



UNC  
SCHOOL OF LAW

NORTH CAROLINA LAW REVIEW

---

Volume 63 | Number 1

Article 9

---

11-1-1984

# Protecting Research: Copyright, Common-Law Alternatives, and Federal Preemption

David E. Shipley

Jeffrey S. Hay

Follow this and additional works at: <http://scholarship.law.unc.edu/nclr>



Part of the [Law Commons](#)

---

## Recommended Citation

David E. Shipley & Jeffrey S. Hay, *Protecting Research: Copyright, Common-Law Alternatives, and Federal Preemption*, 63 N.C. L. REV. 125 (1984).

Available at: <http://scholarship.law.unc.edu/nclr/vol63/iss1/9>

This Article is brought to you for free and open access by Carolina Law Scholarship Repository. It has been accepted for inclusion in North Carolina Law Review by an authorized administrator of Carolina Law Scholarship Repository. For more information, please contact [law\\_repository@unc.edu](mailto:law_repository@unc.edu).

# PROTECTING RESEARCH: COPYRIGHT, COMMON-LAW ALTERNATIVES, AND FEDERAL PREEMPTION

DAVID E. SHIPLEY†  
JEFFREY S. HAY††

*Under federal copyright law, an author's expression is protected but his ideas and discoveries are not. Professor Shipley explores the possibility of expanding copyright to protect the research of nonfiction authors, but concludes that such an expansion would undermine federal copyright policy. State-law remedies exist that will provide such protection if they are not preempted by federal law. Professor Shipley concludes that most contract claims and some misappropriation claims will survive preemption and therefore are a means by which nonfiction authors can protect their research.*

Facts, news, and historical events are in the public domain<sup>1</sup> and are not protectible by copyright.<sup>2</sup> Although facts might be discovered by an author, they are not original to him and thus are not within the realm of copyright.<sup>3</sup> An author's mode of expressing facts and events in a nonfiction narrative, historical account, news report, or biography is copyrightable;<sup>4</sup> his "raw materials," however, are not.<sup>5</sup> Similarly, research would not appear to be copyrightable because the law safeguards only an author's form of expression,

---

† Associate Professor, The University of South Carolina. B.A. 1972, Oberlin College; J.D. 1975, Chicago.

†† Associate, Helms, Mulliss & Johnston; Charlotte, North Carolina. A.B. 1980, Erskine College; J.D. 1983, The University of South Carolina.

1. It is frequently stated that facts are not copyrightable. *Consumers Union of the United States, Inc. v. General Signal Corp.*, 724 F.2d 1044, 1049 (2d Cir. 1983), *cert. denied*, 105 S. Ct. 100 (1984) (No. 83-1870); *see Harper & Row, Publishers, Inc. v. Nation Enters.*, 723 F.2d 195, 202 (2d Cir. 1983), *cert. granted*, 104 S. Ct. 2655 (1984) (No. 83-1632); *Marshall v. Yates*, 27 PAT. TRADE-MARK & COPYRIGHT J. (BNA) No. 658, at 137-38 (C.D. Cal. 1983); *Lake v. CBS*, 140 F. Supp. 707, 708-09 (S.D. Cal. 1956); 17 U.S.C. § 102(b) (1982); N. BOORSTYN, COPYRIGHT LAW 82 (1981); A. LATMAN, THE COPYRIGHT LAW 32 (5th ed. 1979); Gorman, *Copyright Protection for the Collection and Representation of Facts*, 76 HARV. L. REV. 1569, 1577 (1963); *cf. Greenbie v. Noble*, 151 F. Supp. 45, 66 (S.D.N.Y. 1957) (ideas and facts not protectible); *Triangle Publications, Inc. v. Sports Eye, Inc.*, 415 F. Supp. 682, 685 n.9 (E.D. Pa. 1976) (data and ideas not protectible).

2. A writing must originate with the author to be protectible. *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884); *Harper & Row, Publishers, Inc. v. Nation Enters.*, 723 F.2d 195, 202 (2d Cir. 1983), *cert. granted*, 104 S. Ct. 2655 (1984) (No. 83-1632); *Miller v. Universal City Studios, Inc.*, 650 F.2d 1365, 1368 (5th Cir. 1981); *Alfred Bell & Co. v. Catalada Fine Arts, Inc.*, 191 F.2d 99, 103 (2d Cir. 1951); *Suid v. Newsweek Magazine*, 503 F. Supp. 146, 148 (D.D.C. 1980); 1 M. NIMMER, NIMMER ON COPYRIGHT § 2.11[A] (1983).

3. *Miller v. Universal City Studios, Inc.*, 650 F.2d 1365, 1368 (5th Cir. 1981); 1 M. NIMMER, *supra* note 2, at § 1.01[B][2][c].

4. These expressions of fact are protectible even though the term "copyrightable" is not technically correct. The term, however, often is used. *See A. LATMAN, supra* note 1, at 15-62.

5. *Greenbie v. Noble*, 151 F. Supp. 45, 66 (S.D.N.Y. 1957); Gorman, *supra* note 1, at 1577;

not his labor in searching for and gathering facts. Compelling arguments, however, can be made on behalf of an author whose research has been appropriated,<sup>6</sup> and thus the law is not settled on this point.

An author's copyright to a nonfiction narrative gives him exclusive rights to control reproduction, prepare derivative works,<sup>7</sup> perform the work publicly,<sup>8</sup> and authorize and be compensated for a dramatization of his work. Because the facts underlying his narrative are not copyrightable, however, another author may be able to appropriate those facts to prepare his own work without the first author's consent and without any independent research. Under this scenario the second author has not violated the original copyright if he does not copy the first author's manner of expression.<sup>9</sup> This appropriation, however, may greatly reduce the market for the original author's work.

A variety of theories have developed to protect the efforts of nonfiction authors. Some theories expand the scope of federal copyright protection; others are based on common-law doctrines.<sup>10</sup> Several of the common-law theories appear to conflict directly with settled principles of copyright law, and thus may be preempted. This Article studies the basis and scope of the rule that facts are not copyrightable<sup>11</sup> and reviews and criticizes the theories that

Taylor, *The Uncopyrightability of Historical Matter: Protecting Form Over Substance and Fiction Over Fact*, 30 COPYRIGHT L. SYMP. (ASCAP) 33, 35 (1983).

6. Some argue that the labor involved in research is more similar to expression than to the facts uncovered, and therefore research should be protectible by copyright. N. BOORSTYN, *supra* note 1, at 81. Similarly, an author's research arguably should be protectible by copyright because copyright law consistently has protected the labor of those who compile and arrange unprotectible data into directories, telephone books, and catalogues. See *Leon v. Pacific Tel. & Tel. Co.*, 91 F.2d 484 (9th Cir. 1937) (protection of a telephone directory); *Jeweler's Circular Publishing Co. v. Keystone Publishing Co.*, 281 F. 83 (2d Cir.) (collection of trademarks), *cert. denied*, 259 U.S. 581 (1922); *Chain Store Business Guide, Inc. v. Wexler*, 79 F. Supp. 726 (S.D.N.Y. 1948) (directory of names). See also 17 U.S.C. §§ 101, 103 (1982) (definition of "compilation" and scope of rights therein); 1 M. NIMMER, *supra* note 2, at 3-5 n.8. Historians are at least as deserving of protection as compilers. Taylor, *supra* note 5, at 36-56. See *infra* text accompanying notes 94-136.

See generally Denicola, *Copyright in Collections of Facts: A Theory for the Protection of Nonfiction Literary Works*, 81 COLUM. L. REV. 516, 516-17 (1981); Hill, *Copyright Protection for Historical Research: A Defense of the Minority View*, 31 COPYRIGHT L. SYMP. (ASCAP) 45, 59, 67 (1984); Gorman, *supra* note 1, at 1584; Note, *Copyright Law and Factual Works—Is Research Protected?*, 58 WASH. L. REV. 619, 622 (1983). See also *infra* text accompanying notes 71-191.

7. 17 U.S.C. §§ 106(1)(2) (1982). See also *id.* §§ 101, 103 (definition of "derivative work" and scope of rights therein).

8. *Id.* § 106(4).

9. See, e.g., *Miller v. Universal City Studios, Inc.*, 650 F.2d 1365 (5th Cir. 1981) (research not copyrightable); *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972 (2d Cir.) (historical interpretation not protected by copyright), *cert. denied*, 449 U.S. 841 (1980); *Suid v. Newsweek Magazine*, 503 F. Supp. 146 (D.D.C. 1980) (defendant's use of plaintiff's book as source of quotes from unpublished letters did not violate copyright laws). But see *Toksvig v. Bruce Publishing Co.*, 181 F.2d 664 (7th Cir. 1950) (plaintiff's substantial research and translation protected); *Leon v. Pacific Tel. & Tel. Co.*, 91 F.2d 484 (9th Cir. 1937) (telephone directory subject to copyright). See also 1 M. NIMMER, *supra* note 2, § 2.11[E], at 2-164 to -165; Gorman, *supra* note 1, at 1583; Taylor, *supra* note 5, at 37.

10. Some of the possible common-law bases for protection are unfair competition and misappropriation, express contract, implied contract, contract, quasi-contract, unjust enrichment, conversion, and tortious interference with contract. See generally Gorman, *supra* note 1, at 1571, 1584; Denicola, *supra* note 6, at 517-18 n.7.

11. See *infra* text accompanying notes 14-70.

have been used to extend copyright protection to research.<sup>12</sup> The Article concludes by examining the limited protection for research under the common-law theories that survive federal preemption.<sup>13</sup>

## I. FACTS AND COPYRIGHTABILITY

The Constitution authorizes Congress "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors . . . the exclusive Right to their respective Writings . . . ."<sup>14</sup> Pursuant to this authorization the copyright statutes provide that "protection subsists . . . in original works of authorship fixed in any tangible medium of expression . . . from which they can be perceived, reproduced or otherwise communicated . . . ."<sup>15</sup> Accordingly, protectible subject matter encompasses not only literary works<sup>16</sup> but also "any physical rendering of the fruits of creative or aesthetic labor."<sup>17</sup> An author is the one "to whom anything owes its origin . . . ."<sup>18</sup> He must create his work independently, without copying. Although some minimal level of creative labor is required for a work to be protected, the fundamental requirement is originality—*independent creation*.<sup>19</sup> Therefore, facts are not subject to copyright protection.

[A] fact does not originate with the author of a book describing the fact. Neither does it originate with the one who "discovers" the fact. "The discoverer merely finds and records. He may not claim that the facts are 'original' with him, although there may be originality and hence authorship in the manner of reporting, i.e., the 'expression' of the facts."<sup>20</sup>

Courts have denied copyright protection to facts in histories, biographies, news accounts, and other nonfiction works.<sup>21</sup> Section 102(b) of the Copyright

12. See *infra* text accompanying notes 71-191.

13. See *infra* text accompanying notes 192-400.

14. U.S. CONST. art. I, § 8, cl. 8.

15. 17 U.S.C. § 102(a) (1982).

16. A. LATMAN, *supra* note 1, at 18.

17. *Goldstein v. California*, 412 U.S. 546, 561 (1973). See, e.g., *Mazer v. Stein*, 347 U.S. 201 (1954) (statuettes used as lamp bases are protectible by copyright); *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884) (photograph may be protectible subject matter); *Williams Electronics v. Artic Int'l*, 685 F.2d 870, 873-77 (3d Cir. 1982) (plaintiff's computer program and audiovisual works—video games—entitled to copyright protection); *Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d 1240 (3d Cir. 1983) (operating system software protectible).

18. *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 57-58 (1884).

19. "Original" means that a work owes its origin to the author. *Alfred Bell & Co., Ltd. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102 (2d Cir. 1951); A. LATMAN, *supra* note 1, at 20-21. In a novel the author's ideas, arrangement, and final expression originate with him. His ideas can be used freely but his mode of expression is subject to copyright protection. *Gorman*, *supra* note 1, at 1570. In contrast, the facts and sequences of events expressed by journalists, historians, and biographers are in the public domain and are not protectible by copyright. The author's efforts in gathering those facts—his research—are tedious and costly but the data is not protected because it does not originate with the author. *Id.* at 1570, 1577. Only his expression is subject to copyright protection.

20. *Miller v. Universal City Studios, Inc.*, 650 F.2d 1365, 1368 (5th Cir. 1981) (quoting 1 M. NIMMER, *supra* note 2, § 2.03[E]); see *Taylor*, *supra* note 5, at 35.

21. 1 M. NIMMER, *supra* note 2, § 2.11[B], at 2-157; *Gorman*, *supra* note 1, at 1583. Factual works include maps, news and historical accounts, directories, legal and business forms, and re-

Act codifies these results, stating that "[i]n no case does copyright protection for an original work of authorship extend to any idea, procedure, process . . . or discovery . . . ." <sup>22</sup> If an author could claim exclusive rights to an actual event by being the first to narrate and copyright a story, he could prevent others from preparing different accounts of that event. <sup>23</sup> This power would contravene the fundamental purpose of copyright: to encourage production of works of authorship to "advance public welfare through the talents of authors . . . in 'Science and useful Arts.'" <sup>24</sup> "[T]he cause of knowledge is best served when history is the common property of all, and each generation remains free to draw upon the discoveries and insights of the past." <sup>25</sup> Furthermore, the first amendment mandates free use of historical and biographical facts and news events; <sup>26</sup> copyright was not intended to prevent the free communication of ideas, information, and facts. <sup>27</sup> Reward to the copyright owner is only a secondary consideration. <sup>28</sup>

Incentives for creative labor exist, despite the lack of copyright protection for facts. A copyright grants an author enforceable exclusive rights to the literary form in which ideas and facts are arranged and expressed. <sup>29</sup> An author is rewarded financially for his creative expression and the public benefits from the steady production and dissemination of works of authorship <sup>30</sup> and the free use of facts and ideas. Thus, two competing policies are balanced through copyright protection. <sup>31</sup> As one court explained: "[I]f the protectible scope of

---

lated works when the author's materials are objective data that he organizes, selects, arranges, and expresses in an intelligible manner. Gorman, *supra* note 1, at 1569.

22. 17 U.S.C. § 102(b) (1982). Facts are in the public domain and therefore cannot be copyrighted. *E.g.*, *Georgia v. The Harrison Co.*, 218 U.S.P.Q. (BNA) 119, 122 (N.D. Ga. 1982) (statutes not copyrightable); *see also Harper & Row, Publishers, Inc. v. Nation Enters.*, 723 F.2d 195, 202 n.7 (2d Cir. 1983) ("discovery" in § 102(b) interpreted to encompass facts), *cert. granted*, 104 S. Ct. 2655 (1984) (No. 83-1632).

23. *Echevarria v. Warner Bros. Pictures, Inc.*, 12 F. Supp. 632, 638 (S.D. Cal. 1935); *see Harper & Row, Publishers, Inc. v. Nation Enters.*, 723 F.2d 195, 204-05 (2d Cir. 1983), *cert. granted*, 104 S. Ct. 2655 (1984) (No. 83-1632).

24. *Mazer v. Stein*, 347 U.S. 201, 219 (1954); *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975); *cf. Abrams, Copyright, Misappropriation and Preemption: Constitutional and Statutory Limits of State Law Protection*, 1983 SUP. CT. REV. 509, 510.

25. *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 974 (2d Cir.), *cert. denied*, 449 U.S. 841 (1980); *see also Mazer v. Stein*, 347 U.S. 201, 219 (1954); *Greenbie v. Noble*, 151 F. Supp. 45, 67 (S.D.N.Y. 1957).

26. *Harper & Row, Publishers, Inc. v. Nation Enters.*, 723 F.2d 195 (2d Cir. 1983), *rev'g* 557 F. Supp. 1067 (S.D.N.Y. 1983) (*The Nation's* use of President Ford's memoirs not an infringement of copyright), *cert. granted*, 104 S. Ct. 2655 (1984) (No. 83-1632); *cf. Consumers Union of the United States, Inc. v. General Signal*, 724 F.2d 1044, 1049 (2d Cir. 1983) (manufacturer's use of favorable product evaluation in advertising not an infringement; consumer information protected under the first amendment), *cert. denied*, 105 S. Ct. 100 (1984) (No. 83-1870); *see also* 1 M. NIMMER, *supra* note 2, § 2.11[E], at 2-167.

27. Congress' intent was to ensure such free communication. H.R. REP. No. 1476, 94th Cong., 2d Sess., 56-57 (1976) [hereinafter cited as H.R. REP.]. *See also Leibovitz v. CBS*, 213 U.S.P.Q. (BNA) 289, 289-90 (D. Mass. 1981); Gorman, *supra* note 1, at 1579.

28. *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 131, 136 (1973); *United States v. Paramount Pictures*, 334 U.S. 131, 138 (1948); *Berlin v. E.C. Publications, Inc.*, 329 F.2d 541, 543-44 (2d Cir.), *cert. denied*, 379 U.S. 822 (1964); *Abrams, supra* note 24, at 510.

29. H.R. REP., *supra* note 27, at 56; Taylor, *supra* note 5, at 37.

30. *Mazer v. Stein*, 347 U.S. 201, 219 (1954).

31. Conflicts between the interests of creators and users (readers, the public, and later au-

an author's writings is too narrowly defined he will be discouraged from further writing. If, however, the protectible scope of the original author's work is too broadly defined, creative work by others will be discouraged.<sup>32</sup> Copyright law accommodates these competing interests by protecting an author's expression, but not the underlying facts that he expresses.<sup>33</sup>

## II. THE SCOPE OF COPYRIGHT PROTECTION FOR NONFICTION LITERARY WORKS

Copyright encompasses a bundle of exclusive rights<sup>34</sup> that the author may exercise or authorize others to exercise, in whole or in part, by license, transfer, assignment, or other means of conveyance.<sup>35</sup> The author has the fundamental right to control reproduction and prevent others from copying the protected elements of the creation<sup>36</sup>—the arrangement, combination, and expression of ideas and facts.<sup>37</sup> The author's rights are limited because "[a]bsent copying

---

thors) are inherent in copyright and the law of intellectual property. *See generally* Baird, *Common Law Intellectual Property and the Legacy of International News Service v. Associated Press*, 50 U. CHI. L. REV. 411, 415 (1983); Goldstein, *The Competitive Mandate: From Sears to Lear*, 59 CALIF. L. REV. 873, 875-80 (1971); Gorman, *supra* note 1, at 1582. The Constitution authorizes exclusive rights only for "limited Times." U.S. Const. art. I, § 8, cl. 8. Copyright law grants exclusive rights, 17 U.S.C. § 106 (1982), and then subjects them to several specific limitations. *Id.* §§ 110-18. This tension also is evident in the fair-use doctrine, as codified in 17 U.S.C. § 107 (1982), and in the many cases in which courts have tried to balance public interests against the copyright owner's right. *See, e.g.* Universal City Studios, Inc. v. Sony Corp. of Am., 104 S. Ct. 774 (1984); Harper & Row, Publishers, Inc. v. Nation Enters., 723 F.2d 195 (2d Cir. 1983), *cert. granted*, 104 S. Ct. 2655 (1984) (No. 83-1632); Rosemont Enters. v. Random House, Inc., 366 F.2d 303 (2d Cir. 1966), *cert. denied*, 385 U.S. 1009 (1967); Time, Inc. v. Bernard Geis Assocs., 293 F. Supp. 130 (S.D.N.Y. 1968).

32. *Morrison v. Solomons*, 494 F. Supp. 218, 225 (S.D.N.Y. 1980).

33. Because the primary objective of copyright is to serve the public interest, it usually will prevail over an author's interests when there is a conflict. *See United States v. Bily*, 406 F. Supp. 726, 730 (E.D. Pa. 1975); *see also* Denicola, *supra* note 6, at 519; *cf.* Abrams, *supra* note 24, at 510. The public interest in the free use of facts and information is served by denying protection to such matters. Denicola, *supra* note 6, at 525; Gorman, *supra* note 1, at 1582-83. On the other hand, the public interest in encouraging nonfiction works is accommodated by protecting an author's manner of expression. 1 M. NIMMER *supra* note 2, § 2.11[B], at 2-158 to -159; Gorman, *supra* note 1, at 1579; Taylor, *supra* note 5, at 36-39. Thus, even though the chronological arrangement of facts is not original and therefore not protectible, *see infra* notes 61-62 and accompanying text, the author's manner of expressing the facts and chronology is protectible by copyright. Nevertheless, all are free to use the facts in a nonfiction work. *See Miller v. Universal City Studios, Inc.*, 650 F.2d 1365, 1368 (5th Cir. 1981); *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 979 (2d Cir.), *cert. denied*, 449 U.S. 841 (1980); *Wainwright Sec., Inc. v. Wall St. Transcript Corp.*, 558 F.2d 91, 95 (2d Cir. 1977); *Ricker v. General Elec. Co.*, 162 F.2d 141, 142 (2d Cir. 1947); *Suid v. Newsweek Magazine*, 503 F. Supp. 146, 147 (D.D.C. 1980); *Mosley v. Follett*, 209 U.S.P.Q. (BNA) 1109, 1113 (S.D.N.Y. 1980); *Alexander v. Haley*, 460 F. Supp. 40, 45 (S.D.N.Y. 1978); *Rokeach v. Avco Embassy Pictures Corp.*, 197 U.S.P.Q. (BNA) 155, 160-61 (S.D.N.Y. 1978); *Norman v. CBS*, 333 F. Supp. 788, 796 (S.D.N.Y. 1971); *Holdredge v. Knight Publishing Corp.*, 214 F. Supp. 921, 923 (S.D. Cal. 1963); *Consumers Union v. Hobart Mfg. Co.*, 199 F. Supp. 860, 861 (S.D.N.Y. 1961); *Greenbie v. Noble*, 151 F. Supp. 45, 67 (S.D.N.Y. 1957); *see also* 1 M. NIMMER, *supra* note 2, § 2.11[A]; Denicola, *supra* note 6, at 535; Gorman, *supra* note 1, at 1583.

34. 17 U.S.C. § 106 (1982).

35. *Id.* § 201(d).

36. *Id.* § 106(1). Denicola, *supra* note 5, at 522.

37. *Holdredge v. Knight Publishing Corp.*, 214 F. Supp. 921, 923 (S.D. Cal. 1963). *See Eissenschiml v. Fawcett Publications, Inc.*, 246 F.2d 598, 603 (7th Cir.), *cert. denied*, 355 U.S. 907 (1957).

there can be no infringement of copyright,"<sup>38</sup> and even when copying is demonstrated<sup>39</sup> the author must prove substantial similarity of copyrightable expression.<sup>40</sup> Accordingly, copyright is infringed by the substantial appropriation of the author's "particular expression through similarities of treatment, details, scenes, events and characterization."<sup>41</sup> Infringement may result from "imitation, paraphrasing, or colorable alteration" as well as literal copying.<sup>42</sup>

The author also has authority over the preparation of works derived from his protected work,<sup>43</sup> such as the adaptation of a book to a movie.<sup>44</sup> This right is similar to the reproduction right,<sup>45</sup> and it allows an author to control how his work is recast and transformed in a different medium.<sup>46</sup> Thus, a movie studio that adapted a book to a movie without authorization could be liable

38. *Mazer v. Stein*, 347 U.S. 201, 218 (1954). Rights are not infringed by the independent creation of a similar work. *Arnstein v. Edward B. Marks Music Corp.*, 82 F.2d 275, 275 (2d Cir. 1936); *Fred Fisher, Inc. v. Dillingham*, 298 F. 145, 149 (S.D.N.Y. 1924).

39. Copying must be established. In the absence of direct evidence, the plaintiff may be able to establish a strong inference of copying by showing that the defendant had access to the first work and that similarities exist between the works. *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946). Similarities that exist only because both works deal with the same historical material cannot provide the basis for an infringement claim. *Marshall v. Yates*, 27 PAT. TRADEMARK & COPYRIGHT J. (BNA) 137, 137-38 (C.D. Cal. 1983) (author of book about Frances Farmer unable to establish that the movie "Frances" infringed). The plaintiff must prove copying of some protectible element. *Id.* at 138.

40. *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930), *cert. denied*, 282 U.S. 902 (1931). Striking similarities between two works may create a presumption of copying, *see infra* text accompanying notes 351-55, but whether or not such similarities establish a substantial and material taking that constitutes infringement is a different question. A. LATMAN, *supra* note 1, at 161. The alleged infringer may have copied the author's expressions, but this copying will not constitute infringement unless the taking is substantial. *Universal Athletic Sales Co. v. Salkeld*, 511 F.2d 904, 907 (3d Cir. 1975). *See also* *Marling v. Ellison*, 218 U.S.P.Q. 702, 711 (S.D. Fla. 1982).

41. *Wainwright Sec., Inc. v. Wall St. Transcript Corp.*, 558 F.2d 91, 96 (2d Cir. 1977) (quoting *Reyher v. Children's Television Workshop*, 533 F.2d 87, 91 (2d Cir. 1976)).

42. A. LATMAN, *supra* note 1, at 165. *See also* *Chicago Record-Herald Co. v. Tribune Ass'n*, 275 F. 797 (7th Cir. 1921) (*Chicago Herald* infringed *New York Tribune's* news story describing German submarines). That the copying was unintentional is not a defense. A. LATMAN, *supra* note 1, at 160. Facts discovered and expressed by a diligent historian, however, may be appropriated freely if the historian author's particular form of expression is not used. *Gorman, supra* note 1, at 1583. *See generally* Taylor, *supra* note 5, at 36-39.

43. 17 U.S.C. § 106(2) (1982).

44. *Id.* § 101 ("derivative work" defined as "a work based upon one or more preexisting works, such as a . . . dramatization, fictionalization, or motion picture version . . ."). Derivative works, whether prepared by the owner of the underlying work or with his consent or based on a work in the public domain, are copyrightable subject matter. *Id.* § 103(a). The copyright, however, is separate from, and does not affect, the copyright on the underlying work. *Id.* § 103(b). Only those elements that are original to the derivative work—materials contributed by the work's author—are entitled to protection. *Id.*

45. 2 M. NIMMER, *supra* note 2, § 8.09[A], at 8-110.1 to -110.2. This right arguably is superfluous because an adaptation "reproduces" the underlying work. Nevertheless, an adaptation right was recognized explicitly in § 1(b) of the 1909 Act as a right to make any other version of the copyrighted work; § 7 provided that such works were entitled to copyright protection. Act of Mar. 4, 1909, ch. 320, §§ 1, 7, 35 Stat. 1075, 1077 (repealed 1976).

46. This right may result in substantial financial rewards for the copyright owner. A writer could authorize the publication of a condensed version of his novel in *Reader's Digest*, the preparation and performance of a play, and then grant motion picture rights to a major studio. *All the President's Men* was very successful as both a book and a movie, as was *Gone With the Wind*. *But see* *Hoehling v. Universal City Studios*, 618 F.2d 972 (2d Cir.), *cert. denied*, 449 U.S. 841 (1980).

for violating the right to prepare derivative works,<sup>47</sup> as well as the right of reproduction and the right to control performances.<sup>48</sup>

The Act's definition of "derivative work" is broad; it includes "any . . . form in which a work may be recast, transformed or adapted."<sup>49</sup> Notwithstanding this sweeping definition, to infringe this right a work must incorporate a substantial amount of the underlying work's protected expression.<sup>50</sup> A movie about a historic figure is not derivative of the leading biography about that figure absent substantial similarity of protected expression.<sup>51</sup> Thus, the Act's basic limitations on the reproduction right similarly restrict the scope of the right to prepare derivative works.<sup>52</sup>

Fictional elements that an author might include in his otherwise factual or historical work also are protectible;<sup>53</sup> "the fictionalizing of events and incidents in the life of an historic figure is the author's original treatment of the life of such figure and is subject to protection against appropriation by others."<sup>54</sup> Thus, one who uses materials in a factual work risks copying the

47. See *Metro-Goldwyn-Mayer v. Showcase Atlanta Cooperative Productions, Inc.*, 479 F. Supp. 351 (N.D. Ga. 1979) (copyrights to the book and film *Gone With the Wind* infringed by three-act play with music entitled *Scarlett Fever*). But see *Miller v. Universal City Studios, Inc.*, 650 F.2d 1365 (5th Cir. 1981) (infringement by film maker not upheld, despite sufficient evidence, because jury improperly instructed that plaintiff's research was copyrightable).

48. 17 U.S.C. § 106(1), (4) (1982); 2 M. NIMMER, *supra* note 2, § 8.09[A]. If the right to prepare derivative works has been infringed, a violation of either the reproduction or the performance right necessarily has occurred. Absent substantial similarity of copyrightable expression between the underlying work and the adaptation allegedly constituting a violation of the reproduction right, however, the adaptation will not be deemed derivative so as to infringe 17 U.S.C. § 106(2) (1982). See also *infra* note 51.

49. 17 U.S.C. § 101 (1982). See also A. LATMAN, *supra* note 1, at 174-75. The definition also includes illustrative examples. See *id.*

50. H.R. REP., *supra* note 27, at 62; S. Rep. No. 473, 94th Cong., 1st Sess. 58 (1976); A. LATMAN, *supra* note 1, at 175; Mimms, *Reversion and Derivative Works Under the Copyright Acts of 1909 and 1976*, 28 COPYRIGHT L. SYMP. (ASCAP) 1, 10 (1982) ("[A] work will be considered a derivative work only if it would be an infringing work but for the consent of the copyright owner of the underlying work.").

51. Similarity of subject matter and unprotectible facts is not enough. See, e.g., *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972 (2d Cir.) (hypothesis of Hindenburg sabotage not copyrightable), *cert. denied*, 449 U.S. 841 (1980); *Eisenschiml v. Fawcett Publications*, 246 F.2d 598 (7th Cir. 1957) (historical details), *cert. denied*, 355 U.S. 907 (1957); *Marshall v. Yates*, 27 PAT. TRADEMARK & COPYRIGHT J. (BNA) 137, 137-38 (C.D. Cal. 1983) (biography); *Klekas v. EMI Films, Inc.*, 150 Cal. App. 3d 1102, 198 Cal. Rptr. 296 (1984) (unpublished novel not infringed by movie and novel *The Deer Hunter* primarily because the similarities dealt with subjects that were not independently copyrightable); *Smith v. Weinstein*, 578 F. Supp. 1297 (S.D.N.Y. 1984) (screenplay not infringed by motion picture "Stir Crazy" because thematic similarities dealt with uncopyrightable matters). Determining whether an adaptation infringes another's copyright is not easy unless it is a very close reproduction. The transformations often may be so great that it is difficult to see any connection between the works. See B. KAPLAN, AN UNHURRIED VIEW OF COPYRIGHT 56-57 (1967).

52. 2 M. NIMMER, *supra* note 2, § 8.09[A]; see also *supra* notes 48, 50.

53. 1 M. NIMMER, *supra* note 2, § 2.11[C], at 2-161; Taylor, *supra* note 5, at 42-47.

54. *Greenbie v. Noble*, 151 F. Supp. 45, 65 (S.D.N.Y. 1957); see *De Acosta v. Brown*, 146 F.2d 408, 410 (2d Cir. 1944), *cert. denied sub nom. Hearst Magazines v. De Acosta*, 325 U.S. 862 (1945). In response to plaintiff's claim that he infringed her biography of Clara Barton by copying its fictional elements, defendant in *De Acosta* argued that the material dealt with the life of a public character and therefore was in the public domain. The court rejected defendant's argument, holding that "original treatment of the life of a historic character, like such treatment of any material even in the public domain, is entitled to protection against appropriation by others." *De Acosta*, 146 F.2d at 410; see also 1 M. NIMMER, *supra* note 2, § 2.11[C].



fictional elements added by the original author.<sup>55</sup> An estoppel analysis, however, lessens this danger:<sup>56</sup> "[E]quity and good morals will not permit one who asserts something as a fact . . . to change that position for profit in a law suit" and argue that the material copied from his work was fictional.<sup>57</sup> In *Davies v. Bowes*,<sup>58</sup> a newspaper correspondent wrote an article about a courtroom situation and claimed that it was a "real life drama." A playwright then used the story's facts in a play and the correspondent sued for infringement. The court denied protection for plaintiff's work and held that "it is a matter of morals that he who puts forth a thing as verity shall not be heard to allege for profit that it is fiction."<sup>59</sup> It is common, however, for biographers and historians to fictionalize their works to some degree to convey the style of a period or the personality of a subject. As a result, some courts may not regard such a historical work as entirely factual absent an express representation.<sup>60</sup> Thus, the plaintiff would not be estopped from protecting fictional elements of the work.

In some situations the nonfiction author's sequence or arrangement of facts may not be protectible when that particular presentation is prescribed by the actual events.<sup>61</sup> An account that traces a series of events in chronological order is not an original arrangement:

[N]ot only are all the facts recorded in a history in the public domain, but, since the narration of history must proceed chronologically,—or

55. 1 M. NIMMER, *supra* note 2, § 2.11[C], at 2-161.

56. See, e.g., *Marshall v. Yates*, 27 PAT. TRADEMARK & COPYRIGHT J. (BNA) 137, 137-38 (C.D. Cal. 1983); *Mosley v. Follett*, 209 U.S.P.Q. (BNA) 1109, 1113 (S.D.N.Y. 1980); *Huie v. NBC*, 184 F. Supp. 198 (S.D.N.Y. 1960); *Oliver v. St. Germain Found.*, 41 F. Supp. 296 (S.D. Cal. 1941); *Davies v. Bowes*, 209 F. 53 (S.D.N.Y. 1913); 1 M. NIMMER, *supra* note 2, § 2.11[C].

57. *Oliver v. St. Germain Found.*, 41 F. Supp. 296, 299 (S.D. Cal. 1941).

58. 209 F. 53 (S.D.N.Y. 1913).

59. *Id.* at 55; see *Mosley v. Follett*, 209 U.S.P.Q. (BNA) 1109, 1113 (S.D.N.Y. 1980); *Huie v. NBC*, 184 F. Supp. 198, 200 (S.D.N.Y. 1960); *Marshall v. Yates*, 27 PAT. TRADEMARK & COPYRIGHT J. (BNA) 137, 137-38 (C.D. Cal. 1983); 1 M. NIMMER, *supra* note 2, § 2.11[C], at 2-161 to -162; *Gorman*, *supra* note 1, at 1577-78. *Consumers Union of the United States, Inc. v. General Signal Corp.*, 724 F.2d 1044 (2d Cir. 1983), *cert. denied*, 105 S. Ct. 100 (1984) (No. 83-1870), illustrates a variation on this estoppel concept. The court concluded that plaintiff could not complain about defendant's accurate advertising use of a favorable product rating and evaluation published in *Consumers Union's Consumer Reports* in part because plaintiff held out its testing and evaluation process as objective, intending consumers to rely on its ratings. The court viewed *Consumer Reports* as an informational magazine; defendant reported "facts." Therefore, defendant's copying was a fair use. *Id.* at 1048-51. For a more detailed description of the case, see *infra* note 186.

60. The courts' reluctance to label some historical works as entirely factual lessens the impact of the estoppel defense. See 1 M. NIMMER, *supra* note 2, § 2.11[C], at 2-162 (discussing the uncertainty of the estoppel's operation with cases involving books about Clara Barton and Wyatt Earp). Compare *De Acosta v. Brown*, 146 F.2d 408 (2d Cir. 1944), *cert. denied sub nom. Hearst Magazines v. De Acosta*, 325 U.S. 862 (1945) with *Lake v. CBS*, 140 F. Supp. 707 (S.D. Cal. 1956). Historical facts contained in fictional as well as nonfictional works, however, may be repeated without liability for infringement. See *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 978-79 (2d Cir.) (no infringement because the similarities were only of historical material not subject to copyright protection), *cert. denied*, 449 U.S. 841 (1980); *Jason v. Fonda*, 526 F. Supp. 774, 777 (C.D. Cal. 1981), *aff'd*, 698 F.2d 966 (9th Cir. 1982) (plaintiff's book on Vietnam War's effects on women, injured veterans, and soldiers not infringed by movie *Coming Home* because general theme was not protected and all other similarities related to facts, ideas, and sequences that were not protectible); *Mosley v. Follett*, 209 U.S.P.Q. (BNA) 1109, 1113 (S.D.N.Y. 1980).

61. 1 M. NIMMER, *supra* note 2, § 2.11[B], at 2-159; see *Gorman*, *supra* note 1, at 1578; Taylor, *supra* note 5, at 39-41.

at least, such is the convention—the order in which the facts are reported must be the same in the case of a second supposed author.<sup>62</sup>

Several courts also have held that copyright does not protect an author's historical interpretation or theories even though they were original to him.<sup>63</sup> In *Hoehling v. Universal City Studios, Inc.*<sup>64</sup> plaintiff wrote a full-length book about the destruction of the Hindenburg, incorporating his theory about who was responsible for the disaster. He later sued Universal and another author, alleging that they copied his theory. The court held that "where, as here, the idea at issue is an interpretation of an historical event, . . . such interpretations are not copyrightable as a matter of law."<sup>65</sup> The court concluded that historical theories, like ideas, must be left in the public domain so that subsequent authors are free to write about the event.<sup>66</sup>

Although copyright affords some protection to a nonfiction author, it is limited considerably by the rule that facts are not copyrightable. Authors are free to use earlier works;<sup>67</sup> and, "absent wholesale usurpation of another's expression, claims of copyright infringement where works of history are at

62. "There cannot be any such thing as copyright in the order of presentation of the facts, nor, indeed, in their selection, although into that selection may go the highest genius of authorship, for indeed, history depends wholly upon a selection from the undifferentiated mass of recorded facts." *Myers v. Mail & Express Co.*, 36 Copy. Dec. 478, 479 (S.D.N.Y. 1919), quoted in *Norman v. CBS*, 333 F. Supp. 788, 796-97 (S.D.N.Y. 1971). See *Jason v. Fonda*, 526 F. Supp. 774, 777 (C.D. Cal. 1981), *aff'd*, 598 F.2d 966 (9th Cir. 1982); *Morrison v. Solomons*, 494 F. Supp. 218, 225-26 (S.D.N.Y. 1980). A similar rationale has been used to deny protection to an author's style of writing. Plaintiff in *Ricker v. General Electric Co.*, 162 F.2d 141 (2d Cir. 1947), had written two books explaining the fundamentals of radio communications. She used a simple, readily understood writing style that defendant allegedly had copied. The court stated that an author does not have "a monopoly of the idea of expounding . . . information in simple language comprehensible by lay readers," *id.* at 142, and held that defendant was not liable for infringement for using a style of writing similar to plaintiff's style. See also *McMahon v. Prentice-Hall, Inc.*, 486 F. Supp. 1296, 1302 (E.D. Mo. 1980). If the subject matter dictates that facts be expressed in a certain way, that manner of expression cannot be protected. 1 M. NIMMER, *supra* note 2, § 2.11[B], at 2-159 & n.10.

63. *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 978 (2d Cir.), *cert. denied*, 449 U.S. 841 (1980); *Greenbie v. Noble*, 151 F. Supp. 45, 67 (S.D.N.Y. 1957); *Gorman*, *supra* note 1, at 1582-83.

64. 618 F.2d 972 (2d Cir.), *cert. denied*, 449 U.S. 841 (1980).

65. *Id.* at 978. See *Wainwright Sec. Inc., v. Wall St. Transcript Corp.*, 558 F.2d 91 (2d Cir. 1977), in which the court stated that "[w]hat is protected is the manner of expression, the author's analysis or interpretation of events, the way he structures his material and marshals facts, his choice of words, and the emphasis he gives to particular developments." *Id.* at 95-96. This statement that an author's interpretation is protected seems to contradict statements in *Hoehling*. *Wainwright's* facts differed from *Hoehling's*, however, suggesting that there is no inconsistency between the cases. Defendant in *Wainwright* appropriated plaintiff's analytical reports on major corporations and included the "most creative and original aspects of the reports" verbatim in its own publication. *Id.* at 96. The court stressed that defendant repeatedly used not only plaintiff's theories and research, but also its expression. See also *Harper & Row, Publishers, Inc. v. Nation Enters.*, 723 F.2d 195, 207 n.19 (2d Cir. 1983) (distinguishing *Wainwright*), *cert. granted*, 104 S. Ct. 2655 (1984) (No. 83-1632).

66. *Hoehling*, 618 F.2d at 978 ("[t]o avoid a chilling effect").

67. *Id.* ("broad latitude must be granted to subsequent authors"). See, e.g., *Landsberg v. Scrabble Crossword Game Players, Inc.*, 736 F.2d 485 (9th Cir. 1984) (for infringement of factual works, "similarity of language may have to amount to verbatim reproduction or very close paraphrasing"); *Eisenschiml v. Fawcett Publications, Inc.*, 246 F.2d 598 (7th Cir.), *cert. denied*, 355 U.S. 907 (1957); *Lake v. CBS*, 140 F. Supp. 707 (S.D. Cal. 1956); *Caruthers v. RKO Radio Pictures, Inc.*, 20 F. Supp. 906 (S.D.N.Y. 1937); *Maddux v. Grey*, 43 F.2d 441 (S.D. Cal. 1930); *Gorman*, *supra* note 1, at 1583.

issue are rarely successful.'"<sup>68</sup> If a nonfiction author cannot show verbatim reproduction or close paraphrasing of his form of expression,<sup>69</sup> he will be unable to protect his research unless the court recognizes an extension of copyright theory or a common-law claim.<sup>70</sup>

### III. COPYRIGHT PROTECTION FOR THE PRODUCT OF RESEARCH

#### A. *The Toksvig Rule*

Plaintiff in *Toksvig v. Bruce Publishing Co.*<sup>71</sup> wrote a biography about Hans Christian Andersen. Her research spanned three years and was derived exclusively from Danish sources, including Andersen's original works and letters. Defendant subsequently wrote a book based on Andersen's life after less than a year of researching English sources, including plaintiff's biography. The court concluded that defendant had copied twenty-four specific passages, as well as certain general concepts about Andersen, his life, and his friends, that had first appeared in plaintiff's book. Defendant argued that these materials were in the public domain, that she could have secured the same information from other works, and that this was a fair use of plaintiff's work.<sup>72</sup> The court stated that, in determining whether defendant infringed plaintiff's copyright:

[t]he question is not whether [defendant] could have obtained the same information by going to the same sources, but rather did she go to the same sources and do her own independent research? In other words, the test is whether the one charged with the infringement has made an independent production, or made a substantial and unfair use of the complainant's work.<sup>73</sup>

The record established that defendant had not reviewed the original sources and that her use of plaintiff's work had enabled her to complete her book in less than one-third the time; accordingly, the court held that defendant had infringed plaintiff's copyright.<sup>74</sup> Although this result could be justified be-

68. *Mosley v. Follett*, 209 U.S.P.Q. (BNA) 1109, 1113 (S.D.N.Y. 1980) (quoting *Hoehling*, 618 F.2d at 974); see Taylor, *supra* note 5, at 34 ("historians and biographers . . . have received scant judicial support in their attempts to protect their work product from exploitation").

69. "A verbatim reproduction or close paraphrasing of even a historical or factual work constitutes copyright infringement." *Suid v. Newsweek Magazine*, 503 F. Supp. 146, 148 (D.D.C. 1980); accord *Landsberg v. Scrabble Crossword Game Players, Inc.*, 736 F.2d 485, 488 (9th Cir. 1984).

70. See *Miller v. Universal City Studios, Inc.*, 650 F.2d 1365, 1372 (5th Cir. 1981), *rev'g* 460 F. Supp. 984 (S.D. Fla. 1978) (research not copyrightable; otherwise proper jury instruction stating that research was copyrightable held reversible error); *infra* text accompanying notes 71-136; see also *Suid v. Newsweek Magazine*, 503 F. Supp. 146 (D.D.C. 1980).

71. 181 F.2d 664 (7th Cir. 1950).

72. *Id.* at 666-67.

73. *Id.* at 667.

74. *Id.*; see *Amsterdam v. Triangle Publications*, 189 F.2d 104 (3d Cir. 1951) (plaintiff denied recovery against newspaper that concededly copied his map because copyright on map was invalid because plaintiff had prepared it from several existing maps rather than doing any surveying); see also *Eisenschiml v. Fawcett Publications, Inc.*, 246 F.2d 598, 602-03 (7th Cir.) (no infringement occurred because defendant had done substantial independent research and similarities between his work and plaintiff's work were insufficient), *cert. denied*, 355 U.S. 907 (1957).

cause of defendant's substantial close copying of twenty-four passages, some translated from Danish sources, the holding is much broader: plaintiff biographer had a protectible interest in her research.<sup>75</sup>

*Holdredge v. Knight Publishing Corp.*<sup>76</sup> applied *Toksvig*, holding that defendants infringed plaintiff's historical biography by using it almost exclusively as the source for an article.<sup>77</sup> Plaintiff had done a considerable amount of research; defendant spent only three days researching his work and a fourth day writing.<sup>78</sup> It was clear from defendant's exclusive reliance on the earlier work as source material, the short amount of time he spent in research and writing, and the numerous similarities between the two works that defendant had done no independent research. As in *Toksvig*, infringement could have been based on substantial paraphrasing and verbatim copying.<sup>79</sup> The court, however, relied on *Toksvig* and extended copyright protection to the factual product of the research. Thus, under *Toksvig* and *Holdredge* a second author must do independent research to avoid relying on the facts uncovered by another's research.<sup>80</sup>

The protection afforded by the *Toksvig* rule, however, is not absolute. First, if the alleged infringer conducted independent research, infringement cannot be based on factual similarities between his work and an earlier one.<sup>81</sup> Second, an author can use a copyrighted work to find sources, if he then uses those sources.<sup>82</sup> Last, under the fair-use doctrine, one may "use the copyrighted material in a reasonable manner without [the owner's] consent."<sup>83</sup>

75. 1 M. NIMMER, *supra* note 2, § 2.11[E], at 2-165 to -166 & n.35; Gorman, *supra* note 1, at 1583-84; Hill, *supra* note 6, at 46-48; Taylor, *supra* note 5, at 47-50. The holding also rested in part on the protection copyright affords to translations. 17 U.S.C. §§ 101, 103 (1982) (definition and protection of "derivative works"). Although the court correctly stated that public domain materials cannot be protected by copyright, and found evidence that plaintiff was the author of the specific passages in question, *Toksvig*, 181 F.2d at 666, it went too far by implying that the copyright of a translation of a public domain work would extend to the underlying work. Because the translator is not the author of the underlying work, there is no originality in his work, except for that which is evidenced by the translation itself. Section 103(b) establishes that the translator's copyright to his derivative work does not establish any rights to the preexisting material he translated. 17 U.S.C. § 103(b) (1982).

76. 214 F. Supp. 921 (S.D. Cal. 1963).

77. Defendant author admitted that he did no original research, that one of plaintiff's books was the source of much of his article, and that his only other research consisted of skimming two books. *Id.* at 923.

78. *Id.* at 922-23. The introduction and bibliographies of both of plaintiff's books demonstrated the extent of her research and the available sources; she claimed to have worked eight or nine years on the books. *Id.*

79. *Id.* at 923-24. Defendant copied plaintiff's form of expression.

80. Gorman, *supra* note 1, at 1584 (critical of results); see Taylor, *supra* note 5, at 52-53. Some language in the *Toksvig* opinion indicated that if defendant relied solely on plaintiff's non-fiction book in writing his article, an infringement could be found even if defendant had avoided using plaintiff's form of expression and had used only the facts. See also *Triangle Publications, Inc. v. New England Newspaper Publishing Co.*, 46 F. Supp. 198 (D. Mass. 1942) (conversion of facts into sentence form prohibited by copyright); B. KAPLAN, *supra* note 51, at 62.

81. *Eisenschiml v. Fawcett Publications*, 246 F.2d 598, 602-03 (7th Cir.), cert. denied, 355 U.S. 907 (1957); *Toksvig*, 181 F.2d at 667; see Taylor, *supra* note 5, at 49.

82. *Benny v. Loew's Inc.*, 239 F.2d 532, 536 (9th Cir. 1956). See 1 M. NIMMER, *supra* note 2, § 2.11[E], at 2-168 (plaintiff's work can be used for leads and clues).

83. *Toksvig*, 181 F.2d at 666 (citing H. BALL, *THE LAW OF COPYRIGHT AND LITERARY PROPERTY* § 125, at 260 (1944)); *Denicola, supra* note 6, at 524; cf. Hill, *supra* note 6, at 48-49. The

Generally, however, *Toksvig* requires independent research by a subsequent author. Even though this may require some duplicative efforts,<sup>84</sup> several arguments favor such an extension of copyright to protect an author's research.

## B. Arguments Supporting Toksvig

### 1. The Fruits of Independent Labors

A nonfiction author should have to do his own research and abstracting, so that his work will be original and valuable to society.<sup>85</sup> The first author's efforts are rewarded by copyright protection, and the public may benefit from

---

doctrine is codified at 17 U.S.C. § 107 (1982). The activities the doctrine permits include "quotation of excerpts in a review or criticism for purposes of illustration or comment; quotation of short passages in a scholarly or technical work, for illustration or clarification of the author's observations; [and] . . . summary of an address or article, with brief quotations, in a news report . . ." H.R. REP., *supra* note 27, at 65. Section 107 enumerates various characteristics for the court to examine before determining whether a particular use is fair: "(1) the purpose and character of the use . . . ; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work." 17 U.S.C. § 107 (1982).

84. Note that copyright law, to prevent such duplicative effort, does not protect ideas and facts. Gorman, *supra* note 1, at 1582-84. Professor Nimmer argues that the first amendment may limit *Toksvig*: "[w]hile freedom of speech generally is not impermissibl[y] abridged by copyright protection for 'expression,' to grant a copyright monopoly to facts as such would constitute an intolerable limitation on First Amendment rights." 1 M. NIMMER, *supra* note 2, § 2.11[E], at 2-167. *Contra* Hill, *supra* note 6, at 65 (fair use is adequate to protect the public interest in the free dissemination of information). In 1982 the United States Court of Appeals for the the Second Circuit noted that "[n]o Circuit that has considered the question . . . has ever held that the First Amendment provides a privilege in the copyright field distinct from the accommodation embodied in the 'fair use' doctrine." *Roy Export Co. v. CBS*, 672 F.2d 1095, 1099 (2d Cir. 1982). The court refused to accept CBS's argument that its obituarial use of plaintiff's compilation of highlights from Charlie Chaplin's films was protected by a first amendment privilege. In a 1983 decision, however, the same court acknowledged that the Copyright Act, by protecting expression rather than facts and ideas, protects authors without impeding the public's access to information and without abridging freedom of expression. *Harper & Row, Publishers, Inc., v. Nation Enters.*, 723 F.2d 195, 202 (2d Cir. 1983), *cert. granted*, 104 S. Ct. 2655 (1984) (No. 83-1632). In the work at issue—an article derived from President Ford's memoirs—the need to construe the concept of protectibility by copyright in accordance with the first amendment was especially important because the article described significant factual political events that are not protectible by copyright. *See also Consumers Union of the United States, Inc. v. General Signal Corp.*, 724 F.2d 1044, 1049 (2d Cir. 1983), *cert. denied*, 53 U.S.L.W. 3236 (U.S. Oct. 1, 1984).

85. Jackson, "Fact Works": *Copyrightability and Infringement*, 45 J. PAT. OFF. SOC'Y 833, 841-46 (1963).

The source of any created work . . . [including fact works] . . . is the changing, infinitely complex reality of our total environment, unordered and unlimited. . . . The protection of copyright requires a subsequent creator to go through a similar process of abstraction and creation in order to profit from the sale of another work of the same kind during the life of the original copyright. Society has nothing to lose by this requirement, for only by independently carrying out another abstracting process can the second author possibly create a work that is different, and therefore, that is of additional value to society.

*Id.* at 841-42. *See also* Fred Fisher, Inc. v. Dillingham, 298 F. 145, 150-51 (S.D.N.Y. 1924). Similar arguments have been made with regard to maps. Some courts have required cartographers to do their own surveying, exploring, and inquiring to create a copyrightable map instead of allowing a selection and combination of materials from existing maps. *See, e.g., Amsterdam v. Triangle Publications, Inc.*, 189 F.2d 104, 106 (3d Cir. 1951) ("for a map to be copyrightable its preparation must involve a modicum of creative work"). *But see* *United States v. Hamilton*, 583 F.2d 448 (9th Cir. 1978) (direct-observation rule criticized strongly because it goes beyond the level of originality required by copyright law); 1 M. NIMMER, *supra* note 2, § 2.08[A], at 2-79 to -82 (same); Gorman, *supra* note 1, at 1571-76 (same).

another's original treatment of the same subject.<sup>86</sup> This approach, however, requires an inordinately high level of originality from the subsequent author; the law usually does not demand novelty for a work to be entitled to copyright protection, but merely requires that the work "owes its origin" to the "author."<sup>87</sup> The independent research argument discourages writers from building on the contributions of earlier authors:<sup>88</sup> "A dwarf standing on the shoulders of a giant can see further than the giant himself."<sup>89</sup>

## 2. Protection from Unfair Competition

In addition to encouraging original works by subsequent authors, the *Toksvig* rule also protects the first researcher from unfair competition.<sup>90</sup> It prevents subsequent authors from "reap[ing] where [they have] not sown."<sup>91</sup>

As it is necessary to reward the effort and ingenuity involved in giving expression to a fact, it is necessary also, if we are to expect individuals to labor on [the public's] behalf, to reward the effort and ingenuity involved in obtaining knowledge of the fact.

. . . [T]o hold other than [that] research is copyrightable is to violate the spirit of the copyright law and to provide to those . . . lacking in requisite diligence and ingenuity a license to steal.<sup>92</sup>

Despite these arguments, it is improper to substitute the amorphous concept of unfair competition for the standards of copyright protection and infringement because it can extend the monopoly to public domain materials. Although it may seem unfair for an author to use a predecessor's research, copyright infringement is not the appropriate cause of action to remedy such use unless the alleged infringer has copied protected original elements in the first author's work.<sup>93</sup>

86. *E.g.*, *Reyher v. Children's Television Workshop*, 533 F.2d 87, 90 (2d Cir. 1976). One commentator has argued that the *Toksvig* rule ensures that facts are presented accurately, and that a desire for reasonable accuracy is "of greater public utility than a competing desire to encourage the indiscriminate wholesale merchandising of [historical accounts and trivia]." Taylor, *supra* note 5, at 54.

87. *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102 (2d Cir. 1951) (quoting *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 57-58 (1884)). The law requires "little more than a prohibition of actual copying." *Id.* at 103 (quoting *Hoague-Sprague Corp. v. Frank C. Meyer Co.*, 31 F.2d 583, 586 (E.D.N.Y. 1929)). See *supra* note 19.

88. *Cf. Denicola, supra* note 6, at 525. This argument also extends protection to facts in violation of § 102(b) of the Act.

89. Chafee, *Reflections on the Law of Copyright* (pt. 1), 45 COLUM. L. REV. 503, 511 (1945).

90. *Cf. Marling v. Ellison*, 218 U.S.P.Q. (BNA) 702, 711 (S.D. Fla. 1982) (justifying protection for compilations); 1 M. NIMMER, *supra* note 2, § 3.04, at 3-16; Gorman, *supra* note 1, at 1583-84.

91. *International News Serv. v. Associated Press*, 248 U.S. 215, 239 (1918); *cf. Witt Anderson Co. v. Baldwin Publishing Co.*, 27 F.2d 82, 89 (6th Cir. 1928) (use of source material in non-competitive work does not violate copyright).

92. *Miller v. Universal City Studios, Inc.*, 460 F. Supp. 984, 988 (S.D. Fla. 1978), *rev'd*, 650 F.2d 1365 (5th Cir. 1981).

93. 1 M. NIMMER, *supra* note 2, § 3.04, at 3-16. The United States Court of Appeals for the Second Circuit has repudiated the cases and reasoning that extend copyright to protect an author's labor. *Harper & Row Publishers, Inc. v. Nation Enters.*, 723 F.2d 195, 203 n.11 (2d Cir. 1983), *cert. granted*, 104 S. Ct. 2655 (1984) (No. 83-1632).

### 3. The Compilation Analogy

The strongest argument for extending copyright protection to research is that the analogous efforts of "authors" who compile data are protected.<sup>94</sup> Copyright protects works that are simply compilations of unprotectible facts and data, such as directories, catalogues, listings, codes, and indices.<sup>95</sup> Because the historian's work is more creative than the compiler's, the law arguably also should protect the historian at least as fully as the compiler.<sup>96</sup>

A compilation is a collection of preexisting materials, which in themselves may not be protectible by copyright,<sup>97</sup> "that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship."<sup>98</sup> Protection usually is limited to the author's original contribution and not the preexisting materials.<sup>99</sup> When a compiler exercises judgment in selecting, presenting, or arranging particular uncopyrightable data, the selection<sup>100</sup> and arrangement are protectible by copyright,<sup>101</sup> but the data itself is not.<sup>102</sup> Thus, the scope of copyright protection for a compilation of public domain materials is limited.<sup>103</sup>

94. See 1 M. NIMMER, *supra* note 2, § 2.11[D], at 2-163 to -164; Hill, *supra* note 6, at 56-58.

95. 17 U.S.C. §§ 101 (definition of "compilation"), 103(a) (copyright law protects compilations) (1982); 1 M. NIMMER, *supra* note 2, § 2.04[B], at 2-40 to -42; Denicola, *supra* note 6, at 527.

96. Denicola, *supra* note 6, at 527-38, 542; Taylor, *supra* note 5, at 48-49. "Less protection should be given to a compilation of names in a directory than to a compilation of facts," since the latter requires "greater originality in selection." 1 M. NIMMER, *supra* note 2, § 2.11[D], at 2-163; see also Hill, *supra* note 6, at 58-59.

97. 1 M. NIMMER, *supra* note 2, § 2.04[B], at 2-41.

98. 17 U.S.C. § 101 (1982) (definition of "compilation"). See, e.g., *New York Times Co. v. Roxbury Data Interface, Inc.*, 434 F. Supp. 217 (D.N.J. 1977); *Dow Jones & Co. v. Board of Trade*, 546 F. Supp. 113 (S.D.N.Y. 1982); *National Business Lists, Inc. v. Dun & Bradstreet, Inc.*, 215 U.S.P.Q. (BNA) 595 (N.D. Ill. 1982); *Marling v. Ellison*, 218 U.S.P.Q. (BNA) 702, 711 (S.D. Fla. 1982).

99. See 17 U.S.C. § 103(b) (1982).

100. See *infra* notes 120-36 and accompanying text.

101. See, e.g., *Flick-Reedy Corp. v. Hydro-Line Mfg. Co.*, 351 F.2d 546 (7th Cir. 1965), *cert. denied*, 383 U.S. 958 (1966); *Hartfield v. Peterson*, 91 F.2d 998 (2d Cir. 1937).

102. 1 M. NIMMER, *supra* note 2, § 3.04, at 3-13 to -14. The data is not original to the author.

103. See *Financial Information v. Moody's*, 1984 COPYRIGHT L. REP. (CCH) ¶ 25,617, at 18,765 (S.D.N.Y. Jan. 10, 1984). Thus, a compiler's copyright can prohibit only the reproduction of a substantial amount of his original work, an appropriation of his selection of data, or the copying of his arrangement. See 1 M. NIMMER, *supra* note 2, § 3.04, at 3-16 to -17; cf. *Continental Casualty Co. v. Beardsley*, 253 F.2d 702, 705 (2d Cir. 1958); see also *National Business Lists, Inc. v. Dun & Bradstreet, Inc.*, 215 U.S.P.Q. (BNA) 595, 598-600 (N.D. Ill. 1982); Denicola, *supra* note 6, at 530-33.

Protection should not extend to the public domain materials in the work. 17 U.S.C. §§ 102(b), 103(b) (1982); see *Triangle Publications, Inc. v. Sports Eye, Inc.*, 415 F. Supp. 682, 685-86 (E.D. Pa. 1976); 1 M. NIMMER, *supra* note 2, § 3.04, at 3-16. Two publishers may compile, arrange, and distribute almanacs with lists, census data, election results, sports information, and statistics. Because that data is not protectible by copyright, a publisher cannot complain that a competitor has the same information in its book. Assuming that the data is not interpreted in either of the almanacs, copyright protects only against the close copying of particular selections or arrangements. Because many ways exist to arrange the information contained in an almanac, as well as an almost endless supply of data from which to select, it should not be difficult for a competitor to avoid infringement. See also 1 M. NIMMER, *supra* note 2, § 2.11[E], at 2-164; cf. *Harcourt, Brace & World, Inc. v. Graphic Controls Corp.*, 321 F. Supp. 517, 524-25 (S.D.N.Y. 1971).

a. *The "sweat of the brow" rationale*

Some decisions, however, have prevented copying of public domain materials in a compilation<sup>104</sup> by extending protection to a compiler's labor in preparing the work.<sup>105</sup> These sweat-of-the-brow decisions recognize that the value of a compilation is its collection of previously unavailable data.<sup>106</sup> Thus, the compilation process is protected, rather than the arrangement of the data.<sup>107</sup> These decisions conclude that protection is necessary as an incentive for the creation of such works.<sup>108</sup> Because nonfiction authors labor to select and arrange unprotectible facts, the sweat-of-the-brow rationale also would seem appropriate for the protection of their research.<sup>109</sup> The extension of this doctrine to nonfiction narratives would require subsequent authors to do independent research rather than rely on the research efforts of others.<sup>110</sup>

The sweat-of-the-brow expansion of copyright to protect the labor of the

104. 1 M. NIMMER, *supra* note 2, § 3.04, at 3-14.

105. *See, e.g.*, *Schroeder v. William Morrow & Co.*, 566 F.2d 3, 6 (7th Cir. 1977); *Leon v. Pacific Tel. & Tel. Co.*, 91 F.2d 484, 486 (9th Cir. 1937); *Rand McNally & Co. v. Fleet Management Sys., Inc.*, COPYRIGHT L. REP. (CCH) ¶ 25,624 (N.D. Ill. Dec. 31, 1983); *Marling v. Ellison*, 218 U.S.P.Q. (BNA) 702, 711 (S.D. Fla. 1982) (*dicta*); *National Business Lists, Inc. v. Dun & Bradstreet, Inc.*, 215 U.S.P.Q. (BNA) 595, 598-99 (N.D. Ill. 1982); *Southwestern Bell Tel. Co. v. Nationwide Indep. Directory Serv., Inc.*, 371 F. Supp. 900, 905 (W.D. Ark. 1974); *Triangle Publications, Inc. v. New England Newspaper Publishing Co.*, 46 F. Supp. 198, 202 (D. Mass. 1942). *Leon* is a leading decision in which plaintiff alleged infringement of its alphabetically arranged telephone directory. Relying exclusively on plaintiff's directory, defendants had rearranged the names and telephone numbers in numerical order. Even though defendants did not copy plaintiff's protected alphabetical arrangement, the court enjoined the publication and distribution of the directories, holding that the copying and rearranging of data was infringement. The court held that defendant's fair-use defense was not applicable because wholesale copying and publication of protected material could not be fair use. *Leon*, 91 F.2d at 486. The best explanation of this decision is that the court wanted to protect plaintiff's labor in compiling the data. The opinion failed to consider that names, numbers, and addresses are not protectible by copyright and that protection extends only to plaintiff's arrangement. Instead, it emphasized that the business of publishing such a directory involves skill, ingenuity, expense, and original research. *Id.*; *see also Gorman, supra* note 1, at 1572-73, 1584-89 (discussing the sweat-of-the-brow rationale with respect to maps and directories).

106. *National Business Lists, Inc. v. Dun & Bradstreet, Inc.*, 215 U.S.P.Q. (BNA) 595, 598 (N.D. Ill. 1982)

107. *See Dow Jones & Co. v. Board of Trade*, 217 U.S.P.Q. (BNA) 901, 904 (S.D.N.Y. 1982) (compilation deemed an original work because of the author's labors); *see also Southern Bell Tel. & Tel. Co. v. Associated Tel. Directory Publishers*, 221 U.S.P.Q. (BNA) 132, 136 (N.D. Ga. 1983) (effort and selection equals authorship); *Rand McNally & Co. v. Fleet Management Sys. Inc.*, COPYRIGHT L. REP. (CCH) ¶ 25,624, at 18,804-06 (N.D. Ill. Dec. 31, 1983) (plaintiff must show that its original contributions constitute a sufficient effort to protect compilation); *Marling v. Ellison*, 218 U.S.P.Q. (BNA) 702, 711 (S.D. Fla. 1982) (*dicta*).

108. *National Business Lists Inc. v. Dun & Bradstreet, Inc.*, 215 U.S.P.Q. (BNA) 595, 599 (N.D. Ill. 1982)

109. *See Denicola, supra* note 6, at 529-35. Professor Denicola suggests that the act of aggregating isolated items of information can be authorship and the resulting collection of data a work of authorship.

110. Applying this doctrine to nonfiction works, a historian's well-researched and copyrighted account of a World War II battle would be infringed if a subsequent author prepared another work on that battle without doing independent research. *See Huie v. NBC*, 184 F. Supp. 198 (S.D.N.Y. 1960). It would not be a sufficient defense to argue that facts cannot be protected and that no originality exists in a chronological arrangement of facts. *Myers v. Mail & Express Co.*, 36 Copy. Dec. 478, 479 (S.D.N.Y. 1919). This doctrine is similar to the *Toksvig* rule. *See generally* 1 M. NIMMER, *supra* note 2, § 2.11[E], at 2-166; *Taylor, supra* note 5, at 49.



compiler (and possibly the researcher) has been criticized sharply.<sup>111</sup> It requires undue originality from a second author<sup>112</sup> and gives the compiler a monopoly in public domain materials.<sup>113</sup> Such expansion contradicts the basic principles of copyright codified in section 102(b) of the Copyright Act.<sup>114</sup> Furthermore, the expanded protection contradicts sections 101 and 103, which expressly limit protection to the compiler's original selection or arrangement.<sup>115</sup> Accordingly, the United States Courts of Appeals for the Second and Fifth Circuits have rejected the sweat-of-the-brow rationale in the context of nonfiction authors and compilers.<sup>116</sup>

Limiting protection to the researcher's original arrangement and selection arguably undermines the economic incentive to discover and compile public domain information.<sup>117</sup> Requiring the second author to retrace his predecessor's steps, however, discourages new works and contravenes copyright's primary purpose. The copyright on the first author's selection or arrangement requires a subsequent author to rearrange the data so as to arrange it in his own manner and, thus, exercise independent judgment.<sup>118</sup> Restricting copy-

111. See, e.g., 1 M. NIMMER, *supra* note 2, §§ 2.11[E], at 3.04; Gorman, *supra* note 1, at 1584-86. *Contra* Denicola, *supra* note 6, at 540-41 (first amendment right of free speech generally not infringed by copyrighting collections of facts in nonfiction works).

112. 1 M. NIMMER, *supra* note 2, § 3.04, at 3-16. The person who discovers facts has performed an important task, but his labor is not authorship.

113. 1 M. NIMMER, *supra* note 2, § 3.04, at 3-16.

114. 17 U.S.C. § 102(b) (1982). Section 102(b) provides: "In no case does copyright protection for an original work of authorship extend to any idea . . . or discovery, regardless of the form in which it is described, [or] explained . . . in such work." This provision states the basic dichotomy between protectible expression and unprotectible ideas, and clarifies that "copyright does not preclude others from using the ideas or information revealed by an author's work." H.R. REP., *supra* note 27, at 56-57; see also National Business Lists, Inc. v. Dun & Bradstreet, Inc., 215 U.S.P.Q. (BNA) 595, 599 (N.D. Ill. 1982) ("[P]rotection of the fruit of a compiler's labor may be a doctrine in search of conceptual underpinnings . . ."); Financial Information, Inc. v. Moody's, 1984 COPYRIGHT L. REP. (CCH) ¶ 25,617, at 18,765 (S.D.N.Y. Jan. 10, 1984).

115. Triangle Publications, Inc. v. Sports Eye, Inc., 415 F. Supp. 682, 686 (E.D. Pa. 1976); see also 17 U.S.C. §§ 101, 103 (1982). Section 103(b) provides that copyright on a compilation does not protect the preexisting or public domain material in the work, but only the author's original contribution—the author's selection, coordination or arrangement of that material. Although the Copyright Act of 1909 similarly limited the scope of protection afforded to such works, see Act of Mar. 4, 1909, ch. 320, §§ 7, 64, 35 Stat. 1075, 1088 (repealed 1976), section 103(b) is "intended to define, more sharply and clearly than does section 7 of [the 1909 Act], the important interrelationship and correlation between protection of preexisting works and of 'new' material in a particular work." H.R. REP., *supra* note 27, at 57.

116. See Harper & Row, Publishers, Inc. v. Nation Enters., 723 F.2d 195, 202 n.8, 203 n.11 (2d Cir. 1983), *cert. denied*, 104 S. Ct. 2655 (1984) (No. 83-1632); Miller v. Universal City Studios, Inc., 650 F.2d 1365 (5th Cir. 1981); Hoehling v. Universal City Studios, Inc., 618 F.2d 972 (2d Cir.), *cert. denied*, 449 U.S. 841 (1980); 1 M. NIMMER, *supra* note 2, § 2.11[E] at 2-167 (Watgate example). This principle also was recognized prior to the 1909 Copyright Act. In Simms v. Stanton, 75 F. 6, 13 (C.C.N.D. Cal. 1896), the court stated that, "[t]here is no recognized principle which will prevent a subsequent compiler from copying materials from an existing compilation, and arranging them and combining them in a new form." *Id.* (quoting E. DRONE, A TREATISE OF THE LAW OF PROPERTY IN INTELLECTUAL PRODUCTIONS 424 (1879)).

117. See National Business Lists, Inc. v. Dun & Bradstreet, Inc., 215 U.S.P.Q. (BNA) 595, 598 (N.D. Ill. 1982) (incentives are "swept away" if protection is so limited); Denicola, *supra* note 6, at 530; Taylor, *supra* note 5, at 53-54.

118. See National Business Lists, Inc. v. Dun & Bradstreet, Inc., 215 U.S.P.Q. (BNA) 595, 599 (N.D. Ill. 1982); 1 M. NIMMER, *supra* note 2, § 3.04, at 3-16 to -16.1; see also Mazer v. Stein, 347 U.S. 201, 219 (1954) (primary purpose of copyright is to encourage the production of works of authorship with reward to the author being a secondary consideration).

right protection to a compiler's original selection and arrangement ensures that the copyright monopoly cannot extend to public domain materials, regardless of the manner in which they are described or explained.<sup>119</sup>

*b. The subjective selection rationale*

Some courts have held compilations to be protected, not because of the compiler's labor, but because he "exercised subjective judgment and selectivity in choosing items to list."<sup>120</sup> The selection of the data, apart from the data's arrangement, is recognized as original, protectible authorship.<sup>121</sup> This doctrine is supported by the Copyright Act's express protection of a compilation, which is defined as "a work formed by the collection . . . of data that are *selected . . . or arranged* in such a way that the resulting work as a whole constitutes an original work of authorship."<sup>122</sup>

For a work to be protectible, however, the selection must involve some significant subjective judgment.<sup>123</sup> An ordinary telephone directory would not be protected because no judgment is used in selecting the numbers and names.<sup>124</sup> Similarly, compilations in which the selection is dictated by functional considerations, such as a listing of ingredients, also are not protectible.<sup>125</sup> In contrast, subjective judgment is required in choosing names to

119. See 17 U.S.C. §§ 102(b), 103(b) (1982); 1 M. NIMMER, *supra* note 2, § 3.04, at 3-16 to -17. Regardless of the amount of "sweat on the compiler's brow," if his original selection or arrangement of data is not copied, no basis exists for finding copyright infringement. 1 M. NIMMER, *supra* note 2, § 3.04, at 3-16.1 to -17; see also Harper & Row, Publishers, Inc. v. Nation Enters., 723 F.2d 195, 202 n.8 (2d Cir. 1983), *cert. granted*, 104 S. Ct. 2655 (1984) (No. 83-1632). It is not clear whether courts will disregard those decisions that prevent the copying of public domain material and thereby require a second compiler to gather his own data. N. BOORSTYN, *supra* note 1, § 2.19, at 60-61. See, e.g., Marling v. Ellison, 218 U.S.P.Q. (BNA) 702, 722 (S.D. Fla. 1982). Although these decisions encourage independent research, 1 M. NIMMER, *supra* note 2, § 3.04, at 3-16; cf. Taylor, *supra* note 5, at 54 (public interest in having historians do independent research), and prohibit misappropriation of the compiler's labors, National Business Lists, Inc. v. Dun & Bradstreet, Inc., 215 U.S.P.Q. (BNA) 595, 598-601 (N.D. Ill. 1982), they undermine the Copyright Act's limitations on protection and may offend first amendment interests. See *supra* notes 111-18 and accompanying text.

120. Dow Jones & Co. v. Board of Trade, 217 U.S.P.Q. (BNA) 901, 903 (S.D.N.Y. 1982); Ecks v. Card Prices Update, 736 F.2d 859, 862-63 (2d Cir. 1984); see also Adventures in Good Eating, Inc. v. Best Places to Eat, Inc., 131 F.2d 809, 812-13 (7th Cir. 1942); College Entrance Book Co. v. Amsco Book Co., 119 F.2d 874, 875-76 (2d Cir. 1941); List Publishing Co. v. Keller, 30 F. 772, 773 (C.C.S.D.N.Y. 1887); Meredith Corp. v. Harper & Row, Publishers, Inc., 413 F. Supp. 385 (S.D.N.Y. 1975); Denicola, *supra* note 6, at 530-35; cf. Taylor, *supra* note 5, at 41-42 (historian's selection and arrangement of facts may be copyrighted).

121. See 1 M. NIMMER, *supra* note 2, § 3.04, at 3-16.1; Denicola, *supra* note 5, at 531.

122. 17 U.S.C. § 101 (1982) (emphasis added).

123. See Ecks v. Card Prices Update, 736 F.2d 859, 862-63 (2d Cir. 1984); Dow Jones & Co. v. Board of Trade, 217 U.S.P.Q. (BNA) 901, 903 (S.D.N.Y. 1982); New York Times Co. v. Roxbury Data Interface, Inc., 434 F. Supp. 217, 222 n.2 (D.N.J. 1977); 1 M. NIMMER, *supra* note 2, § 2.04[B], at 2-41 to 2-42, & n.15.1.

124. New York Times Co. v. Roxbury Data Interface, Inc., 434 F. Supp. 217, 222 n.2 (D.N.J. 1977). A telephone directory is usually protected because of its arrangement or, in some jurisdictions, because of the author's labor in compiling it. See, e.g., Schroeder v. William Morrow & Co., 566 F.2d 3, 5 (7th Cir. 1977); Leon v. Pacific Tel. & Tel. Co., 91 F.2d 484, 486 (9th Cir. 1937).

125. See, e.g., Kitchens of Sara Lee, Inc. v. Nifty Foods Corp., 266 F.2d 541, 544 (2d Cir. 1959); 1 M. NIMMER, *supra* note 2, § 2.01[B], at 2-14 to -15.

include in a social register,<sup>126</sup> stocks to include in the Dow Jones listings,<sup>127</sup> or names and data to include in credit reference books;<sup>128</sup> these compilations therefore are protectible.

A historian, journalist, or biographer also exercises subjective judgment in deciding which facts to include in his narrative; it may be argued, therefore, that the collection of facts in his book is a protectible work of authorship.<sup>129</sup> The compilation and directory cases, however, often are interpreted as a separate classification,<sup>130</sup> analogizing these cases to other factual works may be inappropriate.<sup>131</sup> Section 103(b) requires an original contribution beyond pre-existing facts, and the section 101 definition of compilation must not be interpreted so expansively as to undermine that requirement.<sup>132</sup> Facts should not be protectible merely because the author exercised judgment in choosing them;<sup>133</sup> furthermore, since the narration of facts ordinarily proceeds chronologically, the arrangement of the facts is not protectible.<sup>134</sup> Any copyright protection of facts—whether for selection, arrangement, labor, or fair competition—requires subsequent authors to engage in wasteful, duplicative re-

126. See *New York Times Co. v. Roxbury Data Interface, Inc.*, 434 F. Supp. 217, 222 n.2. (D.N.J. 1977); *List Publishing Co. v. Keller*, 30 F. 772 (C.C.S.D.N.Y. 1887).

127. *Dow Jones & Co. v. Board of Trade*, 217 U.S.P.Q. (BNA) 901, 904 (S.D.N.Y. 1982) (selection and analysis of certain blue chip stocks representing a variety of business endeavors as the basis for the determination of the Dow Jones Averages, held to be a list subject to copyright protection)

128. *National Business Lists, Inc. v. Dun & Bradstreet, Inc.*, 215 U.S.P.Q. (BNA) 595 (N.D. Ill. 1982) (plaintiff entitled to recover even though its arrangement not copied); see also *Eckes v. Card Prices Update*, 736 F.2d 859 (2d Cir. 1984) (selection and listing of baseball cards and values protectible); *Meredith Corp. v. Harper & Row, Inc.*, 413 F. Supp. 385, 386-87 (S.D.N.Y. 1975) (copyright protection for topic selection and arrangement of textbook).

129. *Denicola*, *supra* note 6, at 538, 542.

130. *Eckes v. Card Prices Update*, 736 F.2d 859, 862 (2d Cir. 1984); *Financial Information, Inc. v. Moody's, COPYRIGHT L. REP. (CCH) ¶ 25,617*, at 18,765 (S.D.N.Y. Jan 10, 1984). *But see National Business Lists, Inc. v. Dun & Bradstreet, Inc.*, 215 U.S.P.Q. (BNA) 595, 601 (N.D. Ill. 1982) (“[D]irectory cases, rather than being a breed apart, are the most striking illustrations in copyright law that the misappropriation doctrine [has found a home].”). See also *Note*, *supra* note 6, at 627-31 (This note criticizes setting the directory cases apart as a separate classification for fear that some works will be denied effective protection. It suggests a “strata approach” as a basis for protecting the labors involved in compiling such works.)

131. *Harper & Row, Publishers, Inc. v. Nation Enters.*, 723 F.2d 195, 202 n.8, 203 n.11 (2d Cir. 1983), *cert. granted*, 104 S. Ct. 2655 (1984) (No. 83-1632); *Denicola*, *supra* note 6, at 538; *cf. Hill*, *supra* note 6, at 59; *Taylor*, *supra* note 5, at 42. Although the preparation of compilations depends primarily on an author's industry and requires little in the sense of creativity or authorship, compilations are protected. “Copyright law and compilations are uneasy bedfellows” because the law is not well suited for dealing with such works. *Eckes v. Card Prices Update*, 736 F.2d 859, 862 (2d Cir. 1984).

132. See *Harper & Row, Publishers, Inc. v. Nation Enters.*, 723 F.2d 195, 202 n.8, 203 n.11 (2d Cir. 1983), *cert. granted*, 104 S. Ct. 2655 (1984) (No. 83-1632); see also 17 U.S.C. §§ 101, 103(b) (1982).

133. The mass of facts through which an author sifts and selects are materials in the public domain that cannot be protected merely because of the author's selection efforts. See *Gorman*, *supra* note 1, at 1583. This rule, however, must not be read to suggest that copyright cannot be claimed on a nonchronological selection of facts, as in an almanac, textbook, or book of lists. See *supra* notes 120-28 and accompanying text. See also *Meredith Corp. v. Harper & Row, Publishers, Inc.*, 413 F. Supp. 385 (S.D.N.Y. 1975) (copyright protection for topics in text on child psychology); 1 M. NIMMER, *supra* note 2, § 2.11[D], at 2-164.

134. *Myers v. Mail & Express Co.*, 36 Copy Dec. 478, 479 (S.D.N.Y. 1919); 1 M. NIMMER, *supra* note 2, § 2.11[D]. See also *supra* notes 61-62 and accompanying text.

search<sup>135</sup> and may impede first amendment interests.<sup>136</sup>

#### IV. REJECTIONS OF *TOKSVIG*

The United States Court of Appeals for the Second Circuit has rejected the *Toksvig* approach. Decisions in this circuit afford little copyright protection to nonfiction literary works<sup>137</sup> and permit later authors to rely extensively on prior works.

##### A. *Repudiation in Rosemont*

In *Rosemont Enterprises v. Random House, Inc.*,<sup>138</sup> a corporation controlled by Howard Hughes that had acquired the copyrights to magazine articles about Hughes alleged that a subsequent biography infringed its rights. It was clear that material from the articles was contained in the biography. The trial court found infringement, in part because of defendant's failure to conduct sufficient independent research.<sup>139</sup> The court relied on the *Toksvig* principle that an author is not entitled to use the fruits of another's labor in lieu of independent research.<sup>140</sup>

The court of appeals disagreed with the trial court's conclusion as a matter of law. It analyzed *Toksvig*,<sup>141</sup> and stated:

[W]e, however, cannot subscribe to the view that an author is absolutely precluded from saving time and effort by referring to and relying upon prior published material. . . . It is just such wasted effort that the proscription against the copyright of ideas and facts, and to a lesser extent the privilege of fair use, are designed to prevent.<sup>142</sup>

135. Gorman, *supra* note 1, at 1604. Cf. Denicola, *supra* note 6, at 538, 541 (fair-use defense available to subsequent authors using copyrighted collections and presentations of facts); Hill, *supra* note 6, at 59, 60-63 (flat rejection that research is not authorship is not warranted; the fair-use defense should govern use of research).

136. See *Harper & Row, Publishers, Inc. v. Nation Enters.*, 723 F.2d 195, 202, 204 (2d Cir. 1983), *cert. granted*, 104 S. Ct. 2655 (1984) (No. 83-1632); *supra* note 84.

137. *Eckes v. Card Prices Update*, 736 F.2d 859, 862 (2d Cir. 1984); *National Business Lists, Inc. v. Dun & Bradstreet, Inc.*, 215 U.S.P.Q. (BNA) 595, (N.D. Ill. 1982) (citing *Rosemont Enters., v. Random House, Inc.*, 366 F.2d 303 (2d Cir. 1966), *cert. denied*, 385 U.S. 1009 (1967)). *But see* *Huie v. NBC*, 184 F. Supp. 198, 200 (S.D.N.Y. 1960) (broad dicta supporting *Toksvig* rule, but defendant's television show about one of the marines who raised the flag on Iwo Jima not enjoined despite its similarities to plaintiff's book—key question was whether defendant "appropriated plaintiff's literary treatment of 'historical facts'"). See also Hill, *supra* note 6, at 51; Taylor, *supra* note 5, at 50-51.

138. 366 F.2d 303 (2d Cir. 1966), *cert. denied*, 385 U.S. 1009 (1967).

139. *Rosemont Enters. v. Random House, Inc.*, 256 F. Supp. 55, 65-66 (S.D.N.Y.), *rev'd*, 366 F.2d 303 (2d Cir. 1966), *cert. denied*, 385 U.S. 1009 (1967). The lower court also rejected defendant's fair-use defense, in part because of the lack of independent research. It acknowledged, however, that facts are in the public domain and that an author may be guided by earlier works. *Id.* at 66.

140. *Id.* See also *Rosemont*, 366 F.2d at 310. Defendants had relied on previously published newspaper and magazine articles and similar materials.

141. The court cited Nimmer's treatise for the proposition that *Toksvig* could be limited to a finding of substantial and material copying, but noted that the opinion's language was much broader. *Rosemont*, 366 F.2d at 310. See also *supra* notes 71-80 and accompanying text.

142. *Rosemont*, 366 F.2d at 310.

The court also explained that its earlier statement in *Orgel v. Clark Boardman Co.*<sup>143</sup> that an author could not appropriate the "fruits of another's labor and skill in order to publish a rival work"<sup>144</sup> only meant that "[t]he second historian or second directory publisher cannot bodily appropriate the research of his predecessor."<sup>145</sup> Although this explanation is inconsistent with the conclusion that an author may rely on prior material, the court seemed to equate bodily appropriation of research with substantial, verbatim copying or paraphrasing of protected expression.<sup>146</sup> Thus, under *Rosemont*, verbatim copying or paraphrasing of protected expression is prohibited, but reliance on the research of another is allowed.<sup>147</sup>

### B. *The Hoehling Rejection*

In *Hoehling v. Universal City Studios, Inc.*<sup>148</sup> there was more emphatic rejection of *Toksvig* and its protection of research through copyright. Hoehling, author of *Who Destroyed the Hindenburg?*, had completed exhaustive research of the investigative reports and published materials about the 1937 Hindenburg disaster. He also had interviewed many people, including survivors. His book, published in 1962, was written in an objective, journalistic style; it concluded that the airship was sabotaged by a crew member trying to please his girlfriend.<sup>149</sup> Ten years later defendant Mooney published a

143. 301 F.2d 119 (2d Cir.), cert. denied, 371 U.S. 817 (1962).

144. *Rosemont*, 366 F.2d at 310 (quoting *Orgel*, 301 F.2d at 120).

145. *Id.* (quoting *Huie v. NBC*, 184 F. Supp. 198, 200 (S.D.N.Y. 1960)).

146. The court noted that the infringer in *Orgel*, an author of a book on eminent domain, had adopted as his own a prior author's "analysis, organization of material, phrasing and citations . . ." *Rosemont*, 366 F.2d at 310 (quoting *Orgel*, 301 F.2d at 120). Rather than relying on his predecessor's research, defendant appropriated the first author's protected form of expression. The court also cited *West Publishing Co. v. Edward Thompson Co.*, 176 F. 833 (2d Cir. 1910), a case in which one publisher extensively copied lists of decisions and headnotes in case digests from another publisher's work. This was held not to be a fair use. The copying enabled the second publisher to save time and effort, but nevertheless infringed because there was an appropriation of the first publisher's protected expression, arrangement, and selection. *Rosemont*, 366 F.2d at 310 (citing *West Publishing*, 176 F. at 838); see also *Hill*, *supra* note 6, at 49-50.

147. The extent to which *Rosemont* undercut *Toksvig* is uncertain. *Rosemont* allows an author to save time and effort by relying on prior published material but also quotes the statement from *Huie v. NBC*, 184 F. Supp. 198 (S.D.N.Y. 1960), that "one cannot bodily appropriate the research of his predecessor." See *Rosemont*, 366 F.2d at 310 (quoting *Huie*, 184 F. Supp. at 200). *Huie* seemed to adopt the *Toksvig* rule by using the following example in dictum:

[I]f an historian had published a history of the negotiations between the Soviet Union and the United States with respect to nuclear explosions and copyrighted it, it would be an infringement of the copyright for another historian to publish a history re-written from the first historian's book without any independent research.

*Huie*, 184 F. Supp. at 200. Despite this broad statement plaintiff was unsuccessful because he could not prove that defendant copied plaintiff's treatment of the facts. See *supra* note 137.

148. 618 F.2d 972 (2d Cir. 1980). See also *Harper & Row, Publishers, Inc. v. Nation Enters.*, 723 F.2d 195, 203 n.11 (2d Cir. 1983), cert. granted, 104 S. Ct. 2655 (1984) (No. 83-1632); 1 M. NIMMER, *supra* note 2, § 2.11[E], at 2-166 and n.35.1. Nimmer points out that after *Hoehling*, in *MCA, Inc. v. Wilson*, 211 U.S.P.Q. (BNA) 577 (2d Cir. 1981), the United States Courts of Appeals for the Second Circuit again stated in dictum that use of copyrighted material without consent is not reasonable if it bodily appropriates the research of the original. *Id.* at 579. *Wilson* did not involve the use of research; instead, *Wilson* involved defendant's parody of plaintiff's copyrighted song in defendant's off-Broadway musical show. *Id.* at 578.

149. *Hoehling*, 618 F.2d at 975.

book that the court characterized as "more literary than historical in its attempt to weave a number of symbolic themes through the actual events surrounding the tragedy" of the Hindenburg.<sup>150</sup> Universal purchased the motion picture rights to Mooney's book and retained several writers to prepare the screenplay. One of the writers had written, twenty years earlier, an unpublished movie scenario based on the deliberate destruction of the airship.<sup>151</sup> The resulting motion picture was of the disaster film genre with fictional characters, subplots, sabotage plans, attempts to defuse the bomb, and the dirigible's eventual destruction. Hoehling charged that the movie and Mooney's book had infringed his copyrighted work.<sup>152</sup> Mooney acknowledged consulting plaintiff's book and relying on it somewhat, but claimed that he discovered his sabotage theory in a 1962 book by Dale Titler. Titler, however, stated in an affidavit that he had copied Hoehling's sabotage theory.<sup>153</sup>

The court of appeals concluded that Hoehling could recover only if he could prove copying and substantial similarity of copyrightable expression.<sup>154</sup> With regard to the alleged copying of Hoehling's sabotage plot, the court held that when the author's idea is an interpretation of a historical event, rather than a fictional creation, that interpretation is not subject to copyright protection. Thus, Hoehling's expression of his hypothesis was protected by copyright but the idea itself was not. Hoehling's hypothesis, whether or not original to him, was an idea based entirely on interpretation of facts.<sup>155</sup>

The court also discussed Hoehling's claim that defendants had copied facts uncovered in Hoehling's personal research. The court stated that facts are in the public domain and that defendants were free to use them:<sup>156</sup> "Accordingly, there is little consolation in relying on cases in other circuits holding that the fruits of original research are copyrightable. Indeed, this circuit has clearly repudiated *Toksvig* and its progeny."<sup>157</sup> Hoehling's copyright claim failed because the alleged copying was of unprotectible ideas and facts rather than of plaintiff's protectible expression.<sup>158</sup>

150. *Id.* at 976.

151. *Id.* at 975-76. Screenwriter Nelson Giddings had written the unpublished screenplay in 1957, well before the publication of Hoehling's book. *Id.* at 975.

152. *Id.* at 977.

153. *Id.* at 975 n.1. Hoehling had not sued Titler. *Id.*

154. *Id.* at 977. Hoehling's selection, arrangement, and presentation of the facts demonstrated sufficient originality to justify copyright protection for the whole work. *Id.* Much of his presentation, however, was prescribed by the order in which the events occurred. *Id.* Narration of history, by convention, proceeds chronologically, and that order cannot be protected by copyright. *Id.* at 978 (citing *Meyers v. Mail & Express Co.*, 36 Copy. Dec. 478, 479 (S.D.N.Y. 1919)).

155. *Hoehling*, 618 F.2d at 978-79. The court cited *Rosemont* as support for the statement that the public benefits from encouraging the creation of historical and biographical works. The court concluded that "broad latitude must be granted to subsequent authors who make use of historical subject matter, including theories and plots," *id.* at 978, noting that all the authors had related the story differently and, thus, plaintiff's expression was not usurped. *Id.* at 980. See also Taylor, *supra* note 5, at 51-52.

156. 618 F.2d at 979 (citing *Greenbie v. Noble*, 151 F. Supp. 45, 67 (S.D.N.Y. 1957)).

157. *Id.* (citations omitted).

158. This decision was correct. Cf. Hill, *supra* note 6, at 65-66. *Contra* Taylor, *supra* note 5, at 51-52. Plaintiff's book was written in a journalistic style. Mooney's book was more literary than historical, and the movie followed the typical disaster movie formula. The sabotage theory had

C. *Miller v. Universal City Studios, Inc.*

The absolute rejection of *Toksvig* gave rise to a seemingly inequitable result in *Miller v. Universal City Studios, Inc.*<sup>159</sup> Plaintiff, a reporter, wrote a book about the ordeals of a young woman who had been kidnapped and buried alive in a wood and fiberglass capsule for eighty-three hours. The young woman collaborated with the journalist; plaintiff spent more than 2500 hours interviewing participants and investigating, researching, and preparing the book, which was published in 1971. A condensed version appeared in *Reader's Digest* and the book also was serialized in *Ladies Home Journal*. A producer for Universal read the condensed version, thought it would make a good television movie, and gave a copy of the book to a scriptwriter. Universal negotiated with plaintiff to acquire movie rights to the book but when no agreement was reached, the scriptwriter was told to complete the screenplay without using the book. The movie eventually was televised as the ABC Movie of the Week. Despite conflicting evidence about the extent to which defendant's writer had relied on plaintiff's book, the jury found infringement and awarded \$200,000 in damages, including lost profits.<sup>160</sup>

The United States Court of Appeals for the Fifth Circuit stated that the most important issue was whether the trial court had erred by instructing the jury that research is copyrightable.<sup>161</sup> One sentence in a twelve-page jury instruction, which otherwise correctly explained the distinction between unprotectible facts and protectible expression, read: "[M]oreover, if an author, in writing a book concerning factual matters, engages in research on those matters, his research is copyrightable."<sup>162</sup> Plaintiff had testified over defendants' objections about the amount of time he had spent researching the work, and plaintiff's opening and closing arguments had emphasized the extent and

---

been suggested in the late 1930s, and Giddings' 1957 scenario—predating Hoehling by five years—also had been based on the deliberate destruction theory, *id.* at 975, and thus was another possible source for the movie. Furthermore, many of Hoehling's allegations of copying were frivolous; most alleged copying of historical facts. *Id.* at 979 n.6. Copyright policy mandates that facts be free for all to use. *Id.* at 980.

Fundamental copyright policy justifies granting new authors of historical works a relatively free hand in using the research of their predecessors. The law's protection of the author is incidental to its primary goal of encouraging contributions to recorded knowledge. *Id.* at 980 (citing *Berlin v. E.C. Publications, Inc.*, 329 F.2d 541, 543-44 (2d. Cir.), *cert. denied*, 379 U.S. 822 (1964)). "[A]bsent wholesale usurpation of another's expression, claims of copyright infringement where works of history are at issue are rarely successful." *Id.* at 974; *see also* *Abrams*, *supra* note 24, at 510.

*See also* *Suid v. Newsweek Magazine*, 503 F. Supp. 146 (D.D.C. 1980); *infra* notes 296-300 and accompanying text. In *Suid*, the court sympathized with plaintiff's argument that defendant had saved time and effort by relying on plaintiff's research, but concluded that the copyright statute did not protect the research. *Id.* at 148.

159. 650 F.2d 1365 (5th Cir. 1981).

160. *Id.* at 1367. The trial court's opinion has a more complete description of the facts and evidence presented. *Miller v. Universal City Studios, Inc.*, 460 F. Supp. 984 (S.D. Fla. 1978), *rev'd*, 650 F.2d 1365 (5th Cir. 1981). The coauthor assigned her interest in the litigation to plaintiff. *Miller*, 650 F.2d at 1367. The jury was given a copy of the book and viewed the movie twice. *Id.* Defendant's writer had expressed uneasiness in relying so heavily on the book. *Miller*, 460 F. Supp. at 986; Hill, *supra* note 6, at 51-53. Taylor, *supra* note 5, at 53.

161. *Miller*, 650 F.2d 984, 1367-68 (S.D. Fla. 1978).

162. *Id.* at 1372; *Miller v. Universal City Studios, Inc.*, 460 F. Supp. 984, 987 (S.D. Fla. 1978).

copyrightability of his research. Furthermore, the trial court had stated that it viewed "the labor and expense of the research involved in the obtaining of those uncopyrightable facts to be intellectually distinct from those facts and more similar to the expression of the facts than to the facts themselves."<sup>163</sup> Based on these factors, the court of appeals found that the "research-is-copyrightable theory" permeated the entire liability phase of the trial.<sup>164</sup>

The court of appeals stated that "[t]he issue is not whether granting copyright protection to an author's research would be desirable or beneficial, but whether such protection is intended under the copyright law."<sup>165</sup> Plaintiff argued that protection could be based on the same principles that protect compilations, but the court rejected that extension of copyright. Although the court acknowledged difficulty in distinguishing language in the compilation decisions that had protected the labor of compilers, it nevertheless concluded that "[a] copyright in a directory . . . is properly viewed as resting on the originality of the selection and arrangement of the factual material, rather than on the industriousness of the efforts to develop the information."<sup>166</sup>

---

163. *Miller*, 650 F.2d at 1369 (quoting *Miller v. Universal City Studios, Inc.*, 460 F. Supp. 984, 987 (S.D. Fla. 1978)) (statement made in order denying motion for a new trial). The lower court justified its conclusion by stating that:

it doesn't square with reason or common sense to believe that Gene Miller would have undertaken the research involved in writing . . . [the book] if . . . [he] thought that upon completion of the book a movie producer or television network could simply come along and take the profits of the books and his research from him.

*Miller v. Universal City Studios, Inc.*, 460 F. Supp. 984, 988 (S.D. Fla. 1978). According to the court, an author could not be expected to spend time and money researching and gathering facts if those facts could be pirated so easily. *Miller*, 650 F.2d at 1369. The court stated that "to hold [that material] other than research is copyrightable is to violate the spirit of the copyright law and to provide [others] a license to steal." *Id.*

164. *Miller*, 650 F.2d at 1372.

165. *Id.* at 1369. The court of appeals noted that the trial court's interpretation expanded copyright to protect not only the labor of expressing but also the labor of research. *Id.* It rejected this theory to allow "a subsequent author to build upon and add to prior accomplishments without unnecessary duplication of effort." *Id.* at 1371-72. It adopted the approach taken in *Hoehling*, *supra* note 148.

166. *Id.* (citing 1 M. NIMMER, *supra* note 2, § 3.04); see also *Harper & Row, Publishers, Inc. v. Nation Enters.*, 723 F.2d 195, 202 & n.8, 203 n.11 (2d Cir. 1983), *cert. granted*, 104 S. Ct. 2655 (1984) (No. 83-1632). The *Miller* court of appeals suggested that because the directory cases were difficult to distinguish, it would be better to recognize them as a special category, rather than attempt to apply their rationale to other types of nonfiction works. The court noted that "the special protection granted directories under the copyright law has generally not been applied to other factual endeavors." *Id.* at 1370. See also *Eckes v. Card Prices Update*, 736 F.2d 859, 862 (2d Cir. 1984) ("copyright law and compilations are uneasy bed fellows"); *Financial Information v. Moody's*, 1984 COPYRIGHT L. REP. (CCH) ¶ 25,617 at 18,765 (S.D.N.Y. 1984) ("copyright protection for compilations of factual material is at odds with the basic thrust of the copyright laws . . ."). But see *Denicola*, *supra* note 6. Professor *Denicola* argues that research in nonfiction works should be protected under the compilation rationale. He asserts that compilations are protected because of the act of aggregating information and not because of the author's arrangement of the information even though some cases explicitly base protection on the originality of the arrangement of facts. *Denicola*, *supra* note 6, at 527-32. He argues that the appropriation of facts from a nonfiction work may be controlled "by analogizing from the compilation cases and recognizing authorship in the collection of data chosen by the nonfiction writer." *Id.* at 538. This approach, however, does not base copyright protection on the originality of the author's expression, but on the labor expended by that author.

This approach is an improper application of copyright law. Professor *Nimmer* notes that under the Constitution and the Copyright Act, only works of authorship may be protected; expression is "clearly the very essence of authorship." 1 M. NIMMER, *supra* note 2, § 2.11[E], at 2-167.



The court of appeals also noted that the *Rosemont* court had expressly rejected the idea that research is copyrightable and had adhered steadfastly to that position in *Hoehling*.<sup>167</sup> It found the United States Court of Appeals for the Second Circuit's approach "to be more consistent with the purpose and intended scope of protection under the copyright law than that implied by *Toksvig*."<sup>168</sup> The court also stated that the law's distinction between protected expression and unprotectible facts balanced the public's interest in encouraging creative activity with the need for unrestrained access to information: that careful balance could not be maintained if research was copyrightable.<sup>169</sup>

There is no rational basis for distinguishing between facts and the research involved in obtaining facts. To hold that research is copyrightable is no more or no less than to hold that the facts discovered as a result of research are entitled to copyright protection . . . [T]he law is clear that facts are not entitled to such protection. We conclude that the district court erred in instructing the jury that research is copyrightable.<sup>170</sup>

The court therefore remanded the case for a new trial.<sup>171</sup>

#### D. *President Ford's Memoirs and Harper & Row, Publishers, Inc. v. Nation Enterprises*

The United States Court of Appeals for the Second Circuit emphatically reaffirmed its rejection of *Toksvig* in *Harper & Row, Publishers, Inc. v. Nation Enterprises*.<sup>172</sup> Shortly after leaving the White House in 1977 President Ford granted Harper & Row and *Reader's Digest* exclusive rights to publish his then unwritten memoirs. A senior editor from *Reader's Digest* assisted Ford and spent almost two years interviewing, researching, writing, and editing. The memoirs, titled *A Time to Heal*, were scheduled for publication in the spring of 1979; *Time Magazine* was licensed to print prepublication excerpts in its April 23, 1979 issue.

In late March 1979 an unidentified source gave a copy of the manuscript

---

The *Miller* court's suggestion that the directory cases should be treated as a separate category and that the principles they invoke should be extended to nondirectory works, is the better interpretation. The compilation principles are inappropriate for cases involving literary works that are predominantly factual. *Harper & Row, Publishers, Inc. v. Nation Enters.*, 723 F.2d 195, 202 & n.8 (2d Cir. 1983), cert. granted, 104 S. Ct. 2655 (1984) (No. 83-1632); see also Note, *supra* note 6, at 627-30 (argues that the *Miller* holding, and its statement that the directory cases are unique, demonstrate that the fact-expression dichotomy is inadequate to include works such as directories that currently are protected by copyright even though "research" is their only original element); cf. *Landsberg v. Scrabble Crossword Game Players, Inc.*, 736 F.2d 485, 488 (9th Cir. 1984) (scope of copyright for nonfactual works is narrow in comparison to fictional works).

167. *Miller*, 650 F.2d at 1370-71. The court described *Rosemont* as "more soundly reasoned" than *Toksvig*. *Id.* at 1371.

168. *Id.* at 1371.

169. *Id.* at 1371-72. The court quoted *Hoehling* extensively to explain why copyright cannot extend to the depiction of historical events.

170. *Id.* at 1372; see also *Suid v. Newsweek Magazine*, 503 F. Supp. 146, 148 (D.D.C. 1980) (facts are not original to an author and thus not copyrightable).

171. *Miller*, 650 F.2d at 1372. The new trial was to determine whether Miller's protected expression had been copied.

172. 723 F.2d 195 (2d Cir. 1983), cert. granted, 104 S. Ct. 2655 (1984) (No. 83-1632).

to Victor Navasky, editor of *The Nation*. Navasky had to return the manuscript, so in twenty-four hours, he read the manuscript and selected materials for an article without doing any independent research. The resulting article was over two thousand words in length; it detailed the events surrounding the Nixon pardon and several other matters. Navasky eventually learned of *Time's* publication plans, and the first paragraphs of his article, which went on sale in *The Nation's* April 3, 1979 edition, announced the expected publication dates of the complete memoirs as well as the *Time* and *Reader's Digest* excerpts. The prepublication contract with *Time* soon fell through, and shortly thereafter Harper & Row and *Reader's Digest* filed suit alleging copyright infringement and several pendent state-law violations.<sup>173</sup> Defendant argued that it merely had related facts, and used only a minimal amount of protected expression to add flavor and credibility. The lower court, however, held for plaintiffs on the copyright claim, finding that the totality of the historical facts, memoranda, and President Ford's reflections were protected by copyright. *The Nation's* copying—characterized by plaintiffs as paraphrasing or direct thefts of original expression—was held not a fair use.<sup>174</sup>

The court of appeals reversed, holding that the threshold issue was whether the material used by *The Nation* was copyrightable.<sup>175</sup> The court noted that the Copyright Act "grants rights not in ideas or facts, but in expression, . . . [and] is thus able to protect authors without impeding the public's access to that information which gives meaning to our society's highly valued freedom of expression."<sup>176</sup> According to the court, the concept of copyrightability must be construed in accord with the first amendment; as a consequence, neither news events nor historical or biographical facts may be protected.<sup>177</sup> Acknowledging the difficulty of distinguishing fact from expression, the court determined that "*The Nation* drew on scattered pieces of information [facts] from different pages and different chapters, and then described that information in its own words."<sup>178</sup> It stated that such conduct—paraphrasing discrete facts—was permissible because the information was not protected.<sup>179</sup> Furthermore, because the work described political events of major

---

173. *Id.* at 197-99; see also Harper & Row, Publishers, Inc. v. Nation Enters., 557 F. Supp. 1067, 1069-70 (S.D.N.Y.) (trial court's summary of the facts), *rev'd*, 723 F.2d 195 (2d Cir. 1983), *cert. granted*, 104 S. Ct. 2655 (1984) (No. 83-1632). The court held that plaintiffs' common-law claims—conversion and tortious interference with contract—were preempted by § 301 of the Copyright Act. Harper & Row, Publishers, Inc. v. Nation Enters., 501 F. Supp. 848 (S.D.N.Y. 1980), *aff'd*, 723 F.2d 195 (2d Cir. 1983), *cert. granted*, 104 S. Ct. 2655 (1984) (No. 83-1632). See also *infra* notes 291-92 and accompanying text.

174. Harper & Row, Publishers, Inc. v. Nation Enters., 557 F. Supp. 1067, 1070-73 (S.D.N.Y.) *rev'd*, 723 F.2d 195 (2d Cir. 1983), *cert. granted*, 104 S. Ct. 2655 (1984) (No. 83-1632). The court concluded that President Ford's revelations were not news, "hot" or otherwise, and also that the fair-use defense failed because *The Nation's* use superseded use of the original by *Time*. *Id.* The *Nation* also argued that most of the material it used was not protectible by copyright; the court responded, however, that the "totality" was protected by copyright. *Id.* at 1072. The court of appeals rejected this view. Harper & Row, 723 F.2d at 204-05.

176. *Id.*, citing 1 M. Nimmer, *supra* note 2, § 1.10[B]2, at 1-72.

177. *Id.* at 202-04. The court relied on § 102(b) and several cases, including *Rosemont* and *Hoehling*, for support.

178. *Id.* at 203.

179. *Id.* at 204, citing H.R. REP., *supra* note 27, at 56.

significance, and the alleged paraphrasings concerned the "very essence of news and of history," first amendment principles made it necessary to protect as "expression" only the barest elements—the ordering and choice of the words themselves.<sup>180</sup>

By distinguishing between facts and expression, the court of appeals rejected the lower court's holding that the "totality" of the facts, memoranda, and reflections was protected by copyright.<sup>181</sup> The court implied that President Ford's "states of mind" and reflections were unprotected facts under section 102(b), but concluded that even if they were assumed to be expression, their incorporation with other facts did not make those other facts copyrightable.<sup>182</sup> The other materials used in the article were from uncopyrightable government works and from some reproduced statements from other persons made in conversations with the President—not protectible by plaintiffs' copyright.<sup>183</sup> Thus, the greatest part of defendant's article reported uncopyrightable facts. Once these unprotected elements were stripped away, the article contained, at most, roughly 300 words that were copyrighted.<sup>184</sup> Notwithstanding Navasky's lack of independent research, the court held that this meager, infinitesimal taking of President Ford's original expression was fair use.<sup>185</sup>

These decisions repudiating the *Toksvig* rule are consistent with the principle that copyright protects only original expression.<sup>186</sup> To hold that research

180. *Id.* Otherwise, if "expression" were given a broader scope, a writer could "own" an event merely by being the first to express it. *Id.*

181. *Id.* at 204-05. See *supra* note 174.

182. *Id.* at 205.

183. *Id.*

184. *Id.* at 206.

185. *Id.* at 206-08. Accordingly, the court reversed the finding of infringement and award of damages. *Id.* at 209. It also affirmed the dismissal of plaintiff's state-law claims. *Id.* at 199-201. See *infra* notes 301-09 and accompanying text. Judge Meskill dissented, noting that the article was "almost entirely a paraphrase, was of trivial originality and contained no independent research by the author." *Id.* at 214 (Meskill, J., dissenting). Meskill acknowledged that defendant was free to use the facts in the memoir as part of its own original work; however, he stated that defendant was not free to "appropriate the same quotes, expressions, selection of language, events, corroboration and re-creation" present in the original. According to Meskill, *The Nation* compiled a work that allegedly reported facts, although it actually had taken Ford's work and "added nothing original of its own." *Id.* The majority opinion noted that some cases had extended protection to an author's labors, but that those authorities and that reasoning had been rejected explicitly in *Hoehling*. *Id.* at 213 n.11.

186. *Mazer v. Stein*, 347 U.S. 201, 217 (1954); see *Gardner v. Nizer*, 391 F. Supp. 940, 942 (S.D.N.Y. 1975); 17 U.S.C. § 102(b) (1982). Nimmer supports this repudiation of *Toksvig*. 1 M. NIMMER, *supra* note 2, § 2.11[E], at 2-167; *id.* § 3.04, at 3-16 to -17; see also Gorman, *supra* note 1, at 1584. *Contra* Denicola, *supra* note 6, at 535-41.

*Consumers Union of the United States, Inc. v. General Signal Corp.*, 724 F.2d 1044 (2d Cir. 1983), *cert. denied*, 105 S. Ct. 100 (1984) (No. 83-1870), is another important decision addressing the issue of factual works and copyright. In *Consumers Union* the court's analysis was consistent with *Rosemont*, *Miller*, and *Harper & Row*. *Consumers Union of the United States, Inc. (CU)* evaluated lightweight vacuum cleaners and published results of its research in *Consumer Reports*. Defendant's Regina Powerteam model received a favorable rating and defendant reproduced, verbatim, portions of the *Consumer Reports* evaluation—the fruits of CU's research—in several advertisements promoting its product. CU's claim of copyright infringement failed because the court held that defendant's use of the copyrighted evaluation was a fair use. The court emphasized that facts cannot be copyrighted and that CU therefore could not prevent defendant from accurately reporting facts about the results of CU's independent testing. The court also noted that

is copyrightable would be tantamount to holding that facts are copyrightable.<sup>187</sup> The Copyright Act, however, prohibits the protection of discoveries and it permits authors to save time and effort by using, and building on, the ideas and information in earlier works.<sup>188</sup> The factors together mean that the scope of copyright protection for a nonfiction work is narrow,<sup>189</sup> which may discourage some authors. Nevertheless, the primary purpose of copyright protection is to encourage the creation and dissemination of new works of authorship and that goal is served best by allowing the free use of others' research.<sup>190</sup> Thus, the *Toksvig* rule "represents an improper extension of copyright principles in an effort to protect labor and expense which should either go unprotected or should be protected at best under the rubric of unfair competition."<sup>191</sup>

## V. STATE-LAW PROTECTION OF RESEARCH

Because copyright probably does not protect research, plaintiff authors of nonfiction works should include alternative claims alleging common-law bases for protection. Misappropriation, conversion, unfair competition, and, in some instances, contract and quasi-contract theories all are possible claims when a subsequent author has used the plaintiff's research.<sup>192</sup> The availability

---

the scope of fair use is greater with informational works like *Consumer Reports* because the risk of restraining the free flow of information is more significant. *Consumers Union*, 724 F.2d at 1049.

187. *Miller*, 650 F.2d at 1372. The protection of facts contravenes the law's originality requirement. See also *Suid v. Newsweek Magazine*, 503 F. Supp. 146 (D.D.C. 1980), in which the court granted summary judgment against plaintiff's claim that *Newsweek's* four-page article on John Wayne had infringed several passages from his book on war movies. The majority of the material was factual and not original to plaintiff, *id.* at 147-48; thus, defendant was granted summary judgment. *Id.* at 149. The *Suid* court cited *Hoehling* with approval and noted that *Toksvig* had been criticized sharply. *Id.* at 148-49.

188. 17 U.S.C. § 102(b) (1982); H.R. REP., *supra* note 27, at 56.

189. *Landsberg v. Scrabble Crossword Game Players, Inc.*, 736 F.2d 485, 488 (9th Cir. 1984); *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 974 (2d Cir. 1980), *cert. denied*, 449 U.S. 841 (1980); *Denicola*, *supra* note 6, at 531-32, 542; *Taylor*, *supra* note 5, at 33-34. The lower court in *Miller* noted that if the public expects individuals to do research, then it must compensate them in the same manner as those who express the research. To hold otherwise is "to provide to those . . . lacking in requisite diligence and ingenuity a license to steal." *Miller v. Universal City Studios, Inc.*, 460 F. Supp. 984, 988 (S.D. Fla. 1978). That approach, however, improperly extends copyright to cover facts and information apart from the author's particular mode of expression. Facts are not original to an author and to afford them protection contravenes the basic principle that copyright protects expression, *Wainwright Sec. Inc. v. Wall Street Transcript Corp.*, 558 F.2d 91, 95-96 (2d Cir. 1977), and it would constitute an intolerable limitation on first amendment interests. *Harper & Row, Publishers, Inc. v. Nation Enters.*, 723 F.2d 195, 204 (2d Cir. 1983), *cert. granted*, 104 S. Ct. 2655 (1984) (No. 83-1632).

190. *Mazer v. Stein*, 347 U.S. 201, 219 (1954); *Hoehling*, 618 F.2d at 974, 980.

191. *Gorman*, *supra* note 1, at 1584; see also *Suid v. Newsweek Magazine*, 503 F. Supp. 146, 148 (D.C.C. 1980); *supra* note 189 and accompanying text; cf. H.R. REP., *supra* note 27, at 56-57. Such expansive protection improperly extends the copyright monopoly to encompass facts and information. This protection would impede the public's access to ideas and information and would be an intolerable limit on first amendment rights. *Harper & Row, Publishers, Inc. v. Nation Enters.*, 723 F.2d 195, 204 (2d Cir. 1983), *cert. granted*, 104 S. Ct. 2655 (1984) (No. 83-1632).

192. It is common practice to join these pendent state claims with a copyright infringement claim. Notwithstanding the possible preemption of such claims, the plaintiff risks quick dismissal of these state claims from federal court in the event that his federal copyright claim, which often is weak in the case of a factual work, is dismissed before trial. "[I]n the exercise of its discretion, the court may dismiss the pendent claim when the federal claim is dismissed prior to trial." *Jason v.*

and scope of state-law protection, however, is tied inextricably to the issue of federal preemption. Therefore, it is necessary to focus on the scope of federal preemption before examining the common-law doctrines available to authors of nonfiction works.

### A. *The Scope of Federal Preemption*

#### 1. Preemption Before the Copyright Act of 1976

Courts use the preemption doctrine, which is founded on the supremacy clause of the Constitution, to invalidate state statutes and common-law doctrines that conflict impermissibly with federal law.<sup>193</sup> Federal law preempts state law when "either . . . the nature of the regulated subject matter permits no other conclusion, or . . . the Congress has unmistakably so ordained."<sup>194</sup> Pursuant to the Constitution's patent and copyright clause,<sup>195</sup> Congress has enacted comprehensive legislation<sup>196</sup> and in several instances state regulation of some forms of intellectual property has been preempted by the federal statutes. The Supreme Court stated in *Sears, Roebuck & Co. v. Stiffel Co.*<sup>197</sup> that,

These laws, like other laws of the United States enacted pursuant to constitutional authority, are the supreme law of the land . . . . When state law touches upon the area of these federal statutes, it is "familiar doctrine" that the federal policy "may not be set at naught, or its benefits denied" by the state law.<sup>198</sup>

The Supreme Court considered questions of federal preemption in *Sears* and its companion case, *Compco Corp. v. Day-Brite Lighting, Inc.*<sup>199</sup> In each, the court reversed a decision under state unfair competition law that prohibited the copying on an unpatentable light fixture.<sup>200</sup> The Court noted that state-law protection under unfair competition "would . . . permit the State to block off from the public something which federal law has said belongs to the public."<sup>201</sup> Allowing a state to forbid the copying of a work not subject to patent protection "would interfere with the federal policy, found in Art. I, § 8, cl. 8, of the Constitution and in the implementing federal statutes, of allowing

---

Fonda, 526 F. Supp. 774, 778 (C.D. Cal. 1981) (citing *Wham-O Mfg. Co. v. Paradise Mfg. Co.*, 327 F.2d 748, 753 (9th Cir. 1964)), *aff'd*, 217 U.S.P.Q. (B.N.A.) 406 (9th Cir. 1983); *Walker v. Time Life Films, Inc.*, COPYRIGHT L. REP. (CCH) ¶ 25,554 (N.Y. Sup. Ct. 1983) (state claims dismissed by state court, when they were equivalent to copyright claim, over which federal courts have original and exclusive jurisdiction).

193. The supremacy clause provides: "This Constitution, and the laws of the United States . . . shall be the supreme law of the land; and the judges in every state shall be bound thereby, anything in the Constitution or laws of any State to the contrary notwithstanding." U.S. CONST. art. VI, cl. 2. *See, e.g.*, *Hines v. Davidowitz*, 312 U.S. 52, 67 (1941) (state law obstructing Congress' purpose is preempted).

194. *Florida Lime & Avocado Growers, Inc. v. Paul*, 373 U.S. 132, 142 (1963).

195. U.S. CONST art. I, § 8, cl. 8.

196. *See* 17 U.S.C. §§ 101-810 (1982); 35 U.S.C. §§ 1-376 (1982).

197. 376 U.S. 225 (1964).

198. *Id.* at 229 (quoting *Sola Elec. Co. v. Jefferson Elec. Co.*, 317 U.S. 173, 176 (1942)).

199. 376 U.S. 234 (1964).

200. *See Sears*, 376 U.S. at 225-27, 233; *Compco*, 376 U.S. at 234-35, 239.

201. *Sears*, 376 U.S. at 231-32.

free access to copy whatever the federal patent and copyright laws leave in the public domain."<sup>202</sup>

The broad language in *Sears* and *Compco* strongly suggested that protection of intellectual property under state law would be preempted whenever it conflicted, even indirectly, with the objectives of federal copyright and patent laws.<sup>203</sup> The Court, however, subsequently restricted the scope of preemption. Justice Harlan, in *Lear, Inc. v. Adkins*,<sup>204</sup> raised in dictum the question of a state's power to enforce a promise to pay royalties for using an allegedly unpatentable invention while the patent application was pending.<sup>205</sup> The Court implied that some state-created rights might be sufficiently compelling to justify some disruption of federal intellectual property policy.<sup>206</sup> In *Goldstein v. California*<sup>207</sup> the Court held that the Constitution's grant of copyright power to Congress was not exclusive and that states were free to protect published "writings" that did not fall within the scope of federal copyright law.<sup>208</sup> The Court, however, noted that "a conflict would develop if a State attempted to protect that which Congress intended to be free from restraint or to free that which Congress had protected."<sup>209</sup>

In *Kewanee Oil Co. v. Bicron Corp.*<sup>210</sup> the Supreme Court held that federal patent law had not preempted a cause of action under Ohio's trade secret

202. *Compco*, 376 U.S. at 237. The Court, however, noted that state law could prohibit someone from copying such a product and palming it off as the original. *Id.* at 238. See, e.g., *John H. Harland Co. v. Clarke Checks, Inc.*, 26 PAT. TRADEMARK & COPYRIGHT J. (BNA) 384 (11th Cir. 1983) (summary dismissal of copyright claim affirmed because plaintiff's "memory stub" system, a blank form conveying no information, was not subject to copyright protection; this result, however, did not preclude submitting plaintiff's trademark and trade dress infringement claims to the jury).

203. See *Synercom Technology, Inc. v. University Computing Co.*, 474 F. Supp. 37, 40-41 (N.D. Tex. 1979); Shipley, *Publicity Never Dies, It Just Fades Away: The Right of Publicity and Federal Preemption*, 66 CORNELL L. REV. 673, 687-88 (1981); Comment, *The Misappropriation Doctrine After the Copyright Revision Act of 1976*, 81 DICK. L. REV. 469, 480 (1977). The decisions could have been limited to the field of patent law, but a broader interpretation was reasonable since the federal interests in regulating patents and copyrights are similar. *Sears* and *Compco* led one commentator to argue that the states had been deprived of power to apply the passing-off doctrine. Patterson, *Private Copyright and Public Communication: Free Speech Endangered*, 28 VAND. L. REV. 1161, 1195 (1975). The decisions significantly influenced lower courts. See, e.g., *CBS v. DeCosta*, 377 F.2d 315, 318-19 (1st Cir.), cert. denied, 389 U.S. 1007 (1967); *Cable Vision, Inc. v. KUTV, Inc.*, 335 F.2d 348 (9th Cir. 1964), cert. denied sub nom. *Klix Corp. v. Cable Vision, Inc.*, 379 U.S. 989 (1965).

204. 395 U.S. 653 (1969).

205. *Id.* at 674-75.

206. Katz, *Copyright Preemption Under the Copyright Act of 1976: The Case of Droit de Suite*, 47 GEO. WASH. L. REV. 200, 209 (1978).

207. 412 U.S. 546 (1973).

208. *Id.* at 560, 570. Shipley, *supra* note 203, at 688-89; Comment, *supra* note 203, at 481. Defendant in *Goldstein* had argued that the Copyright Act of 1909, which did not apply to sound recordings, preempted protection of such writings under state law. *Goldstein*, 412 U.S. at 563-66, 567. The Court, however, upheld a California law that made the pirating of sound recordings a crime; the legislative history of the 1909 Act reflected no intent to prevent state protection of categories unregulated by the statute, as long as the state's regulation did not interfere with federal copyright policy. *Id.* at 564-71; see also 1 M. NIMMER, *supra* note 2, § 1.01[A], at 1-3 to -6. The states retained residual concurrent powers to regulate copyright, subject to the supremacy of federal law. *Id.*

209. *Goldstein*, 412 U.S. at 559.

210. 416 U.S. 470 (1974).

law. Although the misappropriated secret was an unpatentable process, the Court noted that its uncontrolled disclosure would not benefit the public appreciably.<sup>211</sup> The Court redefined the areas open to state regulation by establishing that state law would not be preempted merely because it related to intellectual property.<sup>212</sup> The Court concluded that "[t]he only limitation on the States is that in regulating the area of patents and copyrights they do not conflict with the operation of the laws in this area passed by Congress . . . ."<sup>213</sup> This conclusion allowed states to regulate the use of intellectual property in any manner not inconsistent with federal law, thereby expanding the potential scope of state intellectual property legislation.<sup>214</sup> The fundamental preemption issue therefore became "not whether state law reaches matters also subject to federal regulation, but whether the two laws function harmoniously rather than discordantly."<sup>215</sup> *Goldstein* and *Kewanee* permit state regulation of intellectual property unless it conflicts with the objectives of federal law.<sup>216</sup>

## 2. Preemption Under the Copyright Act of 1976

The *Goldstein* and *Kewanee* decisions demonstrated that state and federal regulation of intellectual property is concurrent;<sup>217</sup> they also indicated a retreat from *Sears* and *Compco*.<sup>218</sup> After these decisions, however, Congress enacted the Copyright Act of 1976,<sup>219</sup> which specifically prohibits state regulation of certain types of intellectual property.

In one of the most significant changes in copyright law, section 301 of the Act created a single system of federal protection for all published and unpublished "works of authorship that are fixed in a tangible medium of expres-

211. *Id.* at 479, 482-83. The Court predicted that protection of the rights under state trade secret law would not lead to disregard of the patent system. *Id.* at 483-93.

212. *Id.* at 478-79. The Court summarized its *Goldstein* decision: "at least in the case of writings, the States were not prohibited from encouraging and protecting the efforts of those within their borders by appropriate legislation." *Id.*

213. *Id.* at 479.

214. *See id.* at 479-80; *see also* *Abrams*, *supra* note 24, at 512; *Katz*, *supra* note 206, 208-10.

215. *Morseburg v. Balyon*, 621 F.2d 972, 978 (9th Cir.), *cert. denied*, 449 U.S. 983 (1980). In *Morseburg*, the court upheld a California statute that required that artists be paid a five percent royalty each time one of their paintings was resold. The court determined that California's adoption of *droit de suite* provided the artist an additional right not contained in the Copyright Act of 1909, but not conflicting with federal copyright law.

216. *Kewanee*, 416 U.S. at 479-80. "[I]f the scheme of protection developed by [a state] . . . 'clashes with the objectives of the federal patent laws,' . . . then the state law must fall." *Id.* at 480; *see also* 1 M. NIMMER, *supra* note 2, § 1.01[A], at 1-6; *Abrams*, *supra* note 24, at 532; *Katz*, *supra* note 206, at 208-10; *Shipley*, *supra* note 203, at 690. *Aronson v. Quick Point Pencil Co.*, 440 U.S. 257 (1979), is another important preemption decision. The Court held that federal patent law did not prevent state-law enforcement of an agreement to pay royalties on sales of certain articles. The articles embodied an invention for which a patent, though sought, was never issued. *Id.* at 259-60.

217. *See* 1 M. NIMMER, *supra* note 2, § 1.01[A], at 1-6.

218. *See* *Katz*, *supra* note 206, at 208-10; *Shipley*, *supra* note 203, at 701 n.204; *see also* *DeCosta v. CBS*, 520 F.2d 499, 510 (1st Cir. 1975), *cert. denied*, 423 U.S. 1073 (1976).

219. Pub. L. No. 94-553, 90 Stat. 2541 (1976) (codified at 17 U.S.C. §§ 101-810 (1982)). The law became effective on January 1, 1978. 17 U.S.C. § 302(a) (1982).

sion."<sup>220</sup> The section effectively abolished common-law copyright and established that state laws regulating copyright generally are preempted.<sup>221</sup> A state law is preempted if two conditions are satisfied: the state right protected must be "equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106"<sup>222</sup> and the subject matter protected by the state-law doctrine must be a fixed work of authorship that comes within the subject matter of copyright specified in sections 102 and 103.<sup>223</sup> Section 301(b) preserves state laws protecting materials not within the subject matter of copyright,<sup>224</sup> or rights not equivalent to any of the enumerated exclusive rights.<sup>225</sup> That section is intended "to make clear, consistent with the 1964 Supreme Court decisions in *Sears* . . . and *Compro* . . . that preemption does not extend to causes of action, or subject matter outside the scope of the revised Federal copyright statute."<sup>226</sup>

To determine whether a state law is preempted, a court first must determine whether the work being protected is within the subject matter of copyright, which is defined in the Act as "original works of authorship fixed in any tangible medium of expression . . . ."<sup>227</sup> This definition incorporates the

220. 17 U.S.C. § 301 (1982); see A. LATMAN, *supra* note 1, at 12; UNITED STATES COPYRIGHT OFFICE, GEN. GUIDE TO THE COPYRIGHT ACT OF 1978 2:1 (1977).

221. 1 M. NIMMER, *supra* note 2, § 1.01[B] at 1-8; Shipley, *supra* note 203, at 701 & n.204. Section 301 made moot much of the *Goldstein* and *Kewanee* decisions. Katz, *supra* note 206, at 211. The section provides:

(a) On and after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103, whether created before or after that date and whether published or unpublished, are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.

(b) Nothing in this title annuls or limits any rights or remedies under the common law or statutes of any State with respect to—

(1) Subject matter that does not come within the subject matter of copyright as specified by sections 102 and 103, including works of authorship not fixed in any tangible medium of expression; or

(2) any cause of action arising from undertakings commenced before January 1, 1978; or  
(3) activities violating legal or equitable rights that are not equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106.

17 U.S.C. § 301 (1982). Congress intended to provide "a single Federal system" of statutory copyright that "would greatly improve the operation of the copyright law and would be much more effective in carrying out the basic constitutional aims of uniformity and the promotion of writing and scholarship." H.R. REP., *supra* note 27, at 129.

222. The exclusive rights specified in § 106 include the rights to reproduce the copyrighted work, to prepare derivative works based upon it, to distribute copies of the copyrighted work, and to perform or display the work publicly. 17 U.S.C. § 106 (1982).

223. See Abrams, *supra* note 24, at 549; Goldstein, *Preempted State Doctrines, Involuntary Transfers and Compulsory Licenses: Testing the Limits of Copyright*, 24 UCLA L. REV. 1107, 1112 (1977); *supra* note 221. The two criteria for preemption must coalesce. Comment, *supra* note 203, at 409; see also 1 M. NIMMER, *supra* note 2, § 1.01[B], at 1-9.

224. 17 U.S.C. § 301(b)(1) (1982).

225. *Id.* § 301(b)(3).

226. H.R. REP., *supra* note 27, at 131, see Abrams, *supra* note 24, at 560-61.

227. 17 U.S.C. § 102(a) (1982). Section 102(a) lists seven broad categories of works of authorship: literary works; musical works, including any accompanying words; dramatic works, including any accompanying music; pantomimes and choreographic works; pictorial, graphic, and



standard of originality from the Copyright Act of 1909.<sup>228</sup> The fixation requirement is satisfied when a work is embodied "in a copy or phonorecord . . . [and] is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration."<sup>229</sup> Unfixed works, however, are not copyrightable and may receive equivalent state-law protection.<sup>230</sup> The subject matter test is clouded by section 102(b), which provides that copyright cannot extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is embodied, described, or explained.<sup>231</sup> Since copyright protection is not available for these matters, they are arguably not within the subject matter of copyright, and state-law protection of them is not preempted.<sup>232</sup>

The second issue is whether the right protected by state law is equivalent to one of the exclusive rights in section 106. Generally, if the right is infringed by an act that constitutes copyright infringement—unauthorized reproduction, performance, distribution, or display—then the right is equivalent.<sup>233</sup> If some

sculptural works; motion pictures and other audio-visual works; and sound recordings. The listing is illustrative and does not exhaust the scope of original works that the Act is designed to protect. H.R. REP., *supra* note 27, at 53; see 17 U.S.C. § 101 (1982) (definitions).

228. H.R. REP., *supra* note 27, at 51; see *supra* notes 18-19 and accompanying text.

229. 17 U.S.C. § 101 (1982).

230. 1 M. NIMMER, *supra* note 2, § 1.01[B](2)(a), at 1-23. Examples of unfixed works include "choreography that has never been filmed or notated, an extemporaneous speech, 'original works of authorship' communicated solely through conversations . . . and a dramatic sketch or musical composition improvised or developed from memory and without being recorded or written down." H.R. REP., *supra* note 27, at 131. The states may protect such works until they are fixed in a tangible form, even by creating rights that are equivalent to copyright. 1 M. NIMMER, *supra* note 2, § 1.01[B](2)(a), at 1-23.

231. 17 U.S.C. § 102(b) (1982). Facts are equivalent to discoveries. See *Harper & Row, Publishers, Inc. v. Nation Enters.*, 723 F.2d 195, 202 n.7 (2d Cir. 1983), *cert. granted*, 104 S. Ct. 2655 (1984) (No. 83-1632).

232. See *Abrams*, *supra* note 24, at 560-61. An unequivocal conclusion, however, is not possible. See A. LATMAN, *supra* note 1, at 33-35. The states cannot protect a work within §§ 102 and 103 that fails to achieve copyright protection because it is too minimal or lacking in originality to qualify or because it has fallen into the public domain. H.R. REP., *supra* note 27, at 131. This restriction appears to prohibit state-law protection of facts or discoveries since they are not original and are in the public domain. See *Harper & Row, Publishers, Inc. v. Nation Enters.*, 723 F.2d 195, 202 (2d Cir. 1983), *cert. granted*, 104 S. Ct. 2655 (1984) (No. 83-1632). On the other hand, since copyright cannot extend to facts because they are not writings within the copyright clause, they technically are outside the scope of the subject matter protectible by copyright and state protection should not be preempted. See A. LATMAN, *supra* note 1, at 34; 1 M. NIMMER, *supra* note 2, § 1.01[B](2)(b), at 1-23 to -25; *id.* § 2.11[E], at 2-165 n.30.

Arguably, Congress cannot provide copyright protection for facts, so it cannot preempt the state from enacting such legislation. 1 M. NIMMER, *supra* note 2, § 2.11[E] at 2-165 n.30. *Contra Harper & Row, Publishers, Inc. v. Nation Enters.*, 723 F.2d 195, 200 (2d Cir. 1983) (court concluded that the work fell within the subject matter of copyright even though large portions of it were unprotectible materials), *cert. granted*, 104 S. Ct. 2655 (1984) (No. 83-1632); *Abrams*, *supra* note 24, at 562-63. See *supra* notes 172-85 and accompanying text; *infra* notes 301-02 and accompanying text. To conclude otherwise would permit the states "to expand the perimeters of copyright protection to their own liking" on a theory that preemption would not bar state protection of materials that did not satisfy federal standards. *Harper & Row*, 723 F.2d at 200. Allowing such state action would create "vague borderline areas between State and Federal protection" contrary to the intent of section 301. *Id.* (citing H.R. REP., *supra* note 27, at 130); see also *infra* notes 286-324 and accompanying text.

233. The state claim must protect rights that are qualitatively different from the rights of reproduction, performance, distribution, or display to escape preemption. *Harper & Row, Publish-*

other element must be established to constitute a violation in addition to, or instead of, one of those acts, however, the state right is not equivalent to a federal right and is not preempted. Thus, assume that a movie producer and an author contract with the understanding that the producer will consider the author's manuscript as the basis for a movie. The producer determines not to use the manuscript and returns it, but then makes a movie derived from it. The author's breach of contract claim, an action to enforce a state-created right, should not be preempted by copyright law because the author must allege and prove more than acts of reproduction, distribution, performance, or display.<sup>234</sup>

The equivalent-rights test of the section 301 preemption analysis, however, is rarely so easy to apply. The legislative history does not clarify matters; early versions of section 301(b)(3) preserved state remedies for breaches of trust and contract, trespass, conversion, invasion of privacy, defamation, deceptive trade practices, and misappropriation that was not equivalent to any of the exclusive rights.<sup>235</sup> Opposition to the use of misappropriation claims resulted in an amendment that deleted these examples from the final version of the statute.<sup>236</sup> The congressional debate and the additions to and deletions from section 301 obscure legislative intent so that it is unclear whether any of the deleted claims are preserved. Other than misappropriation, the examples seem to be state-created rights that should escape preemption.

The continued vitality of misappropriation, however, is less certain.<sup>237</sup> One court has stated that Congress, by deleting the examples,

---

ers, Inc. v. Nation Enters., 501 F. Supp. 848, 852 (S.D.N.Y. 1980), *aff'd*, 723 F.2d 195 (2d Cir. 1983), *cert. granted*, 104 S. Ct. 2655 (1984) (No. 83-1632); *accord*, Schuchart & Assocs. v. Solo Serve Corp., 540 F. Supp. 928, 943 (W.D. Tex. 1982); *see also* 1 M. NIMMER, *supra* note 2, § 1.01[B], at 1-11 to -12 ("If under state law the act of reproduction, performance, distribution or display . . . will in itself infringe the state created right, then such right is preempted.")

234. *See* Harper & Row, Publishers, Inc. v. Nation Enters., 723 F.2d 195, 200 (2d Cir. 1983) ("when a state law violation is predicated upon an act incorporating elements beyond mere reproduction or the like, the rights involved are not equivalent and preemption will not occur"), *cert. granted*, 104 S. Ct. 2655 (1984) (No. 83-1632); *see infra* notes 322-36 and accompanying text; *cf.* Sellers v. American Broadcasting Co., 668 F.2d 1207 (11th Cir. 1982). The legislative history of § 301 suggests that actions for breach of contract are not preempted. H.R. REP., *supra* note 27, at 132. In discussing the equivalent rights test, Congress noted that:

[t]he evolving common law rights of "privacy," "publicity," and trade secrets, and the general laws of defamation and fraud, would remain unaffected as long as the causes of action contain elements, such as an invasion of personal rights or a breach of trust or confidentiality, that are different in kind from copyright infringement.

*Id.*

235. H.R. REP., *supra* note 27, at 24, 132. Earlier versions of § 301 did not list all of these state-created rights. *See* H.R. 4347, 89th Cong., 2d Sess. (1966); HOUSE JUDICIARY COMM., 88TH CONG., 2D SESS., PRELIMINARY DRAFT FOR REVISED U.S. COPYRIGHT LAW AND DISCUSSIONS AND COMMENTS ON THE DRAFT 18 (Comm. Print 1964). Reports accompanying those earlier versions observed that the legislation would preempt causes of action referred to as misappropriation. *See, e.g.*, H.R. REP. NO. 83, 90th Cong., 1st Sess. 100 (1967). Later drafts added misappropriation actions that did not protect rights exclusively within copyright. These later drafts also added trespass and conversion actions. *See, e.g.*, S. 22, 94th Cong., 2d Sess. § 30(b)(3), 122 CONG. REC. 3849 (1976).

236. The Justice Department was the chief opponent to listing misappropriation as a preserved claim. It argued that this exception would defeat the section's underlying purpose. *See* Shipley, *supra* note 203, at 704-05; Comment, *supra* note 203, at 487-88.

237. *See* Abrams, *supra* note 24, at 548; Shipley, *supra* note 203, at 705-06.

must have decided it was better to permit the states in the first instance through statutory or decisional law to specify or fashion "rights or remedies" that fall within clause (3), subject, of course, to court application of the copyright law limitations of clause (3). While deleted from clause (3), those causes of action remain illustrative of "certain types of misappropriation, not preempted under section 301."<sup>238</sup>

Another court was more equivocal about the impact of the deletions: "it is unclear . . . whether Congress thereby intended to leave the state law of misappropriation intact. The court concurs with Professor Nimmer's view that § 301(b)(3) as finally enacted requires a determination as to whether state misappropriation law is 'equivalent' to copyright."<sup>239</sup> It is reasonable to conclude that a misappropriation claim generally must be analyzed under section 301 just as any other state-law claim; misappropriation may escape preemption only when the subject matter involved is not copyrightable or when the right to be vindicated is not equivalent to a right protected by copyright.<sup>240</sup>

### B. Potential State-Law Remedies

Nonfiction authors have used several common-law causes of action to supplement copyright protection. Misappropriation is the most advantageous claim with which to protect research, although claims for breach of an express, quasi-, or implied-in-fact contract or unjust enrichment also are possible. Such claims must be examined under the two-tiered test of section 301 as well as under *Sears-Compco* principles, however, to determine whether they survive federal preemption.

#### 1. Misappropriation

The misappropriation doctrine potentially is available whenever a person imitates or uses a work developed at the expense of another.<sup>241</sup> Misappropriation

238. *Mitchell v. Penton/Industrial Publishing Co.*, 486 F. Supp. 22, 25 (N.D. Ohio 1979). Plaintiff in *Mitchell* argued that defendant had infringed plaintiff's copyright and therefore should be held liable for unfair competition because defendant had appropriated many of the factual elements of plaintiff's book. *Id.* at 22-23. The court held that the unfair competition claim was preempted because it was asserted to protect rights equivalent to those protected by copyright. *Id.* at 25-26.

239. *Orth-O-Vision, Inc. v. Home Box Office*, 474 F. Supp. 672, 684 n.12 (S.D.N.Y. 1979). Home Box Office's (HBO) counterclaim asserted that plaintiff was misappropriating HBO's signals and broadcasting them without authorization. Plaintiff apparently had misled customers to believe that HBO's service was plaintiff's production; plaintiff was not passing off its services as HBO's. The court noted that the movies televised by HBO are copyrightable subject matter under 17 U.S.C. § 102(a)(6) (1982), so the key preemption issue was whether the state-law claim was equivalent to rights set forth in § 106. HBO asserted that it had lost the right to exhibit its audiovisual works for a profit; the court concluded that this right was equivalent to the performance right. HBO's unfair competition claim therefore was preempted. *Orth-O-Vision*, 474 F. Supp. at 682-84 & n.12.

240. *Abrams*, *supra* note 24, at 537-48 (legislative history of preemption of misappropriation is in a state of confusion); *Shipley*, *supra* note 203, at 706 & n.236.

241. Letter from Michael M. Uhlmann, Assistant Attorney General for Legislative Affairs, to Senator Robert Kastenmeier (July 27, 1976). The misappropriation doctrine applies to facts like those in *Miller*: an author's research, done at considerable time, expense, and labor, and then

tion has evolved into an independent prohibition against conversion of another's investment. It does not provide the defenses available under passing-off and unfair competition theories,<sup>242</sup> and it has been employed successfully against unauthorized users of public domain materials.<sup>243</sup>

The doctrine was developed in *International News Service v. Associated Press*.<sup>244</sup> International News Service (INS) did not have access to the cables that wired war news from Europe, so it copied the news from the Associated Press' (AP) bulletin boards and member newspapers on the east coast. INS then wired the news to its west coast clients. Because some of INS's west coast papers were published earlier than AP's western editions, INS was able to publish the war news before AP. The Supreme Court held that INS's conduct was actionable,<sup>245</sup> and noted that although the expression of news is copy-rightable,<sup>246</sup> the "news" itself is not created by an author and is in the public domain.<sup>247</sup> Because AP was not seeking protection for its expression, it was forced to depend on the law of unfair competition for relief.<sup>248</sup> The Court noted the inequity that would result if INS prevailed:

[INS] admits that it is taking material that has been acquired by complainant as the result of organization and the expenditure of labor, skill, and money, and which is salable by complainant for money, and that defendant in appropriating it and selling it as its own is endeavoring to reap where it has not sown, and by disposing of it to newspapers that are competitors of complainant's members is appropriating to itself the harvest of those who have sown. Stripped of all disguises, the process amounts to an unauthorized interference with the normal operation of complainant's legitimate business precisely

---

expressed in a book, is used by another who writes a screenplay for a movie, without copying the author's expression but also without doing any independent research, writes a screenplay for a movie. This copying deprives the original author of a natural market for his work because he expected to capitalize not only in print media but in derivative media as well. The defendant who used the original author's research without doing any independent research is guilty of misappropriation, just as INS was liable for misappropriating the news from AP. *International News Serv. v. Associated Press*, 248 U.S. 215 (1918). See *infra* notes 244-53 and accompanying text. The second author's actions diminish the value of the original author's work in the medium of the second work—motion pictures—and deprive the first author of a fair return on his investment. Misappropriation has a strong visceral appeal because it affords relief against a second author who seeks "to reap where [he] has not sown." *International News Service*, 248 U.S. at 239.

242. Goldstein, *supra* note 223, at 1116. See Baird, *supra* note 31, at 413; Comment, *supra* note 203, at 479-80.

243. See Abrams, *supra* note 24, at 510-11, 513, 517; Denicola, *supra* note 6, at 517 n.7 and the cases cited therein.

244. 248 U.S. 215 (1918).

245. *Id.* at 231-32, 238-39. Baird, *supra* note 31, at 412.

246. AP had not protected its stories by copyright, in part because the law's notice requirements made protection difficult to retain. Baird, *supra* note 31, at 412 n.5.

247. "It is not to be supposed that the framers of the Constitution, when they empowered Congress [to protect works by copyright] intended to confer upon one who might happen to be the first to report a historic event the exclusive right for any period to spread the knowledge of it." *International News Serv.*, 248 U.S. at 234. The Court recognized that because the news is facts, it is not a writing within the Constitution's copyright clause. *Id.*; see also 1 M. NIMMER, *supra* note 2, § 2.11[E], at 2-165 n.30.

248. *Id.* at 234-35. A court of equity would characterize the misconduct as unfair competition. *Id.* at 240.

at the point where the profit is to be reaped, in order to divert a material portion of the profit, from those who have earned it to those who have not.<sup>249</sup>

Despite this expansive language recognizing AP's quasi-property interest in the news it gathered, the Court only postponed the time during which INS could "participat[e] . . . in the process of distribution and reproduction of news that it had not gathered" to the extent necessary to prevent INS from benefitting from AP's labor.<sup>250</sup> This postponement allowed INS to continue using the unprotected news, though at a later date, while maintaining an incentive for AP to gather and disseminate the news.<sup>251</sup> More importantly, the Court recognized a cause of action for misappropriation—the conversion of the investment, labor, or skill of another for one's own use<sup>252</sup>—without requiring misrepresentation or "palming off."<sup>253</sup>

The court's emphasis on "reaping where . . . [one] has not sown" led other courts to focus on unjust enrichment elements, such as the existence of a competitive relationship, rather than on unfair competition elements.<sup>254</sup> As one court noted,

[t]he modern view as to the law of unfair competition does not rest solely on the ground of direct competitive injury, but on the broader principle that property rights of commercial value are to be and will be protected from any form of unfair invasion or infringement and from any form of commercial immorality . . . .<sup>255</sup>

This extended misappropriation doctrine became "a device through which states prevent copying where statutory copyright will not."<sup>256</sup>

249. *Id.* at 239-40. The Court distinguished between the public's right to use the information conveyed by AP and a competitor's right to use the information to compete unfairly. Thus, the Court recognized a quasi-property interest, valid only against a competitor. See Comment, *supra* note 203, at 479.

250. *International News Serv.*, 248 U.S. at 241.

251. Baird, *supra* note 31, at 415; see *International News Serv.*, 248 U.S. at 233.

252. *International News Serv.*, 248 U.S. at 236; see B. KAPLAN, *supra* note 51, at 86-87.

253. *International News Serv.*, 248 U.S. at 241-42. INS did not represent to readers that the news was gathered by AP, but even if INS had given AP credit for the story, it still would have been liable for unfair competition because it misappropriated AP's information without paying for it. Baird, *supra* note 31, at 413.

254. Comment, *supra* note 203, at 479-80.

255. Metropolitan Opera Ass'n v. Wagner-Nichols Recorder Corp., 199 Misc. 786, 796, 101 N.Y.S.2d 483, 492 (Sup. Ct. 1950), *aff'd*, 279 A.D. 632, 107 N.Y.S.2d 795 (1951). Misappropriation has been defined as having three elements: creation of plaintiff's product through extensive time, labor, skill and money; defendant's use of that product in competition with plaintiff, thereby gaining a special advantage since defendant has not been burdened with the development expenses incurred by plaintiff; and commercial damage to plaintiff. Synercom Technology, Inc. v. University Computing Co., 474 F. Supp. 37, 39 (N.D. Tex. 1979) (citing Dannay, *The Sears-Compo Doctrine Today: Trademarks and Unfair Competition*, 67 TRADE-MARK REP. 132, 134 (1976)).

256. Goldstein, *supra* note 233, at 1116. Roy Export Co. v. CBS, 672 F.2d 1095, 1105 (2d Cir. 1982) (noting the "incalculable variety" of illegal practices falling within the unfair competition/misappropriation rubric under New York law); *Financial Information v. Moody's*, 1984 COPYRIGHT L. REP. (CCH) ¶ 25,617 at 18,766-67 (S.D.N.Y. 1984); Abrams, *supra* note 24, at 515; see also Goldstein, *Federal System Ordering of the Copyright Interest*, 69 COLUM. L. REV. 49, 58 (1969).

a. *Equivalent rights*

Whether misappropriation is preempted by the Copyright Act of 1976 or earlier common-law principles has been debated at length.<sup>257</sup> To the extent that the misappropriation doctrine merely prevents reproduction and distribution while the Copyright Act does not, the rights being protected appear to be equivalent to those protected by section 106.<sup>258</sup> The doctrine of misappropriation, however, does not function solely as another means to prevent copying. When direct competition exists, misappropriation seemingly protects "the limited right of a commercial enterprise to be free from unfair competitive practices that deprive it of a fair return on its work and investment."<sup>259</sup> Although the claimant may have no right to protect his work from use by the public at large, he may have limited rights against unfair acts of a competitor.<sup>260</sup> In such competitive circumstances, misappropriation arguably protects rights other than those in section 106 and should not be preempted.<sup>261</sup>

---

257. See *Abrams*, *supra* note 24, at 537-73; *Baird*, *supra* note 242, at 424; *Shipley*, *supra* note 203, at 705-06; see also *supra* notes 235-40 and accompanying text. Even if the Act's specific statutory preemption provision—§ 301—is not applicable, it appears that the preemption cases decided prior to the adoption of the Copyright Act of 1976 still are applicable and may preempt state-created rights that impermissibly conflict with copyright objectives. See *Klitzner Indus., Inc. v. H.K. James & Co.*, 535 F. Supp. 1249 (E.D. Pa. 1982). In *Klitzner*, the court determined that plaintiff's misappropriation claim was preempted under the *Sears-Compco* doctrine and never considered the applicability of § 301, even though the cause of action arose after the effective date of the Copyright Act of 1976. *Id.* at 1257-58.

258. 1 M. NIMMER, *supra* note 2, § 1.01[B], at 1-17; *Abrams*, *supra* note 24, at 517; *Goldstein*, *supra* note 223, at 1116; see, e.g., *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 918-19 (2d Cir. 1980); *Videotronics, Inc. v. Band Electronics*, 564 F. Supp. 1471 (D. Nev. 1983) (elements of misappropriation established, but the work appropriated was a computer program subject to copyright protection that had been available to the public; thus, plaintiff's state-law claims were preempted); *Suid v. Newsweek Magazine*, 503 F. Supp. 146 (D.D.C. 1980); *Walker v. Time Life Films, Inc.*, 1983 COPYRIGHT L. REP. (CCH) ¶ 25,553 (N.Y. Sup. Ct. 1983) (misappropriation and unfair competition claims held to be equivalent).

259. Comment, *supra* note 235, at 491; see also 1 M. NIMMER, *supra* note 2, § 1.01[B], at 1-20 (discussing New York's law of unfair competition, which bans any form of commercial immorality); see, e.g., *Sellers v. ABC*, 668 F.2d 1207 (11th Cir. 1982) (recovery may be permitted in New York for misappropriation of an idea or theory if the idea is novel, the idea is in concrete form, and defendant makes use of the idea); *Editorial Photocolor Archives, Inc. v. Granger Collection*, 94 A.D.2d 347, 464 N.Y.S.2d 506 (1983) (state-law claim of unfair competition based on alleged appropriation of film transparencies not dismissed under Act's preemption provisions; dissent argued that equivalent reproduction and distribution rights were at core of plaintiff's complaint); cf. *Frederick Warne & Co. v. Book Sales, Inc.*, 481 F. Supp. 1191 (S.D.N.Y. 1979). Because the Copyright Act treats facts, discoveries, ideas, and theories uniformly in § 102(b), it is plausible to argue that New York courts also would treat them uniformly, and thus, under the *Sellers* criteria, would allow recovery for the misappropriation of research upon a similar showing.

260. *International News Serv.*, 248 U.S. at 239; 1 M. NIMMER, *supra* note 2, § 1.01[B], at 1-20; Comment, *supra* note 203, at 491.

261. Comment, *supra* note 203, at 491-92. Requiring a plaintiff to prove unfairness and an unjustifiable attempt to profit from another's labors may distinguish the action apart from copyright infringement. See, e.g., *Roy Export Co. v. CBS*, 503 F. Supp. 1137 (S.D.N.Y. 1980) (New York law of unfair competition, banning "any form of commercial immorality" and requiring proof of bad faith, not preempted), *aff'd*, 672 F.2d 1095 (2d Cir. 1982); see also 1 M. NIMMER, *supra* note 2, § 1.01[B], at 1-20. Professor Nimmer, however, does not agree that the necessity of proving these elements preserves the state-law remedy. See *id.* § 1.01[B], at 1-20 to -21 (stating that the argument is circular); accord *Rand McNally v. Fleet Management Sys.*, 1984 COPYRIGHT L. REP. (CCH) ¶ 25,624, at 18,799, 18,811 (N.D. Ill. Dec. 31, 1983) (immorality and wrongdoing are not additional elements; however, breach of a fiduciary duty may take the claim out of § 301).

The legislative history of section 301 provides some support for this approach. The House Report stated:

[S]tate law should have the flexibility to afford a remedy (under traditional principles of equity) against a consistent pattern of unauthorized appropriation by a competitor of the facts (i.e., not the literary expression) constituting "hot" news, whether in the traditional mold of *International News Service v. Associated Press* or in the newer form of data updates from scientific, business, or financial data bases.<sup>262</sup>

Thus, misappropriation appears to be preserved to the extent that it prohibits a pattern of unfair use by a competitor.<sup>263</sup> In addition to proving the reproduction of material similar to "hot news," the claimant would have to demonstrate that the defendant was both a competitor and engaged in a pattern of misappropriation. Even if the plaintiff could prove these elements, however, the general uncertainty in this area of law still may lead some courts to hold that a misappropriation claim has been preempted.<sup>264</sup>

A nonfiction author normally would be unable to demonstrate a pattern of misappropriation; because of the nature of his work the misappropriation is ordinarily a one-time event. Competition between two authors often could be proved, however, because the second work would diminish the potential market of the first work—particularly when the second work was derivative.<sup>265</sup> Such competition would supply the requisite additional element to enable the misappropriation claim to escape preemption under section 301. The basic cause of action, however, still would be an allegation that the second author reproduced and adapted, without authorization, the information contained in the plaintiff's book. The element of competition would not appear to add anything to the usual copyright infringement claim; rather, it would seem to exist

---

262. H.R. REP., *supra* note 27, at 132.

263. "Section 301 is not intended to preempt common law protection in cases involving activities such as false labeling, fraudulent representation, and passing off even where the subject matter involved comes within the scope of the copyright statute." *Id.* at 132. To the extent that a misappropriation claim involves these additional elements, it should not be preempted by § 301.

264. *See, e.g.*, Board of Trade v. Dow Jones & Co., 108 Ill. App. 3d 681, 439 N.E.2d 526 (1982) (*Dow Jones I*). In a declaratory judgment action brought by the Board, the Illinois appellate court found that the preparation of an index by Chicago's Board of Trade, based on the Dow Jones Industrial Average, which is protectible by copyright, violated proprietary rights of Dow Jones. Thus, the court enjoined the Board from using the Industrial Average, citing *International News Serv. v. Associated Press*. *Id.* at 689-97, 439 N.E.2d at 532-37; *see also* Baird, *supra* note 242, at 425 & n.63 (Dow Jones Industrial Average calculations are easily upheld). Although the misappropriation claim seemingly was equivalent and could have been preempted, the *Dow Jones I* court did not discuss § 301 preemption. *But cf.* Dow Jones & Co. v. Board of Trade of Chicago, 546 F. Supp. 113 (S.D.N.Y. 1982) (*Dow Jones II*). In *Dow Jones II*, plaintiff sought an injunction to prevent the Board from using its lists, which the court held were subject to copyright protection. The court stated that the Board of Trade had misappropriated elements protectible by copyright, but nevertheless denied injunctive relief because the Board's action constituted fair use. *Id.* at 119-21. In each case the challenged activities involved the reproduction of Dow Jones' copyrightable materials. The misappropriation claim was equivalent and the court in *Dow Jones I* should not have recognized it as a ground for relief.

265. In *Miller*, ABC's production of a television movie derived from Miller's book effectively destroyed the demand for Miller's work in the film media. *Miller v. Universal City Studios, Inc.*, 460 F. Supp. 984, 985-86 (S.D. Fla. 1978); *see supra* notes 159-71 and accompanying text.

in nearly every infringement situation. Therefore, unless a pattern of misappropriation also could be proved, the misappropriation claim would be preempted.

*Schuchart & Associates, Professional Engineers, Inc. v. Solo Serve Corp.*<sup>266</sup> involved allegations of copyright infringement, misappropriation, and unjust enrichment with respect to architectural and engineering drawings.<sup>267</sup> Defendants contended that the misappropriation claim was preempted. The court stated that the architectural drawings were within the subject matter of copyright; therefore, the first prong of the section 301 test was satisfied.<sup>268</sup> With regard to the second prong, the court stated that preemption was required "when state law rights are not 'different in kind'" from copyright.<sup>269</sup> Thus, the rights being protected under federal and state laws must be compared to ascertain whether the state-protected rights "are *qualitatively* different from the [federally-protected] rights of reproduction, performance, distribution, or display."<sup>270</sup> The court defined the elements of misappropriation as: (1) plaintiffs' creation of their product "through extensive time, labor, skill or money"; (2) defendants' use of plaintiffs' product in competition with plaintiff, at minimal expense to defendants (free ride); and (3) commercial damage to plaintiffs' product because of defendants' use.<sup>271</sup> The court noted that plaintiffs were required to prove that defendants had copied the drawings under both the misappropriation and the copyright claims. In conclusion, the court held that the state and federal rights were equivalent, even though misappropriation also required defendants' competitive use of plaintiffs' products and commercial detriment to plaintiffs; those additional elements, however, did not make the misappropriation claim different in kind from a copyright claim. Thus, in *Schuchart*, as in other cases in which the plaintiff could not establish a pattern of unfair use,<sup>272</sup> the misappropriation claim was deemed equivalent and thus preempted by federal copyright law.<sup>273</sup>

266. 540 F. Supp. 928, 950 (W.D. Tex. 1982) (defendant's unauthorized use of the copyrighted drawings and plans of a shopping center gave rise to a nonpreempted unjust enrichment claim); see *infra* notes 383-390 and accompanying text.

267. Plaintiffs alleged that defendants did not create, produce, or distribute certain architectural drawings but sought to deceptively and fraudulently use plaintiff's work. *Schuchart v. Solo Serv. Corp.*, 540 F. Supp. 928, 933-35, 942 (W.D. Tex. 1982). Defendants argued that this allegation in effect charged them with misappropriation and moved to dismiss the claims. *Id.* at 942.

268. *Id.* at 943. Protection extends to literary, pictorial, graphic, and sculptural works. 17 U.S.C. § 102(a)(1), (5) (1982).

269. *Schuchart v. Solo Serv. Corp.*, 540 F. Supp. 928, 943 (W.D. Tex. 1982).

270. *Id.* (quoting *Harper & Row, Publishers, Inc. v. Nation Enters.*, 501 F. Supp. 848, 852 (S.D.N.Y. 1980) (emphasis in original), *aff'd in part and rev'd in part*, 723 F.2d 195 (2d Cir. 1983), *cert. granted*, 104 S. Ct. 2655 (1984) (No. 83-1632)).

271. *Id.* at 943-44.

272. The decisions that distinguish between copying (or reproduction) and misappropriation are probably in error. No substantive distinction exists between such actions. 1 M. Nimmer, *supra* note 2, § 1.01[B], at 1-19; cf. *Abrams*, *supra* note 24, at 526. Misappropriation is but another label for reproduction. But see *Rand McNally v. Fleet Management Sys.*, 1984 COPYRIGHT L. REP. ¶ 25,624 at 18,799, 18,811 (N.D. Ill. 1983) (misappropriation claim directed against use of facts from compilation, as opposed to reproduction of the entire compilation, may escape § 301 preemption).

273. *Schuchart v. Solo Serv. Corp.*, 540 F. Supp. 928, 944 (W.D. Tex. 1982). The court acknowledged that, under different facts, an unfair competition claim might protect different rights,



b. *Subject matter*

In the absence of a pattern of misconduct, the author's strongest argument against preemption is not that the state and federal rights are different in kind, but that the research appropriated is not within the subject matter of copyright as required by section 301.<sup>274</sup> Copyright protection subsists in fixed, original works of authorship, including literary works,<sup>275</sup> compilations, and derivative works.<sup>276</sup> Protection, however, does not extend to any "discovery" or idea regardless of the way it is expressed.<sup>277</sup> Because copyright may not be claimed in facts but only in the manner in which facts are expressed, arranged, or selected, the states arguably are free to protect facts per se under misappropriation.<sup>278</sup> This argument, however, is only true if Congress' intent in enacting section 102(b) was to save ideas and facts from preemption, rather than to preclude equivalent state protection of them altogether.<sup>279</sup>

Section 102(a), in describing the protected subject matter categories, refers to "works of authorship." Section 102(b) then states: "In no case does copyright protection for an original work of authorship extend to any idea, . . . or discovery . . ." <sup>280</sup> One could interpret section 102(b) to include ideas and discoveries in the definition of "original works of authorship," but not those protected by the Act. If this is true, the list of unprotected elements in section 102(b) would be "subject matter within the meaning of section 102(a)—and therefore subject to preemption although not protected under the statute."<sup>281</sup> This interpretation, however, seems incorrect because none of the

---

such as palming off, passing off, or likelihood of confusion; if so, it would escape preemption. *Id.* & n.12. In *Schuchart*, however, plaintiffs were seeking to enforce an equivalent right. *Id.* See also *Giangrosso v. CBS*, 534 F. Supp. 472, 478 (E.D.N.Y. 1982), in which the court noted that "[c]ourts in this circuit have consistently recognized that claims for unfair competition are 'equivalent to exclusive rights within the general scope of copyright' and are preempted . . ." See also *Durham Indus. v. Tomy Corp.*, 630 F.2d 905, 918-19 (2d Cir. 1980); *Najarjian v. Tobias*, COPYRIGHT L. REP. (CCH) ¶ 25,595 (D. Mass. 1983); *Videotronics, Inc. v. Bend Electronics*, 26 PAT. TRADE-MARK & COPYRIGHT J. (BNA) 196 (D. Nev. 1983); *Walker v. Time Life Films, Inc.*, COPYRIGHT L. REP. (CCH) ¶ 25,554 (N.Y. Sup. Ct. July 18, 1983). But see *Sellers v. ABC*, 668 F.2d 1207, 1210 (11th Cir. 1982) (interpreting New York law); *Roy Export Co. v. CBS*, 672 F.2d 1095, 1104-06 (2d Cir. 1982) (misappropriation claim survives preemption under *Sears-Compco* principles); *Editorial Photocolor Archives, Inc. v. Granger Collection*, 94 A.D.2d 347, 464 N.Y.S.2d 506 (1983) (unfair competition claim survived preemption).

274. 17 U.S.C. § 301(b)(1) (1982) preserves the state-created rights of works not within the subject matter of copyright.

275. *Id.* § 102(a)(1). Equivalent state-law protection of unfixed works is not preempted. *Id.* § 301(b)(1).

276. *Id.* § 103(a).

277. *Id.* § 102(b).

278. A. LATMAN, *supra* note 1, at 34; 1 M. NIMMER, *supra* note 2, § 1.01[B], at 1-23 to -25; see *Rand McNally v. Fleet Management Sys.*, COPYRIGHT L. REP. (CCH) ¶ 25,624 at 18,799, 18,811 (N.D. Ill. 1983) (misappropriation claim against use of facts from compilation and copying of plaintiff's "procedures, processes, and systems" not preempted under § 301 because such matters are excluded expressly from the subject matter of copyright by § 102(b); however, potential first amendment problems exist). On the other hand, if facts are not within the subject matter of copyright, all state rights or remedies are preempted. 17 U.S.C. § 301(b)(1) (1982).

279. Cf. A. LATMAN, *supra* note 1, at 34; 1 M. NIMMER, *supra* note 2, § 1.01[B], at 1-23 to -26; Goldstein, *supra* note 223, at 1118-20.

280. 17 U.S.C. § 102(a)-(b) (1982).

281. Goldstein, *supra* note 223, at 1119 (citing H.R. REP., *supra* note 27, at 57).

elements listed in section 102(b) appear to be original works. Rather, section 102(b) is phrased to prohibit protection for ideas and discoveries *as they are embodied in the original works of authorship*. Facts are not original works of authorship, which is precisely the reason that copyright does not protect them.<sup>282</sup> Thus, because facts are not within the subject matter of copyright, equivalent state protection should not be preempted;<sup>283</sup> however, the House Report of section 301 stated:

As long as a work fits within one of the general subject matter categories of sections 102 and 103, the bill prevents the States from protecting it even if it fails to achieve Federal statutory copyright because it is too minimal or lacking in originality to qualify, or because it has fallen into the public domain.<sup>284</sup>

This legislative history indicates that Congress intended to preempt equivalent state protection for any work within the general scope of the subject matter of copyright. If a work as a whole is protected by copyright, equivalent state protection of the work should not be allowed, even if parts of the work are not protectible: a biography or historical account is a copyrightable literary work within section 102(a)(1). A work consisting of unprotectible facts is not outside the subject matter protected by the Act. Because the entire work is protectible under the Act, all equivalent state-law claims arguably are preempted,<sup>285</sup> including misappropriation claims for "stolen" facts or research. Section 102(b) should not be interpreted to preserve discoveries (facts) for equivalent state-law protection.

The few decisions dealing with these issues have not been consistent. In *United States Trotting Association v. Chicago Downs Association*<sup>286</sup> the court stated in a footnote that a claim of misappropriation of the facts in race horse eligibility certificates was not preempted.<sup>287</sup> This misappropriation claim, however, was unique because plaintiffs were trying to recover for the actual physical taking of the certificates, rather than for any use of the unprotected information; therefore, this misappropriation claim was not equivalent to

---

282. 1 M. NIMMER, *supra* note 2, § 1.01[B], at 1-24.

283. *Id.* The first amendment may limit state-law protection of facts. *Id.* at 1-25; *see supra* note 84. Professor Nimmer also states that insofar as the *International News Service* case was concerned with news per se, rather than the expression of the news, the AP misappropriation claim would escape preemption under § 301 because news per se is not a writing within the Constitution's copyright clause. *Id.* at 1-25 n.102; *cf.* Harper & Row, Publishers, Inc. v. Nation Enters., 723 F.2d 195, 200, 203-06 (2d Cir. 1983) (news events are not protected by copyright but are protected by the first amendment; court would void an attempt by a state to protect news events), *cert. granted*, 104 S. Ct. 2655 (1984) (No. 83-1632). *But see* Abrams, *supra* note 24, at 563.

284. H.R. Rep., *supra* note 27, at 131.

285. Harper & Row, Publishers, Inc. v. Nation Enters., 723 F.2d 195, 200, 203-06 (2d Cir. 1983), *cert. granted*, 104 S. Ct. 2655 (1984) (No. 83-1632); *cf.* A. LATMAN, *supra* note 1, at 34; Abrams, *supra* note 24, at 563; Goldstein, *supra* note 223, at 1119 & n.52. Otherwise, the state "could expand the perimeters of copyright" to protect material not meeting federal standards. This state-law expansion would create "vague borderline areas between State and Federal protection" and circumvent one of the central purposes of the Act—the establishment of comprehensive federal copyright standards. Harper & Row, Publishers, Inc. v. Nation Enters., 723 F.2d 195, 200 (2d Cir. 1983), *cert. granted*, 104 S. Ct. 2655 (1984) (No. 83-1632); *see supra* note 265.

286. 665 F.2d 781 (7th Cir. 1981).

287. *Id.* at 785 n.6.

copyright.<sup>288</sup> In *Werlin v. Reader's Digest Association*<sup>289</sup> the court treated plaintiff's work as both an article and an idea. To the extent it was an article, the work enjoyed copyright protection; to the extent it was an idea, the work enjoyed limited state-law protection but no federal copyright protection.<sup>290</sup> Such a cursory analysis appears to preserve equivalent state-law remedies for matters excluded from federal protection by section 102(b).

In the litigation over President Ford's memoirs, however, the trial and appellate courts preempted state-law claims for conversion and tortious interference with contract.<sup>291</sup> The lower court determined that President Ford's unpublished manuscript was an original, autobiographical, nonfiction, literary work; that much of it was not protectible as news did not negate its copyrightability.<sup>292</sup> Because the work was "within the general category of works which may qualify for copyright protection, e.g., a literary work as opposed to facts constituting 'hot news,'" <sup>293</sup> the subject matter prong of the section 301 test was satisfied, and the state-law claims were found to be equivalent and preempted.<sup>294</sup> The United States Court of Appeals for the Second Circuit affirmed, noting that the entire work was copyrightable despite the fact that portions of it were unprotectible facts. The court of appeals feared that if the states were free to protect discrete uncopyrightable elements of a work that otherwise was protected by copyright, a vague borderline between state and federal protection would develop. This result was precisely what the Act was intended to prevent.<sup>295</sup>

Neither of the *Nation* opinions examined the actual materials misappropriated by defendant. Instead, both focused on the entire manuscript as a copyrightable work of authorship, embodying the appropriated materials. Similarly, in *Suid v. Newsweek Magazine*,<sup>296</sup> the court did not analyze the actual materials that were misappropriated. Plaintiff authored a book titled

288. *Id.* at 785-86 n.6; see also 1 M. NIMMER, *supra* note 2, § 1.01[B] at 1-25 n.102. The court cited 17 U.S.C. § 301(b)(3) (1982) (the nonequivalent rights proviso) to support its conclusion that the claim was not preempted. *Chicago Downs*, 665 F.2d at 786 n.6.

289. 528 F. Supp. 451 (S.D.N.Y. 1981).

290. *Id.* at 467; *Abrams*, *supra* note 24, at 563-64; see also *Rand McNally v. Fleet Management Sys.*, COPYRIGHT L. REP. (CCH) ¶ 25,624, at 18,799, 18,811 (N.D. Ill. 1983) (facts, procedures, processes, and systems are excluded from protection by § 102(b)); *Bromhall v. Rorvik*, 478 F. Supp. 361, 367 (E.D. Pa. 1978).

291. *Harper & Row, Publishers, Inc. v. Nation Enters.*, 501 F. Supp. 848, 849-50 (S.D.N.Y. 1980), *aff'd*, 723 F.2d 195 (2d Cir. 1983) (affirming dismissal of state-law claims), *cert. granted*, 104 S. Ct. 2655 (1984) (No. 83-1632); see also *supra* notes 172-185 and accompanying text.

292. *Harper & Row Publishers, Inc. v. Nation Enters.*, 501 F. Supp. 848, 850, 851 (S.D.N.Y. 1980) (citing H.R. REP., *supra* note 27, at 131), *aff'd in part and rev'd in part*, 723 F.2d 195 (2d Cir. 1983), *cert. denied*, 104 S. Ct. 2655 (1984) (No. 83-1632).

293. *Id.* at 851.

294. The court concluded that the two state-law counts were not different in kind from copyright and, therefore, were preempted. *Id.* at 852-54.

295. *Harper & Row*, 723 F.2d at 200 (citing H.R. REP., *supra* note 27, at 130-31); see *supra* note 285. The court of appeals analyzed the equivalent rights prong of the section's preemption test and concluded that no qualitative differences existed between plaintiffs' state-law claims and the exclusive rights under the Act. *Id.* at 200-01. The court also determined that plaintiff's alternative theory of conversion failed, even though it escaped preemption, because the interference with property rights was too insubstantial. *Id.*

296. 503 F. Supp. 146 (D.D.C. 1980).

"Guts and Glory—Great American War Movies," and alleged that Newsweek published a subsequent story about the late John Wayne that infringed plaintiff's copyright and competed unfairly by misappropriating his research. The copyright claim failed<sup>297</sup> and the court, not willing to extend such protection to plaintiff's research, held that the state-law claim was preempted.<sup>298</sup> To determine whether the materials misappropriated were within the subject matter of copyright, the court focused on plaintiff's entire book, not on the materials themselves. The court merely noted that, "[a]s plaintiff concedes, his book is clearly a literary work within the subject matter of copyright."<sup>299</sup>

By limiting their analysis to whether entire works are copyrightable, the *Nation* and *Suid* courts have ignored that the misappropriated facts and research are outside the scope of copyright protection under section 102(b), regardless of how they are expressed.<sup>300</sup> The subject matter test arguably is not satisfied when the complete work is within the subject matter of copyright and the materials appropriated are not. It is possible that these state-law claims should be preempted for other reasons, such as first amendment interests or under a *Sears-Compco* analysis,<sup>301</sup> but section 301 preemption is not a foregone conclusion.<sup>302</sup>

### c. General principles of preemption

Although it is uncertain whether section 301 preempts misappropriation claims, the principles of *Sears* and *Compco* may preempt some forms of state-law protection. The *Kewanee* and *Goldstein* decisions reduced the preemptive thrust of *Sears-Compco*;<sup>303</sup> however, it still is impermissible for the states to

297. *Id.* at 147-48. Some of the misappropriated material was factual, some was not original to *Suid* and thus was not protected by his copyright. Newsweek's minimal copying of protected material was held to be a fair use.

298. *Id.* at 148-49.

299. *Id.* at 149. Plaintiff asserted a right to control reproduction, which is an exclusive right. *Id.* Plaintiff argued that Newsweek's failure to attribute authorship to him was an additional necessary element to his state-law claim, and, therefore, was not preempted. The court, however, held that a nonexistent doctrine could not supply the extra element required to preclude preemption. *Id.*

300. *See, e.g., Werlin v. Reader's Digest Ass'n*, 528 F. Supp. 451, 467 (S.D.N.Y. 1981); *Bromhall v. Rorvik*, 478 F. Supp. 361, 367 (E.D. Pa. 1978); *see also infra* notes 375-81, 390-95 and accompanying text.

301. In a sense the court of appeals in the *Nation* case responded to this issue by stating that the states cannot be allowed to expand the scope of copyright to protect materials not meeting the federal statutory standards. *See supra* note 232. *See also infra* notes 303-25, 396-400 and accompanying text. Although this conclusion is correct, general principles of preemption preclude state-law protection that is equivalent to copyright for facts. Furthermore, protection against the copying of facts might create an intolerable limitation on first amendment rights. *Harper & Row, Publishers, Inc. v. Nation Enters.*, 723 F.2d 195, 204 & n.12 (2d Cir. 1983), *cert. granted*, 104 S. Ct. 2655 (1984) (No. 83-1632).

302. Courts have held that neither news events, historical facts, nor facts of a biographical nature, are deserving of the Acts's protection. *Harper & Row, Publishers, Inc., v. Nation Enters.*, 723 F.2d 195, 202 (2d Cir. 1983), *cert. granted*, 104 S. Ct. 2655 (1984) (No. 83-1632). Because these materials are not subject to copyright protection, the subject matter prong of the § 301 preemption test is not satisfied and statutory preemption fails. *See supra* notes 274-79 and accompanying text. *Contra Abrams, supra* note 28, at 563-64 (§ 102(b) was not intended to grant authority to the states to protect facts and information).

303. *See supra* notes 203-16 and accompanying text.

regulate the use of intellectual property in a manner inconsistent with federal law.<sup>304</sup> In *Triangle Publications, Inc. v. Sports Eye, Inc.*,<sup>305</sup> plaintiff alleged that defendant's publication infringed plaintiff's daily racing form.<sup>306</sup> The copyright claim failed because defendant had not copied plaintiff's mode of disseminating the data,<sup>307</sup> but merely had used plaintiff's materials to prepare its own competing racing form.<sup>308</sup> The court noted that *Sears and Compco* preempt state regulation of unfair competition of matters within the broad confines of the Constitution's copyright clause.<sup>309</sup> *Goldstein* had limited only the thrust of those cases by "holding that the copyright and supremacy clauses *by themselves*, in the absence of congressional expression, did not prohibit any state incursions into the area."<sup>310</sup> Thus, under *Sears-Compco*, since federal copyright law protected plaintiff's racing form within constitutional limits, the attempt to protect that work under state law was preempted.<sup>311</sup>

In finding preemption, the court in *Triangle Publications*, like later courts construing section 301, concentrated on plaintiff's entire work, rather than on the unprotectible raw data that had been appropriated. Similarly, in *Hoehling v. Universal City Studios, Inc.*<sup>312</sup> plaintiff joined an unfair competition claim with his copyright infringement action.<sup>313</sup> Because the alleged violation occurred prior to the effective date of the new Act, section 301 was not discussed.<sup>314</sup> Nevertheless, the trial judge and the United States Court of Appeals for the Second Circuit rejected the state-law claim because it would conflict with federal policy: "Where, as here, historical facts, themes, and research have been deliberately exempted from the scope of copyright protection to vindicate the overriding goal of encouraging contributions to recorded knowledge, the states are preempted from removing such material from the public domain."<sup>315</sup> The same preemption analysis was applied in *Suid v.*

---

304. "[A] conflict would develop if a state attempted to protect that which Congress intended to free from restraint or that which Congress had protected." *Goldstein*, 412 U.S. at 559. Furthermore, the *Goldstein* Court noted that if failure to meet federal statutory standards had been involved, rather than subject matter left unaddressed by Congress, it would not have been disposed towards preemption. *Id.* at 569-70.

305. 415 F. Supp. 682 (E.D. Pa. 1976). This case involved the Copyright Act of 1909.

306. *Id.* at 683.

307. *Id.* at 686.

308. *Id.* at 684.

309. *Id.* at 686.

310. *Id.*

311. Otherwise, the state protection would conflict with federal copyright policy. *Id.* at 686-87 (citing *Jacobs v. Robitaille*, 406 F. Supp. 1145, 1153 (D.N.H. 1976)); see also *Abrams*, *supra* note 24, at 537. In *Goldstein*, the Supreme Court stated that "a conflict would develop if a State attempted to protect that which Congress intended to free from restraint or to free that which Congress had protected." *Goldstein*, 412 U.S. at 559. The conflict in *Triangle Publications* stemmed from an attempt to extend state law to prohibit defendant from copying data that could not be protected by copyright.

312. 618 F.2d 972 (2d Cir. 1980).

313. *Id.* at 977; see *supra* notes 148-58 and accompanying text.

314. *Hoehling*, 618 F.2d at 976-77. The alleged violations occurred in the early 1970s; the action was instituted in 1975. The new Act does not annul or limit common-law causes of action arising from acts commenced before January 1, 1978. 17 U.S.C. § 301(b)(2) (1982).

315. *Hoehling*, 618 F.2d at 980 (citing *Sears and Compco*.)

*Newsweek Magazine*,<sup>316</sup> in which the court, so as not to contravene federal law by protecting matters deliberately exempted from copyright protection,<sup>317</sup> held that Suid's unfair competition claim was preempted.

In *Mitchell v. Penton/Industrial Publication Co.*,<sup>318</sup> plaintiff alleged that in writing a book on records retention he had spent many hours sending questionnaires to government agencies and compiling data. Defendant then published an article on records maintenance, and plaintiff alleged copyright infringement and that defendant had misappropriated plaintiff's facts and had traded on plaintiff's good name and reputation.<sup>319</sup> The court, in discussing defendant's use of plaintiff's facts, stated that a claim of passing off would not be preempted under section 301.<sup>320</sup> The court concluded, however, that misappropriation was the gravamen of plaintiff's claim that defendant had taken plaintiff's information and had traded on plaintiff's good name.<sup>321</sup> Because the claim merely alleged the copying of items deemed to be in the public domain, it was similar to those in *Sears and Compco*. The court stated that if plaintiff's copyright infringement action was successful, his misappropriation claim would be redundant. On the other hand, if plaintiff's copyright claim failed, *Sears-Compco* would apply, the state claim would be preempted, and the alleged infringer would be permitted to copy the work. Thus, the court granted defendant's motion to dismiss this "misappropriation" claim.<sup>322</sup>

Discoveries and ideas arguably can be protected by state law because they are not within the statutorily defined subject matter of copyright. Blanket adoption of this interpretation, however, would undermine section 301. To ensure that states do not protect facts and information that Congress intended to be used freely, misappropriation claims should be preempted under *Sears-Compco*. The basic goals of copyright and misappropriation are the same—copyright protects the plaintiff's expression and misappropriation protects the business advantage derived from the plaintiff's work. Enforcement of a misappropriation claim concerning facts or research would contravene Congress' explicit statement in section 102(b) that discoveries and ideas cannot be protected, regardless of how they are embodied in a work. Misappropriation claims must be preempted because they "would interfere with the federal policy, found in article I, § 8, cl. 8, of the Constitution and in the implementing

---

316. 503 F. Supp. 146 (D.D.C. 1980).

317. *Id.* at 149 (citing *Hoehling*.) The *Suid* court also held that the claim was preempted under § 301. See *supra* notes 296-99 and accompanying text.

318. 486 F. Supp. 22 (N.D. Ohio 1979).

319. *Id.* at 22-23. Plaintiff's second count charged defendant's misappropriation saved time and expense, that defendant did little original research, that defendant relied on plaintiff's information, and that defendant gained an unfair commercial advantage as a result. *Id.* at 23. Defendant moved to dismiss this count on preemption grounds. *Id.* at 23.

320. *Id.* at 25. The unfair competition claim of passing off is not a right equivalent to a § 106 right, because it requires an additional element to those required for copyright infringement—plaintiff must prove that defendant is passing off his goods to the public with the express or implied representation that they are plaintiff's goods.

321. *Id.* at 25. The court focused on the question of equivalent rights, not on the issue of protectible subject matter.

322. *Id.* at 26. The dismissal was without prejudice to plaintiff. Thus, plaintiff could assert a state claim consistent with the opinion.

federal statutes, of allowing free access to copy whatever the federal patent and copyright laws leave in the public domain."<sup>323</sup> Furthermore, the statute's essential dichotomy—granting protection for original expression as opposed to ideas and facts—also accommodates first amendment interests by protecting an author's expression without impeding the public's access to information.<sup>324</sup> Thus, even though equivalent state protection of facts and research under the misappropriation doctrine may survive section 301, the principles announced in *Sears-Compco*, even as modified by *Goldstein* and *Kewanee*, should prevent recognition of such a claim.<sup>325</sup>

## 2. Alternatives to Misappropriation

Given the limited copyright protection available for nonfiction works and the potential preemption of misappropriation under section 301 and *Sears-Compco*, the author and researcher probably must rely on other common-law theories to protect against unauthorized use of his facts and research. Some common-law actions, such as breach of an express or implied-in-fact contract, should withstand preemption, while others, such as quasi-contract and unjust enrichment, may not.

To withstand preemption, a plaintiff's state claim must demonstrate that section 301 is not applicable. Under the second prong of the section 301

323. *Compco*, 376 U.S. at 237 (citing U.S. CONST. art. I, § 8, cl. 8); cf. *Goldstein*, 412 U.S. at 559. Enforcement of a misappropriation claim to protect plaintiff's research prohibits the use of facts that, under copyright policy, are available for all to use.

324. *Harper & Row, Publishers, Inc. v. Nation Enters.*, 723 F.2d 195, 202 & n.7 (2d Cir. 1983), cert. denied, 104 S. Ct. 2655 (1984) (No. 83-1632); see *supra* note 84. State-law protection of research may impinge free speech interests. Cf. 1 M. NIMMER, *supra* note 2, § 2.11[E], at 2-169. Nimmer asks whether anyone would suggest seriously that the Washington Post had copyright to the facts of Watergate because its reporters, Woodward and Bernstein, discovered many of those facts through their exhaustive research. *Id.*

325. Except in cases such as *International News Service*, in which a pattern of misappropriation by a competitor has been established, the misappropriation doctrine is preempted—under either § 301 or *Sears-Compco*. See, e.g., *Klitzner Indus., Inc. v. H.K. James & Co., Inc.*, 535 F. Supp. 1249 (E.D. Pa. 1982); *Giangrasso v. CBS*, 534 F. Supp. 472 (E.D.N.Y. 1982); *Suid v. Newsweek Magazine*, 503 F. Supp. 146 (D.D.C. 1980); *Harper & Row, Publishers, Inc. v. Nation Enters.*, 501 F. Supp. 848 (S.D.N.Y. 1980), *aff'd in part and rev'd in part*, 723 F.2d 195 (2d Cir. 1983), cert. granted, 104 S. Ct. 2655 (1984) (No. 83-1632); *Synercom Technology, Inc. v. University Computing Co.*, 474 F. Supp. 37 (N.D. Tex. 1979). Federal preemption of state misappropriation actions is the proper result. Because works embodying facts are subject matter protectible under § 102, a misappropriation claim would be preempted to the extent that the doctrine merely protects against copying. If a court looks at the discrete elements appropriated from the work and concludes that facts are not within the subject matter of copyright, then § 301 would not apply and the states could protect an author's research. *Contra Harper & Row, Publishers, Inc. v. Nation Enters.*, 723 F.2d 195, 200 (2d Cir. 1983) (state protection of research may infringe on first amendment rights), cert. granted, 104 S. Ct. 2655 (1984) (No. 83-1632). State-law protection, however, can be allowed only to the extent that this protection is not inconsistent with the purposes of the Copyright Act. See *Kewanee*, 416 U.S. at 479-80; *Goldstein*, 412 U.S. at 559. Because § 102(b) states that discoveries are not protected by copyright, equivalent state-law protection of research always conflicts with this statement, and would be preempted under *Sears-Compco*. See, e.g., *Harper & Row*, 723 F.2d 195 (2d Cir. 1983), cert. granted, 104 S. Ct. 2655 (1984) (No. 83-1632). *But see Roy Export Co. v. CBS*, 672 F.2d 1095, 1105-06 (2d Cir. 1982) (unfair competition claim arising prior to the Act, based on misappropriation of an unpublished work, escapes preemption because common-law claims concerning unpublished works were not affected by *Sears-Compco*). Furthermore, state-law protection may contravene first amendment interests. See *supra* note 84.

test,<sup>326</sup> it is unclear whether facts fall within the subject matter of copyright as defined in sections 102 and 103, and whether state claims consequently are preempted under section 301.<sup>327</sup> Thus, the plaintiff's stronger argument is based on the first prong of the section 301 test—that his state claim does not protect rights equivalent to the exclusive rights within the general scope of copyright.<sup>328</sup> The Act's congressional history indicates that it was not intended to preempt all common-law theories:

The evolving common law rights . . . would remain unaffected as long as the causes of action contain elements, such as an invasion of personal rights or a breach of trust or confidentiality, that are different in kind from copyright infringement. Nothing in the bill derogates from the rights of parties to contract with each other and to sue for breaches of contract.<sup>329</sup>

To preserve his claim, plaintiff must establish that elements other than, or in addition to, the acts of reproduction, performance, distribution, or display are necessary elements of his state-law claim.<sup>330</sup> Furthermore, to avoid preemption under *Sears-Compco* the plaintiff also must demonstrate that the state-law protection does not offend federal intellectual property policies.<sup>331</sup>

#### a. *Express contracts*

A breach of contract claim must establish an agreement involving a *quid pro quo*, performance by the plaintiff of all conditions precedent, and breach of the contract by the defendant.<sup>332</sup> Because these elements are not identical to the elements of an infringement action, the contract action is not equivalent to infringement and should escape section 301 preemption, regardless of whether the materials that the defendant uses are protectible.<sup>333</sup> Furthermore, because a contract remedy—whether damages, specific performance, or restitution—would apply only to the contracting party, a contract claim would not offend federal copyright policy. Therefore, *Sears-Compco* would not mandate preemption.<sup>334</sup> Under a contract claim, the plaintiff author would be able to

326. See *supra* notes 222-23 and accompanying text.

327. See *supra* notes 274-302 and accompanying text.

328. 17 U.S.C. § 301(b)(3) (1982). An early version of § 301(b)(3) listed several examples of nonpreempted remedies, including breaches of contract, breaches of trust, trespass and conversion. S. 22, 94th Cong., 2nd. Sess., § 301, 122 CONG. REC. 3849 (1976); see *supra* note 235 and accompanying text.

329. H.R. REP., *supra* note 27, at 132.

330. 3 M. NIMMER, *supra* note 2, § 16.04[C], at 16-25.

331. See *supra* notes 193-216 and accompanying text.

332. F. JAMES & G. HAZARD, CIVIL PROCEDURE 112 (2d ed. 1977).

333. The promise to pay for use of materials constitutes the necessary additional element. See 1 M. NIMMER, *supra* note 2, § 1.01[B], at 1-13; 3 M. NIMMER, *supra* note 2, § 16.04[C], at 16-25.

334. Cf. *Aronson v. Quick Point Pencil Co.*, 440 U.S. 257 (1979). The *Quick Point* Court considered whether federal patent laws preempted a state law that allowed enforcement of an agreement to pay royalties on the sale of articles that embodied a particular invention. The inventor had applied for, but not received, a patent for the invention; the contract obligations, however, did not depend on issuance of the patent. *Id.* at 258-61. The court of appeals concluded that the contract action was preempted, because enforcement of the contract would contravene "strong federal policy favoring the full and free use of ideas in the public domain." *Id.* at 261 (quoting



force the defendant to pay for the use of the plaintiff's materials even though the facts and research are in the public domain. *Sears-Compco* does not require a contrary result because contract enforcement would not prevent others from using unprotected elements in the plaintiff's nonfiction work.<sup>335</sup> With respect to such other unauthorized users, the plaintiff would have to rely on his copyright to protect his original expression, but not his facts or research.<sup>336</sup>

*b. Implied-in-fact contracts*

Even if an author cannot prove that an express contract governs a defendant's use of the author's nonfiction work, he may be able to prove that an implied-in-fact contract existed. For example, under New York law<sup>337</sup> a contract will be implied in fact when the evidence demonstrates that the parties intended payment for use of the plaintiff's materials, even though that intention was not expressed orally or in writing.<sup>338</sup> An implied-in-fact contract differs from an express contract in that it is created by conduct rather than words; the preemption issues for the two claims therefore do not differ.<sup>339</sup> Accordingly, an implied-in-fact contract remedy should survive preemption.<sup>340</sup>

---

*Lear, Inc. v. Adkins*, 395 U.S. 653, 674 (1969)). The Supreme Court reversed, noting that commercial transactions traditionally are regulated under state law, *id.* at 262, and that enforcement of the agreement would not conflict with the aims of the patent system. *Id.* at 262-63. See also *Kewanee*, 416 U.S. at 478-79. The manufacturer in *Quick Point* was obligated to pay royalties whether or not the patent was issued. Because the patent was never issued, the manufacturer's competitors eventually were manufacturing and selling the same device with no obligation to pay royalties to the inventor because the invention had entered the public domain. *Quick Point*, 440 U.S. at 260. The Supreme Court nevertheless held the original manufacturer to its contract. *Id.* at 266.

In *Sellers v. ABC*, 668 F.2d 1207 (11th Cir. 1982), plaintiff Sellers informed ABC's investigative reporter that he had an exclusive story on the death of Elvis Presley. Prior to any disclosure the parties signed an agreement that guaranteed Sellers all copyrights to the story, required ABC to credit him with uncovering the cause of Presley's death, and obligated Sellers to deal exclusively with ABC. After the contract was executed, Sellers disclosed his theory that Elvis was murdered either by a withdrawal of cortisone or suffocation. *Id.* at 42. A year later ABC televised a special on Elvis' death that was based solely on the work of its own investigative reporter and did not deal with any of the theories suggested by Sellers, *id.* at 42; Sellers nevertheless sued. His contract claim failed under New York law because an essential element was held to be vague, indefinite, and incomplete and because ABC had not breached the contract since it did not use his theory. *Id.* at 43. The court did not even discuss the possibility that the contract claim was preempted.

335. See, e.g., *Leibovitz v. CBS*, 213 U.S.P.Q. 289, 289 (D. Mass. 1981) (plaintiff could have protected his idea by contract, but his unconditional disclosure made it the property of all because copyright protection does not extend to ideas or concepts); Cf. *Aronson v. Quick Point Pencil Co.*, 440 U.S. 257, 262-64 (1979); *Kewanee*, 416 U.S. at 479-80, 489-91. Because enforcement of a contract will not prevent others from utilizing the unprotected elements of the plaintiff's work, the contract claim is not preempted.

336. See *supra* notes 34-70 and accompanying text. Once the plaintiff's facts, ideas, and theories are disclosed unconditionally—for example by publication of his book—copyright is the plaintiff's only recourse.

337. See generally J. CALAMARI & J. PERILLO, *THE LAW OF CONTRACTS* § 1-12 (2d ed. 1977) (discussion of the law of implied contracts and of quasi-contract remedies); D. DOBBS, *HANDBOOK ON THE LAW OF REMEDIES* § 4.2, at 234-35 (1973) (general discussion of remedies available in restitution actions).

338. *Werlin v. Reader's Digest Ass'n*, 528 F. Supp. 451, 465 (S.D.N.Y. 1981).

339. See 3 M. NIMMER, *supra* note 2, § 16.04[C], at 16-30 to -31.

340. See, e.g., *Landsberg v. Scrabble Crossword Game Players, Inc.*, 736 F.2d 485, 489-90 (9th Cir. 1984) (plaintiff unsuccessful in proving copyright infringement but court determined that he

In *Mann v. Columbia Pictures, Inc.*,<sup>341</sup> plaintiff alleged that she had submitted a twenty-nine page format for a movie that contained ideas Columbia eventually used in making the movie "Shampoo."<sup>342</sup> The California Court of Appeals limited plaintiff's potential recovery on the implied-in-fact contract claim to the "reasonable value" of her ideas as used in the movie.<sup>343</sup> The jury returned a \$185,000 verdict, but the trial court granted a motion for judgment notwithstanding the verdict. This judgment was affirmed by the court of appeals.<sup>344</sup> Because plaintiff's claim involved events that occurred before the effective date of the new Act, section 301 was not at issue.<sup>345</sup> Nevertheless, the court's discussion of the implied-in-fact contract claim is useful for analyzing whether that claim would be preempted by section 301. Because plaintiff had reduced her ideas to a written format, which is protectible subject matter under section 102.<sup>346</sup> Thus, the preemption issue would be whether the contract claim protects rights equivalent to the exclusive rights in section 106.

The court stated that the existence of the contract depended on whether Columbia, knowing that the format was offered to it for sale, accepted and used any part of the format in the movie.<sup>347</sup> Because there was no express agreement, plaintiff had to demonstrate an implied promise to pay:

[P]laintiff must demonstrate that she clearly conditioned her offer of [the format] upon an obligation to pay for it, or its ideas, if used by Columbia; and Columbia, knowing the condition before it knew the ideas, voluntarily accepted their disclosure . . . and found them valuable and used them.<sup>348</sup>

Plaintiff had to prove conduct from which Columbia's promise to pay reasonably could be implied.<sup>349</sup> These elements of proof—knowing the conditions, voluntary acceptance of disclosure, valuable ideas, and use—are not elements

---

may have an implied-in-fact contract remedy under California law); *Smith v. Weinstein*, 1984 COPYRIGHT L. REP. ¶ 25,625, at 18,813, 18,818-20 (S.D.N.Y. 1984) (pendent state contract claims not preempted because the claims involved the relationships between the parties, not copyright rights).

341. 217 U.S.P.Q. (BNA) 468 (Cal. Ct. App. 1982).

342. *Id.* at 469. Warren Beatty and Robert Towne also were defendants.

343. Plaintiff alleged causes of action for plagiarism, quasi-contract, breach of an implied-in-fact contract, and breach of a fiduciary or confidential relationship. All but the implied-in-fact contract claim were dismissed by the trial court. *Id.*

344. *Id.* at 471.

345. 17 U.S.C. § 301(b)(2) (1982).

346. *Id.* § 102(a)(1) (1982) (literary work fixed in a "tangible medium"). Plaintiff, however, was upset over the use of her "ideas" of six principal characters in a beauty salon, rather than her manner of expressing the ideas. See *Mann*, 217 U.S.P.Q. (BNA) at 470. Whether § 301 precludes equivalent state-law protection of ideas not subject to copyright protection is debatable. See 1 M. NIMMER, *supra* note 2, §1.01[B], at 1-23 to -26; *supra* note 274 and accompanying text. Compare *Harper & Row, Publishers, Inc. v. Nation Enters.*, 723 F.2d 195, 201 (2d Cir. 1983) (although plaintiff's specific claims were preempted, other nonequivalent state protection is possible) with *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 980 (2d Cir. 1980) (states are preempted from removing from the public domain those matters left unprotected by Congress).

347. *Mann*, 217 U.S.P.Q. (BNA) at 476.

348. *Id.* at 476-77.

349. *Id.* at 477. Plaintiff's evidence on the essential elements was rebutted by defendant's "clear, positive and uncontradicted evidence" that the format never was submitted to Columbia and that there was no access or use. *Id.* at 478.

of a copyright infringement action. Thus, an implied-in-fact contract claim should escape preemption regardless of the nature of the subject matter.

The court also suggested that proof of substantial similarities between the format and the movie could give rise to an inference of access and use to support plaintiff's claim; that claim was rebutted successfully by defendants.<sup>350</sup> The elements of such an inference, however, appear similar to those of a copyright infringement action—defendant's access to plaintiff's work, similarities between the works, and a material and substantial taking.<sup>351</sup> This apparent equivalence to copyright does not warrant preemption, however, since other elements still must be proven for a plaintiff to recover under an implied-in-fact contract action. The remaining additional elements—voluntariness and the defendant's knowledge of conditions of tender<sup>352</sup>—are not necessary elements in a copyright action;<sup>353</sup> therefore, the implied-in-fact contract claim should not be preempted.<sup>354</sup>

The implied-in-fact contract remedy may be appropriate for a case such as *Miller*,<sup>355</sup> in which the parties could not reach a financial agreement, but defendant nevertheless produced a movie based on plaintiff's book.<sup>356</sup> In *Miller* plaintiff sought damages for copyright infringement and unfair competition, but apparently did not assert a contract claim,<sup>357</sup> possibly because the parties' negotiations were so unsuccessful that a court would be unlikely to find any agreement from their course of conduct.<sup>358</sup> Plaintiff, however, was able to establish that Universal was willing to pay for movie rights, that its writers used his book in preparing the movie, and that negotiations did occur.<sup>359</sup> If a few additional facts relating to the conduct of those negotiations

---

350. Because neither access nor use existed, no contractual obligation to enforce existed. *Id.* at 477-78.

351. See A. LATMAN, *supra* note 1, at 161-62. In the absence of direct evidence of copying, the plaintiff's proof of access and similarities gives rise to an inference of copying.

352. *Mann*, 217 U.S.P.Q. (BNA) at 477.

353. The absence of an intent to copy is irrelevant in an infringement action—the result is the determining factor. A. LATMAN, *supra* note 1, at 160.

354. *Cf. Landsberg v. Scrabble Crossword Game Players, Inc.*, 736 F.2d 485, 489-90 (9th Cir. 1984) (an implied-in-fact contract for disclosure of an idea will be enforced only if circumstances and conduct indicate the terms and existence of a contract prior to or simultaneous with the disclosure of the idea).

355. *Miller v. Universal City Studios, Inc.*, 460 F. Supp. 984 (S.D. Fla. 1978), *rev'd and remanded*, 650 F.2d 1365 (5th Cir. 1981); see *supra* notes 159-71 and accompanying text.

356. *Miller v. Universal City Studios, Inc.*, 460 F. Supp. 984, 985-86 (S.D. Fla. 1978), *rev'd and remanded*, 650 F.2d 1365 (5th Cir. 1981).

357. *Id.* at 985. The reported decisions in the *Miller* litigation make no reference to a contract claim. The court directed a verdict for defendants on the issue of unfair competition and punitive damages and the case went to the jury on the question of copyright infringement. See *id.*

358. Universal's producer offered \$15,000; plaintiff Miller refused and asked for \$200,000. Universal then said it could go as high as \$25,000, but no agreement was reached. *Id.* at 985-96. Miller's copyright claim, however, was credible; Universal had the book, and the book was relied on heavily.

359. *Id.* Sufficient evidence existed from which a jury reasonably could have concluded that Universal had copied Miller's expression and not just his facts. See, e.g., *id.* The court of appeals in *Miller* reversed the verdict for Miller because of the trial court's erroneous instruction; the case was remanded for a new trial. *Id.* at 1376. The appellate court acknowledged that the record and arguments revealed sufficient evidence to support a finding of infringement under principles of copyright law. *Id.* at 1367.

had been established, a court could have concluded that an implied-in-fact contract existed, and that Universal therefore ought to pay Miller fair and reasonable consideration for the movie rights. If the court found no copyright infringement, plaintiff arguably should have received at least Universal's highest offer under the implied-in-fact contract claim.<sup>360</sup> Universal then would have had to pay for what it had used and plaintiff would have been partially compensated for his losses without contravening any copyright policies or the preemptive thrust of section 301.

c. *Quasi-contract and unjust enrichment*

A nonfiction author also may recover on a quasi-contract or contract-implied-in-law claim.<sup>361</sup> Such an action, rather than being based on any express or implied agreement, is based on notions of fundamental fairness and the prevention of unjust enrichment. If the plaintiff recovers on such a claim, the defendant must pay for the benefit he has received despite the absence of an express contract.<sup>362</sup>

This theory was successful in *Werlin v. Reader's Digest Association, Inc.*<sup>363</sup> Plaintiff had written many newspaper and magazine articles, and for several years had been encouraged by defendant's editors to submit articles and story ideas. One of the articles she submitted, which previously had been published in a local newspaper, concerned the Bar Mitzvah ceremony of a child with Downs Syndrome. Defendant decided that plaintiff's article was written too poorly to be published but thought that it contained "the kernel of a darn good story."<sup>364</sup> The article was given to a Reader's Digest writer, who researched the story himself and did not rely on plaintiff's article for any details. Defendant published its own writer's story, never having rejected formally Werlin's article. When plaintiff demanded a by-line, Reader's Digest offered her \$250 for the idea.<sup>365</sup>

Plaintiff sued Reader's Digest and alleged copyright infringement, misappropriation, and unjust enrichment.<sup>366</sup> The court stated that, for copyright purposes, three components exist in such an article: an event, the idea that the event would make a good story, and the author's expression of the story.<sup>367</sup> Because copyright protects only the author's expression of the story and not

360. See *supra* note 359.

361. Unjust enrichment, quasi-contract, contract implied-in-law, breach of a fiduciary or confidential relationship, and a claim for equitable relief (in this situation) all name the same cause of action.

362. See, e.g., J. CALAMARI & J. PERILLO, *THE LAW OF CONTRACTS* § 1-12 (2d ed. 1977); D. DOBBS, *HANDBOOK ON THE LAW OF REMEDIES* § 4.2, at 234-35 (1973); 3 M. NIMMER, *supra* note 2, § 16.03. A plaintiff may join a quasi-contract claim with express and implied contract claims so that the court may impose an obligation to pay even if the contract claims fail for lack of proof. See 3 M. NIMMER, *supra* note 2, § 16.03[B], at 16-16.

363. 528 F. Supp. 451 (S.D.N.Y. 1981).

364. *Id.* at 459.

365. *Id.* at 454-59. The two articles were roughly the same length. *Id.* at 458.

366. *Id.* at 453-54; see also *Bromhall v. Rorvik*, 478 F. Supp. 361, 363, 367 (E.D. Pa. 1979) (similarly situated plaintiff filing similar actions).

367. *Werlin*, 528 F. Supp. at 461.

the event or idea, and because defendant had not copied Werlin's expression, the court held that plaintiff's copyright had not been infringed.<sup>368</sup> The court rejected plaintiff's misappropriation claim because neither a fiduciary nor confidential relationship existed between the parties nor was there any evidence of any bad faith, deception, or fraud. Furthermore, the court noted that defendant's use of plaintiff's idea did not deprive plaintiff of any profit since she had not submitted her article to any other publication.<sup>369</sup>

The court stated that "a contract will be implied in fact when the evidence shows that the parties clearly intended payment to the extent of use of the plaintiff's idea, though they did not set forth that intention in express language."<sup>370</sup> The court held, however, that no contract was implied under the circumstances.<sup>371</sup> The court then concluded that, "[w]here the defendant has benefitted from its use of an idea generated by the plaintiff, a court will allow recovery in quasi contract if the circumstances make it inequitable for the defendant to profit from the use of plaintiff's idea or material."<sup>372</sup> The court stated that for plaintiff to recover in an unjust enrichment action under New York law, she must prove that defendant was enriched by plaintiff, and that under the circumstances it would be unjust in equity and good conscience to permit defendant not to pay. Furthermore, to establish the element of enrichment, plaintiff must demonstrate that her idea was novel, concrete, and actually appropriated by defendant in developing a work that defendant published.<sup>373</sup> The court concluded that Werlin had established these elements, and that, given the years of encouragement by Reader's Digest, "[t]o permit [Reader's Digest] to refuse to pay any compensation to Werlin would be . . . to permit an injustice of the most fundamental sort."<sup>374</sup>

*Werlin* also held that the elements of a quasi-contract claim differ significantly from those of copyright infringement, and that the quasi-contract claim protects rights that differ qualitatively from those protected by copyright. Thus, the court concluded that plaintiff's claim escaped preemption.<sup>375</sup> The court also rejected defendant's argument that copyright was plaintiff's only

368. *Id.* at 461-64.

369. *Id.* at 464-65. The court did not consider whether the misappropriation claim was preempted, perhaps because, under New York law, such a claim demands a showing that defendant abused a confidential or fiduciary relationship to gain access to plaintiff's material. *Id.* at 464. Because this "abuse of a relationship" element is not part of an infringement claim, misappropriation in jurisdictions requiring that element is not equivalent to copyright and therefore, should not be preempted. 1 M. NIMMER, *supra* note 2, § 1.01[B], at 1-19 n.75.1. The court ignored the detrimental effect of the publication of Reader's Digest's story on plaintiff's possible future attempts to market her story. *See Werlin*, 528 F. Supp. at 464-65.

370. *Id.* at 465.

371. *Id.*

372. *Id.*

373. *Id.*

374. *Id.* at 466. Because plaintiff failed to raise the claim until after she had presented her case, the court refused to allow her to submit evidence on the amount of unjust enrichment. The court therefore awarded restitutionary damages of only \$500, the amount that defendant customarily paid to authors of articles that had been considered for publication and subsequently rejected. *Id.* at 467.

375. *Id.* at 467.

means of redress because she had submitted a written article rather than an idea. The court treated Werlin's work as both an article and an idea: to the extent the work was an article, it enjoyed copyright protection; to the extent the work was an idea, it enjoyed no copyright protection and only limited state-law protection.<sup>376</sup>

An unjust enrichment claim similar to the one asserted in *Werlin* may be applicable to the protection of research. If plaintiff in *Miller* could have demonstrated a relationship with Universal Studios similar to the relationship between Reader's Digest and Werlin—encouragement to submit, submission of the manuscript, and other facts giving rise to a quasi-contractual relationship—he may have been able to recover on the basis of unjust enrichment.<sup>377</sup> It is not entirely clear, however, that an unjust enrichment claim is as qualitatively different from a copyright infringement claim as the *Werlin* court stated. To establish that the enrichment is unjust, a plaintiff must prove that the defendant's use—ordinarily reproduction—was wrongful. The element of wrongfulness is the only element of a quasi-contract claim that is not an element of a copyright infringement claim. The wrongfulness element should not be sufficient to distinguish a quasi-contract claim from copyright infringement, and, therefore, the claim should be preempted.<sup>378</sup>

Even if a quasi-contract action is equivalent to copyright, the *Werlin* court's analytic distinction between plaintiff's article and her idea may be applied to save the claim from preemption under section 301. Under this analysis, a nonfiction work enjoys copyright protection to the extent that it contains copyrightable expression; to the extent that it contains unprotectible ideas, facts, and research, it enjoys only limited state-law protection.<sup>379</sup> Statutory preemption would apply only to expression; an unjust enrichment claim could protect research. Furthermore, since the quasi-contract remedy would apply only when some relationship existed between the parties,<sup>380</sup> enforcement of

376. *Id.* The court distinguished the article from the topic on which it was written. *See also* Bromhall v. Rorvik, 478 F. Supp. 361, 366-67 (E.D. Pa. 1979) (claim for accounting because of defendants' unjust enrichment from appropriating plaintiff's idea/creation withstood motion to dismiss on preemption grounds because copyright protection extends only to expression and not to the idea itself); *infra* notes 390-95 and accompanying text. *But see* Harper & Row, Publishers, Inc. v. Nation Enters., 723 F.2d 195, 200 (2d Cir. 1983) (even though portions of a work consist of material not protectible by copyright, the work as a whole is not necessarily outside the subject matter of copyright), *cert. granted* 104 S. Ct. 2655 (1984) (No. 83-1632); *supra* notes 301-02 and accompanying text.

377. Given Miller's negotiations with Universal over movie rights, such a claim would be strong. *Miller v. Universal City Studios, Inc.*, 460 F. Supp. 984, 985-86 (S.D. Fla. 1978), *rev'd and remanded*, 650 F.2d 1365 (5th Cir. 1981).

378. *See* 1 M. NIMMER, *supra* note 2, § 1.01[B], at 1-20 to -21, arguing that state-law causes of action for unjust enrichment and quasi-contract should be regarded as equivalent to infringement claims because their elements are identical to the elements of an infringement claim. *But see* Schuchart & Assocs. v. Solo Serve Corp., 540 F. Supp. 928, 945-46 (W.D. Tex. 1982) (to recover in quantum meruit plaintiff must establish that defendant received valuable benefits, such as services, under circumstances which would reasonably notify defendant that plaintiff expected to be paid); *infra* notes 382-89 and accompanying text. Arguably, the *Schuchart* court articulated additional elements that make the claim not equivalent to an infringement claim.

379. *See Werlin*, 528 F. Supp. at 467. *But see supra* notes 291-302 and accompanying text. Still, there are similarities with copyright as well as misappropriation.

380. *See supra* note 379; *see also* Rowe v. Golden West Televisions Productions, 184 N.J.

the defendant's implied obligation to pay for benefits received would not interfere significantly with copyright policies and should escape preemption under *Sears-Compco*.<sup>381</sup>

In *Schuchart & Associates, Professional Engineers, Inc. v. Solo Serve Corp.*<sup>382</sup> the court considered these issues and concluded that plaintiff's unjust enrichment claim escaped preemption.<sup>383</sup> Texas recognizes a right to recover for unjust enrichment based on an implied-in-law promise to pay for services rendered and knowingly accepted. To establish an unjust enrichment claim in *Schuchart*, plaintiff had to prove that valuable services were rendered, or materials furnished, to defendant. These services or materials had to have been accepted and used by defendant under circumstances reasonably notifying defendant that plaintiff, in performing the services, expected to be paid.<sup>384</sup> Defendants in *Schuchart* had accepted and used plaintiffs' architectural drawings, and plaintiffs sought to recover the value of the architectural services they had rendered to defendants. The court held that the rights asserted in this unjust enrichment claim differed fundamentally from copyright: plaintiffs were not trying to enforce their section 106 rights to control copying and distribution of their works, but to recover for the value of services they had rendered. Accordingly, section 301 did not preempt the unjust enrichment action.<sup>385</sup>

The court next considered, under a *Sears-Compco* analysis, whether the unjust enrichment claim clashed impermissibly with the objectives of the copyright law.<sup>386</sup> It noted that plaintiffs sought to recover the value of services rendered, and thus, to the extent the state-law remedy promoted and protected intellectual endeavors, its enforcement would not conflict with the copyright policy of encouraging intellectual and artistic creation. The court acknowledged, however, that copyright protects only expression,<sup>387</sup> and that defendants could not be prevented under state law from merely using architectural

Super. 264, 270 n.3, 445 A.2d 1165, 1167-68 n.3 (App. Div.) (New Jersey recognizes claim for appropriation of an idea but only "in such circumstances that the law will imply a contractual or fiduciary relationship . . ." (quoting *Flemming v. Ronson Corp.*, 107 N.J. Super. 311, 315, 258 A.2d 153, 156 (Law Div. 1969), *aff'd per curiam*, 114 N.J. Super. 221, 275 A.2d 759 (App. Div. 1971))), *cert. denied*, 91 N.J. 241, 450 A.2d 562 (1982).

381. *See* *Aronson v. Quick Point Pencil Co.*, 440 U.S. 257, 260-63 (1979); *see supra* notes 334-36 and accompanying text.

382. 540 F. Supp. 928 (W.D. Tex. 1982).

383. *Id.* at 948. Plaintiffs eventually prevailed in a later ruling on both the copyright infringement and unjust enrichment theories. Because defendants lost money on the project, however, the court declined to award damages even though plaintiffs proved all necessary elements. *Id.* at 26 PAT. TRADEMARK & COPYRIGHT J. (BNA) 492 (W.D. Tex. 1983).

384. *Schuchart*, 540 F. Supp. at 945.

385. *Id.* The court also stated that plaintiffs were not seeking copyright damages by their quantum meruit claim, but relief measured by the value of the services rendered—defendants used the plans plaintiffs had prepared. *Id.*

386. *Id.* at 946-47. The court stated that "[i]n a line of cases beginning in 1964 [*Sears and Compco*, for example], the Supreme Court has recognized an independent basis for preemption." *Id.* at 946.

387. *Id.* at 948. For a discussion of the first amendment rationale for this dichotomy, see *Harper & Row, Publishers, Inc. v. Nation Enters.*, 723 F.2d 195, 203-05 (2d Cir. 1983), *cert. granted*, 104 S. Ct. 2655 (1984) (No. 83-1632); *supra* note 84.

ideas or concepts identical to those in plaintiffs' drawings. Unjust enrichment, however, could be used to protect plaintiffs' work if they could establish an implied promise by defendants to pay for the beneficial services that plaintiffs rendered and defendants knowingly accepted.<sup>388</sup> Because plaintiffs could recover only if the court determined that defendants accepted the plans and were on reasonable notice that plaintiffs expected payment, plaintiffs' action did not seek to prevent use of the ideas or concepts and the action was not preempted.<sup>389</sup>

In *Bromhall v. Rorvik*,<sup>390</sup> defendant obtained plaintiff's nine-page abstract of an unpublished doctoral thesis by claiming that he wanted assistance for an article he was writing on research in the field of cell transplantation. Instead, defendant wrote a purportedly factual book about experiments that resulted in the creation of a human genetic "twin" through cloning, and cited plaintiff several times in the bibliography.<sup>391</sup> Plaintiff's defamation and common-law copyright counts were dismissed,<sup>392</sup> but his claim for equitable relief withstood defendant's motion to dismiss.<sup>393</sup> Plaintiff alleged that after defendant fraudulently obtained plaintiff's abstract, he appropriated the experimental cloning techniques described by plaintiff in the abstract. According to plaintiff, this taking had enhanced the credibility and sales potential of defendant's book; therefore defendant had been unjustly enriched.<sup>394</sup> The court concluded that this count was not preempted because the rights the court asserted were not governed by the Copyright Act: "[c]opyright protection extends only to *expression* of an idea, not the idea itself."<sup>395</sup>

The success of the unjust enrichment claims in *Werlin*, *Schuchart*, and *Bromhall* depended on whether the facts established a course of conduct or dealings between the parties. This course-of-dealings requirement is not an element of a copyright infringement action, and these unjust enrichment claims therefore are not equivalent to copyright.<sup>396</sup> Furthermore, if a distinction is made between protected expression and uncopyrightable ideas, facts, and research, as in *Werlin* and *Bromhall*, an unjust enrichment action protects

388. *Schuchart*, 540 F. Supp. at 948. The court analogized to the trade secret protection upheld in *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470 (1974). See *supra* notes 210-16 and accompanying text. In *Kewanee* the Supreme Court held that the Ohio trade secret law could not be used to prevent others from discovering plaintiff's secret method by reverse engineering, or from then using that method in competition with plaintiffs, but it could be used against those who obtained the method by unfair means. *Schuchart*, 540 F. Supp. at 948.

389. *Schuchart*, 540 F. Supp. at 948. The court, however, granted summary judgment in favor of one of the defendants on plaintiff's quantum meruit claim. *Id.*

390. 478 F. Supp. 361 (E.D. Pa. 1979).

391. *Id.* at 364-65.

392. *Id.* at 365-66.

393. *Id.* at 366-67. Plaintiff alleged that the book was a hoax, and that it conveyed the false impression that his research involved cloning humans. The common-law copyright count was preempted by § 301 because the claim arose after January 1, 1978. *Id.* at 366.

394. *Id.* Plaintiff therefore sought an accounting.

395. *Id.* at 367 (citing 17 U.S.C. §§ 301(b)(1), (1982)).

396. *Contra* 1 M. NIMMER, *supra* note 2, § 1.01[B], at 1-20 to -21 ("[i]t is submitted, however, that this argument is circular").



subject matter not protectible by copyright.<sup>397</sup> Thus, such an unjust enrichment claim should escape statutory preemption because the subject matter test is not satisfied and because it is not an equivalent right.

If the state claim is protecting copyrightable subject matter, and no facts have established a relationship between the parties, however, an unjust enrichment claim is equivalent to a copyright infringement claim and should be preempted under section 301.<sup>398</sup> A plaintiff's allegations that the defendant had access to and copied the plaintiff's materials, and thereby was enriched unjustly, would be virtually identical to the elements of an infringement action.<sup>399</sup> If a relationship between the parties has not been established, and the unjust enrichment claim protects facts not within the subject matter protected by copyright, section 301 may not apply. *Sears-Compco* principles, however, probably do require preemption. Otherwise, an author could prohibit anyone from using the unprotectible facts embodied in his work on an unjust enrichment theory, regardless of the existence of prior dealings; he would have a monopoly on materials that are deemed to be in the public domain that would offend federal copyright policy and possible first amendment interests as well.<sup>400</sup>

## VI. CONCLUSION

The author of a nonfiction work faces serious difficulties in preventing the unauthorized use of his research. Although the United States Court of Ap-

---

397. *But cf. Harper & Row*, 723 F.2d at 199-201 ("[t]he fact that portions of the [work] may consist of uncopyrightable material, . . . does not take the work as a whole outside the subject matter protected by the [Copyright] Act"). See *supra* note 319.

398. 1 M. NIMMER, *supra* note 2, § 1.01[B], at 1-20 to -21.

399. The claim in that context would be little different than the conversion and tortious interference with contract claims preempted in *Harper & Row*. The court of appeals in *Harper & Row* first determined that § 301's subject matter test was satisfied, *id.* at 199-201, and then analyzed whether plaintiff's state-law claims were equivalent. *Id.* at 201. The court noted that plaintiffs faced a serious dilemma with respect to their conversion claims: If the gravamen of the claims was unauthorized publication, then the claim was preempted as coextensive with rights protected by the Copyright Act—namely, the control over reproduction and derivative uses of copyrighted material. *Id.* Alternatively, if the foundation of the claims was defendant's unauthorized possession and control of the work, then it would not be preempted since these acts were qualitatively different from those proscribed by copyright. This alternative approach to conversion failed, however, because defendant's acts were not a sufficient interference with plaintiff's property rights to demonstrate conversion. *Id.* The court regarded tortious interference with contract as equivalent to a violation of the exclusive right to prepare derivative works based on the copyrighted work, and held that defendant's acts had destroyed plaintiffs' control over prepublication serialization rights. *Id.* It is important to note that the court of appeals' discussion of conversion demonstrates that in some instances conversion is not equivalent—the acts of possession and control of literary works are qualitatively different from the acts proscribed by copyright. This remedy, however, is not appropriate for an author or researcher unless he can demonstrate that defendant is exercising unauthorized dominion and control over the chattel (manuscript) to his complete exclusion. See *id.* at 201 & n.5. Thus, the plaintiff must prove a substantial interference with his property rights, and none of the cases discussed herein dealing with appropriations of research involved such misconduct.

400. *Id.* at 200-01, 203-05. State-law remedies protecting an author's research cannot run against the world. Even if § 301 did not apply to the plaintiffs' conversion and tortious interference with contract claims because the materials converted were not copyrightable, enforcement of these state-law claims would have prohibited defendant from using public domain materials.

peals for the Seventh Circuit in *Toksvig v. Bruce Publishing Co.* arguably extended copyright protection by requiring a second author to conduct independent research, such an extension is inconsistent with the principle that copyright protects expression and not facts. Thus, some courts have rejected the expansive holding in *Toksvig* and have allowed unlimited use of facts found in nonfiction works. Because these courts are unwilling to extend copyright protection to research, an author in these jurisdictions must rely on common-law remedies if he cannot prove copying of protected expression.

The most advantageous common-law alternative to copyright is misappropriation. If the materials at issue are within the subject matter of copyright, however, the Copyright Act's broad preemptive reach limits the application of the doctrine to situations in which there is a pattern of misconduct. Even if section 102(b) of the Copyright Act is interpreted to permit state-law protection of facts and research so that section 301 of the Act would not apply, a misappropriation claim nevertheless should be preempted under the *Sears-Compco* principles. Therefore, state-law protection of research is restricted to cases in which a contractual or quasi-contractual relationship has been breached. Except in these limited circumstances, a nonfiction author is not able to protect his research. To protect research in other situations would contravene the strong federal policy that facts are not the property of any individual.

