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Cover Page Footnote

Associate Professor and Director, Intellectual Property Law Program, Cardozo Law School, New York. The author has profited from the readings of different versions or sections of this Article provided by Barton Beebe, Clyde Spillenger, Jessica Litman, David Nimmer, and Michael Carroll. Thanks also to Nicholas Preston, Brissette Gantt, and Xiaomin Zhang for research assistance. The remaining errors are the exclusive intellectual property of the author.

SIZE MATTERS (OR SHOULD) IN COPYRIGHT LAW

*Justin Hughes**

INTRODUCTION

In the spring of 2001, there was a poster in the Paris Metro that was surely a sign of the times in intellectual property. It was one of a series sponsored by the transit authorities, each poster with a quotation from a famous person. This one said, “Think of the Japanese painter who observes a flower for three months and then sketches it in a few seconds.” The quotation was followed by “© Serge Gainsbourg (1928-1991).”¹ No reference to a book, lecture, or song. Are we to think that the Gainsbourg estate has a copyright on that sentence? That a complete work of Gainsbourg’s appears in footnote 1 and that this paragraph contains an infringing derivative work—an English translation—of the entire Gainsbourg “work”?

Many commentators have expressed concern about intellectual property law becoming too “finely grained”—with claims of independent property protection being draped over smaller and smaller pieces of creativity, innovation, and expression. Professor J.H. Reichman was one of the first to observe this problem,² but others—including Pamela Samuelson, Henry Perritt, James Boyle, and Rebecca Eisenberg—have contributed to our awareness of how the size of independent property claims is a key variable in the impact of intellectual property laws.³

* Associate Professor and Director, Intellectual Property Law Program, Cardozo Law School, New York. The author has profited from the readings of different versions or sections of this Article provided by Barton Beebe, Clyde Spillenger, Jessica Litman, David Nimmer, and Michael Carroll. Thanks also to Nicholas Preston, Brisette Gantt, and Xiaomin Zhang for research assistance. The remaining errors are the exclusive intellectual property of the author.

1. “Il faut penser au peintre japonais qui regarde une fleur pendant trois mois et la cerne en quelque secondes.”

2. See, e.g., J.H. Reichman, *Taking Stock: The Law and Economics of Intellectual Property Rights: Of Green Tulips and Legal Kudzu: Repackaging Rights in Subpatentable Innovation*, 53 Vand. L. Rev. 1743 (2002).

3. James Boyle, *The Opposite of Property?*, Law & Contemp. Probs., Winter/Spring 2003, at 1, 30 (discussing how the granularity of copyright rights affects the public domain because the public domain consists not only of works uncovered by copyright protection, but also of a range of fine-grained liberties that are permitted with “protected” works); Henry H. Perritt, Jr., *Property and Innovation in the Global Information Infrastructure*, 1996 U. Chi. Legal F. 261, 285 (noting that the combination of technology and economics has produced a

Intellectual property scholars have tended to write about granular protection arising in response to technologically driven legislative proposals—such as database protection or the Digital Millennium Copyright Act⁴—or existing laws' operation with technological developments, such as gene sequencing that gives rise to patent claims over express sequenced tags.⁵ But there is a less-discussed aspect of this problem: No matter where we are on the technological curve, enterprising lawyers continually try to produce “fine-grained” protection of their client's interests. Plain old skillful advocacy pushes copyright toward more finely grained protection. The issue is not copyright protection per se: the issue is *independent* protection of very small pieces of creative expression. Plaintiffs have been arguing implicitly that the res that supports an independent copyright can be very, very small indeed. As a function of effective lawyering and changing technology, the implicit push is toward protection of what might be called “microworks.”⁶

The push is possible because American copyright law is an enormous legal structure, full of defined terms, all built on one completely undefined term: the “work.” The Copyright Act defines a “collective work,” a “work made for hire,” “literary works,” a “joint work,” and “a work of visual art.”⁷ But the law runs silent on the foundational concept on which these definitions are built.⁸ Melville Nimmer made a push in the 1960s to add a definition of a “single work” to the copyright statutes for purposes of damage calculations. One participant in the reform project, Mort Goldberg, commented, “[I]t seems to me that the problem is not that of defining what a ‘single work’ is, but what ‘the work’ is that is being talked about.”⁹

situation where people access more granular pieces of information—suggesting that the property rules may respond to such developments).

4. Pub. L. No. 105-304, 112 Stat. 2860 (codified as amended in scattered sections of 17 U.S.C.).

5. See, e.g., U.S. Patent & Trademark Office, Request for Comments on Revised Interim Guidelines for Examination of Patent Applications Under the 35 U.S.C. Sec. 112, para. 1 “Written Description” Requirement (1999), available at <http://www.uspto.gov/web/offices/com/sol/og/2000/week09/patappl.htm> (describing the many comments received concerning the fairness and appropriateness of patenting expressed sequence tags).

6. This is not to be confused with the art of microscopic writings or “micrography” (miniature calligraphy). See, e.g., Valère-Marie Marchand, *Voyage au Pays de l'Infiniment Petit* . . . , Plumes, Apr.-May 2004, at 66.

7. 17 U.S.C. § 101 (2000).

8. 17 U.S.C. § 102 offers a nonexhaustive list of “categories” of copyrightable works, but no definition of a “work.” As Register of Copyrights Marybeth Peters noted in 2004 testimony, “Although one might expect the extensive list of definitions in § 101 of the Copyright Act to include a definition of as fundamental a term as ‘work,’ no such definition is [sic] exists.” *Hearing on The Family Movie Act before the Subcomm. on Courts, The Internet and Intellectual Prop. of the H. Comm. on the Judiciary*, 108th Cong. (2004), available at <http://www.copyright.gov/docs/regstat061704.html> (statement of Marybeth Peters, Register of Copyrights).

9. House Comm. on the Judiciary, 88th Cong., Copyright Law Revision, Part 4, at 147 (Comm. Print 1964) (Transcript of Meeting on Preliminary Draft for Revised U.S. Copyright Law: Discussions of §§ 35-42, Chicago, August 15-16, 1963).

Nimmer's recommendation was not embraced, but the absence of any definition of "work" is hardly unique to American law. Most, if not all, modern copyright laws provide non-exhaustive exemplary lists of copyrightable works, but do little or nothing to try to define the basic idea of a "work."¹⁰ Not surprisingly, the same push to protect "microworks" can be seen in disputes in England, the Netherlands, France, and Japan.

In general, American courts have denied blatant claims that very small pieces of copyrightable material merit independent protection. They have done so with a variety of devices. Under the fair use doctrine, the smaller the amount copied, the fairer the copying. Courts have also deployed a "de minimis" copying rule separate from, and antecedent to, any fair use analysis. The de minimis rule expressly allows the copying of small and insignificant portions of the plaintiff's work.¹¹ However, neither of these doctrines is an adequate device because each takes the *work* as its starting point to measure the amount of copying.

10. Some countries give a bit more definition to a "work," but rarely anything that advances our understanding. National copyright laws commonly describe protected "works" as being in the tripartite realm of the literary, scientific, and/or artistic. Section 1 of the Act Dealing with Copyright and Related Acts of Germany provides that "[a]uthors of literary, scientific and artistic works shall enjoy protection for their works in the manner prescribed by this Act." Friedrich-Karl Beier et al., *German Industrial Property, Copyright and Antitrust Laws II/B/3* (3d ed. 1996). Article 2(1) of the Copyright Act of South Korea similarly defines "[w]orks" circularly as "creative production belonging to the category of original literary, scientific or artistic works." Ministry of Culture & Tourism, *Copyright Law of Korea 1* (2000). The Korean law then provides, in a style similar to American law, specific definitions for "[c]inematographic works," "[w]orks of applied art," and "[j]oint works." *Id.* at 2-3. Some countries embellish the root notion of a "work" to provide that what is protected are "works of the mind" or "intellectual creations." In Slovenia, Article 5(1) of the Copyright and Related Rights Act provides that "[c]opyright works are individual intellectual creations in the domain of literature, science, and art, which are expressed in any mode." *Slovn. Intellectual Prop. Office, Intellectual Property Laws and Regulations of the Republic of Slovenia 65* (1996). In France, copyright protection extends to "works of the mind, whatever the genre, form of expression, merit or destination" and follows this with a long list of candidate works. *Code de la Propriété Intellectuelle 17-20* (George Bonet et al. eds., Dalloz 4th ed. 2004). Following French law, the copyright law in Senegal, under Law No. 73-52 Relative to the Protection of Copyright, also uses the concept of an "original work of the mind." *Suivis du Reglement General, Bureau Senegalais du Droit d'Auteur, Textes Relatifs au Droit d'Auteur et au B.S.D.A. [Texts Concerning Copyright and the Senegal Copyright Bureau] 9, 11.* Article 1 grants copyright protection to "toute oeuvre originale de l'esprit (littéraire, scientifique ou artistique)," provides a typical, nonexhaustive list of examples that "[s]ont notamment considérés comme oeuvres de l'esprit au sens de la présente loi," and states that an "original work" is a "work, that, in its characteristic elements and in its form, or in its form only, permits the *identification* of its author." *Id.* Article 5 states as follows: "'Oeuvre originale' s'entend d'une oeuvre qui, dans ses éléments caractéristiques et dans sa forme, ou dans sa forme seulement, permet d'individualiser son auteur." *Id.* Perhaps in the same spirit, in Japan, Article (2)(1)(i) of the Copyright Law provides that a "work" means a production in which thoughts or sentiments are expressed in a creative way and which falls within the literary, scientific, artistic or musical domain." Copyright Research & Info. Ctr., *Copyright Law of Japan 6* (Yukifusa Oyama et al. trans., 1999).

11. See, e.g., *G.R. Leonard & Co. v. Stack*, 386 F.2d 38 (7th Cir. 1967); *Werlin v. Reader's Digest Ass'n*, 528 F. Supp. 451, 463-64 (S.D.N.Y. 1981).

Another device in American copyright law is a long-standing Copyright Office rule that “[w]ords and short phrases such as names, titles, and slogans” are not copyrightable.¹² No court has ever expressly doubted the vitality of the rule. Yet this principle has been put under pressure in a handful of cases. Some of these cases involve quantitatively insubstantial copying that, nonetheless, is claimed to be qualitatively substantial. Other cases involve naming or evaluation systems—products themselves of “soft” information technology. These cases have produced even more troubling intimations of independent copyright protection for extremely small expressions.

This creeping protection of “microworks” is rooted in a fundamental problem. The Copyright Office’s regulatory bar against copyrighting short phrases has historically been justified with copyright’s “originality” requirement: A small expression is deemed to lack sufficient originality. In other words, any claim that the very small expression is a protected “original work of authorship” is turned back on the issue of the expression’s being “original,” not on the issue of the expression’s being a “work.” But it is fundamentally disingenuous to use the originality requirement as the doctrinal bar against copyright protection of titles, names, and short phrases. Many very small expressions positively leap over the low threshold of originality we have established in copyright law. The real issue is not lack of originality; the real issue is size.

The smooth functioning of copyright law depends upon an implicit “minimum size” principle. We have been wont to admit this because of our inability to formulate the principle. How can we formulate a minimum size principle in a one-size-fits-all copyright doctrine that embraces everything from simple portraiture to massive architectural works, from Emily Dickinson’s poems to computer operating systems? Despite these significant problems, this Article sketches some first steps in how we might develop a minimum size principle and proposes that we acknowledge some notions of minimum size in our idea of a “work.” Size counts—or should—in copyright law.

In this early period of digitization and the Internet, there is much discussion of “remix culture.”¹³ Of course, any culture not in stasis is

12. 37 C.F.R. § 202.1(a) (2004). The Rule states that “[w]ords and short phrases such as names, titles, and slogans; familiar symbols or designs; mere variations of typographic ornamentation, lettering or coloring; mere listing of ingredients or contents” are not subject to copyright. *Id.*

13. Contrary to the intimation in the Wikipedia, Wikipedia.org, *Remix Culture* (June 13, 2005), http://en.wikipedia.org/wiki/Remix_culture, “remix culture” owes its origin to the dance club scene, not Larry Lessig. (I am not aware of any direct connection between the two.) The phrase may have started as a verb/noun phrase and then became an adjective/noun phrase. The band Negativland was also an early adopter of the verb-noun phrase in their call for broader fair use. See Negativland, *Lawyers Lawsuits and Lies*, Irish Times, Dec. 17, 1993, at 14 (noting that the expansion of the “Fair Use doctrine would serve to balance the will of commerce to monopolise its products with the socially desirable urge of artists to remix culture”). The phrase appears to have started in Europe’s dance/electronic community. See Andy Gill, *For the People, by the People*, *Indep.* (London), Oct. 6, 1994, at

always a remix culture. People remix words, painters remix colors (literally), musicians remix musical notes, and programmers remix source code commands. Still, for describing the Internet and digitization, “remix culture” is a better buzzword than “information highway.” Perhaps we might also say “recombinant culture” to capture a technological idea both more organic and more recent than mixing music.¹⁴ In our new recombinant culture, digitization allows very small bits and pieces to be copied and reused with extreme ease, while the Internet makes unprecedented amounts of such bits and pieces instantly available for such reuse. If the res of independent copyright protection shrinks to a “microwork,” this recombinant culture is burdened.

Some readers will immediately think of music sampling, but until *Bridgeport Music*¹⁵ is overruled by the U.S. Supreme Court or, effectively, by the important circuit courts for music litigation, the absolutism of the *Bridgeport Music* doctrine actually makes the microwork problem irrelevant for sound recordings. If any taking from a sound recording constitutes infringement, it does not matter how big the “work” is, because the de minimis, fair use, and merger doctrines are irrelevant.

That is definitely not true for software programming, kinds of text works, and many artistic works, like collages. In the software industry, it is widely

25 (describing techniques of Rundgren’s then-new album, in which “[t]he idea sounds more in line with European remix culture than American rock culture”); Matthew Mirapaul, *Why Just Listen to Pop When You Can Mix Your Own?*, N.Y. Times, Aug. 20, 2001, at E2 (describing Icelandic artist Bjork as “among the first pop stars to take the plunge into remix culture”). The phrase had immigrated to the U.S. by the early 1990s. See Larry Flick, *‘Star-System’ Policies Dim Nightclubs’ Appeal*, Billboard, Jan. 11, 1992, at 19 (describing a set of “DJ-only” albums, the first to be called “Remix Culture”). But its extension to other cultural areas might have happened in the European zeitgeist before it happened in the U.S. See Jim McClellan, *In the Path of the Net Pioneers*, Life: The Observer Mag., Apr. 9, 1995, at 64 (describing “a new kind of journalism, something influenced by music’s remix culture”).

14. See 13 Oxford English Dictionary 347 (2d ed. 1989); Answers.com, Recombinant, <http://www.answers.com/topic/recombinant> (last visited Sept. 12, 2005).

15. *Bridgeport Music, Inc. v. Dimension Films*, 410 F.3d 792 (6th Cir. 2005). In *Grand Upright Music, Ltd. v. Warner Bros. Records, Inc.*, 780 F. Supp. 182 (S.D.N.Y. 1991), the sampling of three words and a short keyboard riff from the song “Alone Again (Naturally)” triggered copyright liability. Judge Kevin Duffy’s decision “left behind the impression of a per se bar to unlicensed digital sampling.” Susan Latham, Newton v. Diamond, *Measuring the Legitimacy of Unauthorized Compositional Sampling—A Clue Illuminated and Obscured*, 26 Hastings Comm. & Ent. L.J. 121, 124 (2003); see also Donald S. Passman, All You Need to Know About the Music Business 296 (1997) (noting that the *Grand Upright* case marked the “[e]nd of the days of casual sampling”); Susan Upton Douglass & Craig S. Mende, *Deconstructing Music Sampling: Questions Arise as Practice Becomes Increasingly Common*, N.Y. L.J., Nov. 3, 1997, at S3 (noting that after *Grand Upright*, “[t]he assumption was that if any copying occurred, then there was infringement”). But the *Bridgeport Music* decision is critically different. Unlike the *Grand Upright Music* opinion, which launched the music industry’s current music sampling licensing practices with little more than its “thou shalt not steal” admonition, the carefully reasoned *Bridgeport Music* opinion hones close to the particular statutory provisions for sound recordings. This Article will not dissect Judge Ralph Guy’s opinion because his analysis turns on the copyright provisions unique to sound recordings, and does not bear directly on the qualitatively substantial, de minimis, fair use, or merger doctrines.

accepted that programmers reuse sections of code from prior programs.¹⁶ On the issue of infringement, one attorney working in the field commented, "The problem lies in figuring out what is a substantial part of a software program."¹⁷ But notice the assumption that the "work" is a "software program." What if the work was a subroutine of the original software program? Then, we would likely be in a world where fair use would be useless to programmers "borrowing" code because any time a person copied a single subroutine, she would be copying an entire work. Or consider the work of bloggers, where the coin of the kingdom is a posting and much of what is most interesting is bloggers commenting on one another. Copyright microwork protection could easily become a tool to harass those commentators with whom one does not agree.¹⁸

This Article begins with a discussion of recent cases. Part I examines cases in which courts have turned back blatant efforts to propertize very small pieces of copyrightable material and cases in which courts have suggested that extremely fine-grained res, i.e., microworks, can enjoy independent copyright protection. Part II then describes how these cases are the predictable offspring of the "work" replacing the "book" as the basic statutory subject of copyright protection in the nineteenth century. The ambiguity latent in the concept of a "work" could only blossom fully when registration was eliminated as a requirement for copyright protection; until then, the system largely policed itself in terms of the size and concept of "works" which creators and owners deemed worthy of protection.

Part III then looks at how copyright's originality doctrine has been used to hold back the pressure to protect "microworks;" how this has become a largely indefensible border; and how it would be useful for courts to have some kind of "minimum size" principle in their doctrinal toolbox. Various rationales against creeping microwork protection are sketched out in Part IV. Part V then considers how we might elaborate a minimum size principle. Recognizing that this will not be an easy task, the discussion is limited to written word (text) works. It is with text works that the problem of microwork protection has emerged most starkly. Part V also looks at the area of statutory damages where courts (and Congress) already have grappled expressly with how to establish the number of "works" infringed. Part V concludes that the test for an independently protected work will remain resistant to *ex ante* formulae and the only guidance to be offered is a rough framework of considerations.

16. See Michael Parsons, *Careless Coders Tempting Legal Troubles?*, CNET News.com, June 3, 2004, <http://news.com.com/2100-1008-5226035.html>.

17. *Id.* (internal quotation omitted).

18. For Lawrence Lessig, "[t]he best of the blog entries are relatively short; they point directly to words used by others, criticizing with or adding to them. They are arguably the most important form of unchoreographed public discourse that we have." Lawrence Lessig, *Free Culture* 41 (2004).

I. RECENT CASES PRESSING THE FRONTIER OF MINIMUM SIZE

American copyright law has a long-standing bar against the copyrighting of “[w]ords and short phrases such as names, titles, and slogans; familiar symbols or designs; mere variations of typographic ornamentation, lettering or coloring; mere listing of ingredients or contents.”¹⁹ Although the bar expressly exists only in the regulations of the Copyright Office, courts have applied this rule against claims of copyright in the names or titles of a literary work,²⁰ an insurance policy,²¹ a musical composition,²² an executive summary,²³ a newsletter,²⁴ a play,²⁵ a radio program,²⁶ a comic

19. 37 C.F.R. § 202.1(a) (2004).

20. *See, e.g.,* *Becker v. Loew's, Inc.*, 133 F.2d 889, 891 (7th Cir. 1943) (“[I]t is well settled that the copyright of a book or play does not give the copyright owner the exclusive right to the use of the title.”); *Atlas Mfg. Co. v. Street & Smith*, 204 F. 398, 403 (8th Cir. 1913) (“[T]he copyright of a book does not prevent others from taking the same title for another book, though the copyright has not expired,” and “[n]either the author nor proprietor of a literary work has any property in its name.” (quoting *Black v. Ehrich*, 44 F. 793, 794 (C.C.S.D.N.Y. 1891))); *see also* *Kalem Co. v. Harper Bros.*, 222 U.S. 55 *passim* (1911) (noting that the book and moving picture had the same name, “Ben Hur,” but that the copyright claim was based on a dramatizing right and not mentioning the defendant’s copying of title).

21. *See, e.g.,* *Arvelo v. Am. Int’l Ins. Co.*, 875 F. Supp. 95, 97 (D.P.R. 1995) (noting that plaintiffs “invented the name ‘Retail Plus’ for the new insurance policy” but had no copyright infringement claim against its use by the defendant).

22. *See, e.g.,* *Jollie v. Jaques*, 13 F. Cas. 910 (C.C.S.D.N.Y. 1850) (No. 7437). The court noted that with copyright “[t]he right secured is the property in the piece of music, the production of the mind and genius of the author, and not in the mere name given to the work. . . . [The name] is not the thing protected or intended to be protected.” *Id.* at 914. But the court did hold open the possibility that “in the case of a valid copy-right of the work[,] . . . [i]t may be that the title should be considered as falling within the purview of the statute, and that to protect the work the court would be required to secure the title from piracy.” *Id.* This reasoning seemed either to be based on a fraud/unfair competition basis or might have been an early kernel of the qualitatively substantial copying analysis of *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539 (1985).

23. *See, e.g.,* *Nikas v. Vietnam Veterans of Am., Inc.*, Copy. L. Dec. (CCH) ¶ 27,031 (D.D.C. 1992) (rejecting copyright claim on title “Standing Tall—Together” because “[i]t has been long held that the title of a copyrighted work does not itself qualify for copyright protection”).

24. *See, e.g.,* *Arthur Retlaw & Assoc., Inc. v. Travenol Lab., Inc.*, 582 F. Supp. 1010, 1014 (N.D. Ill. 1984).

25. *See, e.g.,* *Warner Bros. Pictures, Inc. v. Majestic Pictures Corp.*, 70 F.2d 310, 311-12 (2d Cir. 1934) (“A copyright of a play does not carry with it the exclusive right to the use of the title.”); *Nat’l Picture Theatres, Inc. v. Found. Film Corp.*, 266 F. 208, 210 (2d Cir. 1920) (“It is to be noted that plaintiff’s asserted right does not rest on copyright, though derived from a copyright owner; therefore it may be admitted that a name as such is not protected by the Copyright Act”); *Glaser v. St. Elmo Co.*, 175 F. 276 (C.C.S.D.N.Y. 1909); *Corbett v. Purdy*, 80 F. 901, 902 (C.C.S.D.N.Y. 1897) (“The right secured by the copyright act is the property in the literary composition, and not in the name or title given to it. In no case, so far as this court is advised, has protection been afforded by injunction under the copyright laws to the title alone, separate from the book or dramatic composition which it is used to designate.”); *Isaacs v. Daley*, 39 N.Y. Super. Ct. 511, 513 (City of N.Y. 1874) (“The use of the word ‘Charity’ as a designation for any work of art or literature can not ordinarily be monopolized by any one person.”). The *Isaac v. Daley* action appears to have proceeded under a state common law copyright theory.

strip,²⁷ a motion picture,²⁸ and a newspaper (a compilation work).²⁹ No court has expressly rejected the rule or overruled a Copyright Office refusal to register a copyright on those grounds. The bar against copyright protection in titles and short phrases is also well (but not completely) established in English law and in other jurisdictions with sophisticated copyright jurisprudence.³⁰

Yet new variations of the claim for copyright in names and short phrases arise, many related to new technologies. For example, in *Ticketmaster v. Tickets.com, Inc.*,³¹ the defendant had been “scraping” concert information from Ticketmaster’s website. Given the *Feist* bar to copyright over the concert information itself,³² Ticketmaster tried a variety of claims, including claiming that it had copyright over the Uniform Resource Locators (“URLs”) which identify each Ticketmaster webpage.

26. See, e.g., *Kirkland v. Nat’l Broad. Co.*, 425 F. Supp. 1111, 1114 (E.D. Pa. 1976) (concerning a children’s radio program named *Land of the Lost*, the court noted “it has been well-established that a copyright in literary material does not secure any right in the title itself” and proceeded to a trademark/unfair competition analysis).

27. See, e.g., *Fisher v. United Feature Syndicate, Inc.*, 37 F. Supp. 2d 1213, 1226 (D. Colo. 1999) (“Furthermore, the name ‘Chipper’ is not subject to copyright protection.” (quoting 37 C.F.R. § 202.1 (2004))).

28. See, e.g., *Warner Bros.* 70 F.2d at 311 (“A copyright of a play does not carry with it the exclusive right to the use of the title.”).

29. See, e.g., *Duff v. Kansas City Star Co.*, 299 F.2d 320, 323-24 (8th Cir. 1962) (holding that the newspaper name “Community Herald” could only be protected under trademark laws, not copyright laws).

30. United Kingdom: *Kelly v. Hutton*, (1868) 37 L.J.R. 917, 921 (Ch.) (Eng.) (“Now, it appears to us that there is nothing analogous to copyright in the name of a newspaper . . .”); *Correspondent Newspaper Co. v. Saunders*, (1865) 11 Jurist 540, 541 (Ch.) (Eng.) (expressing doubt “whether the title is part of the copyright”). *But see Shetland Times Ltd. v. Wills*, (1996) 1997 S.C. 316 (Scot.) (Outer House), available at 1996 WL 1093516 (finding that headlines copied for hyperlinks could be literary works within the meaning of the Copyright Statute, despite English precedent on titles not being protected by copyright); see also *Netlitigation, Linking, Framing, and Metatagging*, <http://www.netlitigation.com/netlitigation/cases/shetland.htm> (last visited Oct. 20, 2005) (discussing the case). Australia: *Sullivan v. FNH Inv. Pty Ltd.* [2003] FCA 323, ¶ 112, available at http://www.austlii.edu.au/au/cases/cth/federal_ct/2003/323.html (Jacobson, J.) (finding no copyright in slogans that lacked “judgment, effort and skill” required to be original); see also Anne Fitzgerald & Brian Fitzgerald, *Intellectual Property in Principle* 89 (2004) (observing that, in Australia, “[s]logans, titles and heading are not generally accepted as having copyright protection because insufficient effort has gone into their formulation for them to qualify as original literary works in themselves”). Canada: *Francis Day & Hunter, Ltd. v. Twentieth Century Fox Corp.*, [1940] A.C. 112, 124 (Can.) (noting that the statutory definition that “‘work’ shall include the title thereof when such title is original and distinctive” did not mean that a title was deemed to be a separate and independent “work”). Japan: *Court Denies Copyright for Web News Headlines*, *Mainichi Daily News*, Mar. 25, 2004 (discussing a case brought by newspaper *Yomiuri Shimbun* against an Internet service, in which Judge Toshiaki Imura concluded that “[u]sing headlines that are open to the public on the Internet without authorization does not constitute a copyright violation”). Netherlands: *L. Ernens Beheer B.V./Kolk, Gerechtshof te Amsterdam [Hof] [Ordinary court of appeal of Amsterdam]*, 7 juli 2005 (Neth.), <http://www.boek9.nl/weblog2/images/s1ngle.pdf> (recognizing that the word “S1ngle” may not be copyrighted under Dutch law).

31. No. CV 99-7654, 2003 U.S. Dist LEXIS 6483 (C.D. Cal. March 7, 2003).

32. *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 350-51 (1991).

Ticketmaster contended “that, although the URLs are strictly functional, they are entitled to copyright protection because there are several ways to write the URL, and, thus, original authorship is used.”³³ Without specifically invoking the bar on copyrighting short phrases, the court concluded that the URLs lacked sufficient originality to warrant copyright.³⁴

While courts usually fight off such naked efforts to copyright names and short phrases, there are many occasions when courts have succumbed to arguments that very small pieces of expression are worthy of independent copyright protection. The situations in which judges drop their guard might be roughly categorized into four groups. In the first kind of case, the plaintiffs’ claims of trademark and copyright protection are conflated or the clear existence of trademark protection prevents a thorough exploration of the copyright issues. In the second, judges simply succumb—at least in dicta—to the allure of protecting highly original short phrases. In the third kind of case, the doctrine of qualitatively substantial copying—the holding of *Harper & Row, Publishers, Inc. v. Nation Enterprises*³⁵—leads to de facto protection of microworks. Finally, there has been a rash of post-*Feist* cases involving evaluation and classification systems where the courts elaborate a finely grained vision of copyright protection which implies microwork protection.

The following discussion of the first two categories is limited because these are essentially situations of erroneous reasoning. But the third and fourth categories are more challenging because each involves basic navigational tools of copyright giving us conflicting readings—as, all the while, copyright advocacy presses us into uncharted realms.

A. *Copyright and Trademark Claims Are Not Distinguished*

The 1982 case of *Universal City Studios, Inc. v. Kamar Industries, Inc.*³⁶ is perhaps the prime example of a litigation in which weak copyright claims are coupled with more standard trademark claims. Universal brought suit to stop the defendant from marketing merchandise “bearing prominent inscriptions in the forms of ‘I love E.T.’ and ‘E.T. Phone Home!’”³⁷ The trademark and copyright issues are, to be charitable, intertwined through much of the opinion. The court found, in order, (a) that Universal has trademark rights in both the E.T. character and the name “E.T.” (but does not expressly find rights in the sayings),³⁸ (b) that the phrases “would be

33. *Ticketmaster*, 2003 U.S. Dist LEXIS 6483, at *20.

34. *Id.* This claim could also have been dismissed on merger grounds—the URL’s functionality is inseparable from the expression. The fact of where to find the webpage in question cannot be expressed any other way than with the URL. This is not practical merger, it is absolute merger.

35. 471 U.S. 539 (1985).

36. 217 U.S.P.Q. (BNA) 1162 (S.D. Tex. 1982).

37. *Id.* at 1165.

38. *Id.* at 1164. The court further stated that

recognized readily by the average lay observer as having been appropriated from Universal's copyrighted motion picture,"³⁹ and (c) that Kamar's "unauthorized use of the name 'E.T.' on its products, and its reproduction of lines of dialogue from 'E.T. The Extra-Terrestrial' are likely to cause confusion as to the source of Kamar's products."⁴⁰

The court followed a typical line of copyright reasoning to conclude that "E.T." is a protected character and, then, atypically, that protection of the name "E.T." follows under copyright law because the character is protected.⁴¹ Kamar's use of the name was found to meet the "test for infringement of a character" because "the average lay observer would readily recognize the name 'E.T.' as having been taken from the copyrighted character."⁴² Of course, by those lights, any film review of the movie also violated the copyright protection of the character, as would this law review Article.

The district court went further, establishing de facto copyright protection of the two celebrated phrases from the movie. The court reasoned that "[t]he inscriptions on the defendant's products would be readily recognizable to the lay observer as key lines of dialogue from the copyrighted movie and, therefore, the test for copyright infringement has been satisfied."⁴³ There is no de minimis discussion, no fair use analysis, and no discussion of how these quantitatively insubstantial phrases were nevertheless so qualitatively important to the film.⁴⁴ The court then returned to the discussion of Lanham Act violations and granted the plaintiff preliminary injunctive relief. The only thing positive that can said

Universal has acquired valuable trademark and service mark rights in the "E.T." name and character because of the wide-spread popularity and acclaim of "E.T. The Extra-Terrestrial." The "E.T." character has become a valuable property right and symbol distinctive of Universal and its motion picture, and the name "E.T." has acquired a secondary meaning as indicating Universal's famous "E.T." character.

Id.

39. *Id.* at 1165.

40. *Id.* The court also noted that the phrases were "prominently featured" in the copyrighted film. *Id.*

41. *Id.* The court stated as follows:

The character "E.T." is a central component of "E.T. The Extra-Terrestrial." "E.T." is a unique and distinctive character about whom the movie resolves [sic]. . . . [T]he Court believes, that "E.T." is more than a mere vehicle for telling the story and that "E.T." actually constitutes the story being told. The name "E.T." itself is highly distinctive and is inseparable from the identity of the character. The use of the name "E.T." on Kamar's products inevitably conjures up the image and appeal of the E.T. character. The Court finds that the average lay observer would recognize readily the "E.T." name as used on Kamar's products as having been taken from the central character of Universal's copyrighted motion picture.

Id.

42. *Id.* at 1166.

43. *Id.*

44. But in *Nikas v. Vietnam Veterans of America, Inc.*, the court rejected both a claim of copyright in the title "Standing Tall—Together" for an executive summary and a claim that the "slogan is a significant fragment of the entire copyrighted manuscript." Copyright L. Dec. (CCH) ¶ 27,031 (D.D.C. 1992).

for loose copyright analysis in such cases is that the stronger trademark claims almost certainly mean that mistakes, or over-aggressiveness about copyright law, do not trigger more litigation.

B. *Court Dicta that Sufficiently Original Short Phrases Are Protected by Copyright Law*

Occasionally, a court declines to find copyright liability but leaves a trail of dicta suggesting that short phrases may be protected under copyright law. An example of respected jurists leaving us with this kind of unexploded ordinance is a footnote in a 1946 case in which Jerome Frank offered up the noncontroversial idea that “[t]here may be wrongful copying, though small quantitatively.”⁴⁵ But he then gave as examples “if someone were to copy the words, ‘Euclid alone has looked on Beauty bare,’ or ‘Twas brillig and the slithy toves.”⁴⁶

Another occasion of unfortunate dicta is found in *Narell v. Freeman*,⁴⁷ a 1989 case in which the U.S. Court of Appeals for the Ninth Circuit declined to find liability for the defendant’s “admitted takings” which were “several instances of identical phrases and the more numerous paraphrases.”⁴⁸ Despite the fact that Judge Jerome Farris had just cited Benjamin Kaplan’s concerns about copyright protection of “small groups of words,”⁴⁹ he contrasted the phrases copied from the plaintiff with a Frank Zappa sound recording title, “Weasels Ripped My Flesh,” which Farris called an “original and hence protected phrase.”⁵⁰ There seems no reasonable way to interpret this Zappa dicta other than to conclude that Judge Farris believed “Weasels Ripped My Flesh” was a *res capable* of sustaining its own independent copyright.

Finally, a bizarre yin-yang on this issue occurred just a few years earlier. In 1979, the U.S. District Court for the Southern District of New York held that the “Crazy Eddie” discount chain was liable for copyright infringement in television advertisements which parroted trailers for the popular *Superman* movie.⁵¹ There is nothing in then-district Judge Pierre Leval’s opinion to indicate that the case turned on a single phrase. In fact, Judge Leval stated that “nearly every aspect of defendant’s commercial represents a detailed copying of the plaintiff’s trailers.”⁵² But five years later, in

45. *Heim v. Universal Pictures Co.*, 154 F.2d 480, 487 n.8 (2d Cir. 1946).

46. *Id.*

47. 872 F.2d 907, 911 (9th Cir. 1989).

48. *Id.* at 910.

49. *Id.* at 911.

50. *Id.*; *Frank Zappa & The Mothers of Invention, Weasels Ripped My Flesh* (Rykodisc USA 1970).

51. *DC Comics, Inc. v. Crazy Eddie, Inc.*, 205 U.S.P.Q. (BNA) 1177 (S.D.N.Y. 1979).

52. *Id.* at 1178. The court stated as follows:

I have not the slightest doubt that nearly every aspect of defendant’s commercial represents a detailed copying of the plaintiff’s trailers viewed in court, the only variation occurring when defendant’s name and business purpose is substituted for the Superman character’s name and purpose. Defendant’s advertisement captures

Warner Bros. v. American Broadcasting Co., the Second Circuit understood Judge Leval's opinion as providing protection to "well known copyrighted phrase(s)" like "Look! . . . Up in the Sky! . . . It's a Bird! . . . It's a Plane! . . . It's Superman!"⁵³ The Second Circuit noted:

Especially in an era of mass communications, it is to be expected that phrases and other fragments of expression in a highly successful copyrighted work will become part of the language. That does not mean they lose all protection in the manner of a trade name that has become generic. No matter how well known a copyrighted phrase becomes, its author is entitled to guard against its appropriation to promote the sale of commercial products. That doctrine enabled the proprietors of the Superman copyright to prevent a discount chain from using a television commercial that parodied well-known lines associated with Superman.⁵⁴

Again, this was in the context of concluding that the particular defendant was not liable.⁵⁵ But the dicta remains, suggesting that small, highly original phrases can be protected under copyright law.⁵⁶

both the 'total concept and feel' and the characteristic detail or particularized expression of the "Superman" trailers. The average lay observer would instantly identify the defendant's commercial with the copyrighted material.

Id. (citations omitted).

53. *Warner Bros. v. Am. Broad. Co.*, 720 F.2d 231, 236, 242 (2d Cir. 1983).

54. *Id.* at 242 (citing *D.C. Comics, Inc.*, 205 U.S.P.Q. (BNA) 1177).

55. The court found that the defendant was not liable because the defendant was engaged in parody and "st[ood] on a different footing from the products of a discount chain." *Id.*; see also *Stratchborneo v. Arc Music Corp.*, 357 F. Supp. 1393, 1404 (S.D.N.Y. 1973). In *Arc Music Corp.*, the court found no substantial similarity between two works for using the common word "mojo." While noting that "common phrases are generally not susceptible to copyright protection," *id.* at 1405, the court opined that "unless the reappearing phrase is especially unique or qualitatively important, there is no basis for inferring copying," *id.* at 1404, suggesting that an especially unique short phrase would be the basis to infer copying. See also *Whitney v. Ross Jungnickel, Inc.*, 179 F. Supp. 751, 753 (S.D.N.Y. 1960). In *Ross Jungnickel, Inc.*, the court reasoned that

only two lines are claimed to have been appropriated from plaintiffs' lyric, one of which is from a source in the public domain. The similarity concededly ends there. This would not prevent recovery if the lines claimed to have been appropriated constitute an important and vital part of the two compositions rather than being merely incidental or trivial.

Id.

56. There are also judicial opinions that are unclear as to whether short phrases in a larger work are being individually protected. For example, *Applied Innovation, Inc. v. Regents of the University of Minnesota* established copyright liability for the copying of more than thirty psychological test questions. 876 F.2d 626 (8th Cir. 1989). Although the decision includes language suggesting that the individual test statements are not "short phrases" barred by Rule 202.1(a), the court also noted that "[w]e think the test statements satisfy the minimal standard for original works of authorship within the meaning of the copyright laws, at least within the context of the administration of the MMPI." *Id.* at 635 (emphasis added). This suggests that it was the overall work which was being judged for copyright protection.

C. *The Defendant's Copying Is a Single Phrase, so Either the Phrase Is a Qualitatively Substantial Taking of a Large Work or the Phrase Has De Facto Independent Protection*

In 1985, the Supreme Court gave its modern imprimatur to the notion that copyright liability can be based on a quantitatively insubstantial, but qualitatively substantial copying. In *Harper & Row, Publishers, Inc. v. Nation Enterprises*,⁵⁷ a story in *The Nation* describing former President Gerald Ford's memoirs had included extensive "paraphrases, and facts drawn exclusively from the manuscript,"⁵⁸ but copyright liability was anchored on the story having copied verbatim only "between 300 and 400 words"⁵⁹ from President Ford's "200,000-word manuscript."⁶⁰

The *Harper & Row* decision only confirmed the longstanding use of a "qualitative" measure as one alternative for a substantial similarity judgment. In 1847, *Story v. Holcombe*⁶¹ announced reasoning that could have just as easily been written by the Supreme Court 140 years later: "The infringement of a copyright does not depend so much upon the length of the extracts as upon their value. If they embody the spirit and the force of the work in a few pages, they take from it that in which its chief value consists."⁶² In the 1980 case *Roy Export Co. Establishment of Vaduz, Liechtenstein, Black Inc. v. Columbia Broadcasting System, Inc.*, the court concluded that copying excerpts of less than two minutes each from four films ranging from seventy-two to eighty-nine minutes could be found to be "qualitatively great" even if quantitatively small.⁶³

Whatever one's views about the qualitatively substantial doctrine, it is clear that it can produce de facto protection of short phrases, textual or musical. In *Narell v. Freeman*, Judge Farris quotes the first five lines of Longfellow's epic poem, *Paul Revere's Ride*,⁶⁴ concluding that "direct

57. 471 U.S. 539 (1985).

58. *Id.* at 543.

59. *Id.* at 548. The courts were careful to exclude from this number quotations attributed by President Ford to other people and quotations from U.S. Government documents, since Ford would have no copyright claim over such expression. *Id.* at 565 & n.8, 566.

60. *Id.* at 579 (Brennan, J., dissenting).

61. 23 F. Cas. 171, 173 (C.C.D. Ohio 1847) (No. 13,497).

62. *Id.* The court went on to say that while extensive quotation might be necessary for criticism, "this privilege can not be so exercised as to supersede the original book," a line that *The Nation* crossed when their "scoop" caused *Time* to cancel its serialization of the Gerald Ford memoirs. *Id.*

63. *Roy Exp. Co. Establishment of Vaduz, Liechtenstein, Black, Inc. v. Columbia Broad. Sys., Inc.*, 503 F. Supp. 1137, 1145 (S.D.N.Y. 1980) ("We find that the jury could reasonably have found, at least with respect to some of the films, that CBS' use was quantitatively substantial. And even assuming that CBS' use of some of the films was quantitatively small, the jury could reasonably have concluded that it was qualitatively great."). The case also involved a three-minute, forty-five-second excerpt from a film of one hour.

64. *Narell v. Freeman*, 872 F.2d. 907, 912 (9th Cir. 1989). The lines, of course, are the following:

Listen, my children, and you shall hear
Of the midnight ride of Paul Revere.

copying of all of the [five] lines, or even of the first two lines, might constitute infringement if the original held a valid copyright registration.”⁶⁵ In contrast, the court noted that the defendant before it “ha[d] not copied the equivalent of a unique line or stanza,”⁶⁶ a negative finding⁶⁷ pregnant with possible abuse in the future.

A very different fact pattern is presented in *Foxworthy v. Custom Tees*,⁶⁸ a 1995 case concerning “You might be a redneck if . . .” jokes. The comedian who made this joke routine famous brought suit against a t-shirt maker that had used the same or similar phrases on t-shirts. The basis of the comedian’s action was copyright in (a) an album of his comedy routine; (b) a calendar with 365 “You might be a redneck if . . .” jokes;⁶⁹ and (c) books of his redneck jokes, at least one of which was registered as a “compilation” work.⁷⁰ The court received in evidence eleven t-shirts “bearing the exact same ‘operative’ language” as plaintiff’s redneck jokes⁷¹ (presumably each of the eleven had one joke). The court concluded that the plaintiff had shown the likelihood of success on the merits without any consideration of how much copying the defendant had done.

Foxworthy could be interpreted either as a straightforward protection of short phrases or as the qualitatively substantial doctrine producing de facto short-phrase protection. As to the larger works—the calendar and the joke book—there was no discussion of qualitative or quantitative appropriation: Eleven jokes out of a 365-joke calendar (three percent) are not a quantitatively substantial part of that work. As for the t-shirts, would each be registerable as a “work”? Assuming the printing was a plain design, then if any one t-shirt was copyrightable, it would be a copyright over a single phrase. By glossing over these issues, the court implicitly allowed for the possibility that each of the plaintiff’s one-line redneck jokes was copyrighted.⁷²

Although the facts were not reported in detail, this may also have been what happened in the Eighth Circuit’s 2003 affirmance of a copyright liability judgment against Audi Volkswagen in *Andreas v. Volkswagen of*

On the eighteenth of April, in Seventy-five;

Hardly a man is now alive

Who remembers that famous day and year.

Henry Wadsworth Longfellow, *Tales of a Wayside Inn: The Landlord’s Tale: Paul Revere’s Ride*, reprinted in *The Poems of Longfellow* 275 (Random House 1932).

65. *Narell*, 872 F.2d at 912.

66. *Id.*

67. Later in the opinion, Judge Farris properly analyzed the defendant’s “takings” and concluded that “[t]he similarities between the two works are neither quantitatively or qualitatively significant” and that because of “the insubstantial nature of the copied passages, no reasonable reader could conclude that the works are substantially similar.” *Id.* at 913.

68. 879 F. Supp. 1200 (N.D. Ga. 1995).

69. *Id.* at 1204.

70. *Id.* at 1217.

71. *Id.* at 1214.

72. The court noted that the “[p]laintiff claims ownership to hundreds of jokes,” *id.* at 1204, instead of stating that “plaintiff claims ownership of copyrighted works containing hundreds of jokes.”

*America, Inc.*⁷³ The plaintiff in *Andreas* was the author of a drawing called “Angels of Mercy” which had the caption: “Most people don’t know that there are angels whose only job is to make sure you don’t get too comfortable & fall asleep & miss your life.”⁷⁴ Inspired by the drawing, Audi’s advertising agency created a commercial that “depicted an Audi TT coupe in a garden surrounded by angelic looking, neoclassical statues”⁷⁵ and a voiceover which said, “I think I just had my wake-up call, and it was disguised as a car, and it was screaming at me not to *get too comfortable and fall asleep and miss my life.*”⁷⁶ Incredibly, this was the basis for the Eighth Circuit to reinstate a \$570,000 jury award against Audi which the district court had thrown out on a motion for judgment as a matter of law.⁷⁷ The emphasis is added above to show that Audi’s literal copying of expression was limited to ten words⁷⁸ from a twenty-six word caption of a copyrighted drawing.⁷⁹ Andreas’s work was an art work with text, the same as the greeting card designs in *Roth Greeting Cards v. United Card Co.*,⁸⁰ but unlike *Roth Greeting Cards*, Andreas’s original drawing appears to be extremely different from the Audi advertisement.⁸¹

Finally, it is hard to think of a better example of the qualitatively substantial doctrine producing short-phrase protection than *Cook v. Robbins*, an unpublished Ninth Circuit opinion from 2000.⁸² Wade B.

73. 336 F.3d 789 (8th Cir. 2003).

74. *Id.* at 791.

75. *Id.* at 792.

76. *Id.* (emphasis added).

77. *Id.* at 800.

78. I count an ampersand as a word.

79. In a subtle coding that bolsters the result, the circuit panel referred to these twenty-six words as “the accompanying text” to the drawing. *Andreas*, 336 F.3d at 791.

80. 429 F.2d 1106 (9th Cir. 1970). In *Roth Greeting Cards*, all members of the appellate panel concluded that the text on the greeting card was too commonplace for protection, but a majority found liability on a consideration of “all elements” of the plaintiff’s card, including “text, arrangement of text, art work, and association between art work and text.” *Id.* at 1109.

81. Brian Andreas’s drawing “Angels of Mercy” is available for viewing—and can be purchased—at http://www.losgatoscompany.com/brian_andreas.html and <http://www.16handsgallery.com/baprints.html>. To the degree that the “angelic looking neoclassical statues” were to be understood by the viewer as angels, perhaps Audi also copied that general idea in Andreas’s drawing.

82. *Cook v. Robbins*, Nos. 98-36242, 99-35141 & CV 97-1008 (9th Cir. filed Nov. 16, 2000) ([ca9.uscourts.gov](http://www.ca9.uscourts.gov)), available at [http://www.ca9.uscourts.gov/ca9/newopinions.nsf/04485f8dcb04e1ea882569520074e698/06c0e3346a7b91ab882569990061c40a/\\$FILE/9836242.pdf](http://www.ca9.uscourts.gov/ca9/newopinions.nsf/04485f8dcb04e1ea882569520074e698/06c0e3346a7b91ab882569990061c40a/$FILE/9836242.pdf). Whatever the merits and demerits of unpublished opinions under these circumstances, it may have been the best of bad alternatives. See 9th Cir. R. 36-3 (unpublished dispositions are not binding precedent, except under the law of the case). Unpublished and depublished opinions, in both state and federal court, are a subject of great controversy. See Steven B. Katz, *Without Precedent*, L.A. Law., Mar. 2001, at 43 (discussing depublication practice in California, Arizona, and Hawaii state courts); Hon. Edward R. Becker, Hon. Michael Boudin & Hon. Pierre N. Leval, *Citation of Unpublished Opinions: The Appellate Judges Speak*, 74 *Fordham L. Rev.* 1 (2005) (transcript of a panel discussion held at Fordham University School of Law on February 15, 2005); Thomas F. Kibbey, Note, *Standardizing the Rules Restricting Publication and Citation in the Federal Courts of Appeals*, 63 *Ohio St. L.J.* 833 (2002).

Cook was the author of a best-selling 1995 book, *Wall Street Money Machine*, in which "Cook use[d] his experience as a former taxi cab driver to advocate strategies for stock and stock option transactions."⁸³ Two of the themes developed in *Wall Street Money Machine* were: (a) the "meter drop," Cook's phrase to describe the strategy of seeking a series of small gains instead of waiting for one big transaction; and (b) a "rolling stock," a "stock that tends to consistently roll up to a specific price point and then drop down to a specific price point in an obvious pattern of repeated waves."⁸⁴

The defendant, Anthony Robbins, had been presenting his *Financial Power* seminars since 1989. After Robbins read *Wall Street Money Machine*,⁸⁵ Robbins's August 1996 *Financial Power* seminar manual included the phrase "meter drop" nine times and "rolling stock" twice. In subsequent editions of the *Financial Power* manual, the phrase "rolling stock" disappeared, but "meter drop" continued in six places.⁸⁶ Cook filed suit against Robbins, alleging Robbins copied eleven phrases from *Wall Street Money Machine*. The trial court allowed four of these allegations of copying to go to the jury. One of the four passages at issue included "meter drop";⁸⁷ another included "rolling stock."⁸⁸

The jury found that there had been infringement and awarded Cook \$655,900 in damages. The trial judge then granted judgment as a matter of law in favor of the defendant on the grounds that Cook had proved no causal link between Robbins's infringement and the profits from Robbins's seminars (the basis for the \$655,900 figure).⁸⁹ The Ninth Circuit reversed and ordered the jury award reinstated. Although far from a model of clarity, the opinion seems to focus on the two phrases "meter drop" and "rolling stock," not the full expression of the four passages at issue.⁹⁰ The

83. *Cook*, at 3 (ca9.uscourts.gov).

84. *Id.*

85. At trial, it was adduced that Robbins's seminars had never used the phrases "meter drop" or "rolling stock" before Robbins read Mr. Cook's book. *Id.*

86. *Id.* at 4.

87. *Id.* at 4-5. Concerning that phrase, *Wall Street Money Machine* had the sentence "[m]oney is made on the meter drop" and Robbins's manual had "The ring toss/meter drop. The most money is made on the _____." The purpose of the blank in Robbins's manual was to elicit participation from the audience, i.e., they were intended to mentally fill in the blank with "ring toss/money drop." *Id.* at 5 n.3.

88. *Wall Street Money Machine* had the passage, "No one I know has come up with a name for the type of investing I call 'Rolling Stocks.' It works on stocks that roll up and down in repeated waves. . . . Some roll fast and some roll slow." *Id.* at 5 (ellipsis in original). Robbins's manual had "A rolling stock is a stock that tends to consistently roll up to a specific price point and then drop down to a specific price point in an obvious pattern (repeated waves). Some of these companies roll fast (4-6 weeks) and some roll slow (8-10 weeks)." *Id.* Of the other two phrases, for one the plaintiff's book said, "You have to know your exit before ever going in," and the defendant's manual said, "You have to know your _____ before going in," where the blank was intended to elicit "exit" during Robbins's seminar. *Id.*

89. *Id.* at 6.

90. The court noted that Robbins himself had recognized the phrases as creative and quoted *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991), for the

Ninth Circuit referred to evidence that the two phrases were, according to Cook, “an ‘important part of my book’ and an ‘important part of my life’” and “‘the very essence of what I teach.’”⁹¹ Of course, the question should have been whether Robbins copied a substantial amount of the book, not Cook’s teaching or his life.⁹²

Admittedly, those of us who have defended personality interests in intellectual property⁹³ should pause before criticizing *Cook*; yet looking at the four passages as a whole, most of the wording used in Robbins’s *Financial Power* manual was commonplace, and one is left with the Ninth Circuit hanging copyright protection on the phrases “meter drop” and “rolling stock.” Alarmed that *Cook* would undermine Rule 202.1(a),⁹⁴ the Copyright Office proposed that the U.S. intervene to request rehearing en banc.⁹⁵ Before an interagency review process produced consensus on action by the U.S. Government, the parties settled and the Ninth Circuit ordered the opinion remain unpublished.⁹⁶

D. *Evaluation and Classification Cases that Create De Facto Independent Protection of Microworks*

In the cases discussed above, courts considered fairly traditional expressive works. In this section we examine cases in which judges sought copyright protection for what they perceived as genuine creativity in nonfiction database products—all the while navigating around both the Supreme Court’s holding in *Feist Publications, Inc. v. Rural Telephone Service Co.*⁹⁷ and the merger doctrine. A decade of these cases has sculpted a frontier of protection that respects *Feist* while rewarding originality, but in the process these courts have subverted the prohibition on copyright in short phrases. This subversion may have dramatic effects on recombinant culture, ranging from software development to a wide array of literary practices.

proposition that “‘the requisite level of creativity is extremely low; even a slight amount will suffice.’” *Cook*, at 12 (ca9.uscourts.gov).

91. *Id.* at 14.

92. There was no other evidence in the opinion that the court was considering infringement of written materials that Cook had prepared for his own seminars, which would have made the issue of “teaching” more directly relevant. If Robbins had been alleged to have copied Cook’s written materials for his seminar, there would have been completely different issues of access to the copyrighted work.

93. See Justin Hughes, *The Personality Interests of Artists and Inventors in Intellectual Property*, 16 *Cardozo Arts & Ent. L.J.* 81 (1998); Roberta Rosenthal Kwall, *Copyright and the Moral Right: Is an American Marriage Possible?*, 38 *Vand. L. Rev.* 1 (1985).

94. 37 C.F.R. § 202.1(a) (2004).

95. See Letter from David Carson, Gen. Counsel, U.S. Copyright Office, to Robert E. Kopp, Civil Div., U.S. Dep’t of Justice (Dec. 13, 2000) [hereinafter Carson Letter] (on file with author).

96. See *supra* note 82.

97. 499 U.S. 340 (1991).

In *CCC Information Services v. Maclean Hunter Market Reports, Inc.*,⁹⁸ Maclean Hunter published the well-known “Red Book” of used car valuations. These valuations were “the editors’ projections of the values for . . . used cars (up to seven years old),”⁹⁹ adjusted for condition of the vehicle, the vehicle’s options, and the geographic region of the car’s sale. The defendant had for years been “loading major portions of the Red Book onto its computer network and republishing Red Book information in various forms to its customers.”¹⁰⁰ Nonetheless, the trial court granted summary judgment for the defendant, finding that the valuations were unprotectable facts—a fascinating issue in its own right.¹⁰¹

The Second Circuit reversed, with Judge Leval reasoning that the selection and arrangement of the Red Book was protectable and, more importantly for our purposes, that the valuations in the Red Book were themselves protectable. The court found sufficient “selection and arrangement” originality through different aspects of the Red Book.¹⁰² For example, originality was found in Maclean’s “selection of the number of years’ models to be included in the compilation” (seven years); “the selection and manner of presentation of optional features for inclusion”; and “the adjustment for mileage by 5,000 mile increments (as opposed to using some other breakpoint and interval).”¹⁰³

Judge Leval also found that originality was expressed in the particular regions into which Maclean had divided the country.¹⁰⁴ Judge Leval implied that the selection of regions was “original” because it produced not wholly accurate car values. “The number produced is necessarily both approximate and original.”¹⁰⁵ In short, because Maclean’s regional divisions failed to capture real car values,¹⁰⁶ the selection of those regions is marked with originality—a view that is both strange sounding and

98. 44 F.3d 61 (2d. Cir. 1994).

99. *Id.* at 63.

100. *Id.* at 64.

101. *See id.* (discussing the National Automobile Dealers’ Association’s “Blue Book” and observing that “the laws of certain states use th[e] average figure [from the two books] as minimum for insurance payments upon the ‘total loss’ of a vehicle”). This integration into state law certainly gives rise to the argument that the Red Book prices were “law” or “fact” in the sense of being an integral result of a law’s application.

102. *Id.* at 67. The court found that “the selection and arrangement of data in the Red Book displayed amply sufficient originality to pass the low threshold requirement to earn copyright protection.” *Id.*

103. *Id.*

104. *Id.*

105. *Id.*

106. The court stated,

A car model does not command the same value throughout a large geographic sector of the United States A 1989 Dodge Caravan will not command the same price in San Diego as in Seattle. In furnishing a single number to cover vast regions that undoubtably [sic] contain innumerable variations, the Red Book expresses a loose judgment that values are likely to group together with greater consistency within a defined region than without.

Id.

sensible from copyright's basic premises.¹⁰⁷ Further, the decisions made on the "selection" of regions and mileage increments and optional features themselves determined the car valuations, so that any originality in those choices would seem to permeate necessarily into the car valuations themselves.¹⁰⁸

While the *Maclean Hunter* trial had treated the valuations as facts,¹⁰⁹ Maclean's evidence demonstrated without rebuttal that its car valuations were neither reports of historical prices nor mechanical derivations of historical prices or other data. Instead of being Feistian facts, they "were predictions based not only on a multitude of data sources, but also on professional judgment and expertise."¹¹⁰ It is at this point, with his attention focused on distinguishing the Red Book numbers from uncopyrightable facts, that Judge Leval made a worrisome slip, reasoning that "[t]he valuations themselves [were] original creations of Maclean."¹¹¹ Not that the *Red Book* itself was an original creation—which would have adequately supported the finding of liability—but that the numbers were original "creations" in the plural. The implication is that each valuation is an independently copyrightable creation.¹¹² It is this reasoning which sets the stage for the Ninth Circuit's analysis in *CDN Inc. v. Kapes*.¹¹³

In *Kapes*, CDN published the "Coin Dealer Newsletter, a weekly report of wholesale prices for collectible United States coins" which "include[d] prices for virtually all collectible coins and [was] used extensively by dealers."¹¹⁴ Defendant Kenneth Kapes operated a website with a feature

107. David Nimmer has developed the similar point that the originality in a scholar's reconstruction of the text of the Dead Sea Scrolls appears to be in the mistakes. See David Nimmer, *Copyright in the Dead Sea Scrolls*, 38 Hous. L. Rev. 1, 141-43 (2001).

108. Dan Burk has noted that the metrics for a used car's value are arguably uncopyrightable system methods of operation or system under 17 U.S.C. § 102(b). In that sense, Leval picked an odd starting point to find copyrightability. See Dan L. Burk, *Expression, Selection, Abstraction: Copyright's Golden Braid*, 55 Syracuse L. Rev. 593, 613 (2005).

109. *Maclean Hunter Mkts. Reports, Inc.*, 44 F.3d at 64 (noting that the trial court fudged the issue a bit, also calling the valuations "interpretations of facts").

110. *Id.* at 67. But Judge Leval's own opinion may slip in its very first steps, by framing the case's question as being "the scope of protection afforded by the copyright law to such compilations of informational matter." *Id.* at 63. A compilation of nonfactual, informational matter? I have written elsewhere on the almost metaphysical (and even more certainly epistemological) question whether the car valuations in the Red Book are "facts." See Justin Hughes, *Copyright and the Collapse of the Fact/Value Distinction* (July 29, 2005) (unpublished manuscript, on file with author).

111. *Maclean Hunter Mkts. Reports, Inc.*, 44 F.3d at 67.

112. The court recognized a two-level hierarchy of ideas. The first level consists of "building block" ideas and the second consists of "ideas of [a] weaker category, infused with opinion." *Id.* at 72-73. The court reasoned that protection of "the weaker, suggestion-opinion category" of ideas can be tolerated because restricting access to such expressions "will not inflict injury on the opportunity for public debate, nor restrict access to the kind of idea that illuminates our understanding of the phenomena that surround us or of useful processes to solve our problems." *Id.* at 73.

113. 197 F.3d 1256 (9th Cir. 1999).

114. *Id.* at 1257-58.

called *The Fair Market Coin Pricer* (“Pricer”).¹¹⁵ The defendant’s *Pricer* carried retail prices derived from the plaintiff’s wholesale prices by application of a simple algorithm (i.e., a wholesale \$10 price might become a retail \$12.50 price through a twenty-five percent markup). On appeal, the Ninth Circuit recognized that the sole issue before it was “whether the *prices* are copyrightable.”¹¹⁶

Both the trial and appellate courts focused on distinguishing the CDN prices from the *Feist* telephone numbers. The trial court granted summary judgment for the plaintiff, concluding that CDN’s “prices are original creations, not uncopyrightable facts,”¹¹⁷ again framing the discussion in terms of plural creation. On appeal, the Ninth Circuit found that the reasoning in *Maclean* applied on all fours: Like the used car valuations, the wholesale coin prices in CDN’s newsletter were the result of “a process that involves using [the editors’] judgment to distill and extrapolate from factual data.”¹¹⁸ In keeping with both *Maclean Hunter* and the trial court’s opinion, the evaluations were treated individually. Judge Diarmuid O’Scannlain referred to the protected items as either “prices” or “creations.”¹¹⁹ The court then veered into new territory, saying (a) implicitly that the prices are ideas, and (b) explicitly that copyright law sometimes protects ideas:

CDN does not, nor could it, claim protection for its idea of creating a wholesale price guide, but it can use the copyright laws to protect its idea of what those prices are. Drawing this line preserves the balance between competition and protection: it allows CDN’s competitors to create their own price guides . . . but protects CDN’s creation, thus giving it an incentive to create such a guide. . . . The doctrine of merger does not bar copyright protection in this case.¹²⁰

There is a key difference between *Maclean Hunter* and this case. In *Kapes* what is being protected must be CDN’s evaluative judgments because *Kapes* was not reproducing the CDN expressions themselves. The actual CDN wholesale prices had been changed by *Kapes*’s algorithm. This is clearly akin to recognition of a right of translation or adaptation in a literary work. Indeed, one might be tempted to say that *Kapes*’s algorithm translated from the language of “wholesale” to the language of “retail.”

But for our purposes, the real problem is the *Kapes* court’s apparent understanding of a “work.” The Ninth Circuit described CDN’s work in a way that makes each price a creative “compilation”:

115. *Id.* at 1257.

116. *Id.* at 1258 (emphasis added).

117. *Id.* at 1258. On appeal, the Ninth Circuit recognized that the *Feist* telephone numbers lacked any creative spark, but reasoned that “[t]his spark glows in CDN’s prices, which are compilations of data chosen and weighed with creativity and judgment.” *Id.* at 1260.

118. *Id.* at 1261.

119. *Id.* at 1259. Judge O’Scannlain was following the district court judge, who also labeled the numbers as “creations.” *Id.* at 1258.

120. *Id.* at 1262.

CDN's process to arrive at wholesale prices begins with examining the major coin publications to find relevant retail price information. CDN then reviews this data to retain only that information it considers to be most accurate and important CDN also reviews the online networks for the bid and ask prices posted by dealers. It extrapolates from the reported prices to arrive at estimates for prices for unreported coin types and grades. CDN also considers the impact of public auctions and private sales, and analyzes the effect of the economy and foreign policy on the price of coins The prices CDN creates are compilations of data that represent its best estimate of the value of the coins.¹²¹

The court says that the "prices . . . are compilations" (note the use of plurals), squarely intimating that each individual price counts as a single compilation.¹²² Even if the court did not mean "compilation" in the sense of a "compilation work," the court's reasoning strongly suggests that an individual CDN wholesale price is a protected "work." And one (reasonable) interpretation is that the court meant that an individual number is a "compilation work."¹²³

Unfortunately, *Maclean Hunter* and *Kapes* are not the only suggestions that individual numbers merit independent copyright protection; the same thing has happened repeatedly in what we might call the "taxonomy cases." These cases are the Seventh Circuit's 1997 decision in *American Dental Ass'n v. Delta Dental Plans Ass'n*, the Ninth Circuit's treatment of parallel issues the same year in *Practice Management Information Corp. v. American Medical Ass'n*, and a Pennsylvania district court's 2000 analysis in *Southco, Inc. v. Kanebridge Corp.*

The work at issue in *American Dental Ass'n v. Delta Dental Plans Ass'n*,¹²⁴ was the Code on Dental Procedures and Nomenclature ("ADA Code"), a taxonomy of dental procedures, each procedure with a long description, a short description, and a numeric designation.¹²⁵ Delta Dental published a book which "include[d] most of the numbering system and short descriptions from the ADA's Code."¹²⁶ About the same time, the Ninth Circuit was deciding the strikingly parallel *Practice Management Information Corp. v. American Medical Ass'n* case,¹²⁷ in which Practice Management had engaged in wholesale reproduction of the American

121. *Id.* at 1260 ("CDN employs the process described above that satisfies the 'minimal degree of creativity' demanded by the Constitution for copyright protection.")

122. *Id.*

123. This is a point that the U.S. has recognized in other filings. See Brief for the United States of America as Amicus Curiae Supporting Appellant at 14 n.11, *Southco, Inc. v. Kanebridge Corp.*, 258 F.3d 148 (3d Cir. 2001) (No. 00-1102) ("The CDN court went beyond *CCC* and treated each individual valuation as a 'compilation' copyrightable in itself, despite a statutory definition of 'compilation' that on its face is inapplicable to an individual number." (citing 17 U.S.C. § 101 (2000)) (other citation omitted)). The author participated in the preparation of that brief.

124. 126 F.3d 977 (7th Cir. 1997).

125. *Id.* at 977.

126. *Id.*

127. 121 F.3d 516 (9th Cir. 1997).

Medical Association's Physicians' Current Procedure Terminology ("CPT"). The CPT assigns five-digit codes to various medical procedures in a taxonomy that sounds very similar to the American Dental Association ("ADA") system. Both the Seventh and Ninth Circuits found that the respective taxonomies were protected by copyright, with the Ninth Circuit then directing its attention to the impact of the CPT's adoption by the Medicare/Medicaid system.¹²⁸ Attention to these cases from legal commentators has generally focused on their crafting of post-*Feist* protection of nonfiction, database works; copyright misuse; or copyrighting "law."¹²⁹ What has gone unnoticed is how Judge Frank Easterbrook's *Delta Dental* opinion gently advances microwork protection.

When the ADA sued Delta Dental, the district court ruled that the ADA Code was only a "useful" taxonomy and, therefore, lacked the modicum of creativity necessary for copyright.¹³⁰ On appeal, Judge Easterbrook concluded that the long descriptions were unquestionably copyrightable and that the "original long descriptions make the work as a whole copyrightable."¹³¹

This conclusion seems correct, but Judge Easterbrook further reasoned that "[c]lassification is a creative endeavor,"¹³² concluding that "all three elements of the [ADA] Code—numbers, short descriptions, and long descriptions—are copyrightable subject matter."¹³³ Judge Easterbrook further emphasized that "even the short descriptions and the number are original works of authorship."¹³⁴ Again, this plural wording implies that each short description and each number is an original work of authorship—akin to the fine-grained protection suggested in *Kapes* and *Maclean Hunter*.¹³⁵

128. *Id.* at 520-21.

129. *See, e.g.*, Dan L. Burk, *Anticircumvention Misuse*, 50 UCLA L. Rev. 1095 (2003) (discussing *Practice Management* for its copyright misuse aspects); Lawrence Cunningham, *Private Standards in Public Law: Copyright, Lawmaking and the Case of Accounting*, 104 Mich. L. Rev. 291 (2005) (discussing these cases as examples of copyright over aspects of the legal system); Michael J. Madison, *Legal-Ware: Contract and Copyright in the Digital Age*, 67 Fordham L. Rev. 1025 (1998) (discussing cases as post-*Feist* developments); Kathryn Judge, Note, *Rethinking Copyright Misuse*, 57 Stan. L. Rev. 901 (2004) (discussing these cases as examples of copyright over aspects of the legal system).

130. *Am. Dental Ass'n*, 126 F.3d at 978.

131. *Id.* at 979.

132. *Id.* However, we should temper any categorical statement that all classification is a creative endeavor. Some classification schemes may be so obvious that the activity of classification would not be a creative endeavor.

133. *Id.*

134. *Id.* This statement, implying individual "work" status for each number actually appears in the opinion before the more general and less worrisome conclusion that "all three elements of the [ADA] Code—numbers, short descriptions, and long descriptions, are copyrightable subject matter." *Id.*

135. The *Delta Dental* court casts some doubt on the statement that short descriptions and numbers are original works of authorship by stating that it did not find that the Code on Dental Procedures and Nomenclature ("ADA Code") was a compilation work under 17 U.S.C. § 103. Judge Easterbrook's point at that juncture of the opinion, however, seems to

Delta Dental then takes a couple of steps back from this dangerous line by reasoning that the § 102(b) bar on copyright in ideas, systems, and processes would “permit[] Delta [Dental] to disseminate forms inviting dentists to use the ADA’s Code when submitting bills to insurers” and also “precludes the ADA from suing, for copyright infringement, a dentist whose office files record treatments using the Code’s nomenclature.”¹³⁶ In other words, Easterbrook seems to say that a practitioner could not be sued for just writing the designation numbers—an activity that would literally reproduce such numbers—although a publisher who competes with the ADA might be sued for reproducing them. This distinction may follow our intuitions on unfair competition and seems to give the ADA an Immigration and Naturalization Service-like quasi-property right against competitors, but not against individuals. Yet the distinction makes a hash out of § 106 rights;¹³⁷ it would be more sensible to say that an individual practitioner’s form-filling never produces a work substantially similar to the ADA Code as a whole.

The *Delta Dental* reasoning protecting individual numbers (at least against competitors) found further traction in a 2000 case, *Southco, Inc. v. Kanebridge Corp. (Southco I)*.¹³⁸ The plaintiff in *Southco* manufactured a line of fasteners. Each fastener model was designated with a nine-digit number beginning with an arbitrary “forty-seven” and using the remaining seven digits to “denote functional characteristics of each product, for example, installation type, thread size, recess type (phillips or slotted),” etc.¹³⁹ In competing with Southco, the defendant Kanebridge (a) published comparison charts showing Southco parts numbers with their counterpart Kanebridge parts numbers¹⁴⁰; and (b) on occasion, labeled its own parts with Southco numbers. Southco alleged that Kanebridge had “copied some or all” of fifty-one specified nine-digit part numbers from a Southco handbook which contained over 1000 discrete parts numbers.¹⁴¹ The Eastern District of Pennsylvania court granted a preliminary injunction, concluding that “Southco [was] likely to succeed in establishing that its product identification numbers are copyrightable” and that Kanebridge could be liable for copying “Southco’s numbering system.”¹⁴² Instead of

be to deny the preexisting, Feistian factness of the numbers, short descriptions, and long descriptions. *Id.* at 980.

136. *Id.*; see 17 U.S.C. § 102(b) (2000).

137. 17 U.S.C. § 106.

138. 53 U.S.P.Q.2d (BNA) 1490 (E.D. Pa. 2000), *rev’d* 258 F.3d 148 (3d Cir. 2001), *appeal on remand*, 324 F.3d 190 (3d Cir. 2003), *reh’g en banc*, 390 F.3d 276 (3d Cir. 2004).

139. *Id.*

140. *Southco, Inc.*, 258 F.3d at 150.

141. *Southco I*, 53 U.S.P.Q.2d (BNA) at 1490. The “copied” Southco numbers came either from a Southco “Handbook” or a “Supplement” to one of the company handbooks.

142. *Id.* The parties had previously agreed on a temporary restraining order “containing various restrictions on Kanebridge’s use of Southco’s part numbers.” *Southco, Inc.*, 258 F.3d at 150. The appellate court focused on the comparison chart’s use of Southco numbers, and it is reasonable to infer that the parties’ disagreement as to the scope of a stipulated injunction was focused here.

building its analysis on the fact that only fifty-one of over 1000 numbers had been copied, the district court adopted reasoning similar to the *Kapes* and *Delta Dental* courts: "To the extent each nine-digit number is copyrighted, Kanebridge would be copying the entire copyrighted material."¹⁴³

The Third Circuit reversed on the grounds that the numbers "fail[ed] to satisfy the originality requirement" for copyright protection.¹⁴⁴ The court noted that the district court had not distinguished copyright in "the numbering system" from any copyright in the "actual numbers produced by the system,"¹⁴⁵ but when such a distinction was recognized, the rigorous nature of Southco's numbering system made it "impossible for the numbers themselves to be original."¹⁴⁶ But the silence of the court in *Southco I* on the "finely granular" vision of copyright protection¹⁴⁷ adopted by the district court prompted another three rounds of proceedings. On remand, the district court judge granted summary judgment in favor of the defendant, despite a new declaration from a Southco employee, Robert Bisbing, describing the creativity he used in creating some new individual numbers (for new products). Southco appealed and, in *Southco II*, a new Third Circuit panel agreed that the Bisbing declaration raised "a genuine issue of material fact that assigning product numbers . . . involve[s] creativity and choice about how the fastener[s] should be characterized, and thus that the product numbers are not mechanically derived from the numbering system."¹⁴⁸

This ruling prompted the U.S. Government to intervene and try to convince the Third Circuit that individual part numbers are simply not copyrightable, even if "the Bisbing declaration states that Bisbing exercised creativity and choice in determining the values to be reflected in the

143. *Southco I*, 53 U.S.P.Q.2d (BNA) at 1490.

144. *Southco, Inc.*, 258 F.3d at 151.

145. *Id.* (acknowledging the same distinction drawn in the amicus brief from the U.S. Government). The court called it "the amicus brief submitted on behalf of the U.S. [Patent and Trademark Office]," *id.* at 151 n.5, but the U.S. amicus brief was filed by the Department of Justice, the Patent and Trademark Office, and the Copyright Office. The author participated in the drafting of that brief. After drawing the distinction above, the U.S. amicus brief also raised the issue whether any use of Southco's "system" could infringe a protectable copyright interest given the bar to the protection of methods of operation in 17 U.S.C. § 102(b).

146. *Id.* at 153. As amicus curiae, the U.S. Government had argued that the Southco numbers lacked creativity because each number was the result of the "mechanical application of a set of rules to well-defined physical characteristics of a retractable captive-screw assembly," Brief for the United States of America as Amicus Curiae Supporting Appellant at 12, *Southco, Inc.*, 258 F.3d at 148 (No. 00-1102), such that, as the trial court found, once a third party was familiar with Southco's rules for numbering, that person would know the part's "size, finish, and utility" based "on the content and arrangement of its product number." *Southco I*, 53 U.S.P.Q.2d (BNA) 1490.

147. This was implicitly embraced because the panel wrote "these numbers are examples of works that fall short of the minimal level of creativity required for copyright protection." *Southco, Inc.*, 258 F.3d at 152.

148. *Southco, Inc. v. Kanebridge Corp.* (*Southco II*), 324 F.3d 190, 196 (3d Cir. 2003), *reh'g en banc*, 390 F.3d 276 (3d Cir. 2004).

numbers.”¹⁴⁹ The Third Circuit granted rehearing en banc in April 2003¹⁵⁰ and issued an opinion finally getting things right on December 3, 2004. The en banc *Southco III* decision¹⁵¹ announced that Southco’s part numbers were not copyrightable for two separate reasons: (a) “[T]he Southco product numbers are not ‘original’ because each number is rigidly dictated by the rules of the Southco [numbering] system”¹⁵² and (b) “[t]he Southco part numbers are also excluded from copyright protection because they are analogous to short phrases or the titles of works.”¹⁵³ Expressing “deference” to the Copyright Office’s bar against protection for short phrases, the court concluded that the bar “logically extends to part numbers,”¹⁵⁴ a position the U.S. Government had initially advocated in *Southco I*.

Southco III finally put the brakes—at least in one circuit—on the dangerous reasoning that an individual number might be protectable because of the research, analysis, and judgment involved in each valuation or designation. But it is important to understand that such reasoning is not anomalous; it is the unsurprising result of the copyright principle that any original fixed expression is entitled to copyright protection. Citing no authority at all, two British copyright commentators asserted in the 1980s that in the United Kingdom “[a] mathematical or chemical formula may be accorded protection as an original literary work, where substantial skill or labour are involved in its construction.”¹⁵⁵

Yet that is surely wrong, even before we get to functionality and merger considerations. Consider a simple thought experiment: If an expert working for Maclean Hunter or CDN provided a single valuation, perhaps

149. *Id.* at 197.

150. *Southco, Inc. v. Kanebridge Corp.*, No. 02-1243, 2003 U.S. App. LEXIS 9786 (3d Cir. Apr. 25, 2003).

151. *Southco, Inc. v. Kanebridge Corp. (Southco III)*, 390 F.3d 276 (3d Cir. 2004).

152. *Id.* at 282.

153. *Id.* at 285. Interestingly, three Third Circuit judges (Becker, McKee, and Smith) did not join this portion of the en banc decision.

154. *Id.* at 286-87.

155. J.A.L. Sterling & M.C.L. Carpenter, *Copyright Law in the United Kingdom and the Rights of Performers, Authors and Composers in Europe* 56, ¶ 223 (1986). They go on to write,

[B]ut in the case of a published formula, a license to copy the formula may be implied and even where the written expression of the formula is held to be protected by copyright, the protection, if granted, would only extend to the order and characters of the symbols in the formula, not to the system of the formula. No infringement of copyright would occur where the instructions of the formula are followed by putting together the constituents of the formula.

Id. The last part of this sentence is an unsurprising corollary of the *Baker v. Selden* rule, now codified at 17 U.S.C. § 102(b), that there is “a clear distinction between the book, as such, and the art which it is intended to illustrate,” 101 U.S. 99, 102 (1879), with only the former being protected by copyright. The first part, however (“but in the case of a published formula, a license to copy the formula may be implied”), shows how distorted copyright becomes when according this kind of finely granular protection. If the formula is really a “work,” how would its publication create an implied license to copy? Try applying that rule sensibly across the universe of copyrighted works.

as a consultant hired to do so, would we consider that single number copyrightable? If the ADA announced, *sui generis*, a single-number designation for a dental procedure or Southco did the same thing for a single, popular part, would we permit a copyright on that name? If the answer to these questions is no, then something went amiss in these cases until the en banc majority opinion in *Southco III*.

II. FROM "BOOK" TO "WORK"

Modern Anglo-American copyright law arose in the eighteenth century with little reliance on the concept of the "work." In England, the objects of protection in the Statute of Anne (1710) were "Copies of Printed Books."¹⁵⁶ In 1783, under the Articles of Confederation, Congress passed a resolution "recommend[ing] to the several states, to secure to authors or publishers of any new books not hitherto printed . . . such copy or exclusive right of printing, publishing and vending the same . . ."¹⁵⁷ A few years later, when Congress passed the first federal copyright law in the United States, the resulting "[a]ct for the encouragement of learning" gave authors rights in "any map, chart, book or books."¹⁵⁸

In the nineteenth century and twentieth century, American copyright law was revised repeatedly so as to encompass additional types of creations:¹⁵⁹ "prints" (1802),¹⁶⁰ music (1831),¹⁶¹ dramatic compositions (1856),

156. 8 Ann., c. 19 (1710) (Eng.).

157. 8 Journal of the United States in Congress Assembled, Containing the Proceedings from the First Monday in November 1782, to the First Monday in November 1783, at 256-57 (1783); see also Francine Crawford, *Pre-Constitutional Copyright Statutes*, 23 Bull. Copyright Soc'y 11, 13 (1975).

158. Copyright Act of 1790, ch. 15, § 1, 1 Stat. 124. The statute was described by Justice Miller as follows:

The first Congress of the United States, sitting immediately after the formation of the Constitution, enacted that the "author or authors of any map, chart, book, or books, being a citizen or resident of the United States, shall have the sole right and liberty of printing, reprinting, publishing, and vending the same for the period of fourteen years from the recording of the title thereof in the clerk's office, as afterwards directed.

H.R. Rep. No. 60-2222, at 2 (1909) (quoting *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 56-57 (1883)), cited in 8 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* app. 13-4 (2005) [hereinafter *Nimmer on Copyright*]; see also Copyright Act of 1790, ch. 15, 1 Stat. 124 (protecting maps, books, and charts). In keeping with that observation, the *Philadelphia Spelling Book* was the first work registered under the first U.S. copyright statute. See U.S. Copyright Office, Circular 1a, A Brief History and Overview (2005) [hereinafter U.S. Copyright Office, Circular 1a], available at <http://www.copyright.gov/circs/circ1a.html> (last visited Oct. 21, 2005).

159. All of these are listed in U.S. Copyright Office, Circular 1a, *supra* note 158.

160. The bill extended copyright protection "to the arts of designing, engraving, and etching historical and other prints." See Thorvald Solberg, *Copyright in Congress, 1789-1904*, at 128-30 (1905) (detailing the bill's passage in the House and Senate in April 1802 as well as its signature into law by the President on April 29, 1802).

161. Statute of February 3, 1831, ch. 16, 4 Stat. 436. The text of the 1831 statute can be found in *Clayton v. Stone*, 5 F. Cas. 999, 1001 n.2 (C.C.S.D.N.Y. 1829) (No. 2872). See also Solberg, *supra* note 160, at 378 (showing that the statutory language under consideration covered "musical composition[s]").

photographs (1865),¹⁶² and works of art (1870).¹⁶³ Commentators have noted how expansions of copyright law subject matter were often responses to technological developments.¹⁶⁴ But with the exception of photography, these nineteenth-century expansions of copyright law were not prompted by technological developments.

Indeed, eighteenth-century copyright had never been cleanly cabined to “charts, maps, and books.” There were both more general notions and different, specific notions of the object(s) of copyright’s affections. By the end of 1786, all of the thirteen states except Delaware had passed copyright laws.¹⁶⁵ Although most of these had come after Congress’s recommendation that the states protect “books,” the state statutes varied significantly. Connecticut, Georgia, and North Carolina presaged the first federal act by expressly adding maps and charts to the list of protected works.¹⁶⁶ As to different, specific notions, Connecticut, Georgia, and New York had statutes extending liability to the unauthorized printing of an unpublished “manuscript.”¹⁶⁷ The statutes in Pennsylvania, North Carolina, and Connecticut were similar to one another, referring to “books and other writings [and] pamphlet[s] not yet printed.”¹⁶⁸

162. Solberg, *supra* note 160, at 39 (“[c]opyright of photographs”). Otherwise, Solberg’s history chronicles the procedural development of the amendments of copyright law in 1865 without substantive detail. *See also Sarony*, 111 U.S. at 53 (holding that it was within Congress’s power under the Intellectual Property Clause to grant a copyright in a photograph). The United States’ express protection of photographs followed quickly on the heels of the 1862 amendment of English copyright law to expressly protect photographs. *See English Fine Arts Copyright Act, 1862*, § 1; Keith Lupton, *Photographs and the Concept of Originality in Copyright Law*, 10 Eur. Intell. Prop. Rev. 257, 257 & n.7 (1988).

163. Solberg, *supra* note 160, at 197-204. According to Solberg, a bill “to secure the copyright of paintings, drawings, statuary, and models” was introduced in the Senate in February 1870. *Id.* at 197. It appears that these amendments were combined with other patent and copyright amendments from the House which were signed into law by the President on July 8, 1870. *Id.* at 204. Solberg’s history chronicles the procedural development of the amendments of copyright law in 1856 but does not give substantive details on the contents of that amendment.

164. *See generally* Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417, 430-31 (1984) (discussing the influence of technology on development of copyright law); Jessica Litman, *Copyright Legislation and Technological Change*, 68 Or. L. Rev. 275 (1989).

165. *See generally* Crawford, *supra* note 157, at 13; Thomas B. Nachbar, *Constructing Copyright’s Mythology*, 6 Green Bag (2d Series) 37, 37-38 (2002).

166. Crawford, *supra* note 157, at 19; *see* Horatio Marbury & William H. Crawford, *Digest of the Laws of the State of Georgia* 342 (1802).

167. 1 Laws of the State of New York 275 (2d ed. 1798) (printed by Thomas Greenleaf), *quoted in* Crawford, *supra* note 157, at 19. While the main provisions of New York’s 1786 Act protected books and pamphlets, section IV gave the author rights to damages against any party that might “procure and print any unpublished manuscript.” *Id.* at 299. The Georgia statute is similarly constructed with protection of “unpublished manuscript[s]” in a last section 4. *See* Marbury & Crawford, *supra* note 166, at 343.

168. 11 The Statutes at Large of Pennsylvania from 1682 to 1801, at 272 (1906) (compiled by James T. Mitchell and Henry Flanders). To be completely accurate, the Pennsylvania statute referred to “books and other writings” in the “recital” sections, *id.* at 272, while referring to “any book or pamphlet not yet printed” in the operative rights provisions, *id.*

As to more general notions, the concept of "literary works" and "literary productions" appeared in Massachusetts, New Hampshire, and Rhode Island statutes.¹⁶⁹ The preamble to New York's 1786 Act states that each author should receive "the price that may arise from the sale of his or her works."¹⁷⁰ Considered as a whole, both the variations in late eighteenth-century language and the nineteenth-century expansion in coverage evince an acceptance that the basic rationales for copyright—both incentive and desert-based reasoning—extended to artistic and literary endeavors beyond "books" as ordinarily understood.¹⁷¹

English law shows similar developments. The Statute of Anne had expressly protected "books," but the preamble of the Act had stated that Parliament's intention was to protect "books and other writings."¹⁷² This allowed English jurists to imbue the statutory word "book" with a "far more comprehensive signification" than its ordinary use,¹⁷³ forestalling any need to amend English law until 1842. In fact, expansion of the "book" concept in England began as early as 1777 when Lord Mansfield concluded, in *Bach v. Longman*,¹⁷⁴ that a sonata was a book within the meaning of the statute. Lord Mansfield reasoned that the statute was "not confined to language or letters"¹⁷⁵ and that the same incentive rationale applied to composers as well as text authors: "A person may use the copy by playing it; but he has no right to rob the author of the profit, by multiplying copies and disposing of them to his own use."¹⁷⁶ Eleven years later, a one sheet "musical air, tune, and writing" was protected as a "book" in *Storace v. Longman*.¹⁷⁷

Storace was followed by *Hime v. Dale* (1803) and *Clementi v. Golding* (1809),¹⁷⁸ the conclusion in both cases being, again, that a composition on a single sheet might be protected under copyright as a "book." The *Clementi* court concluded that "book" in "its original meaning . . . signifies any

169. These similar statutes referred to "literary productions" in their titles and "all Books, Treatises, and other literary Works" in the operative statutory provision. See 4 Laws of New Hampshire (Revolutionary Period: 1776-1784), at 521 (Henry Harrison Metcalf ed.).

170. 1 Laws of the State of New York, *supra* note 167, at 274, *quoted in* Crawford, *supra* note 157, at 14.

171. As the 1976 House Report describes it, "The historic expansion of copyright has also applied to forms of expression which, although in existence for generations or centuries, have only gradually come to be recognized as creative and worthy of protection." H.R. Rep. No. 94-1476, at 51-52 (1976).

172. This was discussed by Lord Mansfield in *Bach v. Longman*, (1777) 2 Cowp. 623, 624. See also *Clayton v. Stone*, 5 F. Cas. 999, 1001 (C.C.S.D.N.Y. 1829) (No. 2872) (discussing the Statute of Anne); Eaton S. Drone, A Treatise on the Law of Property in Intellectual Productions in Great Britain and the United States 140 & n.3, 141 n.3 (1879) [hereinafter Drone on Copyright].

173. Drone on Copyright, *supra* note 172, at 140.

174. 2 Cowp. at 623.

175. *Id.* at 624.

176. *Id.*

177. *Clementi v. Golding*, (1809) 170 Eng. Rep. 1069, 1069 n.(b) (K.B.) (quoting *Storace v. Longman*, (1788) 2 Camp. 27); see also Drone on Copyright, *supra* note 172, at 141-42.

178. Both cases are quoted at length in the report of *Clementi v. Golding*, 170 Eng. Rep. at 1070.

writing, without reference to size or form.”¹⁷⁹ In *Hime*, Lord Ellenborough reasoned that if any narrower “construction were put upon the Act, many productions of the greatest genius, both in prose and verse, would be excluded from its benefits.”¹⁸⁰ A decade after *Clementi*, the King’s Bench considered a claim of independent copyright in a piece of instrumental music which was itself printed in a bound volume of musical compositions. In *White v. Geroch*,¹⁸¹ Chief Justice Abbott opined that

any composition, whether large or small, is a book within the meaning of this Act of Parliament. It is perfectly clear, that it would be a book, if printed as a separate and distinct work; and if so, it seems to me, that it does not lose that character, by being found in company with other compositions.¹⁸²

In this passage, Chief Justice Abbott established that a work remains a work even when it is included in a compilation work, but he also celebrated the indeterminacy of a size requirement for copyright protection.

American courts similarly embraced a broad understanding of “book.” In the 1829 case of *Clayton v. Stone*, the court considered a claim to copyright in a newspaper and concluded “a book within the statute need not be a book in the common and ordinary acceptance of the word . . . it may be printed only on one sheet, as the words of a song or the music accompanying it.”¹⁸³ In the 1848 *Scoville v. Toland* case,¹⁸⁴ Justice John McLean, riding circuit, faced the question whether a label was a “book” within the meaning of the Copyright Act of 1831. Justice McLean’s decision denied copyright based on the functional nature of the label, but recognized that copyright might attach to “compositions which are intended to instruct and amuse the reader, though limited to a single sheet or page.”¹⁸⁵

179. *Id.* at 1069.

180. *Id.* at 1070 n.(b) (quoting *Hime v. Dale*, (1803) 2 Camp. 31).

181. (1819) 106 Eng. Rep. 376 (K.B.).

182. *Id.* at 376.

183. *Clayton v. Stone*, 5 F. Cas. 999, 1000 (C.C.S.D.N.Y. 1829) (No. 2872). While denying the claim on other grounds, the court also reasoned as follows:

The literary property intended to be protected by the act is not to be determined by the size, form or shape in which it makes its appearance, but by the subject-matter of the work. Nor is this question to be determined by reference to lexicographers, to ascertain the origin and meaning of the word book. It will be more satisfactory to inquire into the general scope and object of the legislature, for the purpose of ascertaining the sense in which the word “book” was intended to be used in the statute.

Id.

184. 21 F. Cas. 863 (C.C. Ohio 1848) (No. 12,553).

185. *Id.* at 864. Justice McLean reasoned that the label at issue

[I]ike other labels . . . was intended for no other use than to be pasted on the vials or bottles which contained the medicine. As a composition distinct from the medicine, it can be of no value As labels they are useful, but as mere compositions, distinct from the medicine, they are never used or designed to be used. This is not the case with other compositions which are intended to instruct and amuse the reader, though limited to a single sheet or page.

Id., quoted in *Higgins v. Keuffel*, 140 U.S. 428, 432 (1891).

Without a clear line defining “books,” nineteenth-century jurisprudence—both English and American—already had the germ of the microwork problem in its basic reasoning, even before “work” was integrated into the respective copyright statutes. In *Hime v. Dale*, the court proudly trumpeted a rhetorical question about the proper scope of copyright:

Every man knows that the mathematical and astronomical calculations, which will inclose the student during a long life in his cabinet, are frequently reduced to the compass of a few lines; and is all this profundity of mental abstraction on which the security and happiness of the species in every part of the globe depend to be excluded from the protection of British jurisprudence?¹⁸⁶

Similarly, by 1879, Drone could review American law and write that “[b]ooks entitled to the protection of copyright embrace the profoundest work on the universe and the simplest rhyme for the nursery.”¹⁸⁷ Protection of the “compass of a few lines” or the protection of the “simplest rhyme” already presents the problem: Were there any lower limits on size for a copyrighted work?

When American copyright law was revised in 1909, the concept of the “copyrighted work” finally became formally foundational.¹⁸⁸ Yet neither the Nimmer nor the Goldstein treatise comment on this shift in foundational concepts.¹⁸⁹ Perhaps that silence is evidence that, by the time “work” was integrated into the statute, the ambiguities latent in “work” had already percolated through copyright thinking.

III. OUR PRESENT, DISINGENUOUS DOCTRINE AND THE ALTERNATIVE: AN EXPRESS MINIMUM SIZE PRINCIPLE

Courts and the Copyright Office have consistently held that titles and short phrases are outside the scope of copyright despite the fact that “nothing in the Copyright Clause of the Constitution nor in the new Copyright Act itself expressly precludes protection for titles under the copyright laws.”¹⁹⁰ Rule 202.1(a) of the Copyright Office’s regulations provides a list of things outside copyright protection: “[w]ords and short phrases such as names, titles, and slogans; familiar symbols or designs; mere variations of typographic ornamentation, lettering or coloring; mere

186. *Clementi v. Golding*, (1809) 170 Eng. Rep. 1069, 1070 n.(b) (K.B.) (quoting *Hime v. Dale*, (1803) 2 Camp. 31).

187. Drone on Copyright, *supra* note 172, at 144.

188. Copyright Act, ch. 320, 35 Stat. 1075, 1075-76 (1909). Section 1 recited all the copyright holders’ rights and was the 1909 counterpart to section 106 of the 1976 Act. Section 1 defines each right in terms of “the copyrighted work.” *Id.* It was one thing to include “works of art” in the 1870 list of things protected under copyright; it seems quite different to make a “work” the basic coin of copyright.

189. See 1 Paul Goldstein, *Goldstein on Copyright* §1.13.2.3(a), at 1:337-38 (3d ed. 2005) (describing the expansion of copyright subject matter).

190. *Kirkland v. Nat’l Broad. Co.*, 425 F. Supp. 1111, 1114 (E.D. Pa. 1976).

listing of ingredients or contents.”¹⁹¹ The portion of this rule that bars copyright in titles and names has a long pedigree in both American and English case law. By 1879, the Drone treatise on copyright could unequivocally state that “[t]he mere title of a book, magazine, newspaper, or other publication, is not a subject of copyright.”¹⁹²

On the other hand, Drone is silent about “short phrases” or “words.” It is unclear when and how the bar became more generalized into the prohibition expressed in Rule 202.1(a). According to William Patry, the “practice of denying registration to words and phrases dates back at least to 1899.”¹⁹³ At least as early as 1958, prior to the formulation of 202.1(a), the U.S. Copyright Office had expressly put “short phrases” into its understanding of the prohibition. Released that year, Copyright Office Circular No. 46 announced that “[b]rand names, trade names, and other short phrases cannot be copyrighted, even if they are distinctively arranged and printed.”¹⁹⁴

Courts that withhold copyright protection from words and short phrases often reject such claims with the idea/expression dichotomy, the *scenes-à-faire* doctrine, or the merger doctrine.¹⁹⁵ When the question of copyright in words or short phrases is isolated, the dominant justification for the Rule 202 bar is that short phrases simply lack the modicum of creativity for protection under copyright. In other words, sufficient “creativity” only arises at a larger granular level, i.e., too short equals not creative equals not copyrightable.¹⁹⁶ For example, in the *Trademark Cases* the Supreme Court reasoned that even if the category of “writings” was “liberally construed” to

191. 37 C.F.R. § 202.1(a) (2004).

192. Drone on Copyright, *supra* note 172, at 145.

193. 1 William Patry, Copyright Law and Practice 333 n.89 (1994).

194. See also H.R. Rep. No. 90-83, at 14, 15 & n.1 (1967) (discussing the precursor of the 1976 Copyright Act and noting that the bill did not extend copyright protection to “the fringes of literary property” including “titles, slogans, and similar short expressions”).

195. See, e.g., *Mitel, Inc. v. Iqtel, Inc.*, 124 F.3d 1366, 1376 (10th Cir. 1997) (concluding that the plaintiff’s command code values were “unprotectable as scenes a faire because they were dictated by external functionality and compatibility requirements of the computer and telecommunications industries”); *Alberto-Culver Co. v. Andrea Dumon, Inc.*, 466 F.2d 705 (7th Cir. 1972) (examining copyright on short phrases as well as copyright on different labels and aspects of labels); *Perma Greetings, Inc. v. Russ Berrie & Co.*, 598 F. Supp 445, 448-49 (E.D. Mo. 1984) (finding that phrases such as “hang in there,” “message,” and “along the way take time to smell the flowers” are unprotected and considering ideas of images and simple design characteristics to be uncopyrightable); *Alexander v. Haley*, 460 F. Supp. 40, 45-46 (S.D.N.Y. 1978) (finding that any substantial similarities between works pertained to unprotected ideas, materials in the public domain, devices covered by *scenes à faire*, or “cliched language, metaphors, and the very words of which the language is constructed”).

196. See, e.g., *Bell v. Blaze Magazine*, 58 U.S.P.Q.2d (BNA) 1464, 1466 (S.D.N.Y. 2001) (finding that similarity of titles could not give rise to infringement because “[w]ords and short phrases, such as titles or slogans, are insufficient to warrant copyright protection, as they do not exhibit the minimal creativity required for such protection”); *Arica Inst., Inc. v. Palmer*, 761 F. Supp. 1056, 1063 (S.D.N.Y. 1991) (“Fragmentary words and phrases do not exhibit the minimal level of creativity necessary for copyright protection.”), *aff’d*, 970 F.2d 1067, 1072 (2d Cir. 1992) (“We further agree with the district court that of . . . 250 alleged instances of alleged copying . . . all but twenty or so refer to single words or short phrases which do not exhibit the minimal creativity required for copyright protection.”).

include trademarks, trademarks—paradigmatically words or short phrases—were neither sufficiently “original” nor sufficiently “founded in the creative powers of the mind”¹⁹⁷ for protection under the Copyright Clause.¹⁹⁸ Similarly the Nims 1947 treatise on trademark and unfair competition notes that “[t]he right secured by the copyright law is the right to use a literary composition—the product of the mind and genius of the author—not the name or title given to it,”¹⁹⁹ implying that the title is not a product of the author’s mind.

Perhaps the leading case taught to law students in this area is *Magic Marketing v. Mailing Services of Pittsburgh, Inc.*, in which phrases like “Telegram,” “Priority Mail,” and “Contents Require Immediate Attention” appeared in plain text on the plaintiff’s envelopes.²⁰⁰ The court held that such words lacked the minimum creativity necessary for copyright protection.²⁰¹ Similarly, in *Takeall v. Pepsico*,²⁰² the court concluded that the phrase “You’ve got the right one, uh-huh” did not “evince the requisite degree of originality to entitle it to copyright protection.”²⁰³ Expressing this classic justification for the Rule 202 bar, Professor Paul Goldstein writes, “The traditional tests of copyrightability—originality and expressive content—offer the surest quantitative guides to copyrightability. The shorter a phrase is, the less likely it is to be original”²⁰⁴ Discussing

197. Presumably, there is no difference between these standards in post-*Feist* analysis, although one could certainly have argued prior to *Feist* that “original” was a lower standard than “creative.” See Hughes, *supra* note 93, at 98-106 (exploring the “multivalent notion of creativity”).

198. The Trade-mark Cases, 100 U.S. 82 (1879). In the 1891 case of *Higgins v. Keuffel*, the Supreme Court wrestled with the question of whether the expression on a label could be subject to copyright. 140 U.S. 428 (1891). In *Higgins*, Justice Stephen Field reasoned that “mere labels” were outside copyright because they lacked even the distinctiveness of a good trademark; Justice Field’s opinion can be read to suggest that trademarks were somehow higher up the originality scale than “mere labels.” What does “it” refer to in the following passage?

A trade mark may, sometimes, it is true, in form, serve as a label, but it differs from a mere label in such cases in that it is not confined to a designation of the article to which it is attached, but by its words or design is a symbol or device which, affixed to a product of one’s manufacture, distinguishes it from articles of the same general nature, manufactured or sold by others, thus securing to the producer the benefits of any increased sale by reason of any peculiar excellence he may have given to it.

Id. at 433.

199. 2 Harry D. Nims, *The Law of Unfair Competition and Trade-marks* § 272, at 889 (4th ed. 1947).

200. *Magic Mktg. v. Mailing Servs. of Pittsburgh, Inc.*, 634 F. Supp. 769, 771-72 (W.D. Pa. 1986).

201. See *id.* at 772 (holding that “the terse phrases on the envelopes” lacked “the minimal degree of creativity necessary for copyright protection”).

202. No. 93-1237, 1993 WL 509876 (4th Cir. Dec. 8, 1993); see also *Murray Hill Publ’ns, Inc. v. ABC Commc’ns, Inc.*, 264 F.3d 622, 633 (6th Cir. 2001) (holding that a short introductory phrase used by a radio DJ was dictated by “functional considerations inherent in conveying the desired information” about the radio show and not sufficiently creative).

203. *Takeall*, 1993 WL 509876, at *7.

204. 1 Goldstein, *supra* note 189, § 2.7.3, at 2:96.

copyright in the United Kingdom, J.A.L. Sterling and M.C.L. Carpenter similarly observe, "Copyright will not normally subsist in the titles of works, since these will not usually constitute 'original' works, particularly where a few obvious words have been used."²⁰⁵

The problem with this reasoning is apparent. Even assuming that the shorter the phrase is, the less likely it is to be original, that does not deny the existence of thousands or millions of short phrases that are original enough to cross the modicum of the creativity threshold. A rule of general probability is not always the best foundation for an absolute bar.²⁰⁶ The reality is that titles, names, and short phrases can be quite creative. Consider Octavio Paz's vision of the titles used by Mexican photographer Manuel Alvarez Bravo in the 1930s:

The titles of Manuel
are not loose ends;
they are verbal arrows,
blazing signals.²⁰⁷

Consider the first sentence in the first short story Eudora Welty kept a copy of, a sentence from which, by her own admission, Ms. Welty had to redeem herself: "Monsieur Boule inserted a delicate dagger into Mademoiselle's left side and departed with a poised immediacy."²⁰⁸ Clunky, but unquestionably original by the standards we use in copyright.²⁰⁹ With the same number of words—sixteen—William Carlos Williams's poem "The Red Wheelbarrow" has had a powerful influence on

205. Sterling & Carpenter, *supra* note 155, ¶ 222, at 56.

206. A rule of general probability may justify an absolute bar where a combination of one or more of three conditions apply: (a) The probability, while general, is very high; (b) banning the unhelpful, occasional contrary cases is justified because the identification of the contrary cases is difficult or costly; and/or (c) the injustice done (or inefficiency created) by denying rights/status to the contrary cases is low. With copyright claims, "(b)" does not apply—identification of the contrary cases is done regularly by courts—but "(a)" and "(c)" might apply.

207. Paz goes on to write:

The eye thinks,
the thought sees,
the sight touches,
the words burn.

This poem by Octavio Paz appeared in a show of Manuel Bravo's photography at the Musco Nacional Centre de Arte Reina Sotia in 1995.

208. Eudora Welty, *One Writer's Beginnings* 85-86 (1984); see also Vivian Gornick, *The Situation and the Story* 57 (2001) (celebrating short phrases from an essay by Seymour Krim, such as "in the crotch of the pleasure principle," "that profuse upstairs delicatessen of mine," "a voice of scars and stars"); Roland Barthes, *Le Plaisir du Texte* 44 (1973) (recounting a single pleasurable phrase from *Bouvard et Pécuchet*, "Des nappes, des draps, des serviettes pendaient verticalement, attachés par des fiches de bois à des cordes tendues," and observing "I love here the excess of precision, a sort of manic exactitude of language, a folly of description"); *id.* at 132-33 (discussing the power of a passage from Loren Eisely).

209. Commenting on this opening sentence, decades later Welty wrote, "I'm afraid it was a perfect example of what my father thought 'fiction' mostly was. I was ten years older before I redeemed that in my first published story, 'Death of a Traveling Salesman.'" Welty, *supra* note 208, at 86.

American poetry.²¹⁰ We can go smaller too. Copyright's low threshold of creativity is surely crossed by Italo Calvino's beautifully evocative title, *If on a Winter's Night a Traveler*,²¹¹ or Lina Wertmuller's 1974 film title, *Travolti da un insolito destino nell'azzurro mare d'agosto* (*Swept Away by an Unusual Destiny in the Blue Sea of August*).

It is no surprise that our lack of creativity justification has led courts to reason that truly creative titles and short phrases do merit protection. In 1947, a California state court reached the conclusion that if a title is "arbitrary or fictitious or fanciful or artificial or technical," it might achieve copyright protection.²¹² In the 1965 case, *Life Music, Inc. v. Wonderland Music Co.*,²¹³ a Southern District of New York court left us with dicta that copyright was possible for the single word "supercalifragilisticexpialidocious" (a word that is not just the main lyric and leitmotif of a popular children's song, but also the song's title).²¹⁴ And if Mary Poppins's favorite adjective is copyrightable, what about "scrumpdillyishhus"²¹⁵ or even the verb "grok"?

As Jessica Litman puts it baldly, "Coined words are not copyrightable despite the fact that some of them are demonstrably original."²¹⁶ But she does not pursue the obvious implication: that it is disingenuous to justify the Rule 202 bar in terms of lack of creativity. It would be better to acknowledge that such short phrases may manifest creativity²¹⁷ but remain outside the ambit of copyright because they are not "works." Indeed, lack of creativity has long been understood as tenuous grounds for the Rule 202 bar.

Unspoken dissatisfaction with lack of creativity as the foundation for the Rule 202 bar is manifest in the Copyright Office's own regulations. While

210. William Carlos Williams, *Spring and All: XXII. The Red Wheelbarrow*, in 1 *The Collected Poems of William Carlos Williams* 224 (A. Walton Litz & Christopher MacGowan eds., New Directions Books 1986). In the words of one scholar, the poem "had a pretty powerful influence on American poetry . . . for its compression, its creativity, and its effort to achieve both those aims in a natural American speech rhythm." Email from Professor Robert Longworth, Professor Emeritus of English, Oberlin College, to Justin Hughes, Associate Professor, Cardozo Law School (June 7, 2004, 22:18 EST) (on file with author).

211. Italo Calvino, *If on a Winter's Night a Traveler* (William Weaver trans., Harcourt Brace Jovanovich, Inc. 1981) (1979).

212. *Johnston v. Twentieth Century-Fox Film Corp.*, 187 P.2d 474, 482 (Cal. Dist. Ct. App. 1947).

213. 241 F. Supp. 653, 654, 656 (S.D.N.Y. 1965).

214. This is a point not lost on at least one subsequent court. See *Tree Publ'g Co. v. Warner Bros. Records*, 785 F. Supp. 1272, 1275 (M.D. Tenn. 1991).

215. This was a word invented by marketers for Dairy Queen in the 1970s. See David's Dairy Queen, <http://www.davidsdairyqueen.com/history.html> (last visited Sept. 11, 2005).

216. See Jessica Litman, *The Public Domain*, 39 *Emory L.J.* 965, 1013 (1990).

217. In fact, Professor Goldstein recognizes this point in respect to titles—that some "are sufficiently original and expressive to qualify for protection." 1 Goldstein, *supra* note 189, § 2.7.3, at 2:97-98. He then prescribes copyright protection for titles in such circumstances. *Id.* § 2.7.3, at 2:98. In contrast, I would rupture the "shortness equals not original" inference completely, but still deny copyright protection to the full range of things under Rule 202.1(a).

Rule 202.1(a) bars copyright in “[w]ords and short phrases such as names, titles, and slogans,” the regulation does not say why. Copyright Office Rule 202.10(b), discussing labels, leaves things hanging further: “A claim to copyright cannot be registered in a print or label consisting solely of trademark subject matter and lacking copyrightable matter.”²¹⁸ That just restates the obvious: A claim to copyright cannot be registered in (anything) lacking copyrightable matter.

The Copyright Office’s own *Compendium of Copyright Office Practices* supports the point that this exclusion is not based on a lack of creativity:

Noncopyrightable material. The following are not copyrightable and therefore cannot serve as a basis for registration.

Names, titles, slogans, and other short phrases. Names, titles, slogans, and other short phrases or expressions are not copyrightable, even if such expressions are novel, distinctive, or lend themselves to a play on words. Similarly, a mere listing of ingredients or contents is not copyrightable.²¹⁹

It would be difficult to say that an expression which is “novel” and “distinctive” does not meet the copyright law’s minimum threshold of creativity/originality. Indeed, the Nimmer treatise makes much the same point, observing that “[a]s a matter of first impression, it might well be argued that fanciful original titles should be regarded as a form of literary expression, protectible under the copyright laws.”²²⁰

In its 2003 brief in the exasperatingly protracted *Southco* litigation, the U.S. Government finally fessed up: Its brief recognizes that “*even a creative short phrase is not protected by copyright*”²²¹ and “we note that the Copyright Office will not register even a creative short phrase.”²²² The U.S. government’s brief in *Southco* does not explain why the creative short phrase is to be unprotected. The only reasonable way to interpret this statement is implicit advocacy of a minimum size principle. The next two parts explore, respectively, the reasons for a free-standing minimum size principle and the difficulties in implementing such a principle.

218. 37 C.F.R. § 202.10(b) (2004).

219. U.S. Copyright Office, *Compendium II*, §§ 305, 305.01 (Supp. 1998), available at <http://www.copyright.gov/compendium/>; see also U.S. Copyright Office, Circular 34 (2002), available at <http://www.copyright.gov/circs/circ34.pdf>. It appears that predecessor guidelines of the Copyright Office provided that “[b]rand names, trade names, slogans, and other short phrases or expressions cannot be copyrighted, even if they are distinctly arranged or printed.” *Kitchens of Sara Lee, Inc. v. Nifty Foods Corp.*, 266 F.2d 541, 544 (2d Cir. 1959) (quoting Copyright Office Publication No. 46, September 1946).

220. 1 Nimmer on Copyright, *supra* note 158, § 2.16, at 2-185.

221. Brief for United States as Amicus Curiae Supporting Appellee at 16, *Southco, Inc. v. Kanebridge Corp.*, 390 F.3d 276 (3d Cir. 2004) (No. 02-1243), available at <http://www.usdoj.gov/atr/cases/f201000/201034.pdf>.

222. *Id.* at 15.

IV. THE JUSTIFICATION FOR A MINIMUM SIZE PRINCIPLE IN COPYRIGHT

The reasons for a minimum size principle today are no different than they have always been: (a) Protecting microworks would do no good and (b) protecting microworks would do some harm. Protecting microworks would do no good because the legal system already has various incentives for the production of small creations in several ways and there is no evidence that those incentives are inadequate. On the other side of the ledger, independent protection of these small creations would arguably do harm by diminishing the public domain and producing unnecessary transaction costs through fragmentation of the copyright "markets." These points about incentives, transaction costs, and the public domain are familiar ones—and, without empirical evidence, the arguments remain products of intuition-driven contention.²²³ As a separate type of harm, protecting microworks would have deleterious effects on other parts of the structure of copyright law—making the fair use doctrine, de minimis defense, merger doctrine, etc., either overworked or unworkable. I separate this adverse consequence because it is a question of law, not empirical fact, and therefore one about which legal scholars can be more confident.

A. *No Further Incentive Is Needed for the Production of Short Phrases*

There are already ample incentives for the production of titles, words, short phrases, single evaluations, small symbols, or other small creations. Circumstances in which a small, valuable creation is intentionally produced typically—perhaps always—involve: (a) a small creation which can be protected under trademark law, (b) inclusion of the small creation in a larger work which copyright traditionally protects, (c) a small creation produced under contract for a particular person or entity, and/or (d) a small creation produced for nonmonetary reasons.

Protection of titles under trademark or unfair competition law is frequently recognized by courts and commentators, both American and foreign.²²⁴ As mentioned above, this might have been one reason that the

223. See Litman, *supra* note 216, at 997-98 (discussing some of these arguments and noting that "[i]n the absence of empirical data, the result of economic analysis is dictated by the model's placement of the burden of proof").

224. See Warner Bros. Pictures, Inc. v. Majestic Pictures Corp., 70 F.2d 310, 312-13 (2d Cir. 1934); Manners v. Triangle Film Corp., 247 F. 301, 303 (2d Cir. 1917) (finding that protection was warranted only if the title "Happiness" had acquired secondary meaning such that the public would be misled); Nimmer, *supra* note 107, at 141. See generally Victor S. Netterville & Barry L. Hirsch, *Piracy and Privilege in Literary Titles*, 32 S. Cal. L. Rev. 101 (1959). In the U.S., such recognition dates at least to *Benn v. Leclercq*, 18 Internal Revenue Record 94, 95 (C.C. Boston 1873) ("Cases may occur in which a title is protected independently of the contents of the book. But they would not occur under the copyright laws. . . . [T]he protection granted would be analogous to that granted in case of trademarks."). See also Aronson v. Fleckenstein, 28 F. 75, 78 (C.C.N.D. Ill. 1886) (concluding that the owner of the operetta *Erminie* had a right to prevent the defendant from using the same name for a different operetta on trademark-esque grounds "that the name of this composition belongs to this complainant as identifying and describing his literary property, and as a part of the piece itself"); Drone on Copyright, *supra* note 172, at

bar on protection of titles congealed earlier than the more general bar on protection of words and short phrases. For words or short phrases not protected by trademark law, there is the more general and more important point that the copyright system already establishes incentives for the larger-sized res: books, newspaper articles, scripts, songs, taxonomic databases, websites, etc. An entity like Maclean Hunter, CDN, or the ADA appears to have adequate incentive for the preparation of the larger works at issue as long as the larger work is protected against substantial copying (including sequential mining). The incentive for titles, names, and designations themselves comes via the need to market books, films, short stories, music, appliances, tract houses, fasteners, and detergent —markets which are already secured by intellectual, real, and chattel property laws.

For the economics of other microworks, let us return to the observation earlier: If the Maclean Hunter experts had prepared one valuation at the request of, say, Sotheby's, no one would think that that number was copyrightable. Many evaluations are prepared for what we identify as service industries, not for products. Examples include a consultant's asset valuation for a company's acquisition or liquidation, a mediator's valuation of one party's legal claims, and a psychologist's evaluation of a job candidate for a particularly stressful position. In each of these cases, the result will be a single microwork, e.g., the company's west coast operations are worth \$8.3 million. But no one who writes about business, economics, or law ever posits that these things are under-produced for want of copyright protection.

These microworks inhabit an environment akin to the artistic patronage system that produced most cultural works prior to the rise of copyright. No intellectual property incentive is needed because the consultant, the psychologist, the economist, and the mediator already have a "patron"

145 (stating that "[a] title is treated as a trade-mark, in which the owner's rights are recognized and protected on general principles of equity" and that a title which "has the requisites of a valid trade-mark" can be registered as such); *id.* at 535 ("There can be no copyright in a mere title; but, on general principles of equity, an injunction will be granted restraining a person from appropriating the title of a well-known publication for a rival work."). In France titles can be protected via an action for "concurrency déloyale" (unfair competition). André Lucas & Henri-Jacques Lucas, *Traité de la Propriété Littéraire & Artistique* [Treatise on Literary and Artistic Property] ¶ 108, at 101-02 (2d ed. 1994). According to these authors, the terminology of French case law on titles shows that the judges are thinking in trademark and unfair competition concepts, not copyright concepts. *Id.* Some countries do provide for protection of titles under their copyright laws, but typically in such a way that makes it clear that the title is not understood as a "work." For example, article 2 of Senegal's copyright act provides that "[t]he title of a work is protected as the work itself if it presents an original character. No one may, even if the work is not protected, use the title to identify a work of the same genre if this use is likely to cause confusion." *Suivis du Règlement General, Bureau Senegalais du Droit d'Auteur, Textes Relatifs au Droit d'Auteur et au B.S.D.A.* [Texts Concerning Copyright and the Senegal Copyright Bureau] 9, 11. The original French text reads as follows: "Le titre d'une oeuvre est protégé comme l'oeuvre elle-même dès lors qu'il présente un caractère original. Nul ne peut, même si l'oeuvre n'est plus protégé, utiliser ce titre pour individualiser un oeuvre du même genre si cette utilisation est susceptible de provoquer une confusion."

paying for the final product. Separately, there is also what might be called the “Oscar Wilde principle”: Much of the world of witticisms, pithy observations, and insightful judgments exists because of nonmonetary incentives. There is no need to propertize and monetize what arises in abundance from our desire to socialize.

At this juncture, it may be worthwhile to distinguish the minimum size principle from other proposals to remove intellectual property protection from a certain class or kind of “work” because no incentive is needed.²²⁵ Most arguments about excluding certain classes of works from copyright protection suffer from (a) creating an impractical system that (b) assumes technological and/or business stasis. For example, one could argue that movie posters, film promotion web sites, and perhaps even movie soundtracks do not need copyright protection because their cost is folded into the production and distribution costs of a (copyrighted) film.²²⁶ But how would one write a law that distinguishes a movie poster from the broader universe of posters that adorn college dorm rooms, many of which need copyright protection for their production?²²⁷ Or a promotional film/video from any other “short”—how would we define the unprotected category?²²⁸ And when the promotional works generate their own market

225. In addition to proposals to remove intellectual property protection from certain classes of creative works or innovations, it is common to see proposals that intellectual property rules should be tailored to specific classes of creative works or innovations, such as different terms of copyright protection for different kinds of works. See Dan Burk & Mark Lemley, *Is Patent Law Technology-Specific?*, 17 Berkeley Tech. L.J. 1155, 1157 (2002) (describing doctrinal differences in patent law’s handling of biotech and software patents, then normatively advocating “how patent policy may be tailored to provide optimal incentives for innovation”).

226. For an interesting parallel to this argument, consider the “spin-off theory” advanced to limit the scope of the European Union’s 1996 Database Directive. Because the directive’s sui generis database right is expressly intended to protect the investment in databases, the argument has been that the sui generis right should not extend to databases that are simply “spin-offs” of preexisting commercial activities. See P. Bernt Hugenholtz, *The “Spin-Off” Doctrine in the Netherlands and Elsewhere in Europe*, (unpublished manuscript) (paper presented at the Fordham University School of Law eleventh annual conference on International IP Law and Policy in April 2003), available at <http://www.ivir.nl/publications/hugenholtz/spinofffordham.html>. The European Court of Justice recently embraced a version of the “spin-off” theory. *British Horseracing Bd. Ltd. & Others v. William Hill Org. Ltd.*, Case C-203/02, 2004 E.C.R. I-10415, available at http://europa.eu.int/smartapi/cgi/sga_doc?smartapi!celexplus!prod!CELEXnumdoc&lg=en&numdoc=62002J0203.

227. For example, perhaps the most ubiquitous poster in male college rooms in the 1970s was the famous Farrah Fawcett-Majors swimsuit poster of 1976. Although not produced by Aaron Spelling or any entity affiliated with *Charlie’s Angels*, the poster’s release was perfectly timed with the television show and practically everyone identified the poster with the television show. See Jack Condon & David Hofstede, *Charlie’s Angels Casebook* 55-56 (2000).

228. For example, in 2004, Matador Records announced a competition to fund ten short films “inspired by the music and the aesthetic of the band” Interpol. Matador’s competition told filmmakers expressly, “You must not make a music video. We are looking for artistic films inspired by Interpol’s music and ideas, not a promotional clip for a specific song.” See *Matador Records: Interpol Short Film Contest*, www.matadorrec.com/interpol/contest.html (last visited Sept. 5, 2005).

with sales and profits (think music videos) would one move that class of works from unprotected to protected? Even without clever people gaming the new distinction, the distinction that makes sense today is likely to make much less sense tomorrow as markets and technology change.

A minimum size principle is different. Because most candidate microworks are integrated into larger copyrighted works, the principle does not leave identifiable categories of works unprotected. If our goal is to create special incentives for the building of houses, we do not necessarily need special incentives for the making of bricks or the mixing of mortar. In the end, there is only the weak counterargument that incentives directed at brick making will produce even better or even more bricks.²²⁹ However, there is no evidence of this. Without such evidence that our bricks—short phrases, titles, evaluations—are under baked, so to speak, we should prevent the law from moving in that direction, whether through legislation or judicial incrementalism.²³⁰

There is the technology-enhanced danger that larger works will be systematically tapped by the expression counterpart of data mining, a process in which the copyist sequentially copies very small pieces of a work and eventually reassembles the whole work. Microsoft has been concerned about this problem as it has explored the “application service providers” business model, one in which the online client never has the entire application program on his or her computer, but is constantly fed needed routines and subroutines. This kind of “expression mining” could produce the economic effect of copying a substantial portion of a regular-sized work. But this problem could be addressed by modifying our definition of an event of copying, not changing our basic notion of a “work.” Addressing this problem was one of the intelligent components of the justifiably maligned 1996 European Union Database Directive.²³¹

229. The critical reader will say that this analogy is weak because chattel property law will protect the bricks and mortar, whereas no proprietary law will protect the titles and short phrases. But “pieces” of copyrighted works are usually kept private until publication, and remain protected by privacy, unfair competition, and chattel property laws.

230. See, e.g., Justin Hughes, *Of World Music and Sovereign States, Professors and the Formation of Legal Norms*, 35 Loy. U. Chi. L.J. 155, 198-200 (2003) (advocating “a demanding standard of proof needed to justify a change in the law” in the legislative context); Robert Kastenmeier & Michael Remington, *The Semiconductor Chip Protection Act of 1984: A Swamp or Firm Ground?*, 70 Minn. L. Rev. 417, 439-40 (1985) (same); see also James Boyle & Jennifer Jenkins, *The Genius of Intellectual Property and the Need for the Public Domain, in The Role of Scientific and Technical Data and Information in the Public Domain* 10, 12 (Julie M. Esanu & Paul F. Uhlir eds., 2003) (concluding that “fundamental tinkering in the absence of strong evidence that the tinkering is needed would not seem like the optimal strategy”); James Boyle, *A Natural Experiment*, FT.com, Nov. 22, 2004, <http://search.ft.com/search/index.html> (search “Boyle” and “natural” and “experiment”) (lamenting the “empirical emptiness of the debates” about intellectual property).

231. Council Directive 96/9 of the European Parliament and of the Council of 11 March 1996 on the Legal Protection of Databases, 1996 O.J. (L 077) 20 (EC), available at <http://europa.eu.int/eur-lex/lex/LexUriServ/LexUriServ.do?uri=CELEX:31996L0009:EN:H TML>.

B. *Such Protection Causes Transaction Costs and Effectively Shrinks the Public Domain*

The popular notion of the “public domain” includes works outside copyright because of their age (*Moby Dick*), their ineligibility for protection (Feistian databases), or their status as government works (statutes and cases). But sub-copyrightable bits and pieces of protected works are arguably as or more important to discourse and continued creativity than the unprotected works.²³² J.H. Reichman describes the problem this way:

As tiny bundles of small-scale innovation covered by strong intellectual property rights and strong contractual rights thus multiply, they divide up the community’s shared know-how into ever smaller parcels that are withdrawn from the public domain. This produces a tangled web of property and quasi-property rights that in itself constitutes a barrier to entry and a disincentive to further small-scale innovation.²³³

Reichman was writing about technological innovation, but the “tangled web” could also apply to expression.²³⁴ Microwork protection would mean “smaller parcels [of expression would be] withdrawn from the public domain.”²³⁵ Many of us are intuitively repelled by such an idea, but if we assume that the transaction costs were eliminated by some (unimagineable) efficient system, would there be any problem with a system requiring micropayments for the use of short phrases legally owned by others? The answer is yes. This is a huge danger for even a modest version of the “recombinant culture.” This danger to the recombinant culture exists regardless of transaction costs.

Technology holds out the prospect of solving the granularity problem through virtually frictionless clearinghouses. But the question about frictionless digital clearinghouses is not a technological issue; digital clearinghouses will never work “frictionlessly” in the case of copyright works unless we rewrite copyright law. This is because a copyright clearinghouse can only function for works registered to the clearinghouse

232. See Litman, *supra* note 216, at 976. Litman writes,

But the class of works not subject to copyright is, in some senses, the least significant portion of the public domain. The most important part of the public domain is a part we usually speak of only obliquely: the realm comprising aspects of copyrighted works that copyright does not protect.

Id.

233. Reichman, *supra* note 2, at 1776.

234. This problem of fine granularity effectively removing materials from the public domain has also been recognized in the context of Internet rights management systems which might require micro-payments for use of even the smallest amount of material from a work. See Julie E. Cohen, *Intellectual Privacy and Censorship of the Internet*, 8 Seton Hall Const. L.J. 693, 694 (1998) (discussing copyright management technologies “capable of operating at a very fine level of granularity”); David Nimmer, *Aus Der Neuen Welt*, 93 Nw. U. L. Rev. 195, 205 (1998) (discussing payments that would be required by a “cybercash filter attuned with an ultrafine degree of granularity to the relevant copyright management information”); see also Julie E. Cohen, *Copyright and the Perfect Curve*, 53 Vand. L. Rev. 1799 (2000).

235. Reichman, *supra* note 2, at 1776.

system. Since the Berne Convention requires that copyright arises (at least for foreign works) without “formalities,”²³⁶ no law can require registration in some clearinghouse mechanism as a condition for having enforceable rights. Since copyright arises on fixation—most protected works will remain unregistered²³⁷—and therefore subject to substantial search and uncertainty costs.

Concern for the minimum size threshold for liability under the intellectual property system is not new.²³⁸ The difference here is the problem is not driven directly by technological developments, where technology triggers unanticipated adverse effects from an existing legal concept, but by drift in the legal concept itself. This is similar to Rebecca Eisenberg and Michael Heller’s concern over “fine-grained” property protection in genetic material, i.e., the problems that could occur if exclusionary patent rights are awarded over gene fragments in such a way that one would have to deal with a multitude of different owners in order to assemble rights to a functional gene.²³⁹ The drift in the *CDN*, *Southco*, and *American Dental Ass’n* decisions shows courts doing what the United States Patent and Trade Office (“USPTO”) was flirting with doing in regard to gene fragments: identifying a very small thing (expression or innovation) as the protected res.

236. Article 5(2) of the Berne Convention provides that “[t]he enjoyment and the exercise of these rights shall not be subject to any formality.” Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, as revised at Paris on July 24, 1971 and amended on Sept. 29, 1979, 25 U.S.T. 1341, 828 U.N.T.S. 221 [hereinafter Berne Convention]. The United States joined the Berne Convention in 1989. See Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, §§ 7-9, 102 Stat. 2853. The United States has consistently interpreted this as meaning that registration of works protected via the Berne Convention (that is, foreign works) could not be required in order to exercise rights under U.S. copyright law.

237. A world in which every work were “registered” upon fixation would be one in which, for example, all composition occurred on networked PCs, so that the network could instantly “register” and catalog your work each time it did a timed backup. If people are permitted to use laptops—let alone pen and paper, canvases, unnetworked tape recorders, etc.—millions of unregistered works sprout into existence at any given moment.

238. For example, Pamela Samuelson and J.H. Reichman have presented cogent analyses of exclusionary entitlements becoming “finely grained.” In his discussion of the “green tulip,” for example, Professor Reichman has explored the problem of how to reward an innovator for a single subpatentable innovation without unduly burdening downstream applications of that single innovation. See J.H. Reichman, *Legal Hybrids Between the Patent and Copyright Paradigms*, 94 Colum. L. Rev. 2432, 2504 n.401 (1994); Reichman, *supra* note 2. Another variant of the “granularity” concern is that in a networked, digital environment, copyright owners will be able to extract payments for all types of uses of information products, including demanding micropayments for usages that everyone in the past would have considered free and/or fair use. See generally Trotter Hardy, *Property (and Copyright) in Cyberspace*, 1996 U. Chi. Legal F. 217 (describing and defending the appropriateness of such a system).

239. Michael A. Heller & Rebecca S. Eisenberg, *Can Patents Deter Innovation? The Anticommons in Biomedical Research*, 280 Sci. 698, 698-701 (1998); see also Burk & Lemley, *supra* note 225, at 1195-96 (2002) (“A multitude of narrow patents seems likely to strangle downstream product development in a morass of required licenses . . .”).

Still, what would be the danger in a frictionless system of micropayments for microworks? The public domain is society's accumulated information stock. If we moved toward a system of ownership of microworks, the stockpile of information capital would not disappear; one would just have to pay a little to use it—no different than when an entrepreneur wants to borrow money from the markets (our accumulated capital stock). These new, additional costs might suppress some artistic and informational production, at least initially. But according to one view, that decline would correct itself over time. If the protection of microworks brings additional royalties to owners of creative works, the larger income stream provides more capital in economic sectors that generate creative works. Because of increased revenue streams, subsequent creative works can be expected to have increased budgets (that might pay for the increased payments to microwork owners).²⁴⁰

But we do not need to resolve that debate to see the redistributive impact of the public domain (or its diminution). In the rosiest, most frictionless scenario there is a difference in who accumulates capital, both informational and financial. Independent protection of microworks and a micropayment structure would transfer wealth to existing owners of informational or financial capital. This would weaken the egalitarian, empowering aspect of intellectual property: that it allows individuals with little or no preexisting property to develop valuable property out of public domain materials, completely unencumbered by obligations to prior property owners.²⁴¹

240. This is a variation of one of the arguments used to justify the twenty-year extension of copyright protection that Congress passed in 1998; it would bring additional revenue to copyright owners which would, in turn, get plowed back into new copyrighted works. See, e.g., S. Rep. No. 104-315, at 12 (1996) (“[T]he promise of additional income will increase existing incentives to create new and derivative works.”), available at <http://www.copyright.gov/legislation/s-rep104-315.html>. Stated that way, the argument erroneously treats copyright industries as economically self-contained. If Disney is a rational actor, when it makes an additional \$100 million in copyright royalties, it should invest that money where it brings the highest returns, whether in a new motion picture, a new rollercoaster, or a high-tech hedge fund. As Dennis Karjala notes, the Senate report—and companion documents—“mentions no mechanism for insuring that the extra income will indeed be used for this purpose [new works].” Dennis S. Karjala, *Judicial Review of Copyright Term Extension Legislation*, 36 Loy. L.A. L. Rev. 199, 207 & n.35, 208 (2002). Conversely, if film projects are appealing they will attract capital from copyright owners, French banks, French waterworks owners, and Canadian liquor company magnates. A better form of the argument is that in a properly functioning market higher expected revenues for any copyrighted work *X* will prompt larger investment in each *X* work and/or investment in more *X* works, regardless of where the investment comes from. At that point, people can disagree about the optimal level of investment in expressive works.

241. See, e.g., Justin Hughes, *The Philosophy of Intellectual Property*, 77 Geo. L.J. 287, 291 (1988) (arguing that intellectual property, by propertizing the “talent” of newcomers, does not offer the conservative bias of property which some political theorists like Edmund Burke advocate). A similar point is raised in Randal C. Picker, *From Edison to the Broadcast Flag: Mechanisms of Consent and Refusal and the Propertization of Copyright*, 70 U. Chi. L. Rev. 281, 295-96 (2003) (noting that “even if dropping transaction costs allowed us to price discriminate perfectly,” people can raise objections if their “allocative tastes” do not favor giving the producer all the surplus value).

C. *A Minimum Size Principle Complements Other Elements of Copyright Laws*

Requiring works to be of a minimum size in order to qualify for independent copyright protection comports with our presumptions about independent creation as well as with how we use the merger, “fragmented literal similarity,” de minimis, and fair use doctrines. As to the first of these, the doctrinal tenet that titles and short phrases lack originality has a corollary in our presumption that larger works do have originality. Generally speaking, microwork protection would complicate copyright litigation as each case included proof and counter-proof on the question of originality. Exemplary of this is *Acuff-Rose Music, Inc. v. Jostens, Inc.*, concerning infringement of the phrase “You’ve got to stand for something, or you’ll fall for anything.”²⁴² The defendant prevailed on summary judgment with evidence ascribing the same or similar phrase to Abraham Lincoln, John Cougar Mellencamp, and Martin Luther King, Jr. On appeal, Acuff-Rose contended that the copyright registration and a letter from William Brock, the putative originator of the phrase, were both evidence of the plaintiff’s originality. Judge Guido Calabresi noted that “[b]oth of these constitute some evidence that Brock thought he had come up with the words on his own,” but agreed with the district court that prior usage made it exceedingly unlikely that Brock had independently created the phrase.²⁴³

Another side effect of microwork protection would be strenuous, if not continuous, application of the merger doctrine. The 1998 *Matthews v. Freedman* litigation concerned a t-shirt design centered on the phrase “Someone Went to Boston and got me this shirt because they love me Very much.”²⁴⁴ The court concluded that even if the “Someone Went to Boston . . .” phrase was original to the plaintiff,²⁴⁵ a copyright over such a small creation “would virtually give Matthews a monopoly on the underlying idea.”²⁴⁶ Professor Goldstein reasons that “the shorter a phrase is . . . the more likely it is to constitute an idea rather than an expression” and “the shorter the phrase, the less likely it is to have acceptable substitutes, thus barring protection under the merger doctrine.”²⁴⁷ Since a phrase always is an expression of one idea or another, Goldstein’s two points really say the same thing: As the expression becomes smaller and smaller, it becomes

242. *Acuff-Rose Music, Inc. v. Jostens, Inc.*, 155 F.3d 140, 141 (2d Cir. 1998).

243. *Id.* at 144 (emphasis added).

244. *Matthews v. Freedman*, 157 F.3d 25, 26 (1st Cir. 1998).

245. The court concluded that it was “by no means clear” that the “sentiment” could be original to Matthew. *Id.* at 28; see also *Arnstein v. Porter*, 154 F.2d 464, 477 (2d Cir. 1946) (Clark, J., dissenting) (noting that the case was based on a “claim of plagiarism of small detached portions here and there” and that the plaintiff’s songs were “of the simple and trite character where small repetitive sequences are not hard to discover”).

246. *Matthews*, 157 F.3d at 28. In *Matthews*, the plaintiff sought protection of a t-shirt design that was both design and text, so the case was not, strictly speaking, a “short phrase” case.

247. 1 Goldstein, *supra* note 189, § 2.7.3, at 2:96.

much more likely that it is the only reasonable expression of a simple idea. What we call "merger" must apply very frequently with short phrases.

Yet another place where microwork protection would grind against the existing machinery of copyright is the "fragmented literal similarity" doctrine. The doctrine of fragmented literal similarity²⁴⁸ is used to find liability where the expressions taken from the plaintiff's work are not individually large and appear scattered through the defendant's work. Obviously, if the protected "work" becomes small enough, the fragmented similarity doctrine becomes irrelevant; liability will attach for copying the entirety of a choice slogan or turn of phrase because that is the "work." Put differently, fragmented literal similarity between two works is not a single fragment of literal similarity between two works.

The impact of microwork protection on the fair use doctrine and the de minimis doctrine is both obvious and devastating. Microwork protection simply makes a hash of each of these defenses which, in different forms, consider whether enough was copied to constitute actionable copying.²⁴⁹ As Judge Leval observed in his example of a (copyrighted) extortion letter, "If a communication is sufficiently brief, any quotation will necessarily take most or all of it."²⁵⁰

If a single number or short phrase or five lines of computer code is independently protectable, then a person who thinks she has taken just the tiniest bit from a book, program, or other normal-size work will find herself liable for copyright infringement. If one tilts reality just a bit and looks at it from an angle, one already has the obverse problem with the GNU General Public License ("GPL"), the core instrument to insure that downstream developments from open source software remain open source.²⁵¹ The GPL is intentionally "viral" in that it provides that including any open source software in a new software product renders that new software product as an

248. 4 Nimmer on Copyright, *supra* note 158, § 13.03[A], at 53-59.

249. See *Vault Corp. v. Quaid Software, Ltd.*, 847 F.2d 255, 267 (5th Cir. 1988) (holding that thirty characters copied out of fifty pages of source code was de minimis). While we can acknowledge "the partial marriage between the doctrine of fair use and the legal maxim de minimis non curat lex," *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 451 n.34 (1984) (quoting Professor Latman), the de minimis defense is quite separate.

250. Pierre N. Leval, *Toward a Fair Use Standard*, 103 Harv. L. Rev. 1105, 1123 (1990). Similarly, in 1963, during the attenuated process to produce the 1976 Copyright Act—and its shift away from a registration system—one of the participants (himself a representative of composers) commented,

I visualize a day on which every scrap of writing, every memorandum, every letter, every piece of unidentifiable typescript is entitled to Federal copyright . . . when every scrap of paper, every writing of any kind becomes entitled to copyright, there may be a strong public interest in having very minimal remedies with respect to that [kind of work] . . .

House Comm. on the Judiciary, 88th Cong., Copyright Law Revision, Part 4, at 23 (Comm. Print 1964) (Transcript of Meeting on Preliminary Draft for Revised U.S. Copyright Law: Discussions of §§ 19-23, Chicago, August 15-16, 1963) (statement of Sydney M. Kaye, Broadcast Music, Inc.).

251. GNU General Public License, Version 2 (June 1991) <http://www.gnu.org/licenses/gpl.txt>.

open source product, available to all.²⁵² This aspect of the GPL—not defining how much borrowing from an open source program converts the borrower’s work into open source—has caused much concern among software companies. The microwork problem in software strangely works in much the same way, i.e., if subroutines within a program become independent works, then borrowing a small bit from a proprietary program could render the borrower’s new work into an authorized derivative work and therefore, place that work in the public domain.

As for § 107 fair use, the third factor in the § 107 analysis—“the amount and substantiality of the portion used in relation to the copyrighted work as a whole”²⁵³—is directly sensitive to the size of the work; the smaller the work, the more likely it is that the defendant will lose on this factor. But the first and fourth factors are also sensitive to the size of the work. The smaller the work, the less likely that there will be both copying and transformative use, and thus it will be harder for the defendant to have the first factor in her favor.²⁵⁴ And as smaller and smaller creations are recognized as the work, the logic of the system will tend to push courts to see new markets for these very small works, creating an adverse effect on the perceived “potential market” under the fourth factor.

252. This is the clear intent of the General Public License (“GPL”). At section 0, it provides,

The “Program,” below, refers to any such program or work, and a “work based on the Program” means either the Program or any derivative work under copyright law: that is to say, a work containing the Program or a portion of it, either verbatim or with modifications and/or translated into another language.

(Hereinafter, translation is included without limitation in the term “modification.”)

Id. And, at section 2, “You must cause any work that you distribute or publish, that in whole or in part contains or is derived from the Program or any part thereof, to be licensed as a whole at no charge to all third parties under the terms of this License.” *Id.*

253. 17 U.S.C. § 107 (2000).

254. This is interpreting the first factor to mean genuine “transformation”; there are some scholars who maintain that providing the work or parts of the work through a sufficiently different avenue of transmission such that it does not supercede the first work counts as “transformation.” See *Kelly v. Arriba Soft Corp.*, 336 F.3d 811, 819 (9th Cir. 2003). This reading of transformation sits uneasily with the focus the Supreme Court gave the concept. For the Court, the question is whether the “work merely ‘supersede[s] the objects’ of the original creation, or instead adds something new, with a further purpose or *different character*, altering the first with new expression, meaning, or message. It asks, in other words, whether and to what extent the new work is ‘transformative.’” *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994) (quoting *Folsom v. Marsh*, 9 F. Cas. 342, 348 (C.C.D. Mass. 1841) (No. 4901)). The passages emphasize that it is the work, not the distribution mechanism, that needs to be transformative. More importantly, it should be obvious that this collapses the first and fourth factors in § 107. There are four factors and we are obliged to assume that each one means something different. “Transformation” of a work is not photocopying it or offering it up through a different delivery mechanism. See *Infinity Broad. Corp. v. Kirkwood*, 150 F.3d 104 (2d Cir. 1998) (holding that retransmissions are not “transformative” uses); *Am. Geophysical Union v. Texaco, Inc.*, 60 F.3d 913 (2d Cir. 1994) (holding that photocopies distributed within a company are not transformative works or uses).

V. FRAMEWORK FOR A MINIMUM SIZE PRINCIPLE

Commentators sometimes prescribe reforms that are infeasible, either politically or operationally. The discussion here will sketch out a judicially created minimum size test for text works, describing how these elements could be codified by Congress in a definition of “work.” But let us first consider the political environment for such a proposal.

A minimum size principle would be politically feasible because major music, publishing, and audiovisual companies have an interest in keeping short phrases and single words readily available for their own use—the same kind of interest which should rationally make them defenders of the *scenes-à-faire* doctrine, nominative and descriptive fair use in trademark law,²⁵⁵ and the bar on federal government works being copyrighted. All of these doctrines provide creative people, and the copyright industries, with free inputs. Titles, names, and short phrases are used over and over again. For example, there have been three major films titled “Moulin Rouge”;²⁵⁶ a best-selling song/album and unrelated teen film titled “American Pie”;²⁵⁷ one popular song, three films, and a best-selling book (related to only one of the films) titled “Helter Skelter”;²⁵⁸ and a major film, a blockbuster Broadway production, and an over-the-counter antihistamine called “Contact.”²⁵⁹ And that is before we begin to plumb the depths of substantial similarity. No executive in the creative industries wants to create a cognizable claim when Ray Bradbury says that Michael Moore’s “Fahrenheit 9/11” appropriated Bradbury’s “Fahrenheit 451” title.²⁶⁰

But is a minimum size principle that is separate from the originality requirement substantively feasible? In *Southco III*, Judge Edward Becker concurred in the result but disagreed that the short size of the numbers was an independent reason to deny their copyrightability. Becker posed the problem succinctly:

In order for any test that purports to distinguish between short phrases and copyrightable compositions to be viable it would have to identify the point at which a title or short phrase becomes a descriptive narrative.

255. See, e.g., *Mattel, Inc. v. MCA Records, Inc.*, 28 F. Supp. 2d 1120 (C.D. Cal. 1998).

256. *Moulin Rouge* (British Int’l 1929) (E.A. Dupont, director) (silent film); *Moulin Rouge* (MGM/UA Studios 1952) (John Huston, director); *Moulin Rouge* (20th Century Fox 2001) (Baz Luhrmann, director).

257. *American Pie* (Universal Pictures 1999); Don McLean, *American Pie* (UA Records 1974).

258. The Beatles, *Helter Skelter*, on *The Beatles White Album* (Capitol/EMI Records 1968); *Helter Skelter* (One Shot Prods. 2000) (Jess Franco, director); *Helter Skelter* (Warner Bros. 1976) (Tom Gries, director); *Helter Skelter* (Gainsborough Studios 1949) (Ralph Thomas, director); Curt Gentry & Vincent Bugliosi, *Helter Skelter: The True Story of the Manson Murders* (25th Anniversary ed. 1994).

259. *Contact* (Warner Bros. 1997) (Robert Zemeckis, director).

260. Yes, Ray Bradbury complained about this. See Frank Rich, *The Best Goebbels of All?*, N.Y. Times, June 27, 2004, at A1 (“This month Mr. Bradbury, now 83, complained that Michael Moore had appropriated the title of ‘Fahrenheit 451,’ his classic novel about book-burning totalitarianism, without permission.”).

Presumably the length of the writing in question informs this determination, but what else?²⁶¹

The “what else” to support the minimum size principle, particularly for text works, is a multifactor analysis that appeals to (a) commercial activities, such as investment decisions and marketing valuations; (b) our intuitive sense of a “composition;” and (c) the registration practices of copyright owners. Note what is not on this list. One thing not on this list is the views of authors and critics about what constitutes a “work.” Postmodern literary theory will not help us in our quest for a manageable understanding of a “work,” precisely because it has recognized that originality, creativity, and importance may come in very small packages.

Even limiting ourselves to text works, the range of things that strike us as “works”—from Tolstoy novels to Dickinson poems—shows that we will not be able to construct anything approaching a single, bright-line test for a copyrightable work. The problem we are facing is hardly unique to American law. According to André and Henri-Jacques Lucas, French law on copyright protection of titles is “difficult to synthesize”²⁶² and “the problem comes from too comprehensive a conception of the ‘work’”²⁶³—exactly the problem festering in our law, as exemplified by the cases reviewed in Part I. Although French jurisprudence consciously prohibits copyright in titles even if they manifest originality,²⁶⁴ Lucas and Lucas conclude, quite rightly, that copyright protection should not be subjected to an absolute “volume” test.²⁶⁵ If that is true, perhaps discretion, and a bit of

261. *Southco, Inc. v. Kanebridge Corp. (Southco III)*, 390 F.3d 276, 289 (3d Cir. 2004) (Becker, J., concurring). Becker goes on to critique the majority: “The majority does not specify the test, and this is not a situation, I respectfully submit, where we ‘know it when [we] see it.’ . . . Whatever the test, I think the inquiry would inevitably draw us back to the constitutional requirement of originality . . .” *Id.*

262. Lucas & Lucas, *supra* note 224, ¶ 108 (characterizing French cases about copyright over titles as “une jurisprudence abondante, bien difficile à synthétiser”). The authors express understandable puzzlement that originality has been assumed in a number of copyright cases over fairly pedestrian phrases.

263. *Id.* The French text reads as follows: “Le mal vient, croyons-nous, d’une conception trop compréhensive de l’œuvre de l’esprit.”

264. *See id.* at ¶ 108, at 112 (“La jurisprudence en est bien consciente qui limite ici la portée du droit d’auteur en posant que le titre, même s’il est original, n’est pas protégé en tant que tel contre tout usage, et notamment peut être librement utilisé pour réaliser un index documentaire.” The French text is translated into English as follows: “The jurisprudence of it is quite conscious which limits here the range of the royalty while posing that the title, even if it is original, is not protected as such against any use, and in particular can be freely used to carry out a documentary index.”); *see also* Tribunal de grande instance [T.G.I.] [ordinary court of original jurisdiction] Paris, July 13, 1989, Juris-Data 042828 (refusing copyright protection of expression “bide centenaire” while recognizing that the phrase showed a “flash of wit”), *cited in* Jan Klink, *Titles in Europe: Trade Names, Copyright Works or Title Marks?*, 26 Eur. Intell. Prop. Rev. 290, 294 (2004). It should be added that disputes about title protection in France are complicated by moral rights considerations.

265. *See* Lucas & Lucas, *supra* note 224 (“Certes, la protection légale n’est pas subordonnée à la taille ou au volume de la création.” The French text is translated into English as follows: “Certainly, legal protection is not predicated upon the size or the volume of the work.”).

hypocrisy, is the better part of valor. Are we better off with our myth that lack of originality is the only bar to copyright? The discussion that follows takes some baby steps toward a viable, thinkable minimum size principle, separate from copyright's originality requirement.

A. *Commercial Practices, Market Valuations, and Economic Viability*

To date, the definitional lacuna for a "work" has troubled the copyright system only infrequently. For example, in *Edison v. Lubin*,²⁶⁶ a 1903 case which tested the copyrightability of Thomas Edison's new "moving pictures," the district court ruled that each frame of the motion picture required a separate copyright notice and registration because each frame was a "photograph."²⁶⁷ On appeal, the Third Circuit saw this was an absurd result, particularly since any two frames, side by side, would be indistinguishable. The court reoriented the concept of "photograph"²⁶⁸—hence, of "work"—to include a moving picture in its entirety.

But generally speaking the work is almost always taken as a given, at least in the liability phase. The one area of law where the absence of a statutory definition of a "work" has challenged courts is in damage calculations, because copyright law affords statutory damages based on the infringement of each work.²⁶⁹ In such cases, courts have provided various commentaries on and formulations of what constitutes a copyrighted work, some metaphorical and some more rigorous. A number of courts have defined "works" as informational/cultural things that "live their own copyright life,"²⁷⁰ a description as vivid as it is circular. Many of the same

266. 122 F. 240 (3d Cir. 1903).

267. *Id.* at 243. The district court reasoned that the "copyrighting system" applied to "any . . . photograph," but not to any aggregation of photographs, and I think that, to acquire the monopoly it confers, it is requisite that every photograph, no matter how or for what purpose it may be conjoined with others, shall be separately registered, and that the prescribed notice of copyright shall be inserted upon each of them.

Id. at 241 (ellipsis in original) (internal quotations omitted).

268. The appellate panel did so by understanding that Congress intended to cover technological progress:

When Congress, in recognition of the photographic art, saw fit in 1865 to amend the act of 1831 and extend copyright protection to a photograph or negative, it is not to be presumed it thought such art could not progress, and that no protection was to be afforded such progress. . . . While such advance has resulted in a different type of photograph, yet it is none the less a photograph—a picture produced by photographic process.

Id. at 242 (citation omitted).

269. *L. A. Westermann Co. v. Dispatch Printing Co.*, 249 U.S. 100, 104-06 (1919) (interpreting 1909 Copyright Act).

270. *MCA Television Ltd. v. Feltner*, 89 F.3d 766, 769 (11th Cir. 1996); *Robert Stigwood Group Ltd. v. O'Reilly*, 530 F.2d 1096, 1105 (2d Cir. 1976). The usefulness of cases like *Stigwood* for our purposes is lessened by the fact that the court is directly grappling with how many "infringements" there are, not with how many "works." This raises the prospect of there being one infringement of multiple works. In other words, the court concluded that the "infringement of performing rights of *overlapping* copyrights or substantial parts of the entire work should be considered as a single infringement." *Id.* at 1104.

courts have helpfully advanced the view that a copyrightable work is an “expression [that] has an independent economic value and is, in itself, viable.” The Nimmer treatise expands this tentatively and inquiringly, suggesting that “the work that is the subject of a separate copyright would have to be in itself musically, dramatically, or otherwise viable”²⁷¹ But do these tests give us a good way to draw the frontiers of a work?

First, we must recognize that being “musically viable” or “dramatically viable” is quite different from having “independent economic value” or being “economically viable.” I take musical viability and dramatic viability to be issues of artistic integrity. While the answer to such questions has some relevance to economic independence, the relevance is through the intermediation of consumer expectations. Consumers probably would not download digital tracks that cut off twenty-five percent of the song, even if the file were discounted twenty-five percent. So works that are “musically viable” or “dramatically viable” fall under the category of works discussed below, where a work’s “sense of composition” is considered. Here we are focused on economic measures.

There are different ways to consider whether an expression has “independent” economic value or viability. As discussed below, courts have sometimes considered how the works were produced while, at other times—and sometimes in the same opinion—courts have discussed how the works were marketed. There is even an occasional reference to how infringers act in their unauthorized copying. In other words, answering the question of independent economic existence depends on looking at the economics of the expression’s “product cycle” at different points.

In *MCA Television Ltd. v. Feltner*, the court of appeals noted that “[e]ach episode was produced independently from the other episodes and each was aired independently from preceding and subsequent episodes.”²⁷² Similarly, in *Gamma Audio & Video Inc. v. Ean-Chea*, the First Circuit focused on the fact that “each episode in the *Jade Fox* series was separately produced.”²⁷³ Alternatively, economic “viability” can be evinced by marketing. The *Gamma Audio & Video* court reversed a trial court conclusion that each episode of the television show was not a separate work. The trial court noted that four episodes of a television series were consistently sold to video rental stores together in one package, and found that this was sufficient evidence that the four episodes constituted one “work.”²⁷⁴ The First Circuit reversed, not only based on its reasoning that each episode was separately produced, but also on reasoning drawn from marketing. The court observed that the video stores that purchased the packaged series rented single-episode tapes to end-use customers who “may

271. See 4 Nimmer on Copyright, *supra* note 158, § 14.04[E][1].

272. *MCA Television*, 89 F.3d at 769.

273. *Gamma Audio & Video Inc. v. Ean-Chea*, 11 F.3d 1106, 1117 (1st Cir. 1993).

274. *Id.* at 1115.

view one, two, or twenty episodes in a single sitting, and may never watch or rent all of the episodes"²⁷⁵

Another variation of the marketing perspective is to judge how the pirate harms the copyright owner. In *Edison*, the Third Circuit reasoned "that [a motion picture] is, in substance, a single photograph, is shown by the fact that its value consists in its protection as a whole or unit, and the injury to copyright protection consists not in pirating one picture [frame], but in appropriating it in its entirety."²⁷⁶ These inquiries, into how the value is protected and how the defendant harms the plaintiff's economic interests, have also been used to prevent the mere fact that multiple copyrights exist from leading inexorably to the conclusion that multiple works have been infringed.

The multiple-copyrights/single-work analysis was used to limit damages in *Robert Stigwood Group v. O'Reilly*,²⁷⁷ concerning the unauthorized performance of a rock opera. The opera was protected by three overlapping copyrights (for the music, the libretto, and the vocal score), but the Second Circuit concluded that they were not independently viable and, therefore, that only one "work" had been infringed.²⁷⁸ Eight years later, in *RSO Records, Inc. v. Peri*, a Southern District of New York court reasoned that where separate copyrights "have no separate economic value, whatever their artist value, they must be considered part of [a] . . . 'work' for purposes of the copyright statute."²⁷⁹ Perhaps the most interesting result in this family of cases came in the District of Columbia Circuit's conclusion in *Walt Disney Co. v. Powell*:

While Mickey and Minnie are certainly distinct, viable works with separate economic value and copyright lives of their own, we cannot say the same is true for all six of the Disney copyrights of Mickey and Minnie in various poses which the district court found to be infringed in this case. Mickey is still Mickey whether he is smiling or frowning, running or walking, waving his left hand or his right. Thus, we find that Powell's mouse-face shirts infringed only two of Disney's works.²⁸⁰

Although it is black-letter doctrine that characters are only protected as elements of copyrighted works, the court concluded that the defendant had violated two copyrights, not six copyrights, although the Mickey and Minnie poses came from six different movies.²⁸¹ In other words, whatever the doctrine tells us the "work" is, the harm was to Mickey and his mate.

275. *Id.* at 1117; see also *Cormack v. Sunshine Food Stores, Inc.*, 675 F. Supp. 374, 376-77 (E.D. Mich. 1987) (holding that written tests designed to detect honesty and emotional status, respectively, in the workplace are not one "work" for the purpose of statutory damages just because they are packaged and sold together).

276. *Edison v. Lubin*, 122 F. 240, 242 (3d Cir. 1903).

277. 530 F.2d 1096 (2d Cir. 1975).

278. *Id.* at 1104-05.

279. *RSO Records, Inc. v. Peri*, 596 F. Supp 849, 862 n.16 (S.D.N.Y. 1984).

280. *Walt Disney Co. v. Powell*, 897 F.2d 565, 570 (D.C. Cir. 1990).

281. See *id.* at 570 n.10 ("Two of the copyrights that Disney argued Powell infringed portrayed Mickey and Minnie in poses used in the movie 'Steamboat Willie.' While

These kinds of comments about episodes, film frames, characters, or copyrights being “independent,” “viable,” or “valuable” are dissatisfying on many fronts. Typically, they give only a partial analysis of the creative market involved. With serial television—the subject of many of these cases²⁸²—the original decision to produce a television series is made after a green light from the network authorizing a single season of the show (anywhere from thirteen to twenty-two episodes). Similarly, each year, the network renews or cancels the series. So is the season the proper unit of production or economic viability? If the network has the contractual option to cancel after the first five episodes because of low ratings,²⁸³ are the first five episodes themselves the real unit of economic viability? On the marketing side, if the television show is eventually syndicated, it will also be syndicated on the basis of seasons, not individual episodes.²⁸⁴

To further complicate things, economic viability and economic value are quite different. If the test is whether any one episode has some independent economic value, then each episode unquestionably has some value. The fact that economic value of a whole exceeds the sum of the value of its parts by a significant amount does not negate the potential that each economic part may have significant value. The existence of significant value in the smaller “part” seems to exist both in consumption and production.

It warrants pointing out that nineteenth-century English law also used a production/marketing approach to measure when a single sheet of paper could be a “book.” In the 1842 amendment of the English Copyright Act, “book” was defined “to mean and include every Volume, Part or Division of a Volume, Pamphlet, Sheet of Letterpress, Sheet of Music, Map, Chart,

‘Steamboat Willie’ is a work that has a distinct economic value and a copyright life of its own. Powell did not infringe any elements of the movie other than Mickey or Minnie. Thus his infringement on the characters completely overlaps any infringement of the movie.”)

282. Audiovisual serialization had, of course, a strong nineteenth-century counterpart in nineteenth-century publishing practices in which serialization of novels through publication in periodicals and “three deckers” was much more common than today. See generally Lee Erickson, *The Economy of Literary Form: English Literature and the Industrialization of Publishing, 1800-1850* (1996); J.A. Sutherland, *Victorian Novelists and Publishers* (1976); Diane Leenheer Zimmerman, *Authorship Without Ownership: Reconsidering Incentives in a Digital Age*, 52 DePaul L. Rev. 1121, 1156-62 (2003) (additional sources cited therein).

283. According to director Harry Winer (*Dawson’s Creek, Party of Five, Alias, Tarzan, Summerland*, etc.), current network practice may lead to a new show being pulled anywhere from two to fourteen episodes into the first season as networks chase ratings. E-mail from Harry Winer, Director, to Justin Hughes, Associate Professor, Cardozo Law School (June 21, 2004, 17:14 PST) (on file with author).

284. In *MCA Television Ltd. v. Feltner*, the defendant faced a huge damage award for the unauthorized airing of MCA television shows. Against MCA’s claim that each episode was a work that had been infringed, the defendant “assert[ed] that the industry practice is to enter contracts for television series, not individual episodes of series, and that no one would purchase and air just one episode of a series.” 89 F.3d 766, 769 (11th Cir. 1996). Although Feltner lost, the most suitable vantage point to judge “economic viability” in the ex ante structure of copyright is arguably this investment decision perspective.

or Plan separately published”²⁸⁵ Thus, status as a “book” was triggered by separate publication, so that a page from a book would not be protected as a “book,” but a page printed and distributed as a flyer (a “Sheet of Letterpress”) would be. This separate publication test was a harbinger of the economic viability test used by American courts to define “works” for purposes of statutory damage calculations. Like its twentieth-century descendant, the separate publication test is helpful, but had ambiguous, manipulable edges.²⁸⁶

On the other side (the consumption side—we all have favorite scenes), one person might be unwilling to pay to see all of *Star Wars: The Clone Wars* again, but would pay a small fee to see the Yoda/Count Dooku fight scene again.²⁸⁷ Another person might feel that way about the dance sequences in a Gene Kelly movie or *Moulin Rouge*. Bob Fosse’s dance sequences can be watched for their own glory, regardless of the *Cabaret* storyline, and you do not need to know anything about the stories to appreciate the cinematographic style of individual scenes by Nestor Almendros (*Days of Heaven*) or Michael Chapman (*Raging Bull*). This separate consumption value is probably quite limited and “locked up,” so to speak, by our distribution channels. But it exists nonetheless.

As to production, a film’s car chase scene has its own independent economic value in the sense that it was probably budgeted separately.²⁸⁸ There are any number of reasons a scene might have its own separate budget: The scene might be shot on location, require the construction of its own sets, require particular special effects, or simply be added later in the process.²⁸⁹ The special effects scenes, the scenes at different locations, or the action scenes may involve completely different production entities. As soon as a scene has a recognizable, separate budget, it becomes subject to judgments about value and worth, and, in this sense, has its own

285. An Act to Amend the Law of Copyright, 1842, 5 & 6 Vict., c. 45, § 2 (Eng.). The Act also provided protection for “Dramatic Piece[s]” defined as “every Tragedy, Comedy, Play, Opera, Farce, or other scenic, musical, or dramatic Entertainment” *Id.*

286. The “separately published” criterion, however, could itself be made a subjective test of whether or not something was a free-standing work. According to one commentator interpreting the 1842 law, “Each part of a book that is separate, and clearly distinguished in the volume itself was separately published within the meaning of s. 2 of the 1842 Act The author of a book could have copyright in the letterpress and the copyright in the illustrations belong to another.” Earl of Halsbury, 7 Halsbury’s Laws of England 540 n.(c) (Viscount Hailsham, ed., 2d ed. 1932) (citations omitted).

287. For the official description of Yoda and Count Dooku’s fight using lightsabers and the Force, see Starwars Databank, <http://www.starwars.com/databank/character/yoda/> (last visited Sept. 26, 2005).

288. Typically, with an action movie, there is a primary filming budget and a “second unit” budget. The second unit does all explosion, stunt, and heavy action scenes. E-mail from Allison Wilke, Producer, Hollywood Homicide (Columbia TriStar 2003), to Justin Hughes, Associate Professor, Cardozo Law School (Oct. 31, 2005 06:10 PST) (on file with the author); E-mail from Harry Winer, *supra* note 283; E-mail from Jeri Taylor, Producer of *Star Trek: Next Generation* and *Star Trek: Voyager*, to Justin Hughes, Associate Professor, Cardozo Law School (on file with the author).

289. These expenditures are typically budgeted as “additional photography.” E-mail from Allison Wilke, *supra* note 288.

independent economic value. Of course, the production of these scenes is in service to a greater objective: telling the story of the entire film or television episode. But as soon as we resort to talking about these elements being made “in service to” a larger goal, we are moving back to the intuitive idea of a “work” or “composition.”

Consider what is one of the most convincing cases about economic viability: one in which all or almost all viability measures fall one way. In *Video Aided Instruction, Inc. v. Y & S Express, Inc.*, the district court concluded that printed study booklets and audio home study recordings were “not separate viable works worthy of separate awards” from infringement of the videocassettes which they accompanied because “these booklets and audio portions are merely subunits of the . . . video-cassette series.”²⁹⁰ Here almost everything lines up: One would not produce the booklet without the videocassette, one would not market the booklet without the videocassette, one would not buy the booklet without the videocassette. And yet it is almost everything because we can still find ways to parse out independent economic status for the booklet. Perhaps the booklet was produced by a subcontractor who sent a bill to the videotape company: If that were true, from the subcontractor’s perspective, wouldn’t the booklet have independent economic value?

The reader may have an obvious question: In these damage calculation situations, plaintiffs have an incentive to obtain damages for infringement of as many “works” as possible, so why hasn’t the “microwork” issue been more fully vetted in these disputes? The answer is that the United States Code expressly prevents “double” counting, providing that for purposes of damage calculations “all the parts of a compilation or derivative work constitute one work.”²⁹¹ This has shielded courts from strenuous arguments for microwork protection in situations where recognition of a microwork would relabel the larger work as a “compilation” work.²⁹² Undoubtedly, it

290. *Video Aided Instruction, Inc. v. Y & S Express, Inc.*, No. 96-CV-518, 1996 WL 711513, at *5 (E.D.N.Y. Oct. 29, 1996).

291. 17 U.S.C. § 504(c)(1) (2000).

292. Although this provision has undoubtedly saved courts from what would have been reams of briefing about what constitutes the “work,” it has not protected them completely. For example in *UMG Recordings, Inc. v. MP3.com, Inc.*, MP3.com was found liable for having copied tens of thousands of CDs as a first step in building its “Beam It” service. 92 F. Supp. 2d 349 (S.D.N.Y.), *later proc’ding at* 109 F. Supp. 2d 223 (S.D.N.Y. 2000). Universal Music Group (“UMG”) argued that MP3.com’s liability should be “per song” on the grounds that each song is a “work.” UMG argued that treating each song as a work for calculation of damages was especially appropriate because MP3.com had “listed individual songs, encouraged users to create their own playlists without regard to a given CD album, and measured the traffic on its service according to the number of ‘hits’ received for each individual song-title.” Lionel S. Sobel, *Oh, What a Tangled Web We Can Weave if We Can Download Properties Claimed by Others, or at Least so We Believe*, in *Entertainment, Arts, and Sports Law*, ALI-ABA Course of Study 379, 390 (ALI-ABA 2001). In a later proceeding, Judge Rakoff found these arguments inapposite against the clear direction of 17 U.S.C. § 501(c)(1), noting that “[w]hen Congress speaks, the courts must listen.” *UMG*, 109 F. Supp. 2d at 225. This ruling, of course, reduced UMG’s potential recovery to

has also prevented overreaching claims concerning infringement of multiple versions of the same work: As long as all the versions are derivative of the original expression, there is only one “work” infringed.²⁹³

The statutory damages case law teaches us that the economic independence test depends on how much independent economic value will count and that the test is highly perspective dependent.

But there may be a bright lining to this cloudy problem. We do not need to solve the puzzle of a creation’s economic viability or independent economic value in the absolute sense; we only need to solve the puzzle in the context of the plaintiff’s particular claim. We could take the perspective that a separate work exists where a copyright owner, or its predecessor in interest, made an economic decision to produce and distribute the work. Though this approach does not solve all problems (the newspaper publisher makes decisions about the paper and individual editions of the paper), it helps address the microwork problem. None of the plaintiffs in the cases discussed in Part I—Maclean Hunter, CDN, the AMA, the ADA, and the hardware parts company—would have been able to show an economic decision to produce and distribute single evaluations, key phrases, etc. Perhaps the same applies to recombinant uses of the digital era; individual software subroutines are not produced for distribution individually and decisions are not to produce very short melodies for distribution individually. With the possible exception of titles, a plaintiff will probably be unable to show any economic decision concerning production and distribution of a single phrase, paragraph, number, judgment, or computation.

B. *A Quantitative Threshold of Amount of Text: A Sense of “Composition” and Value for the Audience*

There is a strain of American and English cases which, to varying degrees, can be understood as requiring that a creation be a minimum size or manifest a certain kind of integrity and/or minimum size. In a well-known case from the 1970s, *Alberto-Culver Co. v. Andrea Dumon, Inc.*,²⁹⁴ the Seventh Circuit concluded that the phrase “most personal sort of deodorant” was unprotectable because it was an “ordinary phrase” and lacked “an appreciable amount of original text.”²⁹⁵ This case is traditionally taught as holding that the slogan in question lacked originality, but notice the court’s phrase “appreciable amount,” suggesting that too

approximately 1/12th of what it had been, facilitating the final UMG/MP3.com settlement for \$53.4 million. Sobel, *supra*, at 391.

293. For a discussion of this, see 4 Nimmer on Copyright, *supra* note 158, § 14.04[E][1].

294. 466 F.2d 705 (7th Cir. 1972).

295. *Id.* at 711. (quoting Copyright Office Publication No. 46). See *Kitchens of Sara Lee, Inc. v. Nifty Foods Corp.*, 266 F.2d 541, 544 (2d Cir. 1959). Note that some commentators seem to interpret this and the *Alberto-Culver* case as endorsing the “sufficiently short = not creative = not protected” formula. See Robert A. Gorman & Jane C. Ginsburg, Copyright: Cases and Materials 78 (6th ed. 2002). But, strictly read, the case does not require that.

small an amount of original text will not justify copyright protection, even if there is some original text.

Decades later, in 1998, the Second Circuit in *Matthew Bender & Co. v. West Publishing Co.*,²⁹⁶ expressly reasoned that caption titles of court cases could not be copyrightable, even if West Publishing could show that their captioning manifested originality: “Even if these [captioning] choices regarding which words to capitalize and shorten to form the West digest title were an original inspiration, we doubt the decisions to shorten the titles or capitalize certain letters would be copyrightable.”²⁹⁷ While *Alberto-Culver* could be glossed over as saying that there was no originality, this *Matthew Bender* language reasons that even where “West digest titles [are] an original inspiration”—indicating that the titles may have a qualitative modicum of creativity—there would still be no copyright. The most reasonable inference is that copyright is precluded because the text is too small.

In that same spirit, the U.S. Copyright Office’s Publication No. 46 had announced that “[b]rand names, trade names, slogans, and other short phrases or expressions cannot be copyrighted,” explaining that to be protected by copyright, a work must contain something capable of being copyrighted, that is “*an appreciable amount of original text or pictorial material.*”²⁹⁸ While we quibble with the use of the word “work,” the idea of “an appreciable amount of original text” is a gem to be polished—a clear statement of a quantitative threshold of text that must be present before copyright takes hold.

There are also a small number of American and English cases which have found that titles and short phrases simply are not “compositions” of the sort that copyright is intended to protect. Here the requirement seems to shift from a raw quantitative threshold of text to some notion of composition completeness and/or integrity. The notion that copyright attaches only to “literary compositions” was probably familiar to American lawyers in the early nineteenth century,²⁹⁹ but we can start later, with the Supreme Court’s 1891 *Higgins v. Keuffel* decision.³⁰⁰ In *Higgins*, the Court considered whether a label on a bottled product was copyrightable. Endorsing Justice McLean’s holding in the earlier *Scoville v. Toland* circuit case, Justice Stephen Field concluded that the labels “[were] intended for no other use

296. 158 F.3d 674 (2d Cir. 1998).

297. *Id.* at 683; *see also* Signo Trading Int’l, Ltd. v. Gordon, 535 F. Supp. 362 (N.D. Cal. 1981) (concerning a translated list of Arabic equivalents to 850 words and forty-five short phrases in English, where the plaintiff had neither copyright in the individual words/phrases or the compilation).

298. *Kitchens of Sara Lee*, 266 F.2d at 544 (quoting Copyright Office Publication No. 46).

299. For example, counsel in *Folsom v. Marsh*, 9 F. Cas. 342, 345 (C.C.D. Mass. 1841) (No. 4901), argued that the letters of George Washington were not “proper subjects of copyright . . . because they are not literary compositions, and, therefore, not susceptible of being literary property.”

300. 140 U.S. 428 (1891).

than to be pasted on the vials or bottles” and, therefore, were of little or no value as a distinct “composition.”³⁰¹ Justice Field reasoned, “To be entitled to a copyright the article must have by itself some value as a composition, at least to the extent of serving some purpose other than as a mere advertisement or designation of the subject to which it is attached.”³⁰² Courts finding a particular label to be copyrightable, in light of *Higgins*, have done so by finding that the particular label has “value as a composition.”³⁰³ More generally, the point is that “[t]o be entitled to a copyright, the article must have by itself some value as a composition”³⁰⁴ or “[t]he protection given by the copyright statute is to the property in the literary composition, not to the title given to it.”³⁰⁵ These statements about value as a “composition” could be interpreted as assertions about originality or even as assertions about economic value. But a reasonable interpretation of these passages is that judges are using some sense of the integrity and completeness of a “composition” to conclude that only such compositions are protectable “works.”

It might be objected that judgments about “value” as a “composition” get us dangerously close to the kind of art criticism that Justice Oliver Wendell Holmes abolished from American copyright law in *Bleistein v. Donaldson Lithographing Co.*³⁰⁶ The best answer might be that this kind of aesthetic judgment falls within the “narrowest and most obvious limits” that Holmes understood to be both permissible and inevitable. In that sense, it is no different than judgments about sufficient originality that are made in copyright cases daily. In fact, aesthetic judgments about internal, artistic integrity are regularly made by American judges in the Visual Artists Rights Act of 1990 cases³⁰⁷ and already pop up in statutory damage analyses. Again, serial television, not text, provides perhaps the most vivid

301. *Id.* at 432.

302. *Id.* at 431.

303. *See, e.g.*, *Drop Dead Co. v. S.C. Johnson & Son, Inc.*, 326 F.2d 87, 93 (9th Cir. 1963) (finding the Pledge label copyrightable on “the proposition that labels which go beyond a mere trademark are copyrightable; if a label has ‘some value’ as a composition, it no longer is ‘a mere label’”); *Ansehl v. Puritan Pharm. Co.*, 61 F.2d 131 (8th Cir. 1932); *Fargo Mercantile Co. v. Brechet & Richter Co.*, 295 F. 823, 828 (8th Cir. 1924) (“[I]f the label has literary or artistic merit and is not a mere advertisement, if it has some value as a composition, at least to the extent of serving some purpose other than mere advertising, it can be copyrighted.”).

304. *Courier Lithographing Co. v. Donaldson Lithographing Co.*, 104 F. 993, 995 (6th Cir. 1900); *see also Higgins*, 140 U.S. at 431 (“To be entitled to a copyright the article must have by itself some value as a composition, at least to the extent of serving some purpose other than as a mere advertisement or designation of the subject to which it is attached.”).

305. *Becker v. Loew’s, Inc.* 133 F.2d 889, 891 (7th Cir. 1943).

306. 188 U.S. 239 (1903). Justice Holmes wrote, “It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits.” *Id.* at 351.

307. More extensive aesthetic judgments are regularly made in the Visual Artists Rights Act of 1990 cases and, in other common law jurisdictions, by common law judges applying moral rights provisions. *See* Justin Hughes, *American Moral Rights and the Dastar Decision* (Nov. 12, 2004) (unpublished manuscript, on file with author), available at http://papers.ssrn.com/sol3/papers.cfm?abstract_id=618783.

example. In *Twin Peaks Productions, Inc. v. Publications International, Ltd.*,³⁰⁸ the issue was whether the eight-episode first season series of *Twin Peaks* was one work or eight. On the issue of statutory damages, the court stated,

The author of eight scripts for eight television episodes is not limited to one award of statutory damages just because he or she can continue the plot line from one episode to the next and hold the viewers' interest without furnishing a resolution. We might well have a different situation if a book written as a single work was then adapted for television as a group of episodes, for example, the six-part television adaptations of John LeCarre's "Tinker, Tailor, Soldier, Spy" and "Smiley's People." Even in such circumstances, though there would be but one book infringed, there might be separate awards for infringement of each televised episode.³⁰⁹

This reasoning reflects a "compositional" analysis; it reverberates off the idea of a continuing "plot line from one episode to the next"—surely an indication of an integrated composition or narrative whole. The court offers that, despite this narrative integration, separate awards for separate episodes may be warranted. But the court becomes more circumspect about multiple audiovisual "works" being derived from "one book."

We should also consider the direction taken by English Chancery judges in a curious case from the 1980s, *Exxon Corp. v. Exxon Insurance Consultants International, Ltd.*,³¹⁰ in which, in addition to trademark rights, the Exxon Corporation asserted copyright in the word "Exxon." Exxon's copyright claim to its own name was straightforward: English copyright law protects "original literary works," and the word Exxon was unquestionably original and was unquestionably composed of letters, that is, literary.³¹¹

Judge Graham, and subsequently his colleagues on appeal, immediately recognized the problems inherent in copyright in a single word, particularly the name of a company that would often be in the news. Judge Graham noted "if the plaintiffs' argument is right . . . [t]he consequences would be far-reaching and probably in many cases objectionable . . ." ³¹² In expressing his frustration over Exxon's claim, Judge Oliver reminded us that we must often rely on our common sense notions to apply statutory concepts: "In my judgment it is not necessary, in construing a statutory expression, to take leave of one's common sense, and the result to which

308. 996 F.2d 1366 (2d Cir. 1993).

309. *Id.* at 1381.

310. (1981) 2 All E.R. 495, *aff'd* [1982] Ch. 119 (A.C.) (Eng.).

311. Counsel for Exxon argued straight from the dictionary: "The definition of 'literary' in the *Shorter Oxford English Dictionary*, 3d ed. (1944), is: 'Pertaining to the letters of the alphabet'—that is an earlier meaning—and 'Of or pertaining to, or of the nature of, literature . . . or books . . .'" *Exxon Corp.*, 2 All E.R. at 500. So, Exxon "argued strongly that . . . the size of a literary work is immaterial; there is logically no reason why one word which is written should not be a literary work just as much as a work of greater length; if otherwise qualified because of labour expended on it, then it can be a literary work." *Id.*

312. *Exxon Corp.*, Ch. 119 at 123.

[Exxon's counsel] sought to drive us is one which, to my mind, involves doing just that."³¹³

Without relying heavily on older English cases against the copyright in titles,³¹⁴ the Chancery judges emphasized their own common-sense notions of an "original literary work." On appeal, Lord Justice Stephenson reasoned,

I would have thought, unaided or unhampered by authority, that unless there is something in the context of the Act which forbids it, a literary work would be something which was intended to afford either information and instruction, or pleasure in the form of literary enjoyment. . . . I am not sure whether this ["Exxon"] can be said to be a "work" at all; I am clearly of the opinion that it cannot be said to be a "literary work."³¹⁵

Judge Oliver agreed that the word "Exxon" was not a literary work because "[i]t conveys no information; it provides no instruction; it gives no pleasure that I can conceive; it is simply an artificial combination of four letters of the alphabet."³¹⁶ This notion that a protected "work" provides information, instruction, or pleasure seems akin to the notion of a "composition." It is in a cluster of these ideas that we can find the basis for a minimum size—or perhaps minimum "nature"—principle for deciding what is and what is not a "work."

Part II above proposed a number of reasons why the bar on copyrighting titles emerged early. As the most valuable short phrases, titles generated the most litigation and are also the short phrases most obviously protected by a separate area of law, trademarks. But we now have a third reason. With titles, there is a clear "composition" from which the short phrase (the title) can be distinguished. Lord Justice Cairn's opinion in the 1867 case of *Maxwell v. Hogg*³¹⁷ gives us a good sense of this reasoning. Lord Cairn began by questioning how the English copyright registration system could work if copyright protected titles; he then reasoned that single-word titles simply are not compositions:

It is quite absurd to suppose that the Legislature, in providing for . . . that which was to be the indicium, and the description of something collateral—something outside the registry in the shape of a volume or part of a volume—meant that by the registration of one word copyright in that one word could be obtained, even although that one word should be registered as what was to be the title of a book or of a magazine. . . . The copyright which is contemplated by the Act must be a copyright not in a word, but in some words in the shape of a volume or part of a volume,

313. *Id.* at 144.

314. Indeed, while ruling against Exxon, Judge Graham reasoned, "Nothing I have said above is intended to suggest that I consider that a word which is used as a title can, as a matter of law, never in any circumstances be the subject of copyright, and I would disagree with dicta in previous cases to the contrary effect." *Exxon Corp.*, 2 All E.R. at 503.

315. *Exxon Corp.*, Ch. 119 at 143.

316. *Id.* at 144.

317. (1867) 16 L.T. 130 (A.C.) (Eng.).

which is communicated to the public, by which the public are benefited, and in return for which a certain protection is given to the author of that work.³¹⁸

Of all short phrases that might be protected, titles are the ones that can most readily be juxtaposed against the more obvious work—the volume, the newspaper, the story, the musical composition, etc. Lord Cairn then moves to a broader point; the person seeking protection has to give us “a volume or part of a volume.” The first phrase suggests an intuitive idea of a composition (“a volume or part of a volume”) while the second takes us back to economic value (“by which the public are benefited”).

While the “compositional” approach has much to recommend it, and may be the final arbiter, express or implicit, in the cases discussed above, there would be considerable danger in announcing what constitutes the lowest threshold for a composition. Intuitively, we might adopt a “haiku principle”—haikus are perhaps the smallest text-based forms of art that are taught to us as a “work.”³¹⁹ Much of Ezra Pound’s best known imagist poetry also had roughly this size,³²⁰ such as these three poems:

In a Station of the Metro

The apparition of these faces in the crowd;
Petals on a wet, black bough.³²¹

Alba

As cool as the pale wet leaves
of lily-of-the-valley
She lay beside me in the dawn.³²²

L’Art, 1910

Green arsenic smeared on an egg-white cloth,
Crushed strawberries! Come, let us feast our eyes.³²³

But if we announced that was our minimum standard for a work, one could imagine claims that single books or software programs constitute hundreds of works each. It would be fine for courts to announce regularly that they consider the “composition” issue, but not to announce a minimum size for a composition.

318. *Id.* at 133.

319. One example is the verses recited in Kakuzo Okakura, *The Book of Tea* 82 (1989):

A cluster of summer trees,
A bit of the sea,
A pale evening moon.

320. My thanks to colleague Barton Beebe for this point, as well as the poems that follow here.

321. Ezra Pound, *Lustra: In a Station of the Metro*, in *Poems and Translations* 287 (Library of Am. 2003).

322. Ezra Pound, *Lustra: Alba*, in *Poems and Translations*, *supra* note 321, at 287.

323. Ezra Pound, *Lustra: L’Art, 1910*, in *Poems and Translations*, *supra* note 321, at 291.

C. Copyright Registration(s)

Another measure of separateness of works discussed in at least a couple statutory damage cases is how the expressions at issue were registered at the Copyright Office. The argument is that if an owner registers all the components of a series under one copyright registration, that suggests that the owner considered them to be one work.³²⁴ Instead of focusing on an “objective” view of the work, we could hold the plaintiff to his/her own understanding and intent vis-à-vis the creation.³²⁵

There are some complications. For example, a copyright owner can register multiple works on one registration form.³²⁶ The issue is how the works were listed on the form. Moreover, courts have not consistently understood copyright registration and works to have a one-for-one relationship. For example, copyright registration over a music album is understood to constitute registration of each song and each song is treated as a “work.”³²⁷ Still, reference to copyright registration may be particularly appealing when the registration occurred well before litigation. In such circumstances, among alternative conceptions of the work, we can choose the conception the copyright owner chose.

D. Other Considerations

These three ideas—-independent economic value, “compositional” nature, and copyright owners’ understanding—hardly exhaust the candidate criteria for a multifactor minimum size analysis. For example, instead of focusing on the economic perspective of the creative party, we might want to consider their artistic perspective: Do they believe they are creating a “work” or a composition? Unfortunately, the evidence here is likely to be highly equivocal, with creators acknowledging—and wanting to be

324. See, e.g., *Gamma Audio & Video, Inc. v. Ean-Chea*, 11 F.3d 1106, 1116-17 (1st Cir. 1993) (finding that the copyrights in the four episodes at issue were registered on one form).

325. Another option is to hold the plaintiff to the intent of the plaintiff’s predecessor-in-interest. It seems reasonable to place the plaintiff in those shoes.

326. See *Gamma Audio & Video*, 11 F.3d at 1116 (noting that, under regulations promulgated by the Copyright Office, the copyrights in multiple works may be registered on a single form, and thus considered one work for the purposes of registration while still qualifying as separate “works” for purposes of awarding statutory damages) (citing 37 C.F.R. § 202.3(b)(3)(i)(A) (2004)); *Video Aided Instruction, Inc. v. Y & S Express, Inc.*, No. 96-CV-518, 1996 WL 711513, at *5 n.7 (E.D.N.Y. Oct. 29, 1996) (same); see also Copyright Office Circular No. 62 (2004) (Copyright Registration for Serials) (describing registration on a single form for collective works that are serials, understood as “periodicals, newspapers, magazines, bulletins, newsletters, annuals, journals, proceedings of societies, and other similar works”). But see *Stokes Seeds Ltd. v. Geo. W. Park Seed Co.*, 783 F. Supp. 104 (W.D.N.Y. 1991). See generally 4 Nimmer on Copyright, *supra* note 158, § 14.04[E][1].

327. See *MALACO Inc. v. Cooper & Costanza*, No. 3:00-CV-2648-P, 2002 U.S. Dist. LEXIS 12069 (N.D. Tex. July 3, 2002). In *MALACO*, the defendant infringed four songs, two each from two albums that were individually registered with the Copyright Office. *Id.* at *3, *7. The court treated registration of each as registration of each song on the albums and awarded damages per song. *Id.* at *8, *17.

acknowledged—for their contribution to larger works, while also wanting their contributions to be judged independently as meritorious.

Consider opening credits for films. The opening credit sequences for major films are often produced by motion graphics designers, with substantial independence from the film's director. These "title sequences are self-contained overtures that amplify a movie's theme or plot."³²⁸ The perfect title sequence, according to motion graphics designer Randall Balsmayer, "must be so essential that the movie wouldn't be the same without it. . . . [Yet] it should also exist as a complete film unto itself."³²⁹ Mr. Balsmayer characterizes his title sequences as "a formal element of the movie that you can use like a picture frame."³³⁰ So is a Balsmayer title sequence part of the work or part of its "framing?"³³¹ From an artistic perspective, does Mr. Balsmayer perceive himself to be preparing a "complete film unto itself" or a contribution to a collaborative work? My guess is that many creators pressed on this point would remain fiercely "dual aspectual."³³²

CONCLUSION

In the early 1990's Lloyd Weinreb observed that in the "marginal areas" of intellectual property "the driving force . . . seems to be [the] legal imagination, available to the better financed private interest, rather than a careful, systematic effort to discern what will serve the community as a whole."³³³ But that does not say anything special about copyright. It is endemic to the common law tradition that the law evolves largely through legal imagination yoked to private causes, seeking individually maximal outcomes that may cumulatively produce a suboptimal situation for the rest of us. It is up to the rest of us to monitor these developments, detect overall trends, and inform judges and policymakers of the directions in which we are being pulled.

This Article explores how a series of court decisions—*Maclean Hunter, CDN, Delta Dental*, etc.—are pulling copyright jurisprudence in a direction in which each coin valuation or medical procedure code or parts numbering is a copyrighted work. The dicta in these opinions could have devastating

328. Steven Heller, *Giving Credits the Credit They're Due: A Survey of the Work of a Three-Minute Auteur*, N.Y. Times, Mar. 28, 2004, at AR11.

329. *Id.*

330. *Id.*

331. For a discussion of authorial control of "frameworks" for authors' works, see Justin Hughes, *The Line Between Work and Framework, Text and Context*, 19 Cardozo Arts & Ent. L.J. 19 (2001).

332. This phrase is borrowed from modern descriptions of Spinoza. Stuart Hampshire, *Spinoza* (Faber & Faber Ltd. 1956) (1951). Spinoza "argued that the two pervasive features of the Universe as it presents itself to our minds, the Universe as a system of extended or spatial things and the Universe as a system of ideas or thought, must be interpreted as two aspects of a single inclusive reality . . ." *Id.* at 49.

333. Lloyd L. Weinreb, *Custom, Law, and Public Policy: The INS Case as an Example for Intellectual Property*, 78 Va. L. Rev. 141, 146 (1992).

implications for fair use and the entire structure of copyright law. The *Southco III* decision finally produced a solid court of appeals ruling that numbers are too small to be copyrighted, regardless of originality. But the reasoning in other appellate decisions could still be a platform for finely granular claims of protection that copyright was never intended to provide. Similarly, we must turn back results like those in *Cook v. Robbins* and *Andreas v. Volkswagen of America, Inc.* In their most charitable reading, these cases convert the qualitatively substantial taking doctrine of *Harper & Row, Publishers, Inc. v. Nation Enterprises*³³⁴ into de facto independent protection of very short phrases.

Under the suasion of skillful lawyering, judges can too easily lose sight of what the “work” is, or should be. Consider an Eastern District of Pennsylvania case that fell between *Southco I* and *Southco II*. In *R&B, Inc. v. Needa Parts Manufacturing, Inc.*,³³⁵ R&B accused Needa Parts of copying 1000 of R&B’s 18,000 part numbers. The numbers were copied from R&B’s 1994 catalog. Although R&B claimed infringement of both the catalog and the numbers, “[a]t the preliminary injunction hearing, the plaintiff stressed the part numbers claim and barely mentioned the catalog.”³³⁶ There was an obvious reason for that: Needa Parts’ printed materials looked nothing like R&B’s 1994 catalog. Analyzing both claims, Judge Mary McLaughlin concluded, on the strength of *Southco I*, that the R&B part numbers were uncopyrightable because they lacked originality.³³⁷ Turning to the catalog claim, McLaughlin concluded that copying 1000 numbers from a catalog with 18,000 numbers and substantial amounts of text, graphics, and designs constituted only de minimis copying.³³⁸ This second conclusion should have ended all copyright claims in the case, but the pages of the opinion devoted to comparing plaintiff’s numbers to defendant’s numbers implicitly, and mistakenly, treats the numbers as some kind of independent work.

Courts need to repeatedly ask counsel (and themselves), “what is the work at issue here?” When liability for copyright infringement boils down to copying a name, a couple of choice phrases, a slogan, or a small subset of numeric evaluations, copyright law is being dragged by clever lawyers into dark alleys where it should not go. These dark alleys threaten some of the most flourishing areas of recombinant culture—software programming, collage art, the cutting and pasting of snippets which is a wonder of digitization, criticism which requires significant quotation from the target of criticism—whether by a Ph.D. candidate or a blogger.

This lurking microwork protection is the result of our having used the originality requirement to justify copyright law’s prohibition against copying words and short phrases. The problem with small phrases is not

334. 471 U.S. 539 (1985).

335. No. 01-1234, 2001 U.S. Dist. LEXIS 17406 (E.D. Pa. Aug. 10, 2001).

336. *Id.* at *19.

337. *Id.* at *25.

338. *Id.* at *33-34.

that they always lack originality: The problem is that they are always too small. Existing case law gives us the material to develop, particularly for text works, an understanding of the minimum size or nature of a “work” that deserves to attract copyright protection.

Notes & Observations