

5-1998

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Recommended Citation

Y'Barbo, Douglas (1998) "The Heart of the Matter: The Property Right Conferred by Copyright," *Mercer Law Review*. Vol. 49 : No. 3 , Article 2.

Available at: https://digitalcommons.law.mercer.edu/jour_mlr/vol49/iss3/2

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The Heart of the Matter: The Property Right Conferred by Copyright

by Douglas Y'Barbo*

All puffed up with vanity
we see what we want to see
to the powerful and the wise
the mirror always lies

...
let's paint the mirror black
paint it black.

— Neil Peart, *War Paint*

I. INTRODUCTION AND SUMMARY

A. Introduction

The purpose of this Article is to offer a single coherent model that explains copyright law's essential features and to apply the model to reconcile the apparently disparate infringement decisions that comprise contemporary copyright law.

The fundamental premise underlying copyright law—and the one that I intend to dislodge—is that a copyright is a limited property right in relation to the author's original text. The thesis of this Article is that a “copyright” is not an enforceable property right in relation to a particular work of authorship or the expression embodied in it (*i.e.*, “a text”). Instead, I shall demonstrate that it is a far more qualified

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property right in relation to a legally structured market position. Put another way, copyright infringement is best viewed as an unfair intrusion upon the copyright owner's actual or putative market position from which to exploit his or her text, rather than as an isolated, unauthorized borrowing of original portions of the copyrighted text. One material implication of this view is that copyright law is far more closely related to common law misappropriation of the type found in *INS v. AP*¹ than to a pure property regime (for example, patent law).

For years commentators have debated whether copyright is the ideal regime to encourage the creation of original works of authorship.² Yet no one has posed the predicate question that seems so obviously crucial to the debate: what does copyright law actually grant to the author? Or, precisely in what does the property right reside? Instead, commentators have assumed that the answer was in every instance: the text. Everyone, it seems, has implicitly assumed that copyright law confers a property right in relation to the actual text that the author creates (and, of course, substantially similar abstractions from it).³ Indeed, the question whether a lifetime monopoly is necessary to encourage the creation of original works certainly depends upon the breadth of the monopoly one has in mind.

This Article also responds to much of the recent commentary offering proposals for reform of copyright law. A discussion of these efforts should better orient the reader to the novel approach offered in this Article. The response does not appear in a single section, however, but is placed as brief digressions throughout the text as issues arise that implicate particular commentary.

B. Summary

1. **The Thesis.** The objective of this Article is neither piecemeal revision nor a sweeping polemic followed by an unrealistic and unsubstantiated proposal for reform. Instead, I intend this Article to furnish a comprehensive model that explains and justifies the essential features of the copyright infringement standard. This section presents the thesis along with a thorough summary of the major grounds of support. The

1. *International News Serv. v. Associated Press*, 248 U.S. 215 (1918).

2. See, e.g., Stephen Breyer, *The Uneasy Case for Copyright: A Study of Copyright in Books, Photocopies, and Computer Programs*, 84 HARV. L. REV. 281 (1970).

3. See, e.g., Wendy J. Gordon, *An Inquiry into the Merits of Copyright: The Challenges of Consistency, Consent, and Encouragement Theory*, 41 STAN. L. REV. 1343, 1380 (1989) ("The works so fixed—whether pencil-written melodies, tape-recorded symphonies, printed books, or computer programs embedded in plastic disks—have identifiable boundaries and stable identities much as physical things do." (citations omitted)).

reason for this detailed summary is to allow the reader to quickly assess the major points offered in support of this Article's thesis before I proceed to a more exhaustive discussion that follows.

The Copyright Code defines a copyright claim in a text as though it were property.⁴ It expressly enumerates rights over which the copyright owner has exclusive dominion and later defines the unauthorized exercise of those rights as "infringement."⁵ Yet the real test of whether something, particularly an incorporeal something, possesses the attributes of property depends upon whether the property owner has the absolute right to exclude all others (*i.e.*, is it an enforceable right and against whom) and whether the owner has the right to exercise complete control over his or her property.⁶ Therefore, a regime based on the grant of property rights (*i.e.*, exclusive rights to make copies, prepare derivative works, and so forth) should condemn any, or almost any, unauthorized exercise of those exclusive rights as an improper intrusion upon the copyright owner's property, against anyone. Copyright law does not. Moreover, a regime based on the grant of a property right in a text should, of course, subsume a mechanism—either through an *ex ante* registration practice or judicially as a predicate to the infringement analysis—to determine the boundaries of that property right in the thing borrowed. Copyright law does not.

Instead, unlike patent law, a copyright plaintiff must, as part of her *prima facie* case, affirmatively disprove that the defendant independently created the accused work (*i.e.*, without copying from the plaintiff's work). More specifically, the copyright plaintiff must show that the defendant copied from the plaintiff's work. Proof of copying then permits the factfinder to infer that the accused infringer substantially reduced his overall cost of expression (*i.e.*, cost of creating the work), which would allow her to set a price below the plaintiff's marginal cost because the former has a lower cost of expression to recoup.

The ultimate infringement decision is left, in the case of fiction works anyway, to the "ordinary observer" who, after a deliberately unanalytical review of the two texts, condemns the latter as an infringement if it appears to him to have been derived from the former text. It is impossible to overstate the judicial emphasis on the "unanalytical"

4. In this Article, I use the term "work" and "text" more or less interchangeably although in other contexts the two terms are distinct. See Douglas Y'Barbo, § 411 and *Determining the Scope of a Copyright Registration*, 34 SAN DIEGO L. REV. 343 (1977).

5. 17 U.S.C. §§ 106, 501(a) (1994).

6. See, *e.g.*, A.M. Honore, *Ownership*, in OXFORD ESSAYS IN JURISPRUDENCE 113 (A.G. Guest ed., 1961). Honore's definition of property consists of two elements: exclusion and control.

character of this test; thus, "[t]he two works involved in this appeal should be considered and tested, not hypercritically or with meticulous scrutiny, but by the observations and impressions of the average reasonable reader or spectator."⁷

This dependence on the consumer's perception of the accused text compared with the original is the true *sine qua non* of copyright infringement; without this, then regardless of the quantitative extent of copying, infringement is rarely found, as we shall see. Put another way, according to the contemporary copyright infringement standard, merely borrowing protectable expression is not enough. The average consumer must actually perceive some similarity; otherwise, there is no infringement. Indeed, a thorough review of the case law reveals an astonishingly poor correlation between the frequency of infringement verdicts and the quantity of protectable expression taken from the first text.⁸ This observation alone suggests an alternate criterion by which copyright infringement is actually determined.

For many reasons, some of which are discussed in more detail later, this is a peculiar way to enforce a property right that resides in a text. For instance, in the case of patents the accused device and the relevant patent claim are compared element by element. The overall similarity between the device and the claim is irrelevant; instead, what matters is whether every element comprising the claim is present in the accused device. Only then does the similarity become infringement. By contrast, copyright law deliberately eschews a piecemeal analysis of the two texts in favor of the factfinder's desultory hunch. Indeed, not only does copyright law not rely upon an analytical comparison of the two works, but it expressly forbids it, electing instead for the ordinary observer's unreflective impression. If we assume that copyright law grants a

7. *Sid & Marty Krofft v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977) (citing *Twentieth Century-Fox Film Corp. v. Stonesifer*, 140 F.2d 579, 582 (9th Cir. 1944)).

8. The skeptical reader is invited to compare the following sets of cases. These cases comprise a "low-copying" group in which infringement was found: *Robert R. Jones Assoc., Inc. v. Nino Homes*, 858 F.2d 274 (6th Cir. 1988); *Horgan v. MacMillian, Inc.*, 789 F.2d 157 (2d Cir. 1986); *Roy Export Co. v. Columbia Broad. Sys., Inc.*, 503 F. Supp. 1137 (S.D.N.Y. 1980); *Meredith Corp. v. Harper & Row, Publishers, Inc.*, 378 F. Supp. 686 (S.D.N.Y. 1974); *Hedeman v. Tap-Rite Prods. Corp.*, 228 F. Supp. 630 (D.N.J. 1964); *Addison-Wesley Publ'g Co. v. Brown*, 133 USPQ 647 (E.D.N.Y. 1962); *Warren v. White & Wyckoff Mfg. Co.*, 39 F.2d 922 (S.D.N.Y. 1930). By contrast, these cases comprise a "high-copying" group in which infringement was not found: *Worth v. Selchow & Righter Co.*, 827 F.2d 569 (9th Cir. 1987); *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972 (2d Cir. 1980); *Reyher v. Children's Television Workshop*, 533 F.2d 87 (2d Cir. 1976); *Affiliated Hosp. Prods., Inc. v. Merdel Game Mfg. Co.*, 513 F.2d 1183 (2d Cir. 1975); *Rosemont Enters., Inc. v. Random House, Inc.*, 366 F.2d 303 (2d Cir. 1966); *Barris/Fraser Enters. v. Goodson-Todman Enters. Ltd.*, 5 USPQ 2d 1887 (S.D.N.Y. 1988).

property right in relation to a text, then the ordinary observer test is among the least reliable or sensible means of enforcement. In many instances the ordinary observer, by his deliberately casual inspection of the two texts, cannot possibly determine whether one contains protectable expression borrowed from the other (for example, suppose one was a novel, the other a film). But what the observer can do is determine whether a putative consumer will confuse the two works, believing one to be derived from the other. The only possible rationale for this legal standard then is that it protects the copyright owners from harm to their preferred market position—harm whose proper measure is consumer confusion over the original and accused works. Nonfiction works are judged differently (the ordinary observer standard is not used) though with the same result and, as we shall see, for the same reason.

Finally, this latter observation suggests that the relationship between the copyrightable features of a particular text and those elements responsible for its aesthetic appeal (and hence, roughly, its economic value) is remote. In other words, quite often those elements of a text responsible for its aesthetic appeal are not elements that independently qualify for copyright protection (*e.g.*, they are not original, too abstract, etc.). This fragile relationship between copyrightability and economic value further suggests that the property right conferred by copyright resides in something other than the text.

None of these facts is consistent with a regime that grants a property right in strict relation to a text, and taken together, they are convincing evidence that it does not. I suggest that the only plausible explanation is that a copyright is more correctly characterized as a property right in relation to a legally structured market position rather than as a property right in relation to a text.

In summary, my thesis is that a "copyright" is not an enforceable property right in relation to a particular work of authorship or the expression embodied in it (*i.e.*, "a text"); it is instead a far more qualified property right in relation to a legally structured market position. My argument in support of this thesis consists of the following bases. First, no such property right in a text is ever defined either during registration or during litigation. Second, the genuine focus of the infringement test is on the method of infringement rather than what is infringed. Third, the ultimate infringement analysis is left to the casual observer who eschews analytical comparison of the two texts in favor of an uncritical impression. Finally, the copyrightable portions of the text correspond poorly to those elements responsible for the text's economic value.

2. Reconciling the Case Law. The model offered in this Article unifies the highly disparate body of case law relating to copyright

infringement of literary texts, which is completely irreconcilable under current orthodoxy. For instance, of the hundreds of reported cases involving alleged infringement of fiction works (novels, plays, movies), the plaintiffs have won only a handful of them. Indeed, an accused infringer can liberally borrow a prior text's theme, plot, basic sequence of events, and characters with impunity as long as the prose or dialogue is changed.⁹

One very visible and very robust polar exception exists, which I shall refer to as "character cases." In these the accused infringer borrows a widely recognized central character from the prior work. Although the accused infringer may recast the character in an entirely different setting with a different theme, plot, sequence of events, dialogue, and so forth, and indeed even in a different medium of expression, courts almost always condemn the use provided that the character is sufficiently well known (*i.e.*, that he is identifiable in the accused work upon casual inspection by the general public). Usually the character is readily identifiable because the accused infringer uses the original character's name. Some examples include the following: "Superman,"¹⁰ "Mickey Mouse,"¹¹ "Tarzan,"¹² and "Conan."¹³ In each of these cases, the accused text had a different plot, setting, essential sequence of events, supporting characters, and tone, but the court nevertheless found infringement. The only way to reconcile this exception with the larger body of authority on infringement of fiction works is to recognize that what the accused infringer copied is the identifying feature of the prior work—the work's "trademark"—the single most important characteristic that would cause consumers to believe the latter work was derived from the prior one after a casual glance at the two. On the other hand, other literary elements far more worthy of legal protection—such as theme, plot, setting, basic sequence of events, and the precise juxtaposition of all of these elements to one another—are easily borrowed from a prior work and once incorporated into the accused work become hidden from the ordinary observer's view by recombining them with additional elements. For this reason this type of borrowing is hardly ever condemned. In *Kretschmer v. Warner Brothers*,¹⁴ for instance, the accused infringer's film borrowed plaintiff-novelist's theme, plot, main characters, setting, essential sequence of events, and numerous discrete

9. See Douglas YBarbo, *Aesthetic Ambition Versus Commercial Appeal: Adapting Novels to Film and the Copyright Law*, 10 ST. THOMAS L. REV. 299 (1998).

10. *Warner Bros., Inc. v. ABC*, 654 F.2d 204 (2d Cir. 1981).

11. *Walt Disney Prods. v. Air Pirates*, 581 F.2d 751 (9th Cir. 1978).

12. *Burroughs v. MGM*, 683 F.2d 610 (2d Cir. 1982).

13. *Conan Properties, Inc. v. Mattel, Inc.*, 712 F. Supp. 353 (S.D.N.Y. 1989).

14. No. 93CIV.1730 (CSH), 1994 WL 259814, at *8 (S.D.N.Y. June 8, 1994).

events, but the court excused the copying.¹⁵ So copyright law permits this type of copying apparently on the ground that the accused work is not likely to harm the market for the original because the ordinary observer sees little, if any, connection between the two that is not otherwise attributable to similar genre and so forth.

Next, consider *Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.*¹⁶ There the accused infringer created a story of the O.J. Simpson trial, borrowing the literary style of Dr. Seuss but no other aspect of Dr. Seuss's works.¹⁷ The court wasted no time condemning the accused text.¹⁸ Yet, this case is completely unjustified on traditional copyright grounds. Copyright law has never been extended to protect literary style. However, in this instance it was: "Dr. Seuss creates a pleasing rhythm and whimsical effect through the use of two perfectly rhyming, monotonic couplets, unified by epistrophe. [I]n the second passage, Dr. Seuss's choices as to stanza type (tercet), rhyme (masculine perfect), assonance, and accent are all protectable and all appropriated."¹⁹ The only conceivable basis for ignoring settled doctrine is that the "style" in this instance was a highly unique, and more importantly, widely recognizable one—the jittery, staccato prose-poetry of Dr. Seuss that is familiar to nearly everyone. So what was the property right being protected here? Surely not one residing in the text because what was taken was, beyond a shadow of a doubt, not protectable by copyright law. Indeed, what was actually protected was Dr. Seuss's market position from which to exploit his works, whose primary, indeed sole identifying characteristic, is literary style.

Contrast this case with *Musto v. Meyer*.²⁰ In *Musto* plaintiff had written a scholarly article on the history of cocaine use in Europe and America in the nineteenth century. One highlight of the article is Musto's amusing speculation that Sherlock Holmes may have been a frequent cocaine user, which would explain several bizarre events in Doyle's novels about Holmes. The accused work was a novel whose plot structure is derived from Musto's "hypothesis." That is, the events comprising the novel were all taken from the Musto article, and in some instances Musto's prose was copied nearly word for word. Indeed, the accused work was nothing more than Musto's article recast in novel

15. *Id.* at *11.

16. 924 F. Supp. 1559 (S.D. Cal. 1996).

17. *Id.* at 1561.

18. *Id.* at 1576.

19. *Id.* at 1564.

20. 434 F. Supp. 32 (S.D.N.Y. 1977).

form;²¹ nevertheless, the court found no infringement²²—it is difficult to say why. It might have been because plaintiff's work was published in the *Journal of the American Medical Association* and defendant's was a mainstream commercial novel. It may also have been because plaintiff's article was a scholarly work (though the portion taken was not) while defendant's was purely fiction; or it may have been because Musto did not commercialize his work—it was simply given free of charge to the journal to publish.²³ All of these factors suggest that Musto was highly unlikely to have suffered any market harm due to the copying even though the entire essence—the novel feature of his work—was taken.

One final example is *Horgan v. MacMillan, Inc.*²⁴ In this case the accused infringer published a book entitled *The Nutcracker: A Story & A Ballet*, which consisted of text (interviews with the dancers) plus photographs taken during a performance of the New York City Ballet Company's production of *The Nutcracker Ballet*. The choreographer (actually the administratrix of his estate) sued the book publisher claiming the photographs infringed the copyright in the choreography for the ballet.²⁵ A copyright in a choreographic work is extremely specific; protection is limited to the actual flow of steps or movements necessary to execute the performance. Hence, the publisher's defense—which although suspiciously technical was nonetheless legally correct—was that because plaintiff's copyright covered only the particular flow of steps, it could not possibly have been infringed by a limited number of photographs from which it would be absolutely impossible to even begin to recreate the ballet or to even suggest how it might be performed. As far as the sets and costumes (the real content of the photographs) were concerned, plaintiff conceded that they had lapsed into the public domain long ago and that in any event plaintiff's copyright did not cover them.²⁶ Yet the court found that the book infringed plaintiff's copyright even though not one element comprising that copyright could be found in the accused work.²⁷ This case suggests that copyright law's pretense of precision towards the property right at issue is really a subterfuge: regardless of whether the accused infringer actually borrowed from the protected "thing," the court will condemn the borrowing if the new work

21. *Id.* at 33.

22. *Id.* at 37.

23. *Id.* at 33.

24. 789 F.2d 157 (2d Cir. 1986).

25. *Id.* at 157. The Copyright Code protects choreographic works according to 17 U.S.C. § 102(a)(4) (1994).

26. 789 F.2d at 161.

27. *Id.* at 164.

preempts a significant potential or actual source of revenue for the prior work.

3. Property: Expression Versus Market Position. A few definitions are required before going further. First, numerous and, unfortunately, disparate definitions of "property" exist. One commentator remarks:

Property has been variously regarded as all distributable resources, as alienable entitlements, as an incentive to invest, as a source of personhood, as economic power, as status, as a share in society's wealth, as a reward for effort and talent, as an incentive to labor, as a ground for inculcating responsibility, as an expression of the free will, and I am sure, others as well.²⁸

In this Article, I shall use the quite general definition of property proposed by J.E. Penner, which regards property from the standpoint of imposing a general duty of noninterference, a duty mediated by the thing the owner owns and not on the basis of personal relationships between the duty owner and the property owner.²⁹ According to Professor Penner, this duty prohibits two general classes of interference: (1) specific interference with the owner's own use and (2) nonspecific interference (*i.e.*, the unlicensed use of the property by a nonowner that to some degree dispossesses the owner).³⁰ Against this theoretical background, the entitlement conferred by copyright law can be assessed.

Again, the actual property right that copyright law protects relates to a narrowly drawn market position. A violation of this property right is determined by the likelihood of economic harm evidenced by erosion to that preferred market position. This is unusually difficult to measure; hence, copyright law excuses any accused text regardless of similarity with the original text if the author of the accused text did not create that text relying upon the original text. In economic vernacular the accused infringer is a "free-rider" if he relied upon the prior text in preparing his own. If free-riding, or the effect of the copying on the second author's cost of expression, is the primary desideratum in copyright infringement, then you need a way to predict it. That is what the copyright's copying-access requirement does. If the defendant derived or is likely to have derived his work from the plaintiff's work, then the probability is greater that he reduced his cost of expression—a cost differential that he can

28. J.E. Penner, *The "Bundle of Rights" Picture of Property*, 43 UCLA L. REV. 711, 800-01 (1996).

29. *Id.* at 808.

30. *Id.*

exploit in the form of a lower price approaching marginal cost—to the detriment of the original author who is unable to match that price and still recoup his own cost of expression. Conversely, without copying, then regardless of similarity, the defendant did not take a free ride on the plaintiff's protectable expression. Yet, free-riding is not, without more, harmful; it merely reduces the expression costs to the subsequent author. So if she tucks the book away in a locked drawer, the original author is never harmed. All free-riding tells us is whether the potential for market harm exists. Therefore, if the defendant did copy from the plaintiff's text, then a further assay is required to predict probable market harm. The easiest way to do this is to ask the average consumer whether he would confuse the two works—be led into thinking that the latter is derived from the former. Hence, the ordinary observer test is applied: "The lay listener's reaction is relevant because it gauges the effect of the defendant's work on the plaintiff's market."³¹ Thus, the genuine focus of the copyright infringement analysis is on the *method* by which the accused infringer created or acquired the work and the *effect* of the accused work on the market for the original rather than on the *text* copied.

4. Implications. What is the significance of the recharacterization proposed in this Article? Reconceiving a copyright as more like a property right relating to a particular market position rather than as an absolute property right in the text may at first not appear to mean much. After all, what value could a legal right to exclusively copy a particular text have other than the value of exploiting it in a market? As we shall see, this new paradigm has unusual significance.

First, I just discussed a group of otherwise disparate judicial decisions that I suggest are adequately reconciled by the model that I offer. Second, I am not content with a mere linguistic relabeling of the property right protected by copyright. Redirecting attention towards the market exploited by the copyright owner and away from his or her text changes the infringement inquiry completely. Today, commentators disagree over whether a copyright should protect every unauthorized borrowing of all or portions of the author's text (the romantic conception of copyright) or whether copyright law should be delicately calibrated based on the last increment of protection needed to prevent the author from not creating the work for fear that the economic return flowing from the work will be quickly appropriated by others (the instrumentalist conception). All of the evidence presented in this Article converges to the conclusion that the property right conferred by copyright

31. Dawson v. Hinshaw Music, Inc., 905 F.2d 731, 734 (4th Cir. 1990).

law—which again seems directed more towards a particular market position than the text itself—is ostensibly justified (1) by basic considerations of fairness and (2) by a careful titration of legal protection needed to encourage (or at least not discourage) the creation of original works of authorship. Put another way, contemporary copyright law does not appear to permit the copyright owner to capture the full value that consumers may attach to his or her work, as we shall see, but rather delimits protection at or near the minimum threshold needed to support his or her investment.

Third, these are most vexing problems in copyright law. One, precisely how much material, quantitatively speaking, can the accused infringer incorporate into his or her own work before infringement occurs? Second, what level of abstraction of the elements of the work occur without triggering infringement (*e.g.*, does copyright law proscribe borrowing of a plot, setting, characters, etc.)? The case law on these two issues is virtually irreconcilable; no coherent theme is discernable. This Article suggests that these two questions arise due to the fundamental misconception of a copyright as a property right in a text. This paradigm implicitly requires that the factfinder determine the zone of protectability surrounding the original elements of the author's text. As we shall see, this determination is virtually intractable and is in fact almost never performed. Under the view proposed here, which comports with contemporary authority, these two questions become far less important.³² The proper endpoint for the infringement analysis is not "how much protectable expression did the accused infringer borrow?" It is "what is the likelihood of harm to the copyright owner's preferred market position caused by the unauthorized borrowing as evidenced by a reasonable likelihood of the diminution of demand for the copyright owner's work?" Therefore, what is at issue in the question of infringement is the scope of that market position, not the scope of the text itself.

Fourth, copyright law is in serious trouble. Whether this is just a public-image problem or something much more serious is not yet clear. For instance, David Nimmer, the editor of the largest treatise on copyright law, recently authored an article entitled *The End of Copyright* in which he prophesied "[t]he end of traditional copyright jurisprudence."³³ In addition, there is at present an urgent movement to develop a third intellectual property paradigm to protect nascent

32. Granted, the copyright owner's legally protected market position does not extend to proscribe similar works of authorship independently created nor to proscribe works that borrow only nonoriginal material from the copyright owner's own work. Therefore, the work's original material must at some point be separated from the nonoriginal material.

33. David Nimmer, *The End of Copyright*, 48 VAND. L. REV. 1385, 1387 (1995).

technologies (such as internet-related software and artificial intelligence-related systems) thought to be insufficiently protected by current regimes.³⁴ This perceived need, of course, implies a failure or inability of copyright and patent law to adequately protect these technologies sufficiently to encourage the desired level of investment. For instance, prior to 1971 record manufacturers were forced to rely upon state misappropriation law to protect sound recordings. Then, in 1971 Congress passed the Sound Recordings Amendment to the Copyright Code.³⁵ Hence, the need and proper design for a new paradigm to protect these technologies require a precise understanding of existing law, particularly a reliable model regarding what a copyright protects and what it does not. This Article shall furnish that model.

5. A Brief Digression: One Type of Harm—One Legal Regime.

I find the view discussed above—that a new paradigm is needed to protect emerging technologies—to be seriously myopic.³⁶ If we enacted a new intellectual property law every time a new technology arose, then we would be overrun with them by now. Indeed, whenever such a new technology arises, Congress or the Supreme Court (sometimes both) has always provided a timely response—whether for photographs, movies, phonographic records, high-speed photocopiers, or video cassette recorders. When they first appeared, all of these technologies posed apparently insurmountable difficulties for certain classes of authors for which the Copyright Code provided no relief; in every case Congress promptly amended the Code. For instance, prior to 1865 a photograph was apparently not protected under the then-current copyright law because it was not technically a statutory “writing.” Therefore, in 1865 Congress amended the Copyright Act to expressly include photographic prints within its protectable subject matter.³⁷ The next major technological advance was recorded music. Before 1905 the act of making a recording by, for instance, a piano roll or phonograph did not appear to infringe the copyright in the musical score. In 1909 Congress amended the Copyright Act to close that technological loophole. Another example: in 1912 the Supreme Court first condemned infringement of a motion

34. See *Symposium: Toward a Third Intellectual Property Paradigm*, 94 COLUM. L. REV. 2307 (1994).

35. Pub. L. No. 92-140, 85 Stat. 391 (1971), as amended, Pub. L. No. 93-573, 88 Stat. 1873 (1974) (codified as amended at 17 U.S.C. § 102 (1994)).

36. For a contrary view, see Jessica Litman, *Copyright Legislation and Technological Change*, 68 OR. L. REV. 275 (1989).

37. See *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884) (addressing the constitutionality of the 1865 amendment). See also *Bleistein v. Donaldson Lithographic Co.*, 188 U.S. 239 (1903) (Holmes, J.).

picture under the Copyright Code.³⁸ One year later, Congress again amended the Copyright Statute to include movies. The explosive advances in high-speed photocopying in the 1960s and 1970s created entirely unforeseen problems, particularly for publishers of scholarly journals, which the copiers generally claimed was a "fair use." In response the 1976 Act included section 108, a provision that permits the owner of the copy to make a single additional copy.³⁹ The increased use of home videotaping machines ("VCRs") led to a similar problem; private viewers could tape an entire copyrighted television show and watch it later. Again, the Supreme Court responded to create a safe harbor for this type of copying ("time shifting").⁴⁰ These few examples should suffice to show that a technological advance that implicates the copyright law is followed immediately by a suitable legislative or judicial response.

Finally, consonant with the reconception of copyright proposed in this Article, it appears that copyright law is far more closely related to common law misappropriation of the type found in *INS v. AP* rather than to a pure property right regime (e.g., patent law). If nothing else, this result, if true, suggests that we re-evaluate our current taxonomy of intellectual property law. This shall be discussed in more detail much later in this Article. The section that follows is a brief summary of the contemporary infringement standard.

II. A BRIEF SUMMARY OF THE COPYRIGHT INFRINGEMENT STANDARD

A. Introduction

Describing the test for copyright infringement is a complicated task. For one thing, there are a plethora of variants that cannot all be reconciled back towards a single coherent standard. For another, it has too many steps and it is very time-consuming to apply. Below, I shall discuss the infringement standard that originated with the Second Circuit in *Arnstein v. Porter*.⁴¹ There is a second infringement test that was first enunciated by the Ninth Circuit in *Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corp.*⁴² and followed by several circuits. The court in *Krofft* named this test the "intrinsic/extrinsic test"⁴³ though later decisions within the Ninth Circuit have

38. *Kalem Co. v. Harper Bros.*, 222 U.S. 55 (1911) (Holmes, J.).

39. 17 U.S.C. § 108 (1976).

40. *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417 (1984).

41. 154 F.2d 464, 468 (2d Cir. 1946).

42. 562 F.2d 1157 (9th Cir. 1977).

43. *Id.* at 1165.

slightly modified and renamed the test the "objective/subjective" test.⁴⁴ Quite clearly, this test is based on a creative misreading of *Arnstein*, which it purports to follow.⁴⁵ Nevertheless, if one looks closely enough, one would see that the two tests are more or less the same, particularly when one accounts for the gradual refinements to the objective/subjective test over the past twenty years.⁴⁶

To prevail on a claim for copyright infringement, a plaintiff must prove: "(1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original."⁴⁷

B. *Ownership of a Valid Copyright*

The existence of a valid copyright and ownership by the plaintiff are easiest to prove if he can produce a copyright registration for the work that he alleges the defendant infringed. Under the Copyright Statute, the registration—provided that it was obtained within five years after first publication—is prima facie evidence of the validity of the copyright and all of the facts it contains, which includes the copyright's owner.⁴⁸ Moreover, because the Statute requires a putative copyright plaintiff to register his copyright before he can bring suit anyway, this is no doubt the most common means to prove the existence of a valid copyright.⁴⁹

C. *Copying*

Ownership is the first element. Here is the second: copying protected material. This element is further split into two prongs, which go by a number of terms: "actual copying" and "improper appropriation" are as common as any. What they mean is this: a copyright plaintiff must first prove that the defendant's accused work is derived from the plaintiff's (actual copying); then he must show that what the defendant copied from it were protectable elements comprising his copyright

44. *Id.*; *Dr. Seuss Enters., L.P. v. Penguin Books, USA, Inc.*, 109 F.3d 1394, 1398 (1997). "We have recently modified the *Krofft* test, bringing it more in line with the tests followed in other circuits." *Id.* (citations omitted). "[T]he two tests are more sensibly described as objective and subjective analyses of *expression . . .*" *Id.* (quoting *Shaw v. Lindheim*, 919 F.2d 1353, 1357 (9th Cir. 1990)).

45. 562 F.2d at 1165.

46. *See, e.g., Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1442 (9th Cir. 1994).

47. *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991); *see also, e.g., Rogers v. Koons*, 960 F.2d 301, 306 (2d Cir. 1992).

48. 17 U.S.C. § 410(c) (1994).

49. *Id.* § 411(a): "No action for infringement of the copyright in any work shall be instituted until registration of the copyright claim has been made in accordance with this title."

(improper appropriation). In other words, the copyright plaintiff must, as part of his *prima facie* case, affirmatively disprove independent creation of the accused work by the defendant.

For the copying prong (to prove substantial similarity) of the test, expert testimony is permitted.⁵⁰ For instance, a literature professor could be called upon to testify whether the defendant copied from the plaintiff's work. Oddly though, expert testimony is not permissible for the second prong, substantial similarity.⁵¹

D. Actual Copying

Actual copying by the defendant of the plaintiff's work can be proven in one of two ways: either by direct evidence or inferentially by proof of access to the plaintiff's work plus substantial similarity between the accused work and the plaintiff's.⁵² In other words, the plaintiff can either catch the defendant red-handed or else rely on circumstantial evidence. For this prong courts generally apply an implicit indifference-curve analysis, which just means that the greater the similarity between the plaintiff's work and the accused, the less evidence of access is required and, of course, vice versa. For instance, at one extreme of this curve when the accused work is "strikingly similar" to the plaintiff's, courts often immediately shift the burden onto the defendant to show independent creation, thus relieving the plaintiff of having to offer any evidence of access.⁵³

As mentioned in the Introduction, the focus in the copyright infringement test is away from the text and towards the defendant's behavior and whether it results in economic harm to the plaintiff. Indeed, a literary text is intrinsically resistant to a precise definition of its scope of protectable material. Because of this intrinsic resistance, the copying-access prong serves as a proxy to, in effect, define the copyright's scope at least for the limited purposes of enforcing the legal right.

E. Improper Appropriation

To establish improper appropriation, the plaintiff must show "substantial similarity" between the two works with respect to protectable elements of the plaintiff's work.⁵⁴ As the reader can see, "substan-

50. *Arnstein v. Porter*, 154 F.2d 464, 473 (2d Cir. 1946). This case is generally viewed as the *de facto* origin of the modern infringement test.

51. *See, e.g., Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164 (2d Cir. 1977).

52. *See, e.g., Gaste v. Kaiserman*, 863 F.2d 1061, 1066 (2d Cir. 1988).

53. *Id.*

54. *Laureyssens v. Idea Group, Inc.*, 964 F.2d 131, 140 (2d Cir. 1992).

tial similarity" appears twice, once in each prong, but they are very different.⁵⁵ To distinguish between the two, the term "probative similarity," coined by Professor Latman, is sometimes used to refer to the "substantial similarity" that appears in the copying prong. The plaintiff without direct evidence of copying must rely upon evidence showing access and "probative similarity" (evidence of similarity between the two works that tends to show that the defendant copied from the plaintiff's work).⁵⁶

Substantial similarity is determined by the "ordinary observer" test: if the ordinary lay observer, viewing or reading the two works as a whole, would regard their aesthetic appeal as the same, then the accused work infringes.⁵⁷ Two of the most common versions of this test are recited as follows: (1) "The test for substantial similarity is whether an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work,"⁵⁸ (2) "substantial similarity should be judged by the spontaneous response of the ordinary lay observer."⁵⁹

Ours is an age in which we regularly perform technological feats of manipulating copyrighted works, for instance, by seamlessly digitizing and splicing images and sounds to produce hybrid works barely recognizable from their constituents: Charlie Chaplin acting alongside Tom Hanks; Enrico Caruso singing accompanied by Luciano Pavarotti; Michael Jordan playing basketball with cartoon characters; a viewer literally interacting with the movie he is watching. With this in mind, one might argue that it is nothing short of absurd that on the precipice of the twenty-first century, the legal test that we rely upon to determine if one work infringes the copyright in another is to ask the average guy right off the street whether one work reminds him of the other. Yet we do. Moreover, extracting the protectable expression from the text is

55. Indeed, very different. "Substantial similarity" in the copying prong means only enough similarity to raise an inference of copying. Yet in the other prong, it means sufficient similarity so that an ordinary observer would regard aesthetic appeal of the two the same. *Denker v. Ukry*, 820 F. Supp. 722, 729 (S.D.N.Y. 1992) (citing Alan Latman, "Probative Similarity" as Proof of Copying: Toward Dispelling Some Myths in Copyright Infringement, 90 COLUM. L. REV. 1178, 1204 (1990)).

56. Latman, *supra* note 55, at 1204. The major treatise in the field has also embraced that term. MELVILLE B. & DAVID NIMMER, 3 NIMMER ON COPYRIGHT §§ 13.01[B], at 13-13, 13.03[A], at 13-29.

57. *Folio Impressions, Inc. v. Byer California*, 937 F.2d 759, 765 (2d Cir. 1991); *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960).

58. *Kretschmer v. Warner Bros.*, No. 93 CIV.1730 (CCH), 1994 WL 259814, at *8 (S.D.N.Y. June 8, 1994) (citing *Ideal Toy Corp. v. Fab-Lu*, 360 F.2d 1021, 1022 (2d Cir. 1966)).

59. *Walker v. Time Life Films, Inc.*, 784 F.2d 44, 51 (2d Cir. 1986) (citations omitted).

particularly important in contemporary literary works because (as we shall see later) they consist largely, indeed overwhelmingly, of pre-existing material. Hence, the ordinary observer must compare the two works as if almost all of the original was "missing" and instead focus only upon the plaintiff's original contribution.

No one is sure precisely which features of the text comprise the elements of the copyright claim, so we ask the ordinary observer whether he thinks the two are similar. However, before we hand the two works over to him, a predicate determination has already been made: that the defendant in fact derived his work from the plaintiff's.

F. A Brief Digression: The Two Dominant but Competing Theoretical Paradigms of Copyright

There are two distinct rationales to justify protecting an author's works by means of a property right.⁶⁰ These two rationales are used to justify the view that the only legitimate goal of intellectual property law is to calibrate the incentive benefits of legal protection against the deadweight loss of monopoly pricing versus the polar view that ownership of rights in one's creative works are analogous to rights of the person and therefore resistant to sterile economic analysis, which might permit intrusion upon those rights if the author suffers no direct economic harm.

The first of these two rationales is the romantic vision of the independent creative genius, perhaps grounded in natural law, though its etiology is probably more complicated.⁶¹ This view compels the conclusion that an author has a property right in what he created just as if it were a parcel of land (though not, of course, necessarily in the physical article but in the intangible expression). By contrast, the second view is that copyright is merely an instrument of public policy designed to encourage the creation of original works of authorship. It is alternatively known as the "instrumentalist" justification or the *ex ante* perspective. The latter rationale would support an easement across another's property if it did not harm the property; the former, perhaps not. Obviously, the scope of copyright protection is broader under the first rationale than under the second. Under the second rationale, the infringement standard is calibrated roughly according to the economic incentives needed to encourage the author to create the work. More

60. These two competing rationales are examined together in several works. See, e.g., PAUL GOLDSTEIN, *COPYRIGHT'S HIGHWAY: THE LAW AND LORE OF COPYRIGHT FROM GUTENBERG TO THE CELESTIAL JUKEBOX* 15 (1994); MARK ROSE, *AUTHORS AND OWNERS: THE INVENTION OF COPYRIGHT* 140 (1993).

61. See, e.g., *Millar v. Taylor*, 98 Eng. Rep. 201, 224 (K.B. 1769).

precisely: beginning with no protection whatsoever, what is the point at which if the last increment of protectability were removed, the author's incentives to create the work would be quashed or at least seriously diminished?

Which of these two competing rationales of copyright is embodied in modern copyright law? No doubt it is infused with both.⁶² And the dominance of one over the other perhaps depends upon the subject matter more than anything else. For instance, the infringement standard by which databases and factual compilations are judged reflects a hard-edged reality of minimal, incremental creativity driven only by the prospect of commercial gain. Economics rather than aesthetics controls this domain: the infringement standard is mechanically applied and looks only toward what the accused infringer took. By contrast, the infringement standard applied to literary works is premised on the notion of preserving the original author's aesthetic appeal, which innervates the entire work rather than being embodied in one particular element or another. Hence, the infringement standard asks whether an "ordinary observer," after a leisurely—rather than critical—reading of both works would regard their aesthetic appeal the same. The standard applied to literary works seems to appreciate the work—or some ephemeral part of it anyway—as the author's personal property. On the other hand, the database standard seems to reflect an indifference towards the author but also a recognition that the creation of original (hence useful) products must not be discouraged by permitting unrestricted copying.

62. See, e.g., Alfred C. Yen, *Restoring the Natural Law: Copyright as Labor and Possession*, 51 OHIO ST. L.J. 517 (1990); Wendy J. Gordon, *A Property Right in Self-Expression: Equality and Individualism in the Natural Law of Intellectual Property*, 102 YALE L.J. 1533 (1993). These commentators urge the infusion of natural law principles into contemporary copyright doctrine. First, I do not think that anyone seriously doubts that copyright law is premised in part upon natural law. On the other hand, these principles by themselves are unable to support a workable body of doctrine—as evidenced by the efforts of the two commentators recited above—and therefore have given way to a market-based endpoint. Indeed, commentators such as Yen and Gordon who suggest that we revisit natural law principles have not offered any workable scheme—nor, in fact, any scheme at all—by which the copyright law should be so modified. Copyright law operates through its statutory provisions and common law decisions, and therefore any viable proposal for reform should fixate upon either or both of these rather than offering what amounts to nothing more than precatory musings. For example, the following are about as specific as these proposals get: "The proper future construction of our copyright law depends on the restoration of its natural law heritage," Yen, *supra* note 62, at 559; "[the] natural rights approach . . . supports a demand that significant components of intellectual property law be crafted to serve the public benefit," Gordon, *supra* note 62, at 1609.

Moreover, the particular commercial setting may favor one justification over the other. For instance, the difficulty with calibrating an infringement standard on economic incentives is that the threshold point varies drastically according to medium and industry. Indeed, in many industries there is arguably little need for copyright protection to compel vigorous creation of original works of authorship, which, of course, is an argument for narrow protection. For instance, in the software industry—an industry in which new products quickly become technically obsolete—the lead time advantage enjoyed by the first entrant may be sufficient incentive. Infringement of scholarly writing (by other scholars) is enforced, no doubt, by numerous professional and quasi-professional bodies whose sanctions can be far more severe than an infringement verdict in the courts. According to one commentator: “Plagiarism is an academic capital offense, punishable by academic death for student or faculty.”⁶³ Similarly, the film industry has a strict code that discourages stealing ideas from others in the industry.⁶⁴

The romantic conception, in contrast to the instrumentalist justification, unfortunately suggests no reliable endpoint to measure the proper level of protection short of an absolute proscription of copying in any manner. Thus, the instrumentalist justification generally supports an infringement standard more tolerant of copying than the romantic justification. Yet, a higher level of copyright protection rarely benefits the author, who pays for that higher level of protection *ex post* in increased cost of expression due to restricted access to others' works upon which he must necessarily draw. By implication from the preceding sentence, an author somehow benefits no matter where the line is drawn as long as it is clearly drawn.

Hence, copyright law must strike a delicate balance between providing incentives to authors in the form of legal protection against copying their works and not squelching those incentives by so raising the level of protection that future authors may not draw freely upon the stock of prior works without fear of infringement. Hence, the balance is between *authors* on one end and *authors* on the other: the same author who is denied protectability of the ideas contained in his novel against an accused infringer benefits *ex post* because he can borrow other authors' ideas freely when creating his next work. Thus, his incentive to create, though diminished by the narrow scope of protection in his own works, is revived by a reduced cost of expression or cost of creating subsequent works because he can borrow liberally from other works without fear of infringing or obtaining a license. This is rare: often a legal rule

63. K.R. ST. ONGE, *THE MELANCHOLY ANATOMY OF PLAGIARISM* 39 (1988).

64. *See, e.g.*, ROBERT KOSBERG, *HOW TO SELL YOUR IDEA TO HOLLYWOOD* 178 (1991).

balances the interests of two different groups—debtors and creditors, common carriers and passengers, businesses and consumers, public corporations and private investors, and so forth. The significance of this astonishingly simple paradigm is that beyond a certain point, increased copyright protection will actually decrease authors' incentives to create new works because curtailing access to the stock of available material raises their cost of expression.⁶⁵

So, viewed *ex ante*, authors, when viewed as an entire group, are by and large indifferent to the scope of protection afforded their works. Most authors and artists would disagree, of course, because they want it both ways: whether an artist becomes incensed when he or she finds out, for example, the film *Defending Your Life* is a substantial copy from a prior novel, yet was held not to infringe, depends, for instance, upon whether the artist is a rocker or a rapper,⁶⁶ a celebrity author or biographer,⁶⁷ or a postmodern artist or impressionist.⁶⁸ My point is that clearly some authors and artists are net borrowers while others are net contributors, but in this section and in this Article, I am speaking generally. So in an ideal world, legal protection in the form of copyright would be carefully titrated so that the level of protection just exactly matches the point at which one less unit of protection would substantially diminish the author's incentives to create the work; in other words, no

65. Thus, at least in copyright law anyway, the tension over where to draw the line separating protectable from unprotectable matter is largely overstated. Indeed, I see it as a pointless exercise. Shifting the standard in either direction simultaneously benefits (viewed *ex ante*) and harms (viewed *ex post*) authors. So, within broad boundaries there exists a spectrum of "correct" standards. Beyond that, determining the scope of protection is a pure policy decision, not a legal or intellectual one. Although it is a policy decision, one should not expect it to be made by policymakers (legislators). That is because calibrating the desired scope of protection is confounded by the heterogeneity in the types of works (novels, movies, biographies, sculptures, stuffed animals, and so on) and the types of industry within which the works are created and disseminated. Hence, the legal rule would have to take the form of highly specific regulations directed to one work or industry at a time—which also implies that it may vary from medium to medium (*e.g.*, one for computer software, another for literary works, and so on).

66. See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994) (the rap group "2 Live Crew" created a parody of 50s rocker Roy Orbison's hit song "Oh, Pretty Woman").

67. See *Salinger v. Random House, Inc.*, 811 F.2d 90 (2d Cir. 1987) (defendant Random House published a literary biography of plaintiff J.D. Salinger and included quotations and paraphrased text from the letters of Salinger; the court of appeals directed the lower court to issue an injunction).

68. See *Rogers v. Koons*, 960 F.2d 301 (2d Cir. 1992) (defendant-sculptor Koons created a precise sculpture from a photograph taken by plaintiff. As part of Koons' "Banality Show," Koons intended the sculpture to be an accurate depiction of the photograph for purposes of social criticism in the tradition of Andy Warhol, Robert Rauschenberg, and David Salle).

more legal protection is given the author than is necessary. At least if one accepts the instrumentalist justification of copyright over the romantic conception, then copyright is not about helping the copyright owner squeeze every last dime out of his property right. Instead, it is about carefully calibrating the level of protection based on the necessary incentives required to compel the author to create the work. Any additional protection will diminish the incentives of future authors to create because they must pay for that increased protection in the form of higher costs of creation.

III. PROPERTY RULES VERSUS LIABILITY RULES

The reader may wonder by now whether copyright is even a property right at all. If the focus is market harm, why can it not be described using traditional liability rules?

Though this is not a frivolous position, the view taken in this Article is that copyright is best understood, heuristically at least, as a property right—at least if one accepts the current orthodoxy on these matters. According to this view, set forth in its original form by Calabresi and Melamed nearly thirty years ago, the extent and nature of the transaction costs in a particular case dictate whether one of the parties to a Coasian bargain ought to have an absolute property right (injunction) or simply a right to collect damages.⁶⁹ More specifically, property rules are more appropriate when few parties are involved, when valuation of the harm is difficult, and when all other transaction costs between the parties are low. The clear consensus is that intellectual property regimes are best protected, at least in part, by property rules—as indeed they are.⁷⁰

Yet the difference may be overstated. More recent scholarship, most notably by Professor Polinsky, suggests that the real difference between property rules and liability rules is quite often insignificant.⁷¹ Indeed, copyrights are in fact protected by a combination of property rules and liability rules. Injunctions are usually ordered when requested by the prevailing copyright owner.⁷² Yet pure money damages are available in addition to injunctive relief.⁷³ Finally, the availability of statutory

69. Guido Calabresi & A. Douglas A. Melamed, *Property Rules, Liability Rules, and Inalienability: One View of the Cathedral*, 85 HARV. L. REV. 1089, 1092 (1972).

70. See Robert P. Merges, *Of Property Rules, Coase, and Intellectual Property*, 94 COLUM. L. REV. 2655, 2664 (1994).

71. Mitchell A. Polinsky, *Resolving Nuisance Disputes: The Simple Economics of Injunctive and Damage Remedies*, 32 STAN. L. REV. 1075, 1092 (1980).

72. 17 U.S.C. § 502 (1994).

73. *Id.* § 504(b).

damages, which the plaintiff may elect in the event that he is unable to quantify his actual harm, suggests a recognition of the difficult valuations inherent in copyright infringement and therefore evidences a slight bias towards property rules.

In the sections that follow, I will present a detailed argument to support the theory advanced in this Article.

IV. THE COPYRIGHT INFRINGEMENT ANALYSIS PROCEEDS WITHOUT AN ANTECEDENT DEFINITION OF THE PROPERTY RIGHT IN THE TEXT

A. *Introduction*

If a copyright were a property right in relation to the text itself (or more precisely in the expression embodied in the text itself), then at some point, either during the registration process or later during the infringement analysis, reasonably precise boundaries of the property would have to be identified⁷⁴ as it is, for instance, in patent law: "Before analyzing a claim to determine whether infringement occurs, the court must properly interpret the claim."⁷⁵ Ideally, the original (hence protectable) portions of the text would need to be segregated from the rest of the work and then assayed through a series of filters (such as scenes-a-faire and idea-expression dichotomy) to determine whether they qualify for protection by copyright. Of course, this needs to be done because copying from a prior work is not infringement unless what is borrowed is, among other things, original. For instance, the theme of a work of fiction may be original but is generally regarded by courts as too abstract to be protectable. Of course, taking the entire sequence of events from a prior novel is not infringement if the author of that novel in turn borrowed the story from a newspaper account of actual events. So if a copyright were a property right in relation to the text itself, then this type of dissection would occur. Just as in a suit for trespass upon land, the boundaries of the plaintiff's property, unless conceded, would first need to be determined; the portions of the text that are actually protected under the copyright would need to be identified. But, as we shall see, no prior definition occurs.

74. Ownership of the copyright should not, of course, be confused with ownership of the physical item embodying the protected expression. See 17 U.S.C. § 202 (1994) (ownership of copyright as distinct from ownership of material object).

75. *Key Mfg. Group, Inc. v. Microdot, Inc.*, 925 F.2d 1444, 1448 (Fed. Cir. 1991).

B. The Intrinsic Resistance of Literary Works to Precise Definition of Copyright Scope

Today, it is fashionable to say that copyright law, like patent law, is socially constructed. Hence, the essential elements of the legal test as well as the procedural minutiae of each regime are merely artifacts of cultural, bureaucratic, and other random, indeterminate forces that have little or nothing to do with the intrinsic character of the thing sought to be protected. “[A]dvances in production and reproduction make it increasingly clear that the distinctions that seemed to be inherent in the terms ‘patent’ and ‘copyright’ are in fact illusory because they fail to capture anything that is significant about the products of human intellect.”⁷⁶ The view taken in this Article is directly opposed to this view.

Indeed, it appears that the difference between copyright and patent law is due to genuine differences in the attributes of the property that each regime is designed to protect. Though it is not crucial to the thesis advanced in this Article, copyright law and patent law, each exclusive domains for the property they protect, are different at an absolutely primary level. Patent law is directed towards articles and methods that are required to be “useful” whatever else they may be. That is, they are functional and therefore can be described that way: “a method for treating baldness,” “a chemical compound for use in treating baldness having the chemical formula X.” In instances like these, the novelty resides in an improved structure or method compared with existing technology. In the case of novel devices or compounds, the property right is readily described: “a computer having an input device, a monitor, and a processor.”

By contrast, copyright law expressly denies protection for property whose primary attributes are functional.⁷⁷ Rather, copyright law protects only aesthetic features. There is no requirement that they be novel, nor need they traverse some aesthetic threshold—which is too difficult to determine anyway. Copyright law requires only that the work be “original”—a rudimentary threshold. Thus, while intellectual property that is functional can be readily described using functional language, aesthetic property resists accurate description by prose. For instance, how might one describe the protectable elements of a novel?

76. Rochelle Cooper Dreyfuss, *A Wiseguy's Approach to Information Products: Muscling Copyright and Patent into a Unitary Theory of Intellectual Property*, 1992 SUP. CT. REV. 195, 221-22.

77. 17 U.S.C. § 101 (1994). *See also, e.g.*, *Carol Barnhart, Inc. v. Economy Cover Corp.*, 773 F.2d 411, 419 (2d. Cir. 1985).

Certainly the prose would be part of the claim and also, perhaps, the detailed sequence of events, but the problems are these: what is the level of abstraction above which we deny protection, and how do we account for the complex reticulation of the story's different elements (*e.g.*, even if the main character is not protectable, does a protectable element arise if combined with the remaining main characters?)? In other words, copyright law cannot reliably draw a line to separate a detailed description of the story's events (protectable) from a mere outline of the plot (unprotectable), nor can copyright law force a copyright owner to recite the "elements" of her text as though it were a mechanical device because, for instance, most of these cannot be disaggregated from one another.

The result is that a sufficient description of the scope of the copyright claim, particularly in a literary text, is probably impossible. Even if it is not impossible, then it is probably inefficient, which means the cost of adequate description would outweigh the benefits of the additional protection from a well-defined property right. Consider the case of a poem. Beyond the literal language, very little is original or otherwise protectable. So, how would the metes and bounds of that copyright claim be described in an application or registration? Well, short of reciting the entire poem itself on the application, there is no way to do it. So that is precisely what copyright law requires—just a copy of the actual text to accompany the registration certificate. It eschews an inefficient description of an abstract claim to an aesthetic feature. Rather, what it requires is a deposit copy of the physical article itself (two actually, one for the Library of Congress) as part of the application process. Beyond this, the actual process of registration requires only a very cursory description of the material for classification purposes and information for limiting the scope of copyright. For instance, if the work is a derivative work, underlying material is not included within the copyright, or if it is a compilation, the text itself may not be protected. That is probably the best that we can do—to define the original-protectable aspect of a work whose very purpose is quite often subversion of language itself. Consider this remark by Jeanette Winterston, one of the finest living fiction writers:

It is a strange time; the writer is expected to be able to explain his or her work as though it were a perplexing machine supplied without an instruction manual. The question "What is your book about?" has always puzzled me. It is about itself and if I could condense it into

other words I should not have taken such care to choose the words I did.⁷⁸

Still though, could not an alternative scheme be constructed *ab initio* so that the property right is sufficiently well defined to permit courts to render an infringement judgment without relying upon copying? Not likely. Again, copyright law exists to protect artistic endeavor whose economic value is ostensibly its aesthetic appeal. Unfortunately, the means to frame the boundaries of this type of property do not appear to exist.

Consider once again patent law. There are three types of patents: utility patents, design patents, and plant patents. Utility patents, which account for the overwhelming majority of all patents, are, as discussed earlier, directed to functional features. Design patents, on the other hand, are directed to purely aesthetic features. Indeed, this type of protection is a viable substitute for copyright protection for things like fabric designs and ornamental aspects of building designs. If there is a way to more precisely define the property right in an aesthetic feature—*i.e.*, a mechanism to describe the scope beyond a single embodiment—then patent law, given its noteworthy history, would have found it. Yet in this regard, it has failed. Indeed, the central principle of design patent law is this: “Design patents have almost no scope. The claim [of a design patent] is limited to what is shown in the application drawings.”⁷⁹ As this principle implies—unlike utility patents that describe the invention using abstractly worded claims that usually give the patent owner a scope of protection far beyond any physical embodiment than he disclosed in his description—design patents contain no claims in prose form to describe the property right; they contain only drawings (usually just one). This results in a narrow scope of protection.⁸⁰ This feature—common to both copyright and design patent law, which are two regimes of disparate origin—suggests an integral restriction to accurate description of the property right in artistic endeavor rather than a shortcoming of the particular legal regime.

Yet, this inherent resistance to precise definition of the ostensible property right in the text is, quite ironically, exacerbated by an especially compelling need to provide a precise definition of the scope because very little of any literary work is actually original and thus

78. Jeanette Winterson, *A Work of My Own*, in *ART OBJECTS* 165 (Vintage 1995).

79. *In re Mann*, 861 F.2d 1581 (Fed. Cir. 1988).

80. Moreover, design patent law, like copyright law, relies upon the “ordinary observer” to determine whether the two articles are similar with respect to the novel feature claimed in the patent. *See, e.g.*, *Oakley, Inc. v. International Tropic-Cal, Inc.*, 923 F.2d 167 (Fed. Cir. 1991).

protectable by copyright. Think of it this way: a particular element (theme, style, plot, sequence of events, characters) from a literary text copied by an accused infringer is very likely to be unprotectable because among other things, it was in turn borrowed from a prior work. In response, second-best approximating devices that will be discussed next have evolved to provide this determination. But for now, the crucial point is that these devices are not to be confused with an actual separation of the original portions from the rest of the text.

C. *The Idea/Expression Dichotomy*

Even though no reliable means exist to separate original from unoriginal expression, decisions regarding protectability must still be made—often element by element. Generally, the accused infringer will argue that even if he did copy, what he copied was not protectable expression. If one looks at enough infringement disputes involving fiction works, one will find that the primary filter used to do this is the idea/expression concept, which simply stated is this: copyright does not protect ideas but only the expression of those ideas. Though this is copyright law's most time-honored ritual incantation, the phrase "idea versus expression" is at best an unfortunate linguistic choice that has proliferated for years in copyright case law without genuine reflection over its meaning; at worst, it is a tedious substitute for genuine analysis of whether protectable elements from the original work have been incorporated into the accused work. To paraphrase Benjamin Cardozo, the idea/expression standard is simply "[a] generality [that] does not carry us far upon the road to truth."⁸¹ Put still another way: it is not a "test" but a conclusion without supporting premises, yet it is often "applied" tautologically as though it were a test ("copyright law does not protect ideas only expression, this [element] is an idea, therefore it is unprotectable."). Still, because this is by far the most important doctrine by which protectable subject matter is separated from unprotectable subject matter, it deserves discussion in this Article.

The idea/expression filter is very old.⁸² Writing during a time characterized by a far different creative ethos than today (more on this later), William Blackstone, writing in 1761 in *Tonson v. Collins*,⁸³ stated that "[s]tyle and sentiment" rather than ideas were "the essentials

81. BENJAMIN CARDOZO, *THE NATURE OF THE JUDICIAL PROCESS* 174 (1921).

82. At least one scholar has found an oblique reference to it in Blackstone's *Commentaries*. See ROSE, *supra* note 60, at 132 (citing 2 W. BLACKSTONE, *COMMENTARIES ON THE LAWS OF ENGLAND* 406 (1769)).

83. 1 Black W 301, 96 Eng. Rep. 169 (1761).

of a literary composition."⁸⁴ A journalist writing in 1763 agreed, "[The protectable aspect of a book] consists chiefly in the form and composition: at least, this being all that can be in any good degree ascertained, it is all the property capable of being legally secured."⁸⁵ Therefore, the idea/expression dichotomy was recognizable virtually in its present-day form as early as 1761. The earliest American reference to it, of any consequence anyway, is in *Baker v. Seldon*,⁸⁶ a famous copyright case decided by the Supreme Court in 1879. Early copyright decisions under the Statute of Anne confined the scope of copyright to reach hardly beyond the verbatim text.⁸⁷ Thus, in the first half of the eighteenth century, a translation and an abridgment were regarded as new work (they did not infringe the original).⁸⁸ In the nineteenth century, English and U.S. decisions expanded the scope of protection as the emphasis shifted to the abstract concept of a "work." This is evidenced by *Drone on Copyright* (the leading treatise on copyright law during this period), which defined work as the "[e]ssence and value of a literary composition" not limited to the literal language of the text.⁸⁹ As the scope of protection expanded, a filter was needed to separate protectable from unprotectable expression. Put another way, once proscribed copying was extended beyond just verbatim taking of the author's prose, the question became which elements of another's work could be permissibly copied.

Numerous justifications have been offered in support of the idea/expression dichotomy. Richard Posner and William Landes have shown by a formal model that protecting ideas would result in a net decrease in creative output because authors' cost of expression would increase.⁹⁰ They also suggest that it is pareto optimal: it is the rule that authors would prefer ex ante.⁹¹ Other explanations include the suggestion that the cost of "discovering" new ideas is low compared to creating expression; hence, ideas need not be protected to compel their creation. Likewise, the high administrative cost of protecting ideas is no

84. *Id.* at 189.

85. Review of *A Vindication of the Exclusive Rights of Authors to Their Own Works: A Subject Now Under Consideration Before the Twelve Judges of England*, 27 MONTHLY REV. 176, 189 (1763).

86. 101 U.S. 99 (1879).

87. See, e.g., ROSE, *supra* note 60, at 133.

88. *Burnett v. Chetwood*, 2 Mer. 441, 35 Eng. Rep. 1008, 1009 (1720); *Gyles v. Wilcox*, 2 Atk. 141, 26 Eng. Rep. 489, 490 (1740).

89. EATON DRONE, *DRONE ON COPYRIGHT* (1879).

90. Landes & Posner, *An Economic Analysis of Copyright Law*, 18 J. LEGAL STUD. 325, 347-48 (1989).

91. *Id.*

doubt important; it is simply too difficult to determine an idea's source (whether it is original or not).⁹²

I suggest that the purpose of the idea/expression standard is that it is used as a proxy for the virtually intractable originality determination. But why is a doctrine that goes by the label "idea/expression" used to separate original from unoriginal expression? What follows is one response to this question.

The properly crafted intellectual property law strikes a fragile balance between ensuring that the law affords sufficient protection for original creations and not providing too much protection so that a creator's incentives to create are diminished by raising his cost of expression due to overly restricted access to the protected works that he must necessarily draw upon to create new works. Again, the conflict of interest here is not really between authors (producers) and readers (consumers) but between authors and authors. There probably is no optimal scope of protection. Within a range of possible choices, where to draw the line is purely a policy choice, not an intellectual one. Indeed, it is not even possible to conduct a rational debate over where to draw the line separating protectable from unprotectable creation without a reference point. Consider copyright law in light of its sister doctrine, the patent law, which is far more developed in virtually every aspect. Under patent law an inventor must conduct a thorough search for prior inventions that may bear on the patentability of his own invention. Strictly

92. The "merger" and "scenes-a-faire" doctrines are closely related to the idea/expression doctrine. The former is a frequently invoked doctrine in copyright law, generally subsumed under the idea/expression concept and referring to instances in which there are a very limited number of ways to express the idea. When that occurs, the merger doctrine will often be invoked to render the expression unprotectable: "[A]n expression will be found to be merged into the idea when 'there are no or few other ways of expressing a particular ideal.'" *Educational Testing Servs. v. Katzman*, 793 F.2d 533, 539 (3d Cir. 1986) (quoting *Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d 1240, 1253 (3d Cir. 1983)). Hence, the merger doctrine has been applied to deny protection to mathematics questions in a college entrance exam, *Educational Testing Servs.*, 793 F.2d at 40, and a series of tables presenting awards in medical malpractice cases, *Matthew Bender & Co. v. Kluwer Law Book Publishers, Inc.*, 672 F. Supp. 107 (S.D.N.Y. 1987), but not to a numbering system for replacement parts, *Toro Co. v. R&R Prods. Co.*, 787 F.2d 1208 (8th Cir. 1986), or to a system for recording medical laboratory tests, *Norton Printing Co. v. Augustana Hosp.*, 155 USPQ 133 (N.D. Ill. 1967). The scenes-a-faire doctrine is a sweeping doctrine that is frequently relied upon, indeed over-relied upon in my opinion, in literary works cases. The way it works is this: scenes-a-faire is generally defined as stock scenes that inevitably flow from a particular concept, genre, theme, or other—for instance, a story about life in a South Bronx police station is likely to feature a hard-drinking and cynical but dedicated Irish cop—so that particular character, at that level of abstraction, is deemed unprotectable by scenes-a-faire. The reader can, of course, see that the more broadly one defines a work's theme, the more expression is subsumed under it.

speaking, this is not an affirmative duty to search; but it might as well be because the patent examiner, upon receiving his application, immediately conducts his own search. The search of the "prior art" encompasses not only prior patents (U.S. and foreign) but also academic literature, marketing literature, and so forth, which means the search can be quite expensive. In my own experience, it often is expensive compared with the remaining cost of prosecuting the application and even with the cost of invention. This search cost raises the inventor's cost of expression and thus decreases his incentives to create. On the other hand, because the boundaries of the existing state of the art are reasonably well defined, the inventor gets to claim his invention with maximum breadth—the claims comprising his patent can extend right up to these boundaries.⁹³ Therefore, the negative effect of the search "requirement" (raising the inventor's de facto cost of invention) is offset by this positive benefit: a well-established frontier of the state of the art, comprised of previously patented inventions and those in the public domain, which in essence defines the scope of the inventor's patent. In turn this means that the inventor's patent can be as broad as possible: he can get legal protection for his invention that extends right up to the prior art frontier.

Copyright law is in drastic contrast. Searching the "prior art"—even if searches were limited to works registered with the U.S. Copyright Office, which they are not—is virtually impossible for many reasons, not the least of which is that copyright registration certificates (unlike an issued patent) do not adequately describe the claimed work so that the works themselves would have to be searched manually. Even if that were possible—which it is not—it would still leave the virtually infinite sea of texts in the public domain. Not surprisingly then, no search is required of the copyright applicant. Nor does the copyright examiner conduct his own search. Moreover, the examination of a copyright application, unlike the rigorous battle to obtain a patent, is virtually pro forma, which means that the Office does not really pass on the issue of originality even though it is a requirement for copyrightability. Instead, it is left entirely for the courts. So the author's costs of creation do not include this search cost. With only negligible search costs, the author's

93. This is true in practice not just in theory. In practice the inventor's attorney files the application, which is comprised of claims that are almost always broader than the prior art will allow. The examiner will therefore object to them, but always by reference to particular pieces of prior art. This rejection is followed by amendments that narrow the claims. Hence, the effect of this back-and-forth process is patent claims whose scope is essentially defined by the prior art—where the existing state of the art leaves off, the inventor's claims begin.

cost of expression is lower; therefore, his incentives to create are higher than otherwise.

However, there is a downside. Incentives are, of course, affected by the breadth of the legal monopoly granted the author. In the case of patents, the breadth of the inventor's grant is as broad as allowable in light of the prior art. In the case of copyrights, neither the author nor the Copyright Office nor the judge presiding over the infringement dispute has the slightest clue about what is original (and hence protectable) about the author's work. That is because the relevant "prior art" cannot be identified—the inevitably vast corpus of prior literary works of similar subject matter, theme, or genre.

Recall that in the case of patents, the prior art (negatively) defines the scope of the property right just like real property lots that bind each other on all four sides define the boundaries of the others. Yet in copyrights, the prior art is essentially unknown; hence, the frontier of original expression is undefined. So in the case of copyright, how is the scope of protection defined? There is really no way to do it. Indeed, one theme of this Article is that the entire copyright infringement analysis is designed to avoid as much as possible the predicate question of scope and instead to proceed directly to infringement (or perhaps more precisely, it blends the two inquiries into one).

So because it cannot be determined the best way—by reference to the prior art—a number of second-best devices have evolved, one of which is the idea/expression dichotomy (other lesser examples: "merger" and "scenes-a-faire" doctrines). These doctrines do nothing more than draw purely arbitrary lines ostensibly to separate "original" from "unoriginal" expression. These doctrines evolved to limit the scope of the copyright from encroaching on the prior art, hence avoiding overlapping copyright claims granting property rights in material formerly in the public domain. Therefore, the effect of these second-best approximating devices is to scale back the property right well before it reaches the original/unoriginal frontier. Courts are sometimes more candid relying upon their own judgment to draw the idea/expression boundary than at other times. Consider *Herbert Rosenthal Jewelry Corp. v. Kalpakian*,⁹⁴ a case involving a pin in the shape of a bee intended to be worn on a jacket lapel:

What is basically at stake is the extent of the copyright owner's monopoly—from how large an area of activity did Congress intend to allow the copyright owner to exclude others? We think the production of jeweled bee pins is a larger private preserve than Congress intended

94. 446 F.2d 738 (9th Cir. 1971).

to be set aside in the public market without a patent. A jeweled bee pin is therefore an "idea" that defendants were free to copy.⁹⁵

I suspect that this identical reasoning underlies many copyright decisions relying upon the idea/expression dichotomy.

In summary, the idea/expression doctrine quite correctly gives the benefit of the doubt to prior authors and subsequent authors and the reading public—not to the author whose claim is under consideration. Therefore, the idea/expression is a coarse proxy for the virtually intractable question of which elements are original, and thus subsumed within the copyright and which elements are not.

The remainder of this section is directed to persuading the reader that, as a practical matter, the boundaries of the protectable (original) portions of a copyrighted text are never determined during registration or later in litigation.

D. Registration Practice

The examination of a copyright application, unlike the rigorous battle to obtain a patent, is virtually *pro forma*, which means that the Office does not really pass on the issue of originality even though it is a requirement for copyrightability. This issue is left entirely for the courts. Courts are well aware of this, if not its consequences: "[U]nlike a patent claim, a claim to copyright is not examined for basic validity before a certificate issued."⁹⁶

It is undisputed that the Copyright Office has neither the facilities nor the authority to rule upon the factual basis of applications for registration or renewal, and that where an application is fair upon its face, the Office cannot refuse to perform the "ministerial duty" of registration "imposed upon [it] by the law."⁹⁷

"There is no such [patent type] search or examination when a copyright is secured. It issues almost automatically and there is no prior art to contend with."⁹⁸ So not only is a copyright registered *ex parte*, but there is virtually no check on the breadth of the applicant's claim. Even if that were possible—which it is not—it would still leave the virtually infinite sea of texts in the public domain. Not surprisingly then, no

95. *Id.* at 742.

96. *Midway Mfg. Co. v. Bandai-America, Inc.*, 546 F. Supp. 125, 143 (D.N.J. 1982) (citing H.R. REP. NO. 94-1476, at 157, reprinted in 1976 U.S.C.C.A.N. 5659, 5773).

97. *Cadence Indus. Corp. v. Ringer*, 450 F. Supp. 59, 65 (S.D.N.Y. 1978) (citations omitted).

98. *Stein v. Benaderet*, 109 F. Supp. 364, 366 (E.D. Mich. 1952).

search is required of the copyright applicant, nor is one performed by the Copyright Office examiner.

E. The Courts

1. **The Ideal Scenario.** So originality/protectability is not determined during the registration process. That leaves the matter to the courts. Or does it? Consider first, *Kregos v. Associated Press*.⁹⁹ In *Kregos* the plaintiff had developed a form or chart to present baseball statistics on baseball pitchers. The chart included certain categories of statistics for each game's probable starting pitchers including their win-loss records, earned-run averages ("ERA"), and number of innings pitched against particular opponents. Defendant Associated Press ("AP") developed its own chart to display baseball statistics. *Kregos* sued AP for copyright infringement.¹⁰⁰ The court noticed initially that *Kregos's* form differed from the AP form in three respects. First, the AP form included two statistics not found in *Kregos's* form. Second (and third), *Kregos's* form included a set of statistics on the pitcher versus that day's team at that ball park ("vs opp at site"). The AP form did not have that statistic; instead it compiled those statistics into a slightly broader category ("vs opp"). In sum, of the ten performance statistics compiled in the AP form, five were different from those in *Kregos's* form.¹⁰¹ The court then posed the question, whether fifty percent identity equated to "substantial similarity" and thus infringement.¹⁰² What is interesting about this opinion is that the court temporarily put that question to one side to first determine the breadth of *Kregos's* copyright. In other words, the court sought first to determine precisely what about *Kregos's* form was original and therefore protectable. To do this the court first observed that no single pitching form prior to *Kregos's* form contained more than three of the nine categories of pitching statistics included in the *Kregos* form.¹⁰³ It also noted that most of the statistical categories in *Kregos's* form already existed in one form or another at the time *Kregos* created his form.¹⁰⁴ More specifically, the *Kregos* form contained six categories of statistics not found in earlier forms; five of these existed in the AP form. More specifically still, these six original categories of statistics all related to the single set of statistics described

99. 795 F. Supp. 1325, 1327 (S.D.N.Y. 1992).

100. *Id.* at 1328.

101. *Id.* at 1332.

102. *Id.* at 1333.

103. *Id.*

104. *Id.*

by the heading "vs opp at site," that is, how that day's pitcher historically performed against that team at that ballpark.¹⁰⁵ The court next found that this set of statistics was precisely the set of statistics that AP changed; therefore, the court concluded that AP was not guilty of infringement because it had not copied any protectable expression from Kregos regardless of whatever else it had copied.¹⁰⁶ Put another way, none of the material copied by AP from the Kregos form was original to Kregos; therefore, it was not copyrightable: "The balance we strike in this case . . . protects defendants against an infringement claim when the differences between their form and the plaintiff's pitching form involve the very elements that made the Kregos form copyrightable."¹⁰⁷

The lesson from this case is clear: the court was saved from a virtual stalemate over whether a fifty percent similarity constituted an infringement by performing a predicate determination of the scope of the plaintiff's copyright. The court was able to determine that none of the plaintiff's protectable expression was copied by defendant. This in essence precluded the infringement analysis altogether.

Kregos is an ideal copyright infringement case because the court began by defining the scope of plaintiff's copyright (how much of it was original, hence protectable) before proceeding to the question of whether the two works were substantially similar. In reality though, copyright infringement disputes rarely proceed that way because they cannot, particularly in the case of literary works of fiction.

2. The Literary Exemplar. Despite the case just discussed, separation of the copyrighted text into original and nonoriginal portions is not an inquiry into which courts normally engage. Consider *Denker v. Uhry*.¹⁰⁸

Several years ago, the film *Driving Miss Daisy* was released to the public and received critical as well as popular acclaim. As the reader may recall, this movie told the story of an elderly white Jewish person who, faced with advancing age and the consequent loss of independence, enlisted the assistance of an African-American helper (chauffeur). The relationship was initially tenuous, strained by the employer's deeply held attitudes and beliefs about race and social class. Yet the relationship metamorphosed from that of employer-employee to a devoted friendship and thereby depicted the erosion of firmly entrenched racial barriers.

105. *Id.*

106. *Id.* at 1334.

107. *Id.*

108. 820 F. Supp. 722 (S.D.N.Y. 1992).

Such an erosion occurs largely through the patient mentorship of the servant towards the master.¹⁰⁹

A few years before, a different author wrote a novel, *Horowitz and Mrs. Washington*, which also told the story of an elderly white Jewish person who, faced with advancing age and the consequent loss of independence, also reluctantly enlisted the assistance of an African-American helper (physical therapist). This relationship, after a chilly beginning, also developed into a warm and lasting friendship and chronicled a triumph over racism.¹¹⁰ The novel, like the film, relied upon the servant to deliver the message to the recalcitrant master of the irrelevance of race in basic aspects of human experience and value. In both novel and film, the master represented the archetype of the depression-era Jew whose attitudes toward other races, particularly African-Americans, were deeply and ubiquitously imbedded by early childhood from both parents and society at large. The main characters in both were highly similar.

Additionally, several discrete events are found in both the movie and the prior novel: a scene involving the master's son's frustrating attempts to persuade the master of the desperate need for a helper due to the master's advancing age and consequent disability; the master vehemently denying the need for assistance, particularly from an African-American person, even though the master currently employed an African-American housekeeper, who the master obliquely told the son was an "exception." Also, the servant in both the novel and film dutifully reported to work in one scene under adverse weather conditions, a scene intended to depict intense devotion to the master. In both novel and film, the growing admiration and respect by the master toward the servant was illustrated by the master's assistance in a difficult problem faced by the servant—helping the servant's son in legal trouble (*Horowitz*) and teaching the servant to read (*Driving Miss Daisy*). In both, the friendship was catalyzed by the master's loneliness caused by the recent death of her spouse. In both, the servant frequently and graciously keeps the master company.¹¹¹

After the film was released, the author of *Horowitz* sued, among others, the studio that produced *Driving Miss Daisy*, alleging that the latter infringed the copyright in his novel. The screenwriter of *Driving Miss Daisy* conceded that he had read the play and that he had copied from it.¹¹² Despite this, the court, on summary judgment no less, held

109. *Id.* at 726.

110. *Id.* at 725.

111. *Id.* at 724-28.

112. *Id.* at 723-24.

that *Driving Miss Daisy* did not infringe *Horowitz and Mrs. Washington*.¹¹³

To arrive at this result, the court did not bother to determine the protectable scope of Denker's text (what were the original/copyrightable elements), which is what the court in *Kregos* did; the word originality was not mentioned once in the *Denker* opinion. Yet the court in *Denker* did in fact determine the scope of protection in something, but it was not the text. Protectable material was not separated from unprotectable material based on originality; indeed, not one prior work was mentioned in the court opinion.¹¹⁴ I suggest that courts do not engage in this inquiry because it is simply intractable.¹¹⁵

The ordinary observer in the *Driving Miss Daisy* case—asked to determine whether the film appears to be derived from the novel—might quite credibly believe the complex and protean relationship between Miss Daisy and Hoke (master and servant) to be the essence of the novel. Perhaps it is. But that particular "idea" and its general expression is hardly original. Of course, no preexisting work of fiction is identical to it at the very lowest level of abstraction. Nevertheless, the presence of so many literary antecedents means that the scope of protection in *Driving Miss Daisy* is quite narrow. In other words, because his copyright obviously does not extend to cover preexisting works, those works, in essence, define the scope of his copyright.

The master-servant theme indeed has a venerable literary tradition. It has been refined through literary masterpieces such as Cervantes's *Don Quixote*, Twain's *Huckleberry Finn*, Smollett's *Roderick Random*, Fielding's *Joseph Andrews*, Dierdot's *Jacques the Fatalist*, and Dickens' *Pickwick Papers*. Elements from each of these works can be found in the work-in-suit (plaintiff's work, *Horowitz and Mrs. Washington*) in the *Driving Miss Daisy* case referred to earlier. For instance, the transformation of the formal employer-employee relationship into a genuine friendship (the dissolution of the master-servant relationship) and the quasi-paternalistic tenor of the relationship (servant towards the master) that comprise a large part of the aesthetic appeal in *Horowitz* are also major themes in *The Pickwick Papers* and *Huckleberry Finn*. Nor is the

113. *Id.* at 736.

114. *Id.* Instead, the court relied upon the discrete and comprehensive dissimilarities between the two works and, to a far lesser extent, the idea/expression dichotomy and the scenes-a-faire and merger doctrines to determine the scope of protection.

115. Therefore, I find the proposals for copyright reform offered in the literature suggesting that courts "ought to determine whether this taken thing was itself taken by the plaintiff from the cultural tradition known to those in the field . . ." too vague to be of any use. John Shepard Wiley, Jr., *Copyright at the School of Patent*, 58 U. CHI. L. REV. 119, 184 (1991).

treatment in *Horowitz* of the servant as a true equal—perhaps even a superior who educates the master—an original variation of the master-servant theme, having been previously explored in *Jacques the Fatalist*. Nevertheless, none of this appeared in the *Denker* opinion. Indeed, originality was not once mentioned; rather, protection was denied on idea/expression, scenes-a-faire, merger, and extent-of-dissimilar-element grounds.

An ideal infringement analysis would, of course, consider all of these works in defining the scope of *Denker's* copyright claim before deciding infringement. Yet that is obviously intractable, which explains why it was not done in this case, nor is it ever done in disputes involving literary works. This should convince the reader that something other than a property right in relation to a text is being protected by copyright.

F. A Brief Digression: Other Commentators' Efforts

If the reader accepts my thesis—that the boundary separating original from unoriginal subject matter is too difficult in most instances to be reliably drawn—then several proposals offered in the literature for reform of copyright law must be immediately rejected. I shall discuss the most recent and pervasive of these below.

In the past decade, a cluster of articles has appeared that generally offers some sort of proposal to reform copyright, motivated by the stale insight that both patent law and copyright law protect intangible property. Therefore, these commentators argue, a patent law doctrine or two should be transplanted into copyright law to repair the latter. In other instances the commentators call for outright fusion of the two bodies of law or, still more extreme, for outright replacement of copyright doctrines for their patent counterparts.

The purpose of the previous section was to show that a property right in relation to a text would be problematic because of the extraordinary difficulty in separating original from unoriginal expression. I have argued in this Article that the difficulty appears to be an intrinsic attribute of texts—or the thing that copyright must protect—rather than a superficial flaw in the copyright law. Furthermore, this Article showed that neither the Copyright Office nor the courts in litigation engage in this determination. Instead, courts have developed approximating devices, most notably the idea-expression doctrine, to estimate where the prior art frontier lies. The conclusion drawn from this is that copyright law—both in theory and in practice—is poorly suited to define a property right in relation to a text. Rather than offering the conclusion that a copyright is a poorly defined property right in relation to a text, I have relied on that as a premise to show that a copyright is not a property

right in relation to a text at all but is a property right in relation to a legally structured market position. Therefore, I reject the syncretic approaches of these commentators whose work I shall discuss below.

Professor Lemley has argued that copyright law is "more hostile to improvements than is patent law."¹¹⁶ By "improvements" he means related works that borrow from a prior work though this term is ambiguous and problematic when applied to copyright law. For one thing, it is borrowed from patent law; there, an "improvement" has a sensible benchmark—the device performs the function more cheaply, reliably, and accurately than the prior device. Put another way, an "improved" device or method has a clear meaning because a patent is directed to a functional endpoint rather than an aesthetic one—*i.e.*, an improved device is one that performs its intended function somehow "better" than prior ones. I am not sure what it would mean to "improve" upon a work of literature, unless he means new works recast in different media (for example, novel to film), though in that case how can the film be said to be an "improvement?" In any event, Lemley then argues that the best way to fix copyright law is to make it more like patent law—in this instance, to amend the law to provide for "blocking copyrights."¹¹⁷ A "blocking patent" is best characterized as a property right within a property right.¹¹⁸ The concept embodied in the term is confusing because it has no analogue to a concept found in tangible property.¹¹⁹ For instance, suppose Smith has a patent covering compound X; he discloses its use as a fertilizer. While the Smith patent is still in term, Jones discovers that compound X is also an effective anti-tumor agent—a use of which Smith was not aware. Can Jones patent the new use? Yes, and that type of patent is known as a blocking patent because it blocks Smith from selling compound X for use in treating cancer and because Y cannot sell X without infringing Smith's original patent. So, heuristically, the Jones patent can be thought of as a property right existing within Smith's—like a hole in a doughnut. Though it may not be obvious in this context, what makes the tight juxtaposition of these competing rights possible is that they are well-defined property rights. As this Article has argued, literary texts are ill-defined with respect to

116. Mark A. Lemley, *The Economics of Improvement in Intellectual Property Law*, 75 TEX. L. REV. 989, 1029 (1997).

117. *Id.* at 1069.

118. *Id.*

119. Perhaps it does. Suppose a landowner owned a piece of land completely encircled by land owned by another. In that case though he would have the right to exclude the second landowner from his little island of property, the first landowner would not have the right, without an easement, to leave his property (and therefore, commercially exploit it).

their original and unoriginal elements. Yet blocking copyrights require precise boundaries to squeeze the blocking property right within the interstices of the prior right. It will not work for traditional copyrightable subject matter, and I suspect that nearly every copyright practitioner already knows this.

Finally, I disagree with Professor Lemley's premise that copyright is more hostile to improvers than is patent law. He infers this premise from the absence of a system of blocking copyrights, which is where I assume he got his solution to reform copyright law. There is a reason copyright law does not recognize blocking copyrights; they would not work. No one could define this right with sufficient precision to have any legal meaning. Instead, copyright law has its own mechanisms for protecting or immunizing the work of improvers of which Professor Lemley apparently was not aware. Again, the ordinary observer will excuse an accused text if he does not recognize it as having been derived from the first even though the accused text contains protectable expression taken from the first text. This habitually occurs, for instance, in film-adaptation disputes.¹²⁰ The ordinary observer fails to recognize the accused novel's essential features embodied in the film and excuses the copying. Indeed, perhaps this is as close to definition of an "aesthetic improvement" as we can get: a text that the ordinary observer does not recognize as having been derived from the original text even though the accused text embodies elements from the original text. Of course, if we accept this definition, then copyright law is anything but hostile to improvers but indeed immunizes them from infringement although they borrowed protectable expression from a prior text.

Professor Wiley's proposal is more drastic and appears to require no less than a complete replacement of copyright law's essential machinery by doctrines borrowed from patent law.¹²¹ This proposal is not tractable for the same reasons that Professor Lemley's was not. A copyright, regardless of how one characterizes it, does not confer a well-defined property right in a text but confers a poorly defined one at best. Additionally, while it is true that both patent and copyright protect novel intellectual creations, it is easy to overstate this similarity. As this Article has argued above, an aesthetic creation and a functional one are completely different creatures. Indeed, the copyright law makes sure of that: it expressly denies protection for any functional features of an article.¹²² Also, the rigid orthodoxy of patent claim language does not allow for description of the aesthetic features of a device. Therefore, a

120. See Y'Barbo, *supra* note 9, at 304.

121. Wiley, *supra* note 115, at 119.

122. 17 U.S.C. § 101 (1994).

proposal to transplant patent laws' venerable body of law on the patentability standard (based on novelty and nonobviousness) to copyright law is difficult to take seriously.

V. COPYRIGHT INFRINGEMENT IS PREMISED UPON COPYING BY THE ACCUSED INFRINGER

The Copyright Code defines a copyright claim as though it were a property right in relation to a text. The Copyright Statute expressly enumerates rights over which the copyright owner has exclusive dominion and later defines the unauthorized exercise of those rights as "infringement."¹²³ Yet the genuine test of whether intangible property possesses the attributes of property depends upon whether the property owner has the absolute right to exclude all others (*i.e.*, is it an enforceable right, and against whom) and whether the owner has the right to exercise complete control over his or her property. Therefore, a regime based on the grant of property rights should condemn any, or almost any, unauthorized exercise of those exclusive rights as an improper intrusion upon the copyright owner's property, against anyone. Yet copyright does not, which raises the question: From what does the copyright owner have the right to exclude an infringer? As we shall see in this section, this right is severely limited based on the method by which the accused infringer prepared his text.¹²⁴

In this next section, it is argued that liability for copyright infringement is premised on the method by which the accused infringer created his or her text rather than on the amount of protectable expression common to both texts. Put another way: if the accused infringer's text is identical to a prior one, it still does not infringe the prior text unless the accused text was derived from the prior text. This is not just an affirmative defense to a charge of infringement but the chief component of the plaintiff's *prima facie* case. This principle is virtually impossible to reconcile with a regime granting a property right in expression embodied in a text.

Consider the test for patent infringement: "To establish infringement, every limitation set forth in a patent claim must be found in an accused product or process"¹²⁵ This is a sterile, highly analytical process that requires painstaking dissection of the terms comprising the claims in the patent. By contrast, consider a few exemplary formulations of the

123. *Id.* §§ 106, 501(a).

124. *See, e.g.*, Lemley, *supra* note 116, at 1014 ("[C]opyright infringement cases frequently focus on the defendant's actions and intentions in preparing the accused work").

125. *Laitram Corp. v. Rexnord, Inc.*, 939 F.2d 1533, 1534 (Fed. Cir. 1991).

copyright infringement standard: "[Infringement does not] necessarily depend on the quantity taken [but also on the] value of the materials taken. [Infringement may exist] 'if so much is taken, that . . . the labors of the original author are substantially and to an injurious extent appropriated by another . . .'"¹²⁶ "Taking what is in essence the heart of the work is considered a taking of a substantial nature, even if what is actually taken is less than extensive."¹²⁷ "Appropriation of the fruits of another's labor and skill in order to publish a rival work without the expenditure of the time and effort required for the independently arrived at result is copyright infringement."¹²⁸ Finally, from *Arnstein v. Porter*,¹²⁹ perhaps the most important decision in copyright law: "The question, therefore, is whether defendant took from plaintiff's works so much of what is pleasing to the ears of the lay listeners, who comprise the audience for whom such popular music is composed, that defendant wrongfully appropriated something which belongs to the plaintiff."¹³⁰ These excerpts illustrate that (1) copyright infringement is premised on the method by which the accused infringer prepared his or her work rather than on the amount of protectable material copied, and (2) the analysis rapidly distills to a fundamental matter of fairness.

Indeed, the copyright infringement test appears to have always been this way. A review of the nineteenth century copyright cases reveals an unmistakable fixation upon copying, which is offered to corroborate the conclusion presented in the previous section that the method by which the accused infringer created his or her work, not the quantitative measure of the material taken, is the center of gravity of the infringement analysis. Consider how one court in 1845 phrased the infringement test: "[T]he real question on this point, is, not whether such resemblances exists, but whether these resemblances are purely accidental and undesigned, and unborrowed, because arising from common sources accessible to both the authors . . ."¹³¹ A few years later in 1858, another court, relying upon the leading copyright treatise, framed the infringement test this way:

[T]he main question is, whether the author of the work alleged to be a piracy has resorted to the original sources alike open to him and to all writers, or whether he has adopted and used the plan of the work

126. *Folsom v. Marsh*, 9 F. Cas. 342, 348 (C.C.D. Mass. 1841) (No. 4901).

127. *WPOW, Inc. v. MRLJ Enters.*, 584 F. Supp. 132, 136 (D.D.C. 1984).

128. *Meredith Corp. v. Harper & Row Publishers, Inc.*, 378 F. Supp. 686, 690 (S.D.N.Y. 1974).

129. 154 F.2d 464 (2d Cir. 1946).

130. *Id.* at 473.

131. *Emerson v. Davies*, 8 F. Cas. 615, 625 (C.C.D. Mass. 1845) (No. 4436).

which it is alleged he has infringed, without resorting to the other sources from which he had a right to borrow.¹³²

Finally, at about that same time (1862), a federal court in Ohio posed the question essentially the same way:

[T]he true inquiry undoubtedly is, not whether the one is the facsimile of the other, but whether there is such a substantial identity as fairly to justify the inference that in getting up the guide, Mrs. Ewing has availed herself of Mrs. Drury's chart and has borrowed from it its essential characteristics.¹³³

So, compared with patent law and trademark law, the most distinctive feature of copyright law is that the copyright infringement plaintiff must affirmatively disprove independent creation by the accused infringer. This is a more crucial prong of the infringement test than it first appears to be. We shall put to one side the question of precisely why the copyright plaintiff must do so when, for instance, the patent plaintiff must not. For now, consider the following example. Suppose that during an archaeological excavation of a tomb of unknown origin near Cairo, Egypt, a highly regarded egyptologist discovers an ancient dramatic play written on tablets found within the tomb. The play, written over 5,500 years ago in an obscure hieroglyphic-like dialect not previously translatable, represents a find of unprecedented significance to the field of egyptology and, indeed, to the public-at-large. The egyptologist who unearthed the play, after several years of extraordinary effort, successfully translates the play. She then promptly publishes the play in her native language, which is Chinese. Photographs of the pages of hieroglyphic symbols are prepared and made available by the internet from the library at Cairo. The translation of the play is both a premiere scholarly achievement and a huge commercial success.

A year or so later, an American translates the play into English. He publishes it in the U.S. and other English-speaking countries in advance of the Chinese egyptologist's version, which has not yet been translated into English even though plans were currently being made to do so given the important commercial markets that English-speaking countries represent. The American's version also becomes a huge commercial success. Is the American guilty of copyright infringement?

The question, as it is in all copyright infringement cases, is this: Are the two texts substantially similar with respect to only the original work's protectable expression? If so, the American infringes subject to

132. *Greene v. Bishop*, 10 F. Cas. 1128, 1134 (C.C.D. Mass. 1858) (No. 5763).

133. *Drury v. Ewing*, 7 F. Cas. 1113, 1116 (C.C.S.O. Ohio 1862) (No. 4095). *See also*, e.g., *Haas v. Leo Feist, Inc.*, 234 F. 105 (S.D.N.Y. 1916) (Hand, J.).

the important proviso that if the American created his work independently and without copying from the egyptologist's work, then he is not an infringer regardless of the similarity between the two works.

Obviously then, the difficulty lies partially in identifying the protectable expression that comprises the egyptologist's work (*i.e.*, precisely what portions of the work represent his contribution). Consider just how difficult that will be in this instance. The work of the egyptologist is, of course, itself a "copy," or a derivative work of a prior text in the public domain. The defendant, of course, contends that his work is also a translation of the same public domain text and not of the egyptologist's work. Therefore, he argues, some similarity, perhaps most of the similarity, is inevitable. Indeed, the egyptologist's copyright only protects his original contribution, and there is really no way to determine what that is. Thus, determining the scope of the egyptologist's copyright is a difficult task.

But even before we get to the question of whether the two works are substantially similar, the egyptologist must traverse the first prong of the infringement test: that the defendant copied from the egyptologist's text. Regardless of the similarity of the two works, if the American sat down at his desk and created the translation using only the photographs of the hieroglyphic pages, he has not infringed. On the other hand, if he had in front of him and relied upon both the hieroglyphics pages and the egyptologist's Chinese translation—that is, if his own work is derived from the plaintiff's—then he is (depending upon how much he took) an infringer.

So, the egyptologist must prove that the American defendant copied at least partially from the egyptologist's work while the American prepared his translation. As a practical matter, consider what evidence will be proffered by the plaintiff to prove this. Because she has no direct evidence of copying, she must try to prove it inferentially by evidence of access. In this scenario this will not be difficult because of the widespread dissemination of the egyptologist's translation of the play.¹³⁴ Aside from this, she will also no doubt inform the trier-of-fact that the American defendant is not an egyptologist and has no formal training or experience in that area. Instead, the defendant is a clerk in a used bookstore, whose formal education comprises an undergraduate

134. See, *e.g.*, *Cholvin v. B & F Music Co.*, 253 F.2d 102, 104 (7th Cir. 1958) (repeated radio broadcasts in the area where the defendant resides will suffice to prove access); *ABKCO Music, Inc. v. Harrison's Music, Ltd.*, 944 F.2d 971, 982 (2d Cir. 1991) (proof that the plaintiff's song was "#1" on the top hits chart was likewise sufficient to traverse the access requirement). *But see, e.g.*, *Jason v. Fonda*, 526 F. Supp. 774, 777 (C.D. Cal. 1981) (the fact that between two hundred and seven hundred copies of plaintiff's book were available in bookstores was insufficient to permit an inference of access).

and master's degree in the Chinese language. Additionally, the egyptologist argues that she took five years to complete the translation; the defendant completed his in three months.

Consider how that information and the consequent determination of whether the American prepared his work from the original public domain text or whether he relied—even in part—upon the Chinese translation, seem so crucial to the question whether the American's activity is permissible, aside from any similarity between the two texts. Obversely, consider how the issue of similarity between the two texts alone seems inadequate to resolve the infringement question.

*Toksvig v. Bruce Publishing Co.*¹³⁵ is an actual case very similar to the hypothetical just presented. In *Toksvig* plaintiff, Toksvig, published a work entitled *The Life of Hans Christian Andersen*, a biography of the renown children's author. Years later, defendant, Hubbard, wrote a novel entitled *Flight of the Swan*. Although Hubbard's work was a novel, it was closely based on the life of Hans Christian Andersen.¹³⁶ Because Hubbard copied some passages verbatim from Toksvig's biography, though limited to quotations contained in the latter's work taken from letters and other sources clearly in the public domain, the trial court found infringement; the Seventh Circuit affirmed.¹³⁷ The court did not bother to determine the scope of Toksvig's copyright; what material was protectable and what was not. What the court did focus on was that Toksvig had taken three years to complete her work, relying solely on Danish sources including Andersen's original works and letters.¹³⁸ By contrast, the court found that defendant Hubbard neither spoke nor read Danish and completed her novel in only eleven months.¹³⁹

Next, consider *Lipton v. Nature Co.*¹⁴⁰ In *Lipton* plaintiff had written a book comprised of "terms of venery," which are terms used to describe a collection of entities, usually but not always, animals: "a pride of lions," a "gaggle of geese," a "rafter of turkeys," a "parliament of owls," and so forth.¹⁴¹ Apparently, collecting these terms is more difficult than it appears because plaintiff claimed that he compiled the terms "through research of various fifteenth-century texts and manuscripts . . . [translating] the terms from Middle English to modern

135. 181 F.2d 664 (7th Cir. 1950).

136. *Id.* at 666.

137. *Id.* at 668.

138. *Id.* at 666.

139. *Id.* at 667.

140. 71 F.3d 464 (2d Cir. 1995).

141. *Id.* at 467 n.2.

English and [arranging] them based on their 'lyrical and poetic potential.'¹⁴² In any event, the accused infringer did not dispute the similarity between his work and plaintiff's; rather, he claimed that he could not possibly have copied from plaintiff's book because he had never seen it before.¹⁴³ And apparently, the plaintiff was not able to prove otherwise. Observe how this case, like so many other copyright disputes, turns almost entirely on defendant's behavior—how he prepared his work (from whom did he copy) rather than what he copied.¹⁴⁴

In conclusion, these cases suggest that the copyright owner's right to exclude others from copying his work is highly conditional. More particularly, a comparison of the two cases reveals the undeniable dependence upon the method by which the accused infringer created the text rather than upon the extent of similarity between the two texts. How would *INS v. AP* have been decided if the defendant, instead of publishing daily newspapers that competed directly with the plaintiff's own daily newspapers, had used the purloined material for inclusion in topical summaries published in a monthly news magazine? Far differently, one might expect.

VI. THE ULTIMATE QUESTION IN EVERY INFRINGEMENT DISPUTE

A. *The Ordinary Observer*

In the previous section, I argued that the method by which the accused infringer prepares his or her work is far more important than the amount of protectable material common to both works in determining infringement. This section argues that the method is important as a reliable filter, ultimately to determine whether the effect of the unauthorized borrowing is market harm; without copying, no opportunity exists for improper market harm. Thus, copying is a necessary but not a sufficient condition to establish market harm.

Again, the quantitative similarity between the two works appears to be virtually irrelevant compared with the method of the copying and compared with the consequence to the second author's overall cost of

142. *Id.* at 467.

143. *Id.*

144. Yet plaintiff was able to prove that the accused infringer had prepared his work by copying from a third-party work. The way the court resolved this dilemma is interesting. It compared the third-party work with the plaintiff's book and concluded that the two were so similar that the third-party work had to have been copied from plaintiff's book—which meant that defendant had actually had access to and copied from plaintiff's copyright by virtue of copying from a third-party work that embodied protectable elements of plaintiff's copyright claim. *Id.*

expression. Of course, this effect translates into economic harm: independent creation is not actionable because, without free-riding, both parties bear about the same cost of creating their works. Hence, neither can lower the price of copies down to marginal cost.

If free-riding, or the effect of the copying on the second author's cost of expression, is the primary desideratum in copyright infringement, then you need a way to predict it. That is what the copyright's copying and access requirement does. If the defendant derived or is likely to have derived his work from the plaintiff's work, then there is greater probability that he reduced his cost of expression, a cost differential that he can exploit in the form of lower price approaching marginal cost, to the detriment of the original author who is unable to match that price and still recoup his own cost of expression. Conversely, without copying, then regardless of similarity, the defendant did not take a free ride on the plaintiff's protectable expression. If the defendant did copy from the plaintiff's text, a further assay is required to predict probable market harm. The easiest way to do this is to ask the average consumer whether he would confuse the two works—whether he would be led into thinking that the latter is derived from the former. Hence, the ordinary observer test applies: "[t]he lay listener's reaction is relevant because it gauges the effect of the defendant's work on the plaintiff's market."¹⁴⁵ Thus, the ordinary observer excused the movie based on the film, recast in a different genre, though it retained the theme, plot, and essential sequence of events.¹⁴⁶ Yet the same ordinary observer condemned an accused comic book though it only borrowed the characters (in name and likeness) from a cartoon of a far different genre, theme, and storyline.¹⁴⁷

So the ultimate infringement decision—provided the matter proceeds this far—is left to the relentlessly maligned "ordinary observer." Like tort law's "ordinary prudent person" and patent law's "person having ordinary skill in the art," the "ordinary observer" is the fictional character constructed to resolve one of our law's more unanswerable questions.¹⁴⁸ We ask these hypothetical figures: What is "reasonable

145. *Dawson v. Hinshaw Music, Inc.*, 905 F.2d 731, 734 (4th Cir. 1990).

146. *Kretschmer*, 1994 WL 259814, at *9.

147. *Walt Disney Prods. v. Air Pirates*, 581 F.2d 751 (9th Cir. 1978).

148. Why is the ordinary observer the ultimate arbiter of copyright infringement? As I mentioned earlier, in numerous instances, the common law determines liability based on the reaction of an ordinary member of the relevant community (e.g., patent law's "person having ordinary skill in the art," tort law's "ordinary prudent person," and so on). Aside from subtle refinement—i.e., recognizing different communities or audiences from which the ordinary person is selected (hence, the ordinary observer in a copyright infringement dispute involving video games might be a twelve-year old child)—these legal rules appear

care" under the circumstances? What constitutes an "obvious" technical improvement over the state-of-the-art for which patent protection should be denied? And, does one literary work borrow "unfairly" from another—does it infringe?

If copyright law did confer a property right in the author's text, then relying on the ordinary observer's deliberately uncritical opinion to enforce intrusions upon that property right would be highly peculiar, to say the least. In the case of fictional works, the infringement dispute is turned over to the ordinary observer along with this data: (1) plaintiff owns a copyright in the text at issue, which implies some minimal level of originality, though precisely in what elements of that text the originality resides is not determined or is essentially undeterminable; and (2) the accused infringer created her work by copying from this text. Given this information, the ordinary observer is instructed to render an infringement verdict provided that the accused text strikes him as having been derived from the plaintiff's text: "The test for substantial similarity is whether an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work."¹⁴⁹ Notice that he is not asked to perform the far simpler task: to identify discrete elements of the plaintiff's work in the accused work. Notice also that if the factfinder determines beforehand that the plaintiff does not own a valid copyright or, even if it does, that the accused infringer independently created its work, then the court renders summary judgment for the accused infringer, and the ordinary observer is never invoked.

Professor Nimmer is perhaps the most persistent critic of the ordinary observer standard (*e.g.*, "It would seem preferable, in short, to discard the audience test."¹⁵⁰ In his leading treatise, he asks: "Can there be literary theft without an immediate and spontaneous detection by the ordinary observer?"¹⁵¹ Nimmer quite correctly observes that "if this question can be answered in the affirmative, then, obviously, the

to rarely change. One reason I suspect, and it is nothing more than a suspicion, is that rules of this type represent stable equilibria along an evolutionary path. And as stable equilibrium, they are robust—*i.e.*, they resist perturbation (legal challenge to the doctrine's validity).

149. *Kretschmer*, 1994 WL 259814, at *8 (citing *Ideal Toy Corp. v. Fab-Lu*, 360 F.2d 1021, 1022 (2d Cir. 1966) and others). Notice that this is not unlike the "likelihood of confusion" test in trademark law, which is unquestionably premised on confusion of the ordinary consumer rather than a recognition of a property right in a particular trademark.

150. MELVILLE NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT*, § 13.03[E][1][b], at 13-91 (1997).

151. *Id.* at 13-94.

audience test is inadequate."¹⁵² Professor Nimmer apparently believes that the ordinary observer will excuse accused works though in fact they actually embody protectable expression from the work-in-suit. We shall put to one side the tautological nature of Nimmer's question because the copyright community initiates know what he means. In any event, his hypothesis is a testable one.

Suppose the novelist James Michener was interested in writing a novel based on a short story by Dorothy Parker. Ms. Parker (one of the knights of the celebrated "Algonquin Roundtable") wrote numerous short stories, which, though quite entertaining, were also quite short—some less than two thousand words. Yet except for his novels' titles (*e.g.*, *Texas, Hawaii*), there is nothing short about Michener's novels. Most of his novels average somewhere around three hundred thousand words. Now suppose Michener creates a novel and in the process copies every element from Ms. Parker's short story—the characters, theme, plot, sequence of events, tone, style, and so on—except for her actual prose. Suppose further that each of these elements is protectable (an almost surely counterfactual assumption). By applying the contemporary infringement standard, would the novel infringe the short story? Almost certainly not.

To say that the two are "substantially similar" is perhaps to stretch the meaning of the term too far even though it is a term of art. Consider how the ordinary observer analysis would look. (Recall that in practice the test is applied by separating the original and accused works into discrete literary elements—theme, plot, and so forth—and asking for each element whether it is substantially similar in the two works). Again, Michener copied Ms. Parker's entire short story with the exception of the exact prose she used. Notice that is not the same as saying that the corresponding elements are the same in both works. After all, Michener must have done something with his additional 298,000 words. Michener might have added additional (though minor) characters, subplots, and so forth so that it really is a different work than Ms. Parker's original short story. But that does not change the fact, regardless of its legal significance, that he copied the entire short story. Still, one would expect that Ms. Parker would lose this fight; the novel would not infringe, for reasons I shall explain in a moment.

Miller v. CBS, Inc.,¹⁵³ is a case very close to the Dorothy Parker example. In *Miller* plaintiff, a former prisoner who studied law, received his degree and passed the bar, all while in prison, and decided to write a story about this unique experience. He wrote a three-page outline of

152. *Id.*

153. No. CV78-4291-RMT(Sx), 1980 WL 1179, at *1 (C.D. Cal. June 5, 1980).

his story and mailed it to defendant, MCA Universal Television, who incidently purchased a nine-month option but never exercised it.¹⁵⁴

A few years later, CBS produced a TV series called KAZ about an ex-con who also became a lawyer while in prison. There were numerous similarities between plaintiff's brief treatment and the accused TV show. For instance, in both, the lead character (lawyer) filed suit on behalf of incarcerated black muslims whose dietary requirements were frustrated by the prison officials; in both, he was a "jailhouse lawyer" who filed complaints on behalf of other inmates and acted as a judge to resolve disputes among inmates; in both, the lawyer spent six years in a maximum security prison in California, including stints in solitary confinement; in both, the lawyer received sixteen employment rejections while in prison; and in both, the lead character completed his entire law degree by correspondence and passed the bar while in prison. The last fact is significant because the plaintiff was, in real life, the only person known to have ever done so.¹⁵⁵ Still, the court granted defendant's motion for summary judgment.¹⁵⁶ Like the Dorothy Parker example, the court invoked the idea/expression dichotomy to deny protectability to plaintiff's work despite the fact that the accused work contained virtually plaintiff's entire work.¹⁵⁷ Plaintiff's work was a three-page written outline. The accused work was a television show, a far more detailed effort in a different medium.¹⁵⁸

Finally, if copyright is viewed as a property right in a text, even a qualified one, then the Dorothy Parker hypothetical and the *Miller* case are difficult to reconcile under that regime: the accused infringer in each instance borrowed the original author's *entire text*. Surely a property right in the text or in whatever portion of it or however qualified would proscribe an encroachment upon the property right. But if a copyright is viewed as a limited property right of reasonable commercial exploitation of the text, then the results do not seem so outrageous.¹⁵⁹ Indeed, this is further corroboration that copyright law

154. *Id.*

155. *Id.*

156. *Id.* at *6.

157. *Id.* at *3.

158. *Id.* at *1.

159. *Miller* is not an outlier—far from it. Similar (and consistent) results are reached in film-adaptation disputes (plaintiff-novelist alleges copyright infringement by the defendant filmmaker). According to my research, all contemporary film-adaptation cases appear to have the following attributes in common: in each case, the defendant (screenwriter or filmmaker) admitted that he had read plaintiff's novel and copied from it; the plaintiff's and defendant's work share the same basic concept or premise; the defendant copied discrete events, characters, or entire scenes from plaintiff's novel; the defendant took what I believe to be the essence of the work (its message, its thematic intention, and its

does not appear to permit the copyright owner to capture the full value that consumers attach to his or her work but rather delimits protection at or near the minimum threshold needed to support his or her investment.

I predicted that the accused infringer in the Dorothy Parker hypothetical, though he had borrowed the entire text, would not be liable for copyright infringement just as the similarly situated defendant in *Miller* was not. The reason is that the ordinary observer/substantial similarity test looks at the two works as a whole; it does not isolate and then compare only the protectable elements as patent law does. Instead, it judges two texts in their commercial form and not in the form of their legal claim (considering only their protectable elements). Judged that way, they are nothing alike.¹⁶⁰

More than anything else though, the conclusion that Michener is not liable to Dorothy Parker for copyright infringement is a deliberate error of parallax by the ordinary observer. Just as an ordinary viewer may believe the same object to be two distinct objects when viewed from two different perspectives (lighting, angle, distance), the perception of the ordinary observer asked to compare two works of drastically different size, style, and medium is too strained in instances like these to be reliable. Perhaps this is an inherent flaw in the legal standard, and perhaps the test had actually evolved to achieve that result. Indeed, perhaps it is time that we recognize the ordinary observer test for what it really is: a true market-based filter, necessary because the precise boundaries of protectable portions of the text are not determinable. So the ordinary observer tries instead to predict probable harm to the market for the first author's work from among only those cases in which the accused infringer actually copies protectable expression from the plaintiff.

To return to Nimmer's polemic toward the ordinary observer test, I do not disagree with his empirical claim that the literary theft can occur without the ordinary observer detecting it. Indeed, I have just tried to prove it. Rather, I argue that cases of that sort do not prove the

unique impression upon the reader); and each case was decided on summary judgment for the defendant.

160. By the way, the idea/expression dichotomy is the legal rubric upon which a court would likely ground that conclusion. The court would likely fixate on the fact that where Ms. Parker's lead character was described in two thousand words, he or she is described using twenty times that many words in the accused novel. This disparity in the level of generality at which the same character is depicted in the two different works would tempt the court to say that Ms. Parker's lead character is simply too general and too abstract to qualify as protectable expression, particularly in light of Michener's far more detailed treatment of the same material.

irrationality of the ordinary observer standard but suggest that the ordinary observer is designed to detect something, other than the presence of isolated snippets of purloined material in the accused text. That something else is probable market harm, an endpoint for which the ordinary observer is ideally suited.

B. The Equitable Defense of Fair Use

The ordinary observer test is relied upon to determine infringement in fiction works; it is not generally used to judge infringement in works of nonfiction. In this section the standard used in nonfiction works shall be discussed, and this Article shall argue that, though it appears very different from the ordinary observer standard, it too is premised on the likelihood of market harm rather than on an isolated comparison of the two texts. In other words, both the fiction works and nonfiction works infringement standards, though superficially distinct tests, are actually directed to the identical endpoint.

Refer back to *Kregos v. Associated Press*,¹⁶¹ a case discussed earlier as an "exemplar" of a copyright dispute in which the precise boundaries of the protectable portion of the text were actually determined. In *Kregos* the original/protectable portions of the text were readily determinable. This is often the case in nonfiction works. As we shall see, the infringement analysis in these instances moves quickly away from a precise definition of the protectable portion of the text and quickly towards liability based purely on market harm; however, a brief digression is needed before we go further.

Copyright law is deeply fissured into two domains—two distinct bodies of law that are drastically different though, quite astonishingly, rarely discussed that way. In other words, two different legal standards exist to judge infringement of fiction works versus works of nonfiction. The typical infringement dispute over a nonfiction work involves literal (verbatim) copying by the accused infringer. The copyright plaintiff begins by identifying the discrete element or elements copied from his work. So long as what was taken is eligible for copyright protection, the infringement analysis per se is straightforward and proceeds quickly to the real infringement analysis under the guise of the "fair use" defense, which is nothing more than a set of disparate exceptions to excuse otherwise infringing activity.¹⁶² Under fair use, the qualitative (not quantitative) importance of the portion taken is emphasized. Moreover, the similarity of the two works as a whole is almost never considered important to the infringement analysis but only later in the fair use

161. 795 F. Supp. 1325 (S.D.N.Y. 1992).

162. See 17 U.S.C. § 107 (1994).

analysis, particularly the last prong of the analysis, which scrutinizes the effect of the accused work on the market for the original. By contrast, fiction works are judged as a whole without any particular regard to discrete elements.¹⁶³

For instance, consider *Roy Export Co. v. Columbia Broadcasting System, Inc.*,¹⁶⁴ which illustrates the nonfiction standard. In 1977 Charlie Chaplin died. Though an immensely popular figure much earlier, Chaplin was virtually unknown to younger film audiences. This was because he had spent the last twenty years of his life outside the United States (having been forced out of the country on account of political pressure stemming from Senator McCarthy's anticommunism hysteria) and because (perhaps in response to this) he deliberately withheld his later films from distribution within the United States. Upon Chaplin's death, CBS network decided to prepare a major television biography. Given the subject, the biography would naturally have to include some sort of retrospective of Chaplin's films but would also discuss his personal and political life as well. This documentary was scheduled to air on television during prime time. However, CBS had a slight problem. While some of Chaplin's films were in the public domain, others were not. In fact, the owner of the copyright in some of the films had repeatedly refused to grant a license to CBS so that it could prepare its documentary. But CBS went ahead anyway. To prepare its approximately ninety-minute documentary, CBS used excerpts from five of Chaplin's films whose copyrights were owned by a third party. Together, these excerpts comprised about nine minutes of a total of almost eight hours of film from which the excerpts were taken.¹⁶⁵ Despite the fact that CBS's use of the copyrighted works was minimal, indeed no more than necessary, and despite the fact that the film excerpts were used creatively rather than imitatively to produce an entirely new work drastically different from the plaintiff's (*i.e.*, it was a transformative use) and despite the fact that the CBS documentary did not appropriate the economic value of the Chaplin films, the court found the use to be an infringement.¹⁶⁶ Yet the ordinary observer would have pardoned this use because the two works (the Chaplin films) when compared with the TV biography are aesthetically different (though some

163. Compare *Pacific & Southern Co. v. Duncan*, 744 F.2d 1490 (11th Cir. 1984) (nonfiction) with *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930) (Hand, J.).

164. 672 F.2d 1095 (2d Cir. 1982).

165. *Id.* at 1097.

166. *Id.* at 1104. CBS's fair use defense was rejected as well.

variants of the test focus upon whether the ordinary observer would recognize one as having been derived from the other).¹⁶⁷

In the vast majority of infringement disputes over nonfiction works, the infringement analysis is straightforward; typically, the accused infringer has borrowed verbatim a discrete element from the plaintiff's text, which is readily identifiable in the accused work (*e.g.*, a quote or a photograph). Hence, the infringement analysis proceeds fairly quickly toward the "real" infringement analysis: fair use. In essence, the fair use "defense" is a second infringement test.¹⁶⁸ Indeed, fair use is litigated far more often than the *prima facie* infringement case.¹⁶⁹ In fact, rather than being an affirmative defense to a charge of infringement, fair use historically was procedurally and substantively intertwined with the infringement analysis; only recently have the two inquires diverged. So it appears that the fair use doctrine (nonfiction works) and the ordinary observer standard (fiction works) generate parallel results by entirely different means.

167. Perhaps the ordinary observer would condemn the TV biography for the reason that I suggested in the parenthetical—that he would recognize that the TV biography was derived from the Chaplin films. Still, the most common formulation of the ordinary observer test is not the "derived from" variant but the "would regard their aesthetic appeal the same" one. But this brings up an interesting point. Even though the TV biography is comprised of about ninety percent original material with only ten percent coming from the plaintiff's works, that ten percent is still readily recognizable within the accused work even when viewed as a whole. This is a typical aspect of many copyright disputes over nonfiction works: the purloined material is incorporated into the accused work in a way that it is readily recognizable within the accused work (like mixing gin and lime juice).

Generally, though not always, fiction cases look differently. The incorporation of borrowed material (*e.g.*, a basic sequence of events) into the accused work is more like a chemical reaction between the borrowed material and the new stuff—the borrowed material is no longer separately recognizable once subsumed within the accused work but becomes an organic part of the whole (like combining carbon, hydrogen, and oxygen to get sucrose). Hence the ordinary observer would overlook the borrowed material and excuse the copying.

One exception among cases involving fiction works includes "character" cases in which the accused infringer creates an entirely new work around a character (Sam Spade, Mighty Mouse) borrowed from the original. In these instances, the borrowed element is actually recognizable within the accused work. This might explain why these cases stand out among fiction work cases, which generally tolerate substantial copying without infringement, though not in the character cases. *See, e.g.*, *Walt Disney Prods. v. Air Pirates*, 581 F.2d 751 (9th Cir. 1978) (and cases cited therein).

168. That the fair use inquiry is the "real" infringement analysis is no secret. *See, e.g.*, Laura G. Lappe, *The Metaphysics of the Law: Bringing Substantial Similarity Down to Earth*, 98 DICK. L. REV. 181, 188 (1994). "[C]ourts frequently either omit or give cursory treatment to the issue of infringement when the fair use defense is raised." *Id.* at 185. On this, I believe Professor Lappe is quite correct; indeed, in nineteenth-century infringement cases, fair use was blended with the infringement analysis.

169. *See, e.g.*, Gordon, *supra* note 3, at 1372.

Fair use is an enormous and often disparate collection of exceptions to liability, judicially codified since 1976 into copyright law.¹⁷⁰ By far the most important of these exceptions is 17 U.S.C. § 107(4): "the effect of the use upon the potential market for or value of the copyrighted work." Therefore, fair use explicitly redirects liability toward economic harm, or at least putative economic harm, and away from an isolated determination of the scope of protectable expression of the plaintiff's text. As evidence of this, the doctrine of fair use has been invoked in numerous instances to excuse even verbatim borrowing from the copyright owner's work. For instance, in *Sony Corp v. Universal City Studios*,¹⁷¹ the Supreme Court relied on fair use to immunize copying an entire television show by home video-cassette recorder (VCR) owners.¹⁷² This copying was excused on the ground that the copying did not curtail viewer demand for the television shows.¹⁷³ Similarly, the Copyright Act of 1976 contains an explicit provision to permit whole-text copying for books and periodicals for educational purposes.¹⁷⁴ This activity is immunized by similar reasoning. Consider also *Consumers Union of the United States, Inc. v. General Signal Corp.*¹⁷⁵ In *Consumers Union* defendant incorporated a verbatim excerpt from plaintiff's magazine, which recommended defendant's product, into its advertisement.¹⁷⁶ The court found this use to be fair on the ground that the demand for plaintiff's work (that particular magazine issue) was not likely to be suppressed by defendant's use of the borrowed material.¹⁷⁷

VII. THE RELATIONSHIP BETWEEN A TEXT'S COPYRIGHTABLE ELEMENTS AND ITS AESTHETIC APPEAL IS PROBLEMATIC

A. Introduction

Copyright would function most efficiently to encourage the protection of original works of authorship if a perfect correlation existed between copyrightability-protectability and economic value—if those elements of a text responsible for its aesthetic appeal (hence, economic value) corresponded to the protectable elements. Aesthetic appeal matters

170. 17 U.S.C. § 107 (1994).

171. 464 U.S. 417 (1984).

172. *Id.* at 447.

173. *Id.*

174. H.R. REP. NO. 94-1476, at 68-69 (1976); *see also* S. REP. NO. 94-473, at 64-65 (1974).

175. 724 F.2d 1044 (2d Cir. 1983).

176. *Id.* at 1050.

177. *Id.* at 1051.

because that is ostensibly the thing to which the ordinary observer responds. Also, economic value matters because the infringement standard should ideally be calibrated upon the authors' incentives to create, which for present purposes are best approximated as purely economic. Indeed, the most easily identified endpoint for infringement is economic harm to the copyright owner's market position relating to the copyrighted text. In any event, whatever elements of a literary text copyright law protects, one would at least expect that it would protect its "essence" or that combination of elements primarily responsible for its aesthetic appeal, hence its economic value. By "economic value" I mean the commercial value of the text plus the commercial value of all reasonably foreseeable derivative embodiments comprised of the protectable elements of the original copyright claim (as embodied in text deposited with the registration certificate).

Again, my question is this: does contemporary copyright law protect the "essence" of an author's work? This is actually two questions. First, the threshold question: for any given literary work, do those elements that contribute to the work's aesthetic appeal (hence, economic value) tend to qualify for protection by copyright—are they original, sufficiently concrete? The second question is this: even if those elements that comprise a work's essence are copyrightable, is this copyright enforceable—can the first author protect them from copying by others? These two questions may appear to be the same at first, but heuristically they are best separated.

B. The Relationship Between a Work's Aesthetic Essence and Copyrightability

Obviously I do not expect to find some unifying principle nor even robust empirical correlation—just tendencies. Consider *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*,¹⁷⁸ one of Judge Learned Hand's last copyright opinions. This case involved possible infringement of plaintiff's ornamental design imprinted upon cloth used to make women's dresses. Defendant's cloth was similar but not identical to plaintiff's.¹⁷⁹ The essential question for Hand was: would the ordinary observer regard their aesthetic appeal as the same notwithstanding the

178. 274 F.2d 487 (2d Cir. 1960). It occurs to me that one cannot write an article on copyright without citing at least one Judge Learned Hand opinion. I believe Judge Hand wrote many outstanding copyright opinions although some he botched, like *Peter Pan Fabrics*. I intend, at the risk of heresy, to discuss Judge Hand's copyright opinions with the same objective perspective with which I examine all others, which is to say not absolutely paralyzed by reverence.

179. *Id.* at 489.

differences? Hand said yes, and that was the end of the matter; defendant was an infringer.¹⁸⁰ But it is actually much more complicated that.

What Hand did was proceed immediately to infringement without first dealing with the originality problem.¹⁸¹ In other words, Hand's analysis was correct if plaintiff's entire cloth design was original, which is highly unlikely. This complicates everything; for one thing, you have to establish the protectable elements of plaintiff's design and then ask what features of the design are responsible for its aesthetic appeal. Then you must compare those two sets of features. Is it the fabric color, its texture, the overall pattern, the arrangement of the symbols and figures within that pattern, or the symbols and figures themselves? What if the ordinary observer responded only to the color and the overall pattern, neglecting everything else (which is certainly plausible)?

Suppose, however, that those features are not original and thus not protectable (also a reasonable assumption). If that is true, then Hand's analysis was improper because the aesthetic appeal was due to public domain elements. Hence, if the accused infringer's cloth consisted of only those elements that comprised the aesthetic appeal of plaintiff's cloth (features in the public domain), then it would not infringe even though the ordinary observer would regard the two as similar because their aesthetic appeal was essentially the same. I offer this example only to show that those elements in which the work's aesthetic appeal resides are quite likely to be unprotectable.

So what are the protectable elements of a literary work? Remember that copyright law makes no aesthetic judgments: if the work is original and complies with the other statutory requirements, then it is protected by copyright. Copyright protects the circus poster as well as the architectural drawing, the stuffed animal as well as the marble sculpture, the nursery rhyme as well as the lyric poem, the advertising jingle as well as the symphonic score, and the telephone book as well as the literary biography.¹⁸² In other words, a greater aesthetic contribution does not necessarily mean greater copyright protection.

180. *Id.*

181. *Id.* at 488. Really, that is a pleading problem. The defendant's lawyer should have defined, and hence narrowed, plaintiff's original contribution at the injunction hearing.

182. See, for example, Justice Holmes' opinion (from which I borrowed the reference to the circus poster) in *Bleistein v. Donaldson Lithograph Co.*, 188 U.S. 239, 251 (1903) ("It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations . . ."). See also, e.g., *Rushton v. Vitale*, 218 F.2d 434 (2d Cir. 1955).

First, the protectable elements are, of course, a subset of the original elements. A particular "element" in a copyrighted work may be unprotectable for only two reasons: either it is not original or the particular element is not per se protectable, which means it is an idea or concept somehow too abstract to protect. So we begin with the original elements and pare them down using idea/expression, scenes-a-faire, and the merger doctrine. That copyright protection does not extend to ideas, plots, dramatic situations, and events is bedrock copyright law.¹⁸³ Rare exceptions exist if these elements are original and sufficiently detailed.¹⁸⁴ Yet copyright protection extends beyond the precise words the author uses—*e.g.*, a play's dialogue.¹⁸⁵ Somewhere between these two constraints, the boundary separating protectable from unprotectable expression exists. One often-cited aphorism is: "[T]he essence of infringement lies in taking not a general theme but its particular expression through similarities of treatment, details, scenes, events and characterization."¹⁸⁶

The overwhelming majority (judged either quantitatively or qualitatively) of the literary elements that comprise any work—theme, plot, characters, setting, and so forth—is not protectable. This is true generally for the same reasons that any particular thing is not copyrightable: it is not original (there is a similar enough antecedent out there somewhere), or it is too vague to be protectable expression (*e.g.*, a story's theme or premise is almost never protectable).

Even when the elements are sufficiently specific to qualify as "expression," they very often are caught in the filter known as "scenes-a-faire," meaning that the particular thing is inevitable given the broader literary element under which it is subsumed. For instance, if the premise is life in a South Bronx police precinct and the protagonist is a hard-drinking, cynical yet professionally dedicated Irish cop, courts almost always say that this character (even if he is substantially more well-developed than that) is predictable or inevitable in any story that has the same premise (*e.g.*, a comic movie about American tourists in France will likely include a scene, or several, where the locals are unusually rude toward the visitors). Scenes-a-faire is the most common

183. *Walker v. Time Life Films, Inc.*, 784 F.2d 44, 48 (2d Cir. 1986); *Warner Bros. v. ABC*, 654 F.2d 204, 208 (2d Cir. 1981); *O'Neill v. Dell Publ'g Co.*, 630 F.2d 685, 686 (1st Cir. 1980); *Sid & Marty Krofft Television v. McDonald's Corp.*, 562 F.2d 1157, 1163 (9th Cir. 1977); *Scott v. WKJG, Inc.*, 376 F.2d 467, 469 (7th Cir. 1967).

184. *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930) ("[W]e do not doubt that two plays may correspond in plot closely enough for infringement.").

185. *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 55 (2d Cir. 1936) (and cases cited therein).

186. *Reyher v. Children's Television Workshop*, 533 F.2d 87, 91 (2d Cir. 1976).

legal device used in contemporary film-adaptation cases to separate protectable from unprotectable subject matter and works to the benefit of the accused infringer.¹⁸⁷

Additionally, the sine qua non of copyright is originality, which means that the author must contribute something new, however trivial.¹⁸⁸ But how well-stocked is the ordinary observer's mental library so that he can scan for literary antecedents to the work whose originality he is charged with judging? Perhaps he might be able to identify certain archetypal characters upon which more mundane characters of modern fiction are based, such as Oedipus, Hamlet, Faust, Quixote, Clarissa Harlowe, or Tristan; however, I doubt it. Or if the ordinary observer did not know that the novelist borrowed his sequence of events from a local newspaper account of a small town murder, he would believe that to be an original, hence protectable, element of the novel. Yet we expect this

187. All of the modern film adaptation cases, for instance, grossly over-rely on the scenes-a-faire doctrine, which goes a long way toward explaining why what I certainly believed were some very close cases were decided on summary judgment. It seems to me that this is a by-product of defining a work's theme too broadly. Scenes-a-faire is generally defined as stock scenes that inevitably flow from a particular concept, genre, theme, or other. For instance, a story about life in a South Bronx police station is likely to feature a hard-drinking and cynical but dedicated Irish cop, and that particular character at that level of abstraction is deemed unprotectable by scenes-a-faire. The reader can see that the more broadly one defines a work's theme, the more expression is subsumed under it. The following are examples from the case law. *Defending Your Life* case: "The use of courtrooms, judges, jurors, and attorneys is inevitable in any treatment of judgment in the afterlife, and as such, constitutes scenes-a-faire, and are thus unprotectable." *Kretschmer*, 1994 WL 259814, at *8 (citing *Reyher v. Children's Television Workshop*, 533 F.2d 87, 92 (2d Cir. 1976)). *Groundhog Day* case: "Any similarities in structure stem directly from the idea of a repeating day and, hence, are unprotectable." *Arden v. Columbia Pictures, Inc.*, 908 F. Supp. 1248, 1260 (S.D.N.Y. 1995). In both of these cases, the courts defined the work's theme too broadly. In the former case, the court thinks it is "judgment in the afterlife" and in the latter, "a repeating day." I am certainly no literary critic. Yet that is not a prerequisite to see that the courts have completely mischaracterized these works. In both instances, what the court thinks is the theme is really a means of expressing the theme. If this is correct, is it sensible to invoke the scenes-a-faire doctrine? In other words, can expression that supports (at a lower level of abstraction) other (protectable) expression somehow be unprotectable?

What is more, I think judges are relying on more than a little hindsight when invoking this doctrine. Sure, the particular element seems to the reader to be an inevitable aspect to the story. Indeed, the writer went to great lengths to make it seem that way. Also, even if particular elements, taken one-at-a-time (say, a character or an event) are actually scenes-a-faire, the entire set of elements should often be protectable as a whole—indeed, protection for a particular selection and arrangements of elements is bedrock copyright law. The formal rubric is known as a "compilation." See 17 U.S.C. § 101 (1994).

188. See, e.g., *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903) (Holmes, J.).

of him. Otherwise, he credits the copyright plaintiff with more originality and hence a greater scope of protection than he deserves.

Finally, though an educated yet hurried ordinary observer, such as a federal trial judge, might be specifically unaware of or at least unable to recall the contents of particular texts that may bear on the originality of the work-in-suit, she is no doubt aware of the enormous stock of literary precedent. She is also no doubt aware that the more abstractly defined a particular literary element (character, plot, etc.) is the more likely it is that there exists a literary antecedent for it. Perhaps it is this awareness that is responsible, more than anything else, for the very narrow level of protection given to literary works. Along with the obverse impression that a new work of fiction that does not embody elements copied verbatim from the original does not therefore involve enough free-riding on the original author's efforts to justify infringement, this awareness is largely responsible for the extraordinarily strict infringement standard already applied to judge infringement of literary works.

With respect to fiction works, as we have seen, separating protectable from unprotectable expression (or determining the scope of a copyright) is far too difficult, which is why, for instance, courts seldom bother. Second, as we have also seen from the *Driving Miss Daisy* example, very little of any literary work is original and therefore protectable.

There is a virtually inexhaustible supply of other examples to show that even great works of fiction comprise a thin veneer applied over a solid layer of literary precedent. One leading copyright scholar commented that the contemporary play, *West Side Story*, would infringe Shakespeare's *Romeo and Juliet*.¹⁸⁹ Yet *Romeo and Juliet* would more than likely have infringed Ovid's story of Pyramus and Thisbe, which in fact inspired Shakespeare's play.

Hence, the majority of any work of fiction is comprised largely of unprotectable material.¹⁹⁰ Therefore, one might suspect from this fact alone an ambiguous relationship between the protectable elements of a text and those elements responsible for its aesthetic appeal.

189. MELVILLE NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT*, § 13.03[A], at 13-33 (1997).

190. Also, the protectable elements are undoubtedly defined by the medium in which they appear. For instance, in copyright infringement cases involving photographs, the dispute is never focused upon the subject but rather upon things like the "photographer's selection of background, lights, shading, positioning and timing." *Gentieu v. John Muller & Co.*, 712 F. Supp. 740, 742 (W.D. Mo. 1989) (citing *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884)). See also, e.g., *Time, Inc. v. Bernard Geis Assoc.*, 293 F. Supp. 130, 143 (S.D.N.Y. 1968).

Next, what is aesthetic appeal? I was unable to find a suitable definition, just a lot of synonyms: its essence, its spirit, the author's thematic intention. For present purposes, I am content to say that clearly there is such a thing as "aesthetic appeal"—though not defined—because writers, filmmakers, critics, and quite obviously judges, refer to it all the time. Again, I shall refer to it, tautologically I suppose, as the corpus of the work's elements to which the ordinary observer responds.

But is it protectable by copyright? Sometimes, clearly yes. For instance, Edgar Rice Burroughs' noble savage character, Tarzan, is protectable¹⁹¹ as is Dashiell Hammett's Sam Spade,¹⁹² Faulkner's mythical world and setting for several of his novels, and A.S. Byatt's complex plot structures found in her novels, such as *Possession* and *Tower of Babel*. Even narrative style may be protectable as in the spectacular and hauntingly evocative *The Alchemist's Journal* by Evan Connel in which the story is told by extracts from the fictional journals of seven sixteenth-century alchemists. Similarly, the literary style of the renown children's author, Dr. Seuss—comprised of whimsical, jittery, staccato rhyme—is protectable.¹⁹³ Indeed, even theme, if original and sufficiently developed, may be protectable, such as that expressed in Ayn Rand's *The Fountainhead* and *Atlas Shrugged*.

Despite these examples, I am tempted to say that more often than not, those elements that comprise a work's essence are not protected by copyright. I will resist that urge, however, and instead just say this: based on my own research, far beyond the examples I just recited, there appears to be no correlation between a work's essence and protectability. Put another way, the features of a work that comprise its aesthetic appeal appear poorly correlated with its protectable elements. Toward the "essence" of a work of fiction, copyright law is apparently quite indifferent.

An empirical corroboration of this claim is beyond the scope of this Article. Instead, I shall provide anecdotal evidence sufficient in scope to hopefully persuade the reader. An example: audiences are attracted to some movies due solely to the sheer scale of the special effects: *Jurassic*

191. *Burroughs v. Metro-Goldwyn-Mayer, Inc.*, 491 F. Supp. 1320 (S.D.N.Y. 1980), *aff'd mem.*, 636 F.2d 1200 (2d Cir. 1980); *Burroughs v. Metro-Goldwyn-Mayer*, 519 F. Supp. 388 (S.D.N.Y. 1981), *aff'd*, 683 F.2d 610 (2d Cir. 1982).

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

193. *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 924 F. Supp. 1559, 1564 (S.D. Cal. 1996). In my opinion, this case establishes the frontier for protection of abstract literary elements. I am unable to identify another case like it: "[D]r. Seuss's choice as to stanza type (tercet), rhyme (masculine perfect), assonance, and accent are all protectable and all appropriated." *Id.*

Park, for instance. How many saw it for the ethical dilemma posed? How many would have seen it if it were animated? I concede, however, that not all special effect masterpieces derived their appeal from that source alone; *Gone with the Wind*, *Jaws*, and *E.T.* all had more going for them than flammable cities, mechanical fish, and cuddly extraterrestrials.

Other films rely largely on their "concept," or basic premise to create appeal. Movies of this type are known in Hollywood as "high concept" pictures. Examples: *Waterworld* (life after the polar ice caps melt caused by global warming), *Big* (a child's soul in a grownup's body), and *Back to the Future* (traveling back in time to redo things to turn out the way you wish they had happened in the first place). Naturally, none of these concepts is protectable or even close. Yet they are the undeniable source of the films' appeal and their economic value.

In other films the essential appeal may reside in the basic premise or the original idea (which are almost always too abstract to qualify as protectable expression even if they were original). For instance, consider these cases, all involving critically acclaimed and financially successful feature-length films: *Defending Your Life* (redemption through overcoming fear demonstrated through one ordinary person's "sham" trial and judgment in the afterlife); *Groundhog Day* (a man is forced to repeat the same day, though the others around him are oblivious to the repetition. He first seeks to take advantage of this otherwise unfortunate situation through repeated attempts at seducing his neighbor, then becomes frustrated and suicidal); *Driving Miss Daisy* (an African-American servant is employed by a Jewish master, and the formal relationship dissolves, along with long-held racial beliefs as the two become devoted friends), and so on. Incidentally, each of these movies was the focus of separate lawsuits brought by a novelist who claimed the movie infringed his novel. In each of these instances, I recited what I believed to be the source of the novel's aesthetic appeal. And in each instance, the filmmaker copied exactly what I recited but did not infringe the novelist's work.¹⁹⁴

Sometimes the elements that comprise a work's aesthetic appeal may simply be unidentifiable. That is, the work is not so easily dissected, which means that the work's essence may arise from a delicate fusion of a plurality of elements, some protectable, some not. What then? Consider this musing by one noted literary critic who was struggling to identify what features of a Chekhov short story gave it its appeal or essence:

194. In fact, each of these cases was decided on summary judgment for the defendant.

[B]ut there is also something else—every sensitive reader feels this—there is the writer's spirit And it is Chekhov's spirit . . . that makes this story so lovely. We can point to it, but hardly do more Is the "spirit" of a work of art no more than the sum of its technical elements?¹⁹⁵

Upon reflection, the incongruence between aesthetic appeal and copyright protection should not seem counter-intuitive. First, protectability is a function of originality. How is originality related to aesthetic appeal? (I am using the term "originality" in the everyday sense, not the formal copyright law sense, though the two meanings are essentially interchangeable for present purposes). Again, one could, I am sure, empirically demonstrate that the vast bulk of most fiction works is comprised of expression in the public domain, which is another way of saying that most works are comprised of very little protectable expression. As I have said, this alone suggests a tenuous relationship between originality and a work's aesthetic appeal. Paradoxically though, perhaps an inverse relationship exists between the two.

For instance, few movies intended for mass audiences contain any original expression beyond their literal components, and yet many think they are quite entertaining—the sources of the audience satisfaction are shamelessly and perpetually reworked personae, themes, and plot structures. The same can be said for contemporary novels of the legal-thriller genre. Indeed, the appeal quite often lies in the familiar, which suggests that if aesthetic appeal does not inversely correlate with originality, then at least "commercial appeal" certainly might. In fact, I do not see anything unusual about the notion that an audience's (or an ordinary observer's) perception might be drawn to the familiar. What a person likes, he wants to see again, as evidenced by the fact that some of the best-selling books are sequels in which each subsequent novel presents the same lead character transposed in a new setting. Many novels of the "detective genre" fit this description. What follows from this? The aspect of the work that the ordinary observer may fixate upon is quite likely to be unprotectable. And of course, that result does not translate into an infringement verdict because the ordinary observer test is supposed to account for it by filtering out unprotectable expression.

195. IRVING HOWE, *A CRITIC'S NOTEBOOK* 135-36 (1995).

C. Can Those Elements That Comprise a Work's Essence Be Protected Against Copying?

Even in those rare instances in which a work's essence does qualify for copyright protection, can the copyright owner protect that essence against borrowing by others? The answer is obviously yes if we assume that copying protectable expression always leads to an infringement verdict. Yet, as we shall see, rather than being a premise, this must be the conclusion that we test.

In the previous section I argued that the elements of a fiction work that comprise its aesthetic appeal are very often unprotectable. Thus, even a work with the same aesthetic appeal as a prior work may not infringe; the ordinary observer does not base its conclusion of substantial similarity upon unprotectable elements (or at least it is not supposed to anyway). What I discuss in this section is that the opposite scenario is likely to occur as well: the subsequent work borrows the elements responsible for the aesthetic appeal from the prior work, but the ordinary observer fails to recognize them once transplanted in the second work.

In some instances (like the ones that I recited earlier, such as *The Tower of Babel* and *The Maltese Falcon*), if the essence of another's work is extracted and incorporated into a subsequent work recast in another form, such as a novel set in modern times or a feature-length film intended for mass-appeal, that essence would surely survive those distortions, and no court would hesitate to call the new work—whether itself highly original or not—an infringement.

Indeed, courts from time to time try to identify a work's essence as the thing that copyright law should protect. This is not the majority view but a pervasive one nonetheless. Consider the case involving the copyrightability of Dashiell Hammett's famous detective character, "Sam Spade." The Ninth Circuit in dictum commented upon whether a literary character, apart from all other literary elements comprising the work, is protectable alone: "[I]f the character is only the chessman in the game of telling the story he is not within the area of the protection afforded by the copyright [unless the character really constitutes the story being told]."¹⁹⁶ It is inconceivable that the court, by acknowledging this, would be willing to sanction the theft of one of the fundamental components of an artist's intellectual property. The court, it seems, has conditioned copyright protection on how important a particular literary element is to the work as a whole or whether it is a "fundamental

196. *Warner Bros. Pictures*, 216 F.2d at 950.

component" of the author's work. Similarly, Justice Traynor made these remarks about protectability: "[I]n those matters as to which copyright protects—that is, the spirit or soul infusing the creatures of the author's imagination" ¹⁹⁷ And in cases involving a technical document: "Whatever similarities or differences there are in the report generally, the critical parts of the reports—the antenna design—are identical. Taking what is in essence the heart of the work is considered a taking of a substantial nature, even if what is actually taken is less than extensive." ¹⁹⁸

Because originality is the sine qua non of copyright protection, the view expressed above has some rational force: what the author himself created is the essence of the work. Hammett's Sam Spade is by consensus the heart of *The Maltese Falcon*—its essence, the source of its aesthetic appeal; Dashiell Hammett created an original persona embodied in Sam Spade. In that case a near perfect correlation exists between commercial value, protectability, and the essence of the work. Hence, the court had no trouble recognizing it.

Other times, an infringer may borrow the copyrightable essence of another's work, or at least a substantial part of it anyway, with impunity. For instance, a subsequent work that retains the essential aspect of the original but that differs from it at a lower level of abstraction (such as the prose), may often have a different aesthetic appeal than the original. Consider this example: the overwhelming majority of any novel is unprotectable because it consists of ideas, scenes-a-faire, merged expression, historical fact, and other material in the public domain and not least of all because the infringement standard used to judge whether a movie infringes a novel is, for one reason or another, unusually favorable to the accused filmmaker. Bedrock copyright law principles unambiguously support the conclusion that copyright protection stops well short of protecting a "story line" or basic plot structure, which again, appears to be the transplantable element of a novel. ¹⁹⁹

197. *Frankel v. Irwin*, 34 F.2d 142, 144 (S.D.N.Y. 1952).

198. *WPOW, Inc. v. MRLJ*, 584 F. Supp 132, 136 (D.D.C. 1984) (citing *Elsmere Music, Inc. v. NBC*, 482 F. Supp. 741, 744 (S.D.N.Y. 1980), *aff'd*, 623 F.2d 252 (2d Cir. 1980)).

199. *See, e.g., Reyher v. Children's Television Workshop*, 533 F.2d 87, 91 (2d Cir. 1976) ("[T]he essence of infringement lies in taking not a general theme but its particular expression through similarities of treatment, details, scenes, events and characterization.") *See also, e.g., Denker*, 820 F. Supp. at 732.

D. Conclusion

To conclude this section, the relationship between aesthetic appeal and copyrightability is approximately random—the two are uncorrelated. Also, even when the essence of a work is copyrightable (original, sufficiently concrete) a subsequent author may still copy that essence, or those elements that create the work's aesthetic appeal, provided it is no longer recognizable by the ordinary observer in the subsequent work judged as a whole—a scenario that recurs frequently, particularly in the case of derivative works prepared in media different than the original work.

VIII. COPYRIGHT IS TAXONOMICALLY SIMILAR TO MISAPPROPRIATION.

One primary conclusion derived from the thesis advanced in this Article is that copyright law is much more closely related to the common law tort of misappropriation than it is to a pure property regime like patent law. The four primary indicia of misappropriation are: (1) the plaintiff has created a thing having substantial commercial value; (2) it fixates on the method of copying rather than on the thing being copied; (3) the defendant acquired or created the thing at a substantially lower cost than that incurred by the plaintiff; and (4) the plaintiff must have suffered some harm caused by the defendant's conduct.²⁰⁰ Conspicuously absent, of course, is a step requiring definition of the property right upon which the misappropriation plaintiff alleges the defendant intruded.

Misappropriation, therefore, provides a remedy for more than just direct competitive injury though less than any unauthorized intrusion against the thing created by the plaintiff. Instead, it protects an actual and putative market position that plaintiff has acquired by virtue of considerable expense, which plaintiff alone has borne, against "unfair" and "harmful" commercial activity.²⁰¹

Precisely what right is the misappropriation plaintiff claiming? How is it related to the thing created (the text)? Consider the plaintiff in *INS v. AP*. Would AP have objected if INS had independently prepared its own news stories (without copying from AP's) even though the two are, in the end, highly similar? Or would AP have objected if INS had copied the news stories from AP but instead of selling a competing newspaper

200. J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 10:51, at 10-95 (1996). See also *INS v. AP*, 248 U.S. 215 (1918).

201. See, e.g., *Metropolitan Opera Ass'n v. Wagner-Nichols Recorder Corp.*, 101 N.Y.S.2d 483 (Supp. Ct. 1950), *aff'd*, 279 App. Div. 632 (N.Y.A.D. 1951).

had used them to prepare a bi-monthly news magazine? I suspect that the answer to both questions is no and that even if AP had objected, the court may not have condemned the misappropriation. Similarly, an independently created work does not infringe a copyright; nor does an appropriation of a copyrighted work—no matter how much protectable expression it borrows from the first work—if it does not appear to the casual observer that it was derived from the former work.

Next, how closely related, if at all, are copyright and misappropriation? Imagine a spectrum of enforceable rights in intangible property; at one end is unfair competition, of which “palming off” is a suitable exemplar, and at the other a “pure” property right scheme, such as patent law. Somewhere in between these two is *INS v. AP*-type misappropriation; near this are trade-secret law and trademark law. The question is where copyright law is located along this continuum. Patent law represents a property right enforceable against the entire public; it is a set of absolute prohibitions against exercising any of the exclusive rights granted to the patent owner. The specifics of the defendant’s conduct (other than that he made/used/sold/offered for sale/imported the accused device) is irrelevant; whether he is a free-rider is also irrelevant. The nature of the accused method or device, beyond the fact that it infringes, is likewise irrelevant to liability. In other words, the focus is not on the method of creating the thing but upon the thing itself.

More similar to the tort of misappropriation and less similar to patent law, copyright infringement proceeds without a definition of the protectable portion of the text, a determination that, as was shown earlier, is quite often intractable. So too, copyrights are not readily asserted against third parties without regard to the nature of the latter’s use of the material. By “use” I mean how the material is incorporated into the defendant’s new work, what is the nature of the defendant’s final product, and how it impairs the market for the plaintiff’s creation. In that sense a copyright is at best a highly conditional property right in the thing copied; *Miller* and *Toksvig* prove that much. But more probably, *Miller* strongly suggests that whatever legal entitlement copyright confers, it cannot possibly confer a property right in a “text.” And as argued in previous sections, the legal right conferred by copyright looks far more like a property right in a narrowly defined market position.

Second, the only possible justification for immunizing an accused infringer who did not copy from the plaintiff’s work but independently created his own is that the absence of copying is a reliable proxy (along with evidence of consumer confusion supplied by the ordinary observer) for the lack of any real economic harm. Indeed, the harm is caused by

(1) pricing below the first author's marginal cost (made possible by the accused infringer's lower cost of expression to recoup, resulting from copying from the plaintiff's work rather than creating it entirely himself) and (2) selling the copies in the first author's market.

Therefore, copyright infringement appears to be much more closely related to common law misappropriation than to the other federal intellectual property regime, patent law. More generally, "copyright infringement" is more like a commercial tort than an intrusion upon a formal property right.