

# Ideas Not Copyrightable

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## Keywords

copyright, copyrights, copyrightable, copyrightability, expression, idea, ideas, idea-expression dichotomy, idea-expression merger

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## Introduction

It is a well-accepted rule that copyrights in the USA do *not* protect ideas that are contained in the copyrighted work. Copyright only protects the expression of ideas. Although the rule is well established — enshrined in statute and stated in opinions of the U.S. Supreme Court — the reasons for the rule have received little attention. This essay traces the history of the evolution of this rule of law and explains its justification.

A big problem is that neither judges nor statute define *idea*, a problem that I discuss below, beginning at page 34. In science or engineering, we normally begin with a definition. In contrast, lawyers and judges sometimes use words to mean something different from the ordinary use of those words, but they do *not* define their usage.

This essay presents general information about an interesting topic in law, but is *not* legal advice for your specific problem. See my disclaimer at <http://www.rbs2.com/disclaim.htm> .

I list the cases in chronological order in this essay, so the reader can easily follow the historical development of a national phenomenon. If I were writing a legal brief, then I would use the conventional citation order given in the *Bluebook*. Because part of the audience for this essay is nonlawyers, I have included longer quotations from court cases than typical writing for attorneys.

## Ideas “Free As Air” ?

As shown below, at pages 6-32, judges have been amazingly unwilling or unable to explain *why* copyright does not protect ideas. What one can find is occasional rhetoric about ideas being “free as air”. Such a statement first appears in a judicial opinion in an intellectual property case in a dissent by Justice Brandeis:

But the fact that a product of the mind has cost its producer money and labor, and has a value for which others are willing to pay, is not sufficient to ensure to it this legal attribute of property. The general rule of law is, that the noblest of human productions — knowledge, truths ascertained, conceptions, and **ideas** — become, after voluntary communication to others, **free as the air**<sup>1</sup> to common use. Upon these incorporeal productions the attribute of property is continued after such communication only in certain classes of cases where public policy has seemed to demand it. These exceptions are confined to productions which, in some degree, involve creation, invention, or discovery. But by no means all such are endowed with this attribute of property. The creations which are recognized as property by the common law are literary, dramatic, musical, and other artistic creations; and these have also protection under the copyright statutes. The inventions and discoveries upon which this attribute of property is conferred only by statute, are the few comprised within the patent law.

....

*International News Service v. Associated Press*, 248 U.S. 215, 250 (1918) (Brandeis, J., dissenting). Quoted with approval in *Washingtonian Pub. Co. v. Pearson*, 306 U.S. 30, 55 (1939) (Black, J., dissenting); *Goldstein v. California*, 412 U.S. 546, 570 (1973) (majority opinion) (“But there is no fixed, immutable line to tell us which ‘human productions’ are private property and which are so general as to become ‘free as the air.’ ”).

In 1912, Fendler sued Morosco in state court,<sup>2</sup> claiming that Morosco’s copyrighted play was copied from an unpublished play by Fendler. Fendler won a preliminary injunction against Morosco. Morosco appealed to the highest court in New York State, which vacated the injunction and dismissed the case. In 1930, the highest state court in New York State wrote:

There may be literary property in a particular combination of ideas or in the form in which ideas are embodied. There can be none in the ideas. “Ideas, it has always been admitted, even by the Stationers’ Company,<sup>3</sup> are free as air. If you happen to have any, you fling them into the common stock, and ought to be well content to see your poorer brethren thriving upon them.” COPYRIGHT IN BOOKS by Augustine Birrell, page 167.

*Fendler v. Morosco*, 171 N.E. 56, 58 (N.Y. 1930).

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<sup>1</sup> Boldface added by Standler.

<sup>2</sup> Before the Copyright Act of 1976, unpublished manuscripts were protected under state common-law copyright.

<sup>3</sup> The reference is to a guild of printers, publishers, and booksellers in England during the years 1557 to 1710.

From 1872 until 1947, the California Civil Code § 980 specifically included protection for “any product of the mind”, which effectively allowed a state copyright on both ideas and expression in unpublished works. In 1953, the California Supreme Court wrote:

In the *Stanley [ v. Columbia Broadcasting System*, 221 P.2d 73 (Cal. 1950)] and *Golding [ v. R.K.O. Pictures*, 221 P.2d 95 (Cal. 1950)] cases, protection was extended to an ‘idea’ rather than to the form and manner of its expression. The judgment in favor of Stanley was affirmed upon the ground that his idea was the new and novel combination of elements for a radio program. 35 Cal.2d at page 664, 221 P.2d 73. In the *Golding* case the court, relying upon the former wording of section 980, held that the ‘product of the writer's creative mind’, 35 Cal.2d at page 695, 221 P.2d at page 97, is protectible and it extended that protection to his idea, ‘the basic dramatic core’, 35 Cal.2d at page 697, 221 P.2d at page 99, of his play. Such extension of protection to an idea transcends the normal bounds of common law copyright, *Moore v. Ford Motor Co.*, D.C., 28 F.2d 529, 536, *affirmed*, 2 Cir., 43 F.2d 685; Amdur, COPYRIGHT LAW AND PRACTICE 50, § 11; Note, 23 A.L.R.2d 244, 249, in which ideas ‘are free as air’. *Fendler v. Morosco*, 253 N.Y. 281, 287, 171 N.E. 56.

*Weitzenkorn v. Lesser*, 256 P.2d 947, 955 (Cal. 1953). In 1947, the California legislature amended the state copyright statute to delete protection for ideas. From 1947 until federal preemption in 1978, the California statute only protected expression. See also *Desny v. Wilder*, 299 P.2d 257, 265 (Cal. 1956) (“Generally speaking, ideas are as free as the air and as speech and the senses, and as potent or weak, interesting or drab, as the experiences, philosophies, vocabularies, and other variables of speaker and listener may combine to produce, to portray, or to comprehend. But there can be circumstances when neither air nor ideas may be acquired without cost.”).

The opinion of a federal trial court in California in 1953 tersely says:

Plaintiff's attorney conceded in oral argument that it was impossible at the present time in California to attain a property right or a priority for ideas. Ideas are free to the world, and one person's idea can be appropriated by another with impunity. ....

*Taylor v. Metro-Goldwyn-Mayer Studios*, 115 F.Supp. 156, 157 (S.D.Cal. 1953).

Quoted with approval in *Wright v. Warner Books, Inc.*, 953 F.2d 731, 742 (2dCir. 1991) (Van Graafeiland, J., concurring); *Stromback v. New Line Cinema*, 384 F.3d 283, 296 (6thCir. 2004).

In 1991, a judge on a U.S. Court of Appeals in New York City wrote a concurring opinion:

However, this [copyright] interest did not include the author's ideas, which were said to be “free as air”, *Lewys v. O'Neill*, 49 F.2d 603, 607 (S.D.N.Y. 1931), or “free to the world”, *Taylor v. Metro-Goldwyn-Mayer Studios*, 115 F.Supp. 156, 157 (S.D.Cal. 1953); nor did it encompass incorporated facts or real occurrences, which were held to be in the public domain,

....

*Wright v. Warner Books, Inc.*, 953 F.2d 731, 742 (2dCir. 1991) (Van Graafeiland, J., concurring).

In 1997, a U.S. Court of Appeals in Maryland wrote:

Nimmer and Nimmer, *supra*, at § 16.01 (stating that “[t]he concept that ideas are ‘free as air’ is of ancient origin, and is well rooted in our jurisprudence” (footnotes omitted)). It is not that this form of intellectual property ceases to be property, rather it is just not intangible personalty. See, e.g., *Richter v. Westab, Inc.*, 529 F.2d 896, 902 (6th Cir. 1976) (“The law does not favor the protection of abstract ideas as the property of the originator.”).

*U.S. ex rel. Berge v. Board of Trustees of the University of Alabama*, 104 F.3d 1453, 1465 (4th Cir. 1997), *cert. den.*, 522 U.S. 916 (1997).

Not only is the statement “ideas are free as air” a conclusion — not a reason — but also the statement is philosophical, *not* a statement of law. Indeed, for more than two hundred years, one can obtain a U.S. Patent giving the patent owner the right to exclude others from using the patented idea, which is one clear example of where ideas are *not* free to use. Ideas are also *not* free to scientists or mathematicians, who may labor for many thousands of hours to create and develop a novel idea, so that the idea can be expressed in a publication that advances the Progress of knowledge. As I argue later in this essay, beginning at page 75, ideas are valuable to modern society and the law should financially reward those who create novel ideas.

I suggest that the philosophy that “ideas are free as air” was implicitly in judges’ minds when they excluded ideas from copyright protection. I discuss First Amendment concerns, which arose later in copyright history, beginning at page 38, below.

### **History of Ideas Not Protected**

Writing in 1951, Judge Yankwich traced the origins of the American legal rule that copyright does not protect ideas back to a decision in England in the year 1769:

The property in the copy, thus abridged, is equally an incorporeal right to print a set of intellectual ideas or modes of thinking, communicated in a set of words and sentences and mode of expression. It is equally detached from the manuscript, or any other physical existence whatsoever.

*Millar v. Taylor*, 4 Burr. 2303, 2396, 98 Eng.Reports 201, 251 (1769) (Mansfield, J.).

Quoted in Leon R. Yankwich, “Originality in the Law of Intellectual Property,” 11 F.R.D. 457, 458-459 (1952).

#### **A. U.S. Courts before 1909**

*Story’s Executors v. Holcombe*

I have attempted to trace the origins of the American legal rule that copyright does *not* protect *ideas*, by searching the Westlaw databases for federal courts for the query copyright! /s idea. The earliest case I have found said:

It is said there can be no copyright in a plan, distinct from the work itself, any more than there can be a copyright in an idea. This is admitted: but the words in which an idea is expressed, is a subject of property; and so is the classification of the subject discussed.

*Story's Executors v. Holcombe*, 23 F.Cas. 171, 175 (C.C.Ohio 1847).

Despite the words, "it is said", no citation is provided for who said it.

#### publication puts ideas in public domain

Two cases in the 1850s held that an author abandons any property claim in his ideas by publication. *Stowe v. Thomas*, 23 F.Cas. 201, 206 (C.C.Pa. 1853); *Greene v. Bishop*, 10 F.Cas. 1128, 1133-1134 (C.C.Mass. 1858). The rule that publication puts ideas into the public domain is an obvious consequence of the rule that copyright does *not* protect ideas.

#### *Baker v. Selden*

Selden developed a system for organizing bookkeeping data, and he had published blank forms (i.e., a ledger) to be filled in by a bookkeeper. In 1879, the U.S. Supreme Court declared that Selden's work was not copyrightable, for two reasons: (1) blank forms are not copyrightable<sup>4</sup> and (2) use of *ideas* (e.g., a system of bookkeeping) are not protected by copyright.<sup>5</sup> The Court's opinion is poorly written and, as explained below, has conflicting interpretations by experts in copyright law.

The Court tersely noted that ideas (i.e., "truths of a science") are not copyrightable, because such ideas belong to everyone:

Where the truths of a science or the methods of an art are the common property of the whole world, any author has the right to express the one, or explain and use the other, in his own way.

*Baker v. Selden*, 101 U.S. 99, 100-101 (1879).

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<sup>4</sup> *Bibbero Systems v. Colwell Systems*, 893 F.2d 1104 (9thCir. 1990) (blank form not copyrightable). This rule continues today in 37 C.F.R. § 202.1(c) (effective 1959, current Mar 2009) (blank forms are "not subject to copyright", because they "do not in themselves convey information."). By using the word *information* instead of *expression*, the Copyright Office ironically denies copyright to the forms because they are blank, but if the forms were full of handwritten facts, courts would deny copyright, because facts can not be copyrighted.

<sup>5</sup> *Baker v. Selden*, 101 U.S. 99, 107 (1879) ("The conclusion to which we have come is, that blank account-books are not the subject of copyright; and that the mere copyright of Selden's book did not confer upon him the exclusive right to make and use account-books, ....").

The rambling, poorly written opinion digresses from bookkeeping and the two books at issue in this case, and makes analogies to medicine, to the subject of perspective in art, and to mathematics:

.... A treatise on the composition and use of medicines, be they old or new; on the construction and use of ploughs, or watches, or churns; or on the mixture and application of colors for painting or dyeing; or on the mode of drawing lines to produce the effect of perspective, would be the subject of copyright; but no one would contend that the copyright of the treatise would give the exclusive right to the art or manufacture described therein.<sup>6</sup> ....

The difference between the two things, letters-patent and copyright, may be illustrated by reference to the subjects just enumerated. Take the case of medicines. Certain mixtures are found to be of great value in the healing art. If the discoverer writes and publishes a book on the subject (as regular physicians generally do), he gains no exclusive right to the manufacture and sale of the medicine; he gives that to the public.<sup>7</sup> If he desires to acquire such exclusive right, he must obtain a patent for the mixture as a new art, manufacture, or composition of matter. He may copyright his book, if he pleases; but that only secures to him the exclusive right of printing and publishing his book. So of all other inventions or discoveries.

The copyright of a book on perspective, no matter how many drawings and illustrations it may contain, gives no exclusive right to the modes of drawing described, though they may never have been known or used before. By publishing the book, without getting a patent for the art, the latter is given to the public.<sup>8</sup> The fact that the art described in the book by illustrations of lines and figures which are reproduced in practice in the application of the art, makes no difference. Those illustrations are the mere language employed by the author to convey his **ideas**<sup>9</sup> more clearly. Had he used words of description instead of diagrams (which merely stand in the place of words), there could not be the slightest doubt that others, applying the art to practical use, might lawfully draw the lines and diagrams which were in the author's mind, and which he thus described by words in his book.

The copyright of a work on mathematical science cannot give to the author an exclusive right to the methods of operation which he propounds, or to the diagrams which he employs to explain them, so as to prevent an engineer from using them whenever occasion requires. The very object of publishing a book on science or the useful arts is to communicate to the

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<sup>6</sup> There is a legal difference between (1) preventing *copying* of the expression of an idea and (2) asserting the exclusive right to *use* an idea. It is not clear to me that this analogy about medicine, or the following analogies, are relevant to the copyright case before the Court.

<sup>7</sup> This is a statement of the legal rule that publication of ideas puts those ideas into the public domain.

<sup>8</sup> This is another statement of the legal rule that publication of ideas puts those ideas into the public domain.

<sup>9</sup> Boldface added by Standler. This is one of two occurrences of the word *ideas* in this opinion. I suggest that the analogies to medicine, to “drawings and illustrations” in art, and (in the next paragraph) to the use of mathematical science are all to *ideas*. But the opinion is so poorly written that I am not certain of its meaning.



world the useful knowledge which it contains.<sup>10</sup> But this object would be frustrated if the knowledge could not be used without incurring the guilt of piracy of the book. And where the art it teaches cannot be used without employing the methods and diagrams used to illustrate the book, or such as are similar to them, such methods and diagrams are to be considered as necessary incidents to the art, and given therewith to the public;<sup>11</sup> not given for the purpose of publication in other works explanatory of the art, but for the purpose of practical application.

Of course, these observations are not intended to apply to ornamental designs, or pictorial illustrations addressed to the taste. Of these it may be said, that their form is their essence, and their object, the production of pleasure in their contemplation. This is their final end. They are as much the product of genius and the result of composition, as are the lines of the poet or the historian's period. On the other hand, the teachings of science and the rules and methods of useful art have their final end in application and use; and this application and use are what the public derive from the publication of a book which teaches them.<sup>12</sup> But as embodied and taught in a literary composition or book, their essence consists only in their statement.<sup>13</sup> This alone is what is secured by the copyright. The use by another of the same methods of statement, whether in words or illustrations, in a book published for teaching the art, would undoubtedly be an infringement of the copyright.

*Baker v. Selden*, 101 U.S. 99, 102-104 (1879).

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<sup>10</sup> Justice Bradley, who wrote this opinion, *assumes* this is the object of publishing a book. He cites no authority for this conclusion. It is obvious that the object of publishing a book is to make a profit for the commercial publisher, who is engaged in a for-profit enterprise. The author of a book ought to share in this financial reward.

<sup>11</sup> The phrase “necessary incidents” may be an early statement of the merger doctrine, which is discussed below, beginning at page 42.

<sup>12</sup> Again, the Court gives the legal rule that publication of ideas puts those ideas into the public domain.

<sup>13</sup> The Court’s use of *statement* is what copyright law now calls *expression*. Regardless of what it is called, the Court’s next sentence says it is protected by copyright.

The conventional view — expressed in some judicial opinions,<sup>14</sup> the venerable treatise *NIMMER ON COPYRIGHT*,<sup>15</sup> and also in some leading copyright textbooks<sup>16</sup> — is that *Baker v. Selden* is the seminal case on the idea-expression dichotomy. However, a careful reading<sup>17</sup> of the opinion in *Baker v. Selden* shows that the Court is principally concerned with the difference between (1) the exclusive right to control the *use* of a *system* or *method*, which right is only granted by a patent, and (2) the right to prohibit verbatim copying of explanation or description in a book, which is protectable by copyright. Despite the fact that the opinion in *Baker v. Selden* is principally concerned with the difference between patents and copyrights, this opinion is also consistent with the idea-expression dichotomy.<sup>18</sup>

*Simms v. Stanton*

In 1896, a case in a Federal Circuit Court (i.e., trial court) in California said in a case involving alleged copyright infringement of a book on physiognomy:

Another familiar doctrine of the law of copyright is that an author may resort with full liberty to the common sources of information, and make use of the common materials open to all. But his work must be the result of his own independent labor. Drone, *COPYR.* pp. 416, 417, and cases there cited. A copyright gives no exclusive property in the ideas of an author. These are public property, and any one may use them as such. *Perris v. Hexamer*, 99 U.S. 674; *Baker v. Selden*, 101 U.S. 99. In the last case the court say:

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<sup>14</sup> See, e.g., *Anti-Monopoly, Inc. v. General Mills Fun Group*, 611 F.2d 296, 300, n.1 (9thCir. 1979); *Toro Co. v. R & R Products Co.*, 787 F.2d 1208, 1212 (8thCir. 1986); *Whelan Associates, Inc. v. Jaslow Dental Laboratory, Inc.*, 797 F.2d 1222, 1234 (3dCir. 1986); *Cable/Home Communication Corp. v. Network Productions, Inc.*, 902 F.2d 829, 842 (11thCir. 1990); *Digital Communications Associates, Inc. v. Softklone Distributing Corp.*, 659 F.Supp. 449, 457 (N.D.Ga. 1987).

<sup>15</sup> *NIMMER ON COPYRIGHT* § 2.18 [B] to [E].

<sup>16</sup> See, e.g., Alan Latman, Robert A. Gorman, Jane C. Ginsburg, *COPYRIGHT FOR THE NINETIES*, at pp. 89-94 (3d ed. 1989); Craig Joyce, William Patry, Marshall Leaffer, Peter Jaszi, *COPYRIGHT LAW* at pp. 92-98 (3d ed. 1994).

<sup>17</sup> Edward Samuels, “The Idea-Expression Dichotomy in Copyright Law,” 56 *TENNESSEE LAW REVIEW* 321, 326-334 (Winter 1989); Lloyd L. Weinreb, “Copyright for Functional Expression,” 111 *HARVARD LAW REVIEW* 1149, 1171-1180, especially at p. 1175 and 1179 (Mar 1998); Pamela Samuelson, “The Story of *Baker v. Selden*: Sharpening the Distinction Between Authorship and Invention,” pp. 159-193 of *INTELLECTUAL PROPERTY STORIES*, edited by Ginsburg & Dreyfuss (2006); Pamela Samuelson, “Why Copyright Law Excludes Systems and Processes from the Scope of Its Protection,” 85 *TEXAS LAW REVIEW* 1921, 1926-1936 (June 2007).

<sup>18</sup> Pamela Samuelson, “Why Copyright Law Excludes Systems and Processes from the Scope of Its Protection,” 85 *TEXAS LAW REVIEW* 1921, 1928, and n. 16 on p. 1925 (June 2007).

‘Where the truths of a science or the methods of an art are the common property of the whole world, any author has the right to express the one, or explain and use the other, in his own way.’

*Simms v. Stanton*, 75 F. 6, 10 (C.C.Cal. 1896).

Manifestly, the complainant has no monopoly in the subject of physiognomy. His copyrights did not protect the ideas or truths, if they may be termed such, peculiar to this art or science.

These were public property.

*Simms v. Stanton*, 75 F. 6, 11 (C.C.Cal. 1896).

#### *Holmes v. Hurst*

In 1899, the U.S. Supreme Court tersely noted that copyright protects expression, *not* ideas.

The right thus secured by the copyright act is not a right to the use of certain words, because they are the common property of the human race, and are as little susceptible of private appropriation as air or sunlight; nor is it the right to ideas alone, since in the absence of means of communicating them they are of value to no one but the author. But the right is to that arrangement of words which the author has selected to express his ideas, ....

*Holmes v. Hurst*, 174 U.S. 82, 86 (U.S. 1899).

These cases from the 1800s show that the legal rule forbidding copyright of ideas was already well established by the year 1900.

#### B. U.S. Courts between 1909 and 1976

##### *Kalem Co. v. Harper Bros.*

In 1911, the U.S. Supreme Court upheld an injunction prohibiting showing of a movie that infringed a copyright on the book, BEN HUR. In a terse final paragraph, Justice Holmes wrote for the unanimous Court:

It is suggested that to extend the copyright to a case like this is to extend it to the ideas, as distinguished from the words in which those ideas are clothed. But there is no attempt to make a monopoly of the ideas expressed. The law confines itself to a particular, cognate, and well-known form of reproduction. If to that extent a grant of monopoly is thought a proper way to secure the right to the writings, this court cannot say that Congress was wrong.

*Kalem Co. v. Harper Bros.*, 222 U.S. 55, 63 (U.S. 1911).

The Court indirectly said that ideas are not copyrightable.

*Eichel v. Marcin*

In 1913, a federal trial court in New York City heard a copyright case. This opinion was possibly the first to state the rule that *facts* are not copyrightable.<sup>19</sup> Note that the judge bundled facts and ideas together, as if they were the same thing:

The object of copyright is to promote science and the useful arts. If an author, by originating a new arrangement and form of expression of certain ideas or conceptions, could withdraw these ideas or conceptions from the stock of materials to be used by other authors, each copyright would narrow the field of thought open for development and exploitation, and science, poetry, narrative, and dramatic fiction and other branches of literature would be hindered by copyright, instead of being promoted. A poem consists of words, expressing conceptions of words or lines of thoughts; but copyright in the poem gives no monopoly in the separate words, or in the ideas, conception, or facts expressed or described by the words. A copyright extends only to the arrangement of the words. A copyright does not give a monopoly in any incident in a play. Other authors have a right to exploit the facts, experiences, field of thought, and general ideas, provided they do not substantially copy a concrete form, in which the circumstances and ideas have been developed, arranged, and put into shape. *Holmes v. Hurst*, 174 U.S. 82, 19 Sup.Ct. 606, 43 L.Ed. 904.

*Eichel v. Marcin*, 241 F. 404, 408-409 (S.D.N.Y. 1913).

This paragraph has been quoted with approval in *Becker v. Loew's, Inc.*, 133 F.2d 889, 891 (7thCir. 1943); *Tralins v. Kaiser Aluminum & Chemical Corp.*, 160 F.Supp. 511, 516 (D.Md. 1958).

*International News Service*

In 1918, Justice Brandeis at the U.S. Supreme Court wrote a dissenting opinion that mentioned that ideas were not copyrightable:

At common law, as under the copyright acts, the element in intellectual productions which secures such protection, is not the knowledge, truths, ideas, or emotions which the composition expresses, but the form or sequence in which they are expressed; that is, 'some new collocation of visible or audible points-of lines, colors, sounds, or words.' See *White-Smith Music Co. v. Apollo Co.*, 209 U. S. 1, 19, 28 Sup. Ct. 319, 52 L. Ed. 655, 14 Ann. Cas. 628; *Kalem Co. v. Harper Bros.*, 222 U. S. 55, 63, 32 Sup. Ct. 20, 56 L. Ed. 92, Ann. Cas. 1913A, 1285. An author's theories, suggestions, and speculations, or the systems, plans, methods, and arrangements of an originator, derive no such protection from the statutory copyright of the book in which they are set forth;[FN7] and they are likewise denied such protection at common law.[FN8]

FN7 *Baker v. Selden*, 101 U. S. 99, 25 L. Ed. 841; *Perris v. Hexamer*, 99 U. S. 674, 25 L. Ed. 308; *Barnes v. Miner* (C. C.) 122 Fed. 480, 491; *Burnell v. Chown* (C. C.) 69 Fed. 993; [and 4 cases in England].

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<sup>19</sup> Standler, Copyright Protection for Nonfiction or Compilations of Facts in the USA, <http://www.rbs2.com/cfact.pdf> , (22 Feb 2009).

FN8 *Bristol v. Equitable Life Assurance Society*, 132 N. Y. 264, 30 N. E. 506, 28 Am. St. Rep. 568; *Haskins v. Ryan*, 71 N. J. Eq. 575, 64 Atl. 436. *International News Service v. Associated Press*, 248 U.S. 215, 254-255 (1918) (Brandeis, J., dissenting).

Justice Brandeis missed that *INS* is **not** a copyright case. The work by Associated Press was not protected by copyright. Instead, the issue was *INS*'s misappropriation of AP's labor, i.e., an unfair competition case.

*Dymow v. Bolton*

In 1926, the U.S. Court of Appeals in New York City wrote:

One of the entities or things which every author tries to insert in his copyrighted work is a set of ideas; yet ideas as such are not protected. *Holmes v. Hurst*, 19 S.Ct. 606, 174 U.S. 82, 43 L.Ed. 904; *Kalem Co. v. Harper Bros.*, 32 S.Ct. 20, 222 U.S. 55, 56 L.Ed. 92, Ann. Cas. 1913A, 1285.

Just as a patent affords protection only to the means of reducing an inventive idea to practice, so the copyright law protects the means of expressing an idea; and it is as near the whole truth as generalization can usually reach that, if the same idea can be expressed in a plurality of totally different manners, a plurality of copyrights may result, and no infringement will exist.

*Dymow v. Bolton*, 11 F.2d 690, 691 (2dCir. 1926).

*Nutt v. National Institute, Inc.*

The U.S. Court of Appeals affirmed an injunction<sup>20</sup> prohibiting Nutt from delivering lectures similar to copyrighted lectures prepared by Renick, who had assigned his copyright to the National Institute for the Improvement of Memory. Renick took some ideas from earlier lectures by Roth, however Renick added new and original material.

A lecturer has the right to use the ideas expressed in another work, for a copyright does not monopolize the intellectual conception, but the form of expression and arrangement of words adopted by the copyright proprietor. *Holmes v. Hurst*, 174 U.S. 82, 19 S.Ct. 606, 43 L.Ed. 904. A comparison of the Roth course with that of [Renick] shows that the two works upon the same subject contain some thoughts and ideas in common. But it is not the subject that is protected by copyright. It is the treatment of a subject that is protected. *Stephens v. Howells Sales Co.* (D.C.) 16 F.(2d) 805; *Baker v. Selden*, 101 U.S. 99, 25 L.Ed. 841.

*Nutt v. National Institute Inc. for the Improvement of Memory*, 31 F.2d 236, 239 (2dCir. 1929).

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<sup>20</sup> *National Inst. for Imp. of Memory v. Nutt*, 28 F.2d 132 (D.Conn. 1928).

*Guthrie v. Curlett*

Guthrie wrote a copyrighted pamphlet in 1912 about a plan or idea for a freight tariff index. Later, Guthrie sued for copyright infringement and lost in the trial court. The Second Circuit affirmed:

This idea alone, apart from the means of expressing it, is not protected by his copyrights. *Holmes v. Hurst*, 174 U.S. 82, 19 S.Ct. 606, 43 L.Ed. 904; *Dymow v. Bolton* (C.C.A.) 11 F.(2d) 690; *Nutt v. National Institute, Inc.* (C.C.A.) 31 F.(2d) 236-239. ....

Indeed, it is by no means sure that the appellant contributed any new ideas, except in the particular arrangement and symbols he used. All else was in the public domain. The idea of consolidated freight tariff indexes had already been employed by the Erie and other railroads, and designating things by numerals or letters, alone or in combination, with or without the use of ruled columns and dark or light faced type, has been in common practice to very long there is no way now of making that, except in the precise way he does it, the private property of any man.

Careful comparison of the appellees' works with that of the appellant fails to disclose a single instance where the means of expression used by the appellant has been copied. The intricate nature of the work, the subject involved, and the result to be obtained, make it inevitable that, within the scope of the works, the same information can be found; but the appellant has no monopoly upon information, or the purveying of information by a broad general method. He must be protected in his choice of expression, and his copyrights held to that. *Baker v. Selden*, 101 U.S. 99, 25 L.Ed. 841.

*Guthrie v. Curlett*, 36 F.2d 694, 696 (2dCir. 1929).

*Nichols*

The author of a play, Anne Nichols, sued a motion picture studio for allegedly infringing her play. In 1930, Judge Learned Hand of the U.S. Court of Appeals in New York City affirmed the dismissal of Nichols' case:

It is of course essential to any protection of literary property, whether at common-law or under the statute, that the right cannot be limited literally to the text, else a plagiarist would escape by immaterial variations. That has never been the law, but, as soon as literal appropriation ceases to be the test, the whole matter is necessarily at large, so that, as was recently well said by a distinguished judge, the decisions cannot help much in a new case. *Fendler v. Morosco*, 253 N.Y. 281, 292, 171 N.E. 56. When plays are concerned, the plagiarist may excise a separate scene (*Daly v. Webster*, 56 F. 483 (C.C.A. 2); *Chappell v. Fields*, 210 F. 864 (C.C.A. 2); *Chatterton v. Cave*, L.R. 3 App.Cas. 483); or he may appropriate part of the dialogue (*Warne v. Seebohm*, L.R. 39 Ch.D. 73). Then the question is whether the part so taken is 'substantial,' and therefore not a 'fair use' of the copyrighted work; it is the same question arises in the case of any other copyrighted work. *Marks v. Feist*, 290 F. 959 (C.C.A. 2); *Emerson v. Davies*, Fed. Cas. No. 4436, 3 Story, 768, 795-797. But when the plagiarist does not take out a block in suit, but an abstract of the whole, decision is more troublesome. Upon any work, and especially upon a play, a great number of patterns of increasing generality will fit equally well, as more and more of the incident is left out. The last may perhaps be no more than the most general statement of what the play is about, and at

times might consist only of its title; but **there is a point in this series of abstractions where they are no longer protected, since otherwise the playwright could prevent the use of his 'ideas,' to which, apart from their expression, his property is never extended.**<sup>21</sup> *Holmes v. Hurst*, 174 U.S. 82, 86, 19 S.Ct. 606, 43 L.Ed. 904; *Guthrie v. Curlett*, 36 F.(2d) 694 (C.C.A. 2). **Nobody has ever been able to fix that boundary, and nobody ever can.**<sup>22</sup> In some cases the question has been treated as though it were analogous to lifting a portion out of the copyrighted work (*Rees v. Melville*, MACGILLIVRAY'S COPYRIGHT CASES (1911-1916), 168); but the analogy is not a good one, because, though the skeleton is a part of the body, it pervades and supports the whole. In such cases we are rather concerned with the line between expression and what is expressed. As respects plays, the controversy chiefly centers upon the characters and sequence of incident, these being the substance.

We did not in *Dymow v. Bolton*, 11 F.(2d) 690, hold that a plagiarist was never liable for stealing a plot; that would have been flatly against our ruling in *Dam v. Kirk La Shelle Co.*, 175 F. 902, 41 L.R.A.(N.S.) 1002, 20 Ann.Cas. 1173, and *Stodart v. Mutual Film Co.*, 249 F. 513, affirming my decision in (D.C.) 249 F. 507; neither of which we meant to overrule. We found the plot of the second play was too different to infringe, because the most detailed pattern, common to both, eliminated so much from each that its content went into the public domain; and for this reason we said, 'this mere subsection of a plot was not susceptible of copyright.' But we do not doubt that two plays may correspond in plot closely enough for infringement. How far that correspondence must go is another matter. Nor need we hold that the same may not be true as to the characters, quite independently of the 'plot' proper, though, as far as we know such a case has never arisen. If *Twelfth Night* were copyrighted, it is quite possible that a second comer might so closely imitate Sir Toby Belch or Malvolio as to infringe, but it would not be enough that for one of his characters he cast a riotous knight who kept wassail to the discomfort of the household, or a vain and foppish steward who became amorous of his mistress. These would be no more than Shakespeare's 'ideas' in the play, as little capable of monopoly as Einstein's Doctrine of Relativity, or Darwin's theory of the Origin of Species. It follows that the less developed the characters, the less they can be copyrighted; that is the penalty an author must bear for marking them too indistinctly.

*Nichols v. Universal Pictures Corporation*, 45 F.2d 119, 121 (2dCir. 1930),  
*cert. den.*, 282 U.S. 902 (1931).

The sentence saying "nobody has ever been able to fix that boundary" between idea and expression — the sentence that I boldfaced above — has been quoted with approval in:

- *Warner Bros. Inc. v. American Broadcasting Companies, Inc.*, 654 F.2d 204, 208 (2dCir. 1981);
- *Atari, Inc. v. North American Philips Consumer Electronics Corp.*, 672 F.2d 607, 616 (7thCir. 1982), *cert. den.*, 459 U.S. 880 (1982);
- *Burroughs v. Metro-Goldwyn-Mayer, Inc.*, 683 F.2d 610, 624 (2dCir. 1982);

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<sup>21</sup> Boldface added by Standler, to emphasize the rule that ideas can not be copyrighted and Hand's famous abstractions test.

<sup>22</sup> Boldface added by Standler.

- *Kern River Gas Transmission Co. v. Coastal Corp.*, 899 F.2d 1458, 1463 (5thCir. 1990), *cert. den.*, 498 U.S. 952 (1990);
- *Computer Associates Intern., Inc. v. Altai, Inc.*, 982 F.2d 693, 704 (2dCir. 1992) (“Drawing the line between idea and expression is a tricky business. Judge Learned Hand noted that ‘[n]obody has ever been able to fix that boundary, and nobody ever can.’ *Nichols*, 45 F.2d at 121. Thirty years later his convictions remained firm. ‘Obviously, no principle can be stated as to when an imitator has gone beyond copying the “idea,” and has borrowed its “expression,” ’ Judge Hand concluded. ‘Decisions must therefore inevitably be ad hoc.’ *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2dCir. 1960).”).

Later in *Nichols*, Learned Hand said:

We have to decide how much, and while we are as aware as any one that the line, wherever it is drawn, will seem arbitrary, that is no excuse for not drawing it; it is a question such as courts must answer in nearly all cases.

*Nichols v. Universal Pictures Corporation*, 45 F.2d 119, 122 (2dCir. 1930).

In my view, *Nichols* marks the turning point in copyright law when the word *ideas* shifted from its ordinary meaning to something different.

#### *Sheldon v. MGM*

In 1934, Woolsey, a judge in a federal trial court, wrote an unusually thorough justification for why copyright does not protect ideas. The case involved two accounts of a murder trial in Edinberg Scotland in the year 1857, Sheldon's copyrighted play and MGM's movie. Judge Learned Hand on the Second Circuit reversed Judge Woolsey's decision. Despite the fact that Woolsey's decision in this case was overruled on appeal, I believe that Woolsey accurately stated the reasons why copyright does not protect ideas.

Ideas, of course, are not protected by copyright, and, consequently, the plaintiffs' theme, that is, the basic idea of their Play, would not have been protected, quite irrespective of the fact that it was based on the Trial, which was in the public domain. *Nichols v. Universal Pictures Corporation* (C.C.A.) 45 F.(2d) 119, 121.

....

As a matter of the philosophy of the growth of literature, each book when published is thrown into the common heritage of mankind, and contributes to that heritage its share, be it much or little, of general ideas and suggestions. That is what Judge Learned Hand meant, as I understand it, when he said in the *Nichols* Case (C.C.A.) 45 F.(2d) 119, at page 122, speaking of Miss Nichols' copyright: ‘Her copyright did not cover everything that might be drawn from her play; its content went to some extent into the public domain. We have to decide how much, and while we are as aware as any one that the line, wherever it is drawn, will seem arbitrary, that is no excuse for not drawing it; it is a question such as courts must answer in nearly all cases. Whatever may be the difficulties a priori, we have no question on which side of the line this case falls.’



Now, it is of the greatest importance to the growth of human knowledge that literature should be free to develop, and, hence, it is that literary property in ideas has never been recognized. *Holmes v. Hurst*, 174 U.S. 82, 86, 19 S.Ct. 606, 43 L.Ed. 904; *Guthrie v. Curlett*, 36 F.(2d) 694 (C.C.A. 2); *Nichols v. Universal Pictures Corporation*, 45 F.(2d) 119, 121 (C.C.A. 2), and cf. BIRRELL ON LITERARY LARCENY quoted in *Lewys v. O'Neill* (D.C.) 49 F. (2d) 603, at page 607.

*Sheldon v. Metro-Goldwyn Pictures Corporation*, 7 F.Supp. 837, 843 (S.D.N.Y. 1934), *rev'd*, 81 F.2d 49 (2dCir. 1936), *aff'd*, 309 U.S. 390 (1940).

The trial court was quoted by Leon H. Amdur, COPYRIGHT LAW AND PRACTICE, p. 76 (1936).

### *Affiliated Enterprises*

Affiliated Enterprises, Inc. had developed a lottery system that it licensed to motion picture theaters. Affiliated sued defendants. Although defendants' work was substantially similar to Affiliated's, the trial court in Massachusetts dismissed the complaint, because it was a gambling transaction. In 1936, the U.S. Court of Appeals affirmed, but on different grounds. Affiliated had failed to specifically allege copyright infringement in its complaint, and their system could not be copyrighted. The Court of Appeals noted:

“One work does not violate the copyright in another simply because there is a similarity between the two, if the similarity results from the fact that both works deal with the same subject or have the same common sources.” 13 C.J. 1114, 278. See *Harold Lloyd Corp. v. Witwer* (C.C.A.) 65 F.(2d) 1, 4; *Perris v. Hexamer*, 99 U.S. 674, 25 L.Ed. 308.

....

However good and valuable an idea, plan, scheme, or system is, the moment it is disclosed to the public without the protection of a patent, it becomes public property, and the fact that it has been made popular by advertising and the expenditure of effort, time, and money on the part of the originator does not alter the situation.

*Affiliated Enterprises v. Gruber*, 86 F.2d 958, 961 (1stCir. 1936).

The last paragraph in the above quotation reiterates the old rule that publication puts ideas into the public domain.

### *Mazer v. Stein*

In 1954, the U.S. Supreme Court clearly said that copyrights did not protect ideas.

Unlike a patent, a copyright gives no exclusive right to the art disclosed; protection is given only to the expression of the idea — not the idea itself. [FN39]

FN39. *F. W. Woolworth Co. v. Contemporary Arts*, 1 Cir., 193 F.2d 162; *Ansehl v. Puritan Pharmaceutical Co.*, 8 Cir., 61 F.2d 131; *Fulmer v. United States*, 103 F.Supp. 1021, 122 Ct.Cl. 195; *Muller v. Triborough Bridge Authority*, D.C., 43 F.Supp. 298 [(S.D.N.Y. 1942)].

*Mazer v. Stein*, 347 U.S. 201, 217 (U.S. 1954).

*Rosenthal Jewelry v. Kalpakian*

A U.S. Court of Appeal in California in 1971 suggested that judges sometimes draw the boundary between unprotected ideas and protected expression in order to reach a desired result.

The critical distinction between ‘idea’ and ‘expression’ is difficult to draw. As Judge Hand candidly wrote, “Obviously, no principle can be stated as to when an imitator has gone beyond copying the ‘idea,’ and has borrowed its ‘expression.’ ” *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960). At least in close cases, one may suspect, the classification the court selects may simply state the result reached rather than the reason for it. In our view, the difference is really one of degree as Judge Hand suggested in his striking ‘abstraction’ formulation in *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930). The guiding consideration in drawing the line is the preservation of the balance between competition and protection reflected in the patent and copyright laws. *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971).

*Reyher v. Children’s Television Workshop*

In 1976, the U.S. Court of Appeals for the Second Circuit wrote:

It is an axiom of copyright law that the protection granted to a copyrightable work extends only to the particular expression of an idea and never to the idea itself. *Mazer v. Stein*, 347 U.S. 201, 217, 74 S.Ct. 460, 470, 98 L.Ed. 630, 642 (1954); *Baker v. Selden*, 101 U.S. 99, 102-103, 25 L.Ed. 841, 843 (1879). This principle attempts to reconcile two competing societal interests: rewarding an individual's ingenuity and effort while at the same time permitting the nation to benefit from further improvements or progress resulting from others' use of the same subject matter.

“In the case of verbal ‘works’ it is well settled that although the ‘proprietor’s’ monopoly extends beyond an exact reproduction of the words, there can be no copyright in the ‘ideas’ disclosed but only in their ‘expression.’ Obviously, no principle can be stated as to when an imitator has gone beyond copying the ‘idea,’ and has borrowed its ‘expression.’ Decisions must therefore inevitably be ad hoc.”

*Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2 Cir. 1960) (L. Hand).

The difficult task in an infringement action is to distill the nonprotected idea from protected expression. In *Nichols v. Universal Pictures Corporation*, 45 F.2d 119, 121 (2 Cir. 1930), *cert. denied*, 282 U.S. 902, 51 S.Ct. 216, 75 L.Ed. 795 (1931), Judge Learned Hand articulated his “abstractions test” by noting that “(u)pon any work . . . a great number of patterns of increasing generality will fit equally well, as more and more of the incident is left out. . . . (T)here is a point in this series of abstractions where they are no longer protected, since otherwise the playwright could prevent the use of his ‘ideas’ to which, apart from their expression, his property is never extended.” Attempting to further delineate this boundary, one commentator has stated that “protection covers the ‘pattern’ of the work . . . the sequence of events and the development of the interplay of characters.” [FN2]

FN2. Z. Chafee, *Reflections on the Law of Copyright*, 45 *COL.L.REV.* 503, 513 (1945).

While the demarcation between idea and expression may not be susceptible to overly helpful generalization, it has been emphasized repeatedly that the essence of infringement lies in taking not a general theme but its particular expression through similarities of treatment,

details, scenes, events and characterization. *Sheldon v. Metro-Goldwyn Pictures Corporation*, 81 F.2d 49, 54 (2 Cir.), *cert. denied*, 298 U.S. 669, 56 S.Ct. 835, 80 L.Ed. 1392 (1936); *Burnett v. Lambino*, 204 F.Supp. 327 (S.D.N.Y. 1962); *Bevan v. Columbia Broadcasting System, Inc.*, *supra*, 329 F.Supp. at 605. Another helpful analytic concept is that of scenes a faire, sequences of events which necessarily follow from a common theme. “(S)imilarity of expression . . . which necessarily results from the fact that the common **idea is only capable of expression in more or less stereotyped form will preclude a finding of actionable similarity.**”<sup>23</sup> 1 Nimmer [on Copyright (1975)] § 143.11 at 626.2; see Yankwich, *Originality in the Law of Intellectual Property*, 11 F.R.D. 457, 462 (1951). Copyrights, then, do not protect thematic concepts or scenes which necessarily must follow from certain similar plot situations. Thus, “no one infringes, unless he descends so far into what is concrete (in a work) as to invade . . . (its) ‘expression.’ ” *National Comics Publications v. Fawcett Publications*, 191 F.2d 594, 600 (2 Cir. 1951). An example illuminating these somewhat theoretical statements may be helpful at this point. In *Nichols v. Universal Pictures Corporation*, *supra*, the author of the play “Abie’s Irish Rose” claimed that her work had been infringed by defendant’s film “The Cohens and The Kellys.” The court found that the only matter common to the two stories, a “quarrel between a Jewish and an Irish father, the marriage of their children, the birth of grandchildren and a reconciliation,” was not protected by copyright; similarly, the four characters common to both plays were prototypes too indistinct to merit copyright protection. The court concluded that “(a) comedy based upon conflicts between Irish and Jews, into which the marriage of their children enters,” was not within the protection afforded by copyright because this theme was part of plaintiff’s ideas. *Reyher v. Children’s Television Workshop*, 533 F.2d 87, 90-91 (2d Cir. 1976), *cert. den.*, 429 U.S. 980 (1976).

*Sid & Marty Krofft v. McDonald’s Corp.*

In 1977, the U.S. Court of Appeals in California was the first to use the word *dichotomy* in the context of excluding ideas from copyright protection, in the idea-expression dichotomy. The case involved infringement by McDonald’s hamburger commercials of cartoon characters in the copyrighted “H.R. Pufnstuf” children’s television program.

Clearly the scope of copyright protection does not go this far. A limiting principle is needed. This is provided by the classic distinction between an “idea” and the “expression” of that idea. It is an axiom of copyright law that the protection granted to a copyrighted work extends only to the particular expression of the idea and never to the idea itself. *Mazer v. Stein*, 347 U.S. 201, 217-18, 74 S.Ct. 460, 98 L.Ed. 630 (1954); *Baker v. Selden*, 101 U.S. 99, 102-03, 25 L.Ed. 841 (1879). This principle attempts to reconcile two competing social interests: rewarding an individual’s creativity and effort while at the same time permitting the nation to enjoy the benefits and progress from use of the same subject matter.

The real task in a copyright infringement action, then, is to determine whether there has been copying of the expression of an idea rather than just the idea itself. “(N)o one infringes, unless he descends so far into what is concrete (in a work) as to invade . . . (its) expression.” *National Comics Publications v. Fawcett Publications*, 191 F.2d 594, 600 (2 Cir. 1951). Only this expression may be protected and only it may be infringed.[FN6]

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<sup>23</sup> Boldface added by Standler. The remark by Prof. Nimmer is also relevant to the merger doctrine discussed later in this essay. In the Dec 2008 version of NIMMER ON COPYRIGHT, the boldfaced sentence is found at § 13.03 [B] [3].

FN6. The idea-expression dichotomy has been criticized by some commentators as outmoded because it was developed under older, narrower statutes which have since been considerably broadened. See, e. g., Collins, Some Obsolescent Doctrines of the Law of Copyright, 1 S.CAL.L.REV. 127 (1928); Umbreit, A Consideration of Copyright, 87 U.PA.L.REV. 932 (1939); Note, Copyright Protection for Mass-Produced Commercial Products: A Review of the Developments Following *Mazer v. Stein*, 38 U.CHI.L.REV. 807 (1971). Yet the distinction accurately conceptualizes the fundamental elements in an artistic creation and balances the competing interests inherent in the copyright law. We have surveyed the literature and have found that no better formulation has been devised. Moreover, most of these criticisms are directed at the fact that the courts tend to pay only lipservice to the idea-expression distinction without it being fairly descriptive of the results of modern cases. This is a criticism more of the application of the distinction than of the distinction itself, and can be alleviated by the courts being more deliberate in their consideration of this issue.

The difficulty comes in attempting to distill the unprotected idea from the protected expression. No court or commentator in making this search has been able to improve upon Judge Learned Hand's famous "abstractions test" articulated in *Nichols v. Universal Pictures Corporation*, 45 F.2d 119 (2 Cir. 1930), *cert. denied*, 282 U.S. 902, 51 S.Ct. 216, 75 L.Ed. 795 (1931):

"Upon any work, and especially upon a play, a great number of patterns of increasing generality will fit equally well, as more and more of the incident is left out. The last may perhaps be no more than the most general statement of what the play is about, and at times might consist of only its title; but there is a point in this series of abstractions where they are no longer protected, since otherwise the playwright could prevent the use of his 'ideas,' to which, apart from their expression, his property is never extended." 45 F.2d at 121.

See also Chafee, Reflections on the Law of Copyright, 45 COLUM.L.REV. 503 (1945);

Esezobar, Concepts in Copyright Protection, 23 BULL.CPRT.SOC. 258 (1976);

Note, "Expression" and "Originality" in Copyright Law, 11 WASHBURN L.J. 400 (1972).

*Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1163-1164 (9th Cir. 1977).

Later in this opinion, is a rare judicial explanation of why ideas are not copyrightable.

But the impact, if any, of the first amendment on copyright has not been discussed by the [U.S. Supreme] Court.[FN15] We believe this silence stems not from neglect but from the fact that the idea-expression dichotomy already serves to accommodate the competing interests of copyright and the first amendment. The "marketplace of ideas" is not limited by copyright because copyright is limited to protection of expression. As one commentator has stated:

"(T)he idea-expression line represents an acceptable definitional balance as between copyright and free speech interests. In some degree it encroaches upon freedom of speech in that it abridges the right to reproduce the 'expression' of others, but this is justified by the greater public good in the copyright encouragement of creative works. In some degree it encroaches upon the author's right to control his work in that it renders his 'ideas' per se unprotectible, but this is justified by the greater public need for free access to ideas as part of the democratic dialogue."

Nimmer, Does Copyright Abridge the First Amendment Guarantees of Free Speech and Press ?, 17 U.C.L.A.L.REV. 1180, 1192-93 (1970). Cf. *Lee v. Runge*, 404 U.S. 887, 892-93, 92 S.Ct. 197, 30 L.Ed.2d 169 (1971) (Douglas, J., dissenting).

FN15. In *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 84 S.Ct. 784, 11 L.Ed.2d 661 (1964), and *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 84 S.Ct. 779, 11 L.Ed.2d 669 (1964), the court reasoned that in an economy based on free competition, the constitutionality authorized monopolies of patent and copyright must be strictly construed. It therefore found invalid state doctrines of unfair competition which expanded these monopolies. The court's concern was with monopolies as commercial, not political, impediments, and thus it did not reach first amendment considerations. See also *Lee v. Runge*, 404 U.S. 887, 892-93, 92 S.Ct. 197, 30 L.Ed.2d 169 (1971) (Douglas, J., dissenting).

Ideas which may be of public interest are not subject to copyright; the specific form of expression of these ideas are. Thus, the political views of Dr. Martin Luther King may be widely disseminated. But the precise expression of these views in a speech may be protected. *King v. Mister Maestro, Inc.*, 224 F.Supp. 101 (S.D.N.Y. 1963). See also *Public Affairs Associates, Inc. v. Rickover*, 177 F.Supp. 601 (D.D.C. 1960), *rev'd*, 109 U.S.App.D.C. 128, 284 F.2d 262 (1960), *rev'd*, 369 U.S. 111, 82 S.Ct. 580, 7 L.Ed.2d 604 (1962), *on remand*, 268 F.Supp. 444 (D.D.C. 1967); *Atlantic Monthly Co. v. Post Pub. Co.*, 27 F.2d 556 (D.Mass. 1928). Similarly, the facts about a historical figure are available to all to use. But if the expression of those facts in a biography is substantially copied infringement will be found. See, e. g., *Toksvig v. Bruce Publishing Co.*, 181 F.2d 664 (7 Cir. 1950); *Marvin Worth Productions v. Superior Films Corp.*, 319 F.Supp. 1269 (S.D.N.Y. 1970); *Holdredge v. Knight Publishing Corp.*, 214 F.Supp. 921 (C.D.Cal. 1963).

With the law of copyright permitting the free use of ideas, it is not surprising that the few courts addressing the issue have not permitted defendants who copy a work's expression to hide behind the first amendment. See, e. g., *Duchess Music Corp. v. Stern*, 458 F.2d 1305, 1310-11 (9 Cir. 1972); *United States v. Bodin*, 375 F.Supp. 1265, 1267-68 (W.D.Okl. 1974); *McGraw Hill, Inc. v. Worth Publishers, Inc.*, 335 F.Supp. 415, 422 (S.D.N.Y. 1971). In *Walt Disney Productions v. Air Pirates*, 345 F.Supp. 108 (N.D.Cal. 1972), plaintiff sued for infringement of several of its famous cartoon characters by defendants, who used them for purposes of literary criticism. Defendants claimed that the first amendment limited the scope of plaintiff's copyright protection. The court responded:

“However defendants would have it, the hard fact remains that both parties are dealing in cartoon series, comic books or strips, and that the mode which the defendants have chosen for the expression of their concepts amounts to a substantial taking of plaintiff's expression of its concepts, even assuming vast difference in the content of those concepts. It can scarcely be maintained that there is no other means available to defendants to convey the message they have, nor is it even clear that other means are not available within the chosen genre of comics and cartoons. To paraphrase, it is true that it would be easier to copy substantial portions of the expression as distinguished from the idea itself of the Disney works, but the value of such labor-saving utility is far outweighed by the copyright interest in encouraging creation by protecting expression.”

*Id.* at 115 (footnotes omitted).

The district court in *Disney* recognized that the expression inherent in plaintiff's works differs from the mere idea of those works. The "idea" of Mickey Mouse is, after all, no more than a mouse. Yet the particular expression of that mouse has phenomenal commercial value and is recognized worldwide. Defendants there could have chosen any number of ways to express their idea of a mouse, but chose to copy Disney's. So too the defendants in this case had many ways to express the idea of a fantasyland with characters, but chose to copy the expression of plaintiffs'. The first amendment will not protect such imitation.

There may be certain rare instances when first amendment considerations will operate to limit copyright protection for graphic expressions of newsworthy events.[FN16] For example, in *Time, Inc. v. Bernard Geis Associates*, 293 F.Supp. 130 (S.D.N.Y. 1968), LIFE magazine sued a historian for copying frames of the Zapruder films of the assassination of John F. Kennedy. Although the court did not expressly invoke the first amendment, it did justify the defendant's right to copy frames of the film on the ground of the "public interest in having the fullest information available on the murder of President Kennedy." *Id.* at 146. Plaintiffs' work in this case is neither a graphic expression nor concerning newsworthy events. Therefore, no first amendment considerations operate.[FN17]

FN16. This exception to the rule that first amendment considerations do not operate to limit copyright protection was suggested by Professor Nimmer. Nimmer, *Does Copyright Abridge the First Amendment Guarantees of Free Speech and Press?*, 17 U.C.L.A. L.REV. 1180, 1199 (1970). He suggests a system of compulsory licensing for "news photographs," which he defines as all products of the photographic and analogous processes (including motion pictures and video tape but excluding paintings, sculpture, and the like) depicting an event which was the subject of news stories appearing in the press. He gives the photographs of the My Lai massacre as an example.

FN17. In *Rosemont Enterprises, Inc. v. Random House, Inc.*, 366 F.2d 303 (2 Cir. 1966), Howard Hughes attempted to enjoin Random House from publishing a biography of Hughes. The biography was based on information contained in a series of articles appearing in Look magazine over which Hughes (via Rosemont) held a copyright. Had the biography merely attempted to use the information in the articles we would agree with the Second Circuit's refusal to enjoin because such information represents the "idea" of a biography on Hughes. But the Random House biography copied verbatim almost 27% of one of the Look articles and 14% of all of the articles. *Rosemont Enterprises, Inc. v. Random House, Inc.*, 256 F.Supp. 55, 61 (S.D.N.Y. 1966). We believe this represents an unjustifiable appropriation of the expression of the idea, and hence disapprove of the result in *Rosemont*. Because there are available alternatives in the form of expressing any verbal ideas, first amendment considerations should not limit copyright protection in this area. We need not reach this precise issue today, however, since it is clear that neither the H. R. Pufnstuf series nor McDonaldland commercials are newsworthy.

*Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1170-1171 (9th Cir. 1977).

Notice that the U.S. Court of Appeals concentrated on political speech (e.g., Rev. King, Adm. Rickover), news (e.g., film of Kennedy assassination), and facts in a biography. There is nothing in this discussion about ideas in computer programs, reports of novel research results in scientific journals, mathematical journals or books, etc. Because *some* ideas in engineering are

patentable (see page 68, below), it is not clear to me that legal concepts protecting political speech are appropriate for writings in science, mathematics, engineering, or computer science.

### C. 1976 statute

The Copyright Act of 1976 very clearly excludes some types of information, including ideas, from the protection of copyright law:

In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

17 U.S.C. § 102(b), 90 STATUTES-AT-LARGE at 2545 (enacted 1976, still current Jan 2009).

Section 102(b) is known in copyright law as stating the idea-expression dichotomy. This is the first time ideas were excluded from copyright in U.S. federal statute, although the statute simply codifies what was a long-standing rule made by judges. Prof. Samuelson correctly notes that “surprisingly few cases and very little commentary have probed the meaning of § 102(b) ...”<sup>24</sup> While § 102(b) is commonly called the idea-expression dichotomy, Prof. Samuelson said it would be better to call this section the “protectable/unprotectable distinction”, because *eight* items are excluded from copyright protection, not only ideas.<sup>25</sup>

### legislative history

Despite the fact that the Copyright Act of 1976 was the first time federal statute had excluded ideas from copyright protection, the legislative history of this subsection is only the following three terse paragraphs with zero citations and no justification for the exclusion.

Copyright does not preclude others from using the ideas or information revealed by the author's work. It pertains to the literary, musical, graphic, or artistic form in which the author expressed intellectual concepts. Section 102(b) [subsec. (b) of this section] makes clear that copyright protection does not extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

Some concern has been expressed lest copyright in computer programs should extend protection to the methodology or processes adopted by the programmer, rather than merely to the “writing” expressing his ideas. Section 102(b) [subsec. (b) of this section] is intended, among other things, to make clear that the expression adopted by the programmer is the copyrightable element in a computer program, and that the actual processes or methods embodied in the program are not within the scope of the copyright law.

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<sup>24</sup> Pamela Samuelson, “Why Copyright Law Excludes Systems and Processes from the Scope of Its Protection,” 85 TEXAS LAW REVIEW 1921, 1921 (June 2007).

<sup>25</sup> Pamela Samuelson, “Why Copyright Law Excludes Systems and Processes from the Scope of Its Protection,” 85 TEXAS LAW REVIEW 1921, 1923 (June 2007).

Section 102(b) [subsec. (b) of this section] in no way enlarges or contracts the scope of copyright protection under the present law. Its purpose is to restate, in the context of the new single Federal system of copyright, that the basic dichotomy between expression and idea remains unchanged.

U.S. House of Representatives Report Nr. 94-1476 at pages 56-57 (3 Sep 1976), reprinted in 1976 U.S. CODE CONGRESSIONAL AND ADMINISTRATIVE NEWS 5659, 5670.

#### D. U.S. Court cases after 1976

##### *Sony v. Universal City Studios*

In 1984, the U.S. Supreme Court wrote:

As the text of the Constitution makes plain, it is Congress that has been assigned the task of defining the scope of the limited monopoly that should be granted to authors or to inventors in order to give the public appropriate access to their work product. Because this task involves a difficult balance between the interests of authors and inventors in the control and exploitation of their writings and discoveries on the one hand, and society's competing interest in the **free flow of ideas**,<sup>26</sup> information, and commerce on the other hand, our patent and copyright statutes have been amended repeatedly. [footnote omitted]

*Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984).

Quoted with approval in *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 580 (1985). I suspect that lobbying by copyright owners (e.g., publishers of books and motion picture studios) is the real reason that the copyright statutes have been amended repeatedly. And there were only two comprehensive revisions of the copyright statutes in the Twentieth Century, one in 1909 and the other in 1976.

##### *Whelan v. Jaslow Dental Lab.*

In 1986, the U.S. Court of Appeals in Pennsylvania wrote in an early case involving copyright of a computer program:

It is frequently difficult to distinguish the idea from the expression thereof. No less an authority than Learned Hand, after a career that included writing some of the leading copyright opinions, concluded that the distinction will "inevitably be ad hoc." *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960). See also Knowles & Palmieri, *Dissecting Krofft: An Expression of New Ideas in Copyright?*, 8 San.Fern.Val.L.Rev. 109, 126 (1980) (arguing that there can be no meaningful distinction between idea and expression).

....

*Whelan Associates, Inc. v. Jaslow Dental Laboratory, Inc.*, 797 F.2d 1222, 1235 (3d Cir. 1986), *cert. den.*, 479 U.S. 1031 (1987).

After a long discussion, the court in *Whelan* decided that the *idea* in the computer program at issue was the purpose of the program, "to run a dental laboratory in an efficient way." 797 F.2d at 1238 and n.34. While I have no quarrel with the result in *Whelan*, this legal conclusion about the program's idea would be very different than the ideas expressed by the programmer during writing the program.

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<sup>26</sup> Boldface added by Standler.



*Kern River*

In 1990, the U.S. Court of Appeals in Texas wrote:

[quoting 17 U.S.C. § 102(b)] Thus, protection is extended to an expression of an idea fixed in a tangible form, but not to the idea itself regardless of the form in which it is fixed.

In drawing this fundamental distinction, Congress balanced the competing concerns of providing incentive to authors to create and of fostering competition in such creativity. *Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d 1240, 1253 (3d Cir. 1983) (citing *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971)); *Sid & Marty Krofft Television v. McDonald's Corp.*, 562 F.2d 1157, 1163 (9th Cir. 1977). *Kern River Gas Transmission Co. v. The Coastal Corp.*, 899 F.2d 1458, 1463 (5th Cir. 1990), *cert. den.*, 498 U.S. 952 (1990).

Actually, Congress **neither** drew a “fundamental distinction” **nor** “balanced the competing concerns”, but instead copied the holding from judicial opinions going back into the 1800s. And, as shown in the quotations above, the judges did not do any balancing either, they apparently used the antique philosophical doctrine that ideas should be free.

*Mason v. Montgomery Data*

In 1992, the U.S. Court of Appeals in Texas wrote:

We cannot determine whether an idea is capable of a variety of expressions until we first identify what that idea is. A court's decision whether to apply the merger doctrine often depends on how it defines the author's idea. For this reason, in defining the idea the court should be guided by “the balance between competition and protection reflected in the patent and copyright laws.” *Herbert Rosenthal Jewelry*, 446 F.2d at 742. [FN8]

FN8. Thus, as one commentator states:

In copyright law, an “idea” is not an epistemological concept, but a legal conclusion prompted by notions — often unarticulated and unproven — of appropriate competition. Thus, copyright doctrine attaches the label “idea” to aspects of works which, if protected, would (or, we fear, might) preclude, or render too expensive, subsequent authors' endeavors.

Jane C. Ginsburg, No “Sweat”? Copyright and Other Protection of Works of Information after *Feist v. Rural Telephone*, 92 COLUM.L.REV. 338, 346 (1992) (footnotes omitted).

*Mason v. Montgomery Data, Inc.*, 967 F.2d 135, 140 (5th Cir. 1992).

*Computer Associates v. Altai*

In 1992, the U.S. Court of Appeals created a complicated three-step procedure for evaluating copyright infringement of computer programs. The complexity is a direct result of the rule that ideas can not be copyrighted.

It is a fundamental principle of copyright law that a copyright does not protect an idea, but only the expression of the idea. See *Baker v. Selden*, 101 U.S. 99, 25 L.Ed. 841 (1879); *Mazer v. Stein*, 347 U.S. 201, 217, 74 S.Ct. 460, 470, 98 L.Ed. 630 (1954). This axiom of common law has been incorporated into the governing statute. Section 102(b) of the Act provides:

In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

17 U.S.C. § 102(b). See also House Report, at 5670 (“Copyright does not preclude others from using ideas or information revealed by the author's work.”).

Congress made no special exception for computer programs. To the contrary, the legislative history explicitly states that copyright protects computer programs only “to the extent that they incorporate authorship in programmer's expression of original ideas, as distinguished from the ideas themselves.” *Id.* at 5667; see also *id.* at 5670 (“Section 102(b) is intended ... to make clear that the expression adopted by the programmer is the copyrightable element in a computer program, and that the actual processes or methods embodied in the program are not within the scope of copyright law.”).

Similarly, the National Commission on New Technological Uses of Copyrighted Works (“CONTU”) established by Congress to survey the issues generated by the interrelationship of advancing technology and copyright law, see Pub.L. No. 93-573, § 201, 88 Stat. 1873 (1974), recommended, inter alia, that the 1976 Copyright Act “be amended ... to make it explicit that computer programs, to the extent that they embody the author's original creation, are proper subject matter for copyright.” See National Commission on New Technological Uses of Copyrighted Works, Final Report 1 (1979) (hereinafter “CONTU Report”). To that end, Congress adopted CONTU's suggestions and amended the Copyright Act by adding, among other things, a provision to 17 U.S.C. § 101 which defined the term “computer program.” See Pub.L. No. 96-517, § 10(a), 94 Stat. 3028 (1980). CONTU also “concluded that the idea-expression distinction should be used to determine which aspects of computer programs are copyrightable.” *Lotus Dev. Corp.*, 740 F.Supp. at 54 (citing CONTU Report, at 44).

Drawing the line between idea and expression is a tricky business. Judge Learned Hand noted that “[n]obody has ever been able to fix that boundary, and nobody ever can.” *Nichols*, 45 F.2d at 121. Thirty years later his convictions remained firm. “Obviously, no principle can be stated as to when an imitator has gone beyond copying the ‘idea,’ and has borrowed its ‘expression,’ ” Judge Hand concluded. “Decisions must therefore inevitably be ad hoc.” *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960).

The essentially utilitarian nature of a computer program further complicates the task of distilling its idea from its expression. See *SAS Inst.*, 605 F.Supp. at 829; cf. Englund, at 893. In order to describe both computational processes and abstract ideas, its content “combines creative and technical expression.” See Spivack, at 755. The variations of expression found in purely creative compositions, as opposed to those contained in utilitarian works, are not directed towards practical application. For example, a narration of Humpty Dumpty's demise, which would clearly be a creative composition, does not serve the same ends as, say, a recipe for scrambled eggs — which is a more process oriented text. Thus, compared to aesthetic works, computer programs hover even more closely to the elusive boundary line described in § 102(b).

The doctrinal starting point in analyses of utilitarian works, is the seminal case of *Baker v. Selden*, 101 U.S. 99, 25 L.Ed. 841 (1879). In *Baker*, the Supreme Court faced the question of “whether the exclusive property in a system of bookkeeping can be claimed, under the law of copyright, by means of a book in which that system is explained?” *Id.* at 101. Selden had copyrighted a book that expounded a particular method of bookkeeping. The book contained lined pages with headings intended to illustrate the manner in which the system operated. Baker's accounting publication included ledger sheets that employed “substantially the same ruled lines and headings...” *Id.* Selden's testator sued Baker for copyright infringement on the theory that the ledger sheets were protected by Selden's copyright.

The Supreme Court found nothing copyrightable in Selden's bookkeeping system, and rejected his infringement claim regarding the ledger sheets. The Court held that:

The fact that the art described in the book by illustrations of lines and figures which are reproduced in practice in the application of the art, makes no difference. Those illustrations are the mere language employed by the author to convey his ideas more clearly. Had he used words of description instead of diagrams (which merely stand in the place of words), there could not be the slightest doubt that others, applying the art to practical use, might lawfully draw the lines and diagrams which were in the author's mind, and which he thus described by words in his book.

The copyright of a work on mathematical science cannot give to the author an exclusive right to the methods of operation which he propounds, or to the diagrams which he employs to explain them, so as to prevent an engineer from using them whenever occasion requires.

[*Baker v. Selden*, 101 U.S.] at 103.

To the extent that an accounting text and a computer program are both “a set of statements or instructions ... to bring about a certain result,” 17 U.S.C. § 101, they are roughly analogous. In the former case, the processes are ultimately conducted by human agency; in the latter, by electronic means. In either case, as already stated, the processes themselves are not protectable. But the holding in *Baker* goes farther. The Court concluded that those aspects of a work, which “must necessarily be used as incident to” the idea, system or process that the work describes, are also not copyrightable. 101 U.S. at 104. Selden's ledger sheets, therefore, enjoyed no copyright protection because they were “necessary incidents to” the system of accounting that he described. *Id.* at 103. From this reasoning, we conclude that those elements of a computer program that are necessarily incidental to its function are similarly unprotectable.

While *Baker v. Selden* provides a sound analytical foundation, it offers scant guidance on how to separate idea or process from expression, and moreover, on how to further distinguish protectable expression from that expression which “must necessarily be used as incident to” the work’s underlying concept. In the context of computer programs, the Third Circuit’s noted decision in *Whelan* has, thus far, been the most thoughtful attempt to accomplish these ends.

The court in *Whelan* faced substantially the same problem as is presented by this case. There, the defendant was accused of making off with the non-literal structure of the plaintiff’s copyrighted dental lab management program, and employing it to create its own competitive version. In assessing whether there had been an infringement, the court had to determine which aspects of the programs involved were ideas, and which were expression. In separating the two, the court settled upon the following conceptual approach:

[T]he line between idea and expression may be drawn with reference to the end sought to be achieved by the work in question. In other words, the purpose or function of a utilitarian work would be the work’s idea, and everything that is not necessary to that purpose or function would be part of the expression of the idea.... Where there are various means of achieving the desired purpose, then the particular means chosen is not necessary to the purpose; hence, there is expression, not idea.

797 F.2d at 1236 (citations omitted). The “idea” of the program at issue in *Whelan* was identified by the court as simply “the efficient management of a dental laboratory.” *Id.* at n. 28.

So far, in the courts, the *Whelan* rule has received a mixed reception. While some decisions have adopted its reasoning, see, e.g., *Bull HN Info. Sys., Inc. v. American Express Bank, Ltd.*, 1990 Copyright Law Dec. (CCH) ¶ 26,555 at 23,278, 1990 WL 48098 (S.D.N.Y. 1990); *Dynamic Solutions, Inc. v. Planning & Control, Inc.*, 1987 Copyright Law Dec. (CCH) ¶ 26,062 at 20,912, 1987 WL 6419 (S.D.N.Y. 1987); *Broderbund Software Inc. v. Unison World, Inc.*, 648 F.Supp. 1127, 1133 (N.D.Cal. 1986), others have rejected it, see *Plains Cotton Co-op v. Goodpasture Computer Serv., Inc.*, 807 F.2d 1256, 1262 (5th Cir.), *cert. denied*, 484 U.S. 821, 108 S.Ct. 80, 98 L.Ed.2d 42 (1987); cf. *Synercom Technology, Inc. v. University Computing Co.*, 462 F.Supp. 1003, 1014 (N.D.Tex. 1978) (concluding that order and sequence of data on computer input formats was idea not expression).

*Whelan* has fared even more poorly in the academic community, where its standard for distinguishing idea from expression has been widely criticized for being conceptually overbroad. See, e.g., Englund, at 881; Menell, at 1074, 1082; Kretschmer, at 837-39; Spivack, at 747-55;<sup>27</sup> Thomas M. Gage, Note, *Whelan Associates v. Jaslow Dental Laboratories: Copyright Protection for Computer Software Structure — What’s the Purpose?*, 1987 WIS.L.REV. 859, 860-61 (1987). The leading commentator in the field has stated that “[t]he crucial flaw in [*Whelan*’s] reasoning is that it assumes that only one ‘idea,’ in

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<sup>27</sup> The complete citations, from 982 F.2d at 697, are:

Steven R. Englund, Note, *Idea, Process, or Protected Expression?: Determining the Scope of Copyright Protection of the Structure of Computer Programs*, 88 MICH.L.REV. 866, 867-73 (1990) (hereinafter “Englund”); Peter S. Menell, *An Analysis of the Scope of Copyright Protection for Application Programs*, 41 STAN.L.REV. 1045, 1051-57 (1989) (hereinafter “Menell”); Mark T. Kretschmer, Note, *Copyright Protection For Software Architecture: Just Say No!*, 1988 COLUM.BUS.L.REV. 823, 824-27 (1988) (hereinafter “Kretschmer”); Peter G. Spivack, Comment, *Does Form Follow Function? The Idea/Expression Dichotomy In Copyright Protection of Computer Software*, 35 U.C.L.A.L.REV. 723, 729-31 (1988) (hereinafter “Spivack”).

copyright law terms, underlies any computer program, and that once a separable idea can be identified, everything else must be expression.” 3 Nimmer § 13.03(F), at 13-62.34. This criticism focuses not upon the program's ultimate purpose but upon the reality of its structural design. As we have already noted, a computer program's ultimate function or purpose is the composite result of interacting subroutines. Since each subroutine is itself a program, and thus, may be said to have its own “idea,” *Whelan's* general formulation that a program's overall purpose equates with the program's idea is descriptively inadequate.

Accordingly, we think that Judge Pratt wisely declined to follow *Whelan*. See *Computer Assocs.*, 775 F.Supp. at 558-60. In addition to noting the weakness in the *Whelan* definition of “program-idea,” mentioned above, Judge Pratt found that *Whelan's* synonymous use of the terms “structure, sequence, and organization,” see *Whelan*, 797 F.2d at 1224 n. 1, demonstrated a flawed understanding of a computer program's method of operation. See *Computer Assocs.*, 775 F.Supp. at 559-60 (discussing the distinction between a program's “static structure” and “dynamic structure”). Rightly, the district court found *Whelan's* rationale suspect because it is so closely tied to what can now be seen — with the passage of time — as the opinion's somewhat outdated appreciation of computer science.

We think that *Whelan's* approach to separating idea from expression in computer programs relies too heavily on metaphysical distinctions and does not place enough emphasis on practical considerations. Cf. *Apple Computer*, 714 F.2d at 1253 (rejecting certain commercial constraints on programming as a helpful means of distinguishing idea from expression because they did “not enter into the somewhat metaphysical issue of whether particular ideas and expressions have merged”). As the cases that we shall discuss demonstrate, a satisfactory answer to this problem cannot be reached by resorting, a priori, to philosophical first principals.

As discussed herein, we think that district courts would be well-advised to undertake a three-step procedure, based on the abstractions test utilized by the district court, in order to determine whether the non-literal elements of two or more computer programs are substantially similar. This approach breaks no new ground; rather, it draws on such familiar copyright doctrines as merger, scenes a faire, and public domain. In taking this approach, however, we are cognizant that computer technology is a dynamic field which can quickly outpace judicial decisionmaking. Thus, in cases where the technology in question does not allow for a literal application of the procedure we outline below, our opinion should not be read to foreclose the district courts of our circuit from utilizing a modified version.

In ascertaining substantial similarity under this approach, a court would first break down the allegedly infringed program into its constituent structural parts.<sup>28</sup> Then, by examining each of these parts for such things as incorporated ideas, expression that is necessarily incidental to those ideas, and elements that are taken from the public domain, a court would then be able to **sift out all non-protectable material**.<sup>29</sup> Left with a kernel, or possible kernels, of creative expression after following this process of elimination, the court's last step

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<sup>28</sup> This step is called “abstraction”.

<sup>29</sup> Boldface added by Standler. This second step is called “filtration”.

would be to compare this material with the structure of an allegedly infringing program.<sup>30</sup> The result of this comparison will determine whether the protectable elements of the programs at issue are substantially similar so as to warrant a finding of infringement. ....  
*Computer Associates Intern., Inc. v. Altai, Inc.*, 982 F.2d 693, 703-706 (2dCir. 1992).

Incidentally, *Computer Associates v. Altai* was tried in March 1990, and then repeatedly bounced between appellate and trial courts until 1998, generating more than two dozen judicial opinions.

*Gates Rubber v. Bando, Ltd.*

In 1992-1993, there was another application of the old rule that publication of an idea puts that idea into the public domain. *Gates Rubber Co. v. Bando Chemical Industries, Ltd.*, 798 F.Supp. 1499, 1519 (D.Colo. 1992) (“The formulas which are identical in the two programs, were previously published and thus cannot be considered part of the protected elements of the Design Flex program.”), *rev'd on other grounds*, 9 F.3d 823, 842, n.19 (10thCir. 1993) (The trial court “correctly .... found the formulas used in the program to have been previously published and therefore in the public domain”).

*Veck*

In 2002, a dissenting judge, joined by five other judges, on the U.S. Court of Appeals in Texas wrote a discussion of the meaning of the word *ideas* in copyright law.

“Idea” in copyright law is a term of art which does not track its everyday, dictionary meaning. What constitutes an “idea” in the lexicon of copyright law cannot be determined by empirically analyzing a given fact situation until the nascent dividing line between the “idea” and its “expression” finally crystallizes; indeed, just the reverse is true. Case law reveals that identification of the “idea” in a work is not the starting point but the result of a judicial exercise that in turn is highly dependent on the precise factual situation being tested.[FN31] Therefore, designation of the enacted code as an idea vel non is a legal conclusion to be reached by a court, not an initial factual finding to be gleaned intuitively. That determination of idea is not antecedent to a policy determination regarding the “copyrightability” of the code; to the contrary, it is the logical end- product reached after competing concerns are weighed judicially.[FN32]

FN31. *Id.* (“A court's decision whether to apply the merger doctrine often depends on how it defines the author's idea. For this reason, in defining the idea the courts should be guided by ‘the balance between competition and protection reflected in the patent and copyright laws.’ ”) (citations omitted); *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960) (L.Hand, J.)(discussing what the court termed as “verbal works,” the court stated “[T]here can be no copyright in the ‘ideas’ disclosed but only in their ‘expression.’ Obviously, no principle can be stated as to when an imitator has gone beyond copying the ‘idea,’ and has borrowed its ‘expression.’ Decisions must therefore inevitably be ad hoc.”); see also NIMMER ON COPYRIGHT § 13.03[B][2][a] at

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<sup>30</sup> This third step is called “comparison”.

13-60 (“Merely stating the rule [17 U.S.C. § 102(b) ], however, does not make any easier the task of drawing the line between where the idea ends and expression begins.”).

FN32. Cf. NIMMER ON COPYRIGHT § 1.10[B][2] at 1-78 (“On the whole, therefore, it appears that the idea-expression line represents an acceptable balance as between copyright and free speech interests”) (citing *United Video, Inc. v. F.C.C.*, 890 F.2d 1173, 1191 (D.C.Cir. 1989)).

*Veeck v. Southern Bldg. Code Congress Intern., Inc.*, 293 F.3d 791, 819 (5thCir. 2002) (Wiener, J., dissenting). This is an unusually honest recognition of the lack of a precise definition of *idea* in copyright law.

#### *Satava v. Lowry*

In 2003, a U.S. Court of Appeals in California held that the idea of a glass sculpture of a jellyfish, or other natural animal, could not be protected by copyright. The end of the opinion says:

Nature gives us ideas of animals in their natural surroundings: an eagle with talons extended to snatch a mouse; a grizzly bear clutching a salmon between its teeth; a butterfly emerging from its cocoon; a wolf howling at the full moon; a jellyfish swimming through tropical waters. These ideas, first expressed by nature, are the common heritage of humankind, and no artist may use copyright law to prevent others from depicting them.

We do not mean to short-change the legitimate need of creative artists to protect their original works. After all, copyright law achieves its high purpose of enriching our culture by giving artists a financial incentive to create. But we must be careful in copyright cases not to cheat the public domain. Only by vigorously policing the line between idea and expression can we ensure both that artists receive due reward for their original creations and that proper latitude is granted other artists to make use of ideas that properly belong to us all.

*Satava v. Lowry*, 323 F.3d 805, 813 (9thCir. 2003), *cert. den.*, 540 U.S. 983 (2003).

This explanation that idea of depictions of natural animals are not copyrightable may be similar to the rule in patent law that laws of nature are not patentable, see page 68, below. Notice that the judges gave no citation for their conclusion. For a similar case involving the merger doctrine in copyright law, see the quotation from *Yankee Candle* at page 56, below.

#### *Oravec*

In May 2008, a U.S. Court of Appeals in Florida wrote:

Nevertheless, in attempting to distinguish between ideas and expression, it is useful to note the policy purposes served by the distinction. See *Country Kids 'N City Slicks, Inc. v. Sheen*, 77 F.3d 1280, 1285 (10thCir. 1996). The idea/expression dichotomy seeks to achieve a proper balance between competing societal interests: that of encouraging the creation of original works on the one hand, and that of promoting the free flow of ideas and information on the other. See *Feist*, 499 U.S. at 349-50, 111 S.Ct. at 1290 (“[C]opyright assures authors the right to their original expression, but encourages others to build freely upon the ideas and information conveyed by a work.”); accord *Suntrust Bank*, 268 F.3d at 1264; *Herzog*, 193 F.3d at 1248. Therefore, “in defining protectable expression, the court should ‘neither draw

the line so narrowly that authors, composers and artists will have no incentive to produce original literary, musical and artistic works, nor [should the court] draw it so broadly that future authors, composers and artists will find a diminished store of ideas on which to build their works.’ ” *Meade v. United States*, 27 Fed.Cl. 367, 372 (Fed.Cl. 1992) (alteration in original) (quoting Paul Goldstein, COPYRIGHT: PRINCIPLES, LAW, AND PRACTICE § 2.3.1.2 (1989)), *aff'd*, 5 F.3d 1503 (Fed.Cir. 1993).

*Oravec v. Sunny Isles Luxury Ventures*, 527 F.3d 1218, 1225 (11thCir. 2008).

Any balancing must be accomplished by the judge who determines the boundary between unprotected ideas and protected expression.

#### E. Commentators

Just before the U.S. Supreme Court decided *Baker v. Selden*, Eaton S. Drone wrote his famous treatise on copyright law.<sup>31</sup> Despite the 824 page length of this book, Drone mentioned *ideas* in only a few places:

1. Drone at p. 8, n.1 quotes a case in England, *Jefferys v. Boosey*, 4 H.L.C. 868, which says “... the claim is not to ideas, but to the order of words; ....”
2. Drone at p. 385 says “Property cannot exist in simple ideas and thoughts; but only in their arrangement and combination.”
3. Drone at p. 394, n.1 quotes a case in New York, *Banks v. McDivitt*, 2 F.Cas. 759, 761 (C.C.N.Y. 1875), which mentions the word “ideas”.
4. Drone at p. 427, n.1 quotes a case in Ohio, *Story’s Executors v. Holcombe*, which I quoted above, at page 6.

These few terse mentions of the word *idea* suggests to me that, prior to *Baker v. Selden* in the year 1879, the distinction between ideas and expression was not a major concern of copyright law.

Another great treatise on copyright law, this one published in 1917, very tersely remarked that ideas were not copyrightable:

There can be no copyright in ideas, as such, but only in their mode of expression. Ideas themselves, from their very nature, have been deemed free. Arthur W. Weil, AMERICAN COPYRIGHT LAW, at p. 189, § 497 (1917). On the next page, Weil cites *Kalem v. Harper Brothers*, 222 U.S. 55 as the only American case on this point.

In the early 1800s, copyright law only protected authors from reproduction of identical versions in the same format, and others were free to create derivative works.<sup>32</sup> The U.S. copyright statutes added a public performance right<sup>33</sup> in 1856. In 1870, the U.S. copyright statutes added

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<sup>31</sup> Eaton S. Drone, A TREATISE ON THE LAW OF PROPERTY IN INTELLECTUAL PRODUCTIONS, (1879).

<sup>32</sup> See, e.g., Paul Goldstein, “Derivative Rights and Derivative Works in Copyright,” 30 JOURNAL OF THE COPYRIGHT SOCIETY OF THE USA 209 (1983).

<sup>33</sup> 11 STATUTES AT LARGE 138, 139 (18 Aug 1856).



rights of copyright owners to control translations and dramatizations.<sup>34</sup> The Copyright Act of 1909 included these earlier rights and also gave the copyright owner “the exclusive right ... to ... make any other version thereof...”<sup>35</sup> The Copyright Act of 1909 also gave the copyright owner the right to control abridgements.<sup>36</sup> The Copyright Act of 1976 continued all of these earlier rights under the “exclusive rights to do and to authorize ... derivative works based upon the copyrighted work”.<sup>37</sup>

In 1928, Charles Collins published an article, which says in part:

Since the cases that negative any exclusive right in the owner of copyright to abridge, translate, or dramatize his work are no longer law, it remains to be seen whether the doctrine that was enunciated as the *rationale* of those decisions — that there is no copyright in ideas — has perished with the statutes which it owed its birth, or whether the doctrine has survived, although it is not a logical deduction from the existing statute.

Charles B. Collins, “Some Obsolescent Doctrines of the Law of Copyright,” 1 SOUTHERN CALIFORNIA LAW REVIEW 127, 132-133 (Jan 1928). The answer to Mr. Collins’ question is that the doctrine has not only survived, but also was specifically included in the Copyright Act of 1976.

In 1954, Prof. Kaplan of Harvard University observed

But on reflection, how firm is the distinction between “expression” and “idea”? Let us first admit, as Mr. Kenneth B. Umbreit has observed [87 UNIV. PENN. L. REV. 932, 950-951], that copyright deals essentially with ideas in the ordinary meaning of the term: to copy the so-called expression of an idea is still to copy an idea. A workable distinction between ideas and expression might have been maintained when, as was originally the case, infringement of copyright meant essentially tracking a particular word order. We have come a long way since. ... it was idle to imagine that the idea-expression cleavage was a clear one,.... The distinction is especially hard to apply where two different media are involved, for example, when it is claimed that a motion picture infringes a novel.

Benjamin Kaplan, “Implied Contract and the Law of Literary Property,” 42 CALIFORNIA LAW REVIEW 28, 32-33 (Spring 1954).

In 1966, Prof. Kaplan of Harvard University gave a series of invited lectures at Columbia University on copyright law. These lectures were published in a book, which was published by Columbia University Press. Prof. Kaplan says:

The latter enlargement of the monopoly to cover the conversion of a work from one to another artistic medium, taken together with the *Daly* decision [6 Fed.Cas. 1132 (SDNY 1868)], put the question whether any line could really be held, even as to imaginative works, between

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<sup>34</sup> 16 STATUTES AT LARGE 198, 212, § 86 (8 July 1870).

<sup>35</sup> 35 STATUTES AT LARGE 1075, 1075, 17 U.S.C. § 1(b) (4 Mar 1909).

<sup>36</sup> 35 STATUTES AT LARGE 1075, 1077, § 6 (4 Mar 1909). In a later revision of the copyright statute, this section became § 7.

<sup>37</sup> 17 U.S.C. § 106(2). A *derivative work* is defined in 17 U.S.C. § 101.

“idea,” long supposed to be outside copyright protection, and “form,” assumed to be the only thing within it.

Benjamin Kaplan, AN UNHURRIED VIEW OF COPYRIGHT, at p. 32 (1967).

Prof. Kaplan did not further develop his idea, although he cryptically notes that “The question will recur.”

In 1980, a law student wrote a note that continued the views of Collins and Kaplan:

Clearly, the form of a play is different than that of the novel from which it is derived. It is quite difficult, however, to define precisely what such a copyright law does protect. What is the protectable feature common to a novel, its abridgment, its translation, and its dramatizations for the stage and for motion pictures? At least to some degree, the common feature must be a common idea. [footnote quoting Collins]

Stephanie K. Wade, Note, “Derivative Works and the Protection of Ideas,” 14 GEORGIA LAW REVIEW 794, 799 (Summer 1980).

I have an image of an author’s work being like a block of Swiss cheese.<sup>38</sup> The copyright owner owns only the cheese (i.e., original expression), but does not own the holes (i.e., ideas).<sup>39</sup> As explained above, a copyright owner’s control is limited to prohibiting copying (and prohibiting close paraphrases) of protected expression, but does not extend to copying of the ideas. Because ideas are contributed to the public domain when the author makes a public disclosure of the author’s work, the author then relinquishes any control over any ideas in his/her work. In my view of the law, a copyright owner’s exclusive rights to prepare derivative works only extends to the right to prevent copying (and close paraphrases) of the first author’s *expression* in any translation, abridgement, condensation, dramatization, or any other version or adaptation. With this explanation in mind, I do not understand what Collins, Kaplan, and Wade are saying about the right to control derivative works implies a right to control the ideas in the original work.

### Definition of Idea

The word *idea* is **not** defined in either statute or judicial opinions. As indicated by a dissenting judge in *Veeck*,<sup>40</sup> in copyright law the word *idea* has a different meaning from its ordinary definition. As expected, using a word in an unfamiliar way and refusing to define that word leads to serious problems. It is easy for a reader of judicial opinions in copyright law (even a reader who is an attorney) to be confused by the use of the word *idea*. Moreover, because ideas

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<sup>38</sup> What is called “Swiss cheese” in the USA is known in Europe as Emmentaler, a hard cheese characterized by holes with a diameter between 1 and 2 cm.

<sup>39</sup> LANDIS ON MECHANICS OF PATENT CLAIM DRAFTING, § 26, at pp. 58-59 (3d ed. 1990) (“Holes are nothing; you cannot claim a hole.”). See, e.g., *Chicago Telephone Supply v. Stackpole Carbon*, 113 F.2d 570, 570 (3d Cir. 1940) (“The patent is in essence a bid for a monopoly in a hole.”).

<sup>40</sup> *Veeck v. Southern Bldg. Code Congress Intern., Inc.*, 293 F.3d 791, 819 (5th Cir. 2002) (Wiener, J., dissenting). Quoted above, at page 30.

are not protected by copyright law, judges can play with the boundary between unprotected ideas and protected expression to achieve any result the judges desire.<sup>41</sup>

I am not the first person to notice this glaring problem with the definition of *idea* in copyright law. Instead of writing a hideously long footnote, I give the following list of publications where the author has recognized this problem:

- Paul Goldstein, “Infringement of Copyright in Computer Programs,” 47 UNIVERSITY OF PITTSBURGH LAW REVIEW 1119, 1126 (Summer 1986) (“...in the copyright lexicon, ‘idea’ is no more than a metaphor for elements generally belonging in the public domain.”);
- Stephen S. Zimmermann, Comment, “A Regulatory Theory of Copyright: Avoiding a First Amendment Conflict,” 35 EMORY LAW JOURNAL 163, 200, n. 167 (Winter 1986) (“*Wainwright* [558 F.2d 91] illustrates the problem resulting from the courts’ refusal or inability to define what an idea is. The lack of a workable definition gives the court the power to determine what is an idea based on what result it wishes to reach.”);
- Amaury Cruz, Comment, “What’s the Big Idea Behind the Idea-Expression Dichotomy? — Modern Ramifications of the Tree of Prophecy in Copyright Law,” 18 FLORIDA STATE UNIV. LAW REVIEW 221, 222 (Summer 1990) (“But the Copyright Act of 1976 offers no guidance in deciding what is an idea, resulting in jurisprudential uncertainty.”);
- Amy B. Cohen, “Copyright Law and the Myth of Objectivity: The Idea-Expression Dichotomy and the Inevitability of Artistic Value Judgments,” 66 INDIANA LAW JOURNAL 175, 212 (Winter 1990) (“As the cases discussed below indicate, often a court’s view of what constitutes the ‘idea’ is influenced by how novel or creative the court considers the works at issue to be; courts also seem influenced by the relative commercial success of the works, their market value and the reputations of their creators.”);
- Jane C. Ginsburg, “No ‘Sweat’? Copyright and Other Protection of Works of Information After *Feist v. Rural Telephone*,” 92 COLUMBIA LAW REVIEW 338, 346 (March 1992) (“In copyright law, an ‘idea’ is not an epistemological concept, but a legal conclusion prompted by notions — often unarticulated and unproven — of appropriate competition. Thus, copyright doctrine attaches the label ‘idea’ to aspects of works which, if protected, would (or, we fear, might) preclude, or render too expensive, subsequent authors’ endeavors.”);
- Kenneth W. Dam, “Some Economic Considerations in the Intellectual Property Protection of Software,” 24 JOURNAL OF LEGAL STUDIES 321, 338, n. 65 (June 1995) (“The term ‘idea’ is not defined and thus can be said to be a metaphor for what courts choose not to protect....”);
- David M. McGovern, “What’s Your Pitch?: Idea Protection Is Nothing But Curveballs,” 15 LOYOLA OF LOS ANGELES ENTERTAINMENT LAW JOURNAL 475, 477, n. 6 (1995) (quoting Ginsburg’s 1992 article);

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<sup>41</sup> See, e.g., *Mason v. Montgomery Data, Inc.*, 967 F.2d 135, 140 (5thCir. 1992). This opinion was quoted at page 25, above.

- Jane C. Ginsburg, “Copyright, Common Law, and *Sui Generis* Protection of Databases in the United States and Abroad,” 92 UNIV. OF CINCINNATI LAW REVIEW 151, 153-154 (Fall 1997). (“The court has come close to acknowledging that an idea in copyright law is not an epistemological concept; it is a legal conclusion informed by public policy notions of what is necessary to stimulate creation of works in the first place, while still leaving room for subsequent innovation.”);
- Paul Goldstein, GOLDSTEIN ON COPYRIGHT, § 2.3.1 (1998) (“... ‘idea’ and ‘expression’ should not be taken literally, but rather as metaphors for a work’s unprotected and protected elements, respectively.”);<sup>42</sup>
- Irene Segal Ayers, “The ‘Facts’ of Cultural Reality: Redrawing the Line Between Fact and Expression in Copyright Law,” 67 UNIV. OF CINCINNATI LAW REVIEW 563, 573 (Winter 1999) (quoting two articles by Ginsburg);
- John Greenman, “On Communication,” 106 MICHIGAN LAW REVIEW 1337, 1347, n. 38 (May 2008) (“... even in copyright case, the term [*ideas*], which is distinguished from ‘expression,’ is notoriously poorly defined....”);
- Paul Goldstein, GOLDSTEIN ON COPYRIGHT, § 2.3.1 (2008) (“ ‘Idea’ and ‘expression’ are best viewed not as precise pigeonholes, but as metaphors for a work’s unprotected and protected elements, respectively.”);

There seems to be general agreement in copyright law that the best definition of *idea* is in the abstractions test stated by Judge Learned Hand in *Nichols*, see page 14, above. The test is notoriously difficult to apply and effectively gives judges the ability to achieve whatever result they desire. I suggest that such a definition is *unacceptably vague*.

#### my definition

In my earlier essay on copyrightability of facts, I said:

Some copyright lawyers and judges apparently use *ideas* and *facts* as synonyms. I see a distinction:

- A. *ideas* refer to theories, hypotheses, and abstractions, which are products of an author’s mind
- B. *facts* include measurements, calculations, observations, information, and other descriptions of reality.

Standler, Copyright Protection for Nonfiction or Compilations of Facts in the USA, <http://www.rbs2.com/cfact.pdf>, (22 Feb 2009). I use the same definitions in this essay on copyright for ideas. My definitions were created when I was considering nonfiction writings in science, mathematics, and engineering. Below, I give an alternative definition of *idea* when applied to a fictional literary work.

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<sup>42</sup> Quoted by Lloyd L. Weinreb, “Copyright for Functional Expression,” 111 HARVARD LAW REVIEW 1149, 1176, n.105 (Mar 1998).

There is a second possible meaning for the word *idea*. An idea can be a thought in an author's mind that is not yet expressed in speech or writing. In this second sense, an idea is not copyrightable, because it is not yet "fixed in any tangible medium of expression".

17 U.S.C. § 102(a) (enacted 1976). Prior to the Copyright Act of 1976, such an *unexpressed* thought was not copyrightable, because it was not in a format that could be registered with the Copyright Office. Thoughts have long been recognized as not copyrightable.<sup>43</sup>

In this essay, I use the word *idea* to refer to a theory, hypothesis, or abstraction that is expressed in writing.

#### *idea* in fictional works

The *idea* in a fictional literary work, such as a novel or play, can be defined as a terse synopsis of the plot. In support of my definition of *idea* for nonfictional works, I cite:

- *Universal Pictures Co. v. Harold Lloyd Corp.*, 162 F.2d 354, n.7 (9thCir. 1947) (Quoting BALL ON THE LAW OF COPYRIGHT AND LITERARY PROPERTY, pp. 320-321: "Copyright does not protect the plot but only the means of expression by which the plot is worked out. Two dramatic works may be built upon the same fundamental idea, contain instances of similarity of phraseology, characters and locale; yet if the plots are developed by means of substantially different incidents, showing dissimilarity in thought, action, character and treatment ... there has been no infringement of copyright.");
- *Columbia Pictures Corp. v. National Broadcasting Co.*, 137 F.Supp. 348, 353 (S.D.Cal. 1955) ("Some of the material ordinarily appearing in a copyrighted literary or dramatic work is not capable of ownership, is not protectible, and may freely be taken by others without infringing the copyright. Such material includes the following: ... the theme, ... the locale and settings, ... the 'situations,' ... ordinarily the characters, ... the ideas, ... [and the] bare basic plots. [numerous citations omitted]");
- *Berkic v. Crichton*, 761 F.2d 1289, 1293 (9thCir. 1985) ("No one can own the basic idea for a story. General plot ideas are not protected by copyright law; they remain forever the common property of artistic mankind. See *Litchfield [v. Spielberg]*, 736 F.2d at 1357 [(9thCir. 1984)] (no copyright protection for general plot ideas); 3 M. NIMMER ON COPYRIGHT § 13.03[A] (1984)."), *cert. den.*, 474 U.S. 826 (1985);
- *Bucklew v. Hawkins, Ash, Baptie & Co., LLP*, 329 F.3d 923, 929 (7thCir. 2003) ("... the 'idea,' which in the case of fiction is more likely to be a plot or situation than, as in *Baker v. Selden*, an algorithm or other abstraction.");

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<sup>43</sup> See, e.g., Eaton S. Drone, A TREATISE ON THE LAW OF PROPERTY IN INTELLECTUAL PRODUCTIONS, at p. 97 (1879); Arthur W. Weil, AMERICAN COPYRIGHT LAW, at pp. 3, 30 (1917).

- *Stromback v. New Line Cinema*, 384 F.3d 283, 296 (6thCir. 2004) (“... many of these elements are superficial, e.g., the Hell/dungeon setting, the sequence of certain events (main characters leaving Hell, battling their brother, the attempted killing of the main character), racial allusions and a love interest. These are common themes and ideas throughout literature and are beyond any level of abstraction at which copyright protection might begin to attach.”).

### First Amendment Concerns

Both copyright and freedom of speech are mentioned in the U.S. Constitution, so the framers of the Constitution viewed them as existing together. However, it is possible that strong copyright might sometime infringe freedom of speech. Long-standing rules prohibiting copyright on works of the u.s. government and prohibiting copyright of statutes, judicial opinions, and regulations<sup>44</sup> help to avoid some potential conflicts.

I suggest that the rule prohibiting copyright of ideas originated in the 1800s with the philosophy that “ideas are as free as air”. However, in 1970 two law professors independently recognized that the idea-expression dichotomy might protect freedom of speech.<sup>45</sup> Beginning in 1977, a few judges declared that the idea-expression dichotomy was necessary to remove the conflict between freedom of speech and copyright, as explained below. While the idea-expression dichotomy may have this result, such a result was *not* the original reason for creating the idea-expression dichotomy. At best, the idea-expression dichotomy has the collateral benefit of avoiding a conflict between copyright and the First Amendment.

Prof. Yen neatly summarized part of Nimmer’s and Goldstein’s argument for the idea-expression dichotomy:

... to the extent that copyright silences only those who merely repeat what others have already expressed, it disturbs only expression which adds nothing new to the “marketplace of ideas.” Similarly, to the extent that copyright permits the borrowing of ideas, it leaves ample room to authors whose works do not merely repeat the expression of others, but rather add to the “marketplace of ideas.” [two footnotes omitted]

Alfred C. Yen, “A First Amendment Perspective on the Idea/Expression Dichotomy and Copyright in a Work’s ‘Total Concept and Feel’,” 38 EMORY LAW JOURNAL 393, 396 (Spring 1989). I disagree with Prof. Yen’s choice of words about “copyright silences”, because copyright only affects plagiarists or pirates who copy an author’s expression. And if ideas are free for copying, then copyright has no effect on the “marketplace of *ideas*”.

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<sup>44</sup> See, e.g., Standler, No Copyright for Law in the USA, <http://www.rbs2.com/cgovt.pdf>, Jan 2009.

<sup>45</sup> Melville B. Nimmer, “Does Copyright Abridge the First Amendment Guarantees of Free Speech and Press?,” 17 U.C.L.A. LAW REVIEW 1108, 1192 (June 1970); Paul Goldstein, “Copyright and the First Amendment,” 70 COLUMBIA LAW REVIEW 983, 1018, 1056 (June 1970).

In 1977, A U.S. Court of Appeals in California wrote:

... the idea-expression dichotomy already serves to accommodate the competing interests of copyright and the first amendment. The “marketplace of ideas” is not limited by copyright because copyright is limited to protection of expression. As one commentator has stated:

“(T)he idea-expression line represents an acceptable definitional balance as between copyright and free speech interests. In some degree it encroaches upon freedom of speech in that it abridges the right to reproduce the ‘expression’ of others, but this is justified by the greater public good in the copyright encouragement of creative works. In some degree it encroaches upon the author’s right to control his work in that it renders his ‘ideas’ per se unprotectible, but this is justified by the greater public need for free access to ideas as part of the democratic dialogue.”

Nimmer, *Does Copyright Abridge the First Amendment Guarantees of Free Speech and Press?*, 17 U.C.L.A.L.Rev. 1180, 1192-93 (1970). Cf. *Lee v. Runge*, 404 U.S. 887, 892-93, 92 S.Ct. 197, 30 L.Ed.2d 169 (1971) (Douglas, J., dissenting).

*Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1170 (9thCir. 1977).<sup>46</sup>

This part of *Krofft* was quoted with approval in :

- *Walt Disney Productions v. Air Pirates*, 581 F.2d 751, 759 (9thCir. 1978), *cert. den.*, 439 U.S. 1132 (1979);
- *Triangle Publications, Inc. v. Knight-Ridder Newspapers*, 626 F.2d 1171, 1179 (5thCir. 1980) (Brown, J., concurring in part);
- *Authors League of America, Inc. v. Association of American Publishers*, 619 F.Supp. 798, 807 (S.D.N.Y. 1985), *aff'd*, 790 F.2d 220 (2dCir. 1986);
- *Los Angeles News Service v. Tullo*, 973 F.2d 791, 795 (9thCir. 1992).

Two U.S. Supreme Court opinions have endorsed the idea-expression dichotomy as protecting First Amendment concerns. In 1985, the Court wrote:

The Second Circuit noted, correctly, that copyright's idea/expression dichotomy “strike[s] a definitional balance between the First Amendment and the Copyright Act by permitting free communication of facts while still protecting an author's expression.” [*Harper & Row Publishers, Inc. v. Nation Enterprises*, 723 F.2d 195 (2dCir. 1983)] at 203. No author may copyright his ideas or the facts he narrates. 17 U.S.C. § 102(b). See, e.g., *New York Times Co. v. United States*, 403 U.S. 713, 726, n. , 91 S.Ct. 2140, 2147, n. , 29 L.Ed.2d 822 (1971) (BRENNAN, J., concurring) (Copyright laws are not restrictions on freedom of speech as copyright protects only form of expression and not the ideas expressed); 1 Nimmer § 1.10[B][2].

*Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 556 (1985).

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<sup>46</sup> *Krofft* contains a long dictum about political speech, which is quoted above, beginning at page 20.

The U.S. Supreme Court summarized:

In view of the First Amendment protections already embodied in the Copyright Act's distinction between copyrightable expression and uncopyrightable facts and ideas, and the latitude for scholarship and comment traditionally afforded by fair use, we see no warrant for expanding the doctrine of fair use to create what amounts to a public figure exception to copyright.

*Harper & Row*, 471 U.S. at 560.

In 2003, the U.S. Supreme Court wrote:

The Copyright Clause and First Amendment were adopted close in time. This proximity indicates that, in the Framers' view, copyright's limited monopolies are compatible with free speech principles. Indeed, copyright's purpose is to promote the creation and publication of free expression. As *Harper & Row* observed: “[T]he Framers intended copyright itself to be the engine of free expression. By establishing a marketable right to the use of one's expression, copyright supplies the economic incentive to create and disseminate ideas.” 471 U.S., at 558, 105 S.Ct. 2218.

In addition to spurring the creation and publication of new expression, copyright law contains built-in First Amendment accommodations. See *id.*, at 560, 105 S.Ct. 2218. First, it distinguishes between ideas and expression and makes only the latter eligible for copyright protection. Specifically, 17 U.S.C. § 102(b) provides: “In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.” As we said in *Harper & Row*, this “idea/expression dichotomy strike[s] a definitional balance between the First Amendment and the Copyright Act by permitting free communication of facts while still protecting an author's expression.” 471 U.S., at 556, 105 S.Ct. 2218 (internal quotation marks omitted). Due to this distinction, every idea, theory, and fact in a copyrighted work becomes instantly available for public exploitation at the moment of publication. See *Feist*, 499 U.S., at 349-350, 111 S.Ct. 1282.

*Eldred v. Ashcroft*, 537 U.S. 186, 219 (2003).

That the idea-expression dichotomy protects freedom of speech seems like a nice conclusion, until one realizes — as Prof. Yen did in his 1989 article<sup>47</sup> — that the definition of *idea* used by judges in copyright cases is vague.

my view

I do not see copyright as conflicting with the First Amendment. The First Amendment puts limits on what a *government* can do to inhibit freedom, but copyright is a personal property right that belongs to an individual person or corporation. People who find copyright to be oppressive should be sternly told: “Do your own work. Stop copying.”

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<sup>47</sup> Alfred C. Yen, “A First Amendment Perspective on the Idea/Expression Dichotomy...,” 38 EMORY LAW JOURNAL 393, 396-397, 405 (Spring 1989).



One would *not* argue that property law, including the crime and tort of trespass, conflicts with the freedom of assembly in the First Amendment. People have the right to assemble in public places, but *not* on private property.<sup>48</sup> In the same way, people have a legal right to copy expression that is in the public domain, but people do *not* have the legal right to copy an author's copyrighted expression.

I see society's choice as between: (1) an author *not* publicly disclosing his/her work and (2) an author's work being protected by copyright. Given this choice, society should choose copyright. Copyright satisfies the constitutional goal of encouraging and rewarding speech that contains new expression, thus promoting the Progress of knowledge.

With my views, I am *not* concerned with the alleged conflict between copyright and First Amendment law. A hypothetical example of a real conflict — which would concern me — would be if the government granted copyright only on “a condition that to be copyrightable a work may not criticize the government.”<sup>49</sup>

To summarize, I do not see a conflict between copyright and the First Amendment. *If* there is a conflict, and *if* the idea-expression dichotomy could solve the conflict, then we are in trouble, because the definition of idea in copyright law is vague.

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<sup>48</sup> I think it is obvious that the First Amendment does not create a right to violate private property. My quick search for cases on this point shows few reported cases, which I interpret to mean that few attorneys have argued that the First Amendment somehow supersedes private property rights. See, e.g., *Lloyd Corp., Limited v. Tanner*, 407 U.S. 551, 568 (1972) (shopping mall can prohibit distribution of handbills: “Although ... the courts properly have shown a special solicitude for the guarantees of the First Amendment, this Court has never held that a trespasser or an uninvited guest may exercise general rights of free speech on property privately owned and used nondiscriminatorily for private purposes only.”); *Lloyd* was reiterated in *PruneYard Shopping Center v. Robins*, 447 U.S. 74, 80 (1980) (Under the U.S. Constitution, a shopping center can prohibit collection of signatures on a political petition); *D'Aguanno v. Gallagher*, 50 F.3d 877, 880 (11thCir. 1995) (eviction of homeless people who had camped on private property); *Riemers v. Super Target of Grand Forks*, 363 F.Supp.2d 1182 (D.N.D. 2005) (freedom of assembly does *not* give people right to collect signatures on a political petition inside a retail store).

<sup>49</sup> *Ladd v. Law & Technology Press*, 762 F.2d 809, 815 and n.5 (9thCir. 1985).

## Idea-Expression Merger

The doctrine is easy to state. When there is *only one way* — or a very few ways — to express an idea, the expression and idea merge, and the rule making an idea uncopyrightable then also makes the expression uncopyrightable. Because there are nearly always *many* ways to express an idea, the merger doctrine is rarely applicable. While defendants who infringed a copyright sometimes mention the merger doctrine as excusing their bad conduct, the defense is rarely successful. The history of the merger doctrine is difficult to trace, because this doctrine did not have a name until the early 1980s.

### *Baker v. Selden*

One sentence in the U.S. Supreme Court's opinion in *Baker v. Selden* has been identified<sup>50</sup> as the origin of the merger doctrine.

And where the art it teaches cannot be used without employing the methods and diagrams used to illustrate the book, or such as are similar to them, such methods and diagrams are to be considered as necessary incidents to the art, and given therewith to the public; ....

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

The phrase “necessary incidents” suggests that the expression (i.e., “methods and diagrams”) has merged with the idea (i.e., “[useful] art it teaches”) that was given by the author to the public domain. In my view, this terse statement is too tenuous to be acceptable as a full statement of the merger doctrine, although it may be an early hint of the doctrine. In support of my view, I cite the following opinions of judges on the U.S. Courts of Appeals to show that (1) recognition of *Baker v. Selden* as the origin of the merger doctrine is a recent event, and (2) some judges admit that *Baker* was an early statement of what later evolved into the merger doctrine.

- *Kregos v. Associated Press*, 937 F.2d 700, 712 (2dCir. 1991) (Sweet, J., concurring in part) (“On the other hand, the *Baker* Court’s initial holding, distinguishing between an ‘art’ and an explanation of that art, has not been seriously challenged, and has steadily evolved and been refined into what is commonly referred to today as the idea/expression dichotomy, a concept which includes within its bounds the special case of merger.”);
- *Arica Institute, Inc. v. Palmer*, 970 F.2d 1067, 1076 (2dCir. 1992) (“The roots of this ‘merger’ doctrine can be found in such cases as *Baker v. Selden*, 101 U.S. 99, 25 L.Ed. 841 (1879), in which the Supreme Court held unprotected an author’s lined ledger sheets where the sheets were necessary to the application of the author’s accounting system and protecting them would have afforded copyright protection to the underlying system itself.”);

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<sup>50</sup> *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9thCir. 1971). See also, Edward Samuels, “The Idea-Expression Dichotomy in Copyright Law,” 56 TENNESSEE LAW REVIEW 321, 329 (Winter 1989) ; Pamela Samuelson, “Why Copyright Law Excludes Systems and Processes from the Scope of Its Protection,” 85 TEXAS LAW REVIEW 1921, 1934 (June 2007).

- *Computer Associates Intern., Inc. v. Altai, Inc.*, 982 F.2d 693, 707 (2dCir. 1992) (“The portion of *Baker v. Selden*, discussed earlier, which denies copyright protection to expression necessarily incidental to the idea being expressed, appears to be the cornerstone for what has developed into the doctrine of merger.”);
- *CCC Information Services, Inc. v. Maclean Hunter Market Reports, Inc.*, 44 F.3d 61, 72, n.25 (2dCir. 1994) (“Compare *Baker v. Selden*, 101 U.S. 99, 25 L.Ed. 841 (1880), and *Kern River*, [899 F.2d 1458 (5thCir. 1990)], (copyright protection denied, based on merger doctrine, respectively to a system of double entry bookkeeping and the designation of the best available pipeline route from Wyoming to California), with ....”).

If Justice Bradley, who wrote *Baker*, had been clearer about the merger doctrine — perhaps using two or three full sentences to explain the doctrine — then judges on the U.S. Court of Appeals would have sooner recognized the significance of this passage in *Baker*, instead of waiting more than 110 years. Because of the rambling explanation in *Baker*, and because of the terse nature of this passage, I am not convinced that Justice Bradley understood the significance of the above quoted passage in *Baker*.

With the possible exception of *Baker v. Selden*, the U.S. Supreme Court has never mentioned the merger doctrine in its copyright cases.

#### *Sampson & Murdock Co. v. Seaver-Radford*

The U.S. Court of Appeals in Massachusetts wrote a decision in the year 1905 that may be the first mention of the merger doctrine in copyright law. The case involved two directories of businesses in Boston, and the second directory copied information from the first.

It is evident that, while the complainant's copyright was in full force, the respondent copied and identically republished very considerable portions of its directory. On the other hand, it cannot be questioned that the second publisher, although he gives out exactly the same words as the first publisher, is, nevertheless, within his legal right, provided he resorts independently to the same originals that the first publisher went to. **He may, indeed, even make use of the same phraseology, either because the topic necessarily requires it**<sup>51</sup> or through mere incidental coincidences of expression. So, also, it is clear that, under some circumstances and for certain purposes, a subsequent publisher may draw from the earlier publication its identical words, and make use of them. This is peculiarly so with reference to works in regard to the arts and sciences, using those words in the broadest sense, because, with reference to the, any publication is given out as a development in the way of progress, and, to a certain extent, by common consent, including the implied consent of the first publisher, others interested in advancing the same art or science may commence where the prior author stopped. This includes medical and legal publications, in which the entire community has an interest, and which the authors are supposed to give forth, not only for their own pecuniary profit, but for the advancement of science. Therefore, as to copyrighted works of that character, by the common consent to which we have referred, subsequent authors are sometimes entitled, and, indeed, required, to make use of what precedes them in the precise form in which last

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<sup>51</sup> Boldface added by Standler.

exhibited, so that with regard to them the rules under the copyright statutes are very far from fitting a case like that we are not considering.

*Sampson & Murdock Co. v. Seaver-Radford Co.*, 140 F. 539, 541 (1stCir. 1905).

The phrase I boldfaced has been quoted with approval in: *Morrissey v. Procter & Gamble Co.*, 379 F.2d 675, 678 (1stCir. 1967); *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 984, n.31 (11thCir. 1983).

### *Dorsey*

Dorsey obtained copyrights on his insurance policies between 1927-1930. He later sued an insurance company for copyright infringement, but the trial court<sup>52</sup> dismissed his litigation and the U.S. Court of Appeals affirmed:

The right secured by a copyright is not the right to the use of certain words, nor the right to employ ideas expressed thereby. Rather it is the right to that arrangement of words which the author has selected to express his ideas.[FN1]

FN1. *Holmes v. Hurst*, 174 U.S. 82, 86, 19 S.Ct. 606, 43 L.Ed. 904; *Hartfield v. Peterson*, 2 Cir., 91 F.2d 998, 999; *Guthrie v. Curlett*, 2 Cir., 36 F.2d 694, 696; *Ansehl v. Puritan Pharmaceutical Co.*, 8 Cir., 61 F.2d 131, 137, 138; *Harold Lloyd Corp. v. Witwer*, 9 Cir., 65 F.2d 1, 25; *Kaeser & Blair, Inc., v. Merchants' Ass'n, Inc.*, 6 Cir., 64 F.2d 575, 577; *Dymow v. Bolton*, 2 Cir., 11 F.2d 690, 691. See, also, *Affiliated Enterprises, Inc., v. Gantz*, 10 Cir., 86 F.2d 597, 598, and *Affiliated Enterprises, Inc., v. Gruber*, 1 Cir., 86 F.2d 958, 961.

....

The copyrighted forms here involved in the main are an aggregation of these standard provisions including those required by statute. As to those provisions it is clear that there is no infringement. One work does not violate the copyright in another simply because there is a similarity between the two if the similarity results from the fact that both works deal with the same subject or have the same common source. *Affiliated Enterprises, Inc., v. Gruber*, 1 Cir., 86 F.2d 958, 961. The provisions dealing specifically with the family group are alleged to be new and original. The copyrights if valid at all must be limited to those particular provisions and to the particular means employed by Dorsey to express the contractual terms thereof. The provisions in the policies of the Insurance Company dealing particularly with the family group are neither an exact nor a substantial copy of the family group provisions in the copyrighted policies. There is no more similarity than might naturally be expected in policies embracing the same plan of insurance and incorporating like contractual provisions. There can be no doubt that the Insurance Company is free to make contracts embracing like contractual provisions as those included in the copyrighted policies and to use suitable words to express the provisions of such contracts so long as it does not copy the particular means of expression originated by Dorsey.

A copyright upon a form of contractual provision should not be constructed so as to impinge upon the natural right of persons to make contracts containing the same contractual

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<sup>52</sup> *Dorsey*, 34 U.S.P.Q. 226 (W.D.Okla. 1937).

provisions and creating like contractual rights and obligations, and similarity of expression should not be held to constitute infringement in such cases. Necessarily, where the same contractual provision is to be expressed there will be similarity of language. To constitute infringement in such cases a showing of appropriation in the exact form or substantially so of the copyrighted material should be required. See *Brightley v. Littleton*, C.C. Oa., 37 F. 103, 104.

*Dorsey v. Old Sur. Life Ins. Co.*, 98 F.2d 872, 873-874 (10thCir. 1938).

This same problem will arise in enforcing copyrights in *any* contract, because specific language needs to be used in the contract to match case law and statutes. Use of this specific language is *not* copyright infringement, because judicial opinions and statutes are not copyrightable.<sup>53</sup> Indeed, a state insurance commission may require insurance companies to use standard form contracts.

### *Beardsley*

In the 1930s, Beardsley, an attorney and insurance broker, developed a new form of insurance for replacement of lost securities. Twenty years later, Beardsley alleged that his copyrights were infringed by Pullman's forms, and Continental's forms infringed Pullman's forms. The U.S. Court of Appeals in New York City held that Beardsley held a valid copyright, but had not proven infringement.

In *Crume v. Pacific Mut. Life Ins. Co.*, 7 Cir., 140 F.2d 182, *certiorari denied* 322 U.S. 755, 64 S.Ct. 1265, 88 L.Ed. 1584, the court found non-infringement of plaintiff's pamphlet describing a method for reorganizing insurance companies. As in all of these cases, the court was keenly aware that to prohibit similarity of language would have the effect of giving the copyright owner a monopoly on his idea — which the cases uniformly deny to copyright owners. Thus, the court stated, 140 F.2d at pages 184-185:

In the instant situation there is no room for the skill of the mechanic or artisan in utilizing the plan or the method disclosed. Its use, to which the public is entitled, can be effected solely by the employment of words descriptive thereof. In our view, where the use can be effected only in such manner, there can be no infringement even though the plan or method be copied. We realize that such a view leaves little, if any, protection to the copyright owners; in fact, it comes near to invalidating the copyright. This situation, however, results from the fact that the practical use of the art explained by the copyright and lodged in the public domain can be attained solely by the employment of language which gives expression to that which is disclosed.'

....

We also observe that such comparison (of the documents) adds strength to the view heretofore expressed that defendant's rightful use of the art disclosed could only be accomplished by the employment of words which describe plaintiff's method. To hold that an idea, plan, method or art described in a copyright is open to the public but that it can be used only by the employment of different words and phrases which mean the same thing, borders on the preposterous. It is to exalt the accomplishment of a result by indirect means which could not be done directly. It places a premium upon evasion and

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<sup>53</sup> Standler, No Copyright for Law in the USA, <http://www.rbs2.com/cgovt.pdf> , Jan 2009.

makes this the test of infringement. Notwithstanding some authorities which support a theory permitting such a result, we think it is wrong and disapprove it.’

Most recently, in *Miner v. Employers Mutual Liability Co. of Wisconsin*, 97 U.S.App.D.C. 152, 229 F.2d 35, the court approved the District Court holding that ‘there is no similarity in the arrangement of words of plaintiff’s policies and the arrangement of words in defendant’s policy and that defendant has not appropriated in the exact form or substantially so plaintiff’s copyright material.’

These cases indicate that in the fields of insurance and commerce the use of specific language in forms and documents may be so essential to accomplish a desired result and so integrated with the use of a legal or commercial conception that the proper standard of infringement is one which will protect as far as possible the copyrighted language and yet allow free use of the thought beneath the language. The evidence here shows that Continental in so far as it has used the language of Beardsley’s forms has done so only as incidental to its use of the underlying idea. *Chautauqua School of Nursing v. National School of Nursing*, 2 Cir., 238 F. 151. In so doing it has not infringed. *Continental Cas. Co. v. Beardsley*, 253 F.2d 702, 705-706 (2dCir. 1958), *cert. den.*, 358 U.S. 816 (1958).

#### *Morrissey*

In 1967, a U.S. Court of Appeals heard a copyright infringement case involving rules for a contest for purchasers of soap. The plaintiff successfully argued that his rules were similar to those adopted by a soap company for its contest, but the court held that the rules were not copyrightable, because there was essentially only one way to express the rules. The final two paragraphs of the appellate opinion say:

Nonetheless, we must hold for the defendant. When the uncopyrightable subject matter is very narrow, so that ‘the topic necessarily requires,’ *Sampson & Murdock Co. v. Seaver-Radford Co.*, 1 Cir., 1905, 140 F. 539, 541; cf. Kaplan, AN UNHURRIED VIEW OF COPYRIGHT, 64-65 (1967), if not only one form of expression, at best only a limited number, to permit copyrighting would mean that a party or parties, by copyrighting a mere handful of forms, could exhaust all possibilities of future use of the substance. In such circumstances it does not seem accurate to say that any particular form of expression comes from the subject matter. However, it is necessary to say that the subject matter would be appropriated by permitting the copyrighting of its expression. We cannot recognize copyright as a game of chess in which the public can be checkmated. Cf. *Baker v. Selden*, *supra*.

Upon examination the matters embraced in [contest] Rule 1 are so straightforward and simple that we find this limiting principle to be applicable. Furthermore, its operation need not await an attempt to copyright all possible forms. It cannot be only the last form of expression which is to be condemned, as completing defendant’s exclusion from the substance. Rather, in these circumstances, we hold that copyright does not extend to the subject matter at all, and plaintiff cannot complain even if his particular expression was deliberately adopted.

*Morrissey v. Procter & Gamble Co.*, 379 F.2d 675, 678-679 (1stCir. 1967).

Morrissey had the idea of using Social Security numbers to uniquely identify participants in a contest. However, Morrissey was *not* able to use his copyright on the contest rules to prevent the soap company from copying his idea. Perhaps, Morrissey's lawyer should have argued the case under an unfair competition or misappropriation theory, instead of using copyright law.

*Morrissey* in 1967 provides a clear statement of what later became known as the merger doctrine. The next case in the evolution of the merger doctrine, *Rosenthal Jewelry v. Kalpakian* in 1971, clearly established the doctrine.

### *Rosenthal Jewelry v. Kalpakian*

In 1971, a U.S. Court of Appeals in California wrote a landmark decision, of which the final paragraph is a clear expression and explanation of the merger doctrine:

When the 'idea' and its 'expression' are thus inseparable, copying the 'expression' will not be barred, since protecting the 'expression' in such circumstances would confer a monopoly of the 'idea' upon the copyright owner free of the conditions and limitations imposed by the patent law. *Baker v. Selden*, 101 U.S. 99, 103, 25 L.Ed. 841 (1879); *Morrissey v. Procter & Gamble Co.*, 379 F.2d 675, 678-679 (1st Cir. 1967); *Crume v. Pacific Mut. Life Ins. Co.*, 140 F.2d 182, 184 (7th Cir. 1944). See also *Continental Cas. Co. v. Beardsley*, 253 F.2d 702, 705-706 (2d Cir. 1958).

*Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971).

Many subsequent cases recognized that *Rosenthal* had described what is now known as the merger doctrine, amongst which the following are notable:

- *Atari, Inc. v. North American Philips Consumer Electronics Corp.*, 672 F.2d 607, 616 (7th Cir. 1982) ("A related concept is that of idea-expression unity: where idea and expression are indistinguishable, the copyright will protect against only identical copying. *Krofft*, 562 F.2d at 1167-68. *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738 (9th Cir. 1971), presents a good example and discussion of this limitation."), *cert. den.*, 459 U.S. 880 (1982);
- *Apple Computer, Inc. v. Franklin Computer Corp.*, 545 F.Supp. 812, 823 (D.Pa. 1982)<sup>54</sup> ("Defendants argue that the programmed ROM is an object that merges idea and expression to the point they are indistinguishable, see *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971), or merges its utilitarian function and expressive purpose so that they too are inseparable, ...."), *rev'd*, 714 F.2d 1240 (3d Cir. 1983), *cert. dismissed*, 464 U.S. 1033 (1984);
- *Digital Communications Associates, Inc. v. Softklone Distributing Corp.*, 659 F.Supp. 449, 457 (N.D.Ga. 1987) ("... as indicated by the analysis in *Baker v. Selden*, [sic] where an idea has only one 'necessary' form of expression, the idea and its expression 'merge.' See, e.g., *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738 (9th Cir. 1971) ....");

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<sup>54</sup> *Apple Computer v. Franklin* contains the first mention in any reported judicial opinion of the word "merger" in expressing this doctrine in copyright law.

- *Concrete Machinery Co., Inc. v. Classic Lawn Ornaments, Inc.*, 843 F.2d 600, 606 (1stCir. 1988) (citing *Rosenthal* about merger);
- *Johnson Controls, Inc. v. Phoenix Control Systems, Inc.*, 886 F.2d 1173, 1175 (9thCir. 1989) (“Where an idea and the expression ‘merge,’ or are ‘inseparable,’ the expression is not given copyright protection. *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9thCir. 1971).”);
- *Kern River Gas Transmission Co. v. Coastal Corp.*, 899 F.2d 1458, 1463 (5thCir. 1990) (quoting *Rosenthal* about merger), *cert. den.*, 498 U.S. 952 (1990);
- *Mason v. Montgomery Data, Inc.*, 967 F.2d 135, 138 (5thCir. 1992) (“In some cases, however, it is so difficult to distinguish between an idea and its expression that the two are said to merge. Thus, when there is essentially only one way to express an idea, ‘copying the ‘expression’ will not be barred, since protecting the ‘expression’ in such circumstances would confer a monopoly of the ‘idea’ upon the copyright owner free of the conditions and limitations imposed by the patent law.” [*Rosenthal v. Kalpakian*, 446 F.2d] at 742.”);
- *Computer Associates Intern., Inc. v. Altai, Inc.*, 982 F.2d 693, 708 (2dCir. 1992) (citing *Rosenthal* about merger);
- *Gates Rubber Co. v. Bando Chemical Industries, Ltd.*, 9 F.3d 823, 838 (10thCir. 1993) (citing *Rosenthal* about merger);
- *Rubin v. Binary Arts Corp.*, Not Reported in F.Supp.2d, 1998 WL 917797 at \*2 (N.D.Cal. 1998) (“This so-called ‘merger doctrine’ was most clearly expressed by the Ninth Circuit in *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971).”);
- *CDN Inc. v. Kapes*, 197 F.3d 1256, 1261 (9thCir. 1999) (quoting *Rosenthal* about merger);
- *Sportsmans Warehouse, Inc. v. Fair*, 576 F.Supp.2d 1175, 1195 (D.Colo. 2008) (“... *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738 (9th Cir. 1971) (finding merger of the idea and expression ....)”), *appeal dismissed*, (10thCir. 2009).

#### *Affiliated Hospital Products v. Merdel Game*

In 1975, U.S. Court of Appeals in New York City affirmed the trial judge's dismissal of the claim of copyright infringement of rules for a game that was in the public domain. The final two paragraphs say:

Finally, the trial judge dismissed Affiliated's claim of infringement of its copyrighted rulebook for Carroms and related games. Since the introduction of its 100 Play Game Board in 1961, Merdel has published a similar rulebook, which contains the rules for 100 games. In the preparation of the rulebook, Merdel's employee testified that he had used Affiliated's rulebook and that the changes that had been made were made for clarification. Affiliated at trial presented a thorough textual analysis of the two books in an attempt to demonstrate the frequent instances of identical wording. It is clear, however, from an examination of the two rulebooks that Merdel's copying was not slavish, and that Merdel made a good faith attempt to improve upon, and to clarify, the presentation of the rules.



The issue that is squarely raised, therefore, is to what extent a copyright holder can prevent a competitor from publishing a similar rulebook to the copyrighted rulebook. No claim is of course made that appellant can protect the game of Caroms or its variations which are in the public domain. The rules of the game are perforce in the public domain as well as the game itself. Affiliated's copyright only protects Affiliated's arrangement of the rules and the manner of their presentation, and not their content. Here, however, **the simplicity of the games makes the subject matter extremely narrow, and the distinction between substance and arrangement blurs.**<sup>55</sup> On these facts we hold that Merdel, although admitting to access and use of Affiliated's work, did not infringe Affiliated's copyright. Merdel did not copy Affiliated's rules verbatim, and indeed its changes enhanced the clarity of the rules. This conclusion, based on the facts here present, in no way affects the general rule, applicable in other situations, that upon a showing of access to copyrighted material, an alleged infringer cannot escape liability for his appropriation through the introduction of slight changes. [FN11] *Orgel v. Clark Boardman Co.*, 301 F.2d 119 (2 Cir.), *cert. denied*, 371 U.S. 817, 83 S.Ct. 31, 9 L.Ed.2d 58 (1962). We are encouraged in this conclusion through recognition of the fact that a contrary result would prevent publication of the rules of any simple game in the public domain unless the second entrant in the field developed his rules solely through watching the game being played; a result which would afford protection to the game itself. [footnote omitted]

FN11. For a similar result on the issue of copyrightability of contest rules, see *Morrissey v. Proctor & Gamble Co.*, 379 F.2d 675 (1 Cir. 1967).

*Affiliated Hospital Products, Inc. v. Merdel Game Mfg. Co.*, 513 F.2d 1183, 1188-1189 (2dCir. 1975).

*Apple Computer, Inc. v. Franklin Computer Corp.*

As shown above, the doctrine of the idea-expression merger in copyright law can be traced to copyrights for contracts, specifically insurance forms and the contest form in *Morrissey*. However, the first reported copyright case to explicitly use the words *merge*, *merger*, *merged*, etc., is a 1982-83 case on computer programs, *Apple Computer, Inc. v. Franklin Computer Corp.*, 545 F.Supp. 812, n.6 and 823 (D.Penn. 1982), *rev'd*, 714 F.2d 1240, 1252-1253 (3dCir. 1983). The use of the word *merge* is thus a relatively recent development in copyright law.

In a landmark case on the copyrightability of computer programs, the U.S. Court of Appeals in Pennsylvania wrote:

Franklin's other challenge to copyright of operating system programs relies on the line which is drawn between ideas and their expression. *Baker v. Selden* remains a benchmark in the law of copyright for the reading given it in *Mazer v. Stein*, *supra*, where the Court stated, "Unlike a patent, a copyright gives no exclusive right to the art disclosed; protection is given only to the expression of the idea — not the idea itself." 347 U.S. at 217, 74 S.Ct. at 470 (footnote omitted).

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<sup>55</sup> Boldface added by Standler to emphasize the doctrine of merger.

The expression/idea dichotomy is now expressly recognized in section 102(b) which precludes copyright for “any idea.” This provision was not intended to enlarge or contract the scope of copyright protection but “to restate ... that the basic dichotomy between expression and idea remains unchanged.” H.R.Rep. No. 1476, supra, at 57, reprinted in 1976 U.S.CODE CONG. & AD.NEWS at 5670. The legislative history indicates that section 102(b) was intended “to make clear that the expression adopted by the programmer is the copyrightable element in a computer program, and that the actual processes or methods embodied in the program are not within the scope of the copyright law.” *Id.*

Many of the courts which have sought to draw the line between an idea and expression have found difficulty in articulating where it falls. See, e.g., *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930) (L. Hand, J.); see discussion in 3 NIMMER ON COPYRIGHT § 13.03[A]. We believe that in the context before us, a program for an operating system, the line must be a pragmatic one, which also keeps in consideration “the preservation of the balance between competition and protection reflected in the patent and copyright laws”. *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971). As we stated in *Franklin Mint Corp. v. National Wildlife Art Exchange, Inc.*, 575 F.2d 62, 64 (3d Cir.), cert. denied, 439 U.S. 880, 99 S.Ct. 217, 58 L.Ed.2d 193 (1978), “Unlike a patent, a copyright protects originality rather than novelty or invention.” In that opinion, we quoted approvingly the following passage from *Dymow v. Bolton*, 11 F.2d 690, 691 (2d Cir. 1926):

Just as a patent affords protection only to the means of reducing an inventive idea to practice, so the copyright law protects the means of expressing an idea; and it is as near the whole truth as generalization can usually reach that, *if the same idea can be expressed in a plurality of totally different manners, a plurality of copyrights may result*, and no infringement will exist.

(emphasis added).

We adopt the suggestion in the above language and thus focus on whether the idea is capable of various modes of expression. If other programs can be written or created which perform the same function as an Apple's operating system program, then that program is an expression of the idea and hence copyrightable. In essence, this inquiry is no different than that made to determine whether the expression and idea have **merged**,<sup>56</sup> which has been stated to occur where there are no or few other ways of expressing a particular idea. See, e.g., *Morrissey v. Procter & Gamble Co.*, 379 F.2d 675, 678-79 (1st Cir. 1967); *Freedman v. Grolier Enterprises, Inc.*, 179 U.S.P.Q. 476, 478 (S.D.N.Y. 1973) (“[c]opyright protection will not be given to a form of expression necessarily dictated by the underlying subject matter”); CONTU Report at 20.

The district court made no findings as to whether some or all of Apple's operating programs represent the only means of expression of the idea underlying them. Although there seems to be a concession by Franklin that at least some of the programs can be rewritten, we do not believe that the record on that issue is so clear that it can be decided at the appellate level. Therefore, if the issue is pressed on remand, the necessary finding can be made at that time.

Franklin claims that whether or not the programs can be rewritten, there are a limited “number of ways to arrange operating systems to enable a computer to run the vast body of Apple-compatible software”, Brief of Appellee at 20. This claim has no pertinence to either the idea/expression dichotomy or **merger**. The idea which may **merge** with the expression, thus making the copyright unavailable, is the idea which is the subject of the expression. The

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<sup>56</sup> Boldface added by Standler to each of the uses of *merger* in this opinion.

idea of one of the operating system programs is, for example, how to translate source code into object code. If other methods of expressing that idea are not foreclosed as a practical matter, then there is no **merger**. Franklin may wish to achieve total compatibility with independently developed application programs written for the Apple II, but that is a commercial and competitive objective which does not enter into the somewhat metaphysical issue of whether particular ideas and expressions have **merged**.

In summary, Franklin's contentions that operating system programs are per se not copyrightable is unpersuasive. The other courts before whom this issue has been raised have rejected the distinction. ....

*Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d 1240, 1252-1253 (3d Cir. 1983), *cert. dismissed*, 464 U.S. 1033 (1984).

*Educational Testing Services v. Katzman*

In 1986, a U.S. Court of Appeals wrote:

Defendants argue that the principle of merger between the idea and expression is applicable in this case because the idea or subject of the material at issue can be expressed only in a limited number of ways. The merger principle, when raised legitimately, is a variation of the idea/expression dichotomy that we analyzed in *Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d 1240, 1252-54 (3d Cir. 1983), *cert. dismissed*, 464 U.S. 1033, 104 S.Ct. 690, 79 L.Ed.2d 158 (1984). When the idea and the expression of the idea coincide, then the expression will not be protected in order to prevent creation of a monopoly on the underlying "art". See M.B. Nimmer, NIMMER ON COPYRIGHT § 2.18[c] at 2-202 to -204 (1985). As we stated in *Apple Computer*, an expression will be found to be merged into the idea when "there are no or few other ways of expressing a particular idea." 714 F.2d at 1253. See also *Sid & Marty Krofft Television Products, Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1167-68 (9th Cir. 1977). It is on the basis of the merger principle that copyright has been denied to utilitarian ideas, such as forms. *Brown Instrument Co. v. Warner*, 161 F.2d 910 (D.C.Cir. 1947), *cert. denied*, 332 U.S. 801, 68 S.Ct. 101, 92 L.Ed. 380 (1947); *M.M. Business Forms Corp. v. Uarco*, 472 F.2d 1137 (6th Cir. 1973).

However, in *Apple* we explained that "if the same idea can be expressed in a plurality of totally different manners, a plurality of copyrights may result." 714 F.2d at 1253 (quoting *Dymow v. Bolton*, 11 F.2d 690, 691 (2d Cir. 1926)). While the limited number of ways a concept can be addressed may be relevant to the extent of copying permitted, it does not render an original expression per se incapable of copyright protection. As we stated in *Apple Computer*, "If other methods of expressing that idea are not foreclosed as a practical matter, then there is no merger." 714 F.2d at 1253.

*Educational Testing Services v. Katzman*, 793 F.2d 533, 539 (3d Cir. 1986).

*Kregos v. Associated Press*

In 1991, the U.S. Court of Appeals in New York City wrote:

The fundamental copyright principle that only the expression of an idea and not the idea itself is protectable, see *Mazer v. Stein*, 347 U.S. 201, 217, 74 S.Ct. 460, 470, 98 L.Ed. 630 (1954), has produced a corollary maxim that even expression is not protected in those instances where there is only one or so few ways of expressing an idea that protection of the expression would effectively accord protection to the idea itself. See *Educational Testing Services v. Katzman*, 793 F.2d 533, 539 (3d Cir. 1986); *Toro Co. v. R & R Products Co.*, 787 F.2d 1208, 1212 (8th Cir. 1986). Our Circuit has considered this so-called “merger” doctrine in determining whether actionable infringement has occurred, rather than whether a copyright is valid, see *Durham Industries, Inc. v. Tomy Corp.*, 630 F.2d 905, 916 (2d Cir. 1980), an approach the Nimmer treatise regards as the “better view.” See 3 NIMMER ON COPYRIGHT § 13.03[B][3] at 13-58 (1990). Assessing merger in the context of alleged infringement will normally provide a more detailed and realistic basis for evaluating the claim that protection of expression would inevitably accord protection to an idea.

Determining when the idea and its expression have merged is a task requiring considerable care: if the merger doctrine is applied too readily, arguably available alternative forms of expression will be precluded; if applied too sparingly, protection will be accorded to ideas. Recognizing this tension, courts have been cautious in applying the merger doctrine to selections of factual information, see *Educational Testing Services*, 793 F.2d at 540 (doctrine inapplicable to selection of test questions); *Toro Co.*, 787 F.2d at 1212 (doctrine inapplicable to selection of data for numbering parts), though the doctrine has been applied on occasion to selections of categories of data, see, e.g., *Matthew Bender & Co. v. Kluwer Law Book Publishers, Inc.*, 672 F.Supp. 107, 110 (S.D.N.Y. 1987) (categories of data concerning personal injury awards).

In one sense, every compilation of facts can be considered to represent a merger of an idea with its expression. Every compiler of facts has the idea that his particular selection of facts is useful. If the compiler's idea is identified at that low level of abstraction, then the idea would always merge into the compiler's expression of it. Under that approach, there could never be a copyrightable compilation of facts.<sup>57</sup> However, if the idea is formulated at a level of abstraction above the particular selection of facts the compiler has made, then merger of idea and expression is not automatic. Even with an idea formulated at a somewhat high level of abstraction, circumstances might occur where the realistic availability of differing expressions is so drastically limited that the idea can be said to have merged in its expression. *Kregos v. Associated Press*, 937 F.2d 700, 705-706 (2d Cir. 1991).

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<sup>57</sup> About three years later, another panel of the Second Circuit suggested that “of facts” could be omitted, because the sentence also applies to compilations of ideas. *CCC v. Maclean Hunter*, 44 F.3d 61, 71, n. 20 (2d Cir. 1994).

*CCC Information Services v. Maclean Hunter Market Reports*

Maclean Hunter published used car values in its RED BOOK. CCC republished information from the RED BOOK in CCC's computer database. CCC sought declaratory judgment that CCC had no copyright liability to Maclean Hunter. The trial court, in an unpublished opinion, granted summary judgment to CCC. In 1994, Judge Leval of the U.S. Court of Appeals of the Second Circuit partly reversed the trial court's decision.

CCC's strongest argument is that it took nothing more than ideas, for which the copyright law affords no protection to the author. According to this argument, (1) each entry in the Red Book expresses the authors' idea of the value of a particular vehicle; (2) to the extent that "expression" is to be found in the Red Book's valuations, such expression is indispensable to the statement of the idea and therefore merges with the idea, so that the expression is also not protectible, and; (3) because each of Red Book's valuations could freely be taken without infringement, all of them may be taken without infringement. This was one of the alternate bases of the district court's ruling in CCC's favor.

The argument is not easily rebutted, for it does build on classically accepted copyright doctrine. It has been long accepted that copyright protection does not extend to ideas; it protects only the means of expression employed by the author. As the Supreme Court stated in *Mazer v. Stein*, 347 U.S. 201, 74 S.Ct. 460, 98 L.Ed. 630 (1954),

Unlike a patent, a copyright gives no exclusive right to the art disclosed; protection is given only to the expression of the idea — not the idea itself. Thus, in *Baker v. Selden*, 101 U.S. 99 [25 L.Ed. 841] [ (1879) ], the Court held that a copyrighted book on a peculiar system of bookkeeping was not infringed by a similar book using a similar plan which achieved similar results where the alleged infringer made a different arrangement of the columns and used different headings.

*Id.* at 217, 74 S.Ct. at 470 (footnote omitted).

It is also well established that, in order to protect the immunity of ideas from private ownership, when the expression is essential to the statement of the idea, the expression also will be unprotected, so as to insure free public access to the discussion of the idea. See *Kregos*, 937 F.2d at 705; *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971) ("When the 'idea' and its 'expression' are ... inseparable, copying the 'expression' will not be barred, since protecting the 'expression' in such circumstances would confer a monopoly of the 'idea' upon the copyright owner free of the conditions and limitations imposed by the patent law.").[FN9]

FN9. For more extensive discussions of the merger doctrine, see William F. Patry, *COPYRIGHT LAW AND PRACTICE*, 312-325 (1994); Melville B. Nimmer & David Nimmer, *NIMMER ON COPYRIGHT*, § 13.03[A]-[B] (1994).

*CCC Information Services, Inc. v. Maclean Hunter Market Reports, Inc.*, 44 F.3d 61, 68 (2d Cir. 1994), *cert. den.*, 516 U.S. 817 (1995).

The U.S. Court of Appeals in *CCC* noted a conflict between two goals of copyright law, in a rare judicial discussion of the reasons behind the merger doctrine:

The fundamental principle of copyright, as expressed in the Copyright Clause of the Constitution, is to promote the advance of knowledge by granting authors exclusive rights to their writings.[FN10] As the Supreme Court said in *Mazer*, “The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in ‘Science and useful Arts.’ ” 347 U.S. at 219, 74 S.Ct. at 471. See also *Nimmer* at § 1.03[A]. The financial incentives to authors consist of exclusive rights to their writings, that may be sold or licensed for money, so that authors may earn a living from the creations that benefitted the public.

FN10. This essential formulation is found in England's Statute of Anne of 1710, which conceived the Anglo-American copyright. It is entitled, “An Act for the Encouragement of Learning, by Vesting the Copies of Printed Books in the Authors or Purchasers of Such Copies.” The statute is reprinted in *Patry*, *supra*, at 1461-64.

From an early time, however, courts, taking a different approach from that taken in the patent law, developed a theory which almost directly contradicted the original theory of copyright. The new theory was that ideas are too important to the advancement of knowledge to permit them to be under private ownership, and that open public debate, which is essential to a free democratic society, requires free access to the ideas to be debated.[FN11] See *Patry*, *supra*, at 122-23, 319, *Nimmer* at § 1.10[B] 1-71 to -74, 78-79, § 13.03[B] at 13-69 to -70. Judicially created doctrine thus led to a drastic limitation on the scope of copyright protection.[FN12] Ideas were not to be protected; only the manner of their “expression.” This limitation came to be known as the “idea-expression” dichotomy.

FN11. As *Nimmer* explains:

The policy rationale underlying the Act's exclusion of ideas from copyright protection is clear. To grant property status to a mere idea would permit withdrawing the idea from the stock of materials that would otherwise be open to other authors, thereby narrowing the field of thought open for development and exploitation. This effect, it is reasoned, would hinder rather than promote the professed purpose of the copyright laws, i.e., “the progress of science and useful arts.”

*Nimmer* § 13.03[B] at 13-69 to -70 (footnotes omitted).

FN12. This doctrine is codified in section 102(b) of the Copyright Act, which provides that “[i]n no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.” 17 U.S.C.A. § 102(b) (West 1977).

The contradiction between these imperatives, one calling for the protection of creations that will advance the progress of knowledge, the second requiring that these same creations be free of protection, has understandably given rise to bewildering problems of interpretation as to whether copying has been of protected expression or of the unprotected ideas underlying the expression.[FN13] These difficulties led Judge Learned Hand to discourse in *Nichols v.*

*Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930), *cert. denied*, 282 U.S. 902, 51 S.Ct. 216, 75 L.Ed. 795 (1931), that takings from a protected source such as a copyrighted play can occur at varying levels of abstraction from the concrete realization of the original, and that the more remote in abstraction the taking is from the original, the less likely that it will constitute a taking of protected expression.[FN14] This has often been referred to as Hand's "abstractions test"; in fact, as Judge Hand and others have noted,[FN15] it is no test at all, but merely a way of perceiving the problem.[FN16]

FN13. As Judge Walker pointed out in *Computer Assoc. Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 696 (2d Cir. 1992), "the copyright law seeks to establish a delicate equilibrium. On the one hand, it affords protection to authors as an incentive to create, and, on the other, it must appropriately limit the extent of that protection so as to avoid the effects of monopolistic stagnation. In applying the federal act to new types of cases, courts must always keep this symmetry in mind."

FN14. His classic and oft-repeated formula was that:

Upon any work, and especially upon a play, a great number of patterns of increasing generality will fit equally well, as more and more of the incident is left out. The last may perhaps be no more than the most general statement of what the play is about, and at times might consist only of its title; but there is a point in this series of abstractions where they are no longer protected, since otherwise the playwright could prevent the use of his "ideas," to which, apart from their expression, his property is never extended.

45 F.2d at 121.

FN15. "[A]s soon as literal appropriation ceases to be the test, the whole matter is necessarily at large, so that ... the decisions cannot help much in a new case." *Nichols*, 45 F.2d at 121. See also *Nash v. CBS, Inc.*, 899 F.2d 1537, 1540 (7th Cir. 1990) ("Hand's insight is not a test at all. It is a clever way to pose the difficulties that require courts to avoid either extreme of the continuum of generality." (Easterbrook, J.)).

FN16. Hand himself, writing thirty years after his above-quoted formulation of the problem, eschewed any pithy solution of it. In his last copyright case, *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487 (2d Cir. 1960), he opined that: "Obviously, no principle can be stated as to when an imitator has gone beyond copying the 'idea,' and has borrowed its 'expression.' Decisions must therefore inevitably be ad hoc." *Id.* at 489. Thirty years after that, Judge Keeton wrote: "It seems the better part of wisdom, if not valor, not to press the search for a suitable bright-line test ... where Learned Hand, even after decades of experience in judging, found none." *Lotus Dev. Corp. v. Paperback Software Int'l*, 740 F.Supp. 37, 60 (D.Mass. 1990). See also Patry, *supra*, at 320 (dangerous to attempt to formulate broad rules in this area).

This conflict between these contradictory thrusts recurs at the level of several more particular applications of the copyright law. Among them is the issue raised by this appeal of the protection, if any, to be accorded to compilations.[FN17] For if CCC's argument prevails, for reasons explained below, virtually nothing will remain of the protection accorded by the statute to compilations, notwithstanding the express command of the copyright statute.

FN17. Another is the issue of the protection to be afforded to computer programs, as to which the recently conferred statutory protection is not easily reconciled with the judge-made, and statutorily adopted, principle that copyright protection does not “extend to any idea, procedure, process [or] system.” 17 U.S.C. § 102(b). It is difficult to say what a computer program is, if not an idea, procedure, process or system. See generally, *Computer Assoc. Int'l, Inc. v. Altai*, 982 F.2d at 703-07.

*CCC Information Services, Inc. v. Maclean Hunter Market Reports, Inc.*, 44 F.3d 61, 68-70 (2dCir. 1994).

The Court of Appeals in *CCC*, in their footnote 17, explicitly mentioned a troubling aspect about the idea-expression dichotomy. If one literally interprets 17 U.S.C. § 102(b), it would seem that computer programs are not copyrightable, because the instructions in a program are at least one of the following: “idea, procedure, process, system, method of operation”. But, the copyright statute elsewhere specifically allows copyright on computer programs, the Copyright Office registers copyrights on computer programs, and U.S. Courts of Appeals have repeatedly enforced copyrights on computer programs. The difference between the legal theory (here, the idea-expression dichotomy) and legal practice (the reality that computer programs are, and should be, copyrightable) suggest to me that legal theory is wrong. Perhaps the time has come to abandon 17 U.S.C. § 102(b).

#### *Yankee Candle v. Bridgewater Candle*

The U.S. Court of Appeals in Massachusetts had a long discussion of the law of the idea-expression dichotomy and the merger doctrine at 259 F.3d 25, 33-36. The Court of Appeals explained the law of merger in this case involving labels for scented candles:

The district court found that for six of the nine labels in question, there was “only one way to express the idea of these fruits and flowers: by depicting their likeness.” And although the district court held that the remaining three labels (French Vanilla, Spiced Apple/Apple Pie, and Cinnamon/Cinnamon Rolls) expressed more subtle ideas open to greater possibilities of representation, even for those depictions “the idea merge[d] with the expression” and therefore allowed for few choices of subject matter. As a result, the district court held that, as a matter of law, there could be no infringement unless Bridgewater's photographs were “nearly identical” to Yankee's. *Yankee I*, 99 F.Supp.2d at 145-46. Yankee claims that the merger doctrine does not apply because infinite ways exist to depict a fruit, flower, or common flavor such as french vanilla. Again, we agree with the district court's approach.

In *Concrete Machinery*, we explained the rationale behind the merger doctrine:

Some ideas admit of only a limited number of expressions. When there is essentially only one way to express an idea, the idea and its expression are inseparable and copyright is no bar to copying that expression. [Even] [w]hen the idea and its expression are not completely inseparable, there may still be only a limited number of ways of expressing the idea.

[*Concrete Machinery Co., Inc. v. Classic Lawn Ornaments, Inc.*, 843 F.2d 600 (1stCir. 1988).] 843 F.2d at 606 (internal citations omitted). In such cases, the plaintiff has the heavy



burden of showing “near identity” between the works at issue. *Id.* at 606-07 (citing *Sid & Marty Krofft Television v. McDonald's Corp.*, 562 F.2d 1157, 1167 (9th Cir. 1977), and *Flag Fables Inc. v. Jean Ann's Country Flags & Crafts, Inc.*, 730 F.Supp. 1165, 1171 (D.Mass. 1990)). This heightened showing “is necessary because, as idea and expression merge, fewer and fewer aspects of a work embody a unique and creative expression of the idea; a copyright holder must then prove substantial similarity to those few aspects of the work that are expression not required by the idea.” *Id.* at 607 (citing *Universal Athletic Sales Co. v. Salkeld*, 511 F.2d 904, 908 (3d Cir. 1975)).

In general, the merger doctrine is most applicable where the idea and the expression are of items found in nature, or are found commonly in everyday life. See, e.g., *Designer's View*, 764 F.Supp. at 1478. For example, we invoked the merger doctrine in *Concrete Machinery* where the idea at issue was a “realistic-looking life size deer.” 843 F.2d at 607; see also *Leigh*, 212 F.3d at 1214-15 (photograph of statue in public domain); *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738 (9th Cir. 1971) (pin of a “jeweled bee”). As the district court found, six of the labels at issue were fruits and flowers found in nature; the remaining three were representations of common flavors. For the six natural items, there were few associated expressions, of which the most obvious was a realistic representation of the fruit or flower at issue. For the three flavors, the most obvious expression was a realistic representation of a food commonly associated with that flavor.[FN6] Because the merger doctrine applies, the copyright on Yankee's labels does not prevent Bridgewater from using the same subject matter on its labels, even if the genesis for Bridgewater's choice of subject matter was Yankee's labels.

FN6. It is true that more than one food may meet this definition: for example, cinnamon can be represented by cinnamon sticks, cinnamon rolls, or cinnamon toast. However, all that is required for application of the merger doctrine is that there be a sharply limited number of choices. We think that in the case of everyday flavors such as french vanilla, cinnamon, and spiced apple, such is the case.

The merger doctrine does not, however, allow the identical reproduction of photographs of realistic objects when there are sufficient details in those photographs to make them unique. *Concrete Mach.*, 843 F.2d at 609-10 (finding possibility of infringement of concrete deer based on stylized posture and facial expression). If Bridgewater had scanned Yankee's labels into a computer and reproduced them exactly, it would have certainly infringed Yankee's copyrights on those labels. Even if Bridgewater had taken its own photographs, but had arranged the subjects in a “nearly identical” manner to that of Yankee, a jury could have found the requisite showing of substantial similarity to support copyright infringement. Moreover, although Yankee does not enjoy copyright protection on the subject matter of its photographs because of the merger doctrine, its choices as to lighting, background, angle and positioning are protected. *Leigh*, 212 F.3d at 1215; *Rogers v. Koons*, 960 F.2d 301, 307 (2d Cir. 1992). *Yankee Candle Co., Inc. v. Bridgewater Candle Co., LLC*, 259 F.3d 25, 35-37 (1st Cir. 2001).

For another judicial opinion that is protective of ideas in nature, see *Satava v. Lowry*, 323 F.3d 805, 813 (9th Cir. 2003), *cert. den.*, 540 U.S. 983 (2003), quoted at page 31, above.

*Veeck v. Southern Building Code*

Building codes adopted by state or local governments are *not* copyrightable subject matter, because they are law.<sup>58</sup> The majority opinion of the en banc U.S. Court of Appeals for the Fifth Circuit wrote:

Veeck copied the building code of the towns of Anna and Savoy, Texas, based on their adoption of a version of the SBCCI model code. The codes are “facts” under copyright law. They are the unique, unalterable expression of the “idea” that constitutes local law. Courts routinely emphasize the significance of the precise wording of laws presented for interpretation. See, e.g., *Consumer Product Safety Comm'n v. GTE Sylvania, Inc.*, 447 U.S. 102, 108, 100 S.Ct. 2051, 2056, 64 L.Ed.2d 766 (1980) (“[T]he starting point for interpreting a statute is the language of the statute itself.”). Judge Little, dissenting from the panel opinion in this case, observed that

... the merger doctrine is especially appropriate because other methods of expressing the idea are foreclosed. [citation omitted] An individual wishing to publish the text of a law cannot develop his own, unique version and still publish an authoritative copy.

*Veeck v. Southern Bldg. Code Cong. Int'l*, 241 F.3d 398, 416 (5th Cir. 2001) (Little, J., dissenting). It should be obvious that for copyright purposes, laws are “facts”: the U.S. Constitution is a fact; the Federal Tax Code and its regulations are facts; the Texas Uniform Commercial Code is a fact. Surely, in principle, the building codes of rural Texas hamlets are no less “facts” than the products of more august legislative or regulatory bodies. While the Supreme Court has not stated directly that laws are “facts,” it has broadly observed that, as with census data, “the same is true of all facts — scientific, historical, biographical and news of the day. ‘They may not be copyrighted and are part of the public domain available to every person.’” *Feist*, 499 U.S. at 348, 111 S.Ct. at 1289.

....

SBCCI and the dissent next urge the inapplicability of the merger doctrine because there are many possible ways to express model codes: both the multiplicity of building standards and the variety of ways to express those standards compel the conclusion that the ideas have not merged with their expression. Cf. *Mason*, 967 F.2d at 139 (rejecting merger because the idea embodied in the author's maps can be expressed in a variety of ways). What SBCCI and the dissent ignore, however, is the graphic merger of its model building codes with “the law” as enacted by Anna and Savoy, Texas. Veeck copied from SBCCI's model codes, 1994 edition, because those codes were transformed into the “fact” and “idea” of the towns' building codes. Veeck could not express the enacted law in any other way.

*Veeck v. Southern Bldg. Code Congress Intern., Inc.*, 293 F.3d 791, 801-802 (5th Cir. 2002) (en banc majority opinion), *cert. den.*, 537 U.S. 1043 (2002).

I am troubled by the majority opinion, because it takes the *idea-expression* merger rule and uses it in a situation involving *facts* and expression. While neither ideas nor facts are copyrightable, the rules for ideas and facts developed independently. As shown above, by the late 1800s it was well established that copyright did not protect ideas. The rule that copyright does not protect facts

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<sup>58</sup> Standler, No Copyright for Law in the USA, <http://www.rbs2.com/cgovt.pdf> , Jan 2009.

appears to originate in the 1910s, but was first accepted by the U.S. Supreme Court in 1985.<sup>59</sup> The rule that copyright does not protect facts affects only nonfiction works, while the rule that copyright does not protect ideas affects all works. My search of Westlaw in March 2009 shows no authority supporting a fact-expression merger, although such a merger is plausible. While judges are free to expand the common law, such expansion was *unnecessary* in *Veck*. In my opinion, the majority should have held that law (e.g., government regulations) is not copyrightable and stopped there, without mentioning the merger doctrine.

A dissenting judge in *Veck* wrote:

Libertarian advocates of freedom from essentially all copyright protection attempt to find a safe harbor in the merger doctrine as a last resort when they do not prevail on the idea/expression dichotomy. The merger doctrine, however, is a limited exception in copyright law, intended to shelter only those rare cases in which the “idea” is susceptible of more than one expression, but the number of possible expressions is so finite and small as to have effectively “merged” with the idea.[FN35] Similar to the general misconception of the idea/expression dichotomy, the widely misunderstood merger doctrine also depends on the level of abstraction at which the court defines the “idea” that is alleged to have merged with its expression.

FN35. See generally *CCC*, 44 F.3d [61] at 68 [(2dCir. 1994)]; NIMMER ON COPYRIGHT § 13.03[B][3] at 13-68-13-73.

*Veck v. Southern Building Code Congress Intern., Inc.*, 293 F.3d 791, 820-821 (5thCir. 2002) (Wiener, J., dissenting), *cert. den.*, 537 U.S. 1043 (2002).

*Danielson, Inc. v. Winchester-Conant Properties*

In 2003, the First Circuit held that the merger doctrine was not appropriate when a map showed the easiest and cheapest way of developing land, but other ways were possible.

It is axiomatic that, while “[n]o author may copyright his ideas or the facts he narrates,” an author may copyright the expression of those ideas. *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 556, 105 S.Ct. 2218, 85 L.Ed.2d 588 (1985); see 17 U.S.C. § 102(b). Sometimes, however, an idea can be expressed in so few ways that it “merges” with its expression, and the expression become uncopyrightable.

When the uncopyrightable subject matter is very narrow, so that the topic necessarily requires, if not only one form of expression, at best only a limited number ... the subject matter would be appropriated by permitting the copyrighting of its expression. We cannot recognize copyright as a game of chess in which the public can be checkmated. *Morrissey v. Procter & Gamble Co.*, 379 F.2d 675, 678-79 (1st Cir. 1967) (internal quotations and citations omitted); see *Concrete Mach. Co. v. Classic Lawn Ornaments Inc.*, 843 F.2d 600, 606-07 (1st Cir. 1988). For example, we have held that this doctrine of merger foreclosed copyright on rules for a sweepstakes contest which could be effectively communicated using only a limited number of verbal formulations, *Morrissey*, 379 F.2d at

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<sup>59</sup> Standler, Copyright Protection for Nonfiction or Compilations of Facts in the USA, <http://www.rbs2.com/cfact.pdf>, (22 Feb 2009).

679, and on pictures of fruits and flowers used on labels to indicate the scent of candles, *Yankee Candle Co. v. Bridgewater Candle Co.*, 259 F.3d 25, 35 (1st Cir. 2001).

WCP argues that the restrictive covenant means there is only one way to build on the land, and that the covenant drawings merge with that idea. This contention distorts the purpose of the merger doctrine. The doctrine aims to prevent the monopolization of facts or ideas that are present in nature; where ownership of the expression would remove such facts or ideas from the public domain, the doctrine disallows copyright. See *Yankee Candle*, 259 F.3d at 36 (“In general, the merger doctrine is most applicable where the idea and the expression are of items found in nature, or are found commonly in everyday life.”). Here, the restrictive covenant made one method of developing the site legally easier and cheaper than others, but it did not transform the covenant drawings into the only physically possible means to express ideas for such development. ....

*John G. Danielson, Inc. v. Winchester-Conant Properties, Inc.*, 322 F.3d 26, 42-43 (1st Cir. 2003).

### verbatim copying still prohibited

However, when there is identical (i.e., verbatim) copying, then the merger doctrine will *not* save a defendant from copyright infringement. See, e.g.,:

- *Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1168 (9th Cir. 1977) (“When idea and expression coincide, there will be protection against nothing other than identical copying of the work. When other defendants made jeweled bees from the same molds as plaintiffs, they were held liable. See *Herbert Rosenthal Jewelry Corp. v. Grossbardt*, 436 F.2d 315 (2d Cir. 1970). Therefore, the scope of copyright protection increases with the extent expression differs from the idea.”);
- *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 980 (2d Cir. 1980) (“A verbatim reproduction of another work, of course, even in the realm of nonfiction, is actionable as copyright infringement.”), *cert. den.*, 449 U.S. 841 (U.S. 1980);
- *Atari, Inc. v. North American Philips Consumer Electronics Corp.*, 672 F.2d 607, 616 (7th Cir. 1982) (“A related concept is that of idea-expression unity: where idea and expression are indistinguishable, the copyright will protect against only identical copying. *Krofft*, 562 F.2d at 1167-68.”), *cert. den.*, 459 U.S. 880 (1982);
- *Frybarger v. International Business Machines Corp.*, 812 F.2d 525, 530 (9th Cir. 1987) (“Furthermore, the mere indispensable expression of these ideas, based on the technical requirements of the videogame medium, may be protected only against virtually identical copying. *Atari*, 672 F.2d at 616; *Sid & Marty Krofft*, 562 F.2d at 1168. Indispensable expression is accorded only this slight protection because it is so close to the nonprotectible idea itself that ‘the expression provides nothing new or additional over the idea.’ *Id.* ....”);
- *Rachel v. Banana Republic, Inc.*, 831 F.2d 1503, 1507 (9th Cir. 1987) (“Such ‘indispensable expression’ of ideas may be protected only against virtually identical copying. *Frybarger*, 812 F.2d at 530.”);

- *Landsberg v. Scrabble Crossword Game Players, Inc.*, 736 F.2d 485, 488 (9thCir. 1984) (“Factual works are different [from fictional works]. Subsequent authors wishing to express the ideas contained in a factual work often can choose from only a narrow range of expression. .... Therefore, similarity of expression may have to amount to verbatim reproduction or very close paraphrasing before a factual work will be deemed infringed. 1 M. Nimmer, NIMMER ON COPYRIGHT, § 2.11[A]-[B] (1968).”), *cert. denied*, 469 U.S. 1037 (1984);
- *Applied Innovations, Inc. v. Regents of the University of Minnesota*, 876 F.2d 626, 636 (8thCir. 1989) (citing *Landsberg supra*);
- *Johnson Controls, Inc. v. Phoenix Control Systems, Inc.*, 886 F.2d 1173, 1175 (9thCir. 1989) (“Where an idea and the expression ‘merge,’ or are ‘inseparable,’ the expression is not given copyright protection. *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9thCir. 1971). In addition, where an expression is, as a practical matter, indispensable, or at least standard, in the treatment of a given idea, the expression is protected only against verbatim, or virtually identical copying. *Rachel v. Banana Republic, Inc.*, 831 F.2d 1503, 1507 (9thCir. 1987); *Frybarger*, 812 F.2d at 530.”);
- *Apple Computer, Inc. v. Microsoft Corp.*, 709 F.Supp. 925, 1021 (N.D.Cal. 1989) (“If the idea and the author's particular way of expressing that idea cannot be separated, under the concept of merger only identical copying of the expression is barred. See *Krofft*, 562 F.2d at 167-68. .... Merger means there is practically only one way to express an idea. But if technical or conceptual constraints limit the available ways to express an idea, even though there is more than one avenue of expression available, copyright law will abhor only a virtually-identical copy of the original. *Telemarketing Resources v. Symantec Corp.*, 12 USPQ2d 1991, 1989 WL 200350 (N.D.Cal. 1989), *aff'd in part as Brown Bag Software v. Symantec Corp.*, 960 F.2d 1465 (9th Cir. 1992).”), *aff'd*, 35 F.3d 1435, 1444 (9thCir. 1994) (“First, when an idea and its expression are indistinguishable, or ‘merged,’ the expression will only be protected against nearly identical copying. *Krofft*, 562 F.2d at 1167-68; *Kalpakian*, 446 F.2d at 742.”), *cert. den.*, 513 U.S. 1184 (1995);
- *Yankee Candle Co., Inc. v. Bridgewater Candle Co., LLC*, 259 F.3d 25, 36 (1stCir. 2001) (“The merger doctrine does not, however, allow the identical reproduction of photographs of realistic objects when there are sufficient details in those photographs to make them unique. *Concrete Mach.*, 843 F.2d [600] at 609-10 (finding possibility of infringement of concrete deer based on stylized posture and facial expression). If Bridgewater had scanned Yankee’s labels into a computer and reproduced them exactly, it would have certainly infringed Yankee’s copyrights on those labels. Even if Bridgewater had taken its own photographs, but had arranged the subjects in a ‘nearly identical’ manner to that of Yankee, a jury could have found the requisite showing of substantial similarity to support copyright infringement.”).
- *Calcar Advertising, Inc. v. American Isuzu Motors, Inc.*, unpublished, 2000 WL 1465916 at \*1 (9thCir. 2000) (“There are, however, only a limited number of ways in which the ideas contained in these digests and guides can be expressed. Therefore, infringement will be found only if the Isuzu Owner’s Manual Digests amount to a very close paraphrasing or verbatim reproduction of these aspects of the QuickTips guides. See *Landsberg v. Scrabble Crossword Game Players, Inc.*, 736 F.2d 485, 488 (9thCir. 1984).”).

The reasoning for prohibiting verbatim copying, even when idea and expression merged in the original, is simple:

The features of works that are covered by these limiting doctrines [including merger] are protected only from virtually identical copying, for this is the province of the ultimate free-rider, who makes a zero investment in creativity.

*Apple Computer, Inc. v. Microsoft Corp.*, 709 F.Supp. 925, 1022 (N.D.Cal. 1989), *aff'd*, 35 F.3d 1435 (9thCir. 1994), *cert. den.*, 513 U.S. 1184 (1995).

It makes sense that as there are fewer alternative ways of expression, then there needs to be a heightened standard for copyright infringement (e.g., verbatim instead of “substantially similar”, requiring longer passages of verbatim copying, or requiring very closely paraphrased material, etc.).

The same rule against verbatim copying of an entire article, or entire chapter in a book, appears in judicial decisions involving an alleged fair use defense.<sup>60</sup> Judges are properly hostile to defendants who make a verbatim copy of an entire copyrighted item, regardless of defendant’s excuse.

### **Expression of Idea Is Copyrightable**

Lawyers and judges who are not experts on copyright law have been confused by the subtle distinction between an idea and an expression of that idea. To clarify this distinction, I added this section on 7 April 2013. The well-established rule of law is: **While an *idea* is not copyrightable, an *expression of an idea* is copyrightable.**

- *Mazer v. Stein*, 347 U.S. 201, 217 (1954) (“Unlike a patent, a copyright gives no exclusive right to the art disclosed; protection is given only to the expression of the idea — not the idea itself.”);
- *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 547 (1985) (“In addition, no author may copyright facts or ideas. [17 U.S.C.] § 102. The copyright is limited to those aspects of the work — termed ‘expression’ — that display the stamp of the author’s originality.”);

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<sup>60</sup> See cases cited by Standler, Fair Use: No Excuse for Wholesale Copyright Infringement in the USA, <http://www.rbs2.com/unfair.pdf>, (Sep 2009).

See, for example, the following reported cases from the U.S. Courts of Appeals:

- *Dymow v. Bolton*, 11 F.2d 690, 691 (2dCir. 1926) (“... the copyright law protects the means of expressing an idea ....”);
- *Ansehl v. Puritan Pharmaceutical Co.*, 61 F.2d 131, 137-138 (8thCir. 1932) (“The plaintiff is not entitled to be protected in his ideas, but he is entitled to be protected in his expression or illustration of his ideas.”);
- *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 54 (2dCir. 1936) (Learned Hand, J.) (“... but it is convenient to define such a use by saying that others may ‘copy’ the ‘theme,’ or ‘ideas,’ or the like, of a work, though not its ‘expression.’ ”), *cert. denied*, 298 U.S. 669 (1936);
- *National Comics Publication v. Fawcett Publications*, 191 F.2d 594, 600 (2dCir. 1951) (Learned Hand, J.) (“The same result also follows from the fact that a copyright never extends to the ‘idea’ of the ‘work,’ but only to its ‘expression,’ ....”);
- *Rosemont Enterprises, Inc. v. Random House, Inc.*, 366 F.2d 303, 306 (2dCir. 1966) (“Furthermore, while the mode of expression employed by [author of articles appearing in 1954 LOOK magazine] is entitled to copyright protection, he could not acquire by copyright a monopoly in the narration of historical events.”), *cert. denied*, 385 U.S. 1009 (1967);
- *Universal Athletic Sales Co. v. Salkeld*, 511 F.2d 904, 906 (3dCir. 1975) (“A basic principle, easy to articulate but difficult to apply, is that the expression of an idea may be protected by copyright but the idea itself cannot.”), *cert. den.*, 423 U.S. 863 (1975);
- *Reyher v. Children’s Television Workshop*, 533 F.2d 87, 90 (2dCir. 1976) (“It is an axiom of copyright law that the protection granted to a copyrightable work extends only to the particular expression of an idea and never to the idea itself.”), *cert. den.*, 429 U.S. 980 (1976);
- *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 978 (2dCir. 1980) (“Hoehling, however, correctly rejoins that while ideas themselves are not subject to copyright, his ‘expression’ of his idea is copyrightable. [citing *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 54 (2dCir. 1936)]”), *cert. den.*, 449 U.S. 841 (1980);
- *Miller v. Universal City Studios, Inc.*, 650 F.2d 1365, 1368 (5thCir. 1981) (“It is well settled that copyright protection extends only to an author’s expression of facts and not to the facts themselves. [citations omitted]”);
- *Toro Co. v. R & R Products Co.*, 787 F.2d 1208, 1211 (8thCir. 1986) (“The case law embodying the idea/expression dichotomy, which traces its roots back to *Baker v. Selden*, 101 U.S. 99 (1880), holds that copyright protection extends only to the expression of a particular idea, not the idea itself. The doctrine is grounded both in a presumed legislative intent to grant an author a monopoly only in his expressions — not his ideas — and in the First Amendment interest in the free exchange of ideas. *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 105 S.Ct. 2219, 2228-31 (1985).”);

- *Whelan Associates, Inc. v. Jaslow Dental Laboratory, Inc.*, 797 F.2d 1222, 1234 (3dCir. 1986) (“It is axiomatic that copyright does not protect ideas, but only expressions of ideas.”), *cert. den.*, 479 U.S. 1031 (1987);
- *Regents of the University of Minnesota v. Applied Innovations, Inc.*, 685 F.Supp. 698, 707 (D.Minn. 1987) (“There is no copyright protection, however, for an idea, concept, principle, or discovery. *Mazer v. Stein*, 347 U.S. 201, 217-18, 74 S.Ct. 460, 470-71, 98 L.Ed. 630 (1954); *Baker v. Selden*, 101 U.S. (11 Otto) 99, 102-03, 25 L.Ed. 841 (1880). But there may be a valid copyright in an original form of expression of an idea, concept, or discovery. *Toro Co. v. R & R Products Co.*, 787 F.2d 1208, 1211 (8thCir. 1986).”), *aff’d*, 876 F.2d 626 (8thCir. 1989);
- *Kregos v. Associated Press*, 3 F.3d 656, 663 (2dCir. 1993) (“... a copyright does not protect an idea, but only the expression of an idea.”), *cert. den.*, 510 U.S. 1112 (1994);
- *Wildlife Exp. Corp. v. Carol Wright Sales, Inc.*, 18 F.3d 502, 507 (7thCir. 1994) (“In light of this goal the Copyright Act protects the expression of ideas, but exempts the ideas themselves from protection. 17 U.S.C. § 102(b); ....”);
- *MiTek Holdings, Inc. v. Arce Engineering Company, Inc.*, 89 F.3d 1548, 1556, n.19 (11thCir. 1996) (“MiTek seems to misapprehend the fundamental principle of copyright law that copyright does not protect an idea, but only the expression of the idea.”);
- *Attia v. Society of New York Hospital*, 201 F.3d 50, 54 (2dCir. 1999) (“A copyright thus protects not the author's ideas, but only her expression of them.”);
- *Cavalier v. Random House, Inc.*, 297 F.3d 815, 823 (9thCir. 2002) (“Copyright law only protects expression of ideas, not the ideas themselves.”);
- *Kohus v. Mariol*, 328 F.3d 848, 855 (6thCir. 2003) (“It is axiomatic, to begin with, that mere abstract ideas are not protectible, but the expression of an idea is. See *Mazer v. Stein*, 347 U.S. 201, 217 (1954) ....);
- *Rice v. Fox Broadcasting Co.*, 330 F.3d 1170, 1174 (9thCir. 2003) (“... ideas generally do not receive protection, only the expression of such ideas do. *Metcalfe*, 294 F.3d [1069] at 1074.”). Cited with approval in *Swirsky v. Carey*, 376 F.3d 841, 845, n.4 (9thCir. 2004) (“... it must be kept in mind that ideas by themselves are not subject to copyright protection; only the expression of ideas is. See *Rice I*, 330 F.3d [1170] at 1174.”);
- *Johnson v. Gordon*, 409 F.3d 12, 19 (1stCir. 2005) (“... copyright law protects original expressions of ideas but it does not safeguard either the ideas themselves or banal expressions of them.”);
- *JCW Investments, Inc. v. Novelty, Inc.*, 482 F.3d 910, 917 (7thCir. 2007) (“It is, of course, a fundamental tenet of copyright law that the idea is not protected, but the original expression of the idea is.”);



- *L.A. Printex Industries, Inc. v. Aeropostale, Inc.*, 676 F.3d 841, 849 (9thCir. 2012) (“Because copyright law protects expression of ideas, not ideas themselves, we distinguish protectible [sic] from unprotectible elements and ask only whether the protectible elements in two works are substantially similar.”);
- *Miller’s Ale House, Inc. v. Boynton Carolina Ale House*, 702 F.3d 1312, 1325, n.18 (11thCir. 2012) (“Notably, ‘copyright protection does not extend to ideas but only to particular expressions of ideas.’ *Oravec v. Sunny Isles Luxury Ventures, L.C.*, 527 F.3d 1218, 1224 (11thCir. 2008)”).

Many attorneys and judges have been confused by the subtle distinction between an *idea* and the *expression* of that idea. As explained in the cases cited above, the *expression* of an idea is copyrightable.

### Other Concerns plagiarism

Many professors and academic administrators who write a definition of plagiarism explicitly include in plagiarism copying of *ideas*, without citing the source of the ideas. Plagiarism is an academic offense, not a legal offense. The corresponding legal offense is copyright infringement, which occurs when there is verbatim copying, or a close paraphrase, of expression. As this essay explains, copyright does not protect ideas. In my essay on plagiarism,<sup>61</sup> I urged that the definition of plagiarism be restricted to copying expression, so that the academic offense of plagiarism tracks the law of copyright infringement. Such a restrictive definition of plagiarism would allow academic administrators to use concepts from copyright infringement law, instead of reinventing rules and criteria that judges have already used and refined with experience.

Nonetheless, suppose that academics insist that copying *ideas* without citing a source is plagiarism. If the plagiarist appeals his/her punishment to a court, the judge might<sup>62</sup> look at the most relevant body of law (i.e., copyright law) and see that copying ideas is permitted. That would put the college or university in a weak legal position.

I see four common ways that someone could copy an idea without citing its source:

1. If the idea is well known in the relevant field of knowledge (e.g., Newton’s Three Laws of Motion are well known to physicists, astronomers, and mechanical engineers), then a citation is not necessary. Every reader will understand that the idea is common knowledge and *not* asserted as original.

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<sup>61</sup> Standler, Plagiarism in Colleges in USA, <http://www.rbs2.com/plag.pdf> (Feb 2000).

<sup>62</sup> I say *might* because judges routinely refuse to review purely academic decisions, for reasons given in Standler, Academic Abstention in the USA, <http://www.rbs2.com/AcadAbst.pdf> , (June 2007).

2. The accused copied an idea he/she heard or read somewhere, but did not bother to track down the source of the idea. For an important idea in a thesis or dissertation, this is sloppy scholarship. For a minor idea, this omission may be trivial.
3. The accused independently created an idea, which — unknown to the accused — was previously published in some book or journal article.<sup>63</sup> This is *not* misconduct: the reality is that there are many ideas hidden in millions of volumes of books in libraries. Even if the accused made a diligent effort to search old publications, it is very easy to overlook something relevant. Adding to the problem is that there are few searchable full-text databases of old volumes, except for American law. In short, it is *unreasonable* to require that the accused be familiar with *every* relevant publication on his/her topic.
4. The accused fraudulently misrepresented someone else's idea as an original idea by the accused. This is truly egregious misconduct.

Again, I urge that plagiarism be limited to copying (or a close paraphrase of) expression. Alleged copying of an idea is something other than plagiarism, either common knowledge, sloppy scholarship, innocent independent creation of an idea, or fraudulent misrepresentation. Prosecuting copying of expression is relatively straightforward, after the true source has been identified. In contrast, investigation of alleged copying of ideas is more complicated.

#### **compensating people who pitch ideas**

There are many reported cases involving a writer who pitched ideas for a motion picture, television program, or other entertainment to some producer. The producer allegedly used the writer's idea without compensating the writer. Some of these cases involve a writer's idea that is *not* similar to the final product, so it would appear that the writer may have dreamed of success in litigation. A case for copyright infringement is futile, because copyright law does not protect the ideas in a script or synopsis. However, some plaintiffs have been successful under a theory of contract law or confidential relationship law. There is also the possibility of a quasi contract, an implied-in-law contract that is created by the judge to avoid unjust enrichment of the defendant.

There are a large number of articles in law reviews about compensating people who pitch ideas to the entertainment industry. The most famous is a 1954 article by Melville Nimmer,<sup>64</sup> which became § 16 in the treatise *NIMMER ON COPYRIGHT*.<sup>65</sup> In 1994, Prof. Lionel S. Sobel

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<sup>63</sup> Such independent discovery has happened many times in the history of science, mathematics, and engineering. For example, Newton and Leibniz worked independently and concurrently developed calculus.

<sup>64</sup> Melville B. Nimmer, "The Law of Ideas," 27 *SOUTHERN CALIFORNIA LAW REVIEW* 119 (Feb 1954).

<sup>65</sup> In the year 2007, Prof. Sobel wrote a new § 19D in *NIMMER ON COPYRIGHT*, which replaced Nimmer's § 16.

published a critique of Nimmer's article.<sup>66</sup> And in 2006, Prof. Arthur R. Miller of Harvard published a long article<sup>67</sup> that he had begun in 1956. These and additional articles are cited in the bibliography at page 83, below.

The problem of compensating people for "stolen" ideas is not limited to the entertainment industry. When professors or other scholarly researchers seek a contract or grant for funding their research, they submit a written proposal to a possible source of funding. The written proposal explains why the proposed work is important and how the work will be accomplished. The funding source typically sends copies of the proposal to three other researchers in the same field (i.e., competitors) for peer review. An unscrupulous reviewer could give the proposal a bad evaluation to deny funding to the proposal, and then use the confidential idea in the proposal for the reviewer's own work. Because the peer reviewers are anonymous to authors of proposals, the author of the proposal will never know who had access to his/her confidential ideas.

A similar problem can occur when an author submits a paper for publication to a scholarly journal. The editor of the journal typically sends copies of the manuscript to three other researchers in the same field (i.e., competitors) for peer review. An unscrupulous reviewer could give the manuscript a bad evaluation to delay its publication, while the reviewer quickly submits the confidential ideas in the manuscript for publication in a different journal under the reviewer's name. Because the peer reviewers are anonymous to authors of manuscripts, the author of the manuscript will never know who had access to his/her confidential ideas.

Stealing ideas in confidential disclosures (e.g., pitching ideas, proposals for research funding, draft publications) could be prosecuted under trade secret law.<sup>68</sup> In one case, inventors of a game sued a commercial manufacturer of a game, alleging that the idea for the game (a trade secret) was misappropriated by the manufacturer. In passing, the trial court noted the difficulty of tracing the origin of an idea:

But, the equities are not so one-sided as the plaintiffs would have it appear. Ideas are the most intangible of property rights, and their lineage is uniquely difficult to trace. Paternity can be claimed in the most casual of ways, and once such a claim is lodged, definitive blood tests are notoriously lacking. If manufacturers such as MB could not effectively safeguard themselves against such forays, they might well have to curtail submissions from independent inventors. Such a result would be plainly detrimental to both sides-and to the consumer as well.

*Burten v. Milton Bradley Co.*, 592 F.Supp. 1021, 1031 (D.R.I. 1984),

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<sup>66</sup> Lionel S. Sobel, "The Law of Ideas, Revisited," 1 UCLA ENTERTAINMENT LAW REVIEW 9 (Spring 1994).

<sup>67</sup> Arthur R. Miller, "Common Law Protection for Products of the Mind: An 'Idea' Whose Time Has Come," 119 HARVARD LAW REVIEW 705 (Jan 2006).

<sup>68</sup> See, e.g., Margreth Barrett, "The 'Law of Ideas' Reconsidered," 71 JOURNAL OF THE PATENT AND TRADEMARK OFFICE SOCIETY 691 (Sep 1989).

*rev'd on other grounds*, 763 F.2d 461 (1st Cir. 1985) (victory for plaintiffs).

Anyone who has spent hours in a library, laboriously tracing the history of an idea, knows that “lineage [of ideas] is uniquely difficult to trace.” On the other hand, just because it is difficult to trace the history of an idea, including the difficulty of verifying a claim of independent creation, does *not* imply we should abandon rewarding the creator of a new idea.

### Patent Law Protects Some Ideas

While patent law is a completely different area of law than copyright law, it is still interesting to compare patent law and copyright law. Patent protection is restricted by statute to only a “new and useful process, machine, manufacturer, or composition of matter.” 35 U.S.C. § 101. Only novel ideas can be patented. 35 U.S.C. § 102. As explained below, patent law protects *neither* a law of nature, natural phenomenon, abstract idea, purely mental process, *nor* mathematical formula.

- *Le Roy v. Tatham*, 55 U.S. 156, 175 (1852) (“... a principle is not patentable. A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right. Nor can an exclusive right exist to a new power,<sup>69</sup> should one be discovered in addition to those already known. Through the agency of machinery a new steam power may be said to have been generated. But no one can appropriate this power exclusively to himself, under the patent laws. The same may be said of electricity, and of any other power in nature, which is alike open to all, and may be applied to useful purposes by the use of machinery.”);
- *O'Reilly v. Morse*, 56 U.S. 62, 116 (1853) (“... the discovery of a principle in natural philosophy or physical science is not patentable.”);
- *Don Lee, Inc. v. Walker*, 61 F.2d 58 (9th Cir. 1932) (Patent “of a mathematical formula for the solution of a problem in dynamics” declared invalid. “We agree with appellant's contention that such a computation is not ‘a new and useful art, machine, manufacture or composition of matter’ within the meaning of” the patent statute. No cases cited!);
- *Mackay Radio & Telegraph Co. v. Radio Corporation of America*, 306 U.S. 86, 94 (1939) (“While a scientific truth, or the mathematical expression of it, is not patentable invention, a novel and useful structure created with the aid of knowledge of scientific truth may be.”);
- *Funk Bros. Seed Co. v. Kalo Inoculant*, 333 U.S. 127, 130 (1948) (“Their [i.e., bacteria’s] qualities are the work of nature. Those qualities are of course not patentable. For patents cannot issue for the discovery of the phenomena of nature. See *Le Roy v. Tatham*, 14 How. 156, 175, 14 L.Ed. 367. The qualities of these bacteria, like the heat of the sun, electricity, or the qualities of metals, are part of the storehouse of knowledge of all men. They are manifestations of laws of nature, free to all men and reserved exclusively to none. He who

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<sup>69</sup> This is an antique use of the word *power*. As explained in the following sentences of the Court’s opinion in *Le Roy* (and later in *Funk Bros. Seed Co. v. Kalo Inoculant*, 333 U.S. 127, 130 (1948)), *power* means “natural phenomenon”.

discovers a hitherto unknown phenomenon of nature has no claim to a monopoly of it which the law recognizes.”);

- *Prater*, 415 F.2d 1393, 1402 (1969) (purely mental steps not patentable);
- In *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972), the U.S. Supreme Court said:  
The Court stated in *Mackay Co. v. Radio Corp.*, 306 U.S. 86, 94, 59 S.Ct. 427, 431, 83 L.Ed. 506 that ‘(w)hile a scientific truth, or the mathematical expression of it, is not patentable invention, a novel and useful structure created with the aid of knowledge of scientific truth may be.’ That statement followed the longstanding rule that ‘(a)n idea of itself is not patentable.’ *Rubber-Tip Pencil Co. v. Howard*, 20 Wall. (87 U.S.) 498, 507, 22 L.Ed. 410. ‘A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right.’ *Le Roy v. Tatham*, 14 How. (55 U.S.) 156, 175, 14 L.Ed. 367. Phenomena of nature, though just discovered, mental processes, and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work. As we stated in *Funk Bros. Seed Co. v. Kalo Co.*, 333 U.S. 127, 130, 68 S.Ct. 440, 441, 92 L.Ed. 588, ‘He who discovers a hitherto unknown phenomenon of nature has no claim to a monopoly of it which the law recognizes. If there is to be invention from such a discovery, it must come from the application of the law of nature to a new and useful end.’
- In *Parker v. Flook*, 437 U.S. 584, 593 (1978), the U.S. Supreme Court gave an *unsatisfactory* explanation, then followed it with a quotation from a book on patent law that used the rule to justify itself:  
The rule that the discovery of a law of nature cannot be patented rests, not on the notion that natural phenomena are not processes, but rather on the more fundamental understanding that they are not the kind of ‘discoveries’ that the statute was enacted to protect.[FN15]

[FN15] The underlying notion is that a scientific principle, such as that expressed in respondent's algorithm, reveals a relationship that has always existed. “An example of such a discovery [of a scientific principle] was Newton’s formulation of the law of universal gravitation, relating the force of attraction between two bodies,  $F$ , to their masses,  $m_1$  and  $m_2$ , and the square of the distance,  $d$ , between their centers, according to the equation<sup>70</sup>  $F = m_1 m_2 / d^2$ . But this relationship always existed — even before Newton announced his celebrated law. Such ‘mere’ recognition of a theretofore existing phenomenon or relationship carries with it no rights to exclude others from its enjoyment. . . . Patentable subject matter must be new (novel); not merely heretofore unknown. There is a very compelling reason for this rule. The reason is founded upon the proposition that in granting patent rights, the public must not be deprived of any rights that it theretofore freely enjoyed.” P. Rosenberg, *PATENT LAW FUNDAMENTALS*, § 4, p. 13 (1975).

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<sup>70</sup> The equation omits the gravitational constant,  $G$ , so the numerical result will be wrong in either metric or american units of measurement. I changed the notation of the two masses from  $m$  and  $m'$  to use subscripts, in accordance with conventional style in physics.

- *Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980) (“The laws of nature, physical phenomena, and abstract ideas have been held not patentable. See *Parker v. Flook*, 437 U.S. 584, 98 S.Ct. 2522, 57 L.Ed.2d 451 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 67, 93 S.Ct. 253, 255, 34 L.Ed.2d 273 (1972); *Funk Brothers Seed Co. v. Kalo Inoculant Co.*, 333 U.S. 127, 130, 68 S.Ct. 440, 441, 92 L.Ed. 588 (1948); *O’Reilly v. Morse*, 15 How. 62, 112-121, 14 L.Ed. 601 (1854); *Le Roy v. Tatham*, 14 How. 156, 175, 14 L.Ed. 367 (1853). Thus, a new mineral discovered in the earth or a new plant found in the wild is not patentable subject matter. Likewise, Einstein could not patent his celebrated law that  $E=mc^2$ ; nor could Newton have patented the law of gravity. Such discoveries are ‘manifestations of . . . nature, free to all men and reserved exclusively to none.’ *Funk*, supra, 333 U.S., at 130, 68 S.Ct., at 441.”);
- *Diamond v. Diehr*, 450 U.S. 175, 185 (1981)<sup>71</sup> (“Excluded from such patent protection are laws of nature, natural phenomena, and abstract ideas. See *Parker v. Flook*, 437 U.S. 584, 98 S.Ct. 2522, 57 L.Ed.2d 451 (1978); *Gottschalk v. Benson*, supra, at 67, 93 S.Ct., at 255; *Funk Bros. Seed Co. v. Kalo Inoculant Co.*, 333 U.S. 127, 130, 68 S.Ct. 440, 441, 92 L.Ed. 588 (1948). “An idea of itself is not patentable,” *Rubber-Tip Pencil Co. v. Howard*, 20 Wall. 498, 507, 22 L.Ed. 410 (1874). ‘A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right.’ *Le Roy v. Tatham*, 14 How. 156, 175, 14 L.Ed. 367 (1853).”);
- *In re Bilski*, 545 F.3d 943, 952, n.5 (Fed.Cir. 2008) (Reciting the rule that “fundamental principles” are not patentable, and then defining “fundamental principles” to mean “laws of nature, natural phenomena, and abstract ideas.”);
- *In re Bilski*, 545 F.3d 943, 953, n.6 (Fed.Cir. 2008) (“Mathematical algorithms have, in other cases, been identified instead as abstract ideas rather than laws of nature. See, e.g., *State St. [Bank & Trust v. Signature Financial]*, 149 F.3d [1368] at 1373 [(Fed.Cir. 1998)]. Whether either or both views are correct is immaterial since both laws of nature and abstract ideas are unpatentable under [35 U.S.C.] § 101. *Diehr*, 450 U.S. at 185, 101 S.Ct. 1048.”).

The U.S. Supreme Court has never clearly explained *why* laws of nature, natural phenomena, or mathematical formulae are *unpatentable*. Some of the Court’s opinions tersely refer to a philosophical view that these ideas “are part of the storehouse of knowledge of all men.”<sup>72</sup> But, just as motors were unknown until someone invented them, a law of nature was unknown until someone discovered it. The view in *Parker v. Flook* that a law of nature always existed even if it was unknown to man, while motors existed only after their invention, is sophistry designed to justify the rule. It is *not* possible to use a law of nature that always exists but is currently unknown to man! Patents are about using new ideas that are known to the inventor.

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<sup>71</sup> *Diamond v. Diehr* is also noteworthy for denying patent protection to a “mathematical formula”, although one could obtain a patent for a useful invention that included a mathematical formula.

<sup>72</sup> *Funk Bros. Seed Co. v. Kalo Inoculant*, 333 U.S. 127, 130 (1948). See also *Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980).

If we permitted patents on laws of nature or mathematical theorems, the legal doctrine of patent misuse would protect the public from an unscrupulous scientist or mathematician who wishes to maintain a monopoly on the use of his/her discovery.

In 2006, the majority of the U.S. Supreme Court dismissed a writ of certiorari as improvidently granted. Three justices dissented from the dismissal, which dissent gives an excellent — but conventional — explanation of why some ideas are excluded from patent protection:

The relevant principle of law “[e]xclude[s] from ... patent protection ... laws of nature, natural phenomena, and abstract ideas.” *Diamond v. Diehr*, 450 U.S. 175, 185, 101 S.Ct. 1048, 67 L.Ed.2d 155 (1981). This principle finds its roots in both English and American law. See, e.g., *Neilson v. Harford*, WEBSTER'S PATENT CASES 295, 371 (1841); *Le Roy v. Tatham*, 14 How. 156, 175, 14 L.Ed. 367 (1853); *O'Reilly v. Morse*, 15 How. 62, 14 L.Ed. 601 (1854); *The Telephone Cases*, 126 U.S. 1, 8 S.Ct. 778, 31 L.Ed. 863 (1888). The principle means that Einstein could not have “patent[ed] his celebrated law that  $E=mc^2$ ; nor could Newton have patented the law of gravity.” *Diamond v. Chakrabarty*, 447 U.S. 303, 309, 100 S.Ct. 2204, 65 L.Ed.2d 144 (1980). Neither can one patent “a novel and useful mathematical formula,” *Parker v. Flook*, 437 U.S. 584, 585, 98 S.Ct. 2522, 57 L.Ed.2d 451 (1978), the motive power of electromagnetism or steam, *Morse*, supra, at 116, “the heat of the sun, electricity, or the qualities of metals,” *Funk Brothers Seed Co. v. Kalo Inoculant Co.*, 333 U.S. 127, 130, 68 S.Ct. 440, 92 L.Ed. 588 (1948).

The justification for the principle does not lie in any claim that “laws of nature” are obvious, or that their discovery is easy, or that they are not useful. To the contrary, research into such matters may be costly and time-consuming; monetary incentives may matter; and the fruits of those incentives and that research may prove of great benefit to the human race. Rather, the reason for the exclusion is that sometimes too much patent protection can impede rather than “promote the Progress of Science and useful Arts,” the constitutional objective of patent and copyright protection. U.S. Const., Art. I, § 8, cl. 8.

The problem arises from the fact that patents do not only encourage research by providing monetary incentives for invention. Sometimes their presence can discourage research by impeding the free exchange of information, for example by forcing researchers to avoid the use of potentially patented ideas, by leading them to conduct costly and time-consuming searches of existing or pending patents, by requiring complex licensing arrangements, and by raising the costs of using the patented information, sometimes prohibitively so.

Patent law seeks to avoid the dangers of overprotection just as surely as it seeks to avoid the diminished incentive to invent that underprotection can threaten. One way in which patent law seeks to sail between these opposing and risky shoals is through rules that bring certain types of invention and discovery within the scope of patentability while excluding others. And scholars have noted that “patent law[’s] exclu[sion of] fundamental scientific (including mathematical) and technological principles,” (like copyright’s exclusion of “ideas”) is a rule of the latter variety. W. Landes & R. Posner, *THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY LAW* 305 (2003). That rule reflects “both ... the enormous potential for rent seeking that would be created if property rights could be obtained in [those basic principles] and ... the enormous transaction costs that would be imposed on would-be users.” *Id.*, at 305-306; cf. *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 122 (C.A.2 1930) (L.Hand, J.).

Thus, the Court has recognized that “[p]henomena of nature, though just discovered, mental processes, and abstract intellectual concepts are ... the basic tools of scientific and technological work.” *Gottschalk v. Benson*, 409 U.S. 63, 67, 93 S.Ct. 253, 34 L.Ed.2d 273

(1972). It has treated fundamental scientific principles as “part of the storehouse of knowledge” and manifestations of laws of nature as “free to all men and reserved exclusively to none.” *Funk Bros.*, supra, at 130, 68 S.Ct. 440. And its doing so reflects a basic judgment that protection in such cases, despite its potentially positive incentive effects, would too often severely interfere with, or discourage, development and the further spread of useful knowledge itself.

*Laboratory Corp. of America Holdings v. Metabolite Laboratories, Inc.*, 548 U.S. 124, 126-128 (2006) (Breyer, J., dissenting). If Justice Breyer had been a poorly paid research scientist or mathematician — perhaps employed at a mundane job and doing research on his own time — and his ideas were exploited to make multi-million dollar profits for corporations, I doubt he would write the same text.

In my opinion, the best reason to distinguish laws of nature from a useful device is that a law of nature is unique, while there are *many* ways to design one useful device. A patent on a law of nature could inconvenience scientists and engineers, just as copyrighting one word would inconvenience users of that word. In contrast, a patent on a useful device will motivate engineers to design an improvement that avoids infringing the patent.

a patent is an exchange

A fundamental public policy underlying grants of patents is that the inventor must make a public disclosure in the patent of his/her invention that would “enable any person skilled in the art” to duplicate that invention.<sup>73</sup> In exchange (i.e., a “quid pro quo”) for this public disclosure, the government grants patent rights for a limited time. At the expiration of patent protection, anyone can read the patent and freely use the invention.

In 1896, the U.S. Supreme Court said:

It is self-evident that on the expiration of a patent the monopoly created by it ceases to exist, and the right to make the thing formerly covered by the patent becomes public property. It is upon this condition that the patent is granted. It follows, as a matter of course, that on the termination of the patent there passes to the public the right to make the machine in the form in which it was constructed during the patent.

*Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169, 185 (1896).

In 1989, the U.S. Supreme Court reiterated:

We have long held that after the expiration of a federal patent, the subject matter of the patent passes to the free use of the public as a matter of federal law. See *Coats v. Merrick Thread Co.*, 149 U.S. 562, 572, 13 S.Ct. 966, 969, 37 L.Ed. 847 (1893) (“[P]laintiffs’ right to the use of the embossed periphery expired with their patent, and the public had the same right to make use of it as if it had never been patented”); *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 59 S.Ct. 109, 83 L.Ed. 73 (1938); *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169, 16 S.Ct. 1002, 41 L.Ed. 118 (1896). Where the public has paid the congressionally mandated price for disclosure, the States may not render the exchange fruitless by offering patent-like protection

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<sup>73</sup> 35 U.S.C. § 112 (enacted 1952, current Mar 2009).



to the subject matter of the expired patent. “It is self-evident that on the expiration of a patent the monopoly created by it ceases to exist, and the right to make the thing formerly covered by the patent becomes public property.” *Singer*, supra, at 185, 16 S.Ct., at 1008.

*Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 152 (1989).

Cited with approval in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535 U.S. 722, 736 (2002) (“... exclusive patent rights are given in exchange for disclosing the invention to the public. See *Bonito Boats*, 489 U.S., at 150-151, 109 S.Ct. 971.”).

Whether because of a determination of unpatentability or other commercial concerns, petitioner chose to expose its hull design to the public in the marketplace, eschewing the bargain held out by the federal patent system of disclosure in exchange for exclusive use.

*Bonito Boats*, 489 U.S. at 159.

In 1998, the U.S. Supreme Court explained:

As we have often explained, most recently in *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 151, 109 S.Ct. 971, 103 L.Ed.2d 118 (1989), the patent system represents a carefully crafted bargain that encourages both the creation and the public disclosure of new and useful advances in technology, in return for an exclusive monopoly for a limited period of time. The balance between the interest in motivating innovation and enlightenment by rewarding invention with patent protection on the one hand, and the interest in avoiding monopolies that unnecessarily stifle competition on the other, has been a feature of the federal patent laws since their inception. As this Court explained in 1871:

“Letters patent are not to be regarded as monopolies ... but as public franchises granted to the inventors of new and useful improvements for the purpose of securing to them, as such inventors, for the limited term therein mentioned, the exclusive right and liberty to make and use and vend to others to be used their own inventions, as tending to promote the progress of science and the useful arts, and as matter of compensation to the inventors for their labor, toil, and expense in making the inventions, and reducing the same to practice for the public benefit, as contemplated by the Constitution and sanctioned by the laws of Congress.”

*Seymour v. Osborne*, 11 Wall. [78 U.S.] 516, 533-534 [(1870)].

Consistent with these ends, [35 U.S.C.] § 102 of the Patent Act serves as a limiting provision, both excluding ideas that are in the public domain from patent protection and confining the duration of the monopoly to the statutory term. See, e.g., *Frantz Mfg. Co. v. Phenix Mfg. Co.*, 457 F.2d 314, 320 (C.A.7 1972).

*Pfaff v. Wells Electronics, Inc.*, 525 U.S. 55, 63-64 (1998).

The U.S. Courts of Appeals have repeated said similar things:

- *Standard Oil Co. (Indiana) v. Montedison, S.P.A.*, 664 F.2d 356, 363 (3dCir. 1981) (“Compliance with the full disclosure requirement of 35 U.S.C. § 112, which facilitates subsequent free public use of the invention, is the quid pro quo for the grant of a limited patent monopoly on a patentable invention. *In re Argoudelis*, 434 F.2d 1390, 1394 (Cust. & Pat. App. 1970) (concurring opinion); 2 Chisum, PATENTS § 7.01 (1981).”);
- *Chamberlin v. Isen*, 779 F.2d 522, 525 (9thCir. 1985) (“The fundamental policy behind the American patent system is to provide inventors with a limited monopoly in exchange for public disclosure. See Peter D. Rosenburg, PATENT LAW AND FUNDAMENTALS § 1.03 (2d ed. 1985). Accordingly, this circuit has recognized that a patent must be sufficiently clear to allow others to reproduce its results when the monopoly period expires and to enable contemporary inventors to ascertain whether or not they are infringing upon a patent. *Locklin v. Switzer Bros., Inc.*, 299 F.2d 160, 166 (9th Cir. 1961), *cert. denied*, 369 U.S. 861, 82 S.Ct. 950, 8 L.Ed.2d 18 (1962).”);
- *Dana Corp. v. IPC Ltd. Partnership*, 860 F.2d 415, 418 (Fed.Cir. 1988) (“The purpose of the best mode requirement is to ensure that the public, in exchange for the rights given the inventor under the patent laws, obtains from the inventor a full disclosure of the preferred embodiment of the invention. *In re Gay*, 309 F.2d 769, 772, 50 CCPA 725, 135 USPQ 311, 315 (1962).”); *Dana* was quoted with approval in *Bayer AG v. Schein Pharmaceuticals, Inc.*, 301 F.3d 1306, 1316 (Fed.Cir. 2002).
- *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 970 (Fed.Cir. 2002) (“Such description is the quid pro quo of the patent system; the public must receive meaningful disclosure in exchange for being excluded from practicing the invention for a limited period of time.”). Quoted with approval in *Univ. of Rochester v. G.D. Searle & Co., Inc.*, 358 F.3d 916, 922 (Fed.Cir. 2004); *Carnegie Mellon University v. Hoffmann-La Roche, Inc.*, 541 F.3d 1115, 1122 (Fed.Cir. 2008); *In re Alonso*, 545 F.3d 1015, 1019 (Fed.Cir. 2008).

For similar reasons, I urge that, if government is to recognize intellectual property protection for either ideas or facts (or both) in writings, then the government should insist on written public disclosure of those ideas or facts.

### Lack of protection for ideas is a taking?

Neither patent law nor copyright law will protect ideas that are laws of nature, natural phenomena, mathematical theorems, etc. This leaves scientists and mathematicians without any intellectual property protection for their valuable ideas. In the following paragraphs, I use the phrase *unprotected ideas* specifically to refer to new laws of nature, new descriptions of natural phenomena, new mathematical formulae, and other ideas that are neither patentable nor copyrightable subject matter.

Such lack of intellectual property protection might be acceptable *if* the government gave generous financial support to scientists and mathematicians, so the fruits of their intellectual labor belonged to the public, as a result of taxpayer support of the salaries of scientists and mathematicians. But — except for a brief burst of funding during the 1950s and 1960s, and then declining during the 1970s and 1980s — U.S. government support of science and mathematics has been stingy.<sup>74</sup>

In forbidding legal protection to unprotected ideas, the U.S. Government has erected legal rules to prohibit scientists and mathematicians from profiting from their personal investment of labor, skill, and expenses to discover new ideas. The reasoning for this lack of intellectual property protection for unprotected ideas seems to be that ideas belong to everyone, that ideas are public property. That's easy for judges to say. The truth is that discovering new ideas requires a great deal of intellect, diligence, skill, and creativity — attributes that should be respected and encouraged, as a matter of public policy.

It is common that one single publication in science or mathematics is the result of thousands of hours of work, which is often poorly compensated (e.g., meager stipends of graduate students or postdoctoral researchers) or *unpaid* (e.g., evenings, weekends, holidays, and so-called vacations spent by professors who are paid to teach full time). Income from copyright royalties might give a significant financial reward to these poorly paid researchers.

The legal conversion of a scientist's or a mathematician's unprotected ideas (i.e., personal property) into public property is arguably a *taking* that is forbidden under the Fifth Amendment to the U.S. Constitution, for which the owner of the personal property must be compensated. There are at least four ways to avoid such a taking:

1. The easiest way to compensate scientists and mathematicians is for the government to pay their salary and research expenses, in exchange for the government dedicating their ideas and facts to the public domain.

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<sup>74</sup> Standler, Funding of Basic Research in Physical Science in the USA, <http://www.rbs0.com/funding.pdf>, 3 Sep 2004.

2. The least efficient way would be to grant scientists and mathematicians patent rights on their ideas, requiring legal fees for preparation and prosecution of patent applications, and requiring more legal fees for patent infringement litigation.
3. Another way would be to modify copyright law to allow copyright to protect novel ideas in writing that are published.
4. And we could create a new kind of intellectual property that includes ideas.

Some readers may object that *ideas* are not property. But an idea is treated as property in trade secret law. And a patent on a useful idea — a subset of all ideas — is treated as property in patent law. The days when property was required to be tangible are long past — routine transactions in banking and securities process valuable property without any tangible valuable item (e.g., a bar of gold) moving. For example, in the USA, banks no longer physically transfer a paper check, itself a symbol of money in a bank account, instead credits and debits are transferred electronically.

### **Why copyright can not protect ideas**

*the content of this section is a proposal, not actual law*

The U.S. Constitution specifies that the purpose of copyright law is to promote the Progress of knowledge.<sup>75</sup> Allowing copyright to cover novel ideas in scholarly work, including scientific or mathematical papers, would permit scholars to be compensated for their labor, skill, and expenses, which is not only equitable (i.e., avoid unjust enrichment) but also would promote the Progress of knowledge, by encouraging more publications of ideas by financially rewarding authors. When judges refuse to allow any hypothetical monopoly on ideas, judges rely on the reader's horror of monopolies to motivate the reader to agree with the judge. By allowing copyright on ideas, there would be no monopoly — just reasonable royalty income to the author of works containing ideas that other people find useful in their for-profit work.

I have played with drafting statutes to protect ideas, as an intellectual finger exercise.<sup>76</sup> Unfortunately, I have no draft that I can suggest. The protection of ideas seems *impractical* to me.

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<sup>75</sup> U.S. Constitution, Article I, § 8, clause 8. See, e.g., the discussion in Standler, Copyright Protection for Nonfiction or Compilations of Facts in the USA, <http://www.rbs2.com/cfact.pdf>, (22 Feb 2009).

<sup>76</sup> Like many scientists and engineers, I take it as a challenge when the conventional wisdom is that something is impossible.

### what to protect

First of all, 17 U.S.C. § 102(b) needs to be replaced with a simple sentence that copyright also protects novel<sup>77</sup> ideas that were both (1) created by the author of the copyrighted work and (2) were publicly disclosed in a writing.<sup>78</sup>

Ideally, the public disclosure should be in a publication that will be permanently available in many libraries. A temporary or ephemeral public display of ideas or facts (e.g., a lecture, without a simultaneous printed publication by the same author) is not adequate public disclosure, because such temporary or ephemeral public display is *not* available to everyone at any future time. For posting on the Internet (known in copyright law as a public display), the author should have copyright in ideas only during the time that the author's copyrighted work is actually posted on the Internet.

### duration of protection

I suggest that ideas go into the public domain at 30 years<sup>79</sup> from the date of date of first publication. When the public disclosure is only via a public display (i.e., no publication), then the ideas in the copyrighted work go into the public domain on either (a) the date of deliberate removal of the work from public display, or (b) 30 y from the date of the first public display, whichever occurs first. The *expression* of the idea would continue to be protected by copyright law for the full term of copyright protection.

Unfortunately, such a proposal would continue the present mess with the idea-expression dichotomy from 30 years to the end of the copyright term. But allowing an author to own an idea for the full-term of copyright protection — currently life of author plus 70 years — seems to me like an unacceptably long time.

### implied license

Second, there needs to be a section in the copyright statute giving the author of any scholarly work that is publicly disclosed an implied license to use ideas or facts from any previously copyrighted material, provided that both (1) the second author includes a bibliographic citation to the source of the previously copyrighted material and (2) the second author makes a fair use of the

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<sup>77</sup> By analogy with patent law, which only protects novel inventions.

<sup>78</sup> By analogy with patent law, as explained above, beginning at page 72.

<sup>79</sup> I somewhat arbitrarily selected this numerical example, for purposes of discussion. The number in statute would be the result of elaborate discussions in the U.S. Congress.

ideas or facts. This law preserves the status quo for researchers and assures everyone that scholarly research (with properly cited sources) will be neither inhibited nor frustrated by copyright protection for ideas. Already, one sees a hint that it is impractical to protect ideas, when one should exclude protection for ideas that are used in continuing scholarly research.

If there is not an implied license for authors of scholarly work, then it could be burdensome<sup>80</sup> for those authors to obtain permission from owners of hundreds, perhaps even thousands, of ideas contained in a scholarly book or long article.

#### fees for use of novel ideas

Users of ideas (e.g., engineers, attorneys, teachers, businessmen, etc.) who use copyrighted ideas in their business or employment — but who are not creating a written public disclosure — should pay a license fee to the source of the copyrighted ideas. If users feel that they are inconvenienced by paying a license fee, those users should contemplate the much greater inconvenience of avoiding those ideas. The evolving doctrine of copyright misuse could prevent a copyright owner from refusing to license ideas or facts in a work in exchange for a reasonable royalty payment.

There are many ways to determine the amount of the fee for use of an idea:

1. Negotiating a fee, while perhaps fairer to the author in projects of enormous economic value, is impractical, because the transaction costs are generally burdensome to both parties.
2. Fixed fee, same for every user. For example, \$20 to use any and all ideas contained in one publication. This amount could even be set in statute (with automatic annual increases according to inflation) as a compulsory license fee.<sup>81</sup>

But such a proposal is really impractical. Look at the situation involving copyright infringement by people who use photocopy machines to duplicate copyrighted material without paying royalties to the copyright owner — this massive copyright infringement of expression suggests that very few people are willing to pay license fees for use of novel ideas.

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<sup>80</sup> See, e.g., *Gaiman v. McFarlane*, 360 F.3d 644, 659-660 (7th Cir. 2004) (If copyright protected commonplace ideas, stock characters, etc., then "... the net of liability would be cast too wide; authors would find it impossible to write without obtaining a myriad of copyright permissions. .... It would be difficult to write successful works of fiction without negotiating for dozens or hundreds of copyright licenses, even though such stereotyped characters are the products not of the creative imagination but of simple observation of the human comedy.").

<sup>81</sup> *Broadcast Music, Inc. v. Columbia Broadcasting System, Inc.*, 441 U.S. 1, 20 (1979) (blanket license from ASCAP not anti-trust price fixing: "A middleman with a blanket license was an obvious necessity if the thousands of individual negotiations, a virtual impossibility, were to be avoided.").

### notice of novel idea

It seems only fair that if ideas are legally protected, that the reader should have notice of what an author claims as a novel idea. But such notice raises complicated questions that don't have easy answers.

1. Should the government examine novel ideas in a document the way the Patent Office examines applications for a U.S. Patent, in an attempt to exclude pre-existing or obvious ideas? While such a preliminary examination provides the benefit of reducing bogus claims for novel ideas, such an examination has the disadvantage of being very expensive and slow.<sup>82</sup>
2. Should there be a penalty for an author who claims his/her idea is novel, but — in fact — the idea is not novel? In cases where the author had actual knowledge that the idea was pre-existing, there may be fraud by the author. In cases where the author was negligent in not making a search for pre-existing publications of the idea, there is lesser blameworthy conduct by the author. And in cases where the pre-existing publication was in some obscure source found in few libraries, an author might have a reasonable — but erroneous — belief that his/her idea was novel.
3. Should an author of a non-novel idea be required to refund payments of license fees for use of that idea? Even if both (1) the alleged author reasonably believed he/she created the idea and (2) a user received the idea from the alleged author?
4. What happens when an author discloses an allegedly novel idea, and — armed with the knowledge in that disclosure — someone can find a vague suggestion of that idea in a previous publication? Is such hindsight impermissible? How clear does the previous expression of an idea need to be before it invalidates novelty of subsequent expressions of the same idea? Patent law has grappled with this difficult question for a long time.

### infringement of idea

It should be an affirmative defense to litigation for infringement of an idea that either the alleged infringer independently created the ideas or that the ideas were not novel.<sup>83</sup>

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<sup>82</sup> A typical patent application requires approximately \$ 10,000 in legal fees and government fees, and takes several years to complete.

<sup>83</sup> "Not novel" means that the alleged infringer can produce a publication that contains the allegedly infringed ideas that is earlier than the plaintiff's publication. The burden of proof must be on the defendant, because the plaintiff can never prove his/her idea was novel.

impractical

I fear that allowing copyright protection for ideas would shift authors' efforts away from creating and publicly disclosing ideas, toward expensive searches of prior publications.<sup>84</sup>

It is futile to enact statutes that will be violated more often than honored. However, it would not be futile if the statutes also contain mandatory reimbursement of reasonable legal fees by the prevailing party, or if the statutes mandated large awards that would make infringement litigation profitable on a contingency fee basis.<sup>85</sup> As much as I would like to see authors rewarded for their novel ideas, I suggest that society is unwilling to tolerate copyright on novel ideas.

In summary, I believe that it is not practical to have copyright protection for ideas that are publicly disclosed in writing. When judges created the rule that copyright does not protect ideas, but the judges failed to adequately explain the reasons for the rule, it seems that the judges reached the correct result, but probably did not understand *why* they were correct.

## Conclusion

Ideas are *not* protected by copyright law. Beginning at page 6 above, I trace the history of this rule and include the reason(s) for this rule of law. The rule was created by judges, and mentioned in the 1976 statute, but the reasons and explanations for this rule have always been sparse. Judges and legislators seem to believe that the reason(s) for this rule need no explanation. It is astounding to me that there is so little explanation or justification for the rule that copyright does not protect ideas — a rule that the U.S. Supreme Court called “the most fundamental axiom of copyright law”.<sup>86</sup>

Publication of ideas contributes those ideas to the public domain, which is a consequence of the rule that ideas are not protected by copyright.

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<sup>84</sup> I personally enjoy working in a library, reading old publications, and tracing the history of ideas. However — in science, mathematics, and engineering — such scholarly effort *should* be secondary to working in a laboratory or thinking from first principles.

<sup>85</sup> Statutes generally do not affect most people's behavior. For example, the statutes prohibiting the manufacture or sale of alcoholic beverages in the USA during 1919-1933 did not end the consumption of alcohol. The current statutes prohibiting the manufacture or sale of illicit drugs have *not* ended consumer's demand for those drugs.

<sup>86</sup> *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*, 499 U.S. 340, 344-345 (1991).



There is a glaring problem with the rule that ideas are not protected by copyright. As explained at page 34, above, the word *idea* is not defined by either judges or statute, and the word *idea* is used in copyright law to mean something different from the usual meaning of *idea*.

Beginning at page 42, above, I discuss the history of the idea-expression merger: if the idea can only be expressed in one way, then copyright will not protect that unique expression. And beginning at page 62, above, I cite a long string of cases for the proposition that an expression of an idea is copyrightable.

Beginning at page 68 above, I discuss the long-standing legal rule that a patent protects *neither* a law of nature, natural phenomenon, abstract idea, purely mental process, *nor* mathematical formula. Similarly to the lack of explanation for *why* ideas are not copyrightable, judges have failed to explain *why* certain types of ideas are excluded from patent protection.

There are at least five serious problems with the legal rule that copyright does not protect ideas.

1. The reasons or justification for the rule have *not* been clearly explained. When judges create a rule of law, they have an obligation to explain it.
2. The word *idea* is undefined by judges or statute, and in copyright law that word means something different from the ordinary use of that word.
3. The lack of a precise boundary between *unprotected* ideas and protected expression allows judges to reach their desired result and pretend that the result is the consequence of rules of law. This lack of a precise boundary between an idea and expression of an idea has frustrated famous jurists like Learned Hand (see page 14, above) and invites errors by lesser jurists.
4. Holding that ideas are not protected by copyright makes it difficult to financially reward scientists, mathematicians, and engineers who publicly disclose their ideas. It also creates a problem for writers who pitch ideas to the entertainment industry, and is an *unappreciated* problem for scholars who write proposals for funding of their research.
5. 17 U.S.C. § 102(b) creates a nightmare for judges who decide cases involving copyright on a computer program.

Currently, scientists or mathematicians whose publications describe either a new law of nature, a description of natural phenomena, or a new mathematical theorem — each of which are neither patentable nor copyrightable subject matter — have no legal way for the author to protect the content of his/her work. This lack of legal protection for ideas harms society in at least two ways: (1) it denies economic rewards to scientists and mathematicians for publishing their discoveries or new ideas, thus contributing their ideas to the public domain, and (2) it could encourage scientists and mathematicians to keep their discoveries secret, so that the author can exploit those discoveries without competition from others. However, it appears impractical to me to use copyright law to protect ideas, as explained above, beginning at page 76. My personal view is that the government should generously fund basic scientific and mathematical research, and, in exchange for the government funding, dedicate the facts and ideas to the public domain.

Given that the rule that ideas are not protected by copyright has been well established for more than 125 years, it is futile to expect that judges will change the rule. Therefore, any change must come from the U.S. Congress. I believe it is extremely unlikely that Congress will change the rule.

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**compensating people who pitch ideas**

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