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Preliminary Comments on Restatement of Copyright, draft 2

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Preliminary Comments on Restatement of Copyright, draft 2

Jane Ginsburg and June Besek¹

Thank you for the opportunity to comment on Preliminary Draft 2 of the Restatement of Copyright. These are preliminary comments, given the short time frame provided to review the draft, and we anticipate sending further comments after we've had the opportunity to study the draft further, or as a follow-up to the Advisers' meeting and the Consultative Group meeting on November 10 and 11, 2016, respectively.

General observations:

As with the first draft, departures in the black letter from the statutory text too often yield a different (and generally copyright-narrowing) meaning, unsupported by caselaw. Paraphrasing statutes is a perilous venture. A "Restatement" of a uniform federal statute already is a questionable proposition, as many of the Advisers have previously noted; the more the "black letter" and commentary depart from the statute, the less persuasive the enterprise. Of course, there are many gaps in the statute, often intentionally left to judicial construction. As to these, an ALI synthesis can be useful, provided the synthesis appropriately recognizes and discusses caselaw authority, even where the Reporters may disagree with it. We also note the frequent redundancy between Comments and Reporters' Notes; when the Reporters are expressing their views as to preferable rules, we believe ALI tradition confines those expressed preferences to Reporters' Notes, which, unlike the Comments, do not represent ALI positions.

Before we address specific issues with the draft, three recurring problems warrant initial identification. In all three instances, the drafters seem not to have heeded the concerns of many Advisers, voiced in comments and at the 2015 Advisers Meeting. (We do not mean to suggest that the new draft is wholly unresponsive to Advisers' suggestions.) All three betoken the draft's overall approach of giving a narrow compass to copyright protection and a broad scope to limiting doctrines. This choice on the part of the Reporters does not always reflect positive law. To the extent that the Reporters are proposing that the ALI adopt a normative stance in favor of shifting the balance to a lower level of protection, this objective should be clearly articulated (it should not be the work of the Advisers to smoke out these shifts) and should be thoroughly debated by the Advisers and the Council.

¹ Jane Ginsburg is an Adviser to the Restatement Project. June Besek is a liaison from the ABA Section of Intellectual Property, but these comments are done in her individual capacity and not on behalf of the ABA.

- Repeated use of “obtain a copyright.” “Obtain a copyright” suggests that an author must satisfy certain declaratory or administrative requirements to get copyright protection, when one of the important advances of the 1976 Copyright Act was to ensure that copyright protection would exist as soon as an original work was fixed. As to the persistent refusal to employ the statutory term “subsists”, see specific comments to Page 1, lines 2-4, p. 2, lines 12-16 (sec. 1.01).
- Repeated use of the concept of “authorial intent to obtain copyright.” There is no requirement of authorial intention to claim copyright and these references are likely to confuse prospective users of the Restatement.
- Repeated use of the phrase/concept “long enough to allow enjoyment or exploitation of the work’s expressive content after its creation.” This phrase appears to substitute for PD 1’s much-criticized market test of fixation (though vestiges remain, see comment to pages 52-53, lines 30, 1-2). We did not see any case support for this concept, and given the state of the law, we don’t think it is appropriate to create out of whole cloth a standard for the duration of a fixation.

Specific comments:

Chapter 1

Page 1, lines 2-4, p. 2, lines 12-16 (sec. 1.01): This text continues to deviate from the statutory language in ways which shift the meaning and thrust of the statute. The persistent omission of the statutory term “subsists” is very troubling because it a fundamental departure from the statute. "Subsists" means that copyright inheres in a work that is original, etc. It is possible to work in the elements of copyrightability without denying that copyright arises upon creation and fixation of an original work of authorship. For example:

Federal copyright protection subsists in a work of authorship . . . if it is [criteria a-d].

But the actual language of the statute remains preferable. The comment says the new formulation is “true to the actual operation of the Copyright Act,” which is not completely inaccurate, but the new formulation is not at all true to the 1976 Copyright Act’s conception. This is not a lexicographical quibble. Recognizing that the property right arises out of creativity and fixation was a fundamental reorientation of US copyright law (consistent with international standards). Commentators recognize (and some deplore) this choice; it would be highly inappropriate for the ALI to pretend that choice wasn't made, by sweeping it under the rug of "qualifies for." Requirements that the work not be of the US gov't, etc. are not conditions of the same order as creativity and fixation, and lumping them together with creativity and fixation obscures the significance of "subsists." Since the actual language of sec. 102(a) was called to the drafters' attention at the first Advisers' meeting, the drafters' persistence in deviating from the words of the statute here takes on appearance of a polemical stance inappropriate to a Restatement.

Page 1, line 24 to page 2, line 6 (comment b): The statements in this comment are not inaccurate, but they are confusingly arrayed, because they jumble conditions that are intrinsic to the nature of the work (PGS works; merger) with limitations extrinsic to creativity, such as expiration of copyright term (*Little Women*). Since this section concerns qualifications that go to the nature of the work itself, the comment should distinguish extrinsic requirements, such as duration, or, for

pre-1978 works, publication with notice, from intrinsic conditions. The draft should also distinguish intrinsic conditions on the subsistence of copyright in the work as a whole, and limitations on the scope of copyright respecting particular components of the work.

Moreover, the reference to the *Morrissey* case is misleading because it is rare that an entire work will lack copyright protection due to merger; rather, most often the work as a whole will be protected, but some portions or elements may not, as later sections of the draft detail. As written, the comment gives the uninformed reader the wrong impression that entire works do not “qualify for” copyright, when this outcome is in fact very rare. It would be more useful to say that even when a work is protected by copyright, not every aspect of the work may be protected, and direct readers to later sections of the draft.

Page 3, line 15, comment c: Add an example of computer-generated work, e.g., automated translation?

Page 5, line 6: Human authorship wasn’t an issue in *CCNV v. Reid*.

Page 5, line 26, comment d: It may not be appropriate to call fixation a “formality” since a formality concerns post-creation actions taken to assert copyright. Fixation defines the existence of the work.

Page 5, line 27: Iterations of “obtain copyright” should be deleted. As discussed in the last Advisers’ meeting, copyright is not “obtained;” under the 1976 Copyright Act, it inheres in an original work of authorship that is fixed.

Page 7, lines 12-13 (sec. 1.02, comment a): “The Constitution authorizes Congress to grant exclusive rights . . .” The copyright clause authorizes Congress to “secure” exclusive rights; the words are not completely synonymous, and the choice of “grant” again betrays a particular view of copyright to the exclusion of the more nuanced conception of the Constitution and the 1976 Act.

Page 9, line 15 (comment d) “obtain protection”: better to say “qualify for protection” (for reasons expressed earlier).

Pages 10-11: discussion of pantomime and choreographic works, and exclusions of figure skating, etc. We agree that the Copyright Office’s approach is too cramped, or maybe a new category needed (e.g., French law explicitly includes “circus routines” (which it groups with choreography and pantomime: “Les oeuvres chorégraphiques, les numéros et tours de cirque, les pantomimes, dont la mise en oeuvre est fixée par écrit ou autrement ”)).

Even within the current categories, why aren’t ice skating and ice dancing choreography copyrightable? They seem entirely analogous to other choreography. Not all ice skating and ice dancing is done competitively, e.g. “Disney on Ice” (and some regular dancing is done competitively). Of course any individual dance move may not be protectable, but an original series of movements should be.

Page 12, line 3: As pointed out last time: “communicating a story” unduly narrows the universe of dramatic works.

Page 14, line 31: It should say “. . . musical or other work.”

Page 17, lines 3-7: As to the proposition that works that don't fall into a sec. 102(a) category won't qualify as a "work of authorship", it depends on how circus routines, ice dancing and other works excluded from "choreography" are treated, since these are creative and may be fixed. In general, the draft is too dismissive of the possibility that other types of works might qualify. It would be more even-handed to say claims of copyright to material falling outside the enumerated categories should be "approached with caution."

Page 17, line 15: The draft should note that certain foreign pre-1972 sound recordings are protected under federal copyright pursuant to the restoration provisions of the URAA. Also, it would be a disservice to users of this Restatement not to indicate that state law provides protection for pre-1972 sound recordings, and provide some helpful guidance re the state law protection, which seems to us the kind of description and synthesis typically done in Restatements.

Page 22, lines 3-4 and page 31, line 8: Must the recasting, transformation, modification be "in the same manner" or "comparable to" the examples in the definition of derivative work? This would be the case if one applies the principle of *ejusdem generis*, but the statutory phrase "or any other form in which a work may be recast, transformed or adapted" suggests that derivative works need not be confined to those comparable to the examples provided.

Page 23, line 2 (sec 1.03): re adding to or subtracting from prior work: what about changes of context? Would non-intervention in content but juxtaposition of prior work (or portions of it) with new matter be considered an original addition to the content?

Page 24, lines 1-5: Is the shape the only protectable aspect? What about the doll's face?

Page 24, lines 13-16: Unclear. The line between mere display and incorporation may not be obvious: side by side display, if combined in a single object, might qualify as "incorporation." See, e.g., <https://www.lensculture.com/projects/1927-newspaper-diary>

Pages 25-26: Whether the derivative work right is infringed if alleged infringing work is not an original work of authorship: The statute does NOT require originality in a derivative work, and (as emphasized last time), the Restatement should not conflate protectability (for which originality is required) with infringement. The definition of a derivative work does not say the recasting, transforming or adapting has to result in an original work of authorship. Compare the definition of a compilation, which does require originality. "A 'compilation' is a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged *in such a way that the resulting work as a whole constitutes an original work of authorship.*" (emphasis supplied). If the resulting work doesn't constitute an original work of authorship, it's not a "compilation." (Accord, PD2 page 43, Illustration 9.) No such restriction appears with respect to the definition of a derivative work; the Restatement should not interpolate one. As the comment acknowledges, "Adopting the view that originality is a required element of preparing a derivative work makes this exclusive right narrower than it would be if originality were not required." Indeed. As elsewhere, the departures from statutory language have the (intended?) result of narrowing the scope of copyright.

The comment contends that there are "few instances" in which the addition of an originality requirement would make a practical difference since the reproduction right will cover unoriginal adaptations, but maybe they are not so few, and those instances may be disproportionately pertinent to authors who grant reproduction but not derivative work rights. Moreover, what about

adaptations that lack originality for lack of sufficient human intervention, such as machine-generated translations, musical arrangements and other productions on the horizon?

The comment also suggests, p. 26, lines 12-18, without fully spelling out, that an originality requirement would protect authors' termination interests by limiting the derivative works carve-out to termination. But one can keep the originality requirement on the front end (no protection for the alleged derivative work unless it's original) without requiring it on the back end of infringement actions.

Pages 26-27, illustrations 10, 11: are these inconsistent with "new medium" transformations evoked earlier?

Page 26, lines 15-18: Delete sentence beginning "In both of these. . ." because it's meaningless without a discussion of these provisions. The comment is better placed in the context of those provisions.

Page 30, line 21: "an" should be "a"

Page 30, line 22: Omit "some"

Page 30, line 29 (and elsewhere, e.g., page 31, lines 4-5, 23) misquotes statute: the order is "recast, transformed or adapted" (not "recasts, adapts and transforms")

Page 31, lines 15-17: Yes, but one can take too much "information." E.g., *Warner Bros. v. RDR Books* case.

Page 32, line 23: what does "melded" mean in this context?

Page 33, line 38, typo: shouldn't be "F.vSupp."

Page 34, lines 12-13: The requirement that the added content must be "expressive content capable of standing on its own as a copyrightable work" again reflects the general, and highly questionable, position the draft takes that the derivative work right is not infringed unless the accused derivative work would have been copyrightable. The requirement is unduly limiting. Editorial revisions to a work, for example, may contain copyrightable authorship but be incapable of standing on their own.

Page 45, lines 1-10 (sec. 1.05): This new attempt at an extra-statutory definition of fixation is not as troublesome as the prior one, but it doesn't work. It's both under- and over-inclusive. Under-inclusive because a work can be fixed without being experienced. Over-inclusive because live streaming (allowing enjoyment) may occur without copies (other than volatile ones). Also, the definition is inconsistent with the statutory simultaneous fixation rule.

Page 45, line 17, comment a: "obtain copyright protection." Delete "obtain" substitute "qualify for."

Page 49, line 6: "to permit the expressive content of the work": the statute says "A work is 'fixed' in a tangible medium of expression when its embodiment in a copy or phonorecord, by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced,

or otherwise communicated for a period of more than transitory duration” The referent of “it” is the work, not “the expressive content of the work.” Introduction of this condition could tie judges up in knots trying to figure out what in the work is expressive content. The idea/expression inquiry comes at a later stage.

Page 49, line 10: The “enjoyment or exploitation” formulation is concerning. Where does that come from?

Page 50, illustration 2: Should clarify that the work will be protected only after completion of fixation. Simultaneous unauthorized copying of theatrical improvisation wouldn't be a violation of federal copyright law.

Page 51, lines 6-7: Copyright does not require a demonstration of “authorial intention to get federal copyright protection.” The formulation, moreover, harks back to the role of formalities, but formalities are no longer a condition of the existence of copyright.

Page 52, lines 27-28: “lasts long enough to allow the enjoyment or exploitation of the work’s expressive content after the embodiment’s creation.” This is not what the statute says. “Perceived, reproduced or otherwise communicated” implies enjoyment only as to the first. “Reproduced or otherwise communicated” may correspond to “or exploitation” but not necessarily. Also, from whose perspective is transitoriness assessed? For a person 1.2 seconds is trivial, but not for a computer.

Pages 52-53, lines 30, 1-2: “Most importantly, whether the embodiment endures beyond the moment of the work’s creation such that the work’s expressive content can be enjoyed, or can be exploited in some market for the work.” This looks like another go at the very criticized and unprecedented market criterion for fixation.

Page 53, illustration 6 (ice sculpture “the form of the swan persists in the ice for a period sufficient to communicate the work’s expressive content”): If that's the standard, then even the most fleeting embodiments will allow for further digital communication of the work.

Page 56 lines 4-5: “does not produce an embodiment sufficiently stable to permit enjoyment . . .” - on the contrary, it does, since the 1.2-second copy is further communicated and the expressive content is enjoyed.

Page 56, lines 26: How about “error or abuse”? Not necessary to attribute bad motive.

Page 57, Illustration 13 (short story with multiple drafts): which is “the work” and which are derivative works (if any)?

Page 58, lines 1-2: Isn't testimony from the creator “evidence”?

Pages 57-58, Illustration 15: If a court requires contemporaneous evidence of work, what good is the earlier, lost, fixation?

Page 59, lines 24-30: What does this add (i.e., “some minimum period of time”)? Also, part is repetitive.

Pages 59-60, discussion of *Kelley*: the court was clearly wrong, since any given assortment of flowers would last more than a few minutes, hours, or even days. Ditto perishable food in *Kim Seng*.

Page 60, lines 1-3: Is the garden less stable than an ice sculpture?

Page 61, lines 1-11 (discussion of cathode ray tubes): Do the tubes “embody” the images?

Page 61, lines 4-8. Any case support for this?

Page 62, lines 14-16, discussion of *Goldstein v. California*: the quoted portion here is dicta at best, since evanescent expression wasn't the issue. In any event, it is not necessary to pronounce on the constitutional issue, since Congress has decided to make fixation a prerequisite (except for simultaneous fixation of transmission - note possible inconsistency with *Goldstein* dicta), and performance-fixation right can be considered an exercise of the commerce power.

Page 62, comment g (fixation is a prerequisite to display right): where does this come from? Does somebody other than the author have to have made the copy that is the source of the display??

Page 62, lines 34-38: Small point: The legal deposit copies began coming to the Library of Congress in 1846. In 1859 the law requiring legal deposit was repealed, but in 1865, the Librarian of Congress persuaded Congress to reinstate the deposit requirement.

Pages 62 et seq. This discussion is more appropriate to a law review article. And as before, it includes an inappropriate interpolation of a requirement of the author's intent to claim copyright; see our and other Advisers' highly critical comments to first draft.

Pages 64 et seq. Relitigation of *MAI v Peak*: still largely irrelevant and inappropriate; see our and other Advisers' highly critical comments to first draft.

Page 73, line 17, §1.07(d): “. . . does not alone satisfy the minimal creativity requirement.” Why “alone”? Sweat of the brow doesn't satisfy the requirement, full stop. Ditto: page 76 line 29, comment c.

Page 75, lines 4-10, illustration. 4: Hasn't the author also contributed authorship in the descriptions and other narrative portions?

Page 76, line 29: “does not alone constitutes or generates” -- Should be “constitute.” Also, delete “alone”

Page 77, line 15: delete “obtaining” and substitute “qualifying for.”

Page 77, illustration 12 (defective keyboard): strange example, since it seems more pertinent to whether the results of the defect were created by the author in the first place. Is it really helpful? How about iambic pentameter as an example of external constraint (that nonetheless does not preclude authorship)?

Page 78, lines 9-10: Does it matter that the author “intends to describe” or that she “described”?

Page 78, illustration 15 (dropped camera); also page 80 illustration 20 (smartphone): what about “adoption” of accidental creativity (*Bell v. Catalda*)? Excluding adoption may just encourage false testimony about creative process. Also, there is no legal requirement of “authorial intent” and we fear this concept could be used to exclude works from copyright protection. In the Illustrations’ cases the output is purely accidental (and not subsequently adopted).

Page 79, line 3: delete “obtain” and substitute “qualify for.”

Page 79, lines 13-20, illustration 17: the likelihood is that the recording would be mixed by a sound engineer, who would also contribute original authorship.

Page 79, lines 26-30, illustration 19 (tree frogs): Slightly frivolous observation: Does "emphasizing" the sounds of tree frogs make for a "relaxing" soundtrack? Maybe the opposite?!

Pages 80-81, lines 35, 1-2 (reporter’s note; randomness): What about choice to adopt random outcomes? Or (as in *Kelley*), to incorporate randomness into the creative process?

Page 81, line 34: typo; run-together words

Page 83, line 6, §108(b) “Copyright protection is available;” better to use "qualifies for" formulation. Ditto page 85, Illus. 2, 3, 4; page 86, Illus. 5.

Page 87, illustration 8 (Creative Commons license): This doesn’t seem like an “Illustration.”

Page 87, line 14 to page 80, line 2, comment d (US Gov’t work status for joint works): Is a better solution to require the co-author to dedicate her contribution to the public domain, as in the commissioned work example? We’re concerned that characterizing the whole work a “work of the US gov’t” could have bad spill-over effects on works created jointly by employees and freelancers when the freelancer's work doesn't fall into one of the nine categories of commissioned works for hire.

Page 88-89 (commission and assignment): this provision (re government holding transferred copyrights) also makes it possible for gov't-run museums to acquire copyright in artworks given by the artists (or by private collectors, if they also owned the copyrights) to the museum. (Akin to Illustration 13)

Page 89, line 26: delete “be copyrighted” and substitute “qualify for copyright.”

Page 89, lines 24-31, comment f (works of state, local etc gov’ts): If these are not "official texts," art. 2.4 of the Berne Convention does not give member states the option of non protection, so the US would have to protect works of foreign government personnel if they are not "official texts." As for the meaning of that term, see, e.g., Sam Ricketson and Jane C. Ginsburg, INTERNATIONAL COPYRIGHT AND NEIGHBORING RIGHTS: THE BERNE CONVENTION AND BEYOND para 8.108(a) (2006).

Page 91, line 8: “As a work made for hire, the Copyright Act. . .” Dangling modifier.

Page 91, lines 13-14: Why should there be a categorical prohibition of copyright protection in this case? Is there case law support? What if there’s a significant financial benefit to the gov’t in using

the contractor? What if the contractor simply won't do it otherwise (e.g., a work of art created for a federal building)?

Page 91, line 32: It's speculation that the price would be lower. It may be that unless the contractor can retain a copyright interest, he/she won't work for the gov't at all.

Page 93, lines 5-14: We're not confident that the non-government author will be "on notice" of the potential joint author status of the US gov't employee. Contributing individuals often have differing views of the significance of their own contributions relative to those of others. And the non-gov't author may have no intention of sharing credit/authorship. In short, the possibility of significant injustice can't be so easily dismissed.

Page 93, line 31: In general, if one joint author dedicates a valuable work to the public domain without the knowledge or consent of the other joint author, could he be liable for waste or a similar claim as to his disposal of the joint property? Would a unilateral dedication be valid?

Page 98, lines 7-22 (§1.09, comment b): adoption "by implication arising from the government's conduct" of privately-generated commentary as binding interpretation makes the commentary an "edict of law": this is becoming very confiscatory; if the government were to adopt without the consent of the right holder, it could be liable for a taking, and it would be only fair to mention this possibility for the benefit of those consulting the Restatement. The draft should draw the line at express adoption of commentary. (Probably not in ALI's business interests to propound a rule that could effectively expropriate ALI's work product if states or localities adopt ALI model laws and Principles!)

Page 101, lines 18-39 to page 102, line 2: Many cases haven't taken as broad a view as *Veck* and have focused on the due process rationale. The draft's embrace of *Veck* seems designed to preclude any arrangement whereby the gov't reaches an agreement with the right holder to allow free access, e.g., on a website, with the right holder retaining some rights. The conclusion that there should be no middle ground is hardly dictated by the cases, and it may be unwise as a matter of policy.

Page 102, lines 19-25. Legal judgments should not be based on suppositions like "the purpose behind such private drafting efforts almost always is to convince the gov't to adopt the offered text." What if the "code" is "offered" only with conditions, or the text was created for a different purpose?

Page 103, line 19: "are created" should be "are creating"

Page 105, sec 1.10(a): "Every unpublished work meets the national origin eligibility requirement": Section 104(a) does NOT say this. It says unpublished works "are subject to protection under this title" regardless of author's nationality or domicile. I.e., there is NO "national origin eligibility requirement" for unpublished works.

Page 106, lines 12-13, comment a: "Congress has granted protection only to works that meet a national origin eligibility requirement" (also comment b, line 20): Not quite. Protection attaches automatically to unpublished works, so long as they remain unpublished. Thereafter, the national origin eligibility requirement applies. Characterizing the status of unpublished works as meeting a national origin eligibility requirement when the point is that there is no such requirement for

unpublished works, is another example of the draft's non acknowledgement of Congress' recognition that the act of creating an original and fixed work of authorship automatically gives rise to property rights in the work. (I.e., the draft's tendency to obliterate the few indicia of the natural rights strain of US copyright.)

Page 106, lines 32-28, comment c, reference to copyright act definition of publication: (Note for future draft) This definition should be interpreted consistently with the Berne Conv. art. 3(3) definition of publication.

Page 107, lines 24-25, comment e, “national or domiciliary”: The Berne point of attachment (art. 3(2)) is “habitual residence.” “Domicile” therefore should be understood to mean the same thing. (“Habitual residence” is more of a civil law concept, and “domicile” more of a common law concept; not sure what if any difference, but Daniel should know.)

Chapter 2

Page 112 (sec 2.01) Illustrations 1, 2, 3: These are correct but seem more pertinent to originality than the idea/expression distinction.

Page 113, lines 14-15: “by not allowing” is awkward. Maybe “by preventing”?

Page 114, lines 26-29 (chocolate chip cookie music video): "recipe itself": the ingredients and steps to follow to prepare and bake; not the literary, visual, or musical presentation (Leonard Bernstein wrote a song setting a recipe to music).

Page 115, lines 4-5: all the adjectives used here suggest the material isn't original in the first place. Also not sure what "flows naturally" in this context means. Is it any different from the prior list?

Page 115, lines 29-33. Duplicative of comments e and f on 113-14.

Page 115, line 20: grammatical quibble: This seems to be a subjunctive (copyright should extend only) and therefore would be "extend."

Page 116, lines 17-20: Comment f seems redundant.

Page 116, line 33 (description of holding of *Baker v Selden*): maybe more accurately, did not protect the implementation (as opposed to the description) of the system (the Supreme Court distinguished between a book to teach the art and one to carry it out).

Page 119, lines 15-16: “danger” seems overstated. Perhaps “. . . from copyright protection to ensure that copyright protection will not inhibit. . .”

Page 119, lines 28-29 (sec. 2.02) (filtering): But filtering risks losing forest (overall expression of those elements) for the trees.

Page 120, lines 1-2 (quotation from *Cavalier*; also next paragraph reference to *Nichols*): this goes to infringement, and ties into the Reporters' query whether this chapter belongs here or later, when the draft will address infringement

Page 120, lines 25-31: Some of the things listed as “building blocks” (which the text indicates should not be protected) can contain protectable expression, e.g. plot, setting (if fictional), etc.

Page 123, line 16 (sec 2.03, comment a) (“copyright protection does not extend to methods or other ways of accomplishing things”): depends what the “thing” is. A blueprint is a way of accomplishing the building of a building; a musical score is a way of accomplishing the performance of a musical composition; both are protectable by copyright.

Page 125, lines 13-14, discussion of *Lotus v Borland*: This conclusion does not reflect other Circuits' approaches, and is fairly controversial, at least with respect to the breadth of what the First Circuit deemed a “method of operation.”

Page 125, lines 18-22, *Lotus* continued: As a result, *Lotus* presented a kind of merger problem distinct from the issue of methods of operation generally, but the court did not confine its analysis to this feature, nor did it apply the idea/expression distinction, having deemed “method of operation” an autonomous and immediately disqualifying characterization.

Page 126, line 8 (ways to create “such a method”): but what’s a “method”? Also, this seems to be a critique of *Oracle v. Google* in favor of *Lotus v. Borland*; we believe the draft’s embrace of *Lotus* and rejection of *Oracle* is unsupported by the weight of the cases.

Page 126, line 23 (“method of operating a computer”): but does the determination of what is “a method of operating a computer” assume its conclusion? And how to reconcile with the statutory definition?

Page 126, lines 27-28 (“recognizably a method of operation”): What does this mean?

Page 129 discussion of *Oracle v Google*: The condemnation of this decision is as open to question as is the celebration of *Lotus*. As discussed above, we don’t believe the draft’s categorical rejection of *Oracle*’s holding and reasoning is warranted.

Page 132, line 8 (“elements that function as facts”): what does this mean?

Page 132, lines 22-24 (book about Sumerian customs “Copyright may protect the particular language that Author A used to describe”): only the language? What about the other expressive elements of her presentation, such as its selection and arrangement?

Page 133, illustration 3 (copyright does not protect the position of the depicted dolphins): But copyright could protect the visual relationship (placement in the drawing) of the two “real life” positions

Page 134 et seq (sec 2.04) critique of *CCC* and reference to “better reasoned” decisions supposedly rejecting *CCC*: the reasoning in *CCC* was pretty good!

More importantly, the cited cases do NOT support the draft’s argument. *Assessment Technologies* had nothing to do with *CCC*’s “soft facts infused with opinion” and doesn’t even cite the case (on the facts of that case, there would, in any event, have been no reason to refer to *CCC*).

We wouldn’t say *NY Mercantile Exchange* is in tension with *CCC*, since, unlike *CCC*, the court

found, regarding the settlement prices, that there was "no dispute that the Committee members seek to determine the appropriate market valuation of each commodity contract, not how the market should value them or will value them. Under this view, the market is an empirical reality, an economic fact about the world, that Committee members are seeking to discover. Thus, there is a strong argument that, as a matter of law, the Committee is discovering facts, not creating predictions or estimates." Nor would we say *NY Mercantile Exchange* is "better reasoned," since it distinguishes *CCC* on the ground that copyright doesn't supply an incentive to create settlement prices, but making copyright in a given case turn on the extent to which copyright in fact served as an incentive is both unmanageable and dangerous.

BanxCorp doesn't criticize *CCC*, but follows the subjective/objective facts distinction that emerges from *CCC* and *NY Mercantile Exchange*

RBC Nice Bearings distinguished *CCC* on the ground that its valuations were based on much more judgment than plaintiff's "numbers resulting from the adjustment of load rating calculations [that] are merely mechanical derivations."

Page 135, line 5 (numerical values are an "idea" of car's value): But in that case every opinion can be converted to a "fact" or an "idea." And if one opinion is a fact or idea, what about the collected opinions? That's precisely the concern that the Second Circuit addressed in *Kregos* and *CCC*. On some level, every compilation represents a compiler's conception of the best way to select, coordinate and arrange data. But if the "idea" is the compiler's conception, then copyright protection for compilations is virtually meaningless. The court's distinction between personal taste or opinion type ideas, and building block ideas, to preserve meaningful protection for compilations is helpful to understanding how the courts view these cases and would be a useful addition to the Restatement.

Nothing in the draft or the cases it cites effectively refutes the notion that, for example, an individual's wine ratings on a 1-100 scale should not enjoy protection.

Page 135, line 6 (asserting that *Kapes* held that "a number" is an original compilation): No, *Kapes* held that a collection of numbers evaluating coin prices was a protectable compilation. The opinion refers throughout to CDN's prices (plural). The Ninth Circuit also rejected the merger doctrine that the draft advances, observing: "But accepting the principle in all cases, including on these facts, would eviscerate the protection of the copyright law. "

Page 137, line 5 ("The 'opinion' in *CCC* is merely a claimed fact based upon an idea"): this is how expression gets objectified and "merged" with an idea, and so much for copyright protection of subjective compilations of information. As the court in *CCC* explained, defining the idea in terms of the compiler's particular assessment of value or his conception of the best way to select and organize data leaves compilations virtually unprotected.

Page 144, lines 1-2 (choices available to subsequent authors; de facto standards): Maybe a bit facile: what's a "de facto standard"? Does the first entrant, or leading entrant's work become a "de facto" standard merely by being the first or the most successful?

Page 144, illustration 1 ("several specific lines of code"): and only those lines?

Page 146, lines 1-2; page 147, lines 8-9: *Herbert Rosenthal v. Kalpakian* is a problematic case. It

was poorly litigated (plaintiff was apparently unable to suggest any form of jeweled bee pin that would not infringe his), which led to the court's broad merger ruling. Other cases – even those involving Herbert Rosenthal – have admitted the possibility that a jeweled bee pin (or in some cases, a jeweled turtle pin) could be protected by copyright. In *Herbert Rosenthal Jewelry Corp. v. Grossbardt*, 428 F.2d 551 (2d Cir. 1970), the court affirmed the lower court's preliminary injunction prohibiting the defendant from selling copies of the plaintiff's jeweled turtle pin (denying summary judgment to both parties); in a separate suit, the court affirmed a ruling that the defendant had infringed upon the design of Rosenthal's jeweled bee pin. *Herbert Rosenthal Jewelry Corp. v. Grossbardt*, 436 F.2d 315 (2d Cir. 1970). In a third suit, Rosenthal won a preliminary injunction against another defendant for copying the same jeweled bee pin at issue in *Kalpakian* (though both parties' motions for summary judgment were denied). *Herbert Rosenthal Jewelry Corp. v. Zale Corp.*, 323 F.Supp. 1234 (S.D.N.Y. 1971). Although Rosenthal lost its suit against Honora Jewelry Co., the Second Circuit did not rule that a jeweled turtle pin necessarily merged with its underlying idea; rather, the court held that "the average layman would not find sufficient similarity in the parties' particular expressions of the idea of a jeweled turtle pin to warrant a finding of infringement," and that the elements plaintiff argued were protectable (the number of jewels and the way in which they were arranged on the carapace) were not. *Herbert Rosenthal Jewelry Corp. v. Honora Jewelry Co., Inc.*, 509 F.2d 64, 65 (2d Cir. 1974).

Although plaintiff in the *Kalpakian* case couldn't suggest a noninfringing design for a jeweled bee pin, it's apparent from the examples included at the end of our comments that there is a wide range of possible expression.

Page 148, lines 27-32 ("The better approach is to treat merger as part of the plaintiff's prima facie case"): Does this mean that plaintiff has to prove a negative in every case?

Page 152, line 27 to page 153, line 3: At times the *scènes à faire* discussion paints with too broad a brush. Certainly the decision to include a scene in a beer hall in a novel about Germany in the 1930's could not itself be protected expression, but the way in which the scene is described, and aspects of the dialog that advance the plot, etc. could be.

Page 163 lines 28-31 ("the 'flows naturally' formulation also reflects the determination that an author's expression is *scènes à faire* requires a looser connection between that expression and the unprotectable element than does the merger doctrine"): Because "flows naturally" is looser, and ill-defined, it may favor lazy assumptions about what expressions do not "count" in assessing substantial similarity of copyrightable expression. This is another example of the draft's systematic favoring of interpretations that restrict the scope of copyright.

Appendix: Herbert Rosenthal's Vintage Bee Pin:²



Other Bee Pin Examples



² The picture to the right depicts a Herbert Rosenthal Diamond Bee Brooch still available for purchase at <https://www.therealreal.com/products/jewelry/brooches/pin/rosenthal-diamond-bee-brooch>.







Sincerely,

A handwritten signature in black ink that reads "Jane Ginsburg". The signature is fluid and cursive, with a long, sweeping tail on the "g".

Jane Ginsburg

June Besek