



United States Copyright Office

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Reporters, ALI Restatement of the Law, Copyright

Re: Council Draft No. 3

Dear Professor Revesz, Ms. Middleton, and Reporters:

The U.S. Copyright Office is responsible for administering significant portions of the nation's copyright law and providing expert advice to Congress, federal agencies, and the courts on copyright matters.¹ We have reviewed Council Draft No. 3 of ALI's proposed Restatement of the Law of Copyright and offer the below commentary to help guide consideration of the draft.

As we have stated in prior letters, we reiterate the Copyright Office's view that the Restatement should not displace any of the "traditional tools of statutory construction," including examination of the statute's text, structure, purposes, and legislative history.² Nor should the Restatement supplant the Copyright Office's rules and regulatory guidance that interpret and apply the text of the Copyright Act, which are entitled to ordinary and appropriate levels of judicial deference, even where they differ from views expressed in the Restatement. Relatedly, we continue to urge the Reporters to avoid conflicts between the Restatement and Copyright Office regulations or other interpretive guidance, including the *Compendium of U.S. Copyright Office Practices (Third Edition)* ("*Compendium IIP*"), as conflicts could produce significant confusion and adversely affect Copyright Office operations.

The following comments reflect the Office's primary areas of concern in the most recent draft, in order of their appearance in the draft.³

¹ 17 U.S.C. § 701(a), (b).

² See *INS v. Cardoza-Fonseca*, 480 U.S. 421, 446-450 (1987).

³ These comments are illustrative and are not a comprehensive list of the Office's comments on the draft. The Office previously submitted detailed comments on a variety of topics covered in this and previous drafts. See Letter

Section 1.04

The revised text of Comment *f* (previously Comment *e*) fails to fully address the concerns previously raised in the Office’s Nov. 9, 2016 letter.⁴ While we appreciate that the Reporters have clarified that “the owner of the copyright in a compilation may also own copyrights in the underlying material,” the draft Comment suggests that there is no relationship between the two in stating “the copyright in a compilation does not itself protect the underlying material.” While it is true that the copyrightable authorship in a constituent work and in a compilation are different types of authorship, a registration for a compilation can support a claim for infringement of a constituent work where the copyright for that work is also owned by the compiler. In the absence of an express transfer, and if the compilation author is not the same as the author of the constituent work, there is a presumption that the compilation author only has the right to reproduce and distribute each constituent work as part of that particular compilation, a revision of that compilation, and any later compilation in the same series. 17 U.S.C. § 201(c). When there is an express transfer or the author of the compilation is the same as the author of the constituent works, the constituent work is fully included in the copyright and any registration. COMPENDIUM (THIRD) § 618.7(B)(2). The Office recommends rewriting the last paragraph of Comment *f* to make this clear.

The Office notes this position was articulated in the United States’ recent *amicus curiae* brief in *Muench Photography v. McGraw Hill Global Education Holdings, LLC*,⁵ where the United States explained that the Copyright Office has “consistently interpreted Section 409 of the Copyright Act to permit a compilation registration to cover component works owned by the author of the compilation.”⁶ As the brief noted, the Second Circuit adopted the Office’s position as “persuasive” in *Morris v. Business Concepts, Inc.*, holding that where “all rights [in a

from Regan A. Smith, General Counsel and Associate Register of Copyrights, and Robert J. Kasunic, Associate Register of Copyrights and Director of Registration Policy & Practice, to Richard Revesz et al., American Law Institute (Mar. 4, 2019); Letter from Regan A. Smith, General Counsel and Associate Register of Copyrights, and Robert J. Kasunic, Associate Register of Copyrights and Director of Registration Policy & Practice, to David Levi et al., American Law Institute (Oct. 16, 2018); Letter from Karyn Temple Claggett, Acting Register of Copyrights, to The American Law Institute (Jan. 16, 2018); Letter from Sarang V. Damle, General Counsel and Associate Register of Copyrights, and Robert J. Kasunic, Associate Register of Copyrights and Director of Registration Policy & Practice, to Richard Revesz et al., American Law Institute (Dec. 4, 2017); Letter from Sarang V. Damle, General Counsel and Associate Register of Copyrights, and Robert J. Kasunic, Associate Register of Copyrights and Director of Registration Policy & Practice, to Richard Revesz et al., American Law Institute (Nov. 9, 2016).

⁴ COMPENDIUM (THIRD) § 509.2 (“the copyright in the collective work ‘extend[s] to the elements of compilation and editing that went into [creating] the collective work as a whole’ . . . [and] it extends to ‘the contributions that were written for hire by employees of the owner of the collective work, and those copyrighted contributions that have been transferred in writing to the owner by their authors’”) (quoting H. R. Rep. No. 94-1476, at 122 (1976); S. Rep. No. 94-473, at 106 (1976)).

⁵ No. 19-496 (2d. Cir.).

⁶ Brief for the United States as Amicus Curiae at 17, *Muench Photography v. McGraw Hill Global Education Holdings, LLC*, No. 19-496 (2d. Cir. June 10, 2019).

constituent work] have been transferred to the claimant, then the constituent work is included in the registration of the collective work.”⁷

Section 1.09

As an overarching point, the Office does not believe this section fully articulates the origin and underpinning of the bar on copyright protection for federal government works. This Section exclusively cites the 1976 House Report and omits that U.S. law has prohibited copyright for federal government publications since the 1895 Printing Act, which established the Government Printing Office and provided that “no publication reprinted from [government printing plates] and no other Government publication shall be copyrighted.”⁸ Several years later, when a member of Congress attempted to claim copyright in his compilation of presidential messages, the Senate Committee on Printing conducted an investigation, found the copyright claim barred by the 1895 Printing Act, and remarked that: “If the services of any author or compiler employed by the Government require to be compensated, payment should be made in money, frankly and properly appropriated for that purpose, and the resulting book or other publication in whole and as to any part should be always at the free use of the people, and this, without doubt, was what Congress intended.”⁹ The provision of the 1895 Act prohibiting copyright protection for federal publications was later included in the Copyright Act of 1909.¹⁰ The discussion of section 105 and the legislative history of that provision should take into account these precursors to that provision.

Comment *b* and Reporters’ Notes *b* and *d* suggest that the primary motivation behind section 105 is concern about double taxation or a “double subsidy” in which the public pays taxes that fund the creation of copyrighted materials and must pay again for use of the copyrighted materials. This citation over-reads a single reference in the 1976 House Report. The concern regarding a “double subsidy” was raised in connection with debate over copyright in materials “prepared under U.S. Government contract or grant,” not materials created by federal government employees.¹¹ Moreover, the Report explains that, despite the concern raised about a “double subsidy,” Congress ultimately declined to expand section 105 to all federal contracts and grants out of concern for instances “where the denial of copyright protection would be unfair or would hamper the production and publication of important works.”¹² Additionally, states’ ownership of copyright would potentially raise the same concern regarding a “double subsidy,” yet the Copyright Act does not prohibit states from owning copyrights in works created by state employees within the scope of their employment. Thus, the Office does not believe it is accurate to cite concern about a “double subsidy” as the primary or even a significant motivation behind section 105. Rather, as discussed above, section 105 was the continuation of longstanding

⁷ 283 F.3d 502, 505 (2d Cir. 2002), *abrogated on other grounds by Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154 (2010).

⁸ An Act Providing for the public printing and binding and the distribution of public documents, ch. 23, § 52, 28 Stat. 601, 608 (1895).

⁹ S. Rep. No. 56-1473 at 2 (1900).

¹⁰ 17 U.S.C. 7 (1926).

¹¹ H.R. Rep. No. 94-1476 at 59 (1976).

¹² *Id.*

copyright principles. The Office recommends revising your discussion of the basis for section 105 to cite more relevant legislative history.

With respect to Comment *e*, the draft notes the issue of joint works with U.S. government officers is an issue courts “have not addressed,” and the Office urges the Reporters not to take a position on this issue here. First, it is unclear that the Section 105 applies to a work prepared in part by non-government authors, as Section 101 could arguably be read to require the work to be prepared solely by officers or employees of the U.S. government.

Second, there would be factual circumstances in any case that raised this issue that could be relevant to its resolution. For example, building codes are typically drafted based on joint input of numerous stakeholders, including industry, code enforcement officials, design professionals and other interested parties.¹³ Without understanding the specific factual circumstances, it would be imprudent to declare that the participation of a single federal official among dozens of stakeholders would necessarily mean the resulting work was “prepared by [that] office” for purposes of Sections 101 and 105. Nor does the statute seem to require that a packaging label on a product subject to Food and Drug Administration oversight be treated as a government work simply because an FDA official may have required particular text on that label.

Third, the little case law of which the Office is aware on this point does not support the sweeping propositions in the Comment. In *Gaylord v. United States*, the government argued it “had rights” in the Korean War Memorial as a joint work because the government had chosen physical attributes of the sculpted soldiers, such as their ethnicity, facial hair, strength of wind in their ponchos, and wrinkles.¹⁴ The court suggested that the government’s participation in creating the work would not terminate the copyright but would instead make the work a joint work, which would have made the government’s use of the Memorial non-infringing.¹⁵ Similarly, in *Educational Testing Services v. Miller*, the court held that the State Department’s involvement in developing questions for the Foreign Service Exam did not make the exam uncopyrightable.¹⁶

The Office urges against the introduction of a sweeping rule, particularly in the absence of a robust factual record and consideration of the legal and policy issues by the courts.

Section 1.10

We support withholding the section on government edicts until the Supreme Court’s decision in *Georgia v. Public.Resource.org*. We note, however, that the United States has submitted an

¹³ See *Bldg. Officials & Code Adm. v. Code Tech., Inc.*, 628 F.2d 730, 732 (1st Cir. 1980).

¹⁴ 595 F.3d 1364, 1371, 1378 (Fed. Cir. 2010).

¹⁵ *Id.* at 1376, 1379. The court concluded the government had not proven that the Memorial was a joint work because there was insufficient evidence of government authorship and of the parties’ intention that the Memorial be a joint work.

¹⁶ No. 88-cv-2819, 1991 WL 212181, at *3 (D.D.C. Sept. 30, 1991).

amicus brief expressing the view that the government edicts doctrine should cover the “whole work” of lawmakers performed in their capacity as lawmakers in discharging their duties.¹⁷

Section 2.04

The draft has not addressed the concerns we previously raised about this section, particularly with regards to heavy reliance on *Lotus v. Borland* and its characterization of APIs and the facts of *Oracle v. Google*. We direct you to our December 2017 comments on this issue and suggest that, until the Supreme Court decides whether to grant *certiorari* in *Oracle v. Google*, the Council refrain from finalizing this section.

Section 2.06

Revised Comment *f* continues to adopt the same erroneous principle that constraints not faced by a copyright author can subsequently be considered in the merger or *scenes a faire* analysis of that copyright. As we explained in our December 2017 letter, these doctrines look at what creative choices were available to the initial author at the time of creation, and there is no room within their analysis for consideration of post-fixation developments. We continue to object to the characterization of *Lexmark* in this section and its use supporting post-fixation considerations in merger and *scenes a faire*.

Section 2.07

As with Section 2.06 and our prior comments, we disagree with Comment *h* (formerly Comment *f*)’s suggestion that the scope of a copyright can narrow after creation due to post-fixation events. Because copyright “subsists” from creation and “endures,”¹⁸ the text of the Act does not support (or even contemplate) the scope of a copyright narrowing over time due to third-party behavior. As we explained in our December 2017 and October 2018 letters, the holding in *Warner Bros. v. American Broadcasting Corp.* was an idea/expression holding that a superhero wearing a cape and lifting cars was “too general” an idea to constitute copyright expression, not a holding based on *scenes a faire*.¹⁹ The lack of other case law support for this principle, coupled with the numerous cases cited in this comment that disagree with it, countenance in favor of deletion.

The Office welcomes public evaluation and discussion of our copyright law and thanks the ALI and the Reporters for their attention to our comments.

¹⁷ Brief for the United States as Amicus Curiae at 21, *State of Ga. v. Public.Resource.Org, Inc.*, No. 18-1150 (Aug. 2019), available at <https://www.copyright.gov/rulings-filings/briefs/state-of-georgia-v-public-resource-org-inc-no-18-1150-2019.pdf>.

¹⁸ 17 U.S.C. § 302(a).

¹⁹ 654 F.2d 204, 209-10 (2d Cir, 1981) (finding “the expression of the general idea of a hero with miraculous strength in Hero and Superman substantially differs”).

Sincerely,

A handwritten signature in blue ink that reads "Regan A. Smith". The signature is written in a cursive style with a large, stylized initial 'R'.

Regan A. Smith
General Counsel and Associate Register of Copyrights

A handwritten signature in blue ink that reads "Robert Kasunic". The signature is written in a cursive style with a large, stylized initial 'R'.

Robert J. Kasunic
Associate Register of Copyrights and Director of Registration Policy & Practice