

January 1980

Patent & Copyright Law

Richard D. Harmon

Howard Klepper

Paige L. Wickland

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Recommended Citation

Richard D. Harmon, Howard Klepper, and Paige L. Wickland, *Patent & Copyright Law*, 10 Golden Gate U. L. Rev. (1980).
<http://digitalcommons.law.ggu.edu/ggulrev/vol10/iss1/14>

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PATENT & COPYRIGHT LAW

I. RECENT DEVELOPMENTS IN NINTH CIRCUIT PATENT & COPYRIGHT LAW

Richard D. Harmon*

This issue marks the fifth anniversary of the Ninth Circuit Survey—a welcome landmark for all who practice in the Ninth Circuit. I have been privileged to contribute discussions of copyright and patent law to previous Survey issues.¹ Since it is assumed that the following remarks will be read in light of these previous discussions, certain recurring themes and background information will not be restated here.

A. PATENT

This past term, six patents were reviewed by the Ninth Circuit in published opinions.² Five of these patents were declared invalid for obviousness at the district court level, and each declaration of invalidity was affirmed. One patent was held *valid* by a trial court, but the Ninth Circuit reversed, holding that the invention in question was obvious as a matter of law.³

It might appear that the Ninth Circuit was harsh on patentees last term, since every patent under review was held invalid. In truth, however, the number of patents held invalid is an es-

* Member, California Bar; A.B., University of California, Berkeley, 1969; M.A., S.U.N.Y. at Stonybrook, 1973; J.D., Golden Gate University School of Law, 1976.

1. Harmon, *Developments in Ninth Circuit Patent Law, Ninth Circuit Survey*, 8 GOLDEN GATE U.L. REV. 193 (1977) (hereinafter *Developments*); Harmon, *Patentability: Obviousness Revisited, Ninth Circuit Survey*, 9 GOLDEN GATE U.L. REV. 139 (1978-79) (hereinafter *Patentability*).

2. *Norris Indus., Inc. v. Tappan Co.*, 599 F.2d 908 (9th Cir. July, 1979) (per East, D.J., sitting by designation; the other panel members were Goodwin and Tang, JJ.); *Lawrence v. Gillette Co.*, 603 F.2d 68 (9th Cir. May, 1979) (per Merrill, J.; the other panel members were Trask, J. and East, D.J.); *Satco, Inc. v. Transequip, Inc.*, 594 F.2d 1318 (9th Cir. Apr., 1979) (per Bright, D.J., sitting by designation; the other panel members were Chambers and Tang, JJ.); *Herschensohn v. Hoffman*, 593 F.2d 893 (9th Cir. Mar., 1979) (per Carter, J.; the other panel members were Wright, J. and Craig, D.J.); *SSP Agricultural Equip., Inc. v. Orchard-Rite Ltd.*, 592 F.2d 1096 (9th Cir. Mar., 1979) (per VanDusen, D.J., sitting by designation; the other panel members were Wright and Goodwin, JJ.); *Safe Stop Brake Corp. v. General Motors Corp.*, 587 F.2d 982 (9th Cir. Nov., 1978) (per curiam).

3. In *Herschensohn v. Hoffman*, 593 F.2d 893 (9th Cir. 1979), the hair brush invention at issue was held patentable by District Judge Laughlin W. Waters of the Central District of California.

entially meaningless statistic. If the Ninth Circuit adopts and applies uniform standards in accord with the patent laws, patent owners will not be prejudiced, regardless of the number of patents held invalid.

It was submitted the past two terms that the Ninth Circuit has adopted the appropriate standard of patentability when considering the obviousness of combination devices, and that this standard has been applied in a consistent manner by the various Ninth Circuit panels.⁴ It is further submitted that these observations can be reiterated this term. For instance, examination of the five patent cases mentioned above reveals that cases such as *Regimbal v. Scymansky*,⁵ *Hewlett-Packard Co. v. Tel-Design, Inc.*,⁶ and *Deere & Co. v. Sperry Rand Corp.*⁷ continue to be ignored in relation to obviousness issues. It is now suggested that these cases, in fact, play no role in elucidating the Ninth Circuit's contemporary standard of patentability under section 103.⁸

Recent Ninth Circuit patent cases also confirm that obviousness issues must be resolved by a *Graham* analysis in all cases, and that inventions are not evaluated by a double obviousness standard which requires combinations of old elements to be more non-obvious than non-combination devices.⁹ Therefore, despite some awkwardly-worded opinions, there are no requirements for "unusual or surprising results" or "synergism" in the combination context: nonobviousness is the standard, and non-obviousness is to be determined in all cases by a *Graham* inquiry.¹⁰

4. See *Developments, supra* note 1, at 194; *Patentability, supra* note 1, at 139-40.

5. 444 F.2d 333 (9th Cir. 1971).

6. 460 F.2d 625 (9th Cir. 1972).

7. 513 F.2d 1131 (9th Cir. 1975).

8. For a discussion of these Ninth Circuit cases see *Developments, supra* note 1, at 202-03; *Patentability, supra* note 1, at 140.

9. A combination of old elements refers to elements old *in the art*. *Developments, supra* note 1, at 197. See generally *Developments, supra* note 1, at 198-212; *Patentability, supra* note 1, at 141-42.

10. See *Developments, supra* note 1, at 204-12. The Ninth Circuit expressly stated this proposition as this article went to press. *Palmer v. Orthokinetics, Inc.*, 611 F.2d 316, 319-24 (9th Cir. 1980). For an interesting discussion in accord with this author's position, see Markey, *Some Patent Problems Philosophical, Philological, and Procedural*, 80 F.R.D. 203, 211 (1979) (Chief Judge, C.C.P.A.).

Obviousness in the Combination Context

Perhaps *Satco, Inc. v. Transequip, Inc.*¹¹ best illustrates the validity of the foregoing observations. In *Satco*, the district court held that a combination invention was obvious after observing that it produced “no synergistic results, *i.e.*, it ‘is wanting in any unusual or surprising consequences’; [and thus] it is not patentable under the test applicable to combination patents.”¹² The patent owner appealed, contending that the trial court used “an inappropriate test of nonobviousness, equating nonobviousness with producing a synergistic result (or ‘unusual of surprising consequences’), rather than undertake the factual analysis required by the *Graham* case.”¹³

The *Satco* court did not dispute the patent owner’s contentions regarding the standard of patentability. It, therefore, did not deny that *Graham* controls obviousness inquiries, and that it is improper to equate the requirement of nonobviousness with phrases such as “unusual or surprising results” or “synergistic effects.” The court did conclude, however, that the trial court had *not* equated the catch phrases of *A&P*, *Black Rock* and *Ag Pro* with the nonobviousness requirement, and thus that the trial court properly applied the correct legal standards.¹⁴

11. 594 F.2d 1318 (9th Cir. 1979).

12. *Id.* at 1320, citing *Great Atl. & Pac. Tea Co. v. Supermarket Equip. Corp.*, 340 U.S. 147, 152 (1950).

13. 594 F.2d at 1321.

14. *Id.* at 1321-22. For those who were disappointed by the Supreme Court’s indiscriminate use of *A&P* language in *Ag Pro* to justify a result which could have been supported by a modern *Graham* analysis, the following passage from *THE BROTHERS* may be of interest:

For Brennan’s clerks, each lost case was the falling of the citadel, a catastrophe. One Brennan clerk was frequently directed to use what Brennan called his “acid pen.” As a result, Brennan’s dissents were often written in scathing and petulant prose. Many of the Justices and clerks believed that Brennan was overplaying his hand. Increasingly, his opinions seemed designed not to persuade others but to irritate Burger. Brennan appeared to have given up trying to do a careful, scholarly job.

Near the end of the term, the Court heard a case (*Sak-raid v. Ag Pro, Inc.*) involving a patent dispute over a water flush system designed to remove cow manure from the floor of dairy barns. Referred to around the Court as the “cow shit case” it was of no significance, not even posing interesting questions in the arcane field of patent law. The conference was unanimous that there was no patent violation. The case would ordinarily go to the most junior Justice, Stevens. Instead, Bur-

In reaching this conclusion, the *Satco* court observed as follows: (1) The applicable standard—for both combination and non-combination devices—is set forth in section 103, which conditions patentability on nonobviousness, rather than some form of “synergism” or “unusual or surprising results,” (2) federal

ger assigned the “cow shit case” to Brennan.

Brennan was insulted, but he refused to pass along the humiliation to his clerks. He did all the work on the five-page opinion himself.

Later, when an insignificant Court of Claims case (*United States v. Hopkins*) was argued, Brennan decided to vote whichever way would leave him in the minority, “so that bastard can’t give me cases like this.”

B. WOODWARD & S. ARMSTRONG, *THE BRETHERN* 418-19 (1979). Of course every case becomes significant once certiorari is granted and, therefore, the Woodward-Armstrong contention to the contrary can be attributed to their journalistic bent toward sensationalism. However, if there is even a shred of accuracy in the above-quoted passage, many of *Ag Pro*’s inadequacies are explained.

This writer’s views on *Ag Pro* (and *Black Rock*) are a matter of record. See *Developments, supra* note 1, at 212-13. It is submitted that these views are still correct. The Ninth Circuit continues to apply *Graham*, and views *Black Rock* and *Ag Pro* as mere applications of *Graham*.

Of course, the *Black Rock* and *Ag Pro* Courts did not complete full *Graham* analyses because they concluded that neither case involved an invention which even made a threshold contribution to technology. See *Developments, supra* note 1, at 204-13 [Ed. note: the eighth line from the bottom of page 205 should read: “they simply represent an array of expressions the Court used to convey its conclusion that the invention in question did not even make a contribution.”]. Such cases are exceedingly rare, which may explain why in *Black Rock* and *Ag Pro* certiorari was granted in an area which otherwise receives little Supreme Court attention. With the possible exception of *Astro Music, Inc. v. Eastham*, 564 F.2d 1236 (9th Cir. 1977), an *Ag Pro* or *Black Rock*-type case has not been discussed by the Ninth Circuit in a published opinion since late 1975.

The foregoing analysis is dangerous, however, because it accepts the premise that there are some rare patent cases where a full *Graham* inquiry is not required. Such a premise may be considered incorrect since even a threshold “contribution” determination is not possible until after the *Graham* three-part analysis has been fully conducted. This position, however, is contrary to the express language of the *Black Rock* opinion. The *Black Rock* Court clearly based its decision on a lack of contribution, and only alluded to the lack of nonobviousness in the alternative. See *Developments, supra* note 1, at 206-07.

Black Rock, of course, did mandate strict observance of *Graham*. Thus, it is submitted that the best way to reconcile *Black Rock* and *Graham* is to do as the Ninth Circuit has done: view *Black Rock* and *Ag Pro* as mere applications of *Graham* (albeit incomplete applications). The factual circumstances which justify less than a full *Graham* inquiry are so rare that, for all practical purposes, they never arise. Certainly, it would never be error for a court to proceed on the side of caution in a “close” case and conduct a thorough *Graham* analysis.

In any event, the catch phrases of *A&P* which were reiterated in *Ag Pro* have no place in anything other than an *A&P*-type case. This will permit exclusive reliance on *Graham* in every case, as set forth above. If the notion of a short-circuited *Graham* analysis for the rare *A&P*-type case is not accepted, the troublesome language of *A&P*, *Black Rock*, and *Ag Pro* must potentially be dealt with in every combination case since no basis for distinguishing them is advanced.

courts must use the analytical process prescribed in *Graham* when “ascertaining whether an invention meets the nonobviousness test of section 103;” and (3) the Supreme Court “has twice admonished that ‘strict observance’ of [*Graham*’s] factual inquiries is necessary.”¹⁵ These observations are refreshing indeed. It is rare for a Ninth Circuit panel to concisely present such an able discussion of the standard of patentability in the combination context.

The Ninth Circuit panel displayed equal ability when examining the district court’s findings. The district court had arguably applied incorrect legal standards because it adverted to the catch phrases of *A&P* in its findings, and failed to “precisely articulate its application of the *Graham* analysis in deciding the obviousness issue.”¹⁶ In light of this failure, the *Satco* court looked to substance rather than form, and found, on the basis of the record as a whole, that the district court had, in fact, conducted a three-part *Graham* inquiry, since there were findings relating to each of the three areas of inquiry. The court could therefore overlook the trial judge’s references to the lack of “unusual or surprising results,” and effectively treat such references as inartfully worded conclusions that the invention in question was unpatentable due to obviousness. Such conclusions—however ill-phrased—were nonetheless based on a de facto *Graham* inquiry, and thus proper. The *Satco* case clearly stands for the proposition that “synergism,” or “unusual and surprising results,” or the like, are not conditions to patentability in the combination context or in any other context. Nonobviousness is the statutorily defined condition to patentability, and the exclusive method for resolving obviousness issues is set forth in *Graham*.¹⁷

This is not to say that facts relating to matters such as synergism have no place in patent litigation. As the *Satco* court correctly observed, once a three-part *Graham* inquiry is conducted, a legal conclusion must be made regarding “the section 103 condition of patentability.”¹⁸ And, “in forming [this] legal conclusion, [it is proper to consider] the failure of that device, which

15. 594 F.2d at 1320-22.

16. *Id.* at 1321.

17. *Accord*, *AMP, Inc. v. Bunker Ramo Corp.*, 604 F.2d 24, 25-26 (7th Cir. 1979); *Republic Indus., Inc. v. Schlage Lock Co.*, 592 F.2d 963, 968-69 (7th Cir. 1979).

18. 594 F.2d at 1321-22.

combines old elements, to create a synergistic result or to disclose any 'unusual or surprising consequences.'"¹⁹ Such considerations, of course, are not conditions for patentability in and of themselves, and may not even be relevant in relation to a given combination invention.²⁰

Problems with Terminology

In contrast to *Satco's* carefully worded opinion, the opinions in *Herschensohn v. Hoffman*,²¹ *SSP Agricultural Equipment, Inc. v. Orchard-Rite Ltd.*,²² and *Lawrence v. Gillete Company*²³ each contain one or more unfortunate phrases. Nonetheless, these generally routine patent cases are consistent with *Satco*, ignore the *Regimbal*, *Hewlett-Packard* and *Deere* cases, acknowledge *Graham*, do not adopt a doubt-obviousness standard, and so forth. Thus, uniformity continues to exist in Ninth Circuit patent decisions, despite awkward language in some opinions. It may be useful to identify this language so that it can be placed in proper perspective and disregarded when appropriate.

In *SSP Agricultural*, the court noted at one point that "the elements of the . . . invention are *anticipated* by the prior art or are obvious in the light of it."²⁴ The court then apparently discussed how each of the elements of the invention are found in one or another of three prior art references.²⁵ Such an analysis might be relevant to an obviousness inquiry, but not to the strictly "technical" defense of anticipation, which is only available if every element of a combination device is united in a *single* prior art reference in generally the same way to achieve the same purpose.²⁶

Anticipation, also referred to as lack of novelty, is a term of

19. *Id.* at 1322.

20. For instance, there may not be any synergism involved with some patentable mechanical combinations. See, e.g., *Developments*, *supra* note 1, at 208 n.70, and authorities cited therein.

21. 593 F.2d 893 (9th Cir. Mar., 1979).

22. 592 F.2d 1096 (9th Cir. Mar., 1979).

23. 603 F.2d 68 (9th Cir. May, 1979).

24. 592 F.2d at 1100 (emphasis added).

25. *Id.*

26. See, e.g., *Schroeder v. Owens-Corning Fiberglass Corp.*, 514 F.2d 901, 903 (9th Cir. 1975). For a survey of cases decided by the Ninth Circuit, including *Schroeder*, see Note, *Intellectual Property, Ninth Circuit Survey*, 6 GOLDEN GATE U. L. REV. 679, 681 (1976).

art, and should be used with greater care than is evident in the *SSP* opinion, which went on to observe that: (1) “[t]he functions [the elements] perform individually and together also are anticipated by the prior art and no significant new result is achieved;”²⁷ and (2) “[t]he use of [one of the elements] is anticipated in *Upson*.”²⁸ Not only does it appear that the term anticipation is again being misused, the phrase “significant new result” is exactly the type of rhetorical embellishment which serves no useful purpose, as the *Satco* court clearly understood.

The *SSP* court also implied that the invention was unpatentable because “the parts of the combination . . . are obvious.”²⁹ It cannot be overemphasized that section 103’s nonobviousness standard is addressed to “the subject matter as a whole,” and that it makes little sense to discuss the obviousness of individual elements.³⁰

The *SSP* court further complicated matters when it stated that “[a] mechanical combination must utilize a new principle or achieve a new result to cause it to rise to the status of invention.”³¹ This passage not only rings of the defunct constitutional standard of “invention,”³² but it also suggests the existence of a “new principle or new result” test.³³ Perhaps this language

27. 592 F.2d at 1101.

28. *Id.*

29. *Id.*

30. 35 U.S.C. § 103 (1976); see *Developments*, *supra* note 1, at 203 n.52, 208 n.66.

31. 592 F.2d at 1101, *citing* *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282 (1976); *Great Atl. & Pac. Tea Co. v. Supermarket Equip. Corp.*, 340 U.S. at 152-53; *Penn Int’l Indust. v. Pennington Corp.*, 583 F.2d 1078, 1081 (9th Cir. 1978); *Astro Music, Inc. v. Eastham*, 564 F.2d 1236, 1238 (9th Cir. 1977); and *Jeddeloh Bros. Sweed Mills, Inc. v. Coe Mfg. Co.*, 375 F.2d 85, 92 (9th Cir. 1967). The *Penn* case is discussed in *Patentability*, *supra* note 1, at 141-44. The *Astro Music* case is discussed in *Developments*, *supra* note 4, at 210.12.

32. See, e.g., *Developments*, *supra* note 4, at 200 & n.37. It may be reasonable to assume that the *SSP* court meant to say “patentable invention” rather than simply “invention.” If so, the problem warrants continued mention. See, e.g., *Developments*, *supra* note 4, at 200 & nn. 37 & 38, 201, 206 n.62; *Patentability*, *supra* note 1, at 141.

33. The “new principle” language presumably originated from *Jeddeloh Bros. Sweed Mills, Inc. v. Coe Mfg. Co.*, 375 F.2d 85 (9th Cir. 1967). The *Jeddeloh* court held a patent invalid because the invention was obvious at the time it was made. The court simply noted in passing that “[i]t was not necessary . . . to seek and apply any substantially new principle” in order to make the invention. *Id.* at 92.

Unfortunately, twelve years later in *SSP*, the Ninth Circuit created the appearance that it was exalting this useless passage into a requirement that an invention involve a “new principle” in order to be patentable. Of course, a reading of the *SSP* opinion as a whole reveals that the court had no such intention, but nonetheless underscores the im-

merely reflects the writing style of the opinion's author, and is not seriously intended to serve as guidance for courts confronting obviousness issues; such guidance already exists in detail, and is apparent from a reading of *Satco*.

Unfortunately, the *SSP* court's unsophisticated discussion of some of the basic features of patent law was mirrored in *Herschensohn* and *Gillette*. An example from each will suffice.

In *Herschensohn*, the court stated: "It is obvious . . . that the patent is not valid, having no new, unusual or synergistic result, and having no beneficial use other than uses already old in the art. . . . We also hold [that] the patent [is] invalid for obviousness."³⁴ There are several difficulties with this passage. First, by distinguishing between "synergism" and "nonobviousness," the court creates the false impression that these are separate conditions for patentability.³⁵ A close reading of the first part of the court's opinion discloses that such an impression was unintentional. Second, continued use of the old language of *A&P* and *Black Rock* only obscures the points which were made by the *Satco* court, and should now be discontinued in favor of the forms of expression adopted in *Satco*. Third, the gratuitous "no new beneficial use" terminology is an inapt as *SSP*'s "no new principle" pronouncement, and should be viewed accordingly. This writer is not aware of any case in which patentability depended upon a "beneficial use other than uses already old in the art."

In *Gillette*, the court's desire to be emphatic led to a glaring misstatement. The *Gillette* court was obviously unimpressed with the invention in suit, and thus ended its opinion with this remark: "The result here was not only to be expected; it was the

portance of avoiding inartful phrases such as the "new principle" expression used in *Jeddeloh*. If this is not done, undesirable results will occur, such as the invalidation of non-obvious (and thus presumably patentable) combinations of known elements and/or principles.

34. 593 F.2d at 897 (footnote omitted) (emphasis added).

35. The court justified its use of the word "synergism" by citing *Astro Music, Inc. v. Eastham*, 564 F.2d 1236 (9th Cir. 1977) and *Austin v. Marco Dental Prods. Inc.*, 560 F.2d 966 (9th Cir. 1977). *Astro Music* is an unimportant decision as it merely quoted the catch phrases of *A&P*. 564 F.2d at 1238. And, contrary to the *Herschensohn* court's contention, *Austin* is not a combination case. 560 F.2d at 972. ("the Austin Diaphragm valve . . . was a new element"). These authorities do not support the opinion's apparent and incorrect description of the role played by the synergism concept in patent law. See *Developments*, *supra* note 1, 209-10.

only possible result.”³⁶ This implies that a nonobvious combination of old elements is nonetheless unpatentable if there is only one possible mechanical result which said combination can produce. Such a notion, of course, never has been and never will be a feature of the patent laws.³⁷

The Ninth Circuit patent decisions, on a whole, reflect a uniform and consistent application of the proper legal standards. Occasional careless phrases cannot impair this basic fact, but they can create a certain amount of confusion for the over-burdened trial courts, as the findings set forth in *Satco* attest. Accordingly, it may be well to avoid the catch phrases of *A&P* and variations thereof (which often are mere substitutes for a proper *Graham* analysis), or use them only as they were used by the *Satco* court, and then only with the greatest care.

B. COPYRIGHT

Last term, the Ninth Circuit considered important copyright issues in *Walker v. University Books, Inc.*,³⁸ *United States v. Hamilton*,³⁹ *Mills Music, Inc. v. Arizona*,⁴⁰ and *Walt Disney Productions v. Air Pirates*.⁴¹ The *Walker* and *Hamilton* decisions are

36. 603 F.2d at 69.

37. Once a nonobvious combination is discovered, the results which will be produced by that combination will often be predictable. See *Globe Linings, Inc. v. City of Corvallis*, 555 F.2d 727, 731-32 (9th Cir. 1977). For a discussion of *Globe Linings*, see *Developments, supra* note 1, at 203 n.52.

It cannot be denied that there is a fine distinction involved here. The purpose of having a level-of-ordinary-skill standard is to insure that no “tools of the trade,” or any expected results obtainable by combining such tools, are taken away from the public domain and made the exclusive property of any one person. It is undeniable that a patent which “withdraws what is already known into the field of its monopoly . . . diminishes the resources available to skillful men,” and must be invalidated. *Sakraida v. Ag Pro, Inc.*, 425 U.S. at 281-82, quoting *Great Atl. & Pac. Tea Co. v. Supermarket Equip. Corp.*, 340 U.S. at 152.

However, the statutory standard is still obviousness. The danger inherent in casual references to “expected” or “possible” results is the failure to differentiate between prospective and hindsight expectations. A result can be the “only possible result” produced by a combination device, and still be unexpected in a prospective sense. This fact serves to emphasize the importance of carefully following the steps of *Graham*’s analytical process, rather than resorting to quotable phrases.

38. 602 F.2d 859 (9th Cir. June, 1979) (per Curtis, D.J., sitting by designation; the other panel members were Browning and Wallace, JJ.) (rehearing denied).

39. 583 F.2d 448 (9th Cir. Oct., 1978) (per Kennedy, J.; the other panel members were Kilkenny and Sneed, JJ.).

40. 591 F.2d 1278 (9th Cir. Feb., 1979) (per Lucas, D.J., sitting by designation; the other panel members were Hufstedler and Goodwin, JJ.).

41. 581 F.2d 751 (9th Cir. Sept., 1978) (per Cummings, J.; the other panel members were Chambers and Anderson, JJ.).

discussed separately below, and need not be examined here. *Mills* and *Air Pirates*, however, are worth briefly noting.

States are Liable For Infringement

Mills involved repeated infringement of a copyrighted song by the State of Arizona and one of its agencies.⁴² The trial court found that the infringing activity was "willful, with full notice and knowledge of plaintiff's copyrights and in total disregard for those rights," and thus ruled for the plaintiff.⁴³ The State nonetheless appealed, contending solely that "the Eleventh Amendment precludes an award of damages and attorney's fees against a state" ⁴⁴

After deciding that the State had not lost its eleventh amendment immunity by consenting to the jurisdiction of a federal court,⁴⁵ the panel held that the State had waived its immunity by voluntarily participating in an activity regulated by federal law. In other words, applying the standard delineated by the Supreme Court in *Parden v. Terminal Railway*,⁴⁶ the *Mills* court concluded that Congress has authorized suit against "any person" who violates the copyright laws, and that this authorized class of defendants includes any state.⁴⁷ Thus, a state in the Ninth Circuit does waive its eleventh amendment immunity if it infringes a copyright.

42. The song in question was used as the theme song for the 1971 Arizona State Fair. The length of time separating the acts of infringement and the Ninth Circuit's decision on February 26, 1979, suggests the need for a judicial response which will mitigate the harm such delay will otherwise inflict on all litigants. A suggested response is discussed in the text accompanying notes 65 to 73 *infra*.

43. 591 F.2d at 1281. For factual background see *id.* at 1280-81.

44. *Id.* The eleventh amendment provides: "The Judicial power of the United States shall not be construed to extend to any suit in law or equity, commenced or prosecuted against one of the United States by Citizens of another State, or by Citizens or Subjects of any Foreign State." U.S. CONST. amend XI.

45. 591 F.2d at 1281-82. A state can waive its immunity by consenting to jurisdiction, but the consent must be unequivocal. In the absence of such consent, a state can raise an eleventh amendment defense at any time—even on appeal. *Id.* at 1282. The panel was obviously uncomfortable with this rule, but felt "constrained" to invoke it in light of *Edelman v. Jordan*, 415 U.S. 651 (1974). See 591 F.2d at 1282 n.6.

46. 377 U.S. 184 (1964). The *Mills* court also examined *Edelman v. Jordan*, 415 U.S. 651 (1974) and *Employees v. Department of Pub. Health & Welfare*, 411 U.S. 279 (1973), stating that "the *Parden-Employees-Edelman* trilogy establishes that the Eleventh Amendment immunity is waived when Congress has authorized suit against a class of defendants that includes states, and the state enters into the activity regulated by federal law." 591 F.2d at 1283.

47. *Id.* at 1284-86.

At least one circuit has held differently,⁴⁸ but the result in *Mills* is consistent with *Parden*, sensible in light of the purpose of the copyright laws, and eminently fair to the owners of copyright interests. As such, *Mills* is a welcome contribution to the body of intellectual property law.

Fair Use

In *Walt Disney v. Air Pirates*, the Ninth Circuit has significantly clarified and relaxed the fair use standards which had been previously applied in the parody context in *Benny v. Loew's, Inc.*,⁴⁹ a 1956 decision which the *Air Pirates* court characterized as "controversial." Many believed that the *Benny* court considered the "substantiality of the taking" to be virtually dispositive of any fair use issue, and that the substantiality test was met by copying, significant enough to constitute infringement.⁵⁰ The *Air Pirates* court correctly pointed out that, as commonly interpreted, the *Benny* test emasculated the fair use defense by having it only apply to situations where it was not needed, *i.e.*, to situations where there is no copyright infringement due to the minor extent of the copying.⁵¹ The *Air Pirates* court salvaged *Benny* by concluding that *Benny* only advances a "threshold test" which "eliminates from the fair use defense copying that is virtually complete or almost verbatim."⁵² Thus, in those parody situations involving less than "almost verbatim" copying, the *Berlin* test applies.⁵³ *Berlin* states that a parodist may fairly use that amount of the original which is necessary "to recall or conjure up" the work being satirized, as long as "almost verbatim" copying is avoided.⁵⁴

Although the *Air Pirates* decision is helpful to the extent that it neutralizes some of the adverse impacts of the *Benny* case, it is far from being entirely satisfactory.⁵⁵ The greatest diffi-

48. *Wihtol v. Crow*, 309 F.2d 777 (8th Cir. 1962), *discussed in Mills Music, Inc. v. Arizona*, 591 F.2d at 1286.

49. 239 F.2d 532 (9th Cir. 1956), *aff'd by an equally divided court*, 356 U.S. 43 (1958).

50. *See* 581 F.2d at 756-57.

51. *Id.*

52. *Id.* at 756-57.

53. *Berlin v. E.C. Publications, Inc.*, 329 F.2d 541 (2d Cir.), *cert. denied*, 379 U.S. 822 (1964). *See also* Annot., 23 A.L.R.3d 139, 177-83 (1969).

54. 581 F.2d at 757. The *Air Pirates* court clearly indicated that parody which would be greatly improved by closer imitation would nonetheless be required to adhere to an inferior format if such a format nonetheless "conjured up" the object being satirized.

55. *See, e.g., Denicola, Copyright and Free Speech: Constitutional Limitations on*

culty with *Air Pirates* is that it endorses blanket rules, e.g., “almost verbatim” copying is never fair in the parody context. The case also assigns excess weight to copyright interests as it balances them against society’s interest in high quality parody. The fair use analysis now set forth in 17 U.S.C. section 107 expressly requires a balancing of factors as opposed to blanket or per se rules.⁵⁶ Moreover, the central factor is the impact the challenged use will have on the market for or commercial value of the copyrighted work.⁵⁷

Considering this central factor in the parody context, it seems clear that a parody will rarely adversely affect the value of the works being satirized. Indeed, the attention created by a parodist often stimulates interest in the original work. Parodists do not deprive copyright owners of the economic benefits of their monopoly, and therefore do not do violence to the purpose of the copyright laws, which is to provide an economic inducement for individuals to publish their creative works. Accordingly, virtually all parody should be considered fair use, regardless of the “substantiality” of the taking. Social interests would be well served thereby, while no legitimate copyright interest would be injured as a result.⁵⁸

It should be noted, of course, that *Air Pirates* and the *Benny* threshold test must be confined to the parody context, which the court acknowledged as unique. In other taking situations—such as the recent *Betamax* cases—⁵⁹ section 107’s balancing approach (with an emphasis on the economic impact on *the very work* copied) must be observed. Accordingly, even verbatim and complete copying can constitute fair use under the appropriate circumstances.⁶⁰

the Protection of Expression, 67 CALIF. L. REV. 283, 299 n.84 (1979); Light, *Parody, Burlesque and the Economic Rationale for Copyright*, 11 CONN. L. REV. 615, 635 n.101 (1979).

56. Of course, the *Air Pirates* court was required to apply the old Copyright Act, which has no fair use provision. 581 F.2d at 754.

57. 3 M. NIMMER, NIMMER ON COPYRIGHT, § 13.05 [b] [4] (1979).

58. A contrary conclusion would only be justified in *Air Pirates* if Walt Disney could have shown that the activities of parodists caused profits from its cartoon business to drop significantly.

59. *Universal City Studios, Inc. v. Sony Corp. of America*, 203 U.S.P.Q. 656 (C.D. Cal. 1979); *Bruzzone v. Miller Brewing Co.*, 202 U.S.P.Q. 809 (N.D. Cal. 1979), discussed in *N.Y. Times*, June 5, 1979, Sec. D, at 13, col. 5; *Marketing News*, Aug. 10, 1979, Sec. 1, at 11. The *Universal* and *Bruzzone* cases are noted in J. LAWRENCE & B. TIMBERG, *FAIR USE AND FREE INQUIRY: COPYRIGHT LAW AND THE NEW MEDIA* 308-09, 340-41 (1980).

60. See *Universal City Studios, Inc. v. Sony Corp. of America*, 203 U.S.P.Q. at 683-

Copyrightability of Characters

An issue that the *Air Pirates* court did handle well relates to the copyrightability of cartoon characters. Ever since the famous *Maltese Falcon* case,⁶¹ there has been some question in the Ninth Circuit about the extent to which characters are amenable to copyright protection. In the *Maltese Falcon* case, the court basically stated that characters are not protectable, unless "the character really constitutes the story being told."⁶²

The defendants in *Air Pirates* naturally sought to rely on this rule. In a somewhat strained analysis, the trial court avoided the consequences of the *Maltese Falcon* rule by concluding that Walt Disney characters are part of the stories being told by these characters.⁶³ On appeal, the *Air Pirates* court took the preferred approach of differentiating between cartoon characters and literary characters of the type at issue in the *Maltese Falcon* case. It is quite clear that cartoon characters are essentially visual creations entitled to the scope of copyright protection conferred by the *Air Pirates* court.⁶⁴

C. CONCLUSION: THE NECESSITY OF STAYING INJUNCTIONS WHILE APPEALS ARE PENDING

Patent, copyright, and trademark litigation in the Ninth Circuit is presently complicated by two important developments: the use of juries in cases involving difficult issues of fact and law,⁶⁵ and the delay caused by this court's crowded docket.⁶⁶ The

84; *Bruzzone v. Miller Brewing Co.*, 202 U.S.P.Q. at 812. The *Bruzzone* case involved verbatim copying of television commercials by a Betamax, and then selective use of various portions of the copies in market research questionnaires. The *Bruzzone* case is even more far reaching than the *Universal* case because the use in *Bruzzone* was for a commercial purpose, and the market research information made possible by the use was made available to the competitors of the copyright owner. However, even if this information aided the competitors, the copying could not have harmed the market value of the work copied, and thus it was held to be fair. 202 U.S.P.Q. at 812. An excellent discussion which supports a broad fair use right is contained in Comment, *The First Amendment Exception to Copyright: A Proposed Test*, 1977 Wis. L. Rev. 1158.

61. *Warner Bros. Pictures, Inc. v. Columbia Broadcasting System, Inc.*, 216 F.2d 945 (9th Cir. 1954).

62. *Id.* at 950.

63. See *Walt Disney Prods. v. Air Pirates*, 345 F. Supp. 108, 111-13 (N.D. Cal. 1972). Again, it should be noted that a significant amount of time, over six years, elapsed between the entry of judgment and the decision on appeal.

64. See 581 F.2d at 754-55.

65. This is especially true where issues of unfair competition (which are, of course, irrelevant to issues of patent validity) are arguably available to engender jury sympathy.

growing trend toward jury trials reflects the belief that jurors will usually find patents, copyrights or trademarks⁶⁷ valid and infringed on the basis of the apparent equities, rather than on the prescribed factual and legal inquiries, which are simply too difficult and technical for a jury to invoke with precision.⁶⁸

The pro-patent nature of most juries is rarely discussed lest one be accused of denying patentees their constitutional right to a trial by jury. However, oblique references to this fact of life can be found:

In determining whether to endorse the jury demand on the complaint or wait until a responsive pleading is filed, there are some tactical considerations involved. There is no question that in particular factual contexts a jury might be inclined to favor one of the parties on grounds essentially unrelated to the merits of the controversy. As a consequence [for example] of an inclination to accept the administrative determination of patentability reflected by the issuance of the patent, a favorable decision may be more readily obtainable from a jury than from the court sitting as the finder of fact.⁶⁹

As a result, the party charged with infringement can often expect an adverse ruling if a jury trial is involved, even if a meritorious defense is available. Ordinarily, this would present little difficulty, even in cases where motions for a judgment notwith-

One could argue that the most serious error committed by the patentees in *Herschensohn* (involving "literally 'Chinese copies' of plaintiffs' . . . brush") and *SSP* (involving issues of trademark infringement) was the failure to demand a jury trial.

66. The court recognizes this in the initial instructions which are provided by the office of the clerk when an appeal is taken. The clerk's instructions state: "Non-criminal cases with no statutory priority may wait up to two years for oral argument. (Hopefully, this time period will be gradually reduced as new judges are added to the court.)" *Clerk's Instructions* at 10.

67. For the sake of brevity, the remaining text will explore this topic in the context of patent litigation. However, the analysis would be similar for all intellectual property law cases.

68. The Ninth Circuit has noted "that patent suits do not lend themselves readily to trial by jury for obvious reasons." *Shubin v. United States District Court*, 299 F.2d 47, 47 (9th Cir. 1961). Similar remarks have been made by other courts, but all acknowledge that the right to a jury trial is inviolable. *See, e.g., Reynolds-Southwestern Corp. v. Dresser Indus., Inc.*, 372 F.2d 592, 593 (5th Cir. 1967); *Railex Corp. v. Joseph Guss & Sons, Inc.*, 40 F.R.D. 119, 124 (D.D.C. 1966).

69. 3 R. WHITE, *PATENT LITIGATION: PROCEDURE & TACTICS*, § 2.02 [6], at 2-20 to 2-21 (1971).

standing the verdict or new trial are denied, for appellate panels have demonstrated skill in applying the correct legal standards to complex factual records. The court of appeals also has the advantage of being fully briefed by the parties on the basis of the trial transcript, whereas the transcript is often not available to the trial court during the post-verdict motion stage of a jury case.

However, what would ordinarily be a manageable problem becomes unmanageable due to the extensive delay now created by the crushing work-load imposed upon the Ninth Circuit. The situation as it now often exists can be described as follows: (1) a judgment and injunction is entered upon the jury's verdict of infringement; (2) the defendant is prevented from using all devices covered by the patent in question, often with severely prejudicial and irreparable economic consequences for the defendant; (3) several years later the patent is finally declared invalid and/or not infringed by the court of appeals; but (4) the patentee has nonetheless fully exploited a monopoly to which he never had a legal right. Under such circumstances, it is clear that the result on appeal will be of little more than academic interest to the parties, that the defendant's right to an effective appeal will essentially be denied, and that the defendant's business will needlessly suffer permanent damage.

A simple and obvious solution to these problems exists in the form of a stay of the injunction pending appeal. Rule 62(d) of the Federal Rules of Civil Procedure already provides for a stay of a money judgment as a matter of right if a sufficient supersedeas bond is filed with a timely lodged notice of appeal.⁷⁰ Similarly, the injunction can be stayed under Rule 62(c). A Rule 62(c) stay is not obtainable as a matter of right, but should nonetheless be routinely granted in a normal case in order to preserve the right to an effective appeal and avoid irreparable harm.⁷¹

70. "By doing all the acts necessary to perfect an appeal and by giving a proper supersedeas bond an appellant may obtain a stay as of right." 7 J. MOORE'S FEDERAL PRACTICE, ¶ 62.06, at 62-27 (1979) (footnotes omitted).

71. Motions for such stays have nonetheless been denied in recent cases in the Northern District of California which are now being appealed to the Ninth Circuit. *See, e.g., Carson Mfg. Co. v. Carsonite, Int'l Corp.*, No. 79-4474 (9th Cir. Aug. 8, 1979); *Velo-Bind, Inc. v. Minnesota Mining & Mfg. Co.*, Nos. 79-3338, 79-4448 (9th Cir. July 17, 1979; Aug. 1, 1979). However, the position being advocated is strongly supported by *Vacuum Oil Co. v. Grabler Mfg. Co.*, 53 F.2d 975 (6th Cir. 1931), a patent case where an

Patent-owners, of course, will object on the ground that if the judgment is upheld on appeal, continued infringement will nonetheless occur during the years prior to decision. However, harm to the patentee can be avoided by simply establishing an interest-bearing escrow account into which the defendant must deposit a percentage of the amount obtained from each post-judgment sale of the allegedly infringing device. If the judgment is affirmed, the patentee will receive all the funds in the escrow account, and its patent monopoly will remain intact. If the judgment is reversed, on the other hand, the defendant will receive the escrow funds, and will not suffer the injustice of being enjoined from using technology which it actually had a legal right to use as it saw fit.

It will be the rare case where use of Rule 62(c) in this manner will prejudice any party. However, serious prejudice to the defendant will inevitably result in every case where the injunction is not stayed, and the judgment is eventually reversed.⁷² This fact strongly militates in favor of using Rule 62(c), especially in light of the problems created by the present delays associated with appeals in the Ninth Circuit.

If a trial judge is disinclined to invoke Rule 62(c) in a given case, the injunction should, at the very least, be viewed as a preliminary injunction or interlocutory order entered prior to a final determination on the merits.⁷³ As such, the patent-owner should be required to provide adequate security as a condition to receiving injunctive relief which will probably eliminate the defendant as a competitor for years. This would appear to be the only alternative way of protecting the successful appellant from serious irreparable harm.

injunction was stayed by the court of appeals pending resolution of an appeal.

Vacuum Oil appears to be only reported decision directly in point, and it pre-dates Rule 62. However, in *Western Lighting Corp. v. Smoot-Holman Co.*, 352 F.2d 1019 (9th Cir. 1965), a Ninth Circuit panel indicated that the *Vacuum Oil* rule is proper by stating that, when an appeal was taken and a supersedeas bond filed, "this effectively stayed the injunction." *Id.* at 1020.

72. In other words, even if *Vacuum Oil* is not considered dispositive, a traditional Rule 62(c) analysis would support the *Vacuum Oil* court's position. See, e.g., *Reserve Mining Co. v. United States*, 498 F.2d 1073 (8th Cir. 1974) (granting a stay of injunction); *Virginia Petroleum Jobbers Ass'n v. Federal Power Comm'n*, 259 F.2d 921 (D.C. Cir. 1958); *Roe v. Ferguson*, 389 F. Supp. 393, 396 (S.D. Ohio 1974) (trial courts should "not lightly deny motions for stays of its orders pending appeals"); 7 J. MOORE's, *supra* note 70, ¶ 62.05, at 62-25.

73. See *Vacuum Oil Co. v. Grabler Mfg. Co.*, 53 F.2d at 976.

II. ORIGINALITY IN CARTOGRAPHY: THE STANDARD FOR COPYRIGHT PROTECTION

A. INTRODUCTION

In *United States v. Hamilton*,¹ the Ninth Circuit considered the standard of originality² that a map must meet in order to merit copyright protection. Writing for the court, Judge Kennedy held that elements of compilation and synthesis, either alone or considered along with direct geographical observation, may constitute the original authorship necessary to support a map copyright.³ A prior line of cases⁴ has restricted maps to a narrower test or originality, known as the direct-observation rule. As stated in *Amsterdam v. Triangle Publications, Inc.*,⁵ this rule requires cartographers to acquire a significant portion of the information displayed on a copyrighted map by an original geographic investigation of the area depicted.⁶ The Ninth Circuit expressly declined to follow the direct-observation rule.⁷

This Note will examine the reasoning of the *Hamilton* court, and suggest how the court might have arrived at a clearer and more practical originality standard.

B. FACTUAL BACKGROUND

In 1973, KDB Enterprises, a company specializing in making maps of the Pacific Northwest, produced and registered for copy-

1. 583 F.2d 448 (9th Cir. Oct., 1978) (per Kennedy, J.; the other panel members were Kilkenny and Sneed, JJ.).

2. *Hamilton* was decided under the Copyright Act of 1909, which does not expressly require originality. Courts have inferred this requirement from the fact that copyright protection is provided for "all the writings of an author." Copyright Act of 1909, 17 U.S.C. § 4 (1970). It is reasoned that a work is not the writing of an author unless it is the original creation of that author. 1 NIMMER ON COPYRIGHT, § 8.31 (1967). Cf. Copyright Act of 1976, 17 U.S.C. § 102(a) (Supp. I 1976) (granting copyright protection to "original works of authorship").

3. 583 F.2d at 452.

4. Beginning with *Amsterdam v. Triangle Publications, Inc.*, 189 F.2d 104, 106 (3d Cir. 1951), and followed or cited with approval in *County of Ventura v. Blackburn*, 362 F.2d 515, 520 (9th Cir. 1966); *Axelbank v. Rony*, 277 F.2d 314, 318 (9th Cir. 1960); *Alaska Map Serv., Inc. v. Roberts*, 368 F. Supp. 578, 579 (D. Alaska 1973); *Newton v. Voris*, 364 F. Supp. 562, 564 (D. Or. 1973); *Carter v. Hawaii Transp. Corp.*, 201 F. Supp. 301, 303 (D. Hawaii 1961); *Hayden v. Chalfant Press, Inc.*, 177 F. Supp. 303, 306 (S.D. Cal. 1959), *aff'd on other grounds*, 281 F.2d 543 (9th Cir. 1960); *Marken & Bielfeld, Inc. v. Baughman Co.*, 162 F. Supp. 561, 562 (E.D. Va. 1957).

5. 189 F.2d 104 (3d Cir. 1951).

6. *Id.* at 106.

7. 583 F.2d at 450.

right a map of Ada County, Idaho.⁸ KDB used an Idaho Department of Highways map as a base, and added information derived from a variety of sources, including other government maps and KDB's own previously copyrighted map produced in 1970. Some of the information on the 1973 map, including rifle ranges, jeep and motorcycle trails, a landing strip, and other landmarks, was derived from the personal observations of a KDB employee.⁹

Defendant Hamilton was president of United Publishing Co., Inc., an Oregon corporation doing business as ADCO. ADCO sold advertising to merchants, which it placed on the borders of a map. Copies of the map were left with merchants to be given away to customers. In the course of this business, Hamilton produced and sold advertisements bearing an exact copy of the 1973 KDB map. Hamilton was convicted by the District Court for the District of Idaho of willful infringement of copyright for profit, under the Copyright Act of 1901.¹⁰ Hamilton admitted copying and selling the KDB map.¹¹ The sole contention of the defendant both at trial and on appeal was that the KDB copyright was invalid due to a lack of original authorship, and ipso facto could not be infringed.¹² The Ninth Circuit upheld the validity of both the copyright and defendant Hamilton's conviction.¹³

C. ISSUES PRESENTED

The principal issue before the Ninth Circuit panel was whether the 1973 KDB map had the requisite degree of originality for copyright protection. In resolving this issue the court consid-

8. *Id.* at 449.

9. *Id.* at 449, 452.

10. Copyright Act, ch. 391, § 104, 61 Stat. 652 (1947) (current version at 17 U.S.C. § 506 (Supp. I 1976)) provides, in pertinent part: "Any person who willfully and for profit shall infringe any copyright secured by this title . . . shall be guilty of a misdemeanor . . ." *Hamilton* is unusual among the map copyright cases in being a criminal prosecution. Compare *United States v. Hamilton*, 583 F.2d 448 with *United States v. Wells*, 176 F. Supp. 630 (S.D. Tex. 1959).

11. 583 F.2d at 449.

12. A certificate of copyright "shall be admitted in any court as prima facie evidence of the facts stated therein." Copyright Act, ch. 391, § 209, 61 Stat. 652 (1947) (current version at 17 U.S.C. § 410(c) (Supp. I 1976)). The defendant then has the burden of disproving the validity of the copyright. Defendant Hamilton argued that since his was a criminal case, his burden was only to raise a reasonable doubt as to the validity of the copyright, the burden then shifting to the government to overcome this doubt. Brief for Appellant at 23, *United States v. Hamilton*, 583 F.2d 448 (9th Cir. 1978), citing *United States v. Wells*, 176 F. Supp. 630 (S.D. Tex. 1959)). The opinion of the Ninth Circuit does not speak to this question.

13. 583 F.2d at 449.

ered (1) whether KDB's direct investigation of the terrain was substantial enough to support the map copyright;¹⁴ (2) whether compilation, arrangement, and presentation, either alone or in combination with direct observation, may constitute sufficient original authorship to make a map eligible for copyright protection;¹⁵ (3) whether KDB's efforts in compiling the map were substantial enough to qualify the map for copyright;¹⁶ and (4) whether KDB's presentation of new information in its 1973 map, in combination with its work in compilation, supported the validity of the copyright.¹⁷

Was There Sufficient Direct Observation?

The *Hamilton* court found that the record before it presented a close question whether KDB's direct observation, taken alone, had been substantial enough to support the copyright.¹⁸ The prosecution and the defendant differed as to whether added information on the 1973 KDB map had come from direct observation or from sources in the public domain. The Ninth Circuit ruled that more than a trivial contribution is needed to satisfy the originality requirement,¹⁹ but chose not to decide the close question whether KDB's observations had in fact been more than merely trivial.²⁰

Does Compilation Comprise Original Authorship in Cartography?

Rather than decide the factual question regarding KDB's added information, the *Hamilton* court chose to address the validity of the direct-observation rule, and to decide whether selection, arrangement, and presentation of information may be considered as part of the skilled efforts that constitute a cartographer's authorship.²¹

1. The *Amsterdam* Rule

In *Amsterdam*, the Third Circuit held that for a map to merit

14. *Id.* at 450.

15. *Id.*

16. *Id.* at 452.

17. *Id.*

18. *Id.* at 450.

19. *Id.*, citing *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102-03 (2d Cir. 1951).

20. 583 F.2d at 452.

21. *Id.* at 450.

copyright protection, a substantial portion of the information depicted must be obtained originally by the cartographer through the "sweat of his brow."²² The defendant publisher reproduced the plaintiff's copyrighted map in a Sunday newspaper supplement. The map had been compiled by the plaintiff from other maps in the public domain. The defendant contended that the map did not merit copyright protection, due to a lack of original authorship. The Third Circuit, quoting with "complete accord" the language of the trial court, held that the exercise of judgment and discretion in the compilation and presentation of information in the public domain was not the type of original work needed to qualify the plaintiff's map for copyright.²³ Original work in cartography was equated with obtaining new information not available from previously published sources.²⁴ *Amsterdam* has been followed in the Third and Ninth Circuits.²⁵

The *Hamilton* panel discussed *Amsterdam* at length. The court first considered that *Amsterdam* might reflect a fear that if a copyright were granted for a map compiled from public domain sources, other cartographers would thereby be denied the use of those sources in compiling later maps.²⁶ This theoretical fear was dismissed as being clearly false, since one author's copyright does not prevent another from using the same sources independently to create a similar or even identical work.²⁷

22. 189 F.2d at 106.

23. *Id.*

24. *Id.*

25. See cases cited note 4 *supra*. But see *C. S. Hammond & Co. v. International College Globe, Inc.*, 210 F. Supp. 206, 216 (S.D.N.Y. 1962) ("The elements of the copyright consist in the selection, arrangement, and presentation of the component parts," citing *General Drafting Co. v. Andrews*, 37 F.2d 54, 55 (2d Cir. 1930)). See also *Moore v. Lighthouse Publishing Co., Inc.*, 429 F. Supp. 1304, 1309-11 (S.D. Ga. 1977) (the court noted some confusion in the law concerning the direct-observation rule, but avoided confronting the issue by finding that the plaintiff had not presented sufficient evidence to warrant a conclusion that the defendant had in fact copied.).

Commentators have been unanimous in their disapproval of the direct-observation rule. See *Whicher, Originality, Cartography, and Copyright*, 38 N.Y.U. L. REV. 280, 289-92 (1963); *Dworkin, Originality in the Law of Copyright*, 39 B.U. L. REV. 526, 536-38 (1959); *Gorman, Copyright Protection for the Collection and Representation of Facts*, 76 HARV. L. REV. 1569, 1571-76 (1963); 1 M. NIMMER, *supra* note 2, at § 18.32 states: "The fallacy of the direct-observation rule stems from the *Amsterdam* court's misunderstanding of the copyright concept of originality."

26. 583 F.2d at 450.

27. *Id.* Although the Ninth Circuit did not cite cases, other courts have addressed this point. See, e.g., *Fred Fisher v. Dillingham*, 298 F. 145, 150 (S.D.N.Y. 1924) where Judge Learned Hand stated:

The Ninth Circuit next suggested that *Amsterdam* rests on the judgment that obtaining data by surveying is the only facet of cartography sufficiently original to deserve copyright protection.²⁸ The court saw no persuasive reason for this judgment, but rather reasoned that direct observation is not the only aspect of a cartographer's skill and talent worthy of copyright.²⁹ The court expressly declined to rule that maps present unique considerations requiring their originality to be judged by a different standard from all other copyrightable classes of subject matter.³⁰

The *Hamilton* panel expressed an awareness that a cartographer seeking to prove originality under a standard which admitted compilations might, in some cases, have difficulty showing that a map is the product of an original compilation rather than a copy of a similar independent work.³¹ While this difficulty might discourage cartographers from undertaking works of compilation and synthesis, the court reasoned that to give no protection at all to such works would clearly be much more discouraging to progress in the field of cartography.³²

Problems of proof under the *Amsterdam* standard were also considered. When most of the information depicted on a map could have been obtained by means other than direct observation, one who independently resurveyed an area would present evidence of physical investigations similar to that presented by one who had visited the area only to verify data obtained elsewhere.³³ The Ninth Circuit reasoned that, since a work resulting from independent efforts may be copyrightable even though it is

Any subsequent person is, of course, free to use all works in the public domain as sources for his compositions. No later work, though original, can take that from him The defendant's concern lest the public should be shut off from the use of works in the public domain is therefore illusory; no one suggests it. That domain is open to all who tread it

28. 583 F.2d at 450-51.

29. *Id.* at 451.

30. *Id.* The usual rule may be found in the statute: "Compilations . . . arrangements . . . or other versions of works in the public domain, or of copyrighted works . . . shall be regarded as new works subject to copyright . . ." Copyright Act of 1909, 17 U.S.C. § 7 (1973) (current version at 17 U.S.C. § 103 (Supp. I 1976)). Professor Nimmer has suggested that the direct-observation rule has the effect of taking maps outside of the provisions of § 7. 1 M. NIMMER, *supra* note 2, at § 18.32.

31. 583 F.2d at 451.

32. *Id.*

33. *Id.*

identical to either another copyrighted work or one in the public domain,³⁴ the resurveyed map would be entitled to copyright under the *Amsterdam* standard, while the verified map would not.³⁵ The court suggested that while *Amsterdam* might seek to protect the work of only those who originally obtain their information by surveying, and not those who conduct surveys solely to verify data previously obtained, it would in practice be difficult for courts to distinguish between the two.³⁶

2. The *Hamilton* Rule

After analyzing *Amsterdam*, the court discussed the standard of originality applicable in general to copyrightable subject matter. It noted that originality in copyright requires only that a work display some element that is the independent creation of its author,³⁷ and not that it present something novel or unique.³⁸ As a general rule of law, the court stated that compilation or arrangement is an aspect of authorship that is protectible by copyright, even when the individual components of the compilation are commonplace and not copyrightable themselves.³⁹ However, the Ninth Circuit emphasized that the compilation or arrangement must be more than trivial to pass the threshold of originality.⁴⁰ Minor elements of presentation, such as choice of colors, symbols, and key system, were described as falling short of this threshold.⁴¹

34. *Id.* at 451 n.4, citing *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 54 (2d Cir. 1936), *aff'd*, 309 U.S. 390 (1940). Judge Hand, writing for the Second Circuit, held that "if by some magic a man who had never known it were to compose anew Keats's Ode on a Grecian Urn, he would be an 'author,' and, if he copyrighted it, others might not copy that poem, though they might of course copy Keats's." 81 F.2d at 54.

35. 583 F.2d at 451.

36. *Id.*

37. *Id.*, citing *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 250 (1903).

38. 583 F.2d at 451, citing *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 103 (2d Cir. 1951). *Contra*, *Lee v. Runge*, 441 F.2d 579 (9th Cir. 1971), *cert. denied*, 404 U.S. 887 (1971) (Douglas, J., dissenting; *mem.*) (arguing that novelty is a constitutional requirement for copyright as well as for patent). Justice Douglas's dissent is strongly criticized in Nimmer, *A Comment on the Douglas Dissent in Lee v. Runge*, 19 BULL. COPYR. SOC'Y 68 (1971), and in Note, *Copyrights: Novelty of Originality?*, 55 J. PAT. OFF. SOC'Y 314 (1973).

39. 583 F.2d at 451, citing *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106, 1109-10 (9th Cir. 1970); *Axelbank v. Rony*, 277 F.2d 314, 317 (9th Cir. 1960); *Universal Pictures v. Harold Lloyd Corp.*, 162 F.2d 354, 363 (9th Cir. 1947); *Leon v. Pacific Tel. & Tel. Co.*, 91 F.2d 484, 485-86 (9th Cir. 1937).

40. 583 F.2d at 451.

41. *Id.*, citing *Perris v. Hexamer*, 99 U.S. 674, 675-76 (1878); *Christianson v. West Publishing Co.*, 149 F.2d 202, 203-04 (9th Cir. 1945). *But see* text accompanying notes 79 to 87 *infra*.

The court noted that maps have been recognized as copyrightable subject matter since the first copyright statute of 1790, and that earlier cases had considered selection, arrangement, and presentation to be copyrightable facets of cartography.⁴² The court ruled that elements of compilation that are more than merely trivial may, either alone or considered along with direct observation, support a finding that a map is sufficiently original to merit copyright protection.⁴³ As further support for its reasoning, the court analogized mapmaking to photography, where the courts have generally held minor elements of presentation, such as variations in lighting, background, or perspective, to be protectible by copyright.⁴⁴ The court argued that cartography should be treated similarly, by recognizing selection, design, and synthesis as copyrightable elements of authorship in maps.⁴⁵

Was There Sufficient Compilation to Support the Copyright?

It remained for the *Hamilton* panel to decide whether the work done by KDB in producing its 1973 map was more than trivial. The court first considered the synthesis of information from other maps. It found that “the compilation that produced the 1973 map was the result of substantial creative efforts,” and weighed it “heavily” in support of a finding of originality,⁴⁶ but stopped short of holding that KDB’s work in compilation, taken alone, supported the validity of the copyright.⁴⁷

Did the Compilation and Direct Observation Together Support the Copyright?

The panel next considered the added information gathered by a KDB employee. Although the prosecution and defense dif-

42. 583 F.2d at 452, citing *General Drafting Co. v. Andrews*, 37 F.2d 54, 55 (2d Cir. 1930); *Emerson v. Davies*, 8 F. Cas. 615, 619 (C.C.D. Mass. 1845) (No. 4,436). See *Woodman v. Lydiard-Peterson Co.*, 192 F. 67, 69 (C.C.D. Minn.), *aff’d*, 204 F. 921 (8th Cir. 1912): “The fact that he did secure all this material from other publications which were not copyrighted does not, to my mind, prevent him from getting a copyright upon this map, if it constitutes a new arrangement of old materials”; *Chapman v. Ferry*, 18 F. 539, 542 (C.C.D. Or. 1883): “[A]s absolute originality is not possible in the case of a map, a person may take material from prior publications, provided he bestows on it such skill and labor, in revision or otherwise, as to produce an original result.”

43. 583 F.2d at 452.

44. *Id.*, citing *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884); *Time, Inc. v. Bernard Geis Assocs.*, 293 F. Supp. 130, 141-43 (S.D.N.Y. 1968).

45. 583 F.2d at 452.

46. *Id.*

47. *Id.*

ferred as to whether the employee had obtained this information by his own observations or from sources in the public domain, the Ninth Circuit found this issue irrelevant.⁴⁸ The court held that this new information, however it had been gathered, when considered together with the work of compilation and synthesis, made the 1973 KDB map sufficiently original for copyright.⁴⁹

D. CRITIQUE

The *Hamilton* court ruled correctly that compilation and synthesis are protectible elements of original authorship in cartography. The direct-observation rule has been an unjustified anomaly in copyright law.⁵⁰ As the Ninth Circuit stated, there is no persuasive reason for holding maps outside of the usual rules for determining what is copyrightable subject matter.⁵¹ Although there is now a conflict between the Third and Ninth Circuits, the better-reasoned rule of *Hamilton*, allowing copyright protection for compiled maps, should be universally followed.

The Ninth Circuit may be praised for the general rule it established. However, the court's holding on the facts leaves some uncertainty as to the amount of original work, whether in compilation or direct observation, needed to support a map copyright. This uncertainty will lead to difficulty in applying the *Hamilton* rule to future cases. The court found that "the compilation that produced the 1973 KDB map was a result of *substantial creative efforts*,"⁵² but rather than holding this to be dispositive of the originality issue, it only weighed the compilation "heavily" in support of a finding that the copyright was valid.⁵³ The court found it necessary to consider the presentation of new information along with the work of compilation before reaching its conclusion that the 1973 KDB map was copyrightable.⁵⁴ There is no explanation given why the compilation, standing alone, was not sufficient. *Hamilton* could be construed as holding that more than a "substantial" amount of creative, skilled effort in compilation and synthesis is needed to support a map copyright, in the absence of any information not found in prior maps. Such an

48. *Id.*

49. *Id.*

50. See articles cited at note 25, *supra*.

51. See note 30 *supra*.

52. 583 F.2d at 452 (emphasis added).

53. *Id.*

54. *Id.*

extreme reading of *Hamilton*, while consistent with the manner in which the Ninth Circuit worded its holding on the facts, would be clearly contrary to the main thrust of the court's reasoning: that maps should not be excluded from the permissive standard of copyrightability established for other classes of subject matter. The leading cases of *Bleistein v. Donaldson Lithographing Co.*,⁵⁵ and *Alfred Bell v. Catalda Fine Arts, Inc.*,⁵⁶ cited by the Ninth Circuit as controlling authority, clearly set a very minimal standard of originality.⁵⁷

While there are cases that suggest that factual works, such as maps, directories, and business forms, may be held to a higher standard of originality than literary and artistic works,⁵⁸ the Ninth Circuit rejected a separate standard for maps as "theoretically unsound."⁵⁹ Factual works may be distinguished from literary and artistic works in that their social value lies not so much in their aesthetic qualities as in their practical utility as sources of information.⁶⁰ What the copyright law seeks to protect in factual works is not an individual's creative concept so much as his or her expenditure of money and labor.⁶¹ In the case of

55. 188 U.S. 239 (1903).

56. 191 F.2d 99 (2d Cir. 1951).

57. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. at 250-51; *Alfred Bell v. Catalda Fine Arts, Inc.*, 191 F.2d at 102-03.

58. See, e.g., cases following *Amsterdam* cited at note 4 *supra*; Gorman, *supra* note 25, at 1569 *passim* (a comprehensive discussion of the treatment of factual works under copyright law).

59. 583 F.2d at 451.

60. See *Baker v. Selden*, 101 U.S. 99, 102-03 (1880):

Of course, these observations are not intended to apply to ornamental designs, or pictorial illustrations addressed to the taste. Of these, it may be said that their form is their essence, and their object the production of pleasure in their contemplation. This is their final end. They are as much the product of genius and the result of composition as are the lines of the poet or the historian's periods. On the other hand, the teachings of science and the rules and methods of useful art have their final end in application and use; and this application and use are what the public derive from the publication of a book which teaches them.

Although maps are both artistic and factual in nature, the courts have considered their copyrightability to be a reflection of their practical value, rather than their aesthetic merit. See Gorman, *supra* note 25, at 1571-76.

61. See, e.g., *Jeweler's Circular Publishing Co. v. Keystone Publishing Co.*, 281 F. 83, 88 (2d Cir.), *cert. denied*, 259 U.S. 581 (1922):

The right to copyright a book upon which one has expended labor in its preparation does not depend upon whether the materials which he has collected consist or not of matters which

literary and artistic works, courts have shown an extreme reluctance to make judgments of merit.⁶² However, in the case of factual works, for which value is of a more pragmatic nature, courts have been more willing to evaluate the merit of a particular contribution.⁶³

The *Hamilton* court alluded to this dual standard when it referred to cartography as an "art" and as an "artistic form."⁶⁴ The court expressly declined to rule that maps present considerations that are distinct from "all other cases"⁶⁵ and stated that maps do not need to be judged by rules distinct from those applied to "other artistic forms seeking to touch on external realities."⁶⁶ Clearly the court could not have intended, in disposing of the facts of the instant case, to reassert a unique standard of copyrightability for maps.

The confusion between the court's dictum allowing copyright for compilation and its holding on the facts might have been avoided by a more precise use of terms. The court used the word "originality" to denote two distinct aspects of copyrightability: (1) original authorship (the work must be an independent crea-

are publici juris, or whether such materials show literary skill or originality, either in thought or in language, or anything more than industrious collection He produces by his labor a meritorious composition, in which he may obtain a copyright

62. See, e.g., *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251, where Justice Holmes stated: "It would be a dangerous undertaking for persons trained only to the law to constitute themselves the final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits."

63. Compare *Alfred Bell v. Catalda Fine Arts, Inc.*, 191 F.2d at 103 ("No matter how poor artistically the 'author's' addition, it is enough if it be his own.") with *Axelbank v. Rony*, 277 F.2d at 318 ("[W]e are unable to say as a matter of law that [plaintiff's] map involved such a high degree of creation that even if copied by Rony it constituted an infringement of appellant's copyright.") (first emphasis added; second emphasis in original).

64. 583 F.2d at 451.

65. *Id.*

66. *Id.* Although the phrase "seeking to touch on external realities" might be construed as a reference to factual works only, such a construction seems unlikely in view of the court's later analogy of cartography to photography. Photography is a perfect example of an artistic form which is directly representative of external reality, but as the *Hamilton* court recognized, (see note 44 *supra*), photographs have been held to a very minimal test of originality. E.g., *Jewelers' Circular Publishing Co., v. Keystone Publishing Co.*, 274 F. 932 (S.D.N.Y. 1921), *aff'd*, 281 F. 83 (2d Cir.), *cert. denied*, 259 U.S. 581 (1922): "no photograph, however simple, can be unaffected by the personal influence of the author, and no two will be absolutely alike." 274 F. at 934.

tion rather than a mere copy); and (2) intrinsic merit (the work must have sufficient value to be worthy of protection).

The requirement of originality is derived from cases which hold that an "author" must be the person to whom a work owes its origin.⁶⁷ In order to be original, a work must be independently created but need not be novel nor unique in comparison with other works.⁶⁸ The *Bell* court discussed this point as follows: "Originality in this context 'means little more than a prohibition of actual copying.' No matter how poor artistically the 'author's' addition, it is enough if it be his own."⁶⁹ Thus, as a term of art, "originality" properly has one meaning, *viz.*, that the work has not been copied. The Ninth Circuit used originality in this context when it stated that "[o]riginality requires only that the work display 'something irreducible, which is one man's alone.'"⁷⁰

"Originality" has been used to denote a separate concept, that of intrinsic merit.⁷¹ This requirement is derived from the constitutional grant of copyright power to Congress "[t]o promote the Progress of Science and the useful Arts."⁷² Courts have held that a work does not promote progress unless it has some intrinsic value or usefulness.⁷³ While this quantum of merit has been variously described by terms "creativity" and "intellectual labor,"⁷⁴ it is also referred to under the rubric of "originality."⁷⁵ When the *Hamilton* court stated that "the compilation that produced the 1973 [KDB] map was a result of substantial creative

67. *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 57-58 (1884). See note 2 *supra*.

68. *E.g.*, *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 53-54 (2d Cir. 1936); *Fred Fisher v. Dillingham*, 298 F. 145, 151 (S.D.N.Y. 1924).

69. 191 F.2d at 103, quoting *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903).

70. 583 F.2d at 451, quoting *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903).

71. See 1 M. NIMMER, *supra* note 2, at §§ 8.31, 10.2; L. AMDUR, *COPYRIGHT LAW AND PRACTICE* §§ 12-19 (1936).

72. U.S. CONST. art. I, § 8, cl. 8.

73. *Higgins v. Keuffel*, 140 U.S. 428, 431 (1891); *Chamberlin v. Uris Sales Corp.*, 150 F.2d 512, 513 (2d Cir. 1945).

74. Compare, *e.g.*, *Andrews v. Guenther Publishing Co.*, 60 F.2d 555, 557 (S.D.N.Y. 1932)(creativity), and *Axelbank v. Rony*, 277 F.2d 314, 318 (9th Cir. 1960) (creativity) and 1 M. NIMMER, *supra* note 2, at § 10.2 (creativity), with *Higgins v. Keuffel*, 140 U.S. 428, 431 (1891) (intellectual labor), and *Trade-Mark Cases*, 100 U.S. 82, 94 (1879)(intellectual labor), and 1 M. NIMMER, *supra* note 2, at § 8.31 (intellectual labor).

75. *E.g.*, *Amsterdam v. Triangle Publications, Inc.*, 189 F.2d at 106; *United States v. Hamilton*, 583 F.2d at 452.

efforts, and we weigh it heavily in support of the finding that the 1973 map was an original work,"⁷⁶ it was weighing the merit of the author's work, and referring to that merit as originality.

By distinguishing the question of original authorship from that of intrinsic merit, the Ninth Circuit might have avoided the ambiguity that is found in *Hamilton*. No one denied that KDB was the map's compiler. Having ruled that compilation is a type of original authorship in cartography, the court should have disposed of the question of intrinsic merit summarily; KDB's "substantial" compilation was obviously well beyond the *de minimis* standard of *Bleistein* and *Bell* which the court had approved.

A similar ambiguity is found in the court's statement that "elements of compilation which amount to more than a matter of trivial selection may . . . support a finding that a map is sufficiently original to merit copyright protection."⁷⁷ When the court speaks of "sufficient originality," it asserts that the compilation must meet a standard of intrinsic merit. But the court has already stated that the elements of compilation must be more than trivial which presumably means beyond the minimal standard of *Bleistein* and *Bell* that the Ninth Circuit endorsed.⁷⁸ If such elements "may" support a finding of "sufficient originality," the court appears to refer to a second hurdle of "sufficiency." It appears again to suggest a higher standard of merit for maps. Had the court said "shall" instead of "may," the meaning of the rule would be clear. It would mean that compilation is an aspect of original authorship in cartography, and that compiled maps will be held to the same minimal standard of merit as other types of copyrightable subject matter.

The Ninth Circuit sought to define by example what might be a trivial element of compilation and synthesis. The court noted that "it is well-settled that copyright of a map does not give the author an exclusive right to the coloring, symbols, and key used in delineating boundaries of and locations within the territory depicted."⁷⁹ While the court's example would support a fairly low

76. 583 F.2d at 452.

77. *Id.*

78. *Id.* at 451.

79. *Id.*, citing *Perris v. Hexamer*, 99 U.S. 674, 675-76 (1878); *Christianson v. West Publishing Co.*, 149 F.2d 202, 203-04 (9th Cir. 1945).

standard of intrinsic merit, the cases cited, on careful reading, do not support the "well-settled" rule that the court ascribes to them. In *Perris v. Hexamer*,⁸⁰ the plaintiff mapmaker used an original color scheme to denote different types of buildings in his depiction of a city. The defendant used a similar color scheme in a map depicting a different city. The court properly held that there was no infringement, since the defendant's map was obviously not a copy of the plaintiff's.⁸¹ When the *Perris* court stated that "it has never been supposed that a simple copyright of the map gave the publisher an exclusive right to the use upon other maps of the particular signs and key which he saw fit to adopt for the purposes of his delineations,"⁸² it was affirming the principle that copyright will protect only a particular form of expression, and not an idea.⁸³ While the *idea* of using a particular color scheme could not be copyrighted, the decision does not indicate that if a plaintiff cartographer's original contribution was to employ a detailed color scheme to present information on a map, that map might be freely copied without fear of infringement. Such a contribution would be both original and meritorious, and should be protectible under copyright law.⁸⁴

In *Christianson v. West Publishing Co.*,⁸⁵ as in *Perris*, it was held that the defendant publisher had, in fact, not copied the plaintiff's map.⁸⁶ The *Christianson* court did not hold that the plaintiff's map was not copyrightable, but noted that the plaintiff could not copyright the *idea* of grouping the states according to the defendant's National Reporter System.⁸⁷ As examples of the dissimilarities which led to its conclusion that there had been no copying, the court noted that the maps used different color schemes, and that while one had an explanatory key, the other did not. There is no holding in *Christianson* that elements such as coloring and key symbols are not copyrightable. In misreading *Christianson*, the Ninth Circuit unfortunately repeated an error made by the Third Circuit in *Amsterdam*.⁸⁸

80. 99 U.S. 674 (1878).

81. *Id.*

82. *Id.* at 675-76.

83. *E.g.*, 17 U.S.C. § 102(b) (Supp. I 1976).

84. *See* Dworkin, *supra* note 25, at 538.

85. 149 F.2d 202 (9th Cir. 1945).

86. *Id.* at 203-04.

87. *Id.* The court held that copyright protection could not extend to the "intellectual conception apart from the thing produced." *Id.*

88. 189 F.2d at 106. *See also* Hengst v. Early & Daniel Co., 59 F. Supp. 8, 9 (D.C. Ohio 1945).

By adopting a uniformly low standard of merit, and separating the questions of intrinsic merit and original authorship, courts would not only avoid a source of ambiguity, but would additionally make the trial of many cases simpler and speedier. Where a defendant copier asserts as a defense that the plaintiff's work was not copyrightable, the defense may be based on either a lack of original authorship in the plaintiff's work, or a lack of intrinsic merit, or both. If the defendant asserts a lack of original authorship, he is claiming that the plaintiff's work was copied from a prior source, and has the burden of so proving.⁸⁹ While questions of degree indubitably arise with respect to copying, there are many cases where the copying is verbatim, or, in the case of a pictorial work, photographic, and therefore easily determined. In less clear-cut cases, the courts have applied an objective test: whether the author has created a distinguishable variation in the eyes of an ordinary observer.⁹⁰ When courts undertake to evaluate intrinsic merit, however, there are no objective tests to apply, and judicial standards may vary widely. The trier of fact may have to choose between the opposing opinions of expert witnesses.⁹¹ The more testable question of original authorship should be considered first.

Once it is established that a plaintiff's work is original (not copied), and that the defendant has in fact copied the plaintiff's work, the question of intrinsic merit should in many cases be dealt with summarily. Leading cases have suggested that a defendant's copying is conclusive evidence of the merit of the plaintiff's work.⁹² Courts in these cases have reasoned that a defendant who

89. See note 12 *supra*.

90. *E.g.*, *National Comics Publications v. Fawcett Publications*, 191 F.2d 594, 600 (2d Cir. 1951): "Added phrases in a written 'work,' or changes of a few lines or colors in a pictorial one, may be too trivial to be noticeable by an ordinarily attentive reader or observer; and we will assume arguendo that in such cases the variant cannot be copyrighted." (emphasis added); *Gerlach-Barklow Co. v. Morris & Bendien*, 23 F.2d 159, 161 (2d Cir. 1927); *Ziegelheim v. Flohr*, 119 F. Supp. 324, 327 (S.D.N.Y. 1954): "[T]he test to be applied . . . is whether it was a 'distinguishable variation' . . . [or] whether he 'contributed' something more than a 'merely trivial' variation, something recognizably 'his own.'"

91. See *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 123 (2d Cir. 1930), *cert. denied*, 282 U.S. 902 (1931): "We cannot approve the length of the record, which was due chiefly to the use of expert witnesses. Argument is argument whether in the box or at the bar, and its proper place is the last."

92. "That these pictures had their worth and their success is sufficiently shown by the desire to reproduce them without regard to the plaintiffs' rights." *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. at 252; *Italian Book Co. v. Rossi*, 27 F.2d 1014 (S.D.N.Y.

pirated another's work should not be able to assert as a defense that the work was worthless. This reasoning is especially compelling in the case of willful infringement for profit. Although an innocent infringer⁹³ might have reasonably believed that the work copied was too trivial to be copyrighted, the willful infringer knows that the author has claimed a copyright, and has chosen to disregard that claim. If the willful infringer truly believed the work to be worthless, then he or she would have believed it possible to recreate the work without any appreciable effort, and should have done so rather than ignore another's claim of right. The claim of insufficient merit is usually raised by such an infringer as an afterthought after an action has been brought. Courts may properly refuse to hear such a specious defense, which would shorten many trials.

Although a uniformly low standard of intrinsic merit might lead to a proliferation of copyrights, it need only be pointed out that the protection of a copyright extends no further than the author's original contribution.⁹⁴ If some derive pleasure from affixing a copyright symbol to their every opusculum, there is really no harm done. If an underlying work is in the public domain, the author acquires no exclusive right to it; the author still must obtain a license for the use of underlying copyrighted material.⁹⁵ As reasoned earlier, a truly insignificant contribution may easily be independently recreated.

In the case of a map, the courts should uphold the validity of a copyright to an original map that is the product of *any* useful work, either in compilation and synthesis, or in the presentation of new information.⁹⁶

1928); *Henderson v. Tompkins*, 60 F. 758, 765 (C.C.D. Mass. 1894); *Ziegelheim v. Flohr*, 119 F. Supp. 324, 328 (S.D.N.Y. 1954).

93. An innocent infringer is one without notice or other reason to believe the work copied was copyrighted. See 17 U.S.C. § 504(c)(2) (1976).

94. *E.g.*, *American Code Co. v. Bensinger*, 282 F. 829, 834 (2d Cir. 1922).

95. "[T]he publication of any such new works shall not affect the force or validity of any subsisting copyright upon the matter employed or any part thereof, or be construed to imply an exclusive right to such use of the original works . . ." Copyright Act of 1909, 17 U.S.C. § 7 (1973) (current version at 17 U.S.C. § 103 (Supp. I 1976)).

96. "He, in short who by his own skill, judgment and labor, writes a new work, and does not merely copy that of another, is entitled to a copyright therein; if the variations are not merely formal and shadowy, from existing works." *Emerson v. Davies*, 8 F. Cas. 615, 619 (C.C.D. Mass. 1845) (No. 4,436) (Story, J.).

E. CONCLUSION

By refusing to follow the direct-observation rule in *Hamilton*, the Ninth Circuit took a significant step towards correcting the unjustifiably harsh standard of originality that has been applied to maps. The court's reasoning supports the conclusion that maps should be held to the same minimal standard of intrinsic merit that leading cases have established for other classes of copyrightable works. This is the standard that the *Hamilton* court intended, despite some ambiguous language in the holding. Such ambiguity may be avoided in the future by separate analysis of the questions of original authorship and intrinsic merit. This bifurcated approach, combined with a uniformly low standard of merit, will result in easier administration of the law, while maintaining a just and viable system of copyright.

Howard Klepper*

III. PRELIMINARY COPIES: ACTIONABLE INFRINGEMENT

A. INTRODUCTION

In *Walker v. University Books, Inc.*,¹ the Ninth Circuit, addressing a question of first impression, held that blueprints of a final product protected by copyright are "infringing" copies under the 1909 Copyright Act (the Act).²

The plaintiff in *Walker* had copyrighted and published a set of seventy-two "I Ching Cards."³ The cards were designed to aid in the use of the fortune-telling system described in the *I Ching*, a work in the public domain.⁴ In response to defendant University Books' interest in distributing her cards, plaintiff sent the defendant a sample deck. The defendant then proceeded to produce and distribute its own set of cards, based on plaintiff's cards,

* Second Year Student, Boalt Hall.

1. 602 F.2d 859 (9th Cir. Sept., 1979) (per Curtis, D.J., sitting by designation; the other panel members were Browning and Wallace, JJ.).

2. *Id.* at 864.

3. The validity of the copyright was not at issue. *Id.* at 861.

4. Plaintiff's cards were based on the James Legge translation of the *I Ching* (*Book of Changes*), a Chinese text on divination. The cards were illustrated with English and Chinese words and figures and with instructions. *Walker v. University Books, Inc.*, 193 U.S.P.Q. 596, 599 (N.D. Cal. 1977).

without plaintiff's authorization.⁵

The blueprints were prepared by the defendant as proofs of the art work to appear on the finished set of cards.⁶ The issue of whether they constituted infringing copies arose because by the time the defendant had produced and manufactured the finished set of cards, the plaintiff no longer held the copyright.⁷

In awarding summary judgment to the defendant, the district court held that the blueprints did not constitute infringing copies and that the plaintiff was not entitled to damages because "[a] copy is a *tangible reproduction* of a work not a mere blueprint preliminary to production."⁸ The Ninth Circuit held this conclusion in error and reversed the grant of summary judgment.⁹

5. Plaintiff also brought suit against Noble Offset Printers, Inc. and Felix Morrow for unfair competition. She alleged that they misappropriated trade secrets by disclosing to defendant University Books her suggested improvements for the cards, which she had discussed with them in confidence. The court affirmed the lower court's grant of summary judgment to defendants on the trade secrets claim on the basis that the improvements did not constitute trade secrets. 602 F.2d at 865.

6. Plaintiff learned of defendant's intention to infringe on her copyright when she obtained an advertising flyer, put out by University Books' distributor, which announced the upcoming publication of "I Ching Cards" based on the James Legge translation of the *I Ching*. Her attorney wrote to the distributor and warned that the announced publication would infringe on plaintiff's copyright. The distributor replied by letter on March 8, 1972, denying the infringement and attaching copies of the blueprints, apparently to demonstrate how different defendant's version of the cards was. *Id.* at 861.

7. Plaintiff's original suit included claims for unfair competition and for defendant's sales and distribution of their version of the cards. The unfair competition claim was dismissed. *See* note 5 *supra*. The claim based on defendant's sales and distribution was also dismissed because plaintiff had no standing to sue. Plaintiff assigned the copyright on March 2, 1972. The assignee subsequently forfeited the copyright through failure to affix the copyright notice. University Books did not begin to sell and distribute its version of the cards until May, 1972, three months after the assignment. The court held that plaintiff lacked standing to sue once she lost ownership of the copyright through assignment. 602 F.2d at 862. The blueprints, which plaintiff received on March 8 and which arguably existed prior to March 2, thus constituted the only infringement for which plaintiff had standing to sue.

8. 193 U.S.P.Q. at 602 (emphasis added).

9. 602 F.2d at 863, 864. The court was careful to limit its holding: "Our holding is thus limited in scope and we reverse the district court only as to this proposition [that the blueprints could not, as a matter of law, constitute infringing copies] upon which the grant of summary judgment as to infringement prior to March 2, 1972 was based." *Id.* Thus, at trial plaintiff would still have to show that the blueprints had in fact existed before March 2, *see* note 7 *supra*, and that the defendant's cards were substantially similar to her work in order to present a *prima facie* case of infringement. The defendant had conceded the other necessary element, access to the protected work. *Id.* at 864.

B. WHAT CONSTITUTES AN INFRINGING COPY

The Ninth Circuit correctly rejected the district court's cursory analysis of the blueprint issue. The district court casually disposed of the issue by declaring: "Plaintiff has cited no authority, nor is the Court aware of any, which holds that the existence of plans, preparations or blueprints of a final product constitutes copying which would give rise to liability for damages."¹⁰ The Ninth Circuit held that this analysis gave unwarranted weight to the stage of production toward a final, infringing product. The district court assumed that until the infringers completed production, no copying could take place as a matter of law.

Acknowledging that the issue of whether preparatory copies could constitute infringing copies had never been decided in previous cases,¹¹ the Ninth Circuit rejected the district court's holding. In its own examination of the issue, the Ninth Circuit correctly applied traditional copyright principles. The court noted first that the district court's analysis ignored the fact that a blueprint is itself a tangible and perceivable expression. A blueprint, therefore, qualifies as a copy of the protected work, since a copy need only "consist of some tangible material object upon which the work is 'fixed'"¹² and that "in some manner, take[s] on the

10. 193 U.S.P.Q. at 602.

11. 602 F.2d at 863.

12. *Id.* The court cited *C.M. Paula Co. v. Logan*, 355 F. Supp. 189 (N.D. Tex. 1973) for this proposition, but that case is inapposite. The court also cited 2 M. NIMMER ON COPYRIGHT, § 8.02 (b) (1979). Professor Nimmer used *C.M. Paula* to illustrate his contention that the current Act's definition of "copy" as the embodiment of the work in a material object, *see* note 13 *infra*, is a continuation of earlier case law. In the three cases that Professor Nimmer cites—*C.M. Paula Co. v. Logan*, 355 F. Supp. 189 (N.D. Tex. 1973); *Blazon, Inc. v. Deluxe Game Corp.*, 268 F. Supp. 416 (S.D.N.Y. 1965); *Smith v. Paul*, 174 Cal. App. 2d 744, 345 P.2d 546 (1959)—the courts focused on whether a defendant who utilizes a purchased copy of plaintiff's work in his own product thereby infringes. The real issue presented was not whether the work was embodied in a tangible object but whether the defendant copied or reproduced that work.

In *C.M. Paula*, for example, the defendant affixed the design from plaintiff's copyrighted stationery onto his own ceramic plaques. The court held that he had not thereby infringed because he had not copied plaintiff's work. 355 F. Supp. at 191. In *Blazon*, the court held that a defendant who displayed plaintiff's hobbyhorse did not thereby copy the hobbyhorse. 268 F. Supp. at 420. These holdings depend in part on the fact that "[t]o print, reprint, publish and copy are continuing rights throughout the life of the copyright, but the right to transfer or vend . . . is exhausted as to particular copies once the proprietor has disposed of them unrestrictedly at his own price. . . ." H. HOWELL, *THE COPYRIGHT LAW* 120 (3d ed. 1952).

The *Walker* court only cited *C.M. Paula*, and of the three cases it is the only one that does not address the "material object" requirement at issue in *Walker*. The court in *Smith v. Paul*, on the other hand, noted that "the noun 'copy' ordinarily and as used in the

physical aspects of the protected work such that the 'copy' of that work may be perceived by an observer."¹³

The court focused on two basic principles of copyright law. First, there is no requirement that a copy be expressed in the same medium as the original work to be an infringement of that work.¹⁴ Thus a motion picture may infringe on the play upon which it is based,¹⁵ or a three-dimensional ornament may infringe upon a two-dimensional illustration of that ornament.¹⁶

The different-medium principle has previously been applied only in cases where the copy was the final product rather than a preliminary step.¹⁷ This application, however, does not limit the principle to final-product copies only. As the court noted, "the question is not whether the Appellees utilized the blueprints as merely a step in the manufacture of their cards but whether they unauthorizedly utilized Appellant's work in the manufacture of their blueprints."¹⁸ Thus, regardless of the final use to which the preliminary copy is to be put, it can constitute a per se infringing copy.

The second principle is also a traditional one: there is no requirement that the copy be sold for profit to give rise to damages for infringement.¹⁹ The Act specifies statutory "in lieu" dam-

copyright cases signifies a tangible object that is a reproduction of the original work," 174 Cal. App.2d at 755-56, 345 P.2d at 553, and the court in *Blazon* based its holding in part on the fact that "insofar as the right to copy is concerned, there is no 'tangible object that is a reproduction of the original work'; in fact there has been no reproduction whatsoever." 268 F. Supp. at 434 (citation omitted). Either of these cases would have been better authority for the court's proposition in *Walker* than *C.M. Paula*.

13. 602 F.2d at 864. The holding and analysis of the court would not be changed by the new Copyright Act, effective January 1, 1978. The old Act did not define "copies." See *Manes Fabric Co. v. Celebrity Inc.*, 246 F. Supp. 975 (S.D.N.Y. 1965). According to Professor Nimmer, the definition of "copies" given in the new Act merely codifies existing judicial interpretation, see note 12 *supra*. The new Act defines "copies" as follows: "'Copies' are material objects, other than phonorecords, in which a work is fixed by a method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device." 17 U.S.C. § 101 app. (1977).

14. 602 F.2d at 864.

15. 2 M. NIMMER, *supra* note 12, at § 8.01 (B).

16. *Walco Products, Inc. v. Kittay & Blitz, Inc.*, 354 F. Supp. 121 (S.D.N.Y. 1972).

17. Both the district court, 193 U.S.P.Q. at 602, and the Ninth Circuit, 602 F.2d at 863, recognized that there exist no previous cases establishing that a preliminary copy constitutes an infringing copy. As to the different-medium principle, see generally 2 NIMMER, *supra* note 12, at § 8.01 (B); H. HOWELL, *supra* note 12, at 121-22.

18. 602 F.2d at 864.

19. *Id.*

ages for cases in which the infringement does not give rise to actual damages.²⁰ Thus, the fact that the defendant in *Walker* did not sell the blueprints—but only used them to produce cards which they did sell—did not defeat a claim for damages based on the blueprints alone.

20. The specific provision in the 1909 Act is 17 U.S.C. § 101 (b) app. (1970), which reads in pertinent part:

If any person shall infringe the copyright in any work protected under the copyright laws of the United States such person shall be liable:

. . . .
(b) Damages and profits; amount; other remedies

To pay to the copyright proprietor such damages as the copyright proprietor may have suffered due to the infringement, as well as all the profits which the infringer shall have made from such infringement . . . or in lieu of actual damages and profits, such damages as to the court shall appear to be just . . . and such damages shall in no other case exceed the sum of \$5,000 nor be less than the sum of \$250, and shall not be regarded as a penalty.

The new Act contains a similar provision at 17 U.S.C. § 504 (1977), which provides in pertinent part:

(a) In general

Except as otherwise provided by this title, an infringer of copyright is liable for either—

(1) the copyright owner's actual damages and any additional profits of the infringer, as provided by subsection (b); or

(2) statutory damages, as provided by subsection

(c).

. . . .
(c) Statutory damages

(1) Except as provided by clause (2) of this subsection, the copyright owner may elect, at any time before final judgment is rendered, to recover, instead of actual damages and profits, an award of statutory damages for all infringements involved in the action, with respect to any one work, for which any two or more infringers are liable jointly and severally, in a sum of not less than \$250 or more than \$10,000 as the court considers just.

These provisions reflect the policy behind the statutes: In *Hedeman Products Corp. v. Tap-Rite Products Corp.*, 228 F. Supp. 630 (D.N.J. 1964), the court stated:

The statute is designed not only to take away an infringer's profits and to remedy the injury to the copyright proprietor, but also to discourage such infringement even if it is noninjurious or unprofitable The "in lieu of actual damages" provision may be applicable where there is no showing as to any actual loss . . . when proof of damage is difficult or impossible . . . or where, even if some damages have been proven, the trial court, in its discretion, determines it would be "more just" to allow a recovery based on the statutory formula.

Id. at 635 (citations omitted).

C. INJUNCTIVE RELIEF FOR PREPARATORY INFRINGEMENT

The decision in *Walker* has important implications for copyright holders who have proof of infringement before wide-scale marketing by the infringer has begun. In most cases, actions are initiated after the damage has been done—after the infringer has produced and distributed the copies and has consequently cut into plaintiff's potential market.²¹ Under *Walker*, a copyright holder can sue at an earlier stage.

The reason for such a suit would not be the collection of damages, since recovery would be limited to statutory minimum damages²² in most cases, but for the issuance of a preliminary injunction. In a suit for preparatory infringement, the copyright holder must make a prima facie case for infringement.²³ That is, the plaintiff must show: (1) that he or she is the owner of a valid copyright;²⁴ (2) that the defendant had access to the protected work;²⁵ (3) that there exists a substantial similarity between the protected work and the preliminary copy;²⁶ and (4) that the preliminary copy is sufficiently tangible, perceivable, and permanent to qualify as a "fixed" object.²⁷ In *Walker* the fourth requirement was met by blueprints; in other cases it might be met by page proofs, sketches, mock-up designs, or molds.

If the plaintiff makes this prima facie showing, he or she will

21. Since most actions are initiated after damage has occurred, *Walker* illustrates the court's acknowledgement that preparatory copies, like the blueprints in *Walker*, constitute infringing copies. 602 F.2d at 863.

22. The minimum statutory damages under both the old and new Acts are \$250. See note 20 *supra*. The *Walker* district court noted that "[m]ere copying without resulting gain or profit on the part of defendant or specific damage on the part of defendant would probably result in a minimum damage award of \$250. . . ." 193 U.S.P.Q. at 602 n.4.

23. *Wainwright Sec. Inc. v. Wall St. Transcript Corp.*, 558 F.2d 91, 94 (2d Cir. 1977), *cert. denied*, 434 U.S. 1014 (1978). The requirement is sometimes described as being a burden on the plaintiff to show "a reasonable probability of prevailing on the merits." *Greeff Fabrics Inc. v. Malden Mills Indus.*, 412 F. Supp. 160, 162 (S.D.N.Y. 1976), *aff'd* 556 F.2d 556 (2d Cir. 1976), *quoting* *Concord Fabrics, Inc. v. Marcus Bros. Textile Corp.*, 409 F.2d 1315, 1317 (2d Cir. 1969) (*per curiam*). See generally Latman, *Preliminary Injunctions in Patent, Trademark, and Copyright Cases*, 60 TRADEMARK REP. 506 (1970).

24. *Walker v. Univ. Books, Inc.*, 193 U.S.P.Q. at 601. See also *Greeff Fabrics Inc. v. Malden Mills Indus.*, 412 F. Supp. at 162.

25. 602 F.2d at 864.

26. *Id.*

27. *Id.* A mere plan to copy, short of an embodiment of the plaintiff's work in a tangible object, is not an actionable infringement. Thus, for example, an in-house memorandum outlining a company plan to infringe does not, of itself, constitute copying for the purposes of copyright infringement.

generally obtain a preliminary injunction.²⁸ If the plaintiff prevails on the merits in the subsequent trial for statutory damages, he or she will generally also secure a permanent injunction against the infringers.²⁹ Such a result would preserve the market for the copyright holder's own distribution and sales of his or her own work.

There are two potential obstacles to bringing an action for injunctive relief. First, evidence of preliminary copies may not always be so easy to discover as it was in *Walker*.³⁰ Second, the preliminary copy may not pass the "substantial similarity" test³¹ as easily as a finished copy would. Nonetheless, where a copyright holder is able to obtain evidence of infringement, the ruling in

28. See note 23 *supra*.

29. Under the old Act, preliminary and permanent injunctions against infringers were provided for under 17 U.S.C. § 101 (a) and § 112 (1970). Section 112 provides in pertinent part that the "court . . . shall have power, upon complaint filed by any party aggrieved, to grant injunctions to prevent and restrain the violation of any right secured by this title, according to the course and principles of courts of equity, on such terms as said court or judge may deem reasonable."

The new Act, 17 U.S.C. § 502 (a) app. (1977), the statute provides in pertinent part: "Any court having jurisdiction of a civil action arising under this title may . . . grant temporary and final injunctions on such terms as it may deem reasonable to prevent or restrain infringement of a copyright." See generally Strauss, *Remedies Other Than Damages for Copyright Infringement*, in GENERAL REVISION OF THE COPYRIGHT LAW REVISION STUDY (1959).

30. See notes 6 and 7 *supra*.

31. In order to constitute an infringement of the copyright holder's right to copy or reproduce the protected work, the copy must be substantially similar to the protected work. The *Walker* court noted that where the defendant's access to the plaintiff's work is uncontroverted, as it was in *Walker*, "proof of actual copying . . . is often attained by a demonstration . . . [that] the similarity between the two works is such that no explanation other than copying is reasonable plausible." 602 F.2d at 864.

One commentator states:

[T]he determination of the extent of similarity which will constitute a substantial and hence infringing similarity presents one of the most difficult questions in copyright law, and one which is the least susceptible of helpful generalizations. It is clear that slight or trivial similarities are not substantial and are therefore non-infringing. But it is equally clear that two works may not be literally identical and yet be found substantially similar for purposes of copyright infringement. The problem, then, is one of line drawing. Somewhere between the one extreme of no similarity and the other of complete and literal similarity lies the line marking off the boundaries of "substantial similarity."

3 M. NIMMER, *supra* note 12, at § 13.03 (A) (citations omitted). For a discussion of elements to be considered in the determination of substantial similarity, see generally, 3 M. NIMMER, *supra* note 12, at § 13.03 (A)-(E).

Walker supports an action before real damage to plaintiff has been done.

D. CONCLUSION

In holding that an unauthorized copy of a protected work is not disqualified as an infringing copy solely because it is a preliminary or preparatory copy, the Ninth Circuit in *Walker v. University Books, Inc.*, correctly applied traditional copyright theory by allowing those who have evidence of preliminary copying to obtain injunctive relief before the infringer has invaded their potential market.

Paige L. Wickland