The Five *W*'s of Merger

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Just to start things off, I'm a big student of the nineteenth century. I love the 1800s, I write about them,[1] and I think about them a lot. There are a lot of questions in modern copyright law where we look back, and we spend time thinking about what was going on in the 1800s and opinions from the 1800s. And so when we came up with this idea to talk about the scope of copyright, I went back to the cases from the 1800s, and the Supreme Court has told us a lot about what is copyrightable and what is not from a perspective of merger—from a perspective of protecting laws or not.

If you look at *Perris v. Hexamer*, which was from 1879, the Court had before it two maps of New York City, delineated with colors and characters, and containing reference keys.[2] And although the defendant's map originally was very similar to the plaintiff's map, they changed it in a number of ways. But fundamentally they are pictures of New York City, and they have certain similar markings on the map. The Supreme Court told us that there was no infringement in that case, because the plaintiffs did not have "the exclusive right to use the form of the characters they employ to express their ideas upon the face of the map" because "[s]carcely any map is published on which certain arbitrary signs, explained by a key printed at some convenient place for reference, are not used to designate objects of special interest."[3]

Scènes à faire? Maybe.

In *Baker v. Selden*, the Court famously considered the book *Selden's Condensed Ledger, or Book-keeping Simplified*, and specifically its annex of forms "consisting of ruled lines, and headings, illustrating the system and showing how it [would] be used and carried out in practice."[4] No one questions that the book was copyrightable. Instead, the issue decided by the Court was whether the defendant's version was an

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1. *See* Joshua L. Simmons, *Inventions Made For Hire*, 2 N.Y.U. J. INTELL. PROP. & ENT. L. 1 (2012); Joshua L. Simmons, *On the Road to a Modern Copyright System*, LANDSLIDE, Mar./Apr. 2019, at 5; Joshua L. Simmons, *The Next Great Copyright Office*, LANDSLIDE, July/Aug. 2015, at 22.
2. Perris v. Hexamer, 99 U.S. 674 (1878).
3. *Id.* at 676.
4. Baker v. Selden, 101 U.S. 99, 100 (1879).

infringement of those forms given that, according to the Court, it "use[d] a similar plan so far as results are concerned; but ma[de] a different arrangement of the columns, and use[d] different headings."[5]

Critically, the Court viewed the case as concerning whether the defendant "uses the same system as that which is explained and illustrated in" the plaintiff's books and whether "in obtaining the copyright of his books," the copyright extended to the system. Presaging what would become Section 102(b) of the 1976 Act,[6] the Court held that the plaintiff's copyrights in the book did not extend to the bookkeeping system. The Court then pressed further, holding that if the idea of the plaintiff's system could only be achieved by using "methods and diagrams" from the book because they were "necessary incidents to the" system, then they too would not be protectable.[7] That kernel became what is commonly known as the merger doctrine. But, as Professor Pamela Samuelson points out,[8] the concept of merger did not enter the lexicon of copyright until the *Apple v. Franklin* case in 1982.[9] So we went 100 years without identifying this as merger.

Now, with *Baker* as a backdrop, I want to talk about five fundamental questions about merger.

WHO? AND WHEN?

First, from whose perspective—the copyright owner or the alleged infringer—and second, at what point in time—the creation of the work or the alleged infringement—is merger assessed? And this is partially what Joe Gratz started with.[10]

Given that merger turns on what is protectable about the copyright holder's work, many take the position that the Copyright Act only makes sense if merger is determined from the perspective of the copyright holder at the time the work is created. Section 102 states that "[c]opyright protection subsists . . . in original works of authorship" at the moment of fixation.[11] Section 302(a) goes on to say that "[c]opyright . . . subsists from [the moment of] creation" until the term ends.[12] Likewise, the Copyright Office determines registrability (including copyrightability) at one point in time, not successively based on changing circumstances over the years. Thus, litigants have argued that the statute makes no accommodation for the idea that copyright protection would somehow change over time.

Baker is consistent with this perspective, as the Court considered whether the annexes to Selden's book were necessarily incident to the unprotectable system when

5. *Id.*
6. 17 U.S.C. § 102 (2020).
7. *Baker*, 101 U.S. at 103.
8. Pamela Samuelson, *Reconceptualizing Copyright's Merger Doctrine*, 63 J. COPYRIGHT SOC. 417, 419–20 (2016) (article provided in Symposium materials).
9. Apple Computer, Inc. v. Franklin Computer Corp., 714 F.2d 1240 (3d Cir. 1983).
10. *See generally* Joseph Gratz, *Merger as a Matter of Extrinsic Constraints*, 43 COLUM. J.L. & ARTS 403 (2020).
11. 17 U.S.C. § 102(a) (2020).
12. 17 U.S.C. § 302 (2020).

Selden created it.[13] Likewise, the Federal Circuit in *Oracle v. Google* concluded that merger could not turn on whether Google had other options available to it in copying the declaring code of Oracle's Java platform.[14] Instead, the question must be what options were available at the time the code was created.

Now, some commentators argue the opposite, as Google attempted to do in *Oracle*: that merger can be determined based on the constraints placed on the alleged infringer, and that this is an important feature because it ensures that "the first author who expressed that idea is not the only one who has the right to create works on that same idea."[15] Now, first and foremost, we have a concept called independent creation.[16] It is a complete defense to infringement: If you did not copy the work, you can create the exact same work. It does not have to be a variation; it can be the exact same thing, as long as you're not copying from the original creator.

Let's leave that aside for a second. The cases that those commentators cite do not actually appear to support the proposition that you can consider merger from the point of view of the defendant. For example, *ATC v. Whatever it Takes* involved a taxonomy of transmission parts and whether they were protectable.[17] The Sixth Circuit relied on the merger doctrine in considering the interplay between the claimed bases of creativity in the part numbers and the choices available to the copyright holder. It wrote:

> For almost all of the types of creativity claimed by ATC, there is only one reasonable way to express the underlying idea. For example, the only way to express the prediction that a maximum of four additional types of sealing ring might be developed is to leave four numbers unallocated, and the only way to express the idea that a novel part should be placed with the sealing rings rather than with the gaskets is to place that part with the sealing rings.[18]

Now, I know you are all really up on your part numbers, so that all made sense to you, but the bottom line is that the thing they were saying was creative, the court said you could only express in one way, so it was merged.

Similarly, in *New York Mercantile Exchange v. IntercontinentalExchange*, the Second Circuit considered settlement prices related to stock exchanges, and it adopted the district court's idea—"the price of a particular futures contract at the close of trading"—but found the record did not demonstrate "a range of possible variations" that NYMEX could have selected.[19] (And we'll come back to the question of what did the evidence show in the case, because as a litigator, *whose*

13. Baker v. Selden, 101 U.S. 99, 103 (1879).

14. Oracle Am., Inc. v. Google Inc., 750 F.3d 1339 (Fed. Cir. 2014).

15. Samuelson, *supra* note 8, at 443.

16. "Proof of copying by the defendant is necessary because independent creation is a complete defense to copyright infringement. No matter how similar the plaintiff's and the defendant's works are, if the defendant created his independently, without knowledge of or exposure to the plaintiff's work, the defendant is not liable for infringement." Rentmeester v. Nike, Inc., 883 F.3d 1111, 1117 (9th Cir. 2018) (citing Feist Pubs., Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 345–46 (1991)).

17. ATC Distribution Grp., Inc. v. Whatever It Takes Transmissions & Parts, Inc., 402 F.3d 700 (6th Cir. 2005).

18. *Id.* at 707.

19. N.Y. Mercantile Exch., Inc. v. IntercontinentalExchange, Inc., 497 F.3d 109 (2d Cir. 2007).

burden it is to produce that evidence is a critical factor.)

Thus, even those cases appear to comport with the idea that merger be considered based on the copyright holder's choices at the time of the work's creation. And you can litigate these cases and say, at another point in time, "hey, by the way, they were constrained when the work was created," but you do not litigate at the point of creation, you litigate years later.[20] The point is you can find evidence that supports what were those constraints at the time.

WHERE?

Third question: Where in the copyright infringement analysis should merger be considered? Courts and commentators have suggested that the debate is binary: merger should be considered either at the point of determining copyrightability or at the point of infringement. The search for a bright-line rule, however, may ignore an important subtlety.

In most cases, the work as a whole easily will satisfy the Supreme Court's test for copyright protection as set forth in *Feist*,[21] and as we discussed this morning, a "modicum of creativity" is not so hard. And so, in those cases, the idea of the work as a whole and its expression may not have merged.

Yet, if the basis for the infringement is less than the totality of the work, it is possible that the idea and expression would merge and be filtered out in the substantial similarity analysis as part of determining infringement. That is the approach adopted by the Second Circuit in cases like *Kregos v. Associated Press*, which found no merger, as the idea that baseball "statistics can be used to assess pitching performance" could be expressed in various ways, including the elements copied from the plaintiff's particular form.[22] The Ninth Circuit adopted the same view in *Ets-Hokin v. Skyy Spirits*, which is the case about the vodka bottle photograph.[23] And the *Nimmer on Copyright* treatise has referred to this as the better view.[24]

The cases to which commentators point for the proposition that merger can be determined as a matter of copyrightability generally involve works of such low originality that a finding of merger as to the allegedly infringed element is coterminous with a holding that the work is not copyrightable as a whole. In other

20. "[W]hen specific instructions, even though previously copyrighted, are the only and essential means of accomplishing a given task, their later use by another will not amount to an infringement." Nat'l Comm'n on New Tech. Uses of Copyrighted Works (CONTU), *Final Report of the National Commission on New Technological Uses of Copyrighted Works*, 3 COMPUTER L.J. 53, (1981). In other words, when determining whether a later work constitutes an infringement of specific software instructions, courts consider whether those instructions were the only way to accomplish the functionality achieved by the instruction when they were created.

21. *Feist*, 499 U.S. at 346.

22. Kregos v. Associated Press, 937 F.2d 700, 707 (2d Cir. 1991) ("Our Circuit has considered this so-called 'merger' doctrine in determining whether actionable infringement has occurred, rather than whether a copyright is valid . . . .").

23. Ets-Hokin v. Skyy Spirits, Inc., 225 F.3d 1068, 1082 (9th Cir. 2000).

24. 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT, § 13.03[B][3] (Matthew Bender, rev. ed.).

words, if the basis for copyrightability and what was allegedly infringed are the same, finding that what was infringed is not protectable is the same as finding the work is not copyrightable.

So, to give you an example, there is a case called *Kern River v. Coastal*;[25] it is often cited for the proposition that you can decide this issue as a matter of copyrightability. But the works that were at issue there were "quad maps," which the court described as showing "the proposed route of a natural gas pipeline" that "consisted of lines and mile markings drawn by Kern River on topographical maps published by the United States Geological Survey."[26] In other words, the plaintiff did not create the maps; what it created were markings on the map where this pipeline was going to go. And so, the Fifth Circuit held that "the idea of the location of the pipeline and its expression embodied in the . . . maps are inseparable and not subject to protection."[27]

The Sixth Circuit acknowledged this concept in *Lexmark*,[28] the case that Joe mentioned earlier,[29] when it noted that "When a work itself constitutes merely an idea . . . or when any discernible expression is inseparable from the idea itself . . . copyright protection does not extend to the work."[30] Similarly, the Copyright Office *Compendium* indicates that the Office will "communicate with the applicant or may refuse to register [a] claim" if protecting "the author's expression would effectively afford protection to the idea . . . itself."[31]

Now, why does this matter? This matters because, generally, plaintiff copyright holders have the burden of proving copyrightability, and the defendant, the alleged infringer, has the burden of proving affirmative defenses.[32] So, whomever you place that burden on, if there is a failure of proof, then that is the party that is going to lose the case. And as I discussed, in the *NYMEX* case, that is in fact what the court said—that is why they lost.[33]

WHAT?

Now, fourth: What is being merged? The most commonly discussed form of merger is between, on the one hand, ideas (and the synonyms for ideas in Section

25. Kern River Gas Transmission Co. v. Coastal Corp., 899 F.2d 1458 (5th Cir. 1990).
26. *Id.* at 1460.
27. *Id.* at 1463–64.
28. Lexmark Int'l, Inc. v. Static Control Components, Inc., 387 F.3d 522 (6th Cir. 2004).
29. *See* Gratz, *supra* note 10, at 405.
30. *Lexmark*, 387 F.3d at 538.
31. U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 313.3(B) (3d ed. 2017).
32. Oracle Am., Inc. v. Google Inc., 750 F.3d 1339, 1358 (Fed. Cir. 2014) ("In the Ninth Circuit, while questions regarding originality are considered questions of copyrightability, concepts of merger and scenes a faire are affirmative defenses to claims of infringement." (citing Ets-Hokin v. Skyy Spirits, Inc., 225 F.3d 1068, 1082 (9th Cir. 2000); Satava v. Lowry, 323 F.3d 805, 810 n.3 (9th Cir. 2003)).
33. N.Y. Mercantile Exch., Inc. v. IntercontinentalExchange, Inc., 497 F.3d 109, 118 (2d Cir. 2007) ("While NYMEX contends that there are 'numerous possible variations . . . as to what the Settlement Prices should be,' it has not demonstrated a range of possible variations that would preclude application of the merger doctrine.").

102(b)), and, on the other hand, expression. But, as Joe mentioned, we have this concept of laws that merge.

The Supreme Court in 1834 decided *Wheaton v. Peters*, which gave us the "edicts of government" doctrine.[34] It was the idea that none of the reporters could own the copyright in what the judges were saying; that's not protectable. And half a century later, in twin cases, you had the Court wrestling with this again. In *Bates v. Manchester*, the Court actually comes out and says, not as a matter of scènes à faire, not as a matter of merger, but purely as a matter of public policy, copyrights should not be secured in "labor done by judicial officers in the discharge of their judicial duties."[35] Now, because that was such a public-policy-focused argument, in the case decided at the same time, *Callaghan v. Myers*—where the reporter had added some additional material and there was this compilation—the Court said the "parts of the book" that the reporter authored he could own as a matter of public policy.[36]

There is a case—*Veeck v. Southern Building Code*—which is in this line of cases that Joe's talking about, that deals with the concept of building codes and things getting adopted by governments.[37] But that case was really decided on the basis of this public policy approach—a feeling that you should not own the law. And it had this alternate holding that was that "laws are 'facts,'" and so used a merger-like doctrine and said the text required to convey the fact of what the law is must have merged with it.[38] But that decision is completely inconsistent with the Supreme Court's approach to this issue, and the subsequent cases involving merger. We'll see whether the Supreme Court picks that up in the *Georgia* case,[39] but I do not think the litigants have focused on that so much as the question of whether law is just unprotectable on its own, which resolves this difficulty of "this has become the law; I need to cite to it."

WHY?

We have considered the who, the when, the what, and the where of merger. Let me leave you with a few thoughts on the why.

The Third Circuit, which originated the merger term, explained in *Educational Testing v. Katzman* that merger exists "to prevent creation of a monopoly on the underlying 'art'."[40] In other words, merger is intended to protect the idea-expression dichotomy and allow new creators to come up with new expression for unprotectable ideas. That is why, in *Apple v. Franklin*, the court focused on whether there were other ways to express the plaintiff's idea—in that case, it was mostly translating source code to object code and whether you had a protection in operating the system.[41] And if there are other ways to do it, we do not need merger. We do not

34. Wheaton v. Peters, 33 U.S. 591 (1834).
35. Banks v. Manchester, 128 U.S. 244, 253 (1888).
36. Callaghan v. Myers, 128 U.S. 617, 650 (1888).
37. Veeck v. S. Bldg. Code Cong. Int'l, Inc., 293 F.3d 791 (5th Cir. 2002).
38. *Id.* at 801.
39. Georgia v. Public.Resource.Org, No. 18-1150 (U.S. argued Dec. 2, 2019).
40. Educ. Testing Servs. v. Katzman, 793 F.2d 533, 539 (3d Cir. 1986).
41. Apple Computer, Inc. v. Franklin Computer Corp., 714 F.2d 1240, 1253 (3d Cir. 1983).

need to protect people in this way.

Despite this, an increasing number of defendants have attempted to argue that, even if there were multiple ways for a copyright holder to express an idea when her work was created, merger nonetheless should apply when the defendant feels her choices were constrained. That proposition is inconsistent with the Third Circuit's holding in *Apple* that it does not matter if there were a limited number of ways for the defendant to use the plaintiff's work. There, the defendant argued that there were a "limited 'number of ways to arrange operating systems to enable a computer to run the vast body of Apple-compatible software.'"[42] The court rejected that idea, saying it "is a commercial and competitive objective which does not enter into the somewhat metaphysical issue of whether particular ideas and expressions have merged."[43]

Merger is an important concept with a critical role in copyright law, but for the copyright system to operate properly we must understand its purposes and its history. Thank you.

42. *Id.*
43. *Id.*