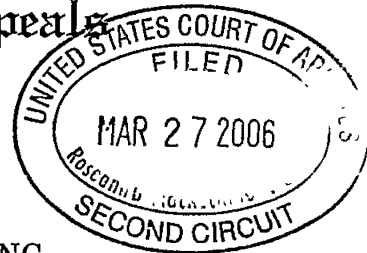



05-5585-CV


United States Court of Appeals

FOR THE SECOND CIRCUIT

Docket No. 05-5585-cv



NEW YORK MERCANTILE EXCHANGE, INC.,

Plaintiff-Counter-Defendant-Appellant,

—v.—

INTERCONTINENTALEXCHANGE, INC.,

Defendant-Counter-Claimant-Appellee.

ON APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK

**BRIEF AMICUS CURIAE
OF THE UNITED STATES OF AMERICA
IN SUPPORT OF DEFENDANT-APPELLEE
INTERCONTINENTALEXCHANGE, INC.**

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**UNITED STATES COURT OF APPEALS
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Docket No. 05-5585-cv

NEW YORK MERCANTILE EXCHANGE, INC.,

Plaintiff-Counter-Defendant-Appellant,

—v.—

INTERCONTINENTALEXCHANGE, INC.,

Defendant-Counter-Claimant-Appellee.

**BRIEF *AMICUS CURIAE* OF THE UNITED STATES OF
AMERICA IN SUPPORT OF DEFENDANT-APPELLEE
INTERCONTINENTALEXCHANGE, INC.**

STATEMENT OF INTEREST

The United States has a substantial interest in the resolution of this appeal. It has numerous responsibilities related to the proper administration of the intellectual property laws, as well as primary responsibility for enforcing the antitrust laws, which establish a national policy favoring economic competition. Accordingly, the United States has an interest in properly maintaining the “delicate equilibrium,” Computer Assocs. Int’l v. Altai, Inc., 982 F.2d 693, 696

(2d Cir. 1992), Congress established with the copyright law, between protecting private ownership of expression to encourage creativity and enabling the free use of information for future creativity. See Twentieth Century Music Corp. v. Aiken, 422 U.S. 151, 156 (1975). The claims in this case seeking copyright protection for a commodity exchange's individual determinations of futures contract settlement prices threaten that equilibrium.

The Register of Copyrights ("Register" or "Copyright Office") administers the copyright law by, among other things, advising Congress, the courts and federal departments and agencies on copyright issues, 17 U.S.C. § 701(b), and by reviewing applications for copyright registration and registering copyright claims when it determines that the material deposited constitutes copyrightable subject matter and that other legal and formal requirements of copyright law have been met, 17 U.S.C. § 410(a), (b). In this case, the plaintiff commodity exchange was advised that the Copyright Office would not register claims in the plaintiff's individual determinations of futures contract settlement prices. That determination was based on longstanding principles of copyright law applied by the Copyright Office in evaluating claims for copyright registration. To convey its concerns, the Register filed a Statement of Interest with the district court pursuant to 28 U.S.C. § 517. (JA 1593-1613).

We file this brief as *amicus curiae* pursuant to the first sentence of Federal Rule of Appellate Procedure 29(a).

INTRODUCTION AND SUMMARY

The district court was entirely correct in holding that (1) settlement prices are not copyrightable because they are facts, and not original, creative works; (2) settlement prices are not copyrightable because they are short phrases; and (3) the merger doctrine precludes a copyright infringement claim here. The settlement prices of physical commodity futures contracts traded on the New York Mercantile exchange (“NYMEX”) are market facts calculated by NYMEX to value its clearing members’ customers’ accounts at the close of each business day. They are not sufficiently creative or original to merit copyright protection. They are also short phrases, which, under settled law and longstanding agency practice, are not subject to copyright protection. NYMEX settlement prices are also the inevitable expression of a specific idea – that each settlement price states the value of a given futures contract at the close of a particular day of trading. Because the settlement price is the only way to express the idea of the value of a particular contract, copyright protection is unavailable under the merger doctrine. For all of these reasons, each of which is a sufficient basis to deny NYMEX’s claim, the United States respectfully urges the Court to affirm the district court’s judgment.

ARGUMENT

POINT I

THE DISTRICT COURT CORRECTLY HELD THAT NYMEX SETTLEMENT PRICES ARE UNCOPYRIGHTABLE FACTS

A. Copyright Protection Extends to Original, Creative Works Only, Not to Facts

The copyright system of the United States reflects a balancing of private and public interests. See Eldred v. Ashcroft, 537 U.S. 186, 211-13 n.18 (2003) (“copyright law serves public ends by providing individuals with an incentive to pursue private ones”); Twentieth Century Music, 422 U.S. at 156 (creative work is encouraged, but private motivations must serve the interest of promoting public availability of literature). The United States Constitution authorizes Congress to “promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.” U.S. Const. Art. 1, § 8, cl. 8. To encourage innovation, the copyright laws grant the creators of works that qualify for a copyright an exclusive right to use and benefit from their works for a limited period of years. See 17 U.S.C. §§ 301-305. Copyright protection is available for “original works of authorship fixed in any tangible medium of expression,” 17 U.S.C. § 102(a), and the owner of a copyright “has the exclusive rights . . . to reproduce the copyrighted

work,” 17 U.S.C. § 106.

To determine whether copyright protection is available, courts examine whether a work is sufficiently original to warrant protection, because protecting an unoriginal expression would not “promote the Progress of Science and useful Arts.” See Feist Publ’ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 349-50 (1991); ATC Distribution Group, Inc. v. Whatever It Takes Transmissions & Parts, Inc., 402 F.3d 700, 710 (6th Cir. 2005). Rather, copyright protection that impedes the use of a previously available expression would hinder new intellectual work. Accordingly, the Supreme Court has long interpreted the constitutional terms “authors” and “writings” (Art. 1, § 8, cl. 8) to “presuppose a degree of originality.” Feist, 499 U.S. at 346. For purposes of copyright law, a work is not original unless it “possesses at least some minimal degree of creativity.” Id. at 345. Moreover, even if a work as a whole has sufficient creativity to be protectable, the law’s concern for promoting public use of existing intellectual knowledge limits that protection only to “those components of a work that are original to the author.” Id. at 348.

As established by the copyright statutes and the courts that have interpreted them, copyright protection does not apply to facts or ideas: “in no case does copyright authorship extend to any idea, procedure, process, system, [or] method

of operation . . . regardless of the form in which it is described, explained, illustrated, or embodied.” 17 U.S.C. § 102(b); see Feist, 499 U.S. at 356 (“Section 102(b) is universally understood to prohibit any copyright in facts.”). Indeed, “[t]he most fundamental axiom of copyright law is that ‘no author may copyright his ideas or the facts he narrates.’” Feist, 499 U.S. at 344-45 (citation omitted). “This principle, known as the idea/expression or fact/expression dichotomy, applies to all works of authorship.” Id. at 350; see, e.g., Eldred, 537 U.S. at 217 (“[C]opyright gives the holder no monopoly on any knowledge. A reader of an author’s writing may make full use of any fact or idea she acquires from her reading. See § 102(b).”).

Facts are not copyrightable because “[t]he *sine qua non* of copyright is originality,” and facts “do not owe their origin to an act of authorship.” Feist, 499 U.S. at 345, 347. As explained by the Supreme Court, “[t]he first person to find and report a particular fact has not created the fact; he or she has merely discovered its existence.” Id. at 347. Because a fact has no “maker” or “originator,” copyright protection is unavailable. Id.

Protecting newly discovered facts could, arguably, “promote the Progress of Science and useful Arts” by providing incentives to identify such facts, but the copyright law has rejected this view. At one time, certain courts applied a “sweat

of the brow” analysis, awarding copyright protection based on the extent of effort rather than originality. See Feist, 499 U.S. at 352-55. Congress and the Supreme Court repudiated the “sweat of the brow” doctrine, however, and made clear that even when effort and hard work underlie the process of discovering a fact, the fact nonetheless does not merit copyright protection. See id. “When Congress decided to overhaul the copyright statute” in 1976, it inserted originality as an explicit prerequisite to copyright, “[t]o ensure that the mistakes of the ‘sweat of the brow’ courts would not be repeated.” Id. at 354-55; see 17 U.S.C. § 102(b). Thus, it is now settled law that “originality is an essential element of copyright protection, and that toil, or ‘sweat of the brow,’ expended in collecting information does not justify conferring copyright protection.” CCC Info. Servs., Inc. v. Maclean Hunter Mkt. Reports, Inc., 44 F.3d 61, 65 (2d Cir. 1994). Denying copyright protection to newly discovered facts “may seem unfair” to those who worked hard to uncover the facts, but it “encourages others to build freely upon the ideas and information conveyed by a work.” Feist, 499 U.S. at 349-50.

B. NYMEX Settlement Prices Are Facts

The district court correctly held that NYMEX settlement prices are not copyrightable because they are facts. New York Mercantile Exchange, Inc. v. IntercontinentalExchange, Inc., 389 F. Supp. 2d 527, 541 (S.D.N.Y. 2005)

(“NYMEX”).

Prices are generally considered facts that cannot be copyrighted. See Miracle Blade, LLC. v. Ebrands Commerce Group, LLC., 207 F. Supp. 2d 1136, 1150-51 (D. Nev. 2002) (“Plaintiff’s allegations that defendants copied plaintiff’s price should also not be considered since price is a non-copyrightable fact.”); Project Development Group, Inc. v. O.H. Materials Corp., 766 F. Supp. 1348, 1354 (W.D. Pa. 1991) (“Estimates of scope of work, price and quantities are all factual.”), aff’d, 993 F.2d 255 (3rd Cir. 1993); Special Appendix (“SPA”)* 24 (Copyright Office, Examining Division, Literary Online Practices, Chap. 20 C.II.D.3.d [2003] (“Prices are not generally considered copyrightable because the determination of prices is considered a business decision and thus they represent facts.”)).

NYMEX argues that its settlement prices should be treated differently than other prices because they are not facts, but rather “an expression of an opinion as to value stated as a number.” Brief for Appellant NYMEX (“NYMEX Br.”) 38.

* The Register’s Statement of Interest filed in the district court was accompanied by exhibits attached to the Declaration of Assistant United States Attorney Nicole Gueron. See NYMEX, 389 F. Supp. 2d at 543 n.12 (citing to Declaration). Those documents were not included in the joint appendix on appeal. Accordingly, for the Court’s convenience, we provide copies of these documents in a Special Appendix attached as an addendum to this brief. (SPA 1-51).

The Court should reject this argument for several reasons. First, this description could apply to any price set by any seller of any product, from the price of grapes at the corner grocery to the closing sale price of a painting at a Sotheby's auction. Thus, NYMEX's proposed exception would swallow the rule that prices are noncopyrightable facts. Second, the record in this case demonstrates that the settlement prices are facts, not creative expressions of opinions. As NYMEX's Chief Operating Officer stated in testimony before a U.S. Senate Committee, the settlement prices are relied on heavily by the energy industry "[b]ecause the settlements reflect actual trades, and not market sentiment." (Joint Appendix ("JA") 131). The industry relies on the settlement prices precisely because they are facts, not "sentiment" or "opinion."

It does not matter for copyright purposes that NYMEX may have used some judgment or discretion in determining the Settlement Prices, as the district acknowledged in ruling that "[t]he numerical settlement price that arises from NYMEX's judgment and discretion reflects no more than a pure fact or idea of the present price of a futures contract." NYMEX, 389 F. Supp. 2d at 541. Copyright is unavailable because NYMEX's judgment was exercised solely to ensure that the settlement price was accurately measured. (JA 789 (NYMEX rules governing measurement of settlement price)). All measurement involves some amount of

judgment and estimation.* Census data are uncopyrightable facts, Feist, 499 U.S. at 347-48 (census data not copyrightable because census takers “do not ‘create’ the population figures that emerge from their efforts”), even though they are “inherently less than absolutely accurate,” Gaffney v. Cummings, 412 U.S. 735, 745 (1973), and their production involves judgment. The process of taking the decennial census is largely left to the discretion of the Secretary of Commerce, 13 U.S.C. § 141(a) (“in such form and content as [the Secretary] may determine, including the use of sampling procedures and special surveys”), subject to statutory limitations, 13 U.S.C. § 195 (barring use of “sampling” in determining population for purposes of apportioning seats in the House of Representatives); see also Utah v. Evans, 536 U.S. 452 (2002) (approving Census Bureau use of “hot-deck imputation” to fill gaps and resolve conflicts in data collected for purposes of apportioning seats in the House of Representatives), but the results are nevertheless facts. NYMEX is therefore wrong to suggest that applying judgment to a measurement destroys the factual nature of the result.

Further proof of the factual nature of the settlement prices lies in what

* Thus, for scientific measurement, the National Institute of Standards and Technology advises, “[a] measurement result is complete only when accompanied by a quantitative statement of its uncertainty.” See “Guidelines for Evaluating and Expressing the Uncertainty of NIST Measurement Results,” <http://physics.nist.gov/Pubs/guidelines/appc.html>.

NYMEX does with its prices: they are published in newspapers “no later than the morning of the next day” (JA 1545), and NYMEX uses them to value the accounts of its clearing members’ customers and to trigger margin calls for accounts whose value has dropped too low, NYMEX Br. at 9-10; (JA 1081-84).^{*} Nothing in the record suggests that an account holder could refuse to meet a margin call on the ground that the settlement price valuation was merely NYMEX’s opinion. To the contrary, as explained by NYMEX’s Chief Operating Officer, the “Settlement Prices are used at the end of each trading day to determine whether each trader with an open position has made or lost money on his or her open positions that day.” (JA 1084). According to NYMEX, the “Settlement Prices are the cornerstone of the clearing process, assuring all customers of the Exchange of the fairness, independence, and integrity of the values used to ‘mark to market’ their open positions, thus resulting in a calculation of each customer’s profits and losses that day.” (Id.).

On this record, the district court properly rejected NYMEX’s claim that its settlement prices are opinions, instead recognizing that “NYMEX settlement

^{*} We do not imply that the use of a fact is an element of proof as to its copyrightability. A settlement price is a fact because it is a calculation of a factual value rather than an original expression of an opinion. NYMEX’s use of its settlement prices only serves to bolster this conclusion.

prices are widely publicized and used as benchmarks by market participants.

NYMEX settlement prices are thus real-world facts used by commodities traders to value their open positions and trigger margin calls or margin reductions.”

NYMEX, 389 F. Supp. 2d at 542. The district court correctly concluded that the prices are noncopyrightable facts that “do not owe their origin to an act of authorship.” Feist, 499 U.S. at 347.

C. The District Court Correctly Distinguished CCC and CDN

NYMEX’s reliance on this Court’s decision in CCC Information Services, Inc. v. Maclean Hunter Market Reports, Inc., 44 F.3d 61, 65 (2d Cir. 1994), to argue that its settlement prices are copyrightable, NYMEX Br. 23-27, is misplaced. As a threshold matter, CCC is inapplicable because it concerned a compilation copyright. Section 103 of the Copyright Act of 1976 provides that the “subject matter of copyright as specified by section 102 includes compilations.” 17 U.S.C. § 103. A “compilation,” in turn, is defined as “a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship.” 17 U.S.C. § 101. Thus, “[a]lthough facts themselves are not subject to copyright protection, a compilation of preexisting facts . . . can still meet the constitutional minimum for copyright

protection if it features original selection, coordination or arrangement of those facts.” Victor Lalli Enters., Inc. v. Big Red Apple, Inc., 936 F.2d 671, 672 (2d Cir. 1991); see Key Publ’ns v. Chinatown Today Pub. Enters., 945 F.2d 509, 512-13 (2d Cir. 1991) (compilation of uncopyrightable facts may be copyrightable).

As the Supreme Court explained in Feist:

The compilation author typically chooses which facts to include, in what order to place them, and how to arrange the collected data so that they may be used effectively by readers. These choices as to selection and arrangement, so long as they are made independently by the compiler and entail a minimal degree of creativity, are sufficiently original that Congress may protect such compilations through the copyright laws. . . . No matter how original the format, however, the facts themselves do not become original through association.

Id. at 348-49. Because the copyright in a compilation does not extend to the underlying compiled facts, the Court recognized that “the copyright in a factual compilation is thin.” Feist, 499 U.S. at 349.*

* The Copyright Office will sometimes register a compilation of prices. (See SPA 36-37 (Compendium of Copyright Office Practices, Compendium II, § 307.02 (1984) (“Telephone books, directories, price lists, and the like may be registered if they contain sufficient authorship in the form of compilation or other copyrightable material.”)); SPA 9 (Literary Online Practices, Chap. 20 C.II.A.1.a (defining a “compilation of data” as a “compilation of facts, terms, etc., in which there could be no separate copyright protection (e.g., parts catalogs, phone directories, real estate listings, price lists, some genealogies).”). A compilation registration, however, does not confer copyright protection on the otherwise uncopyrightable component parts of the compilation, such as an individual price on a price list. See Feist, 499 U.S. at 349 (facts do not become original through

In CCC, this Court applied the Supreme Court’s reasoning in Feist and held that the Red Book – a compendium of used car valuations – was copyrightable. See CCC, 44 F.3d at 63, 67-68. The Court repeatedly emphasized that its decision concerned compilations of prices and “the protection, if any, to be accorded to compilations.” Id. at 70; accord id. at 63 (“this appeal raises the question of the scope of protection afforded by the copyright law to such compilations of informational matter”). As the district court here noted, 389 F. Supp. 2d at 542, the copyright infringement in CCC involved “the takings by CCC from the Red Book . . . of virtually the entire compendium.” CCC, 44 F.3d at 72 (“The copying is so extensive that CCC effectively offers to sell its customers Maclean’s Red Book through CCC’s data base.”). CCC thus stands for the proposition that wholesale copying of a compilation of prices is barred; it does not extend copyright protection to an individual price. Cf. ATC Distribution Group, 402 F.3d at 711 (characterizing CCC as a compilation decision). Accordingly, the district court properly held that “CCC does not support NYMEX’s argument,” because in CCC, “it was the compilation that was protected,” whereas NYMEX “did not seek a copyright registration for a compilation and does not rely on the concept of compilations to protect its settlement prices.” NYMEX, 389 F. Supp. 2d at 542

association with a copyrighted compilation).

(citing counsel’s statement at oral argument (JA 1541-42)).

CCC’s passing references to individual valuations in dicta, see 44 F.3d at 67, 68 n.8, do not alter the fundamental holding of the case, which is limited to the copyrightability of compilations of prices. To the extent these passages in CCC can be construed to recognize a copyright in individual valuations, they are erroneous. CCC appeared to distinguish between price “predictions” based on “professional judgment and expertise” and “mechanical derivations of historical prices,” 44 F.3d at 67, but copyright law does not support such a distinction. No single price, no matter how derived, is copyrightable.

The district court also properly distinguished CDN Inc. v. Kapes, 197 F.3d 1256 (9th Cir. 1999). See NYMEX, 389 F. Supp. 2d at 542 n.11. Like CCC, the CDN decision involved a compilation – a wholesale coin price guide that compiled and reported the prices of collectible coins. See CDN, 197 F.3d at 1257. The CDN court recognized that “[d]iscoverable facts, like ideas, are not copyrightable,” but noted that “compilations of facts are copyrightable even where the underlying facts are not,” and described the issue in the case as “whether the prices themselves are sufficiently original as compilations to sustain a copyright.” Id. 197 F.3d at 1259. As the district court here concluded, to the extent the Ninth Circuit’s decision in CDN suggests the remarkable proposition that an individual

price is itself a copyrightable compilation, “it is an unsupportable extension of copyright.” NYMEX, 389 F. Supp. 2d at 542 n.11; see R. Berman and S. Plotkin, “Case Suggests Copyright Can Protect Numbers,” Nat’l Law Journal, Jan. 31, 2000, at C14 (available on Westlaw) (calling CDN decision “perplexing”). Indeed, in the seven years since CDN was decided, no court has relied on it for the proposition that a price is copyrightable, and this Court should not do so here.

POINT II

THE DISTRICT COURT CORRECTLY DETERMINED THAT A SETTLEMENT PRICE IS AN UNCOPYRIGHTABLE SHORT PHRASE

As the district court recognized, “[t]he Copyright Office’s long-standing practice is to deny copyright protection to words and short phrases.” NYMEX, 389 F. Supp. 2d at 543 & n.12. The NYMEX settlement prices are short phrases. The district court thus correctly ruled that “the short phrase analysis provides an additional and compelling basis for the conclusion that NYMEX’s settlement prices are non-copyrightable.” Id. at 544.

A. Short Phrases Are Not Copyrightable

The Copyright Office’s practice of denying registration to “words and phrases” dates back at least to 1899. Southco, Inc. v. Kanebridge Corp., 390 F.3d 276, 285 (3rd Cir. 2004), cert. denied, 126 S. Ct. 336 (2005) (citing 1 W. Patry,

Copyright 333 n. 89 (1994)). The Copyright Office issued Circular No. 46, titled “Copyright for Commercial Prints or Labels” in 1958, and reissued it on several occasions through 1976. (SPA 27-30).^{*} The circular explains that “[t]o be entitled to copyright protection, a work must contain a substantial amount of original text or pictorial material.” (Id. at 28). Thus, “[b]rand names, trade names, slogans, and other short phrases or expressions cannot be copyrighted, even if they are distinctively arranged or printed.” (Id.).

In 1959, the Copyright Office published its first short phrases regulation.

See 24 Fed. Reg. 4955-01 (June 18, 1959). The regulation, issued pursuant to 17

U.S.C. § 702, currently provides, in relevant part:

Material not subject to copyright.

The following are examples of works *not subject to copyright* and applications for registration of such works cannot be entertained:

(a) *Words and short phrases* such as names, titles, and slogans; familiar symbols or designs; mere variations of typographic ornamentation, lettering or coloring; mere listing of ingredients or contents

37 C.F.R. § 202.1 (emphasis added).

* The Copyright Office regularly publishes Circulars to explain and interpret important copyright concepts and principles to the public. See Morris v. Business Concepts, Inc., 283 F.3d 502, 505 (2d Cir. 2002) (citing Copyright Office Circular as the Office’s interpretation of a copyright precept).

As the district court recognized, NYMEX, 389 F. Supp. 2d at 543, the short phrase copyright prohibition embodied by the regulation was swiftly endorsed by the Second Circuit in Kitchens of Sara Lee, Inc. v. Nifty Foods Corporation, 266 F.2d 541, 544 (2d Cir. 1959). There, a copyright was sought for standard cake box labels, including pictures, serving directions and ingredients. Id. at 545. In rejecting the copyright claim as to serving directions and ingredients, the Second Circuit quoted the short phrase regulation and described it as a “fair summary of the law.” Id. at 544. This Court and others have relied on the doctrine ever since. See Matthew Bender & Co. v. West Publ’g Co., 158 F.3d 674, 683 (2d Cir. 1998) (doubting that editorial text changes to case titles or capitalization would be copyrightable, citing short phrases regulations); Arica Institute Inc. v. Palmer, 970 F.2d 1067, 1072 (2d Cir. 1992) (denying copyrightability as to “single words or short phrases which do not exhibit the minimal creativity required for copyright protection”); Murray Hill Publ’ns, Inc. v. ABC Communications, Inc., 264 F.3d 622, 632-33 (6th Cir. 2001) (holding unprotectable, as a short phrase or slogan, “Good morning, Detroit. This is J.P. on JR in the A.M. Have a swell day.”); CMM Cable Rep., Inc. v. Ocean Coast Props., Inc., 97 F.3d 1504, 1519-20 (1st Cir. 1996) (noting that “[i]t is axiomatic that copyright law denies protection to ‘fragmentary words and phrases’ and to ‘forms of expression dictated solely at

functional considerations’ on the grounds that these materials do not exhibit the minimal level of creativity necessary to warrant copyright protection,” and holding unprotectable “if you’re still ‘on the clock’ at quitting time” and “clock in and make \$50 an hour”); Alberto-Culver Co. v. Andrea Dumon, Inc., 466 F.2d 705, 711 (7th Cir. 1972) (applying Sara Lee and holding “most personal sort of deodorant” an “ordinary phrase” lacking “appreciable amount of original text” and therefore not protected by copyright); F.A. Davis Co. v. Wolters Kluwer Health, Inc., 05-CV-681, 2005 U.S. Dist. LEXIS 17161, at *16 (E.D. Pa. Aug. 16, 2005) (book topic headings are uncopyrightable short phrases).

B. NYMEX Settlement Prices Are Short Phrases

The district court correctly determined that NYMEX settlement prices are short phrases that cannot be protected by copyright. NYMEX, 389 F. Supp. 2d at 543-44. As reflected in the short phrase regulation and the Copyright Office circulars cited herein, the Register of Copyrights declines to register copyrights in short sets of numbers – such as prices or the numbers ascribed to tool or machine parts – because they do not “constitute[] copyrightable subject matter.” 17 U.S.C. § 410. The district court applied this rule to the numerical settlement prices in this case, citing recent decisions by the Third and Sixth Circuit Courts of Appeals agreeing with the Register and denying copyright protection to part numbers. See

NYMEX, 389 F. Supp. 2d at 543-44 (citing ATC Distribution Group, 402 F.3d at 708-10 (transmission part numbers not eligible for copyright protection); Southco, 390 F.3d at 285-86 (tool part numbers excluded from copyright protection “because they are analogous to short phrases or the titles of works”) (Alito, J.); Sega Enters. Ltd. v. Accolade, Inc., 977 F.2d 1510, 1524 n. 7 (9th Cir. 1993) (20-byte initialization code is of *de minimis* length and thus likely a “word” or “short phrase” not protected by copyright law pursuant to 37 C.F.R. § 202.1(a))).

The district court correctly ruled that the courts’ reasoning in ATC and Southco precluding copyright protection for part numbers “applies with equal force to NYMEX settlement prices.” NYMEX, 389 F. Supp. 2d at 544. As in CMM Cable, a price expressed in numbers and currency is a “form of ‘expression dictated solely at functional considerations.’” Id. (quoting CMM Cable, 97 F.3d at 1519). Further, as the district court noted, public conduct would be unreasonably limited if a settlement price in dollars “constituted copyrightable subject matter.” NYMEX, 389 F. Supp. 2d at 544. Unlike a trademark, the exclusive rights granted by a copyright are not limited to any particular context. Id. Thus, a grant of copyright protection to one of the NYMEX settlement prices would apply to that dollar price regardless of its use, regardless of the context. Id. If NYMEX had a copyright in a given price, then any reproduction of that price, in any context,

might infringe the copyright if the author had access to NYMEX's prices (as most people would, since they are published in the major newspapers the day after they are generated) (JA 1545). Then-Judge Alito recognized the peril of such a result in his opinion in Southco:

Because the owner of a copyright “has the exclusive rights” “to reproduce the copyrighted work,” 17 U.S.C. § 106, if a part number (say, 471020210, to take the example discussed above) were copyrighted, *any* use of the number would potentially infringe the copyright. Moreover, if Southco's nine-digit numbers are protected, would there be a principled basis for denying protection to a number with, say, seven or five digits? Could a company or person thereby obtain the exclusive right to use the number 4,710,202 or 47,102? In light of the huge number of part and product numbers (and other analogous numbers) that now exist, this prospect gives reason for concern.

390 F.3d at 286; see also ATC Distribution Group, 402 F.3d at 709 (noting same concern).

As the district court noted, although the fair use doctrine might provide a defense for the user in such circumstances, it would be “highly inefficient” to force users to prove an affirmative defense to copyright infringement for the mere use of a price. NYMEX, 389 F. Supp. 2d at 544; see also ATC Distribution Group, 402 F.3d at 709 (requiring fair use affirmative defense “extremely inefficient”); Southco, 390 F.3d at 286 (requiring fair use affirmative defense “may impose undue burden”). The inefficiency of litigating what plainly ought to

be permitted – the use by others of the settlement prices – is particularly troubling in the context of lawsuits between business competitors. Cf. Smithkline Beechum Consumer Healthcare, I.P. v. Watson Pharms., Inc., 211 F.3d 21, 29 n.5 (2d Cir. 2000) (copyright protection in text may not be used as means to leverage control over uncopyrightable product and harass competitors).*

C. Even if NYMEX Settlement Prices Derived From a Creative Process, They Are Uncopyrightable Short Phrases

NYMEX tries to overcome the district court’s ruling that a settlement price is a short phrase by arguing that its settlement prices are “a creative expression in numerical form.” NYMEX Br. at 37. But no matter how creative one may be in writing a short phrase, the phrase itself lacks the measure of creativity required for copyright protection. The Copyright Office’s Circular No. 34 (June 2002) (SPA 31-33, available at <http://www.copyright.gov/circs/circ34.html>), which elaborates on the Register’s practice regarding short phrases, explains that “[e]ven if a name, title, or short phrase is novel or distinctive or if it lends itself to a play on words, it cannot be protected by copyright.” (SPA 31). Excluded from protection under Circular No. 34 are “brief combinations of words such as . . . [c]atchwords,

* This is not to suggest an antitrust violation here. That issue was litigated below and not appealed. See NYMEX v. IntercontinentalExchange, Inc., 323 F. Supp. 2d 559 (S.D.N.Y. 2004).

catchphrases, mottoes, slogans . . . [and] [m]ere listing of ingredients, as in recipes, labels, or formulas.” (Id.; see also SPA 34-35, Compendium of Copyright Office Practices, Compendium II, § 305.01 (1984) (“Names, titles, slogans, and other short phrases or expressions are not copyrightable, even if such expressions are novel, distinctive, or lend themselves to a play on words.”)).

Copyright protection does not extend to short phrases, no matter how much creativity is expended in creating them, because they are understood not to include a “substantial amount of original text.” (SPA 28 (Circular No. 46)); accord Arica Institute, 970 F.2d at 1072; CMM Cable, 97 F.3d at 1519; Alberto-Culver, 466 F.2d at 711.* NYMEX’s arguments about creativity misdirect the copyright inquiry to how creative an author is in drafting a short phrase – *i.e.*, how creative

* Instead of copyright, trademark may be, in a proper case, the mechanism for protecting short phrases, at least when used in association with commercial products. The Copyright Office’s Circular No. 46 notes that “[u]nder certain circumstances, a name, slogan, phrase, or symbol can be protected under the common law principles of unfair competition, or it can be registered under State or Federal trademark statutes.” (SPA 28). Likewise, Circular No. 34 explains that short phrases may be entitled to protection “under the general rules of law relating to unfair competition, or they may be entitled to protection and registration under the provisions of state or federal trademark laws.” (SPA 32). The latter circular notes that the “federal trademark statute covers trademarks and service marks – those words, phrases, symbols, or designs that identify the source of the goods or services of one party and distinguish them from those of others.” (Id.). We do not suggest that a trademark or unfair competition theory would be viable here.

NYMEX may be in determining the precise value of a particular contract on a particular day. But copyright law is not concerned with how creative a process the author uses in writing an expression; it is concerned with the creativity of the expression itself. See ATC Distribution Group, 402 F.3d at 708-09 (creativity inherent in system generating numbering scheme does not render numbers copyrightable); Southco, Inc. v. Kanebridge Corp., 258 F.3d 149, 151 (3d Cir. 2001) (“For purposes of copyright law, however, Southco’s numbering system itself and the actual numbers produced by the system are two very different works.”).

Congress’s decision not to disturb the Copyright Office’s long-standing practice of not registering short phrases, despite repeated, extensive revisions of the copyright laws, establishes that Congress approves of the complete bar against granting copyright protection to short phrases. When Congress was considering substantially revising the copyright laws before 1976, it expressly recognized that short phrases would remain outside of copyright protection. See H.R. Rep. No. 90-83, at 14-15 n.1 (1967) (listing, among “other areas of existing subject matter that this bill does not propose to protect but that future Congresses may want to,” “titles, slogans, and similar short expressions”). Congress’s acquiescence in the longstanding administrative rule against registering short phrases suggests that

Congress approves of the rule. Cf. J.E.M. AG Supply, Inc. v. Pioneer Hi-Bred Int'l, Inc., 534 U.S. 124, 145 (2001) (Congress's awareness of the Patent & Trademark Office's practice of issuing utility patents on plants "suggests a recognition on the part of Congress" that the practice was authorized by statute).

To be sure, one well-known treatise suggests that "even a short phrase may command copyright protection if it exhibits sufficient creativity." (SPA 45 (1 Melville B. Nimmer & David Nimmer, Nimmer on Copyright, § 2.01[B] at 2-17 (2004)). But another esteemed commentator suggests the opposite, in keeping with the Register's practice. (SPA 49 (Paul Goldstein, Copyright, § 2.7.3 (2003) (noting that courts withhold copyright protection from words and short phrases, and that "[t]he shorter a phrase is, the less likely it is to be original and the more likely it is to constitute an idea rather than an expression")). Even Nimmer concedes that "[t]he smaller the effort (e.g., two words) the greater must be the degree of creativity in order to claim copyright protection." (SPA 45).

In any event, to the extent the statute is ambiguous as to whether short phrases may be copyrighted, the district court correctly found that the Register of Copyright's long-standing practice of denying copyright protection to words and short phrases is entitled to deference. NYMEX, 389 F. Supp. 2d at 543; see also De Sylva v. Ballentine, 351 U.S. 570, 577-78 (1956) (deference to Copyright

Office's interpretation of ambiguous provisions in copyright statutes ordinarily warranted); Morris, 283 F.3d at 505-06 (denying panel rehearing, relying in part on Copyright Office's view as to registration of serial, and rejecting statement in Nimmer on Copyright); Southco, 390 F.3d at 286-87 n. 5 (deferring to views of Copyright Office regarding short phrases because "[a]t a minimum, the practice of the Copyright Office 'reflects a 'body of experience and informed judgment to which courts and litigants may properly resort for guidance'"). Thus, the district court's ruling that the settlement prices are uncopyrightable short phrases should be affirmed.

POINT III

THE DISTRICT COURT CORRECTLY CONCLUDED THAT THE MERGER DOCTRINE PROVIDES AN ALTERNATIVE BASIS FOR DISMISSING NYMEX'S CLAIM OF COPYRIGHT INFRINGEMENT

In addition to its holdings that the settlement prices are not copyrightable as facts and short phrases, the district court correctly ruled that the merger doctrine precludes a claim of copyright infringement. See NYMEX, 389 F. Supp. 2d at 543. Because a settlement price in dollars is the only way to express the idea being conveyed by NYMEX, the merger doctrine precludes a copyright

infringement claim here.*

The merger doctrine provides that “if there is just one way to express an idea, the idea and expression are said to merge, and the expression is not protectable.” Yurman Design, Inc. v. PAJ, Inc., 262 F.3d 101, 111 (2d Cir. 2001). This Court deems the merger doctrine to be a “corollary maxim” to the fundamental rule against copyrighting an idea: “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.” Kregos, 937 F.2d at 705. Thus, “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.” CCC, 44 F.3d at 68.

* NYMEX incorrectly asserts that the district court erred in considering the merger doctrine as part of a copyrightability analysis. NYMEX Br. at 31. This Court generally considers the merger doctrine in determining whether an infringement has occurred, rather than whether a copyright is valid. See CCC, 44 F.3d at 72 n.26; Kregos v. Associated Press, 937 F.2d 700, 705 (2d Cir. 1991). However, the logic underlying this approach is to ensure that the Court has a “detailed and realistic basis for evaluating the claim that protection of expression would inevitably accord protection to an idea.” Kregos, 937 F.23d at 705. Where, as here, the work in question provides no basis for distinguishing between those elements not considered in an infringement analysis because of merger and those elements that may be considered despite merger, the distinction between the two views of merger analysis is a distinction without a difference.

The district court correctly determined that the merger doctrine applies to NYMEX settlement prices. As it explained, “because NYMEX’s settlement prices are the actual prices and are the only way to express the idea of a settlement price stated in numbers – the expression of the price is . . . not sufficiently distinct from the idea of the price to warrant copyright protection.” NYMEX, 389 F. Supp. 2d at 542 (citing ATC, 402 F.3d at 708-09).

NYMEX tries to escape this conclusion by arguing that the district court misunderstood the “idea” here. Thus, NYMEX claims that the idea at issue is not that a particular futures contract has a particular value at the end of a trading day, but, more generally, “that a sound and reasonable opinion of fair market value for each NYMEX contract . . . may be achieved by assessing trades, bids and offers.” NYMEX Br. at 33. NYMEX contends that it is not seeking to monopolize this broad concept, but only “its expressions of the consensus opinions of the Settlement Price Committee members.” Id.

This argument is without merit. NYMEX has avowed that its settlement prices are the “cornerstone of the clearing process” and are the basis for calculating whether its customers made or lost money on a particular day. (JA 1084). Given this reality, it is simply not credible for NYMEX to argue that its settlement prices reflect only one expression (among many) of the sweeping idea

that market values can be derived from market transactions. To the contrary, as the district court correctly ruled, a NYMEX settlement price is the expression of a much more specific idea, for example, that a Henry Hub natural gas futures contract is worth \$25 dollars at the end of a given day. NYMEX, 389 F. Supp. 2d at 541-42. Indeed, that is how NYMEX itself describes a settlement price: “the amount which NYMEX treats as the value, at the end of trading each day, of a particular futures contract for a particular commodity for future delivery at a particular time.” NYMEX Br. at 6. Thus, the district court properly determined that “NYMEX’s settlement prices are the actual prices and are the only way to express the idea of a settlement price stated in numbers.” NYMEX, 389 F. Supp. 2d at 542.

NYMEX’s claim that a settlement price is just one possible expression of a broad, all-embracing concept is a transparent effort to avoid the merger doctrine. In this way, NYMEX seeks to take advantage of Judge Learned Hand’s observation that any expression can be described at “varying levels of abstraction from the concrete realization of the original.” CCC, 44 F.3d at 69 (citing Nichols v. Universal Pictures Corp., 45 F.2d 119, 121 (2d Cir. 1930)). Here, because the settlement price is obviously the only way to express the idea behind it, NYMEX’s only defense to the merger doctrine is to claim to be relying on a more abstract,

general idea. The Court should reject this effort, and affirm the district court's ruling that the merger doctrine precludes a claim of copyright infringement here.

CONCLUSION

The judgment of the district court should be affirmed.

Dated: New York, New York
March 27, 2006

Respectfully submitted,

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Certificate of Compliance

Pursuant to Rule 32(a)(7)(c) of the Federal Rules of Appellate Procedure, the undersigned counsel for amicus curiae hereby certifies that this brief complies with the type-volume limitation of Rule 32(a)(7)(B). As measured by the word processing system used to prepare this brief, there are 6836 words in this brief.

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ANTI-VIRUS CERTIFICATION

Case Name: N.Y. Mercantile Exchange v. Intercontinentalexchange

Docket Number: 05-5585-cv

I, Natasha R. Monell, hereby certify that the Amicus Brief submitted in PDF form as an e-mail attachment to briefs@ca2.uscourts.gov in the above referenced case, was scanned using Norton Antivirus Professional Edition 2003 (with updated virus definition file as of 3/27/2006) and found to be VIRUS FREE.



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Dated: March 27, 2006

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A. DEFINITION OF COMPILATION: A work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship.

1. Kinds of compilations: A compilation is not associated with any particular class of works, in contrast to "music," "artwork," or "computer program," but is found in all classes. There are two types of compilations – a compilation of data elements and a compilation of copyrightable material or works described as collective works..

a. Compilation of Data: This is a compilation of facts, terms, etc., in which there could be no separate copyright protection (e.g., parts catalogs, phone directories, real estate listings, prices lists, some genealogies). Such a compilation is considered an all new work, unless it is a revision of a previous compilation.

b. Collective Work Compilation: This is a compilation that involves material that could be copyrightable. This material could be preexisting (e.g., anthology of previously published poetry, articles from previous periodicals, etc.) or new, i.e., not previously published or registered, and owned by the compiler (a collection of short stories by the compiler from 2001, thoughts from the diary of the compiler over 30 years).

. REQUIREMENT FOR A COPYRIGHTABLE COMPILATION: To be copyrightable, a compilation must represent a modicum of original authorship in its selection, coordination, or arrangement of elements (it is rare that compilation authorship is expressed as "coordination").

1. Feist Standard: In its holding in *Feist Publications, Inc. v. Rural Telephone Co., Inc.* (499 U.S. 340, 1991), the Supreme Court held that the alphabetical listing of names and addresses in the white pages of a phone directory did not represent sufficient original authorship for it to be copyrightable as a compilation. The Court rejected the "sweat-of-the-brow" doctrine; effort per se is not copyrightable. The Court confirmed a very low quantitative threshold for copyrightability of compilations, as well as works in general.

2. Quantitative Requirement for a Compilation: As with all other authorship or works, there is a quantitative threshold that a compilation must meet to be "copyrightable." The House Report accompanying the 1976 statute cites as de minimis a compilation that involves only three elements, regardless of whether there is original authorship in the selection or ordering of these elements. This standard represents a point of departure for the Office in determining whether there is a sufficient number of elements involved.



REQUIREMENT FOR A COPYRIGHTABLE COMPILATION

3. Originality of Compilation Authorship: Either the selection or the ordering must represent original authorship (it is not necessary for both to be original).

a. Originality of Selection of Elements/Data: There must be an indication of choice or creative judgment. The selection cannot be predetermined or completely predictable (e.g., the collected stories by Zane Grey from 1949, a listing of parts added to a catalog during the last year in chronological order, a listing of names and addresses of alumni from the Class of 1969, who are still living).

Example:

Title: BALANCE. Sp-2: Compilation of words. Work: acrostic based on the word "balance": Being Aware of Love And Needs Completes Existence.

Clear: There is a creative element to the selection of the words for this acronym.

b. Originality of Co-ordination/Arrangement: Originality in this context means that the ordering cannot be mechanical, obvious, or dictated by the elements (e.g., a numerical, chronological, or alphabetical listing; a family tree; a list of 10 top teams based on scores).

4. Examining Division Policy**a. Applying Criteria To Determine Copyrightability of Compilation:**

This is generally a complex process, one in which the examiner must:

- 1) take into account the kind of material being compiled;
- 2) assess the originality or creativity of the selection and/or ordering,
and
- 3) balance these aspects with the number of elements involved.

Note: In determining the originality of the compilation, you should consider the following:

Selection:

- From how large or diverse of a pool was the selection made?
- How obvious was the selection?
- How many different selection configurations are possible?

Arrangement:

- How many different ordering configurations are possible? (e.g., there are 24 ways to order four numbers)
- How obvious or logical is the ordering?

Where authorship in addition to compilation is being claimed by the same author, we do not have to be as rigorous in our determination regarding the compilation.

b. Extent of Claim for Compilations: Often compilations embody authorship in addition to compilation, e.g., introductory text, editorial revisions, etc. It is the normal rule, however, that the Office take action based

on the authorship being claimed on the application, and not being up the possibility of a later claim, even if corresponding. Genealogies are an exception to this rule because the applicant is usually uninformed and confused. We should not go too far even here, however.

c. Updated Compilations: Many compilations are based on creating an organizational framework for recording data. A typical example is a real estate multiple listing database, in which the compilation is based on the setting up the data fields for recording information. Such a compilation is updated by inserting new data into this original framework, utilizing the criteria established by it. Policy: If the original selection and/or grouping of data or categories constituted copyrightable authorship, the update also represents copyrightable selection or arrangement authorship, providing more than a de minimis quantity of new data is added. We will assume this is the case, unless there is a clear indication that the data added is de minimis.

d. Unauthorized Compilation of Copyrighted Materials: Where the compilation is clearly unauthorized (e.g., the applicant acknowledges as much), Write to question basis of claim. This is used as an example in the House Report on the 1976 law of an unauthorized use in which the new material could not be separated from the copyrighted material use unlawfully.

C. ISSUES RELATING TO SPECIFIC KINDS OF COMPILATIONS:**1. Phone Directories: (Includes: commercial telephone directories, street directories, criss-cross directories, private phone directories, membership directories).**

a. White Pages: Based on the Supreme Court decision in Feist v. Rural, white page sections that present standard information (name, address, phone number), do not represent sufficient original compilation authorship to be copyrightable. The effort required to gather the information is not considered.

If a claim statement implies that the claim extends to the white pages as well as to the yellow pages (e.g., revisions throughout), write/call for an acceptable statement limiting the claim to the yellow pages.

If additional elements are included in the white pages, there might be a copyrightable compilation, e.g., profession, salary, years in business, speciality, etc.). If this appears to be the case, but you are not sure, consult with your SE/TL.

b. Yellow Pages: The placement of the advertisements normally involves sufficient choices to support a compilation claim. There may original artwork present as well.

Examples of Directories:

1. Street directory containing only names, addresses, and phone numbers arranged alphabetically by street, then numerically under the street name. In addition, gives cross streets and a "B" indicating a business listing.

Reject for lack of originality.

2. Business directories arranged numerically by standard industrial classification code (SIC code), then alphabetically by company name within each code. Each entry includes company name, address, phone number plus SIC code number and number of employees.

Reject as de minimis.

3. Specialized business directory (e.g., health clubs, antique dealers, museums, etc.) compiled from classified directories (yellow pages) from wide area. Contains various added features gleaned not only from the yellow pages from from the businesses or entities themselves (franchise code, yellow-page ad size code, year of first listing code, owner/manager, number of employees.

Clear. This directory has enough originality based on the number and kind of added features.



PERIODIC COMPILATIONS
C. ISSUES RELATING TO DIFFERENT KINDS OF COMPILATIONS

2. Serial Compilations that are Periodically Updated: (Includes: Parts Catalogs, real estate listings, various databases):

a. Original or First Publication: Examine the work carefully. If the compilation presents the possibility of a variety of choices either in the selection or arrangement, **Clear**. If the selection is exhaustive (e.g., parts catalog covers limited, standard information on all parts sold by the company) and the arrangement obvious (presents the parts in numerical order), **Write to question compilation**.

b. Updates to Prior Compilations: Assuming the original compilation was registered, **Clear** unless there is a clear indication that the amount of data compiled for the update is minimal.

Examples of Periodically Updated Compilations:

1. Classified collection of manufacturers' catalogs, updated annually, organized into broad categories (general data, sitework, concrete, masonry, metals, wood & plastics, thermals & moisture protection), which are divided into subdivisions.

Clear the original and the subsequent updates or revised compilations. The selection/ordering of the categories and headings represents sufficient quantity and originality.

2. Employee relocation directory. Membership directory organized into 4 groups: appraisers, brokers, relocation companies, maps, plus explanatory text that is probably reprinted when the directory is updated every year. Each group has various added features about each person or firm.

listed.

Clear the original and the subsequent updates. This work goes well beyond straight obvious listings.



REJECT THE COMPILATIONS
ISSUES RELATING TO SPECIFIC KINDS OF COMPILATIONS

3. Periodic Cumulations: Where the compilation represents an accumulation of information published previously in smaller editions (e.g., monthly or quarterly editions), the selection may be exhaustive and the ordering predetermined (sequentially/chronologically). We must take care in these works to look for an indication of original, creative choices in the selection or ordering.

Examples of Periodic Cumulations:

1. Title: Biological Abstracts Semi-Annual Cumulative Index.

Sp. 2: Compilation. Deposit: It appears to be a mechanical integration of previously published indices in the same series.

Reject: It there is clearly other authorship, apparently owned by the same party, that would support a claim. **Reject the compilation,** but raise the possibility of an alternative claim.

2. Title: Oregon Blue & White Book 2000 Cumulative Pamplet.

Sp. 2: Compilation of tables. Deposit: Cross-reference index showing the page number of case decisions in one reporter and the corresponding vol. and Page no. of that same case in a separate reporter.

Reject:

4. Standard Organizational Charts: Typically, these charts present standard information in an obvious arrangement. In this case, **Reject.** However, look for non-standard aspects.

Examples of Standard Organizational Charts:

5. Mailing (or Subscriber) Lists: Typically, these lists present standard information about a pre-determined group in an obvious arrangement (e.g., a mailing list of donors who contributed more than

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§250 in a given year, arranged sequentially by zipcode and alphabetically within each zipcode). In any case, **Reject.**

Examples of Mailing/Subscriber Lists:





6. Genealogies; Historical or Public Records: Watch for exhaustive selection of elements (alphabetized list of names on all gravestones in cemeteries in Augusta County), or a verbatim copying of records in chronological order (the Lebanon PA Lutheran church birth records from 1850 to 1900). If there is no original compilation, write. You may want to raise a question about another possible claim, if an examination of the copy warrants it.

7. Answer Sheets (amended 1/23/04): Answer sheets are forms used to record the correct answers to multiple choice questions. For each question there is a row of a number of responses. We should apply the Feist standard with these works to determine whether one represents a copyrightable compilation of data, one of which is correct. You should keep in mind standard information normally associated with answer sheets. With the master answer sheet on which the correct answers are recorded, the placement of the correct response in each row of responses may represent a copyrightable compilation. Where a claim in compilation is asserted with this work, we should not question it unless there is an indication in the registration materials that no compilation exists (e.g., a statement on the copy indicates that the assignment of correct responses in each row was done at random by a computer).

D. CLAIM STATEMENTS FOR COMPILATIONS (see also CII: 624 - 625): Generally, the work should be examined for the authorship being claimed, and the claim should be cleared, questioned or rejected based on that authorship.

1. "Compilation" as Sole Statement for an Author: Clear only if the compilation is clearly copyrightable (or there is no reason to assume that it is not). If it appears to be de minimis or pre-determined, Write to question.

4. "Compilation" with Other Authorship Elements:

a. Single Author on Appl: Clear if the elements taken as a whole represent copyrightable authorship. It is not as critical that the compilation be clearly copyrightable. On the other hand, if there is no compilation or it is obviously de minimis or pre-determined, Write to reject claims in compilation

b. Multiple Authors on Appl:

1) "Compilation" Sole Contribution of One of the Authors: The compilation must be clearly copyrightable to have the compiler considered a co-author of a joint work.

2) Compiler Contributed Other Copyrightable Authorship: This is similar to 2.a. We would not question the compilation unless it were clearly de minimis or not present.



REG. THE COMPILATIONS
IF CLAIM STATEMENTS FOR COMPILATIONS

c. “Compilation, Selection and Arrangement,” Selection or Arrangement not Copyrightable:

Clear. Each of these terms represents a claim in “compilation.” Thus, even though the selection or the ordering is not copyrightable or is not present, the other element still supports a claim in “compilation.” The same would be true if the claim were in “selection and arrangement” without any reference to compilation.

d. “Data” with “Compilation”: Write/call to delete the reference to “data,” unless the work contains copyrightable authorship to which this term might apply.

Example:

Sp 2: Compilation and new data. **Deposit:** Genealogy of the Gregory family by recording facts from selected church records. Includes some occasional comments from author.

Clear. Selection is copyrightable compilation and “data” could encompass comments, providing only one author involved.

3. Other Terms Used to Register Compilations:

a. Only “Entire Work” or Space 2 Blank: If the work is a fact-based compilation and there is copyrightable authorship to support any claim (whether or not the compilation itself is copyrightable), Clear. The nature of the work indicates that the claim covers less than the entire work. The statement in space 2 does not specifically claim in “compilation.”

b. Only “Entire Text”: This claim should be cleared only if the claim extends to the entire copyrightable text (not including factual statements and the like). It should not be read as extending to a compilation. (This represents a change from the the Compilations Guidelines in the LIT Practice Manual).

c. Only "Index": Clear if the index represents copyrightable compilation authorship (this will normally involve selection because the arrangement is usually alphabetical).

d. "Prices" alone or with Other Authorship: Write to reject the claim in "prices." Prices are not generally considered copyrightable because the determination of prices is considered a business decision and thus they represent facts. If the term is included with other copyrightable authorship by the same author, you can call to request authorization to delete this term.

e. "Crossword Puzzle": Although this term describes the nature of the work, it is one that virtually always involves a copyrightable compilation.



20011: COMPILATIONS

4. "Collective Work" as an Statement of Claim: A collective work is one in which a number of contributions constituting separate and independent works in themselves, are assembled into a collective whole. As a statement of claim "collective work" includes authorship of the work as a whole (e.g., the editing and compilation), as well as any contributions of which the same author is considered to be the author as creator or employer for hire.

a. General Policy re "Collective Work": If the work deposited is a collective work, Clear. We do not have to verify whether the claim in fact includes any contributions.

b. Policy for Print Works: If the work is an issue of a serial published in print form, Clear, whether or not the particular issue is a collective work.

c. Policy for Online Works:

1) Work Is a Single Article: If the work being registered is a single article from an online journal that is published one article at a time, Write/call to clarify claim and request an appropriate authorship statement (e.g., "text," "editing"). (Note: if Short Form SE or Form SE/Group was used, request a new application using Form TX.)

2) Group Serial Registration Includes Single and Multiple Article Issues: Clear, providing at least one issue is a collective work. (Note: The same applies to a group of online newsletters published after 6/7/99, if the form has a "collective work" check-off box.)

[Should NP's position stated in memo of 5/29/98 be included? She may have backed off this position]

5. Statements of Claim for Revised Compilations:

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a. Acceptable Compilation Statements and Equivalents:

Updated Compilation

Updates and Revisions

Compilation

Additions and Deletions to Update..

Revised Compilation

b. "Revised Data" "New and Revised Data": If the only apparent authorship meant by the term is a compilation, Write/call to change the term to "revised compilation" or the like. If the term clearly refers to copyrightable text, Clear. [This is change from Literary Practice Manual.

END OF CHAPTER

Copyright for Commercial Prints or Labels

WHAT IS A COMMERCIAL "PRINT OR LABEL?"

The term commercial "prints and labels" generally refers to single-page works that contain copyrightable pictorial matter, text, or both, and that are published in connection with the sale or advertisement of articles of merchandise.

WHAT CAN BE COPYRIGHTED AS A PRINT OR LABEL

Original Text or Pictorial Matter Essential. A work is not copyrightable merely because it can be classified as a commercial "print or label." To be entitled to copyright protection, a work must contain a substantial amount of original text or pictorial material. When a print or label consists only of uncopyrightable elements, registration is not possible.

Classification. Separate prints and labels used for articles of merchandise, and advertisements of merchandise in periodicals, are registered in Class K on Form KK. Catalogs, brochures, and other multipage works are more appropriately classified as "books," and may be registered in Class A on Form A. However, a folder that can be opened out to form a single page need not be considered a multipage work, and is classifiable as a commercial print or label. Copyright procedures for books are different from those for commercial prints and labels. For information about copyrighting books, request Circular 60.

WHAT CANNOT BE COPYRIGHTED AS A PRINT OR LABEL

Unpublished Prints and Labels. An unpublished work is not entitled to registration as a commercial "print or label." Unpublished works are protected at common law against unauthorized use before publication occurs, without any action being required in the Copyright Office.

Names, Short Phrases, Typography, Coloring, etc. Brand names, trade names, slogans, and other short phrases or expressions cannot be copyrighted, even if they are distinctively arranged or printed. The following elements are also insufficient in themselves to support a copyright registration: familiar symbols or designs, mere variations of typographic ornamentation, lettering or coloring, and mere listings of ingredients or contents.

Copyright Different from Trademark Registration. The type of protection available under State or Federal trademark laws cannot be obtained by copyright. Under certain circumstances a name, slogan, phrase, or symbol can be protected under common law principles of unfair competition, or it can be registered under State or Federal trademark statutes. For information about Federal trademark registration, write to the Commissioner of Patents and Trademarks, Washington, D.C. 20231.

NEW VERSIONS OF PRINTS AND LABELS

A revised version of a previously published print or label can be copyrighted as a "new work," but only if the additions or revisions in the new version are copyrightable in themselves. Reprints are not registrable, and changes in a brand name, color scheme, or other uncopyrightable element will not support a new registration.

HOW TO SECURE STATUTORY COPYRIGHT

Three steps must be taken to comply with the law concerning commercial prints and labels: (1) produce copies containing the copyright notice; (2) publish the print or label; and (3) register the copyright claim.

1. **Produce Copies Bearing the Copyright Notice.** The copies may be reproduced by printing or other means of reproduction. To secure and maintain copyright protection in a published work, all copies must bear the notice prescribed by law from the time of first publication. It is the responsibility of the copyright owner to place the required notice of copyright on his work. Permission of the Copyright Office is not required.

- **ELEMENTS OF THE NOTICE.** The notice must contain these three elements:

★ The word "Copyright," the abbreviation "Copr.," or the symbol ©. Use of the symbol © with the name of the copyright owner and year date of publication may result in securing copyright in some countries outside the United States under the provisions of the Universal Copyright Convention.

★ The name of the copyright owner.

★ The year date of publication. This is the year in which copies of the work were first placed on sale, sold, or publicly distributed by the copyright owner or under his authority.

In Class K, a special form of notice is permissible. This may consist of the symbol ©, accompanied by the initials, monogram, mark, or symbol of the copyright owner, if the owner's name appears elsewhere on some accessible part of the work. Note, however, that the special Universal Copyright Convention notice requires a year date and name as explained above.

- **FORM OF THE NOTICE.** The three elements must appear together. Example:

© John Doe 1976

The notice should be clearly legible and permanently affixed to the print or label itself. A periodical advertisement should include the notice as an integral part. The notice should be placed on all copies in such a way that it does not appear to be limited to an uncopyrightable element such as a name or slogan.

2. **Publish the Work with the Copyright Notice.** Copyright can be obtained only if the published works bear the required notice. "Publication," for copyright purposes, is generally considered the placing on sale, sale, or public distribution of copies.

NOTE: Once a work has been published without the required copyright notice, copyright protection is lost permanently and cannot be regained. Adding the correct notice later will not restore protection or permit the Copyright Office to register a claim.

3. **Register the Copyright Claim.** Promptly after publication, mail to the Register of Copyrights, Library of Congress, Washington, D.C. 20559, two complete copies of the print or label as published with notice, an application on Form KK, and a fee of \$6. Registration will usually be faster if you mail the application, copies, and fee together at the same time.

OPTIONAL DEPOSIT

For certain prints and labels it may be impractical to deposit copies because of their size, weight, fragility, or monetary value. In these cases the Register of Copyrights has discretion to permit the deposit of photographs or other reproductions instead of actual copies. Detailed instructions concerning this optional form of deposit will be sent on request.



Copyright Office • Library of Congress • Washington, D.C. 20559

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**Circular 34**

Copyright Protection Not Available for Names, Titles, or Short Phrases

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- [Names, Titles, And Short Phrases Not Protected By Copyright](#)
- [Subject Matter Of Copyright](#)
- [Copyright Office Records Listed Alphabetically By Title](#)
- [Protection Under Trademark Or Unfair Competition Laws](#)
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NAMES, TITLES, AND SHORT PHRASES NOT PROTECTED BY COPYRIGHT

Names, titles, and short phrases or expressions are not subject to copyright protection. Even if a name, title, or short phrase is novel or distinctive or if it lends itself to a play on words, it cannot be protected by copyright. The Copyright Office cannot register claims to exclusive rights in brief combinations of words such as:

- Names of products or services
- Names of businesses, organizations, or groups (including the name of a group of performers)
- Names of pseudonyms of individuals (including pen name or stage name)
- Titles of works
- Catchwords, catchphrases, mottoes, slogans, or short advertising expressions
- Mere listings of ingredients, as in recipes, labels, or formulas. When a recipe or formula is accompanied by explanation or directions, the text directions may be copyrightable, but the recipe or formula itself remains uncopyrightable.

SUBJECT MATTER OF COPYRIGHT

Copyright protection under the copyright code (title 17, section 102, U.S. Code) extends only to "original works of authorship." The statute states clearly that ideas and concepts cannot be protected by copyright. To be protected by copyright, a work must contain at least a certain minimum amount of authorship in the form of original literary, musical, pictorial, or graphic expression. Names, titles, and other short phrases do not meet these requirements.

COPYRIGHT OFFICE RECORDS LISTED ALPHABETICALLY BY TITLE

The titles of registered works are filed alphabetically and appear in that order in the indexes and catalogs of the Copyright Office.

However, the presence of a title in the Copyright Office registration records does not mean that the title itself is copyrighted or subject to copyright protection. In many cases, our records show the same or closely similar titles for entirely different works.

Copyright Office files may be examined through LOCIS (Library of Congress Information System). Access to LOCIS requires Telnet support. If your online service provider supports Telnet, you can connect to LOCIS through the Copyright Office Website or directly by using Telnet.

www.copyright.gov
Telnet: [locis.loc.gov](telnet://locis.loc.gov)

If your online service provider does not support Telnet, address your concerns directly to the provider.

PROTECTION UNDER TRADEMARK OR UNFAIR COMPETITION LAWS

Some brand names, trade names, slogans, and phrases may be entitled to protection under the general rules of law relating to unfair competition, or they may be entitled to protection and registration under the provisions of state or federal trademark laws. The federal trademark statute covers trademarks and service marks—those words, phrases, symbols, or designs that identify the source of the goods or services of one party and distinguish them from those of others. The Copyright Office has no role in these matters.

For questions on trademarks or for information on registering a federal trademark, write to

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or call the Patent and Trademark help line at (800) PTO-9199 or (703) 308-HELP (TTY: (703) 305-7785). For the Trademark Assistance Center, call (703) 308-9000. Internet information is available at www.uspto.gov

FOR FURTHER INFORMATION

To request Copyright Office circulars and application forms, write to:

Library of Congress

Copyright Office
Publications Section, LM-455
101 Independence Avenue, S.E.
Washington, D.C. 20559-6000

Or, if you know which forms and circulars you want, request them 24 hours a day from the Forms and Publications Hotline at (202) 707-9100. Leave a recorded message.

Circulars, announcements, recent regulations, and copyright registration forms are available via the Copyright Office Website at www.copyright.gov.

For general information about copyright, call the Copyright Public Information Office at (202) 707-3000. The TTY number is (202) 707-6737. Information specialists are on duty from 8:30 a.m. to 5:00 p.m. eastern time, Monday through Friday, except federal holiday. Recorded information is available 24 hours a day.

Revised December 2004

This electronic version has been altered slightly from the original printed text for presentation on the World Wide Web. For a copy of the original circular, consult the [PDF version](#) or write to Copyright Office, 101 Independence Avenue S.E., Washington, D.C. 20559-6000.

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101 Independence Ave. S.E.
Washington, D.C. 20559-6000
(202) 707-3000

COMPENDIUM II

COMPENDIUM

OF

COPYRIGHT OFFICE PRACTICES

Under the Copyright Law Which
Became Fully Effective on
January 1, 1978, Including
Title 17 of the United States
Code and Amendments Thereto



COPYRIGHT OFFICE
THE LIBRARY OF CONGRESS
WASHINGTON, D. C. 20559

1984

Chapter 300

COPYRIGHTABLE MATTER:
NONDRAMATIC LITERARY WORKS

- 301 Applicability of this chapter. This chapter concerns itself solely with nondramatic literary works.
- 302 Definition: literary works. Literary works are defined as works, other than audiovisual works, expressed in words, numbers, or other verbal or numerical symbols or indicia, regardless of the nature of the material objects, such as books, periodicals, manuscripts, phonorecords, film, tapes, disks, or cards, in which they are embodied. 17 U.S.C. 101.
- 303 Definition: nondramatic literary works. A nondramatic literary work is one that explains, describes, or narrates a particular idea, theme, or subject; it does not usually employ dialog or action to represent or give directions for representing all or a substantial portion of a story as actually occurring.
- 304 Copyrightable literary expression. To be registrable, a nondramatic literary work must contain at least a certain minimum amount of literary expression owing its origin to the author. See Chapter 200: COPYRIGHTABLE MATTER - IN GENERAL.
- 305 Noncopyrightable material. The following are not copyrightable and therefore cannot serve as a basis for registration.
- 305.01 Names, titles, slogans, and other short phrases. Names, titles, slogans, and other short phrases or expressions are not copyrightable, even if such expressions are novel, distinctive, or lend themselves to a play on words. Similarly, a mere listing of ingredients or contents is not copyrightable. See 37 C.F.R. 202.1(a).

COMPENDIUM II

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307

Compilations. (cont'd)

307.01

Registrability. A compilation is registrable if its selection, coordination, or arrangement as a whole constitutes an original work of authorship. The greater the amount of material from which to select, coordinate, or order, the more likely it is that the compilation will be registrable. Where the compilation lacks a certain minimum amount of original authorship, registration will be refused. Any compilation consisting of less than four selections is considered to lack the requisite original authorship. See also section 625 of Chapter 600: REGISTRATION PROCEDURES.

Examples:

- (1) The selection and ordering of 20 of the best short stories of O. Henry would be registrable as a compilation.
- (2) Where all three of an author's plays were previously published and the present publication consists of all three plays, no registration based on compilation authorship is possible.

307.02

Telephone books, directories, price lists, and the like. Telephone books, directories, price lists, and the like may be registered if they contain sufficient authorship in the form of compilation or other copyrightable material.

307.03

Coordination and arrangement. Reference to "coordinated" or "arranged," as used in the definition of a "compilation" in 17 U.S.C. 101, does not refer to format, but to the original ordering or grouping of the items.

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Collective works. A collective work is a work, such as a periodical issue, anthology, or encyclopedia, in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole. 17 U.S.C. 101.

NIMMER ON COPYRIGHT

VOLUME 1

by

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of old or stock situations. Such a conclusion is clearly contrary to the prevailing rule.²³ It should be said, however, that if a plaintiff's work is largely identical to an old or stock situation, this may well be persuasive as an issue of fact that such work not only lacks novelty, but also that it is not original. Still, unless the trier of fact is persuaded that plaintiff copied from such old or stock situation, he may not be denied relief merely because his work is not novel.²⁴

[B]—The *Quantum* of Originality

It has been said that all legal questions are in the last analysis questions of degree, requiring judicial line drawing. Certainly, copyright law is replete with such questions. The determination of the *quantum* of originality necessary to support a copyright presents such a question. It is not, however, among the more troublesome questions of degree inherent in copyright law, as the line to be drawn includes almost any independent effort on the side of sufficient originality.^{24.1} Any "distinguishable variation" of a prior work will constitute sufficient originality to support a copyright if such variation is the product of the author's independent efforts, and is more than merely trivial.²⁵ This doctrine owes its origin in large part to the words of Justice Holmes in *Bleistein v. Donaldson Lithographing Co.*²⁶

Personality always contains something unique. It expresses its singularity even in handwriting, and a very modest grade of art has in it something irreducible which is one man's alone. That something he may copyright unless there is a restriction in the words of the act.

It is to be noted that the poster in issue in the *Bleistein* case, while somewhat crude, was extremely detailed and elaborate. Copyright in the poster had been questioned primarily because of its use for advertising purposes. Apart from the question of the copyrightability of advertisements *per se*,²⁷ there would seem to be little difficulty in finding in the poster sufficient originality to support

²³ See § 2.01 Ns. 11, 12 and 13 *supra*.

²⁴ Even if there was copying from an old or stock situation, copyright protection may still be available for original material interpolated therein. See Chap. 3 *infra*.

^{24.1} *Warren Pub., Inc. v. Microdos Data Corp.*, 115 F.3d 1509, 1524 (11th Cir.) (*en banc*), *cert. denied*, 522 U.S. 963 (1997) (Godbold, Hatchett, & Barkett, JJ., dissenting) (previous four sentences of Treatise quoted).

²⁵ *Twentieth Century Fox Film Corp. v. Marvel Enters., Inc.*, 155 F. Supp. 2d 1 (S.D.N.Y. 2001) (Treatise quoted), *aff'd on other grounds*, 277 F.2d 253 (2d Cir. 2002); *Dolci Fabrics, Inc. v. Limited, Inc.*, 662 F. Supp. 1347, 1353 (S.D.N.Y. 1987) (Treatise quoted); *Best Medium Publishing Co. v. National Insider, Inc.*, 385 F.2d 384 (7th Cir. 1967) (Treatise cited), *cert. denied*, 390 U.S. 955 (1968). See *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951); *Alva Studios, Inc. v. Winninger*, 177 F. Supp. 265 (S.D.N.Y. 1959).

²⁶ 188 U.S. 239, 250 (1903).

²⁷ See § 2.08[G][4] *infra*.

copyright. Nevertheless, Justice Holmes' reasoning, in refusing to weigh the artistic merits of the work, provides the underlying rationale for the prevailing rule as to the determination of the necessary *quantum* of originality:

It would be a dangerous undertaking for persons trained only to the law to constitute themselves judges of the worth of pictorial illustrations,^{27.1} outside of the narrowest and most obvious limits. At one extreme, some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke. It may be more than doubted, for instance, whether the etchings of Goya or the paintings of Manet would have been sure of protection when seen for the first time. At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge. Yet if they command the interest of the public, they have a commercial value — and the taste of any public is not to be treated with contempt. It is an ultimate fact for the moment, whatever may be our hopes for a change. That these pictures had their worth and their success is sufficiently shown by the desire to reproduce them without regard to the plaintiff's rights.

The *Bleistein* doctrine that judges may not properly assay artistic merit has found expression in many succeeding cases where the author's creative contribution was of a much humbler and more minimal nature than in the *Bleistein* poster. As was said in the leading case of *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*,²⁸ originality for copyright purposes amounts to “. . . little more than a prohibition of actual copying. No matter how poor the ‘author’s’ addition, it is enough if it be his own.” Thus, in general, it may be concluded that if any author's independent efforts contain sufficient skill to motivate another's copying, there is *ipso facto* a sufficient *quantum* of originality to support a copyright.²⁹

Despite this seemingly all inclusive measure of originality, there remains a narrow area where admittedly independent efforts are deemed too trivial or insignificant to support copyright.³⁰ Within these (in the words of Justice

^{27.1} In the *patois* of almost a century later, it matters not if the judge be computer booster or technophobe. *Comprehensive Technologies Int'l, Inc. v. Software Artisans, Inc.*, 3 F.3d 730, 741 & n.10 (4th Cir. 1993).

²⁸ 191 F.2d 99 (2d Cir. 1951). See also *Wihitol v. Wells*, 231 F.2d 550 (7th Cir. 1956); *Original Appalachian Artworks, Inc. v. Toy Loft, Inc.*, 684 F.2d 821 (11th Cir. 1982).

²⁹ *Drop Dead Co. v. S.C. Johnson & Son, Inc.*, 326 F.2d 87 (9th Cir. 1963), *cert. denied*, 377 U.S. 907 (1964); *Amplex Mfg. Co. v. A.B.C. Plastic Fabricators, Inc.*, 184 F. Supp. 285 (E.D. Pa. 1960). See *Scientist Inc. v. Lindsey*, 39 U.S.P.Q.2d 1853 (E.D. Pa. 1996); *Rockford Map Pub., Inc. v. Directory Serv. Co. of Colo.*, 768 F.2d 145 (7th Cir. 1985) (amount of time spent irrelevant, as copyright may inhere in “the work of an instant”); *cert. denied*, 474 U.S. 1061 (1986).

³⁰ *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 358 (1991) (Treatise cited); *Magic Marketing, Inc. v. Mailing Servs. of Pittsburgh, Inc.*, 634 F. Supp. 769, 771 (W.D. Pa. 1986) (Treatise cited); *Samara Bros., Inc. v. Wal-Mart Stores, Inc.*, 165 F.3d 120, 136 (2d Cir. 1998)

Holmes) "narrowest and most obvious limits," there is invoked at least a minimal^{30.1} requirement of creativity over and above the requirement of independent effort.³¹ Moreover, the mere fact of success in the marketplace cannot vouchsafe the necessary quantum of originality.^{31.1}

It is of only semantic significance whether originality is defined as embodying such creativity or whether such creativity is regarded as a necessary adjunct to

(Newman, J., dissenting in part) (Treatise cited), *rev'd on other grounds*, 529 U.S. 205 (2000). See *Universal Athletic Sales Co. v. Salkeld*, 511 F.2d 904 (3d Cir. 1975) ("a modicum of creativity may suffice for a work to be protected"), *cert. denied*, 423 U.S. 863 (1975); § 1.08[C][1] *supra*. However, the unintentional should not be confused with the trivial. The independent effort that constitutes originality may be inadvertent and still satisfy the requirements of copyright. "A copyist's bad eyesight or defective musculature, or a shock caused by a clap of thunder, may yield sufficiently distinguishable variations. Having hit upon such a variation unintentionally, the 'author' may adopt it as his and copyright it." *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 105 (2d Cir. 1951). See *Chamberlin v. Uris Corp.*, 150 F.2d (2d Cir. 1945); *Florabelle Flowers, Inc. v. Joseph Markovits, Inc.*, 296 F. Supp. 304 (S.D.N.Y. 1968) (the "accidental or laboriously contrived" may nevertheless be original). Cf. *Kuddle Toy, Inc. v. Pussycat-Toy Co.*, 183 U.S.P.Q. 642 (E.D.N.Y. 1974) (protection denied to "a trifling variation, perhaps the result of imperfect copying . . .").

^{30.1} *Atari Games Corp. v. Oman*, 888 F.2d 878, 883 (D.C. Cir. 1989) (Treatise cited) (review of Register of Copyright's denial of registration). But see *id.* at 890 (Silberman, J., concurring) (opining that Register should be allowed to reject "the creativity standard found to be 'normal' or appropriate by certain courts of appeals and by Professor Nimmer.").

³¹ *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991) (Treatise cited); *L. Ballin & Son, Inc. v. Snyder*, 536 F.2d 486 (2d Cir. 1976) (*en banc*) (Treatise quoted), *cert. denied*, 429 U.S. 857 (1976). Cf. H. Rep., p. 51: "This standard [of originality] does not include requirements of novelty, *ingenuity*, or *aesthetic merit*, and there is no intention to enlarge the standard of copyright protection to require them." (Emphasis added.) This probably merely means that the minimal requirement of creativity extant under the 1909 Act is not to be enlarged, not that it is to be eliminated. Note the following explanation of language identical to that of present § 102(a), as contained in the 1965 Revision Bill (H.R. 4347, 89th Cong., 2d Sess. Sec. 102): ". . . when it came to drafting, a great deal of concern was expressed about the dangers of using a word like 'creative' . . . it was argued that the word might lead courts to establish a higher standard of copyrightability than that now existing under the decisions . . . Our intention here is to maintain the *established* standards of originality without implying any *further* requirements of aesthetic value, novelty, or ingenuity." Reg. Supp. Rep., p. 3 (emphasis added).

^{31.1} We do not leave our common sense at the courthouse door. Works may experience commercial success even without originality and works with originality may enjoy none whatsoever. Nothing has been presented to us showing any correlation between the two. Moreover, under [plaintiff's] theory a work may not be copyrightable at one point when it enjoys no sales but may later become copyrightable if it experiences an upswing in economic fortune. This cannot be. A work is either original when created or it is not.

Paul Morelli Design, Inc. v. Tiffany & Co., 200 F. Supp. 2d 482, 488 (E.D. Pa. 2002) (Treatise cited).

2-14.1

SUBJECT MATTER OF COPYRIGHT

§ 2.01[B]

originality. However, a greater clarity of expression is perhaps achieved by regarding originality and creativity as separate elements.³²

As with all words, care must be exercised to ascertain the precise meaning of the terms employed, here "originality" and "creativity." We have just seen that the former does not connote novelty.^{32.1} By the same token, the latter does
(Text continued on page 2-15)

³² Warren Pub., Inc. v. Microdos Data Corp., 115 F.3d 1509, 1523 n.2 (11th Cir.) (*en banc*), *cert. denied*, 522 U.S. 963 (1997) (Godbold, Hatchett, & Barkett, JJ., dissenting) (Treatise cited). See § 2.08[B][1] *infra*. Creativity must further be distinguished from novelty. A work may find no counterpart in prior creations by others, (hence be "novel") and yet lack the spark of artistic expression associated with creativity.

^{32.1} See § 2.01[A] *supra*. For another sense in which "originality" is *not* used in the copyright context, see Overview N. 64 *supra*.

not mean an "inventive leap" or "new idea" in the sense of never having been conceived before.^{32.2} Instead, it refers to matter bearing a spark of distinctiveness in copyrightable expression.^{32.3} Illustrative of the requirement of minimal creativity are those cases that deny copyright protection to fragmentary words or phrases,³³ noncreative variations of musical compositions,³⁴ numbers generated sequentially or randomly,^{34.1} and to forms of expression dictated solely by functional considerations.³⁵ It is seen also in connection with works of art.³⁶

^{32.2} *Lotus Dev. Corp. v. Borland Int'l, Inc.*, 831 F. Supp. 202, 218 (D. Mass. 1993), *rev'd on other grounds*, 49 F.3d 807 (1st Cir. 1995), *aff'd by an equally divided court*, 516 U.S. 233 (1996).

^{32.3} See *Foxworthy v. Custom Tees, Inc.*, 879 F. Supp. 1200, 1218 (N.D. Ga. 1995) (original expression of others' ideas as to "redneck humor"). Human creativity knows no bounds, from larcenous stratagems to innovative manners of demonstrating parental love; most such matters obviously lie far beyond copyright protection, which is confined to the realm of fixed expression. "Derivation of a scientific formula may require a great deal of creativity and produce an original result. If the formula fails the copyrightability test, it is because the formula is not expressive — independently of creativity or originality." *Lotus Dev. Corp. v. Borland Int'l, Inc.*, 831 F. Supp. 202, 217 (D. Mass. 1993); *rev'd on other grounds*, 49 F.3d 807 (1st Cir. 1995), *aff'd by an equally divided court*, 516 U.S. 233 (1996).

³³ *Arica Inst., Inc. v. Palmer*, 770 F. Supp. 188, 191-92 (S.D.N.Y. 1991), *aff'd*, 970 F.2d 1067, 1072 (2d Cir. 1992) (Treatise cited); *Kanover v. Marks*, 91 U.S.P.Q. 370 (S.D.N.Y. 1951); *Smith v. Muchlebach Brewing Co.*, 140 F. Supp. 729 (S.D. Mo. 1956). See *Magic Marketing, Inc. v. Mailing Servs. of Pittsburgh, Inc.*, 634 F. Supp. 769 (W.D. Pa. 1986) (Treatise cited) (denying protection to advertising phrases on envelope).

³⁴ See, e.g., *Northern Music Corp. v. King Record Distrib. Co.*, 105 F. Supp. 393 (S.D.N.Y. 1952); *Shapiro Bernstein v. Miracle Record Co.*, 91 F. Supp. 473 (N.D. Ill. 1952); *McIntyre v. Double-A Music Corp.*, 179 F. Supp. 160 (S.D. Cal. 1959); *Norden v. Ditson*, 13 F. Supp. 415 (D. Mass. 1936); *Supreme Records, Inc. v. Decca Records, Inc.*, 90 F. Supp. 904 (S.D. Cal. 1950). But cf. *Desclée & Cie S.A. v. Nemmers*, 190 F. Supp. 381 (E.D. Wis. 1961); *Consolidated Music Publishers v. Ashley Publications*, 197 F. Supp. 17 (S.D.N.Y. 1961).

^{34.1} *Toro Co. v. R & R Prods. Co.*, 787 F.2d 1208, 1212 (8th Cir. 1986) ("we hold that [plaintiff's parts numbering system for replacement parts of lawn mowers] lacks the requisite originality"); *Mitel, Inc. v. Iqtel, Inc.*, 124 F.3d 1366, 1374 (10th Cir. 1997) ("random and arbitrary use of numbers" inadequate).

³⁵ *CMM Cable Rep., Inc. v. Ocean Coast Properties, Inc.*, 97 F.3d 1504, 1519 (1st Cir. 1996) (Treatise cited); *Dow Jones & Co. v. Board of Trade*, 546 F. Supp. 113 (S.D.N.Y. 1982) (Treatise quoted); *Consumer Union of U.S., Inc. v. Hobart Mfg. Co.*, 199 F. Supp. 860 (S.D.N.Y. 1961); *Tate Co. v. Jiffy Enters., Inc.*, 16 F.R.D. 571 (E.D. Pa. 1954); *Morrissey v. Procter & Gamble Co.*, 379 F.2d 675 (1st Cir. 1967). See *Higgins v. Baker*, 309 F. Supp. 635 (S.D.N.Y. 1969) (Treatise cited). For a questionable application of this principle, see *Donald v. Zack Meyer's T.V. Sales & Serv.*, 426 F.2d 1027 (5th Cir. 1970), *cert. denied*, 400 U.S. 992 (1971). In holding that a given legal form lacked the requisite originality because it was quite similar to prior published forms, the court concluded that a distinguishable variation to be protectible "must be meaningful and must result from original creative work on the author's part . . . [Plaintiff] merely made trivial word changes by combining various forms and servilely imitating the already stereotyped language found therein." (emphasis added.) To the same effect is *M.M. Business Forms Corp. v. Uarco, Inc.*, 472 F.2d 1137 (6th Cir. 1973) (required creativity lacking where "word arrangements . . . merely a paraphrasing of earlier forms."). See also *Donald v. Uarco Business Forms*, 344 F. Supp. 338 (W.D.

This position was likewise reflected in the Copyright Office Regulations under the 1909 Act that provided that the following are not subject to copyright:

Words and short phrases such as names, titles, and slogans; familiar symbols or designs; mere variations of typographic ornamentation, lettering or coloring; mere listing of ingredients or contents.³⁷

The refusal to protect short phrases applies *a fortiori* to one or two words.^{37.1}

However, it must be recalled that even most commonplace and banal results of independent effort may command copyright protection,³⁸ provided such

(Text continued on page 2-17)

Ark. 1972), *aff'd*, 478 F.2d 764 (8th Cir. 1973); Arthur v. American Broadcasting Cos., 633 F. Supp. 146 (S.D.N.Y. 1985). It would seem that the very act of combining forms should satisfy the low standard of originality required by copyright law. Cf. Pittway Corp. v. Reliable Alarms Mfg. Corp., 164 U.S.P.Q. 379 (E.D.N.Y. 1969); Telex Corp. v. International Business Machs. Corp., 367 F. Supp. 258 (N.D. Okla. 1973), *aff'd in part and rev'd in part*, 510 F.2d 894 (10th Cir. 1975). See also Trifari, Krussman & Fishel, Inc. v. Charel Co., 134 F. Supp. 551 (S.D.N.Y. 1955); Surgical Supply Serv., Inc. v. Adler, 206 F. Supp. 564 (E.D. Pa. 1962), *rev'd on other grounds*, 321 F.2d 536 (3d Cir. 1963); Caddy Imler Creations, Inc. v. Caddy, 299 F.2d 79 (9th Cir. 1962). See § 2.18 *infra*. Cf. Gelles-Widmer Co. v. Milton Bradley Co., 313 F.2d 143 (7th Cir. 1963), *cert. denied*, 373 U.S. 913 (1963); Dietrich v. Standard Brands, Inc., 32 F.R.D. 325 (E.D. Pa. 1963).

³⁶ See § 2.08[B][1] *infra*.

³⁷ 37 C.F.R. § 202.1(a) (1959). See Murray Hill Publ'ns, Inc. v. ABC Communications, Inc., 264 F.3d 622, 632-33 (6th Cir. 2001); Arvelo v. American Int'l Ins. Co., 875 F. Supp. 95, 100 (D.P.R.), *aff'd mem.*, 66 F.3d 306 (1st Cir. 1995); Johnson v. Automotive Ventures, Inc., 890 F. Supp. 507, 511 (W.D. Va. 1995); Manufacturers Technologies, Inc. v. Cams, Inc., 706 F. Supp. 984, 996 (D. Conn. 1989) (Treatise cited); Applied Innovations, Inc. v. Regents of the Univ. of Minn., 685 F. Supp. 698, 707 (D. Minn. 1987) (Treatise cited), *aff'd*, 876 F.2d 626, 635 (8th Cir. 1989) ("test statements are short, simple, declarative sentences, but they are not merely fragmentary words and phrases") (Treatise cited); Perma Greetings, Inc. v. Russ Berrie & Co., 598 F. Supp. 445, 448 (E.D. Mo. 1984).

^{37.1} See Bird v. Parsons, 127 F. Supp. 2d 885, 889 (S.D. Ohio 2000), *aff'd*, 289 F.3d 865, 881-82 (6th Cir. 2002) (word "financia"). An alarming indication that the phrases "meter drop" and "rolling stock" could win protection was withdrawn. See Cook v. Robbins, 232 F.3d 736 (9th Cir. 2001).

³⁸ See Heim v. Universal Pictures Corp., Inc., 154 F.2d 480 n.17 (2d Cir. 1946); Drop Dead Co. v. S.C. Johnson & Son, Inc., 326 F.2d 87 (9th Cir. 1963), *cert. denied*, 377 U.S. 907 (1964).

independent effort is quantitatively more than minimal (*e.g.*, exceeds that required for a fragmentary work or short phrase).^{38.1} Conversely, it would seem (notwithstanding the above quoted Copyright Office Regulation) that even a short phrase may command copyright protection if it exhibits sufficient creativity.³⁹ Thus Judge Jerome Frank in *Heim v. Universal Pictures Corp., Inc.*,⁴⁰ suggested that copyright protection would be accorded such lines as "Euclid alone has looked on Beauty bare" and " 'Twas brillig and the slithy toves."⁴¹ It appears, then, that there is a reciprocal relationship between creativity and independent effort. The smaller the effort (*e.g.*, two words) the greater must be the degree of creativity in order to claim copyright protection.⁴²

The application of the doctrine of originality to various specific types of copyrightable matter⁴³ is discussed in ensuing sections of this treatise.⁴⁴

^{38.1} See *NEC Corp. v. Intel Corp.*, 10 U.S.P.Q.2d 1177, 1989 Copyright L. Dec. (CCH) ¶ 26,379 (N.D. Cal. 1989) (Treatise quoted).

³⁹ However, the weight of existing authority apparently precludes copyright protection for a title regardless of its degree of creativity. See § 2.16 *infra*. The exclusion of titles from copyright protection may now be seen as a matter of Congressional intent. See § 2.03 *infra*.

⁴⁰ 154 F.2d 480 n.8 (2d Cir. 1946).

⁴¹ Judge Frank was not discussing copyrightability, but rather the extent of copying necessary to establish an infringement. Cf. *Toulmin v. Rike-Kumler Co.*, 137 U.S.P.Q. 533 (S.D. Ohio 1962), *aff'd*, 316 F.2d 232 (6th Cir.), *cert. denied*, 375 U.S. 825 (1963); *G.P. Putnam's Sons v. Lancer Books, Inc.*, 239 F. Supp. 782 (S.D.N.Y. 1965).

⁴² But see *Prestige Floral, S.A. v. California Co.*, 201 F. Supp. 287 (S.D.N.Y. 1962). Cf. *Landry v. American Inst. for Research*, 393 F.2d 48 (5th Cir. 1968). Most of the paragraph that precedes this footnote is quoted in *Universal Athletic Sales Co. v. Salkeld*, 511 F.2d 904 (3d Cir.), *cert. denied*, 423 U.S. 863 (1975).

⁴³ In a case defining the scope of protection for a factual compilation, the Supreme Court implied that originality may be lacking to the extent that all choices are governed by state law rather than by the compiler's choice. See *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 363 (1991). Query whether that proposition could apply to works more artistic than the telephone directories there at issue. See § 2.04[B] *in fine infra*.

⁴⁴ See §§ 2.05[D], 2.08[A][3], 2.08[B][2], 2.08[C][2], 2.08[E][1], 2.08[G][3], 2.10[A][2], and 3.03 *infra*.

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Subject Matter

§2.7.3

any event be reconciled with the general test for the copyrightability of literary characters. The *Warner Brothers* court may only have been saying that stock characters are unprotectible if their interaction with new situations is not both distinctive and predictable and thus does not create new incidents. Also, later courts have viewed as dicta the conclusion that the character involved in the case—Dashiell Hammett's Sam Spade—was not protectible.⁵¹

§2.7.3 Titles, Short Phrases, Labels, and Recipes

Courts withhold protection from—and Copyright Office regulations prohibit the registration of—words and short phrases such as names, titles, and slogans.⁵² For example, one court held that the phrases “Telegram,” “Gift Check” and “Priority Message” on envelopes that plaintiff used in its direct mail advertising campaigns lacked the minimal level of creativity required for

before it—visually depicted characters, which are “more likely” than literary characters “to contain some unique elements of expression,” *id.* at 755—*Air Pirates* may have reinforced *Warner's* authority respecting literary characters. But the court's method of analysis—applying the idea-expression distinction to characters generally—suggests a modification of *Warner's* categorical standard. See also *Anderson v. Stallone*, 11 U.S.P.Q.2d 1161, 1165-1167 (C.D. Cal. 1989).

⁵⁰ See, e.g. *Columbia Broadcasting Sys., Inc. v. DeCosta*, 377 F.2d 315, 320 (1st Cir.), *cert. denied*, 389 U.S. 1007 (1967); *Ideal Toy Corp. v. Kenner Prods., Etc.*, 443 F. Supp. 291, 301 n.8, 197 U.S.P.Q. 738 (S.D.N.Y. 1977). But see *Hospital for Sick Children v. Melody Fare Dinner Theatre*, 516 F. Supp. 67, 72, 209 U.S.P.Q. 749 (E.D. Va. 1980).

⁵¹ A district court in the Ninth Circuit subsequently characterized *Warner's* discussion of character protection as “an alternative rationale” for the decision. *Walt Disney Prods. v. Air Pirates*, 345 F. Supp. 108, 111, 174 U.S.P.Q. 463 (N.D. Cal. 1972) (primarily the decision “was premised upon construction of the contract, drawn by the assignee of the rights [to *The Maltese Falcon*] with the result that the rights over the characters themselves were held not to have been conveyed”), *aff'd in part, rev'd in part on other grounds*, 581 F.2d 751 (9th Cir. 1978), *cert. denied sub nom. O'Neill v. Walt Disney Prods.*, 439 U.S. 1132 (1979). See also *Columbia Broadcasting Sys., Inc. v. DeCosta*, 377 F.2d 315, 320 (1st Cir.), *cert. denied*, 389 U.S. 1007 (1967).

⁵² See 37 C.F.R. §202.1(a) (1993).

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Subject Matter, Formalities, Ownership and Term

copyright.³³ The court also denied protection to the phrase "Contents Require Immediate Attention" because it was "nothing more than a direction or instruction for use."³⁴

Short Phrases. How short can a phrase be and still qualify for copyright protection? In one case, a court ruled that the phrase, "You've got the right one, uh-huh," failed "to evince the requisite degree of originality to entitle it to copyright protection and is a short expression of the sort that courts have uniformly held uncopyrightable."³⁵ Judge Jerome Frank probably had the bare minimum length in mind when he observed that the phrases "Euclid alone has looked on Beauty bare" and "Twas brillig and the slithy toves" would qualify for protection.³⁶ A later court doubtless went too far in holding that the phrases "I love you E.T." and "E.T. Phone Home" used in a popular motion picture were individually protectible.³⁷ To be sure, these two phrases may have had great commercial value. But it is unfair competition and trademark law, not copyright, that represents the appropriate vehicle for capturing the value of such terse phrases.³⁸

³³ *Magic Mktg. v. Malling Servs. of Pittsburgh*, 634 F. Supp. 769, 772, 230 U.S.P.Q. 230 (W.D. Pa. 1986).

³⁴ 634 F. Supp. at 772.

³⁵ *Takeall v. Pepsico, Inc.*, 14 F.3d 596, 29 U.S.P.Q.2d 1913 (4th Cir. 1993) (unpublished opinion), *cert. denied*, 114 S. Ct. 2742 (1994). *See also* *Murray Hill Publications, Inc. v. ABC Communications, Inc.*, 264 F.3d 622, 633, 60 U.S.P.Q.2d 1080 (6th Cir. 2001) (The line, "Good morning, Detroit. This is J.P. on JR in the A.M. Have a swell day," was "nothing more than a short phrase or slogan, dictated to some degree by the functional considerations inherent in conveying the desired information about McCarthy's morning show, *i.e.*, whose morning show, what radio station, and what time"; "therefore there can be no infringement in this case as a matter of law.").

³⁶ *Heim v. Universal Pictures Co.*, 154 F.2d 480, 487 n.8 (2d Cir. 1946). *See also* *Applied Innovation, Inc. v. Regents of the Univ. of Minn.*, 876 F.2d 626, 635, 11 U.S.P.Q.2d 1041 (8th Cir. 1989) (test statements, though "short, simple, declarative sentences," are "not merely fragmentary words and phrases within the meaning of 37 C.F.R. §202.1(a)").

³⁷ *Universal City Studios, Inc. v. Kamar Indus., Inc.*, 217 U.S.P.Q. 1162, 1166 (S.D. Tex. 1982). *Cf.* *Regents of the University of Minnesota v. Applied Innovations, Inc.*, 685 F. Supp. 698, 5 U.S.P.Q.2d 1689 (D. Minn. 1987); *Life Music, Inc. v. Wonderland Music Co.*, 241 F. Supp. 653, 656 (S.D.N.Y. 1965).

³⁸ *See* §15.13, below. Unfair competition represented an alternative ground

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The traditional tests of copyrightability—originality and expressive content—offer the surest quantitative guides to copyrightability. The shorter a phrase is, the less likely it is to be original³⁹ and the more likely it is to constitute an idea rather than an expression.⁴⁰ Also, the shorter the phrase, the less likely it is to have acceptable substitutes, thus barring protection under the

[Next page is 2:101.]

for decision for plaintiff in the *E.T.* case. See *Universal City Studios, Inc. v. Kamar Indus., Inc.*, 217 U.S.P.Q. 1162, 1167-1168 (S.D. Tex. 1982).

³⁹ See §2.2.1, above.

⁴⁰ See §2.3, above.

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merger doctrine.⁴¹ On principle and precedent, the dispositive questions in these cases are whether copyright will give the plaintiff protection for something he did not originate and will close off fundamental building blocks from use by others.

Labels. Courts have held that product labels are copyrightable but that their protection does not extend to short phrases or slogans or to elements that merely describe or tout the product.⁴² In one case,⁴³ for example, the court of appeals affirmed a lower-court decision withholding copyright from purely descriptive language appearing on the plaintiff's label and from language dealing with instructions and cautions.⁴⁴ But the appellate court reversed the lower court's decision that another phrase appearing on plaintiff's label—"most personal sort of deodorant"—was copyrightable. In the appellate court's view, "this phrase is just as descriptive as the rest of the text. The ingenuity and creativity reflected in the development of the product itself does not give appropriate descriptive language, such as 'personal sort of deodorant,' any separate value as a composition or as an extension of a work of art."⁴⁵

Titles. Courts have universally held that titles of works are not copyrightable.⁴⁶ One rationale for denying copyright to titles may

⁴¹ See §2.3.2, above.

⁴² See, e.g., *Alberto-Culver Co. v. Andrea Dumon, Inc.*, 466 F.2d 705, 175 U.S.P.Q. 194 (7th Cir. 1972); *Drop Dead Co. v. S.C. Johnson & Son, Inc.*, 326 F.2d 87, 95 (9th Cir. 1963), *cert. denied*, 377 U.S. 907 (1964); *Abli, Inc. v. Standard Brands Paint Co.*, 323 F. Supp. 1400, 168 U.S.P.Q. 553 (C.D. Cal. 1970); *Laskowitz v. Marie Designer*, 119 F. Supp. 541, 552 (S.D. Cal. 1954) ("I do not think that phrases such as 'This is Nature's most restful posture' or phrases emphasizing 'the relaxing' qualities of the chair, which are so purely descriptive of the product, comply even with the slight requirement of originality in the law of copyright as applied to advertisements.").

Cf. Higgins v. Keuffel, 140 U.S. 428, 431 (1891) ("To be entitled to a copyright the article must have by itself some value as a composition, at least to the extent of serving some purpose other than as a mere advertisement or designation of the subject to which it is attached.").

⁴³ *Alberto-Culver Co. v. Andrea Dumon, Inc.*, 466 F.2d 705, 175 U.S.P.Q. 194 (7th Cir. 1972).

⁴⁴ 466 F.2d at 711.

⁴⁵ 466 F.2d at 711.

⁴⁶ See, e.g., *Becker v. Loew's*, 133 F.2d 889, 891 (7th Cir.), *cert. denied*, 319 U.S. 772, *reh'g denied*, 320 U.S. 811 (1943); *Oxford Book Co. v. College Entrance*

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§2.8

of the 1976 Act barred protection for the recipes in issue "as either a 'procedure, process, [or] system.'"⁴⁸ The court added, however, that it was not establishing a *per se* rule that recipes are uncopyrightable.⁴⁹

**§2.8 MUSICAL WORKS, INCLUDING
ANY ACCOMPANYING WORDS**

Section 102(a)(2) of the 1976 Copyright Act includes "musical works, including any accompanying words" as protectible subject matter.¹ The nature of the tangible medium in which the

[Next page is 2:103.]

⁴⁸88 F.3d at 480-81.

⁴⁹88 F.3d at 481.

§2.8 ¹ On the protection of musical arrangements as derivative works, see §2.16.2.2, below.