories of information, see, e.g., Victor Lalli Enters., 936 F.2d at 672 (charts of winning numbers in illegal gambling operations); see also Mid America Title Co., 59 F.3d at 722 (title examiner's report; selecting which facts to include in this compilation of data was not a matter of discretion based on Mid America's personal judgment or taste, but instead it was a matter of convention and strict industry standards"), or (ii) the author made obvious, garden-variety, or routine selections, see Feist, 499 U.S. at 362, 111 S.Ct. at 1296 (concluding that the selection and arrangement of a white pages in which the publisher had chosen to include name, town and telephone number, and to arrange these listings in alphabetical order were entirely "typical" and "garden-variety"); BellSouth Adver. & Publ'g Corp. v. Donnelley Info. Publ'g, Inc., 999 F.2d 1436, 1444 (11th Cir. 1993) (in banc) (holding that the categories for the organization of material in a yellow pages directory lacked creativity where many of the selected headings, such as "Attorneys" or "Banks" are so obvious and many others "result from certain standard industry practices").

Thus, when it comes to the selection or arrangement of information, creativity inheres in making non-obvious choices from among more than a few options. See, e.g., Hearn v. Meyer, 664 F. Supp. 832, 847 (S.D.N.Y. 1987) ("Copyright protection is afforded rarely where a fact permits only a narrow
continuum or spectrum of expression."). For example, in Kregos v. Associated Press, 937 F.2d 700, 704 (2d Cir. 1991), the decision to express a pitcher's performance in terms of nine statistics from "at least scores of available statistics about pitching performance available to be calculated from the underlying data and therefore thousands of combinations of data that a selector can choose to include in a pitching form" was not necessarily obvious or self-evident. We therefore concluded that the district court erred in granting summary judgment on the uncopyrightability of the pitching forms. Id. at 704-05, 711; see also American Dental Ass'n v. Delta Dental Plans Ass'n, 126 F.3d 977, 979 (7th Cir. 1997) (holding taxonomy of dental procedures creative after noting that they "could be classified . . . in any of a dozen different ways"). However, selection from among two or three options, or of options that have been selected countless times before and have become typical, is insufficient. Protection of such choices would enable a copyright holder to monopolize widely-used expression and upset the balance of copyright law.

[26] In sum, creativity in selection and arrangement therefore is a function of (i) the total number of options available, (ii) external factors that limit the viability of certain options and render others non-creative, and (iii) [p*683] prior uses that render certain selections "garden variety." See, e.g., 1 Patry, supra, at 196 ("As a general principle, the greater the amount of material from which to select, coordinate, or arrange, the more likely it is that a compilation will be protectible. On the other hand, where less material is available, it is less likely that a compilation, even if original, will be protectible, since de minimis efforts, including selections, are not subject to copyright.").

C.

[27] We proceed to assess the originality and creativity underlying the elements of West's case reports that HyperLaw seeks to copy.

1. Captions, Courts, and Date Information

[28] West claims that originality inheres in the following enhancements:

"* The format of the party names - the "caption" - is standardized by capitalizing the first named plaintiff and defendant to derive a "West digest title," and sometimes the party names are shortened (e.g., when one of the parties is a union, with its local and national affiliations, West might give only the local chapter number, and then insert etc.)."

"* The name of the deciding court is restyled. E.g., West changes the slip opinion title of "United States Court of Appeals for the Second Circuit" to "United States Court of Appeals, Second Circuit." "

"* The dates the case was argued and decided are restyled. E.g., when the slip opinion gives the date on which the opinion was "filed," West changes the word "filed" to "decided." "

"* The caption, court, docket number, and date are presented in a particular order, and other information provided at the beginning of some slip opinions is deleted (such as the lower court information, which appears in the West case syllabus)."

[29] We do not think that the district court committed clear error in finding that these changes are insubstantial, unoriginal, and uncreative. Reference to a case by the names of the first plaintiff and first defendant is a garden variety decision. See, e.g., The Bluebook: A Uniform System of Citation rule 10.2.1(a) (16th ed. 1996) (hereinafter "The Bluebook"). The same is true of West's manner of shortening long case names. See, e.g., id. rule 10.2.1(i) ("Cite a union name exactly as given in the official reporter, except that: (i) only the smallest unit should be cited . . . (ii) all craft or industry designations . . . should
be omitted. . ."). Even if these choices regarding which words to capitalize and shorten to form the West digest title were an original inspiration, we doubt the decisions to shorten the titles or capitalize certain letters would be copyrightable. See Secure Servs. Tech., Inc. v. Time & Space Processing, Inc., 722 F. Supp. 1354, 1363 n. 25 (E.D. Va. 1989) ("Size of print . . . is not copyrightable."); 37 CFR § 202.1(a) (1998) ("Words and short phrases such as names [and] titles . . . mere variations of typographic ornamentation [or] lettering" are not copyrightable.). Nor does West's overall choice concerning which procedural facts to include at the start of the case report demonstrate the requisite originality or creativity: The names of the parties, the deciding court, and the dates of argument and decision are elementary items, and their inclusion is a function of their importance, not West's judgment. Cf. Kregos, 937 F.2d at 702 (noting that "there can be no claim of a protectable interest in the categories of information concerning each day's [baseball] game," including the teams, starting pitchers, the game time, and the betting odds).

2. Attorney Information

[30] The second claimed creative element is West's selection and arrangement of attorney information. The Supreme Court slip opinions and some slip opinions of the courts of appeals omit some or all of the information about counsel that West compiles from the docket sheets and from other sources. For Supreme Court opinions, West lists the arguing counsel and the lawyer's city and state of practice; for court of appeals decisions, West lists the names of briefing attorneys as well as arguing attorneys, and specifies each lawyer's city and state of practice and law-firm or agency affiliation.

[31] Here again we agree with the district court that West's decisions lack a modicum of creativity. Like the name, town and telephone number included in *Feist*'s telephone directory, the information West includes - attorney names, firms and cities of practice - is entirely "typical" and "garden-variety." See, e.g., *Skinder-Strauss Assoc's. v. Massachusetts Continuing Legal Educ., Inc.*, 914 F. Supp. 665, 676 (D. Mass. 1995) (noting that "[i]n compiling a Massachusetts directory of lawyers and judges, . . . [t]he 'selection' of other directory data, including the attorney name, address, telephone and fax numbers, year of bar admission, and so forth are . . . unoriginal and determined by forces external to the compiler"); cf. *Key Publications, Inc. v. Chinatown Today Publ'g Enters., Inc.*, 945 F.2d 509, 514 (2d Cir. 1991) (emphasizing the creativity inherent in designating phone-book classifications of particular interest to Chinese-Americans). In fact, most courts (this one included) provide the very same information in their slip opinions.

[32] West's decision to provide more information about counsel in the court of appeals case reports, and less in the Supreme Court case reports does not strike a creative spark because the options available to a publisher are simply too limited. West's claim illustrates the danger of setting too low a threshold for creativity or protecting selection when there are two or three realistic options: West lists only the arguing attorneys and city of practice, while United States Law Week lists the arguing and briefing attorneys, their firm affiliations and city and state of practice. If both of these arrangements were protected, publishers of judicial opinions would effectively be prevented from providing any useful arrangement of attorney information for Supreme Court decisions that is not substantially similar to a copyrighted arrangement.

3. Subsequent History

[33] West's case reports reflect certain subsequent procedural developments, such as orders amending an opinion or denying rehearing. The district court found that West's alteration of opinions to reflect these subsequent case developments does not reflect an exercise of originality or creativity, in part because West's realistic options are limited. We cannot say that this was clear error.

[34] In most appeals, the only subsequent development is a denial of rehearing. West's manuscript manager Bergsgaard described two possible ways to reflect this action: (i) a file line, inserted at the Copyright 2003: Topic 2-65
beginning of the case just after the date of the original decision, which simply states "rehearing denied" and the date of the denial, or (ii) a table containing the same information. West has chosen to reflect denial of rehearing via a file line. Neither this choice, nor the actual language used to reflect the denials ("rehearing denied" followed by the date), is creative or requires judgment.

[35] As the trial testimony reflects, subsequent orders sometimes reflect more extensive changes or additions to opinions, such as amendments to the original opinion (ranging from minimal to extensive), or subsequent opinions upon denial of rehearing or in dissent from denial of rehearing or rehearing in banc. The actual text of any amendments to opinions or new opinions issued with the denial of rehearing will always be the court's. But West points to the following available options for reflecting these changes, and claims that its choice from among these options is creative: (i) printing the order in full at the end of the opinion; (ii) altering the text of the opinion to reflect the amendments; (iii) publishing the order separately from the original opinion in a different volume and cross-referencing to the original opinion; or (iv) reprinting the original opinion in full with the changes reflected in the text. [p*685]

[36] Almost never will these decisions present more than one or two realistic or useful options, and almost always the choice among them will be dictated by the timing of the court action. For example, an order amending an opinion will either (i) reflect the exact locations in the opinion where changes are to be made, in which case the obvious preference is to alter the text of the opinion, or (ii) include some general language modifying the opinion, in which case the obvious preference is to print the order at the end of the text of the opinion. If the opinion has not yet gone to print in an advance sheet or a bound volume, West will actually make these changes in the original opinion. If the opinion has already been printed in the bound volume, then West (once again) has only binary options: (i) print only the order and cross-reference to the original opinion, or (ii) reprint the opinion in full, incorporating the changes and/or publishing the order at the end of the opinion. As set forth in the margin, West's exemplar confirms how little judgment is exercised even in a case with a complicated subsequent procedural history. West also adds a file line explaining the action, but the line merely sets forth the court's action. Given the few practical options available to West, and the fact that the choice among these narrow options will be dictated by the timing and nature of the court's action, we do not think the district court clearly erred in determining that this element of West's case reports does not demonstrate sufficient creativity to be protectable.

4. Parallel or Alternate Citations

[37] As the district court recognized, the element of West's case reports that raises the closest question as to creativity is West's emending of the citations, as follows:

"(a) West inserts parallel citations when the judicial opinion does not, e.g., (i) for citations to Supreme Court opinions, it inserts parallel citations to United States Reports, Supreme Court Reporter, and Lawyer's Edition, (ii) for citations to a state court, West inserts parallel citations to the official reporter and West's regional reporter, and (iii) for citations to looseleaf, specialized, or electronic reporters, West inserts parallel citations to a West National Reporter System ("NRS") reporter or Westlaw (West's on-line database);

"(b) West substitutes some court citations, e.g., if the court cites to a slip opinion that has been published in an NRS reporter, West will substitute a citation to the NRS reporter; and"

"(c) West adds citations when the opinion refers to a case by name but does not insert a citation."

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[38] The district court concluded that "[i]n most instances the determination of which parallel citations to include . . . reflect[s] no level of originality," and that the "selections made tend to conform to the standard of the legal profession and appear consistent with those recommended in A Uniform System of Citation." Matthew Bender & Co., 1997 WL 266972, at *4.

[39] We cannot find that the district court's conclusion was unreasonable. West claims that it exercises careful judgment as to which sources are most useful to legal practitioners. However, almost every one of West's decisions relating to citation alterations is inevitable, typical, dictated by legal convention, or at best binary. See 1 Patry, supra, at 196-97 ("Even where theoretically there is a large number of items to choose from, functional, commercial, or legal constraints may limit, or [p*686] even bar, protectibility."). And each case report exhibits only one or two decisions on how to alter citations.

[40] West has issued a series of memoranda to its editors that contain guidelines for citation alterations (a complete list of the citational instructions is set out in the margin[n8]). Most of West's citation guidelines need no discussion because they involve obvious, garden-variety decisions to cite to West NRS case reporters and to Westlaw whenever the court has cited to sources that are not easily accessible, such as looseleaf or daily or weekly reporter services or slip opinions; there are few options to begin with, and West's case reporters and Westlaw have the widest availability and have essentially become the standard citation to case law. See, e.g., The Bluebook, supra, at 165-225 (recommending citation to West federal and regional reporters for all federal and state courts, with the exception of the Supreme Court, for which Supreme Court Reporter is listed as a secondary cite); id. rule 10.3.1 (recommending citation to West regional reporters, and if not published therein, to a "widely used computer database" or to a "service," in that order of preference). No evaluative judgment is involved in a decision to cite to those two sources (especially given West's self-interest in including citations to its own products).

[41] As for the other guidelines, the following represent the citation decisions that receive the most emphasis by West, and that represent most, if not all, of the examples of citation alterations included in cases that West offered into evidence at trial:

** West's decision to insert a citation to the denial of certiorari only when the denial pre-dated the opinion is necessary to avoid anachronism, and is in any event a choice [p*687] among two or three options at most. See, e.g., BellSouth Adver. & Pub'l'g Corp. v. Donnelley Info. Pub'l'g, Inc., 999 F.2d 1436, 1441 (11th Cir. 1993) (in banc) (holding that determination of closing date after which no changes were included in the yellow pages at issue did not demonstrate creativity in selection because "any collection of facts 'fixed in any tangible medium of expression' will by necessity have a closing date" (footnote omitted)).

** As proof of its creativity in electing to parallel-cite to United States Reports, Supreme Court Reporter, and Lawyer's Edition, West lists eight other reporters of Supreme Court opinions that do not parallel-cite to these sources, and to which West does not parallel-cite. But all of these reporters are daily or weekly updates intended to provide quick copies of the slip opinions, not to serve as research tools or permanent records, and they are not recognized as standard sources for citation in the legal profession. West's decision to omit parallel citation to those reporters requires no evaluative judgment, and the decision by the publishers of those reporters and services to omit parallel citation to the same reporters cited by West reflects the more limited purpose of those reporters rather than the creativity of West's own choice. In the end, West decided to include every permanent record of Supreme Court opinions - i.e., it makes no "selection" at all.

** Nor do we see any creativity in West's decision to cite to official state reporters as well as regional NRS reporters for state court decisions. These are almost always the only two
realistic choices (again, this hardly amounts to "selection"), and a decision to cite to an
official reporter can hardly be said to be anything other than typical. [n11]

[42] One useful way to appreciate how little creativity inheres in West's citation decisions is to consider what West's competitors would have to do to avoid an infringement claim were we to find West's citation decisions copyrightable. Competitors such as HyperLaw seeking to create a useful case report would need to engage in their own original selection of parallel and alternate citations. But while some generally useful information which does not appear in West's case reports could be included (such as citations to LEXIS instead of Westlaw), most of the information a researcher would find useful (such as citations to West NRS reporters) already have been added to West's case reports; West gives few examples of other useful supplementary information. A competitor that included these alterations, notwithstanding their inclusion in West's case reports, could have no confidence that an infringement claim could be avoided, especially given our warning in Key Publications that infringement cannot be avoided by pointing to isolated differences from a copyrighted work. See Key Publications, Inc. v. Chinatown Today Publ'g Enters., Inc., 945 F.2d 509, 514 (2d [p*688] Cir. 1991) (holding that a compilation copyright is not so "thin" as to be "anorexic," and does not allow "subsequent compilers to avoid infringement suits simply by adding a single fact to a verbatim copy of the copyrighted compilation, or omitting in the copy a single fact contained in the copyrighted compilation"). One way of saying that West's "choices" are obvious and typical is that a competitor would have difficulty creating a useful case report without using many of the same citations. Affording these decisions copyright protection could give West an effective monopoly over the commercial publication of case reports (at least those containing supplemental citations).

[43] Nor do we think the district court erred in concluding that the combination of these citation decisions is unprotectable. West's particular decisions about which parallel citations to insert are driven in each instance by the court's decision to cite to a certain case, and thus each editorial choice is independent of the others. The cumulative effect of these citation decisions is a piling up of things that are essentially obvious or trivial (albeit helpful), each in its discrete way in its discrete spot. The whole does not disclose or express an overall creative insight or purpose, such as a set of statistics that together allow the ranking of a group of ball players, or a designation or highlighting of phone numbers that together allow the user of a phone book to enjoy an unusual or particular convenience. The combined effect of West's non-creative citation decisions cannot be said to be creative, on such a theory or any other theory that West advances. We conclude that the district court did not clearly err in deciding that West's citation alterations display insufficient creativity to be protectable.

[44] * * *

[45] Finally, West's overall decision to add attorney information, subsequent history, and additional citation information exhibits little, if any, creative insight; most courts already provide attorney information, and opinion accuracy mandates inclusion of subsequent history.

[46] West's editorial work entails considerable scholarly labor and care, and is of distinct usefulness to legal practitioners. Unfortunately for West, however, creativity in the task of creating a useful case report can only proceed in a narrow groove. Doubtless, that is because for West or any other editor of judicial opinions for legal research, faithfulness to the public-domain original is the dominant editorial value, so that the creative is the enemy of the true. [n12]

[47] Our decision in this case does not mean that an editor seeking to create the most accurate edition of another work never exercises creativity. [n13] As West argues, our decisions [p*689] establish a low threshold of creativity, even in works involving selection from among facts. But those cases involved the exercise of judgments more evaluative and creative than West exercises in the four elements of the case reports that HyperLaw intends to copy. For instance, in Kregos thousands of different permutations of pitching statistics were available for inclusion in the publisher's pitching chart. See Kregos, 937 F.2d at
In *Key Publications*, we found sufficient creativity because the author of the yellow pages "excluded from the directory those businesses she did not think would remain open for very long." 945 F.2d at 67. And in *Lipton v. Nature Co.*, 71 F.3d 464 (2d Cir. 1995), the author "selected [the terms included in the work] from numerous variations of hundreds of available terms." *Id.* at 470. In each of these cases, the compiler selected from among numerous choices, exercising subjective judgments relating to taste and value that were not obvious and that were not dictated by industry convention. *See Mid America Title Co. v. Kirk*, 59 F.3d 719, 723 (7th Cir. 1995) (distinguishing cases involving exercise of subjective judgment).[14]

[48] Similarly, in *Weissmann v. Freeman*, 868 F.2d 1313 (2d Cir. 1989), a textual derivative-work case, we found sufficient creativity where the author of the derivative work had drawn on earlier joint works with another professor to create a document that contained the following new elements from the previous version of the document:

"(1) a selection and arrangement of photo illustrations and associated captions; (2) references to recent reports in the pertinent literature; (3) selection, condensation, and description of additional source material; (4) several new textual additions; (5) substantial rearrangement of the manner and order of presentation of material contained in the parties' prior joint works; and (6) the addition of a section on "congenital disorders," a revised treatment of "chronic cholecystitis," and the incorporation of Dr. Freeman's "false positive" studies." *Id.* at 1322.

[49] As this passage demonstrates, the alterations inserted in the derivative work were by no means obvious or driven by professional convention, and resulted in substantial changes to the substance and flow of the piece. No such substantial variations characterize West's case reports.

**CONCLUSION**

[50] The district court did not clearly err in concluding that the elements of West's case reports that HyperLaw seeks to copy are not copyrightable. The judgment of the district court is affirmed.

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

[For footnotes see on-line version of the case]

[51] Sweet, D.J.

[52] The key issue in this appeal is whether West's Supreme Court Reporter and Federal Reporter case reports in the context of its overall reporter citation system meet the constitutional and statutory requirement of creative originality. Because the majority imposes a standard that demands significantly more than the "modicum" of originality required by *Feist Publications, Inc., v. Rural Telephone Service Company, Inc.*, 499 U.S. 340 (1991), and far more than the "non-trivial" variation required by this Court for derivative-work and compilation copyright protection, I respectfully dissent.[n1]
[53] I find that West's selection and arrangement of factual annotations to public domain judicial opinions, considered as a whole, is copyrightable.

[54] Originality alone - whether the "author make[s] the selection or arrangement independently (i.e. without copying that selection or arrangement from another work)" - is not sufficient. Feist, 499 U.S. at 358. The work must also "display some minimal level of creativity." Id. Creativity for copyright purposes is not a philosophical question: the "creative spark" need only pass "the narrowest and most obvious limits." See Bleistein v. Donaldson Lithographing Company, 188 U.S. 239, 260. The "modicum of creativity" requires simply that the author prove "the existence of . . . intellectual production, of thought, and conception." Feist, 499 U.S. at 362 . . .

[55] Thus, while the majority is correct that it is "not a goal of copyright law" to encourage the creation of compilations which lack "sufficient creativity," it is well-established that the required level of creativity is "extremely low." Feist, 499 U.S. at 345. 

* * *

[57] Here, West has made choices to make its reporters and its citation system valuable. West makes dozens of multi-part, variable judgments, and there is no evidence that any of West's choices are commonplace, "practically inevitable," dictated by law, or that they follow any external guidelines. . . .

* * *

[59] The fact that federal judges publish written opinions differently than West is sufficient reason to conclude that West's version requires some "thought" and is sufficiently "creative" to satisfy the modicum necessary for copyrightability. If a federal judge chooses to cite only to the United States Reporter, include minimal attorney information in his or her written opinion, or not provide a cite for a referenced case, then an alternative choice to provide parallel citations, expand attorney information, and cite the case cannot be deemed so "typical," "garden-variety," "obvious" or "inevitable" to prohibit copyrightability. Cf. Feist, 499 U.S. at 362-63.

[60] The majority dissects each element of West's editorial process and then extrapolates that "the cumulative effect of these citation decisions is a piling up of things that are essentially obvious or trivial (albeit helpful), each in its discrete way in its discrete spot."

[61] West's originality, however, cannot be determined by the sum total of whatever (creativity) remains after each individual component is atomized. Indeed, this Court recently warned against the dangers of basing copyrightability analysis on an approach which isolates each element or ignores the "protectible expression within an unprotectible element." Softel, Inc. v. Dragon Medical and Scientific Communications, Inc., 118 F.3d 955, 964 (2d Cir. 1997) . . .

[62] West's selection of particular annotations for each case must be considered a whole, not individually. See Key Publications, 945 F.2d at 514 . . .

* * *

[64] Contrary to the majority's view, the alternative factual annotations selected by West are not comparable to the cases where courts have denied copyright protection based on lack of originality. In Victor Lalli Enterprises, Inc. v. Big Red Apple, Inc., 936 F.2d 671 (2d Cir. 1991), it was undisputed that the publisher's selection and arrangement of fact categories was exactly the same as that of all racing-chart publishers. Id. at 672. In Financial Information, Inc. v. Moody's Investors Service, Inc., 808 F.2d 204 (8th Cir. 1986), cert. denied, 484 U.S. 820, it was beyond dispute that the five basic facts listed on the
Daily Bond Cards were an "inevitable" choice devoid of originality. In this case, by contrast, all of West's basic choices involve subjective judgment.

* * *

[66] The copyright granted West is thin, but it is sufficient to protect against the verbatim digital copying proposed by Hyperlaw. This result protects the advancement of science and the arts, while not permitting Hyperlaw to undermine any incentive for West to annotate judicial opinions selectively. . . .

[67] There is no danger here that granting West's copyright protection to its annotations provides them a monopoly over the "idea" of publishing judicial opinions. When the number of ways data can be organized is so limited that its expression merges with the idea, copyright may be denied. However, here "there are a sufficient number of ways of expressing the idea . . . to preclude a ruling that the idea has merged into its expression." *Kregos v. Associated Press*, 937 F.2d 700 (2d Cir. 1991). . . .

[68] To the extent that the West selection of factual annotation may seem obvious to anyone familiar with legal sources, it may be because of West's success in the market. Cf. *BellSouth*, 999 F.2d at 1444 (industry standard copied from industry association).

[69] For the reasons stated, I conclude the summary judgment granted in favor of Hyperlaw should be reversed.

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1. Although not dispositive since I believe that the district court's determination is clearly erroneous, review should be de novo. Whether West's annotations are copyrightable requires application of the legal standard imposed by the constitution and copyright statute to the undisputed facts. To the extent prior Second Circuit opinions have reviewed issues of copyrightability for clear error, they appear inconsistent with the Supreme Court's de novo review of a similar issue in *Feist* (impliedly, although not expressly, reversing district court after de novo review), inconsistent with the de novo standard applied by this Court in other mixed questions in copyright law, see e.g. *American Geophysical Union v. Texaco Inc.*, 60 F.3d 913, 918 (2d Cir. 1995) (fair use is mixed question subject to de novo review); *Carter v. Helmsley-Spear, Inc.*, 71 F.3d 77, 85 (2d Cir. 1995) (work for hire status legal conclusion reviewed de novo, although factual finding of each relevant factor reviewed for clear error); *Folio Impressions, Inc. v. Byer California*, 937 F.2d 759, 766 (2d Cir. 1991) (substantial similarity reviewed de novo since credibility not at issue), or distinguishable, see *Financial Information, Inc. v. Moody's Investors Service, Inc.*, 808 F.2d 204, (2d Cir. 1986) (noting that district court relied "on its evaluation of the credibility of witnesses - which we are ill-disposed to disturb on appeal" whereas here facts are not in dispute).

2. Indeed, "[m]ost applications of *Feist* have recognized the circumscribed sphere to which its holding applies, ruling that it invalidates the copyright only in the most banal of works, such as the white pages of a phone book." 1. M. Nimmer, *Copyright* § 3.04[B][2], p. 3-33 (footnotes omitted).

3. The contention that all of West's enhancements are trivial is somewhat ironic given that what motivates this litigation, it is assumed, is the desire to make money by copying West's valuable editorial work.
JACOBS, Circuit Judge.

[1] Defendants-appellants West Publishing Co. and West Publishing Corp. (collectively "West") create and publish printed compilations of federal and state judicial opinions. Plaintiff-appellee Matthew Bender & Company, Inc. and intervenor-plaintiff-appellee HyperLaw, Inc. (collectively "plaintiffs") manufacture and market compilations of judicial opinions stored on compact disc-read only memory ("CD-ROM") discs, in which opinions they embed (or intend to embed) citations that show the page location of the particular text in West's printed version of the opinions (so-called "star pagination"). [n1] Bender and HyperLaw seek judgment declaring that star pagination will not infringe West's copyrights in its compilations of judicial opinions. West now appeals from a judgment of the United States District Court for the Southern District of New York (Martin, J.), granting summary judgment of noninfringement to Bender and partial summary judgment of noninfringement to HyperLaw. [n2]

[2] West's primary contention on appeal is that star pagination to West's case reporters allows a user of plaintiffs' CD-ROM discs (by inputting a series of commands) to "perceive" West's copyright-protected arrangement of cases, and that plaintiffs' products (when star pagination is added) are unlawful copies of West's arrangement. We reject West's argument for two reasons:

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

B. In any event, under a proper reading of the Copyright Act, the insertion of star pagination does not amount to infringement of West's arrangement of cases.

BACKGROUND

[5] West creates "case reports" of judicial opinions by combining (i) certain independently authored features, such as syllabi (which summarize each opinion's general holdings), headnotes (which summarize the specific points of law recited in each opinion), and key numbers (which categorize the points of law into different legal topics and subtopics), with (ii) the text of the opinions, to which West adds parallel citations to other reporters, information about the lawyers, and other miscellaneous enhancements. West then publishes these case reports (first in paperbound advance sheets, and then in hardbound volumes) in various series of "case reporters." These case reporters are collectively known as
West's "National Reporter System," and include (as relevant to this case): the Supreme Court Reporter, which contains all Supreme Court opinions and memorandum decisions; the Federal Reporter, which contains all federal court of appeals opinions designated for publication, as well as tables documenting the disposition of cases that are unpublished; the Federal Rules Decisions and Federal Supplement, which contain selected federal district court opinions; and the New York Supplement, which contains selected New York State case reports. Cases appearing in West's case reporters are universally cited by the volume and page number of the case reporter series in which they appear. One citation guide recommends - and some courts require - citation to the West version of federal appellate and trial court decisions and New York State court decisions. See The Bluebook: A Uniform System of Citation at 165-67, 200-01 [p*697] (16th ed. 1996); see, e.g., Third Cir. R. 28.3(a); Eleventh Cir. R. 28-2(k); see also The University of Chicago Manual of Legal Citation 15 (1989) ("When citing to a state case, indicate the volume and first page of the case for both the official and commercial reporters.").

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

[7] Bender obtains the text of the judicial opinions through a license from LEXIS (an on-line database containing legal and non-legal data), and stores the opinions and orders on the discs arranged by court and date, which is also the order in which they would be seen by a user who for some reason browses through the discs without sorting the case reports in a search. For each case that appears in West's case reporters, Bender intends to insert (and in some cases already has inserted) a parallel citation (e.g., 100 F.3d 101) to the West case reporter at the beginning of the opinion and a citation to the successive West page numbers at the points in the opinion where page breaks occur in the West volume (e.g., *104 or 100 F.3d 104).

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

[9] West claims (and for the purposes of this summary judgment motion, we accept as true) that the FOLIO retrieval system permits a user of Bender's product to view (and print) judicial opinions in the same order in which they are printed in a West volume by repeating the following steps: (i) a user activates the jump feature in the program to go to the first page in a West case reporter volume, (ii) pages through to the bottom of the case, (iii) finds the last star pagination reference, and (iv) activates the jump cite feature to retrieve the case beginning on the same or next West page number. [p*698]

[10] HyperLaw markets Supreme Court on Disc, an annual CD-ROM disc containing opinions of the United States Supreme Court since 1991, and Federal Appeals on Disc, a quarterly CD-ROM disc containing nearly all opinions (published and unpublished) of the federal courts of appeals since January 1993. HyperLaw currently obtains the text of its opinions directly from the courts and includes in its Federal Appeals CD-ROM disc many more cases than published by West. The opinions are organized on the CD-ROM disc in an order that is "approximately chronological." HyperLaw includes parallel citations to West's case reporters for all cases appearing in the Supreme Court Reporter and the Federal Reporter, and intends to add star pagination as well. [n7]

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

DISCUSSION

[12] West's case reporters are compilations of judicial opinions. The Copyright Act defines a "compilation" as "a work formed by the collection and assembling of pre-existing materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship." 17 U.S.C. § 101 (1994). Compilations are copyrightable, but the copyright "extends only to the material contributed by the author of such work, as distinguished from the pre-existing material employed in the work." 17 U.S.C. § 103 (1994). Works of the federal government are not subject to copyright protection, 17 U.S.C. § 105 (1994), although they may be included in a compilation.

[13] Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340, 111 S.Ct. 1282 (1991), is the seminal Supreme Court decision on copyrights in compilations. In Feist, the publisher of a telephone book claimed that a competitor had infringed its compilation copyright by copying some of its white pages listings. The Court clarified the scope of a copyright in compilations: "A factual compilation is eligible for copyright if it features an original selection or arrangement of facts, but the [p*699] copyright is limited to the particular selection or arrangement. In no event may copyright extend to the facts themselves." Id. at 350-51, 111 S.Ct. at 1290. Because of this limitation on protectability, "the copyright in a factual compilation is thin. Notwithstanding a valid copyright, a subsequent compiler remains free to use the facts contained in another's publication to aid in preparing a competing work, so long as the competing work does not feature the same selection and arrangement." Id. at 349, 111 S.Ct. at 1289. The Court expressly rejected the "sweat of the brow" doctrine, which had justified the extension of copyright protection to the facts and other non-original elements of compilations on the basis of the labor invested in obtaining and organizing the information. Id. 359-60, 111 S.Ct. at 1295.

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

[15] However, as is clear from the second Feist element, copyright protection in compilations "may extend only to those components of a work that are original to the author." Id. at 348, 111 S. Ct. at 1289. The "originality" requirement encompasses requirements both "that the work was independently created . . ., and that it possesses at least some minimal degree of creativity." Id. at 345, 111 S.Ct. at 1287 (emphasis added); see also Key Publications, Inc. v. Chinatown Today Publ'g Enters., Inc., 945 F.2d 509, 512-13 (2d Cir. 1991) ("Simply stated, original means not copied, and exhibiting a minimal amount of creativity."). At issue here are references to West's volume and page numbers distributed through the text of plaintiffs' versions of judicial opinions. West concedes that the pagination of its volumes - i.e., the insertion of page breaks and the assignment of page numbers - is determined by an automatic computer program, and West does not seriously claim that there is anything original or creative in that process. As Judge Martin noted, "where and on what particular pages the text of a court opinion appears does not embody any original creation of the compiler." Because the internal pagination of West's case reporters does not entail even a modicum of creativity, the volume and page numbers are not original components
of West's compilations and are not themselves protected by West's compilation copyright. See Feist, 499 U.S. at 363, 111 S. Ct. at 1297 ("As a constitutional matter, copyright protects only those constituent elements of a work that possess more than a de minimis quantum of creativity.").

[16] Because the volume and page numbers are unprotected features of West's compilation process, they may be copied without infringing West's copyright. However, West proffers an alternative argument based on the fact (which West has plausibly demonstrated) [p*700] that plaintiffs have inserted or will insert all of West's volume and page numbers for certain case reporters. West's alternative argument is that even though the page numbering is not (by itself) a protectable element of West's compilation, (i) plaintiffs' star pagination to West's case reporters embeds West's arrangement of cases in plaintiffs' CD-ROM discs, thereby allowing a user to perceive West's protected arrangement through the plaintiffs' file-retrieval programs, and (ii) that under the Copyright Act's definition of "copies," 17 U.S.C. § 101, a work that allows the perception of a protectable element of a compilation through the aid of a machine amounts to a copy of the compilation. We reject this argument for two separate reasons.

A.

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

[18] West concedes that insertion of parallel citations (identifying the volume and first page numbers on which a particular case appears) to West's case reporters in plaintiffs' products (as well as any other compilations of judicial opinions) is permissible under the fair use doctrine. See West Reply Brief at 5 n. 5 (noting "West's long-held position [p*701] that parallel citation to West case reports by competitors (without additional star pagination) is a fair use under 17 U.S.C. § 107 - i.e., an otherwise infringing use that, when analyzed under the § 107 factors, is deemed 'fair'"); West's Response to Bender's Rule 3(g) Statement 6 32, Joint Appendix at 1581; see also West Publ'g Co. v. Mead Data Central, Inc., 799 F.2d 1219, 1222 (8th Cir. 1986) ("West concedes that citation to the first page of its reports is a noninfringing 'fair use' under 17 U.S.C. § 107."). West admitted at oral argument (as it did in the district court) that these parallel citations already allow a user of plaintiffs' CD-ROM discs to perceive West's arrangement with the aid of a machine and that plaintiffs' CD-ROM discs therefore already have created a lawful "copy" of West's arrangement on their CD-ROM discs - as West defines "copy."[n15]

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

[20] The opposite conclusion was reached by the district court in Oasis Publishing Co. v. West Publishing Co., 924 F. Supp. 918 (D. Minn. 1996), which reasoned that the fair-use copying of parallel citation, which could be used to perceive the arrangement of cases, did not excuse copying interior pagination, which could also be used to perceive arrangement. See id. at 926. It is true that copying under the fair use doctrine will not necessarily permit additional uses, and will not excuse additional copying that in the aggregate amounts to infringement. But a compilation has limited protectability; only the original elements of a compilation (i.e., its selection, arrangement, and coordination) are protected from copying.
The insertion of parallel citations already creates a "copy" of West's arrangement (at least as West defines a copy), a copy that is permissible under the fair use doctrine. Star pagination cannot be said to create another copy of the same arrangement. Prohibiting star pagination would simply allow West to protect unoriginal elements of its compilation that have assumed importance and value. Accordingly, [p*702] even were we to agree with West's interpretation of the Copyright Act, we would not find infringement.

B.

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

[22] For reasons set forth below, we conclude that a CD-ROM disc infringes a copyrighted arrangement when a machine or device that reads it perceives the embedded material in the copyrighted arrangement or in a substantially similar arrangement. At least absent some invitation, incentive, or facilitation not in the record here, a copyrighted arrangement is not infringed by a CD-ROM disc if a machine can perceive the arrangement only after another person uses the machine to re-arrange the material into the copyright-holder's arrangement.

1. Section 101's Definition of "Copies"

[23] West relies on the statutory definition of "copies." To establish infringement, the copyright holder must demonstrate a violation of an exclusive right. 17 U.S.C. § 501 (1994). One such right is the right "to reproduce the copyrighted work in copies or phonorecords." 17 U.S.C. § 106(1) (1994) (emphasis added). Section 101 of the Copyright Act defines "copies" as follows, the emphasis supplied on terms implicated by the analysis in this case:

"Copies" are material objects, other than phonorecords, in which a work is fixed by any method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. The term "copies" includes the material object, other than the phonorecord, in which the work is first fixed." 17 U.S.C. § 101. "A work is 'fixed' in a tangible medium of expression when its embodiment in a copy . . . is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration." Id. (emphasis added).

[24] The Copyright Act establishes a "fundamental distinction" between the original work of authorship and the material object in which that work is "fixed." See supra note 9. The sole purpose of § 101's definitions of the words "copies" and "fixed" is to explicate the "fixation" requirement, i.e., to define the material objects in which copyrightable and infringing works may be embedded and to describe the requisite fixed nature of that work within the material object. See 1 William F. Patry, Copyright Law and Practice 168 (1994) ("The two essential criteria of statutory copyright are originality and fixation."); id. at 174 (noting that the definition of "copies" is "intended to 'comprise all the material objects in which copyrightable objects are capable of being fixed'"). Under § 101's definition of "copies," a work satisfies the fixation requirement when it is fixed in a material object from which it can be perceived or communicated directly or with the aid of a machine. [n17]
This definition was intended to avoid the distinctions "derived from cases such as [p*703] White-Smith Publishing Co. v. Apollo Co., 209 U.S. [1, 28 S.Ct. 319] (1908), under which statutory copyrightability in certain cases [had] been made to depend upon the form or medium in which the work is fixed." H.R. Rep. No. 94-1476, at 52 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5665; see also S. Rep. No. 94-473, at 51 (1975).

In White-Smith, the Supreme Court held that a piano roll did not infringe the copyrighted music it played because its perforations were unintelligible to the eye and therefore did not amount to a "copy" of the music (which the Court defined as "a written or printed record of [the musical composition] in intelligible notation"). See White-Smith Publ'y Co., 209 U.S. at 17, 28 S. Ct. at 323. There was no question in that case that the work embodied in the piano roll reproduced the original work of authorship, i.e., the piece of music; the only question was whether this reproduction met the "fixation" requirement. Thus, the definition of "copies" is intended to expand the "fixation" requirement to include material objects that embody works capable of being perceived with the aid of a machine, thereby ensuring that reproductions of copyrighted works contained on media such as floppy disks, hard drives, and magnetic tapes would meet the Copyright Act's "fixation" requirement.

That definition - intended to clarify that a work stored on a disk or tape can be a copy of the copyrighted work even if it cannot be perceived by human senses without technological aid - means that CD-ROM discs can infringe a copyright even if the information embedded upon them is not perceptible without the aid of a CD-ROM player. In this case, however, the only fixed arrangement is the (non-West) sequence that is embedded on plaintiffs' CD-ROM discs and that appears with the aid of a machine without manipulation of the data.

To recapitulate a bit, West relies on the definition of "copies" to argue that plaintiffs' CD-ROM discs duplicate its copyrighted arrangement of cases because star pagination permits a user to "perceive" the copyrighted element "with the aid of" a computer and the FOLIO retrieval system, i.e., by manipulating the data embedded on a CD-ROM disc to retrieve the cases in the order in which they appear in the West case reporters. West's definition of a copy, as applied to a CD-ROM disc, would expand the embedded work to include all arrangements and rearrangements that could be made by a third-party user who manipulates the data on his or her own initiative. But the relevant statutory wording refers to material objects in which "a work" readable by technology "is fixed," not to another work or works that can be created, unbidden, by using technology to alter the fixed embedding of the work, by rearrangement or otherwise. The natural reading of the statute is that the arrangement of the work is the one that can be perceived by a machine without an uninvited manipulation of the data.

West cites no case which supports its interpretation of § 101's definition of "copies," and every case we have found has relied upon the definition solely to ascertain whether a work has met the fixation requirement, not to determine the arrangements and rearrangements of the work fixed on the material object. See, e.g., Stenograph L.L.C. v. Bossard Assocx., Inc., 144 F.3d 96, 100 (D.C. Cir. 1998) (citing § 101's definition of "copies" to "support the proposition that the installation of software onto a computer results in 'copying' within the meaning of the Copyright Act"); Stern Elecs., Inc. v. Kaufman, 669 F.2d 852, 856 (2d Cir. 1982) (using § 101's definition of "copies" to determine whether an audiovisual work met the "fixation" requirement); Sega Enters. Ltd. v. Accolade, Inc., 785 F. Supp. 1392, 1396 (N.D. Cal.) (using § 101 to determine whether an intermediate copy was actionable and noting substantial similarity between intermediate copy and allegedly infringed work as the test for determining whether intermediate copy was reproduction of copyrighted work), aff'd in part and rev'd in part, 977 F.2d 1510 (9th Cir. 1992).

2. Substantial Similarity

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

[30] The Supreme Court in *Feist* emphasized that copyright protection for a factual compilation is "thin," and that a compilation containing the same facts or non-copyrightable elements will not infringe unless it "feature[s] the same selection and arrangement" as the original compilation. *Feist*, 499 U.S. at 349, 111 S.Ct. at 1289 (emphasis added); see also *Key Publications, Inc. v. Chinatown Today Publ'g Enters.*, Inc., 945 F.2d 509, 514 (2d Cir. 1991) (holding that to establish infringement, a compilation copyright holder must demonstrate "substantial similarity between those elements, and only those elements, that provide copyrightability to the allegedly infringed compilation"). To determine whether two works contain a substantially similar arrangement, courts compare the ordering of material in the two works, finding infringement only when both compilations have featured a very similar literal ordering or format. See, e.g., *Lipton v. Nature Co.*, 71 F.3d 464, 472 (2d Cir. 1995) (finding infringement of arrangement when of 25 terms contained in copyrighted work, 21 are listed in same order on allegedly infringing work); *Worth v. Selchow & Righter Co.*, 827 F.2d 569, 573 (9th Cir. 1987) (holding that alphabetical arrangement of factual entries in a trivia encyclopedia was not copied by a copyrighted game that organized the factual entries by subject matter and random arrangement on game cards); see also Jane C. Ginsburg, No "Sweat"? Copyright and Other Protection of Works of Information After *Feist* v. Rural Telephone, [p*705] 92 Colum. L. Rev. 338, 349 (1992) (noting that under *Feist*, nothing "short of extensive verbatim copying" will amount to infringement of a compilation). "If the similarity concerns only noncopyrightable elements of [a copyright holder's] work, or no reasonable trier of fact could find the works substantially similar, summary judgment is appropriate." *Williams v. Crichton*, 84 F.3d 581, 587 (2d Cir. 1996) (internal quotation marks and citations omitted). We agree with plaintiffs and amicus United States that West fails to demonstrate the requisite substantial similarity.[n20] West's case reporters contain many fewer cases than plaintiffs' CD-ROM discs, and are arranged according to classification such as court, date, and genre (opinions, per curiam opinions, orders, etc.), subject to certain exceptions characterized by West as features of originality, whereas plaintiffs organize their cases simply by court and date. Comparison of the works reveals that cases that appear adjacent in the West case reporters are separated on plaintiffs' products by many other cases; and even if these other cases are disregarded, the West cases included on plaintiffs' products are not in an order at all resembling West's arrangement.[n21]

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

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

### 3. Contributory Infringement

* * *

C. 

[38] We differ with the Eighth Circuit's opinion in *West Publishing Co. v. Mead Data Central, Inc.*, 799 F.2d 1219 (8th Cir. 1986). In that case, LEXIS (an on-line database provider) announced plans to star paginate its on-line version of cases to West case reporters. West claimed that the star pagination would allow users to page through cases as if they were reading West volumes, and in that way copied West's arrangement of cases. *Id.* at 1222. The court held that "West's arrangement is a copyrightable aspect of its compilation of cases, that the pagination of West's volumes reflects and expresses West's arrangement, and that MDC's intended use of West's page numbers infringes West's copyright in the arrangement." *Id.* at 1223. Even if it was not "possible to use LEXIS to page through cases as they are arranged in West volumes," the court said that insertion of comprehensive star pagination amounted to infringement:

"Jump cites to West volumes within a case on LEXIS are infringing because they enable LEXIS users to discern the precise location in West's arrangement of the portion of the opinion being viewed. . . ."

"With [LEXIS's] star pagination, consumers would no longer need to purchase West's reporters to get every aspect of West's arrangement. Since knowledge of the location of opinions and parts of opinions within West's arrangement is a large part of the reason one would purchase West's volumes, the LEXIS star pagination feature would adversely affect West's market position. "[A] use that supplants any part of the normal market for a copyrighted work would ordinarily be considered an infringement." S. Rep. No. 473, 94th Cong., 1st Sess. 65 (1975). . . ."

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

[39] The Eighth Circuit in *West Publishing Co.* adduces no authority for protecting pagination as a "reflection" of arrangement, and does not explain how the insertion of star pagination creates a "copy" featuring an arrangement of cases substantially similar to West's - rather than a dissimilar arrangement that simply references the location of text in West's case reporters and incidentally simplifies the task of someone who wants to reproduce West's arrangement of cases. It is true that star pagination enables users to locate (as closely as is useful) a piece of text within the West volume. But this location does not result in any proximate way from West's original arrangement of cases (or any other exercise of original creation) and may be lawfully copied. So any damage to the marketability of West's reporters resulting from such copying is not cognizable under the Copyright Act. It is interesting that the Eight Circuit's quotation from the Senate Report on supplanting use is drawn from the Report's discussion of the fair use doctrine, which applies only when the copyright holder has first demonstrated infringement of a protectable element of its work.

[40] At bottom, *West Publishing Co.* rests upon the now defunct "sweat of the brow" doctrine. That court found that LEXIS had infringed West's copyright simply because it supplanted much of the need for West's case reporters through wholesale appropriation of West's page numbers. In reaching this
conclusion, the court (i) noted that LEXIS's appropriation would deprive West of a large part of what it "[had] spent so much labor and industry in compiling," *West Publ'g Co.*, 799 F.2d at 1227, and (ii) cited *Hutchinson Telephone v. Fronteer Directory Co.*, 770 F.2d 128 (8th Cir. 1985), see *West Publ'g Co.*, 799 F.2d at 1228, which in turn relied on *Leon v. Pacific Telephone & Telephone Co.*, 91 F.2d 484 (9th Cir. 1937), and *Jeweler's Circular Pub Co v. Keystone Pub Co*, 281 F. 83 (C.C.A. Cir. 1922) - classic "sweat of the brow" cases that were overruled in *Feist*. Thus, the Eighth Circuit in *West Publishing Co.* erroneously protected West's industrious collection rather than its original creation. Because *Feist* undermines the reasoning of *West Publishing Co.*, see *United States v. Thomson Corp.*, 949 F. Supp. 907, 926 (D.D.C. 1996), we decline to follow it.

**CONCLUSION**

[41] We hold that Bender and HyperLaw will not infringe West's copyright by inserting star pagination to West's case reporters in their CD-ROM disc version of judicial opinions. The judgement of the district court is affirmed.

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

[For footnotes see on-line version of the case]

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Sweet, D.J.

[42] I respectfully dissent.

[43] This appeal from the grant of summary judgment in favor of the appellee Bender presents challenging issues, the extent of copyright protection for compilations under the § 501(a) and § 106(1) and (3) of Title 17, U.S.C. what constitutes copying in the electronic age, and the propriety of summary judgment in determining issues of fair use. Because the majority reaches conclusions on the first two issues, with which I disagree, and consequently failed to address the third issue, I feel required to dissent, emboldened by the holdings of the three other courts which have considered the issue, *West Pub. Co. v. Mead Data Central, Inc.*, 616 F. Supp. 1571 (D.Minn. 1985), aff'd, 799 F.2d 1219 (8th Cir. 1986), *cert. denied*, 479 U.S. 1070 (1987); *Oasis Pub. Co. v. West Pub. Co.*, 924 F. Supp. 918 (D.Minn. 1996) . . .

[44] . . . The West page numbers and the corresponding Bender and Hyperlaw star pagination are the keys which open the door to the entire West citation system which as the majority noted is an accepted, and in some instances, a required element for the citation of authorities.

[45] . . . By characterizing star pagination as a fact, rather than as an essential part of the selection or arrangement the majority deprives the West pagination of its originality and consequent copyright protection.

* * *

[47] In my view West's case arrangements, an essential part of which is page citations, are original works of authorship entitled to copyright protection. Comprehensive documentation of West's selection and arrangement of judicial opinions infringes the copyright in that work.
This reasoning is consistent with *Feist*. As discussed above, the majority notes that the compiler's copyright is "thin." *Feist*, 499 U.S. 340 at 350-51. . . .In this case, allowing plaintiffs to use the page numbers contained in West's publication enables them to feature West's same selection and arrangement. Indeed, were it not for the ability to reproduce West's arrangement, its pagination would be of limited (if any) use.

* * *  

[50] Here the pagination results from West's arrangements, selections, syllabi, headnotes, key numbering, citations and descriptions. The page number, arbitrarily determined, is the sole result of the West system, appears nowhere else, and is essential to its coordinated method of citation. It is, so to speak, an original fact resulting from West's creativity.

* * *

[52] The comprehensive copying of first-page parallel citations alone, even in a competing work, is arguably fair use because citations do not substantially supplant the need for the West volumes. Conversely, complete electronic cross-pagination fulfills the same market demand as West's volumes. . . .

[53] According to the majority, a more fundamental reason to reject West's argument that plaintiffs have copied its arrangement is that the arrangement can be perceived only after a person uses the machine to rearrange the material.

[54] Some of the most seminal developments in copyright law have been driven by technological change. There was a time when people questioned whether photographs, see *Burrow-Giles Lithographic co. v. Sarony*, 111 U.S. 53 (1994), or advertisements, see *Bleistein v. Donaldson Lithographic Co.*, 188 U.S. 293 (1903), were copyrightable. . . . plaintiffs provide the ability for a user to push a button or two and obtain West's exact selection and arrangement. This technological capacity presents a new question. The majority's answer threatens to eviscerate copyright protection for compilations.

[55] . . . Accordingly, plaintiffs' CD-ROMs infringe West's reproduction right if the information is "fixed" in the CD-ROM (which it is) and if West's protected selection and arrangement "can be perceived . . . with the aid of a machine."

[56] Broadly read, plaintiffs' inclusion in their work of West's precise page break information permits the Reporters to be "perceived" by the aid of a computer. . . .

* * *

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

* * *

[60] In *West Publishing Co.*, the Eighth Circuit's persuasively reasoned that (i) comprehensive pagination, when linked to the text of a compilation, is copyrightable in terms of originality because it expresses the compiler's expression and arrangement, and (ii) a compilation's selection and arrangement is copied when comprehensive cross-pagination is inserted into an electronic database containing the compilation's text. 799 F.2d at 1227-28.
[62] For these reasons I believe the grant of summary judgment granting the declaratory judgment requested by Bender was error, and I therefore dissent from the majority's affirmance of that judgment.

***

2. It is immaterial that plaintiffs' products may display other arrangements as well as West's. The capability of a CD-ROM to display more than one arrangement does not make the encoding of an original selection and arrangement such as West's any less of an infringement.

"It is also irrelevant that plaintiffs' products may contain material beyond West's selection and arrangement. Infringement is determined by how much of the copyright owner's work was taken, not by what else the copier's work contains. See e.g., Warner Bros., Inc. v. American Broadcasting Cos., Inc., 720 F.2d 231, 241 (2d Cir. 1983)."
EDITH H. JONES, Circuit Judge:

[1] The issue in this en banc case is the extent to which a private organization may assert copyright protection for its model codes, after the models have been adopted by a legislative body and become "the law". Specifically, may a code-writing organization prevent a website operator from posting the text of a model code where the code is identified simply as the building code of a city that enacted the model code as law? Our short answer is that as law, the model codes enter the public domain and are not subject to the copyright holder's exclusive prerogatives. As model codes, however, the organization's works retain their protected status.

BACKGROUND

[2] Peter Veeck individually operates "Regional Web" (<http://regionalweb.texoma.net>), a non-commercial website that provides information about north Texas. Sometime in 1997, Veeck decided to post on Regional Web the local building codes of Anna and Savoy, two small towns in north Texas that had adopted the 1994 edition of the Standard Building Code written by appellee, Southern Building Code Congress International, Inc. ("SBCCI"). Veeck made a few attempts to inspect several towns' copies of the Building Code, but he was not able to locate them easily. Eventually, Veeck purchased the 1994 model building codes directly from SBCCI; he paid $72.00 and received a copy of the codes on disk. Although the software licensing agreement and copyright notice indicated that the codes could not be copied and distributed, Veeck cut and pasted their text onto his Regional Web. Veeck's website did not specify that the codes were written by SBCCI. Instead, he identified them, correctly, as the building codes of Anna and Savoy, Texas.

[3] The author of the codes, SBCCI, is a non-profit organization consisting of approximately 14,500 members from government bodies, the construction industry, business and trade associations, students, and colleges and universities. Since 1940, SBCCI's primary mission has been to develop, promote, and promulgate model building codes, such as the Standard Plumbing Code, the Standard Gas Code, the Standard Fire Prevention Code, and the Standard Mechanical Code. SBCCI encourages local government entities to enact its codes into law by reference, without cost to the governmental entity. No licensing agreements are executed in connection with legislative adoption, nor does SBCCI keep track of the entities that have adopted its codes. Although SBCCI is a non-profit organization, its annual budget, exceeding $9 million, derives in part from sales of its model codes and is used to fund continuing activities. There are no restrictions or requirements on membership in SBCCI, but non-members are charged considerably more for copies of its codes than are members.
While SBCCI continues to assert its copyright prerogatives -- exclusively to publish the codes and license their reproduction and distribution -- even as to codes that have been adopted by local entities, the organization insists that it grants liberal permission for copying. To support this contention, SBCCI offered in evidence several dozen letters of permission written to entities as diverse as book publishers, seminar providers, and municipal inspection agencies. Notably, each permit letter carefully circumscribed the amount of copying allowed.

SBCCI's generosity did not extend to Veeck's public-service posting of the Anna and Savoy building codes on his website. The organization demanded that he cease and desist from infringing its copyrights. Veeck filed a declaratory judgment action seeking a ruling that he did not violate the Copyright Act. SBCCI counterclaimed for copyright infringement, unfair competition and breach of contract. Both parties moved for summary judgment on the copyright infringement issue.

Finding no genuinely disputed material facts, the district court granted summary judgment in favor of SBCCI, including a permanent injunction and monetary damages. On appeal, a divided panel of this court upheld SBCCI's copyrights in the municipal building codes posted by Veeck, and it rejected his defenses to infringement based on due process, merger, fair use, copyright misuse and waiver.

We elected to rehear this case en banc because of the novelty and importance of the issues it presents.

DISCUSSION

As the organizational author of original works, SBCCI indisputably holds a copyright in its model building codes. See 17 U.S.C. § 102(a). Copyright law permits an author exclusively to make or condone derivative works and to regulate the copying and distribution of both the original and derivative works. 17 U.S.C. § 106. The question before us is whether Peter Veeck infringed SBCCI's copyright on its model codes when he posted them only as what they became -- building codes of Anna and Savoy, Texas -- on his regional website. Put otherwise, does SBCCI retain the right wholly to exclude others from copying the model codes after and only to the extent to which they are adopted as "the law" of various jurisdictions?

The answer to this narrow issue seems compelled by three sources: the Supreme Court's holding that "the law" is not copyrightable; alternatively, the Copyright Act's exclusion from its scope of "ideas" or "facts"; and the balance of caselaw.

I. The Supreme Court's View

Excluding "the law" from the purview of the copyright statutes dates back to this nation's earliest period. In 1834, the Supreme Court interpreted the first federal copyright laws and unanimously held that "no reporter has or can have any copyright in the written opinions delivered by this Court. . ." Wheaton v. Peters, 33 U.S. (8 Pet.) 591, 668 (1834). The case arose when one of the Court's official reporters was asserting copyright protection for his annotated compilations of Supreme Court opinions. The Court distinguished between the reporter's individual work and the Justices' opinions. The Court's rejection of copyright for judicial opinions paralleled the principle -- recognized by attorneys for both parties -- that "[s]tatutes were never copyrighted." Based on the acknowledged and incontestable analogy with legislative acts, Wheaton held unanimously that "the law" in the form of judicial opinions may not be copyrighted.

The same broad understanding of what constitutes "the law" for copyright purposes underlies the Court's later decision in Banks v. Manchester, 128 U.S. 244, 9 S.Ct. 36 (1888). The Court there denied a copyright to a court reporter in his printing of the opinions of the Ohio Supreme Court. The Court first
noted that whatever work the judges perform in their official capacity cannot be regarded as authorship under the copyright law. As a question of "public policy," the Court stated that,

there has always been a judicial consensus, from the time of the decision in the case of Wheaton v. Peters, 8 Pet. 591, that no copyright could, under the statutes passed by Congress, be secured in the products of the labor done by judicial officers in the discharge of their judicial duties. The whole work done by the judges constitutes the authentic exposition and interpretation of the law, which, binding every citizen, is free for publication to all, whether it is a declaration of unwritten law, or an interpretation of a constitution or statute. Banks, 128 U.S. at 253, 9 S.Ct. at 40. (emphasis added). At this point, Banks relied upon a decision of the Massachusetts Supreme Judicial Court, which stated, [1]It needs no argument to show that justice requires that all should have free access to the opinions, and that it is against sound public policy to prevent this, or to suppress and keep from the earliest knowledge of the public the statutes, or the decisions and opinions of the Justices. Nash v. Lathrop, 142 Mass. 29, 6 N.E. 559 (1886). The court in Nash further observed that a legislature likewise could not deny public access to statutes.

[12] Banks represents a continuous understanding that "the law," whether articulated in judicial opinions or legislative acts or ordinances, is in the public domain and thus not amenable to copyright. (4) Modern decisions have followed suit. (5) Significantly, the 1976 Copyright Act specifically denies protection to federal statutes and regulations. 17 U.S.C. § 105. Given the state law foundation of Banks and its progeny, there is no reason to believe that state or local laws are copyrightable. See generally L. Ray Patterson & Craig Joyce, Monopolizing the Law: The Scope of Copyright Protection for Law Reports and Statutory Compilations, 36 U.C.L.A. L. Rev. 719, 751-58 (1989); 1 Melville B. Nimmer & David Nimmer, Nimmer on Copyright § 5.06 [c] at 5-92 (2000) ("state statutes, no less than federal statutes, are regarded as being in the public domain"); 1 Patry, Copyright Law and Practice 351, 357 (1994).

[13] As governing law, pursuant to Banks, the building codes of Anna and Savoy, Texas cannot be copyrighted.

[14] SBCCI and its numerous amici must limit or circumvent the Banks line of cases in order to prevail. Initially, SBCCI divides Banks into two holdings and concludes that either holding must be squared with the policies and purposes of copyright law. This not insubstantial mode of analysis must be carefully reviewed.

[15] The first holding of Banks is said to deny copyright to judicial opinions because judges, whose salaries are paid by the government, cannot claim to be "authors" of their official works. SBCCI contends that this discussion shows only that judges have no need of the Copyright Act's economic incentives in order to author judicial opinions. Banks, it is implied, articulates a utilitarian rationale for denying copyright protection to judicial opinions. SBCCI contrasts government employees with the private "authors" of model codes who allegedly depend on copyright incentives in order to perform their public service. SBCCI concludes that this "prong" of Banks does not apply to private code-writing organizations whose work has been adopted or incorporated into statutes, ordinances, or government regulations. Two courts, in addition to the panel that originally heard this case, have identified the consideration of authorship incentives as a "holding" of Banks. See Practice Management Info. Corp. v. American Medical Ass'n, 121 F.3d 516, 518 (9th Cir. 1997), opinion amended by 133 F.3d 1140 (9th Cir. 1998); [n7] County of Suffolk v. First American Real Estate Solutions, 261 F.3d 179, 194 (2d Cir. 2001).

[16] The second "holding" of Banks, which requires "the law" or its exposition to be "free for publication to all," is recharacterized by SBCCI as a "due process" argument. That argument devolves into a factual question concerning public "access" to the law. Because SBCCI contends that there is no dispute about
the adequacy of public "access" to its model codes, after their enactment as the building codes of Anna and Savoy, *Banks* is inapplicable.

[17] The "dual holding" analysis seems to foist on *Banks* a rationale that the Supreme Court never explicitly articulated. *Banks*, however, does not bifurcate its holding based on the particular authors' need of the Copyright Act's incentives or a factual calculus concerning the "adequacy" of public access to the law. Instead, *Banks* declares at the outset of its discussion that copyright law in the United States is purely a matter of statutory construction. *See Banks*, 128 U.S. at 251, 9 S.Ct. at 39. In the next paragraph, the Court points out that the court reporter was not the statutory "author" of the judicial decisions. Then, the Court states that

In no proper sense can the judge who, in his judicial capacity, prepares the opinion or decision, the statement of the case, and the syllabus, or head-note, be regarded as their author or their proprietor, in the sense of [the copyright statute] . . .

Judges, as is well understood, receive from the public treasury a stated annual salary, fixed by law, and can themselves have no pecuniary interest or proprietorship, as against the public at large, in the fruits of their judicial labors.

128 U.S. at 253, 9 S.Ct. at 40. The Court then broadly defines the judges' official work and states that as a matter of public policy and judicial consensus, "no copyright could, under the statutes passed by Congress, be secured in the products of the labor done by judicial officers in the discharge of their official duties." This paragraph of *Banks* climaxes with the explanation:

The whole work done by the judges constitutes the authentic exposition and interpretation of the law, which, binding every citizen, is free for publication to all, whether it is a declaration of unwritten law, or an interpretation of a constitution or statute. *Id.* at 253-54 [*citing Nash v. Lathrop*].

[18] There is simply no independent holding in *Banks* that judges are not "authors" under the copyright law because, as public officials, they do not need the "incentives" that copyright law affords in order to write opinions. Instead, *Banks* refers to the source of the judges' salary in order to explain that it is the public at large, not the judges, who have the "pecuniary interest or proprietorship" in "the fruits of their judicial labors." The whole of those judicial labors, as *Banks* immediately defines them, "constitutes the authentic exposition and interpretation of the law," which is "free for publication to all . . ." *Id.*

[19] Moreover, when viewed in light of *Wheaton*, the last case relied on by *Banks*'s analysis, the argument for bifurcation is seriously weakened. *Wheaton*'s holding, as has been shown, derives from an analogy between judicial opinions and legislative acts as together constituting "the law," which is not subject to copyright.

[20] The origin of the bifurcated holding interpretation of *Banks* seems to lie in the First Circuit's thoughtful opinion in *Building Officials and Code Adm. v. Code Technology, Inc.*, 628 F.2d 730 (1st Cir. 1980), but the First Circuit does not endorse bifurcation. In this opinion, which will be discussed further *infra*, the First Circuit considered the argument of BOCA, the model code writer, urging copyright protection for a model building code similar in origin and purpose to the one before us. BOCA's argument, the court said, "implies that the rule of *Wheaton v. Peters* was based on the public's property interest in work produced by legislators and judges, who are, of course, government employees." *BOCA*, 628 F.2d at 734.

[21] While acknowledging that this interpretation is "not without foundation," the First Circuit cautioned: "But BOCA's argument overlooks another aspect of the ownership theory discussed in these cases." *Id.* BOCA then identifies the real premises of *Banks* and related cases: the "metaphorical concept of citizen
authorship" of the law, together with "the very important and practical policy that citizens must have free access to the laws which govern them." Id. BOCA cited the authorship rationale for Banks only to find it unsatisfactory. In our view, BOCA was correct.

[22] Only by bifurcating Banks can SBCCI achieve its purpose of claiming authorship of "the law" and proprietary rights in its codes that have been enacted into law. However, the acceptance of SBCCI's and the dissent's theory, that non-governmental employees who draft model statutes or regulations may be entitled to copyright protection, raises troubling issues. The complexities of modern life and the breadth of problems addressed by government entities necessitate continuous participation by private experts and interest groups in all aspects of statutory and regulatory lawmaking. According to SBCCI, a utilitarian test should be invoked to determine which organizations "need" the incentives provided by the Copyright Act in order to perform the public service of drafting specialized statutes, ordinances or regulations. Alternatively, perhaps SBCCI and the dissent intend that whenever any private "author" finds his or her proposal adopted verbatim in law, copyright protection may be claimed. As an example, three law professors have taken credit for drafting a recent federal statute on supplemental federal court jurisdiction. See 28 U.S.C. § 1367; Christopher M. Fairman, Abdication to Academia: The Case of the Supplemental Jurisdiction Statute, 28 U.S.C. § 1367, 19 SETON HALL LEGIS. J. 157 (1994). Under SBCCI's reasoning, it is likely that these professors, had they so desired, could have asserted a copyright in their "model supplemental jurisdictional provision." SBCCI offers no outer limit on claims of copyright prerogatives by nongovernmental persons who contribute to writing "the law."

[23] Not only is the question of authorship of "the law" exceedingly complicated by SBCCI's and the dissent's position, but in the end, the "authorship" question ignores the democratic process. Lawmaking bodies in this country enact rules and regulations only with the consent of the governed. The very process of lawmaking demands and incorporates contributions by "the people," in an infinite variety of individual and organizational capacities. Even when a governmental body consciously decides to enact proposed model building codes, it does so based on various legislative considerations, the sum of which produce its version of "the law." In performing their function, the lawmakers represent the public will, and the public are the final "authors" of the law.

[24] The BOCA decision put it thus:

The citizens are the authors of the law, and therefore its owners, regardless of who actually drafts the provisions, because the law derives its authority from the consent of the public, expressed through the democratic process. 628 F.2d at 734. This "metaphorical concept of citizen authorship" together with the need for citizens to have free access to the laws are the ultimate holding of Banks. Id.

[25] BOCA described free access as a policy "based on the concept of due process," the people's right to know what the law requires so that they may obey it and avoid its sanctions. SBCCI and the dissent contend that this "due process" reasoning involves nothing more than the factual issue of "sufficient" public access to the building codes of Anna and Savoy. Since a copy of the codes is available for inspection and individual copying in a public office, SBCCI contends that the obligations of due process are fulfilled.

[26] We disagree that the question of public access can be limited to the minimum availability that SBCCI would permit. Banks does not use the term "due process." There is also no suggestion that the Banks concept of free access to the law is a factual determination or is limited to due process, as the term is understood today. Instead, public ownership of the law means precisely that "the law" is in the "public domain" for whatever use the citizens choose to make of it. Citizens may reproduce copies of the law for many purposes, not only to guide their actions but to influence future legislation, educate their neighborhood association, or simply to amuse. If a citizen wanted to place an advertisement in a
newspaper quoting the Anna, Texas building code in order to indicate his dissatisfaction with its complexities, it would seem that he could do so. In our view, to say, as Banks does, that the law is "free for publication to all" is to expand, not factually limit, the extent of its availability.

[27] Moreover, as the BOCA decision observed, it is difficult to reconcile the public's right to know the law with the statutory right of a copyright holder to exclude his work from any publication or dissemination. SBCCI responds that due process must be balanced against its proprietary rights and that the fair use doctrine as well as its honorable intentions will prevent abuse. Free availability of the law, by this logic, has degenerated into availability as long as SBCCI chooses not to file suit. [m12]

[28] For these reasons, we reject SBCCI's deconstruction of Banks into merely utilitarian and factual issues. Instead, we read Banks, Wheaton, and related cases consistently to enunciate the principle that "the law," whether it has its source in judicial opinions or statutes, ordinances or regulations, is not subject to federal copyright law. [m13]

[29] To sum up this section, we hold that when Veeck copied only "the law" of Anna and Savoy, Texas, which he obtained from SBCCI's publication, and when he reprinted only "the law" of those municipalities, he did not infringe SBCCI's copyrights in its model building codes. The basic proposition was stated by Justice Harlan, writing for the Sixth Circuit: "any person desiring to publish the statutes of a state may use any copy of such statutes to be found in any printed book . . ." Howell v. Miller, 91 F. 129, 137 (6th Cir. 1898).[14] See Jerry E. Smith, Government Documents: Their Copyright and Ownership, 22 Copyright Symposium 147, 174 (ASCAP 1977), reprinted in 5 Tex. Tech L. Rev. 71, 92 (1973).

II. The Copyright Act

A. The Merger Doctrine

[30] As we earlier stated, SBCCI is the "author" of model building codes that, qua model building codes, are facially copyright-protected. This is true even if Banks places the building codes of Anna and Savoy, and other governmental entities that adopted part or all of SBCCI's model codes, in the public domain. But if the holding of Banks fails, Veeck alternatively asserts a defense under the Copyright Act to the protection of the model codes after they have been enacted into positive law. Once adopted, he asserts, the model codes become "facts" that are not protected under the Copyright Act. Further, because there is only one way to express the meaning of the building codes, the "idea" embodied in the law merges with SBCCI's expression, and at that point, renders copyright protection unavailable.

[31] It is not the sole purpose of copyright law to secure a fair return for an author's creative labor. Under the Constitution,

The primary objective of copyright is not to reward the labor of authors but '[t]o promote the Progress of Science and the useful Arts.'" Article I, Sec. 8, clause 8 [U.S. Constitution]. To this end, copyright law assures authors the right to their original expression, but encourages others to build freely upon the ideas and information conveyed by a work. This principle, known as the idea/expression or fact/expression dichotomy, applies to all works of authorship.

Feist Publications, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 349, 111 S.Ct. 1282, 1289-90 (1991). The statute excludes from copyright protection ideas, procedures, processes, systems methods of operation, or information in the public domain. See 17 U.S.C. § 102(b); Feist Publications, 499 U.S. at 350, 111 S.Ct. at 1290 (citation omitted); Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 547-48, 105 S.Ct. 2218, 2223 (1985). If an idea is susceptible to only one form of expression, the merger doctrine applies and § 102(b) excludes the expression from the Copyright Act. As the Supreme Court has explained it, this "idea/expression dichotomy strike[s] a definitional balance between the First

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Amendment and the Copyright Act by permitting free communication of facts while still protecting an author's expression." Harper & Row, 471 U.S. at 556, 105 S.Ct. at 2228.

[32] Veeck copied the building code of the towns of Anna and Savoy, Texas, based on their adoption of a version of the SBCCI model code. The codes are "facts" under copyright law. They are the unique, unalterable expression of the "idea" that constitutes local law. Courts routinely emphasize the significance of the precise wording of laws presented for interpretation. See, e.g., Consumer Product Safety Comm'n v. GTE Sylvania, Inc., 447 U.S. 102, 108, 100 S.Ct. 2051, 2056 (1980) ("[T]he starting point for interpreting a statute is the language of the statute itself."). Judge Little, dissenting from the panel opinion in this case, observed that

. . . the merger doctrine is especially appropriate because other methods of expressing the idea are foreclosed. [citation omitted] An individual wishing to publish the text of a law cannot develop his own, unique version and still publish an authoritative copy. Veeck v. Southern Bldg. Code Cong. Int'l, 241 F.3d 398, 416 (5th Cir. 2001) (Little, J., dissenting). It should be obvious that for copyright purposes, laws are "facts": the U.S. Constitution is a fact; the Federal Tax Code and its regulations are facts; the Texas Uniform Commercial Code is a fact. Surely, in principle, the building codes of rural Texas hamlets are no less "facts" than the products of more August legislative or regulatory bodies. While the Supreme Court has not stated directly that laws are "facts," it has broadly observed that, as with census data, "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." Feist, 499 U.S. at 348, 111 S.Ct. at 1289.

[33] Emphasizing not the language of § 102(b), but the "policy" of the merger doctrine, SBCCI contends that merger poses no bar to copyright protection here. The idea/expression dichotomy was enacted into law by Congress to "balance [] the competing concerns of providing incentive to authors to create and foster[] competition in such creativity." Kern River Gas Transmission Co. v. The Coastal Corp., 899 F.2d 1458, 1463 (5th Cir. 1990) [n15] Veeck's merger argument ignores the goal of fostering competition in creativity. SBCCI thus asserts that "merger would only apply in this case if a subsequent author seeking to create a building code for Anna or Savoy would have to use the same expression to convey the idea." SBCCI supplemental en banc brief at 7. This argument effectively converts the merger doctrine from a limit on copyrightability into a mere defense against infringement based on the identity of the author. In our view § 102(b) does foster the creativity that SBCCI applauds, but it does so by permitting the free flow of information in facts and ideas from their emergence, rather than as a defense to infringement claims. See Kern River at 1460; Mason v. Montgomery Data, Inc., 967 F.2d 135, 138 n.5 (5th Cir. 1992) ("Mason argues that application of the merger doctrine does not render a work uncopyrightable, but rather prevents a finding of infringement of an otherwise copyrightable work. But this court has applied the merger doctrine to the question of copyrightability.").

[34] SBCCI and the dissent next urge the inapplicability of the merger doctrine because there are many possible ways to express model codes: both the multiplicity of building standards and the variety of ways to express those standards compel the conclusion that the ideas have not merged with their expression. Cf. Mason, 967 F.2d at 139 (rejecting merger because the idea embodied in the author's maps can be expressed in a variety of ways). What SBCCI and the dissent ignore, however, is the graphic merger of its model building codes with "the law" as enacted by Anna and Savoy, Texas. Veeck copied from SBCCI's model codes, 1994 edition, because those codes were transformed into the "fact" and "idea" of the towns' building codes. Veeck could not express the enacted law in any other way.

[35] The final argument deployed by SBCCI and the dissent casts the merger doctrine as an inherent balancing test in which courts must reconcile the policies underlying the Copyright Act with the public interest in the free flow of information and ideas. Compare CCC Info Serv. Inc. v. McLean Hunter Market Reports, Inc., 44 F.3d 61, 68 (2nd Cir. 1994) (interpreting Second Circuit's balancing test). It is true that
where the line is unclear between expression and facts, procedures, processes, methods of operation, or information in the public domain, a court considering the applicability of § 102(b) must recur to the statute's underlying policy. See, e.g., Feist, 499 U.S. at 361-64, 111 S.Ct. at 1295-97 (determining copyrightability of compilations of facts); Mason, 967 F.2d at 139 (copyrightability of expression in maps). This case, however, is not close. The building codes of Anna and Savoy, Texas can be expressed in only one way; they are facts. Veeck placed those facts on his website in precisely the form in which they were adopted by the municipalities. When the § 102(b) dichotomy is clear, judges are not permitted to substitute policy choices for the legislature's determination.

[36] We emphasize that in continuing to write and publish model building codes, SBCCI is creating copyrightable works of authorship. When those codes are enacted into law, however, they become to that extent "the law" of the governmental entities and may be reproduced or distributed as "the law" of those jurisdictions.

B. Other Provisions

[37] SBCCI's amici make much of provisions of the Copyright Act that, they contend, should protect SBCCI's copyrights from "appropriation" by local government entities. Section 105 of the Act, taken together with the definition of "works of the government," denies copyright protection to official works of the United States Government, while reserving the possibility that government employees and contractors may obtain, or transfer to the government, copyrights for non-official works. 17 U.S.C. §§ 105, 101. On its face, these provisions say nothing about the relationship between non-federal government entities and copyright holders. Moreover, they have never been held inconsistent with Banks or with the merger doctrine.

[38] Section 201(e) of the Act reflects Congress's intention to protect copyrights from involuntary appropriation by government entities. 17 U.S.C. § 201(e). This is not, however, a "takings" case, not least because SBCCI urged localities to adopt its model codes. The issue in the case is not the voluntariness of the appropriation but the legal consequences flowing from the permission that SBCCI gave.

III. The Caselaw; Model Codes Versus Standards

[39] Until recently in our history, it was understood that Wheaton, Banks and nearly every other pertinent case held that copyright protection may not be asserted for the text of "the law." The basic proposition was stated by Justice Harlan, writing for the Sixth Circuit: "any person desiring to publish the statutes of a state may use any copy of such statutes to be found in any printed book . . ." Howell v. Miller, 91 F. 129, 137 (6th Cir. 1898).

[40] As of 1980, the noncopyrightability of "the law" appeared settled to the First Circuit in BOCA. The court focused on the real holding of Banks and accordingly vacated preliminary injunctive relief to the author of a building code adopted into law by the Commonwealth of Massachusetts. The court held that BOCA had failed to carry its burden of distinguishing, for preliminary relief purposes, the Massachusetts building code from non-copyrightable statutes and judicial opinions. But the court then remanded the case for further development in light of the novelty of the issue, the insufficiency of the trial court record, and the apparent trend toward adoption of model codes by governmental entities. The court nevertheless was skeptical that BOCA would prevail, commenting it is hard to see how the public's essential due process right of free access to the law (including a necessary right freely to copy and circulate all or part of a given law for various purposes), can be reconciled with the exclusivity afforded a private copyright holder . . . BOCA, 628 F.2d at 730. Though not a definitive holding, BOCA clearly favors Veeck's position over that of SBCCI, and it is most closely on point.
[41] The record has been developed in this case and, with the perspective gained from other recent caselaw and from the multiple submissions to the court, we have no hesitation in confirming BOCA’s predisposition against the copyrightability of model codes to the extent they have been adopted as law. But the limits of this holding must be explained. Several national standards-writing organizations joined SBCCI as amici out of fear that their copyrights may be vitiated simply by the common practice of governmental entities’ incorporating their standards in laws and regulations. This case does not involve references to extrinsic standards. Instead, it concerns the wholesale adoption of a model code promoted by its author, SBCCI, precisely for use as legislation. Caselaw that derives from official incorporation of extrinsic standards is distinguishable in reasoning and result. See CCC Info. Services v. Maclean Hunter Market Reports, Inc., 44 F.3d 61 (2nd Cir. 1994); and Practice Management Info. Corp. v. American Medical Ass’n, 121 F.3d 516 (9th Cir. 1997), opinion amended by 133 F.3d 1140 (9th Cir. 1998).

[42] In CCC Information Services, a New York statute required insurance companies to use the "Red Book," a privately prepared and copyrighted list of projected automobile values, as one of several standards in calculating the payments upon the total loss of a vehicle. CCC Information Services systematically loaded portions of the Red Book onto its computer network and distributed the information to its customers. One of CCC’s theories was that the Red Book had entered the public domain. The Second Circuit addressed the public domain issue briefly, stating that "we are not prepared to hold that a state's reference to a copyrighted work as a legal standard for valuation results in loss of the copyright." CCC Info. Services, 44 F.3d at 74. CCC notes the infringer's reliance on the BOCA decision, but it does not opine on that case, confining itself to the precise facts before the court.

[43] Practice Management involved the American Medical Association's copyrighted coding system for reporting physicians' services and medical procedures. The Federal Health Care Financing Administration (HCFA) contacted and then agreed with AMA to use the AMA's coding system for identifying physicians' services on Medicare and Medicaid reimbursement forms. AMA granted a "non-exclusive, royalty-free and irrevocable" license to HCFA, without restrictions on the government's ability to reproduce or distribute AMA's codes. There was no evidence that AMA had restricted the code's availability to anyone. The Ninth Circuit held that the HCFA's decision to adopt regulations requiring physicians to use a version of the AMA code on Medicaid claim forms did not place the code in the public domain under Banks. Practice Management, 121 F.3d at 519 ("[T]he AMA's right under the Copyright Act to limit or forgo publication of the [coding system] poses no realistic threat to public access.").

[44] Both the Second and Ninth Circuits feared that reaching the opposite conclusion in those cases would have "expose[d] copyrights on a wide range of privately authored model codes, standards, and reference works to invalidation." Practice Management, 121 F.3d at 519. The Ninth Circuit suggested that federal court rules regarding citations could invalidate the copyrightability of the Blue Book. Id. at n.5. The Second Circuit feared that a ruling in favor of CCC Information Systems would call into question the copyrightability of school books once they were assigned as part of a mandatory school curriculum. CCC Info Services, 44 F.3d at 74.

[45] These decisions, and the hypothetical situations they discuss, are all distinguishable from Veeck. If a statute refers to the Red Book or to specific school books, the law requires citizens to consult or use a copyrighted work in the process of fulfilling their obligations. The copyrighted works do not "become law" merely because a statute refers to them. See 1 Goldstein Copyright, § 2.49 at n. 45.2 ( noting that CCC and Practice Management "involved compilations of data that had received governmental approval, not content that had been enacted into positive law"). Equally important, the referenced works or standards in CCC and Practice Management were created by private groups for reasons other than incorporation into law. To the extent incentives are relevant to the existence of copyright protection, the authors in these cases deserve incentives. And neither CCC nor AMA solicited incorporation of their
standards by legislators or regulators. In the case of a model code, on the other hand, the text of the model serves no other purpose than to become law. SBCCI operates with the sole motive and purpose of creating codes that will become obligatory in law.

[46] At first glance, Practice Management appears to pose a closer issue because the HCFA did not simply refer physicians to the AMA's coding system. The court's opinion directs the reader to HHS's notice in the Federal Register announcing that HCFA would require physicians to use exclusively a common procedure coding system. The system is the HCFA common procedure coding system (HCPCS). This coding system is to be used for coding procedures that have been performed . . . and is basically used for determining reimbursement amounts. HCFA developed the HCPCS in 1979 and 1980 by using the AMA's CPT-4 [the copyrighted coding system] for physician services and adding HCFA-developed codes for some non-physician services. In addition, we developed conversion techniques to prevent unwarranted payment escalation. 50 Fed. Reg. 40895, 40897. To be precise, then, HCFA had its own coding system (the HCPCS) that incorporated AMA's code but also included additional information.

[47] But unlike Veeck, Practice Management Information Corporation, a commercial publisher of medical textbooks, was not trying to publish its own version of the HCPCS. Practice Management desired to sell a cheaper edition of the AMA's code, which was also used by insurance companies and had other non-governmental uses. It is not clear how the Ninth Circuit would have decided the case if Practice Management had published a copy of the HCPCS. By analogy, the result in this case would have been different if Veeck had published not the building codes of Anna and Savoy, Texas, but the SBCCI model codes, as model codes.

IV. Policy Arguments

[48] Many of SBCCI's and the dissent's arguments center on the plea that without full copyright protection for model codes, despite their enactment as the law in hundreds or thousands of jurisdictions, SBCCI will lack the revenue to continue its public service of code drafting. Thus SBCCI needs copyright's economic incentives. 1 Goldstein § 2.5.2, at 2:51.

[49] Several responses exist to this contention. First, SBCCI, like other code-writing organizations, has survived and grown over 60 years, yet no court has previously awarded copyright protection for the copying of an enacted building code under circumstances like these. Second, the success of voluntary code-writing groups is attributable to the technological complexity of modern life, which impels government entities to standardize their regulations. The entities would have to promulgate standards even if SBCCI did not exist, but the most fruitful approach for the public entities and the potentially regulated industries lies in mutual cooperation. The self-interest of the builders, engineers, designers and other relevant tradesmen should also not be overlooked in the calculus promoting uniform codes. As one commentator explained,

. . . it is difficult to imagine an area of creative endeavor in which the copyright incentive is needed less. Trade organizations have powerful reasons stemming from industry standardization, quality control, and self-regulation to produce these model codes; it is unlikely that, without copyright, they will cease producing them.

1 Goldstein § 2.5.2, at 2:51.

[50] Third, to enhance the market value of its model codes, SBCCI could easily publish them as do the compilers of statutes and judicial opinions, with "value-added" in the form of commentary, questions and answers, lists of adopting jurisdictions and other information valuable to a reader. The organization could also charge fees for the massive amount of interpretive information about the codes that it doles out. In

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short, we are unpersuaded that the removal of copyright protection from model codes only when and to
the extent they are enacted into law disserves "the Progress of Science and useful Arts." U.S. Const. art. I.
§ 8, cl. 8.

Conclusion

[51] For the reasons discussed above, we REVERSE the district court's judgment against Peter Veeck,
and REMAND with instructions to dismiss SBCCI's claims.

1. The facts stated here are undisputed.

2. We review the district court's grant of summary judgment de novo. Morris v. Covan World Wide Moving, Inc.,
144 F.3d 377, 380 (5th Cir. 1998); Fed. R. Civ. P. 56(c). At the summary judgment stage, a court may not weigh the
evidence or evaluate the credibility of witnesses, and all justifiable inferences will be made in the nonmoving party's
favor. Id. (citing Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 255, 106 S.Ct. 2505, 2513-14 (1986)). The district
court drew some inferences from the facts, however, regarding the impact of copyrightability on SBCCI's operations
that, if material, should not have been decided without a trial. We find it unnecessary to reach those issues.

3. See Precis of Argument by Counsel for Wheaton [pet'r], 33 U.S. (8 Pet.) at 615. Wheaton acknowledged, even
while arguing that judicial opinions could be copyrighted, that "it would be absurd, for a legislature to claim the
copyright; and no one else can do it, for they are the authors, and cause them to be published without
copyright. . . . Statutes were never copyrighted." Id. Further, "it is the bounden duty of government to promulgate
its statutes in print . . .." Id. at 616.

Counsel for Peters, the respondent, emphasized the governing policy that "all countries . . . subject to the
sovereignty of the laws" hold the promulgation of the laws, from whatever source, "as essential as their existence." 
Id. at 618-19. Peters's brief continues:

It is, therefore, the true policy, influend by the essential spirit of the government, that laws of every description
should be universally diffused. To fetter or restrain their dissemination, must be to counteract this policy; to limit, or
even to regulate it, would, in fact, produce the same effect.

. . .

If either statutes or decisions could be made private property, it would be in the power of an individual to shut out
the light by which we guide our actions.

Id. at 620.

4. In Davidson v. Wheelock, for example, the court stated that a compiler of state statutes "could obtain no copyright
for the publication of the laws only; neither could the legislature confer any such exclusive privilege upon him."
injunction sought for the compiler of Michigan statutes, holding that "no one can obtain the exclusive right to


6. The amici supporting SBCCI's position include Building Officials and Code Administrators International
(BOCA), International Code Council, International Conference of Building Officials, American Medical
Association, American National Standards Institute (ANSI), American Society of Association Executives (ASAE),
American Society of Heating, Refrigerating and Air-Conditioning Engineers (ASHRAE), American Society of
Mechanical Engineers (ASME), National Fire Protection Association (NFPA), Texas Municipal League, and
Underwriters Laboratories, Inc. (UL).

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7. *Practice Management* declares, "The copyright system's goal of promoting the arts and sciences by granting temporary monopolies to copyright holders was not at stake in *Banks* because judges' salaries provided adequate incentive to write opinions." *Id.*

8. If there were an independent holding in *Banks* relying on the fact that judges are paid by the public, it was rejected by the Court itself one month later, when the Court ruled that a court reporter, notwithstanding that he was a state employee, could assert copyright in all of his compilation of judicial opinions except the opinions themselves. *Callaghan v. Myers*, 128 U.S. 645, 9 S.Ct. 617 (1888).

9. One of SBCCI's amici argues that this is an unrealistic threat, since, *inter alia*, the run-of-the-mill lobbyist or good citizen involved in the legislative process does not assert a copyright. That these "authors" may be more generous, or less sophisticated, than the large and well-funded code-writing organizations before us hardly furnishes a reason to approve an open-ended test of authorship of the law.

10. We are not stating or holding that the authorship of government works never presents a legitimate issue of copyright. On the contrary, the Copyright Act carefully defines the extent to which federal government employees and contractors can obtain copyright protection. But these provisions have never been held to supersede *Banks*' holding that "the law" is in the public domain.

11. Technically, citizen "ownership" of the law might suggest that local governmental entities, as public representatives, could prevent copying of the law. As Goldstein notes, the decisions holding that statutes are in the public domain prevent any such misunderstanding. 1 Goldstein, Copyright, § 2.48 at n.42.

12. SBCCI does not permit governmental entities to publish its model codes when they are enacted. Instead, it permits their adoption by reference and furnishes a copy of the adopted code to the entity. SBCCI also generously allows that if a governmental entity were to publish the building code on an Internet site to meet its due process obligation, that would be a fair use. But when the North Carolina Building Officials were permitted to publish a model code on their non-public access website, SBCCI expressly reserved its rights.

13. What constitutes "the law" when a governmental entity adopts or incorporates by reference an author's copyrightable work will be considered *infra*, Part III.

14. Our decision might well be the opposite, if Veeck had copied the model codes as model codes, or if he had indiscriminately mingled those portions of "the law" of Anna and Savoy adopted by their town councils with other parts of the model codes not so adopted.

15. *See id.* at 1460 (proposed route for a pipeline approved by the Federal Energy Regulatory Commission was an uncopyrightable "idea.")

16. For the first time, in this court, SBCCI alleges that Veeck did not exactly copy the ordinances, because in the course of their adoption, the towns rejected certain parts of the SBCCI model codes. There is no evidence in the district court record to sustain this contention.

17. Veeck also raised infringement defenses based on his fair use of the model codes or SBCCI's waiver of its copyrights. It is unnecessary to reach these issues.

18. *See also Texas v. West Publishing Co.*, 882 F.2d 171, 174, 177 (5th Cir. 1989), in which the State of Texas sought a declaratory judgment that West's copyright in their original arrangement of annotated Texas statutes was invalid. This court rejected the state's argument and observed in passing that West did not claim a copyright in the text of the statutes themselves or in any of the readily-available public compilations of statutes.

19. BOCA is an *amicus curiae* in this case supporting SBCCI's position.

21. SBCCI's factual "evidence" on this point consisted of self-serving affidavits from its officers and employees, and proof that it earns perhaps 40% of its revenue from sales of the domestic model codes and amendments. No effort was made to show by what amount copying by people like Veeck would or could reduce the organization's revenue.

22. This court's opinion does not, of course, withdraw all copyright protection from the model codes qua model codes.

WIENER, Circuit Judge, joined by KING, Chief Judge, and HIGGINBOTHAM, DAVIS, STEWART, and DENNIS, Circuit Judges, dissenting:

[52] Technical codes and standards have become necessary, pervasive, and indispensable ingredients of Twenty-First Century life in this country; regrettably, today's majority opinion has a real potential of drastically changing the societal landscape through that opinion's predictably deleterious effects on these codes and standards, their authors, and the public and private entities that daily use and depend on them. Despite efforts to clothe its ruling in classic copyright lingo ---- "public domain," "fact/expression," "merger" ---- in holding for Veeck under the discrete facts of this case, the majority had to (and did) adopt a *per se* rule that a single municipality's enactment of a copyrighted model code into law by reference strips the work of all copyright protection, *ipso facto*. Firmly believing that for this court to be the first federal appellate court to go that far is imprudent, I respectfully dissent.

I. FACTS AND PROCEEDINGS

[53] As the underlying facts are undisputed, I adopt the majority opinion's detailed recitation of the facts, supplementing it with the following observations contained in the record. The technical codes here at issue are not mere compilations; rather they are original, "from scratch" creations by SBCCI which rightfully enjoy copyright protection from their inceptions. In each of its codes, SBCCI asserts a copyright under which it claims the exclusive right to publish these codes or license their reproduction and publication. Despite its copyright, SBCCI ensures free access by specifying that once a governmental unit enacts such a model code into law, copies must be made available for inspection by the public in the enacting government's offices. As a general proposition, members of the public may make or obtain copies of portions of the adopted versions of SBCCI codes from city offices or local libraries, or may purchase copies of the codes directly from SBCCI and from some third-party sources, such as bookstores.

[54] Several municipalities in North Texas have adopted SBCCI's codes, including the towns of Anna and Savoy. Veeck avers that he attempted to obtain a copy of the building code of his hometown of Denison, Texas, after learning that it had adopted SBCCI's Model Building Code as its own. Failing to locate Denison's building code at local bookstores or libraries, Veeck ordered copies of the codes that SBCCI had produced. He ordered these copies in electronic format directly from SBCCI. According to Veeck, he later visited approximately twenty towns in North Texas, including Anna and Savoy, in an effort to obtain copies of their local building codes, not all of which had been produced by SBCCI. Veeck was not able to buy complete copies at any of the towns that he visited. He apparently never attempted to view or copy the SBCCI codes in any city clerk's or other municipal offices of the towns that had enacted the codes by reference.

[55] In contravention of the software license agreement and copyright notice included with the electronic version of the model codes he purchased from SBCCI, Veeck failed to identify the codes as the products of SBCCI when he posted them on his website. Instead, he simply (and inaccurately) identified them as the building codes of Anna and Savoy, Texas. As detailed in the majority opinion, the litigation ensuing from this conduct culminated with the grant of summary judgment in favor of SBCCI on its
claims for copyright infringement. As Veeck cannot legitimately find a safe haven in any of his affirmative defenses, the district court's order should have been affirmed.

* * *

III. CONCLUSION

[106] Two decades ago, in BOCA, the First Circuit wrestled with the serious issues raised by what was then only a "possible trend" toward local, state, and federal adoption of model codes. That court wisely left open for future evaluation the modern realities surrounding technical regulatory codes and standards. As the BOCA court wrote, groups that develop such works "serve an important public function; arguably they do a better job than could the state alone in seeing that complex yet essential regulations are drafted, kept up to date and made available." In like manner, the two federal circuits that subsequently addressed challenges similar to that considered by the First Circuit in BOCA have declined to invalidate copyrights in works incorporated by reference into the law. In the legislative arena, Congress has decreed the policy that federal agencies adopt privately authored technical standards without voiding the protection afforded to the authors by copyright; and the OMB has directed all federal agencies adopting such standards to respect the copyright protections of the copyright holders ---- the diametric opposite of causing copyright protection to vanish when the work is adopted as law.

[107] I emphasize that my analysis is restricted to the narrow set of facts and circumstances before us. At bottom, I think it improvident for this court to legislate judicially an absolute, per se rule that referential enactment of a copyrighted work like a technical code into law mystically metamorphoses it into an "idea," puts it into the public domain, waives its copyright protection universally, and otherwise strips it of copyright protection vel non. Under the instant circumstances, no one is being denied reasonable access to the SBCCI codes that have been adopted in globo by local governments; neither does Veeck's specific actions, however altruistic they might have been, make a viable case for fair use. Nevertheless, I readily concede, that even slightly different facts under but slightly different circumstances could convince me to support a different result, albeit not a per se rule.

[108] Today, the trend toward adoption of privately promulgated codes is widespread and growing, and the social benefit from this trend cannot be seriously questioned. The necessary balancing of the countervailing policy concerns presented by this case should have led us to hold that, on these facts, the copyright protection of SBCCI's privately authored model codes did not simply evanescipso facto, when the codes were adopted by local governments; rather, they remain enforceable, even as to non-commercial copying, as long as the citizenry has reasonable access to such publications cum law ---- and subject, of course, to exceptions for implied or express waiver or consent, fair use, or other recognized exceptions, when applicable. For these reasons, I cannot join in the majority's inflexible reasoning and unnecessarily overbroad holding. I therefore respectfully dissent.

23. As noted by the majority members and nonmembers are charged different prices for copies of the codes. For example, members were charged $48 for a copy of SBCCI's 1994 Standard Building Code, for which nonmembers were charged $72.

24. The record is not completely clear, but it appears that Veeck made no attempt to view or copy the codes in the Denison city clerk's office. When Veeck received the 1994 codes from SBCCI, he realized that Denison had adopted the 1988 version of the building codes. He posted the 1994 codes on his Internet site despite the fact that they were not the same as the version adopted by Denison.
25. It appears that in some of the cities, the correct version of the building code was not available at alternative locations. For instance, Sherman, Texas, had adopted the 1997 version of the building code, but the local library had only the 1994 version on hand.

26. Veeck did not include the enacting ordinances of either municipality. Anna's enacting statute, for example, includes ordinances resolving conflicts between the adopted SBCCI code and previous city laws and also includes a clarification regarding which city officials would be responsible for enforcing different sections of the code.

* * *
[1] INTRODUCTION

Plaintiff Mitel, Inc. ("Mitel") appeals the denial of its motion for a preliminary injunction in this action for copyright infringement. 17 U.S.C. § 502(a). At issue is the protectability of a set of four-digit numeric instructions known as "command codes." Mitel created these command codes to access the features of a piece of telecommunications hardware known as a call controller.

Mitel contends that the district court erred in denying its motion for a preliminary injunction based upon the court's conclusion that Mitel failed to demonstrate a substantial likelihood that it will prevail on the merits of its claim. See Mitel, Inc. v. Iqtel, Inc., 896 F. Supp. 1050, 1054 (D. Colo. 1995). Specifically, Mitel argues that the district court erred by concluding that (1) Mitel's command codes are unprotectable under 17 U.S.C. § 102(b) because they are a "procedure process, system, [or] method of operation"; (2) Mitel's command codes are unprotectable under the scenes a faire doctrine; and (3) Iqtel's use of the command codes is a fair use under the Copyright Act, 17 U.S.C. § 107. We exercise jurisdiction pursuant to 28 U.S.C. § 1292(a)(1) and affirm.

[4] BACKGROUND

Mitel and Iqtel manufacture competing call controllers. A call controller is a piece of computer hardware that enhances the utility of a telephone system by automating the selection of a particular long distance carrier and activating optional features such as speed dialing. Typically, a long distance carrier purchases a call controller from a manufacturer like Mitel or Iqtel and installs it on the premises of its business customer to automate that customer's access to the carrier's long distance service.

I. Mitel's Call Controller and Command Codes

Mitel began manufacturing the Smart-1 call controller for sale in 1985. In order to activate and manipulate the features of its call controller, Mitel devised an instruction set of over sixty four-digit numeric command codes. Mitel published and copyrighted manuals describing how to program its call controller by using these command codes.

A technician activates features of a call controller by dialing the four-digit command code for a particular controller function on a touch-tone telephone or a computer keyboard connected to the call controller. The numeric value of each digit of a command code is generally limited to the keys on a telephone keypad, i.e., 0-9, *, and #.

Each command code may be broken down into separate parts, the names and particular definitions of which are important to our analysis. The first three digits of a command code are known together as the

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"register." For most of Mitel's codes, two digits of each three-digit register arbitrarily identify the particular function selected. A third digit may identify the particular telephone line to be accessed or the preprogrammed "route" that a call will take through the public telephone network to its destination. Mitel numbers telephone lines and routes sequentially. For example, the register "X27" identifies the function "Time to Auto Answer." By activating this function a technician may specify the period of time the controller waits before answering an incoming call after it detects ringing. The "X" indicates the number of the telephone line for which the feature will be activated, 1-4 or 5 for all lines. Were a technician to enter 427, the controller would understand that the technician wished to set the period of time to wait before answering calls ringing on line four.

Mitel's other registers identify features that do not apply to particular lines or routes. The functions accessed by this latter group are identified by a leading "0" followed by two arbitrary digits that represent the function to be accessed. For example, 006 stands for "RS-232 Baud Rate." Were a technician to enter 006, the controller would understand that the technician wished to set the speed at which the controller was to communicate with other pieces of computer equipment, a printer for example.

The first digit of a register that is not a line number or a route number often represents a particular group of similar functions, e.g., a first digit of "9" indicates a group of special programming functions. Mitel admits that it arbitrarily selected the particular digit that represents each group of functions.

The final digit of Mitel's command codes is known as the "description." The description is a number or symbol (usually 0 through 9, *, or #) that represents a particular setting within each function. The various possible settings for each controller function are referred to as "values." Thus, for each function, a "value" is assigned to each digit in the range of possible "descriptions." For example, the possible descriptions and accompanying values for the function 006 (RS-232 Baud Rate) described above are:

<table>
<thead>
<tr>
<th>Description</th>
<th>Value</th>
</tr>
</thead>
<tbody>
<tr>
<td>1</td>
<td>110 baud</td>
</tr>
<tr>
<td>2</td>
<td>300 baud</td>
</tr>
<tr>
<td>3</td>
<td>600 baud</td>
</tr>
<tr>
<td>4</td>
<td>1200 baud</td>
</tr>
<tr>
<td>5</td>
<td>2400 baud</td>
</tr>
<tr>
<td>6</td>
<td>4800 baud</td>
</tr>
<tr>
<td>7</td>
<td>9600 baud</td>
</tr>
</tbody>
</table>

Therefore, in order to set the RS-232 Baud Rate at 4800 baud, a technician would press the digits 0066 into a touch-tone telephone keypad. The combination of values and descriptions vary in nature and degree from function to function. Thus, the description "4" stands for the value of "1200 baud" for function 006, but stands for the value of "40 seconds" for the X27 (Time to Auto-Answer) function.

III. Iqtel's Call Controller, Command Codes, and Copying

Iqtel began manufacturing the IQ200+ call controller for sale in 1994. Iqtel devised an instruction set of command codes to activate the features of its call controller. Although the Iqtel and Mitel call controllers provide many of the same features, to identify features of its controller, Iqtel selected
"registers" that were different from Mitel's "registers." Iqtel used identical "descriptions" and "values" where the functions of the IQ200+ were the same as Mitel's Smart-1 controller.

[16] Because Mitel controlled a large share of the call controller market, Iqtel concluded that it could compete with Mitel only if its IQ200+ controller were compatible with Mitel's controller. Iqtel reasoned that technicians who install call controllers would be unwilling to learn Iqtel's new set of instructions in addition to the Mitel command code set, and the technicians' employers would be unwilling to bear the cost of additional training. In addition to its own set of command codes, therefore, Iqtel designed the IQ200+ controller to accept Mitel command codes.

[17] In order to produce a call controller compatible with Mitel's controller, Iqtel copied Mitel's command codes in three important respects. First, Iqtel programmed the IQ200+ to accept Mitel command codes and translate them to the corresponding Iqtel command code. Iqtel named this feature the "Mitel Translation Mode." Second, Iqtel facilitated technicians' use of this mode by publishing an appendix to its manual that listed and cross-referenced Mitel and Iqtel command codes. Third, in its own command codes, Iqtel copied Mitel's "values" and the "descriptions" assigned to them for the call controllers' common functions.\[n3\]

[18] Iqtel's IQ200+ proved to be highly competitive with Mitel's Smart-1 call controller. Mitel commenced this copyright infringement action on April 25, 1995. Mitel sought a preliminary injunction and the court heard three days of evidence on the matter. On August 23, 1995, the district court issued its decision denying Mitel's motion for a preliminary injunction because Mitel failed to demonstrate a substantial likelihood that it will prevail on the merits of its claim. Mitel, Inc., 896 F. Supp. 1050.

[19] Resting its decision on several grounds, the court found that Mitel's command codes are not copyrightable subject matter because they constitute a method of operation under 17 U.S.C. § 102(b), they are unoriginal under 17 U.S.C. § 102(a), and they are dictated by external factors and unprotectable under the scenes a faire doctrine. Id. at 1054-56. In addition, the court concluded that if the command codes were protectable, Iqtel's copying was a fair use of Mitel's codes. Id. at 1056. Mitel now appeals these determinations.

[20] DISCUSSION

[21] A plaintiff seeking a preliminary injunction must establish that (1) it has a substantial likelihood of prevailing on the merits, (2) it will suffer irreparable injury unless the injunction issues, (3) its threatened injury outweighs the injury caused by the injunction, and (4) an injunction would not be adverse to the public interest. Country Kids 'n' City Slicks, Inc. v. Sheen, 77 F.3d 1280, 1283 (10th Cir. 1996). We review the denial of a preliminary injunction to determine whether the district court "'abuse[d] its discretion, commit[ted] an error of law, or [wa]s clearly erroneous in its preliminary factual findings.'" Country Kids, 77 F.3d at 1283 (quoting Autoskill Inc. v. National Educational Support Systems, Inc., 994 F.2d 1476, 1487 (10th Cir. 1993)) (alterations in original).

[22] In order to establish copyright infringement plaintiff must prove (1) that it owns a valid copyright, and (2) that the defendant copied protectable elements of the copyrighted work. Feist Publications Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 361 (1991); Country Kids, 77 F.3d at 1284. As to the first element, Iqtel does not appeal the district court's determination that Mitel owns a valid copyright in the disputed work.

[23] The second element requires us to consider two distinct issues. First we must determine whether, as a factual matter, the defendant copied plaintiff's work. Country Kids, 77 F.3d at 1284. Second, as a mixed question of law and fact, we must evaluate whether the elements copied by the defendant are protected by copyright. Id. As to the first issue, Iqtel admits that it copied virtually the entire set of Mitel
command codes when it created its command set and the Mitel Translation Mode for the IQ200+ call controller. In addition, Iqtel undisputedly published the codes as part of the Mitel-to-Iqtel code translation tables in IQ200+ installation manuals.

[24] Thus, the appeal before us requires us to evaluate whether Mitel is substantially likely to prove that the command codes copied by Iqtel are protected by copyright. If we conclude that the codes are protectable expression, we must then consider whether Iqtel's copying constitutes a fair use of the command codes under 17 U.S.C. § 107. Before analyzing whether the command codes are protectable, however, we must address the appropriate framework for our analysis.


[26] "Copyright protection subsists . . . in original works of authorship fixed in any tangible medium of expression . . . from which they can be perceived, reproduced, or otherwise communicated." 17 U.S.C. § 102(a). Section 102(b) limits the scope of copyright protection by providing that "[i]n no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, [or] method of operation . . . regardless of the form in which it is described, explained, illustrated, or embodied." 17 U.S.C. § 102(b).

[27] Section 102(b) codifies one of copyright law's fundamental distinctions-copyright protection extends to an "author's original expression and not to the ideas embodied in that expression." Gates Rubber Co. v. Bando Chem. Indus., Ltd., 9 F.3d 823, 836 (10th Cir. 1993). Thus, when considering whether a defendant copied protectable elements of a copyrighted work, we must determine whether or to what extent the copied portions constitute ideas, processes, systems, or methods of operation, on one hand, or protectable expression, on the other. The district court relied alternatively on two means of separating Mitel's idea from expression: a literal application of 102(b) and the abstraction-filtration-comparison test.

[28] In recent opinions this court has relied increasingly upon the conceptual framework known as abstraction-filtration-comparison to aid in separating idea from expression and identifying protectable expression. We utilize this approach as follows:

First, in order to provide a framework for analysis, . . . a court should dissect the [work] according to its varying levels of generality as provided in the abstractions test.\[n5] Second, poised with this framework, the court should examine each level of abstraction in order to filter out those elements of the [work] which are unprotectable. Filtration should eliminate from comparison the unprotectable elements of ideas, processes, facts, public domain information, merger material, scenes a faire material, and other unprotectable elements suggested by the particular facts of the program under examination. Third, the court should then compare the remaining protectable elements with the allegedly infringing [work] to determine whether the defendants have misappropriated substantial elements of the plaintiff's [work].

[29] Gates, 9 F.3d at 834 (footnote added). Although abstraction-filtration-comparison analysis is particularly useful in cases involving copyright in computer programs, we recently noted that the approach merits application in cases that extend well beyond that narrow context. Country Kids, 77 F.3d at 1284 n. 5.

[30] As its initial basis for finding Mitel's command codes unprotectable, the district court applied the literal language of section 102(b) and concluded that Mitel's set of command codes is an unprotected method of operation or "a method for achieving a particular result." Gates Rubber, 9 F.3d at 836 n. 13. The court based its conclusion upon the finding that Mitel's command codes comprise the method by which a long distance carrier matches the call controller's functions, the carrier's technical demands, and the telephone customer's choices.
The First Circuit reached a similar conclusion in Lotus Development Corp. v. Borland Int'l, Inc., 49 F.3d 807 (1st Cir. 1995), aff'd without opinion by an evenly divided Court, 116 S.Ct. 804 (1996). Lotus concerned whether the commands and the menu trees in which the commands were organized in the spreadsheet program Lotus 1-2-3 constituted copyrightable subject matter. Id. at 809. The Lotus court defined "method of operation":

We think that "method of operation" as that term is used in § 102(b) refers to the means by which a person operates something, whether it be a car, a food processor, or a computer.

Lotus, 49 F.3d at 815.

Based upon this definition, the First Circuit concluded that the "menu command hierarchy" was not protected by copyright because the hierarchy and its components constituted a "method of operation" unprotectable under 17 U.S.C. § 102(b). Id. The Lotus court concluded that the question whether a work is excluded from protection under section 102(b) logically precedes consideration of whether the individual components of the work are "expressive." Id. Most significantly, the Lotus court held that otherwise protectable expression that is embodied in a method of operation is excluded under section 102(b) from copyright protection because it is part of the method of operation:

Under the district court's reasoning, Lotus's decision to employ hierarchically arranged command terms to operate its program could not foreclose its competitors from also employing hierarchically arranged command terms to operate their programs, but it did foreclose them from employing the specific command terms and arrangement that Lotus had used. In effect, the district court limited Lotus 1-2-3's "method of operation" to an abstraction.

We . . . hold that [the] expression [in Lotus's expressive choices in choosing and arranging command terms] is not copyrightable because it is part of Lotus 1-2-3's "method of operation." We do not think that "methods of operation" are limited to abstractions; rather, they are the means by which a user operates something. If specific words are essential to operating something, then they are part of a "method of operation" and, as such, are unprotectable.

Lotus, 49 F.3d at 816.

We conclude that although an element of a work may be characterized as a method of operation, that element may nevertheless contain expression that is eligible for copyright protection. Section 102(b) does not extinguish the protection accorded a particular expression of an idea merely because that expression is embodied in a method of operation at a higher level of abstraction. Rather, sections 102(a) & (b) interact to secure ideas for public domain and to set apart an author's particular expression for further scrutiny to ensure that copyright protection will "promote the . . . useful Arts." U.S. Const. art. I, § 8, cl. 8. Our abstraction-filtration-comparison approach is directed to achieving this balance. Thus, we decline to adopt the Lotus court's approach to section 102(b), and continue to adhere to our abstraction-filtration-comparison approach. See Gates Rubber, 9 F.3d at 843 (noting the applicability of abstraction-filtration-comparison to "menus and sorting criteria"); Autoskill, 994 F.2d at 1493, 1495 n. 23 (stating that "more than literal application of § 102(b) is required") (citing Toro Co. v. R & R Prods. Co., 787 F.2d 1208, 1211-12 (8th Cir. 1986)).

We are mindful of the concern expressed by the Lotus court that, by its very nature, the abstraction-filtration-comparison approach tends to produce a core of copyrightable protectable expression that, if literally copied, would make the copier liable for infringement. Lotus, 49 F.3d at 815. Undoubtedly, the portions of a work to which a court applies abstraction analysis frequently contain a level of abstraction which reveals expression that does not fall within the excluded categories of section 102(b). Although this core of expression is eligible for copyright protection, it is subject to the rigors of filtration analysis which
excludes from protection expression that is in the public domain, otherwise unoriginal, or subject to the
doctrines of merger and scenes a faire.

[37] Notwithstanding our endorsement of abstraction-filtration-comparison analysis, we emphasize that
the approach is valuable only insofar as it aids the court in distinguishing protectable elements of a work
from those that are unprotectable. Not every case requires an extensive abstraction-filtration-comparison
analysis. Rather, "the appropriate test to be applied and the order in which its various components are to
be applied . . . may vary depending upon the claims involved, the procedural posture of the suit, and the
nature of the [works] at issue." Gates Rubber Co., 9 F.3d at 834 n. 12.

[38] Where, as here, the alleged infringement constitutes the admitted literal copying of a discrete, easily-
conceptualized portion of a work, we need not perform complete abstraction-filtration-comparison
analysis. Mitel does not claim copyright in the names of the functions that are accessed by its command
codes or in the idea of using four-digit numeric codes to manipulate the functions of a call controller.
Rather, Mitel contends that copyright protection extends only to its selection of particular four-digit
numbers that activate and manipulate the functions of the Smart-1 call controller and to the particular
"values" assigned to the "description" digit of Mitel's codes. Thus, we may proceed directly to the
protectability analysis that is normally subsumed in the filtration portion of the abstraction-filtration-
comparison approach.

[39] II. Protectability Analysis

[40] The district court concluded that Mitel's command codes contain no protectable expression because
the expression in the command codes lacks requisite originality and is not entitled to protection against
infringement under the scenes a faire doctrine. We agree with the district court that Mitel's command
codes are largely unoriginal. Further, to the extent that the codes contain original expression, that
expression is excluded from protection under the scenes a faire doctrine.

[41] A. Originality

[42] Copyright inheres only in original works of authorship. 17 U.S.C. § 102(a); Feist Publications, 499
U.S. at 345; Gates Rubber, 9 F.3d at 837. "Original, as the term is used in copyright, means only that the
work was independently created by the author . . . and that it possesses at least some minimal degree of
creativity." Feist Publications, 499 U.S. at 345. Although originality is not a "stringent" requirement,
"[t]here remains a narrow category of works in which the creative spark is utterly lacking or so trivial as
to be virtually non-existent." Id. at 359.

[43] Even though the district court discussed originality under section 102(a) and method of operation
under section 102(b) together, the court clearly found that Mitel's command codes lack originality. The
district court stated that "the numbers constituting the command codes were arbitrarily chosen and
Co., 787 F.2d 1208, the court concluded that such arbitrariness was insufficient to sustain a finding of
originality.

[44] In Toro the Eighth Circuit rejected the copyrightability of a lawn tractor manufacturer's numbering
of replacement parts because the numbers were insufficiently original. Id. at 1213. When the
manufacturer created each part, it assigned the part an arbitrary identifying number. Id. The court held
that the arbitrary assignment of numbers to parts lacked any creativity or variation by which one could
distinguish authorship. Id. Like the Toro court, the district court in this case concluded that Mitel used
such minimal effort and judgment to select the "registers" and "descriptions" that they are unoriginal
under section 102(a). We agree.
Mitel's arbitrary selection of a combination of three or four numbers required de minimis creative effort. Mitel's own witnesses testified to the arbitrariness of the command codes. Mitel's arbitrary assignment of particular numbers to particular functions and its sequential ordering in registers and descriptions "lack[] the modicum of creativity necessary to transform mere selection into copyrightable expression." Id. at 362.

Further, purely sequential elements of the codes are not original under section 102(a). The "descriptions" are strictly sequential and matched with increasing incremental "values." The concept of numbering registers and descriptions in ascending sequence is analogous to arranging telephone entries in alphabetical order. See Feist, 499 U.S. at 362-63. Both of these arrangements are obvious and insufficiently creative to constitute original expression under section 102. Id. Thus, Mitel's arbitrary assignment of particular numbers to particular functions and its sequential ordering in registers and descriptions "lack[] the modicum of creativity necessary to transform mere selection into copyrightable expression." Id. at 362.

We must also consider the originality of the remaining component of Mitel's command codes - the content of the "values" created by Mitel and assigned to its "descriptions." Mitel devised the "values" to set each function at a particular level of operation. For example, the possible "values" or settings for the function 006 (RS-232 Baud Rate) described above are 110 baud, 300 baud, 600 baud, 1200 baud, 2400 baud, 4800 baud, and 9600 baud. As another example, upon the failure of a call sent over a particular telephone network route, the technician can activate the "R58" function which tells the controller how to respond to the failure. The possible values for the function include several combinations of redialing over another route or reattempting the call over the same route again before trying another route.

Unlike the merely arbitrary or sequential registers and descriptions discussed above, Mitel's values reveal "the existence of . . . intellectual production, of thought, and conception." Feist Publications, 499 U.S. at 362 (quoting Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53, 59-60 (1884)) (omission in original). We find that the effort required of Mitel's employees to devise appropriate values for the wide variety of individual functions reflects at least the "minimal degree of creativity" to qualify as an "original" work of authorship. Autoskill, 994 F.2d at 1495 n. 23 (quoting Feist Publications, 499 U.S. at 345)). Thus, we must further evaluate whether the expression found in Mitel's values is protected from infringement or excluded from protection by the scenes a faire doctrine.

2. Scenes a Faire

The district court concluded that Mitel's command codes should be denied copyright protection under the scenes a faire doctrine because they are largely dictated by external factors such as hardware compatibility requirements and industry practices. Under the scenes a faire doctrine, expressive elements of a work of authorship are not entitled to protection against infringement if they are standard, stock, or common to a topic, or if they necessarily follow from a common theme or setting. Gates Rubber, 9 F.3d at 838; Autoskill, 994 F.2d at 1494.

Granting copyright protection to the necessary incidents of an idea would effectively afford a monopoly to the first programmer to express those ideas. Furthermore, where a particular expression is common to the treatment of a particular idea, process, or discovery, it is lacking in the originality that is the sine qua non for copyright protection.
[52] Gates Rubber, 9 F.3d at 838. For example, "[f]oot chases and the morale problems of policemen, not to mention the familiar figure of the Irish cop, are venerable and often-recurring themes of police fiction," and are unprotectable scenes a faire. Walker v. Time Life Films, Inc., 784 F.2d 44, 50 (2d Cir. 1986).

[53] We have extended this traditional copyright doctrine to exclude from protection against infringement those elements of a work that necessarily result from external factors inherent in the subject matter of the work. For computer-related applications, these external factors include hardware standards and mechanical specifications, software standards and compatibility requirements, computer manufacturer design standards, industry programming practices, and practices and demands of the industry being serviced. See Gates Rubber, 9 F.3d at 838; Computer Assocs. Int'l, Inc. v. Altai, Inc., 982 F.2d 693, 709-10 (2d Cir. 1992); Plains Cotton Coop. Assoc. v. Goodpasture Serv., Inc., 807 F.2d 1256, 1262 (5th Cir. 1987) (declining to extend protection to a computer program where the similarities between the plaintiff's and defendant's programs were dictated by "the externalities of the cotton market" and by other "market factors"); see also 4 Melville B. Nimmer & David Nimmer, Nimmer on Copyright § 13.03[F][3], at 13-130-141 (1997) [hereinafter Nimmer]. Because these factors concern functional aspects of a work, the scenes a faire doctrine plays a particularly important role in ensuring that copyright rewards and stimulates artistic creativity in a utilitarian work "in a manner that permits the free use and development of non-protectable ideas and processes" that make the work useful. Computer Assocs., 982 F.2d at 711.

[54] In its discussion of scenes a faire, the district court properly focused on the factual circumstances surrounding Mitel's selection of registers, descriptions, and values. A portion of its analysis, however, discussed whether external factors such as market forces and efficiency considerations justified Iqtel's copying of the command codes. The court's analytical focus should have remained upon the external factors that dictated Mitel's selection of registers, descriptions, and values. By excluding expression dictated by external factors from protection against infringement, copyright law secures for public use the "necessary incidents" of ideas and processes and strikes the appropriate "balance between competition and protection." Computer Assocs., 982 F.2d at 711 (quoting Apple Computer, Inc. v. Franklin Computer Corp., 714 F.2d 1240, 1253 (3d Cir. 1983)). Thus, the scenes a faire doctrine identifies and excludes from protection against infringement expression whose creation "flow[ed] naturally from considerations external to the author's creativity." Nimmer 13.03[F][3], at 13-131.

[55] Nonetheless, in this case the district court correctly found that much of the expression in Mitel's command codes was dictated by the proclivities of technicians and limited by significant hardware, compatibility, and industry requirements. In particular, the record contains substantial evidence supporting the conclusion that Mitel's values should be excluded from protection against infringement under the scenes a faire doctrine.

[56] External factors frequently dictated Mitel's selection of particular values to activate the range of call controller functions. For example, many of the values were selected by Mitel's product management department in response to customer demand or to ensure compatibility with equipment already installed in the central offices of Mitel's customers. Frequently, the values were divided in equal increments across a numerical range, and the descriptions and the value increments were matched in ascending steps. Standard programming conventions such as "1" for "on" and "0" for "off" determined some of the descriptions and values. App't App., Vol. III at 757. In addition, some of the values for the set of command codes that were actually copied were dictated by the need for compatibility with older-model Mitel call controllers or the limits on the capabilities of the controller itself. Id. Other values were dictated by the limits inherent in the public telephone networks that the call controllers accessed. For example, the vice president of Iqtel, Don Jorgenson, testified that the phone company is able to recognize touch-tone numbers only when the tone lasts 40 milliseconds or longer. Id. Thus, the minimum length of time that a technician can set a touch-tone to last using Mitel's command code X02 ("DTMF Dialing Rates") or Iqtel's command code 17L ("DTMF Tone Length") is 40 milliseconds. App't App., Vol. II at 283, 456. In sum, although Mitel's values constitute non-arbitrary original expression, they are unprotectable as scenes
a faire because they were dictated by external functionality and compatibility requirements of the computer and telecommunications industries.

[57] Consideration of Mitel's motion for a preliminary injunction did not require the district court to conduct an exacting examination and analysis of every component of every command code. Rather, the district court must determine upon the evidence before it whether the plaintiff is substantially likely to succeed on the merits of its action. The record in this case contains ample evidence that Mitel is not substantially likely to succeed on the merits. The doctrines of originality and scenes a faire render Mitel's command codes unprotected by copyright. Therefore, we need not consider whether Iqtel's copying of Mitel's command codes constituted fair use under 17 U.S.C. § 107.

[58] CONCLUSION

[59] Mitel has failed to demonstrate that its command codes contain expression that is original and goes beyond the necessary incidents of the ideas which the codes express. We therefore conclude that the district court did not abuse its discretion in denying Mitel's motion for a preliminary injunction. The decision of the district court is AFFIRMED.

1. The Honorable John C. Godbold, Senior Circuit Judge, United States Court of Appeals for the Eleventh Circuit, sitting by designation.

2. A very limited number of functions also permit the entry of a letter (e.g., C, D, E, or F) to set a function at a particular level of operation. Such entry, however, may only be accomplished by utilizing a computer keyboard and not a telephone keypad.

3. For example, Mitel's register for RS-232 Baud Rate is "006." Iqtel's register for RS-232 Baud Rate is "022." However both Mitel and Iqtel selected the same descriptions and values for this function, namely:

   1 for 110 baud
   2 for 300 baud
   3 for 600 baud
   4 for 1200 baud
   5 for 2400 baud
   6 for 4800 baud
   7 for 9600 baud

4. We use copying as a general term which includes infringement of any of a copyright holder's rights as set forth in 17 U.S.C. § 106. In pertinent part, section 106 provides:

Subject to sections 107 through 120, the owner of copyright under this title has the exclusive rights to do and to authorize any of the following: (1) to reproduce the copyrighted work in copies . . .; (2) to prepare derivative works based upon the copyrighted work; (3) to distribute copies . . . of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending . . . .
5. The abstractions test is a conceptual tool that helps the court separate idea from expression. Judge Learned Hand first enunciated the approach in *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930):

Upon any work, and especially upon a play, a great number of patterns of increasing generality will fit equally well, as more and more of the incident is left out. The last may perhaps be no more than the most general statement of what the play is about, and at times might consist only of its title; but there is a point in this series of abstractions where they are no longer protected, since otherwise the playwright could prevent the use of his 'ideas,' to which, apart from their expression, his property is never extended.

The test does not identify protectable expression, "[r]ather it is merely one tool that can be utilized to accomplish this task." *Gates*, 9 F.3d at 834.

6. Although not cited by the district court, the court discussed the applicability of *Lotus* with the parties at oral argument.

7. According to Mitel, its witnesses used the word "arbitrary" to mean that the command codes could have been written in a variety of different ways, not only the way that was chosen by Mitel's engineers. Thus, Mitel contends that the expression contained in its command codes is not subject to application of the merger doctrine. Under that doctrine, copyrightable expression is denied protection from infringement because the expression "is inseparable from or merged with the ideas, processes, or discoveries underlying the expression." *Gates Rubber*, 9 F.3d at 838 (citing *Concrete Mach. Co. v. Classic Lawn Ornaments, Inc.*, 843 F.2d 600, 606-07 (1st Cir. 1988); see *Hart v. Dan Chase Taxidermy Supply Co.* , 86 F.3d 320, 322 (2d Cir. 1996) (merger of idea and expression properly considered in the context of infringement rather than copyrightability). Mitel fails to recognize that originality is an independent requirement that is not satisfied merely because the merger doctrine is inapplicable. The district court did not apply the merger doctrine to deny Mitel's command codes protection from infringement, and we do not rely on that doctrine to reach today's holding.

8. DTMF stands for "Dual Tone Multiple Frequency" and is merely the acronym for what most of us know as "touch-tone" telephone dialing.
SATAVA v. LOWRY, 323 F.3d 805 (9th Cir. 2003)

Before: Barry G. Silverman and Ronald M. Gold, Circuit Judges, and Charles R. Weinger, [n*] Senior Circuit Judge

GOULD, Circuit Judge:

[1] In the Copyright Act, Congress sought to benefit the public by encouraging artists' creative expression. Congress carefully drew the contours of copyright protection to achieve this goal. It granted artists the exclusive right to the original expression in their works, thereby giving them a financial incentive to create works to enrich our culture. But it denied artists the exclusive right to ideas and standard elements in their works, thereby preventing them from monopolizing what rightfully belongs to the public. In this case, we must locate the faint line between unprotected idea and original expression in the context of realistic animal sculpture. We must decide whether an artist's lifelike glass-in-glass sculptures of jellyfish are protectable by copyright. Because we conclude that the sculptures are composed of unprotectable ideas and standard elements, and also that the combination of those unprotectable elements is unprotectable, we reverse the judgment of the district court.

I

[2] Plaintiff Richard Satava is a glass artist from California. In the late 1980s, Satava was inspired by the jellyfish display at an aquarium. He began experimenting with jellyfish sculptures in the glass-in-glass medium and, in 1990, began selling glass-in-glass jellyfish sculptures. The sculptures sold well, and Satava made more of them. By 2002, Satava was designing and creating about three hundred jellyfish sculptures each month. Satava's sculptures are sold in galleries and gift shops in forty states, and they sell for hundreds or thousands of dollars, depending on size. Satava has registered several of his works with the Register of Copyrights.

[3] Satava describes his sculptures as "vertically oriented, colorful, fanciful jellyfish with tendril-like tentacles and a rounded bell encased in an outer layer of rounded clear glass that is bulbous at the top and tapering toward the bottom to form roughly a bullet shape, with the jellyfish portion of the sculpture filling almost the entire volume of the outer, clear-glass shroud." Satava's jellyfish appear lifelike. They resemble the pelagia colorata that live in the Pacific Ocean:
During the 1990s, defendant Christopher Lowry, a glass artist from Hawaii, also began making glass-in-glass jellyfish sculptures. Lowry's sculptures look like Satava's, and many people confuse them.
[5] In Hawaii, Satava's sculptures have appeared in tourist brochures and art magazines. The sculptures are sold in sixteen galleries and gift shops, and they appear in many store windows. Lowry admits he saw a picture of Satava's jellyfish sculptures in American Craft magazine in 1996. And he admits he examined a Satava jellyfish sculpture that a customer brought him for repair in 1997.

[7] Glass-in-glass sculpture is a centuries-old art form that consists of a glass sculpture inside a second glass layer, commonly called the shroud. The artist creates an inner glass sculpture and then dips it into molten glass, encasing it in a solid outer glass shroud. The shroud is malleable before it cools, and the artist can manipulate it into any shape he or she desires.

[8] Satava filed suit against Lowry accusing him of copyright infringement. Satava requested, and the district court granted, a preliminary injunction, enjoining Lowry from making sculptures that resemble Satava's. Lowry appealed to us.

II

[9] A preliminary injunction must be affirmed on appeal unless the district court (1) abused its discretion or (2) based its decision on an erroneous legal standard or on clearly erroneous findings of fact. United States v. Peninsula Communications, Inc., 287 F.3d 832, 839 (9th Cir. 2002). We hold that the district court based its decision on an erroneous legal standard, so we reverse.

[10] Copyright protection is available for "original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device." 17 U.S.C. § 102(a). Copyright
Any copyrighted expression must be "original." *Feist Publs., Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991). Although the amount of creative input by the author required to meet the originality standard is low, it is not negligible. *See Feist*, 499 U.S. at 362. There must be something more than a "merely trivial" variation, something recognizably the artist's own. *Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 489 (9th Cir. 2000).

The originality requirement mandates that objective "facts" and ideas are not copyrightable. *Baker v. Selden*, 101 U.S. (11 Otto) 99 (1879); *Feist*, 499 U.S. at 347; *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106, 1109-10 (9th Cir. 1970). Similarly, expressions that are standard, stock, or common to a particular subject matter or medium are not protectable under copyright law. \[\text{n3}\] *See v. Durang*, 711 F.2d 141, 143 (9th Cir. 1983).

It follows from these principles that no copyright protection may be afforded to the idea of producing a glass-in-glass jellyfish sculpture or to elements of expression that naturally follow from the idea of such a sculpture. *See Aliotti v. R. Dakin & Co.*, 831 F.2d 898, 901 (9th Cir. 1987) ("No copyright protection may be afforded to the idea of producing stuffed dinosaur toys or to elements of expression that necessarily follow from the idea of such dolls."). Satava may not prevent others from copying aspects of his sculptures resulting from either jellyfish physiology or from their depiction in the glass-in-glass medium. *See id.* ("Appellants therefore may place no reliance upon any similarity in expression resulting from either the physiognomy of dinosaurs or from the nature of stuffed animals.").

Satava may not prevent others from depicting jellyfish with tendril-like tentacles or rounded bells, because many jellyfish possess those body parts. He may not prevent others from depicting jellyfish in bright colors, because many jellyfish are brightly colored. He may not prevent others from depicting jellyfish swimming vertically, because jellyfish swim vertically in nature and often are depicted swimming vertically. \[\text{n4}\] *See id.* at 901 n.1 (noting that a Tyrannosaurus stuffed animal's open mouth was not an element protected by copyright because Tyrannosaurus "was a carnivore and is commonly pictured with its mouth open").

Satava may not prevent others from depicting jellyfish within a clear outer layer of glass, because clear glass is the most appropriate setting for an aquatic animal. *See id.* (noting that a Pterodactyl stuffed animal's depiction as a mobile hanging from the ceiling was not protectable because Pterodactyl "was a winged creature and thus is appropriate for such treatment"). He may not prevent others from depicting jellyfish "almost filling the entire volume" of the outer glass shroud, because such proportion is standard in glass-in-glass sculpture. And he may not prevent others from tapering the shape of their shrouds, because that shape is standard in glass-in-glass sculpture.

Satava's glass-in-glass jellyfish sculptures, though beautiful, combine several unprotectable ideas and standard elements. These elements are part of the public domain. They are the common property of all, and Satava may not use copyright law to seize them for his exclusive use.

It is true, of course, that a combination of unprotectable elements may qualify for copyright protection. *Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1446 (9th Cir. 1994); *United States v. Hamilton*, 583 F.2d 448, 451 (9th Cir. 1978) (Kennedy, J.) ("[O]riginality may be found in taking the commonplace and making it into a new combination or arrangement."). *See also Metcalf*, 294 F.3d at 1074 ("The particular sequence in which an author strings a significant number of unprotectable elements can itself be a protectable element. Each note in a scale, for example, is not protectable, but a pattern of notes in a tune may earn copyright protection."). But it is not true that any combination of unprotectable elements automatically qualifies for copyright protection. Our case law suggests, and we hold today, that

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a combination of unprotectable elements is eligible for copyright protection only if those elements are numerous enough and their selection and arrangement original enough that their combination constitutes an original work of authorship. See Metcalf, 294 F.3d at 1074; Apple Computer, Inc., 35 F.3d at 1446. See also Feist, 499 U.S. at 358 ("[T]he principal focus should be on whether the selection, coordination, and arrangement are sufficiently original to merit protection.").

[18] The combination of unprotectable elements in Satava's sculpture falls short of this standard. The selection of the clear glass, oblong shroud, bright colors, proportion, vertical orientation, and stereotyped jellyfish form, considered together, lacks the quantum of originality needed to merit copyright protection. See Hamilton, 583 F.2d at 451 ("Trivial elements of compilation and arrangement, of course, are not copyrightable because they fall below the threshold of originality."). These elements are so commonplace in glass-in-glass sculpture and so typical of jellyfish physiology that to recognize copyright protection in their combination effectively would give Satava a monopoly on lifelike glass-in-glass sculptures of single jellyfish with vertical tentacles. See Feist, 499 U.S. at 363 (noting that the selection, coordination, and arrangement of phone numbers in a directory "is not only unoriginal, it is practically inevitable"). Because the quantum of originality Satava added in combining these standard and stereotyped elements must be considered "trivial" under our case law, Satava cannot prevent other artists from combining them.\[n5]\[2] We do not mean to suggest that Satava has added nothing copyrightable to his jellyfish sculptures. He has made some copyrightable contributions: the distinctive curls of particular tendrils; the arrangement of certain hues; the unique shape of jellyfishes' bells. To the extent that these and other artistic choices were not governed by jellyfish physiology or the glass-in-glass medium, they are original elements that Satava theoretically may protect through copyright law. Satava's copyright on these original elements (or their combination) is "thin," however, comprising no more than his original contribution to ideas already in the public domain. Stated another way, Satava may prevent others from copying the original features he contributed, but he may not prevent others from copying elements of expression that nature displays for all observers, or that the glass-in-glass medium suggests to all sculptors. Satava possesses a thin copyright that protects against only virtually identical copying. See Ets-Hokin, ___ F.3d at ___ (9th Cir. 2003) ("When we apply the limiting doctrines, subtracting the unoriginal elements, Ets-Hokin is left with . . . a 'thin' copyright, which protects against only virtually identical copying."); Apple, 35 F.3d at 1439 ("When the range of protectable expression is narrow, the appropriate standard for illicit copying is virtual identity.").

[19] We do not hold that realistic depictions of live animals cannot be protected by copyright. In fact, we have held to the contrary. See Kamar Intl, Inc. v. Russ Berrie and Co., 657 F.2d 1059, 1061 (9th Cir. 1981). We recognize, however, that the scope of copyright protection in such works is narrow. See Herbert Rosenthal Jewelry Corp. v. Kalpakian, 446 F.2d 738, 741 (9th Cir. 1971) ("Any inference of copying based upon similar appearance lost much of its strength because both [works] were lifelike representations of a natural creature."). Nature gives us ideas of animals in their natural surroundings: an eagle with talons extended to snatch a mouse; a grizzly bear clutching a salmon between its teeth; a butterfly emerging from its cocoon; a wolf howling at the full moon; a jelly-fish swimming through tropical waters. These ideas, first expressed by nature, are the common heritage of humankind, and no artist may use copyright law to prevent others from depicting them.

[20] An artist may, however, protect the original expression he or she contributes to these ideas. An artist may vary the pose, attitude, gesture, muscle structure, facial expression, coat, or texture of animal. An artist may vary the background, lighting, or perspective. Such variations, if original, may earn copyright protection. Because Satava's jellyfish sculptures contain few variations of this type, the scope of his copyright is narrow.

[21] We do not mean to short-change the legitimate need of creative artists to protect their original works. After all, copyright law achieves its high purpose of enriching our culture by giving artists a financial
incentive to create. But we must be careful in copyright cases not to cheat the public domain. Only by vigorously policing the line between idea and expression can we ensure both that artists receive due reward for their original creations and that proper latitude is granted other artists to make use of ideas that properly belong to us all.

[23] REVERSED.

1. Justice Potter Stewart explained this feature of copyright law: "The immediate effect of our copyright law is to secure a fair return for an 'author's' creative labor. But the ultimate aim is, by this incentive, to stimulate artistic creativity for the general public good." Twentieth Century Music Corp. v. Aiken, 422 U.S. 151, 156 (1975).

2. The injunction prevented Lowry from making or selling sculptures with "a vertically oriented, colorful, fanciful jellyfish with tendril-like tentacles and a rounded bell encased in an outer layer of rounded clear glass that is bulbous at the top and tapering toward the bottom to form roughly a bullet shape, with the jellyfish portion of the sculpture filling almost the entire volume of the outer, clear glass shroud."

3. Standard elements sometimes are called "scènes à faire," vaguely French for "scenes which 'must' be done." Ets-Hokin v. Skyy Spirits, Inc., 225 F.3d 1068, 1082 n.17 (9th Cir. 2000). The Ninth Circuit treats scènes à faire as a defense to infringement rather than as a barrier to copyrightability. Id. See also Ets-Hokin v. Skyy Spirits, Inc., ___ F.3d ___ (9th Cir. 2003) (reviewing the district court's decision after remand).

4. Vertical orientation is a standard element partly because human beings prefer the world right-side-up.

5. We reach this conclusion based in part on our examination of the dozens of photographs of glass-in-glass jellyfish sculptures in the record. Some of the sculptures depict almost colorless jellyfish. Some of the sculptures have spherical shrouds. Some have shrouds encased in opaque black glass with clear windows cut through. Though none of the sculptures are identical, all of them are substantially similar. They differ only insofar as an artist has added or omitted some standard element. To give Satava a copyright on this basic combination of elements would effectively give him a monopoly on the idea of glass-in-glass sculptures of single vertical jellyfish. Congress did not intend for artists to fence off private preserves from within the public domain, and, if we recognized Satava's copyright, we would permit him to do exactly that.

Our analysis above suggests that the "merger doctrine" might apply in this case. Under the merger doctrine, courts will not protect a copyrighted work from infringement if the idea underlying the copyrighted work can be expressed in only one way, lest there be a monopoly on the underlying idea. CDN Inc. v. Kapes, 197 F.3d 1256, 1261 (9th Cir. 1999). In light of our holding that Satava cannot prevent other artists from using the standard and stereotyped elements in his sculptures, or the combination of those elements, we find it unnecessary to consider the application of the merger doctrine.
EASTERBROOK, Circuit Judge.

[1] This case presents the question whether a taxonomy is copyrightable. The American Dental Association has created the Code on Dental Procedures and Nomenclature. The first edition was published in 1969; the Code has been revised frequently since, in response to changes in dental knowledge and technology. All dental procedures are classified into groups; each procedure receives a number, a short description, and a long description. For example, number 04267 has been assigned to the short description "guided tissue regeneration - nonresorbable barrier, per site, per tooth (includes membrane removal)", which is classified with other surgical periodontic services. The Code made its first appearance in the Journal of the American Dental Association, covered by a general copyright notice; the 1991 and 1994 versions were submitted for copyright registration, which was granted by the Register of Copyrights. Delta Dental Association has published a work entitled Universal Coding and Nomenclature that includes most of the numbering system and short descriptions from the ADA's Code. In this suit for copyright infringement, Delta contends that it is entitled to reprint modified versions of the Code under an express or implied license, as a joint author (Delta participated in the groups that drafted the Code), and as fair use. It contends that by distributing pamphlets containing some of the Code's older versions without copyright notices the ADA has forfeited its copyright. Delta also argues that the Code is not copyrightable subject matter, and the district court granted summary judgment in its favor on this ground without reaching Delta's other arguments.

[2] The district court held that the Code cannot be copyrighted because it catalogs a field of knowledge - in other words, that no taxonomy may be copyrighted. A comprehensive treatment cannot be selective in scope or arrangement, the judge believed, and therefore cannot be original either. Taxonomies are designed to be useful. The judge wrote that if "nothing remains after the 'useful' is taken away - if the primary function is removed from the form - the work is devoid of even that modicum of creativity required for protection, and hence is uncopyrightable." 39 U.S.P.Q.2d 1715, 1721, Copyright L. Rep. ¶ 27,582 at 29,440 (1996) (footnote omitted). No one would read the ADA's Code for pleasure; it was designed and is used for business (for records of patients' dental history or making insurance claims) rather than aesthetic purposes. The district court added that, as the work of a committee, the Code could not be thought original. Creation by committee is an oxymoron, the judge wrote.

[3] The sweep of the district court's reasoning attracted the attention of many other suppliers of taxonomies. The American Medical Association, the American National Standards Institute, Underwriters Laboratories, and several other groups have filed a brief as amici curiae to observe that they, too, produce catalogs of some field of knowledge and depend on the copyright laws to enable them to recover the costs of the endeavor. Other groups or firms might say the same. The manuals issued by the Financial Accounting Standards Board to specify generally accepted accounting practices could not be copyrighted. Nor could the tests and answers devised by the Educational Testing Service. The district court's reasoning logically removes copyright protection from the West Key Number System, which is designed as a comprehensive index to legal topics, and A Uniform System of Citation (the Bluebook), a taxonomy of legal sources. Very little computer software could receive a copyright if the district judge is correct: no
one reads, for pleasure, the source or object code of the word processing program on which this opinion was written, or of the operating system that runs the computer: take away the "useful" elements and these endeavors are worthless. Worse, most commercial software these days is written by committee, and authors receive less public credit than the gaffers on a movie set, whose names at least scroll by at the end after the audience has turned its collective back to head up the aisles. Blueprints for large buildings (more committee work), instruction manuals for repairing automobiles, used car value guides, dictionaries, encyclopedias, maps - all these, and many more, would flunk the district court's test of originality. Yet these items are routinely copyrighted, and challenges to the validity of these copyrights are routinely rejected. E.g., Educational Testing Service v. Katzman, 793 F.2d 533 (3d Cir. 1986) (Scholastic Aptitude Test); CCC Information Services, Inc. v. Maclean Hunter Market Reports, Inc., 44 F.3d 61 (2d Cir. 1994) (list of used-car prices); Lipton v. Nature Co., 71 F.3d 464 (2d Cir. 1995) (terms describing groups of animals). See also 17 U.S.C. § 101 (including "architectural plans" within the definition of "pictorial, graphic and sculptural works" that are copyrightable); Paul Goldstein, Copyright: Principles, Law and Practice § 2.15.2 (1989) (discussing copyright protection for computer programs). The American Medical Association's copyright in the Physician's Current Procedural Terminology, its catalog of medical procedures, was recently sustained, although against a challenge different from the district court's rationale. Practice Management Information Corp. v. American Medical Association, No. 94-56774 (9th Cir. Aug. 6, 1997), slip op. 9323-27. Maps and globes are not only copyrightable, see Rockford Map Publishers, Inc. v. Directory Service Co., 768 F.2d 145 (7th Cir. 1985), but also constituted two-thirds of the original scope of copyright. The Copyright Act of 1790 specified three protectable items: maps, charts, and books. Act of May 31, 1790, 1 Stat. 124. Like taxonomies, maps are valued to the extent they offer useful organizations of facts; like the Code, maps are produced by committees. (As are opinions of appellate courts, which despite this handicap, and the judges' effort to produce something useful, might occasionally have a modicum of originality.)

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

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

[6] Number 04267 reads "guided tissue regeneration - nonresorbable barrier, per site, per tooth" but could have read "regeneration of tissue, guided by nonresorbable barrier, one site and tooth per entry". Or "use of barrier to guide regeneration of tissue, without regard to the number of sites per tooth and whether or
not the barrier is resorbable". The first variation is linguistic, the second substantive; in each case the decision to use the actual description is original to the ADA, not knuckling under to an order imposed on language by some "fact" about dental procedures. Blood is shed in the ADA's committees about which description is preferable. The number assigned to any one of the three descriptions could have had four or six digits rather than five; guided tissue regeneration could have been placed in the 2500 series rather than the 4200 series; again any of these choices is original to the author of a taxonomy, and another author could do things differently. Every number in the ADA's Code begins with zero, assuring a large supply of unused numbers for procedures to be devised or reclassified in the future; an author could have elected instead to leave wide gaps inside the sequence. A catalog that initially assigns 04266, 04267, 04268 to three procedures will over time depart substantively from one that initially assigns 42660, 42670, and 42680 to the same three procedures. So all three elements of the Code - numbers, short descriptions, and long descriptions, are copyrightable subject matter under 17 U.S.C. § 102(a). The Maroon Book and the Bluebook offer different taxonomies of legal citations; Wotquenne and Helm devised distinct catalogs of C.P.E. Bach's oeuvre; Delta Dental Association could have written its own classification of dental procedures.

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

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

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

[10] Delta asks us to affirm the judgment on a ground that the district judge did not reach: that the Code is not copyrightable because it is a "system." Section 102(b) tells us that copyright protection even of an original work does not cover "any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work." But what could it mean to call the Code a "system"? This taxonomy does not come with instructions for use, as if the Code were a recipe for a new dish. Cf. Publications International, Ltd. v. Meredith Corp., 88 F.3d 473 (7th Cir. 1996) (holding that recipes are not copyrightable). A dictionary cannot be called a "system" just because new novels are written using words, all of which appear in the dictionary. Nor is word-processing software a "system" just because it has a command structure for producing paragraphs. The Code is a taxonomy, which may be put to many uses. These uses may be or include systems; the Code is not.

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

[12] Few "how-to" works are "systems" in Baker's sense. If they were, architectural blueprints could be freely copied, although the Berne Convention Implementation Act of 1988, Pub. L. 100-567, 102 Stat. 2854, adds protection for "architectural plans" to the statute. Descriptions of how to build or do something do not facilitate monopoly of the subject-matter being described, so the concern of Baker is not activated. Again consider blueprints: other architects can imitate the style of the completed building; they just can't copy the plans. What is more, a form that contains instructions for its completion is copyrightable in part (the instructions) and in the public domain in part (the lines and boxes). Edwin K. Williams & Co. v. Edwin K. Williams & Co. East, 542 F.2d 1053, 1061 (9th Cir. 1976); Goldstein at § 2.15.1.b. So far as the ADA is concerned, any dentist, any insurer, anyone at all, may devise and use forms into which the Code's descriptions may be entered. The ADA encourages this use; standardization of language promotes interchange among professionals. (The fact that Delta used most of the Code but made modifications is the reason ADA objects, for variations salted through a convention impede communication.) Section 102(b) precludes the ADA from suing, for copyright infringement, a dentist whose office files record treatments using the Code's nomenclature. No field of practice has been or can be monopolized, given this constraint. Section 102(b) permits Delta Dental to disseminate forms inviting dentists to use the ADA's Code when submitting bills to insurers. But it does not permit Delta to copy the Code itself, or make and distribute a derivative work based on the Code, any more than Baker could copy Selden's book.

[13] Whether there are other obstacles to the relief the ADA seeks is a subject best left to the district court in the first instance. The judgment is vacated, and the case is remanded for further proceedings consistent with this opinion. Any award of attorneys' fees, the second subject of the ADA's appeal, must abide the final decision in the litigation.

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