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APPLICATIONS OF THE IDEA/EXPRESSION MERGER DOCTRINE IN COPYRIGHT INFRINGEMENT CASES

by WILLIAM E. GREENSPAN*

Imagine a situation whereby Professor Sam Scriber decides to author an original, innovative Business Law text designed to appeal to professors and students involved in introductory college-level Business Law courses. This novel text will prepare students for the Twenty-First Century. Ten percent of the material covers new advances in the discipline not appearing in other current, popular Business Law texts. The other ninety percent contains the traditional topics.

Sam recognizes that the subject matter in Business Law texts restricts creative discretion. There is material of a technical nature, compelling similarity in expression. Sam also understands that Business Law professors desire texts to which their own class notes can be adopted. In addition a particular, neutral literary style is essential. It must be contemporary, readable, inviting to students, not "stuffy," and adaptable to any possible teaching style.

Consequently Sam appropriates the patterns of current texts using substantially similar chapter headings, case examples, diagrams, charts, and technical language. There is little verbatim copying. To every extent possible, Sam creates an original selection, coordination, and arrangement of preexisting materials.

The publisher and author of a competing Business Law text sue Sam for copyright infringement. Sam raises the following defenses: First, I did not copy. Second, if I did copy anything, I only copied

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facts or ideas. These are not copyrightable. Only an original expression of facts or ideas is copyrightable. Finally, even if I copied an original expression of facts or ideas, I am not liable because there are only a limited number of ways to express certain basic legal principles. If an idea can only be expressed in one way (or in a limited number of ways), then the idea and the expression merge, and the result is not copyrightable. This is known as the merger doctrine.

The extent to which the merger doctrine would be applicable to Sam's case, or any other copyright infringement case in which the merger doctrine is raised as a defense, is the primary focus of this paper. The merger doctrine could apply in numerous copyright infringement cases involving original works of authorship such as computer programs, software, and computer related services; textbooks, treatises, and do-it-yourself guides; ornamental designs, statues, and designer jewelry; and maps, forms, and photographs.

This paper will discuss (1) the "originality" requirement for copyright protection, (2) the idea/expression dichotomy in copyright infringement cases, (3) the merger doctrine, (4) applications of the merger doctrine, and (5) conclusions and recommendations.

THE "ORIGINALITY" REQUIREMENT FOR COPYRIGHT PROTECTION

In exercise of the constitutional power "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,"¹ Congress enacted the first copyright law of the United States in 1790. Congress neglected to define the crucial terms "authors" and "writings." However, two subsequent United States Supreme Court decisions made it clear that originality is required for a particular work to be classified as writings of authors and thus entitled to copyright protection.

In *Trade-Mark Cases*,² the Court explained that "[O]riginality is required. And while the word 'writings' may be liberally construed, '... it is only such as are *original*, and are found in the creative powers of the mind. The writings which are to be protected are the *fruits of intellectual labor*, embodied in books, prints, engravings, and the like."³ In *Lithographic Co. v. Sarony*,⁴ the Court defined "author" as "he to whom anything owes its origin; originator; maker; one who

¹ U.S. Const. Art. I, § 8, cl. 8.

² 100 U.S. 82 (1879).

³ *Id.* at 94.

⁴ 111 U.S. 53 (1884).

completes a work of science or literature.”⁵ Subject matter is copyrightable so far as it is representative “of original intellectual conceptions of the author.”⁶ When an author sues for copyright infringement, “the existence of those facts of originality, of intellectual production, of thought, and conception on the part of the author should be proved.”⁷

Comprehensive revisions were enacted to the Copyright Law in 1831, 1870, 1909, and 1976. In enacting the Copyright Act of 1976,⁸ Congress replaced the 1909 Act’s phrase “all the writings of an author” with the new phrase, “original works of authorship.”⁹ The legislative history indicates that Congress was merely clarifying existing law: “The two fundamental criteria of copyright protection [are] originality and fixation in tangible form. . . . The phrase ‘original works of authorship,’ which is purposely left undefined, is intended to incorporate without change the standard of originality established by the courts under the present [1909] copyright statute.”¹⁰

Such works of authorship include literary works; musical works; dramatic works; pantomimes and choreographic works; pictorial, graphic, and sculptural works; motion pictures and other audiovisual works; sound recordings; and architectural works.¹¹

Since the Copyright Act intentionally fails to define the term “originality,” the definition has been developed on a case-by-case basis in the courts. There must be “a modicum of creativity.”¹² It is well settled that the “basic standard in copyright law is that only a minimal amount of creativity and originality is necessary to support a valid copyright.”¹³ “Where a work is based on a work already in

⁵ *Id.* at 58.

⁶ *Id.*

⁷ *Id.* at 60.

⁸ Pub. L. No. 94-553, 90 Stat. 2544 (1976), 17 U.S.C. §§ 101 et. seq.

⁹ Section 102(a) of the 1976 Copyright Act provides: Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, not known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. 17 U.S.C. § 102(a) (1988).

¹⁰ H.R. Rep. No. 94-1476, p. 51 (1976); S. Rep. No. 94-473, p. 50 (1975), *reprinted in* 1976 U.S. Code Cong. & Admin. News 5659, 5664.

¹¹ 17 U.S.C. § 102(a) (1988), as amended 12/1/90, P.L. 101-650, Title VII, § 703, 104 Stat. 5133.

¹² *Atari Games Corp. v. Oman*, 979 F.2d 242, 244 (1992) (*Atari BREAKOUT* video game may be copyrightable as an “audiovisual work” because the “flow of the game as a whole” is sufficiently original, even though the individual screens containing “simple geometric shapes and coloring” are not “per se” copyrightable.)

¹³ *Donald v. Uarco Business Forms*, 478 F.2d 764, 765 (8th Cir. 1973) (Business form not copyrightable.)

the public domain, a valid copyright may not exist in the new work unless it shows more than a trivial variation from the old work."¹⁴ "However, if a work is independently created, it is entitled to a copyright even if it is identical to a work in the public domain."¹⁵ There must be evidence of independent creation,¹⁶ an original form of expression.¹⁷ "Originality" requires more than "a mosaic of the language" appearing on preexisting material already in the public domain.¹⁸ "Copyright matter need not be strikingly unique or novel. A distinguishable variation suffices."¹⁹ It "means little more than a

¹⁴ *Id.* See also *Magic Marketing v. Mailing Services of Pittsburgh*, 634 F.Supp. 769, 771 (W.D. Pa. 1986) (Envelopes with words "PRIORITY MESSAGE: CONTENTS REQUIRE IMMEDIATE ATTENTION" not copyrightable.) Regulations promulgated pursuant to the Copyright Act list works not subject to copyright because they are not original:

The following are examples of works not subject to copyright and application 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;

(b) Ideas, plans, methods, systems, or devices, as distinguished from the particular manner in which they are expressed or described in a writing;

(c) Blank forms, such as time cards, graph paper, account books, diaries, bank checks, score cards, address books, report forms, order forms and the like, which are designed for recording information and do not in themselves convey information;

(d) Works consisting entirely of information that is common property containing no original authorship, such as, for example: Standard calendars, height and weight charts, tape measures and rulers, schedules of sporting events, and lists or tables taken from public documents or other common sources. 37 C.F.R. § 202.1 (1992).

¹⁵ *Donald v. Uarco Business Forms*, 478 F.2d at 766.

¹⁶ *J. R. O'Dwyer Co. v. Media Marketing Intern.*, 755 F.Supp. 599, 605 (S.D.N.Y. 1991) (A directory of selected "true public relations firms" constitutes sufficient authorship.)

¹⁷ *Rubin v. Boston Magazine Co.*, 645 F.2d 80, 83 (5th Cir. 1981) (A dissertation setting forth a "love scale" and "liking scale" which consists of twenty six questions designed to elicit one's feelings about another is original and therefore copyrightable.)

¹⁸ *M. M. Business Forms Corporation v. Uarco, Inc.*, 472 F.2d 1137, 1139 (6th Cir. 1973) (An agreement clause from a legal form book for use in a sales contract is not copyrightable, even if it is used for the first time in a service contract.)

¹⁹ *Best Medium Publishing Co. v. National Insider, Inc.*, 385 F.2d 384, 386 (7th Cir. 1967) (Articles in the *National Enquirer* weekly tabloid magazine dealing with Hollywood personalities are original and therefore copyrightable.) See also *Wainwright Sec. v. Wall Street Transcript Corp.*, 558 F.2d 91 (2d Cir. 1977) (Institutional research and brokerage business reports are copyrightable. News events are not copyrightable. "What is protected is the manner of expression, the author's analysis or interpretation of events, the way he structures material and marshals facts, his choice of words, and the emphasis he gives to particular developments"), 558 F.2d at 95-96.

prohibition of actual copying.”²⁰ “We reward creativity and originality with a copyright but we do not accord copyright protection to a mere copycat. As one noted authority has observed, ‘to make the copyright turnstile revolve, the author should have to deposit more than a penny in the box.’”²¹

In *Feist Publications v. Rural Telephone Service Co.*,²² the United States Supreme Court held that the white-pages listing of names, addresses and phone numbers in a telephone directory was not copyrightable because the listing contained raw, unoriginal material. The Court explained that “[o]riginal, as the term is used in copyright, means only that the work was independently created (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity.”²³

To be sure, the requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, no matter how crude, humble or obvious it might be. Originality does not signify novelty; a work may be original even though it closely resembles other works so long as the similarity is fortuitous, not the result of copying.²⁴

In *Feist* the Court found no originality. “The end product is a garden-variety white pages directory, devoid of even the slightest trace of creativity.”²⁵

Even if a work of authorship is original and fixed in any tangible medium of expression as required by Section 102(a) of the Copyright Act of 1976, Section 102(b) imposes a limitation known as the idea/expression dichotomy.

THE IDEA/EXPRESSION DICHOTOMY

Section 102(b) of the Copyright Act of 1976 makes it clear that facts or ideas are not copyrightable. Only an original expression of facts or ideas is copyrightable. Facts (or discoveries) are already in the public domain and are, therefore, not original. The author does not create, make, or originate facts; he merely discovers them.

²⁰ *Best Medium Publishing Co.*, 385 F.2d at 386.

²¹ *Donald v. Zack Meyer's T.V. Sales and Service*, 426 F.2d 1027, 1031 (5th Cir. 1970) (An agreement which was not more than an ordinary conditional sales contract or chattel mortgage agreement was not copyrightable.)

²² 111 S.Ct. 1282 (1991).

²³ *Id.* at 1287.

²⁴ *Id.*

²⁵ *Id.* at 1296.

In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.²⁶

In enacting Section 102(b), the legislative history indicates that Congress did not change the current 1909 copyright law, but merely clarified it. "This section is nothing more than a codification of the idea/expression dichotomy as it developed in the case law prior to the passage of the 1976 Act."²⁷ "Section 102(b) in no way enlarges or contracts the scope of copyright protection under the present law. Its purpose is to restate . . . that the basic dichotomy between expression and idea remains unchanged."²⁸ Copyright protects only the expression of ideas and not the ideas themselves.

"[N]o principle can be stated as to when an imitator has gone beyond copying the 'idea,' and has borrowed its 'expression.' Decisions must therefore inevitably be *ad hoc*."²⁹

For example, an author may decide to write a book, a fictional work, whereby the idea or theme is "boy meets girl." "[T]his idea can be expressed in many ways. A copyright infringement would occur only if there were substantial similarity in the expression of this general theme."³⁰ In *Beal v. Paramount Pictures*,³¹ Alveda King Beal wrote a book, *The Arab Heart*, which involves a foreign prince coming to the United States and meeting the woman he would eventually marry. Beal sued Paramount Pictures, Art Buchwald (writer), and Eddie Murphy (writer and director) for copyright infringement, the allegedly infringing work being the movie "Coming to America." "Coming to America" also involved a foreign prince coming to the United States and meeting the woman he would eventually marry. But the plots differed greatly. One prince chose to come to the United States; the other was forced to do so by his grandfather. One prince hid his royalty and status; the other flaunted it. The courtships that led to marriage, and the nature of the relationships, differed greatly. The romantic "goal" of each prince differed, and the relationships developed differently. The characters of the two princes were different - one was humble, the other arrogant.³²

²⁶ 17 U.S.C. § 102(b) (1988).

²⁷ *Toro Co. v. R & R Products Co.*, 787 F.2d 1208 (8th Cir. 1986).

²⁸ H.R. Rep. No. 94-1476 at 57; S. Rep. No. 94-473 at 54, reprinted in 1976 U.S. Code & Adm. News 5670.

²⁹ *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960).

³⁰ *Beal v. Paramount Pictures*, 806 F.Supp. 963, 966 (N.D.Ga. 1992).

³¹ 806 F.Supp. 963 (N.D.Ga. 1992).

³² *Id.* at 968.

The Court held there was no copyright infringement. The idea of each of the two works was "boy meets girl" or "a prince coming to America." These are generalized themes, which are not copyrightable. The expressions of these ideas or themes were not substantially similar. Therefore the Court granted the defendant's motion for summary judgment.³³

Consider *Mazer v. Stein*,³⁴ in which respondents obtained copyrights on original statuettes of male and female dancing figures made of semivitreous china. The respondents casted the statuettes in molds and copied them for use on lamp bases. The United States Supreme Court held that the idea of "using statuettes of human figures in table lamps" is not copyrightable; the respondents "may only prevent use of copies of their statuettes as such or as incorporated in some other article. . . . [A]rtistic articles are protected in form but not their mechanical or utilitarian aspects."³⁵ Copyright "protection is given only to the expression of the idea - not the idea itself."³⁶

In *Eden Toys, Inc. v. Marshall Field & Co.*,³⁷ Eden Toys, a nationally known manufacturer of stuffed, plush toys, designed, manufactured, and copyrighted a stuffed toy snowman. The toy proved to be a popular item, and Eden sold a number of the toys to retail department stores, including Marshall Field & Company, for the coming Christmas season. The following March, Marshall Field was shown a stuffed toy snowman manufactured by a Korean producer of plush toys. After the Korean manufacturer agreed to make a few changes (allegedly resembling the Eden snowman), Marshall Field placed a sizable order. Eden brought suit against Marshall Field for copyright infringement. Evidence showed that while the two snowmen were roughly the same size, their "total concept and feel" were substantially different.³⁸

The circuit court held there was no infringement of copyright. "The protection afforded a copyrighted work covers only the work's particular expression of an idea, not the idea itself." The plaintiff cannot copyright the "idea" of a snowman. Any similarity between the Eden snowman and the Korean snowman "would appear to the ordinary observer to result solely from the fact that both are snowmen. . . . Even if an alleged copy is based on a copyrighted work, a defendant may legitimately avoid infringement by intentionally mak-

³³ *Id.* at 967-69.

³⁴ 347 U.S. 201 (1954).

³⁵ *Id.* at 218.

³⁶ *Id.* at 217.

³⁷ 675 F.2d 498 (2d Cir. 1982).

³⁸ *Id.* at 499-500.

ing sufficient changes in a work which would otherwise be regarded as substantially similar to that of the plaintiffs.”³⁹

Now suppose that a person creates an original work of authorship fixed in a tangible medium of expression. He wants to obtain copyright protection for the original expression of his idea. However evidence indicates that his idea can only be expressed in one way, or in a very limited number of ways. To what extent is he entitled to copyright protection? This leads to the primary focus of this paper, the merger doctrine.

THE MERGER DOCTRINE

The merger doctrine, a variation of the idea/expression dichotomy, states that when an idea can only be expressed in one way (or in a very limited number of ways), the idea and the expression merge, and the result is not copyrightable.⁴⁰ This doctrine is necessary to prevent an author from obtaining a monopoly on his/her idea (which is the realm of patent law).

In order to serve the designated purpose of the Copyright Act - “to promote the Progress of Science and the useful Arts” - copyright affords an incentive to authors. While the “immediate effect of our copyright law is to secure a fair return for an author’s creative labor,” the “ultimate aim is, by this incentive, to stimulate artistic creativity for the general public good.”⁴¹ Generally, for a period of “the life of the author and fifty years after the author’s death,”⁴² the author has the exclusive right “to reproduce the copyrighted work in copies.”⁴³ This is consistent with the fundamental purpose of the Copyright Act - “to encourage the production of original works by protecting the expressive elements of those works while leaving the ideas, facts, and functional concepts in the public domain for others to build on.”⁴⁴ Thus the merger doctrine is necessary to maintain the “balance between protection (incentive) and dissemination of information (use), to promote learning, culture, and development.”⁴⁵

The merger doctrine derives from the United States Supreme Court’s decision in *Baker v. Selden*.⁴⁶ Charles Selden obtained copy-

³⁹ *Id.* at 500-501. See also *Gund, Inc. v. Applause, Inc.*, 809 F. Supp. 304 (S.D.N.Y. 1993) (Anyone can make an original expression of a stuffed, floppy, toy dog.)

⁴⁰ *CMA/Cleveland, Inc. v. UCR, Inc.*, 804 F.Supp. 337 (M.D.Ga. 1992).

⁴¹ *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975).

⁴² 17 U.S.C. § 302(a) (1988).

⁴³ 17 U.S.C. § 106 (1988).

⁴⁴ *Sega Enterprises Ltd. v. Accolade, Inc.*, 977 F.2d 1510 (9th Cir. 1992).

⁴⁵ *Digital Communications v. Softklone Distributing*, 659 F.Supp. 449, 458 (N.D.Ga. 1987).

⁴⁶ 101 U.S. 99 (1879).

rights on a series of books exhibiting and explaining a new system of double entry bookkeeping to which were "annexed certain forms or blanks, consisting of ruled lines, and headings, illustrating the system and showing how it is to be used and carried out in practice."⁴⁷ Baker allegedly infringed these copyrights when he wrote a book using a similar plan, but made a different arrangement of the columns, and used different headings.

The Court phrased the issue: "[W]hether, in obtaining the copyright of his books, [Selden] secured the exclusive right to the use of the system or method of bookkeeping which the said books are intended to illustrate and explain. . . . Stated in another form, the question is, whether the exclusive property in a system of bookkeeping can be claimed, under the law of copyright, by means of a book in which that system is explained?"⁴⁸

Selden argued that "he has secured such exclusive right, because no one can use the system without substantially the same ruled lines and headings which he has appended to his books in illustration of it."⁴⁹

The Court held no exclusive copyright could be claimed in the system of bookkeeping:

The very object of publishing a book on science or the useful arts is to communicate to the world the useful knowledge which it contains. But this object would be frustrated if the knowledge could not be used without incurring the guilt of piracy of the book. And where the [idea Selden's book] teaches cannot be used without employing the methods and diagrams used to illustrate the book, or such as are similar to them, such methods and diagrams are to be considered as necessary incidents to the art, and given therewith to the public . . . for the purpose of practical application.⁵⁰

Thus "in using the art, the ruled lines and headings of accounts must necessarily be used as incident to it."⁵¹

In conclusion the Court stated "that blank account-books are not the subject of copyright; and that the mere copyright of Selden's book did not confer upon him the exclusive right to make and use account-books, ruled and arranged as designated by him and described and illustrated in said book."⁵² Comparing copyrights to patents, the Court explained that "[t]o give to the author of the book an exclusive

⁴⁷ *Id.* at 100.

⁴⁸ *Id.* at 101.

⁴⁹ *Id.*

⁵⁰ *Id.* at 103.

⁵¹ *Id.* at 104.

⁵² *Id.* at 107.

property in the art described therein, when no examination of its novelty has ever been officially made, would be a surprise and a fraud upon the public. That is the province of patent, not of copyright."⁵³

Courts since *Baker v. Selden* have interpreted the case to set forth several principles, two of which are: (1) "copyright laws may not be used to obtain and hold a monopoly over an idea,"⁵⁴ and (2) "necessary expressions incident to an idea 'merge' with that idea and also are not copyrightable (this is the realm of patent, not copyright protection)."⁵⁵ One problem with the merger doctrine is that there is no uniform approach to analyzing a merger situation. The courts do this on a case-by-case basis.

APPLICATIONS OF THE MERGER DOCTRINE

One category of subject matter protected by the Copyright Act is pictorial, graphic, and sculptural works.⁵⁶ One example of a work in this category is a map. In *Mason v. Montgomery Data, Inc.*,⁵⁷ Hodge Mason created and published 233 real estate ownership maps covering Montgomery County, Texas. The maps pictorially depict the location, size, and shape of surveys, land grants and tracts. Numbers and words on the maps pinpoint deeds, abstract numbers, acreage, and owners of various tracts. Mason used several sources to prepare his maps, including tax, deed, and survey records; title data; and other maps from various government agencies. When Montgomery Data, Inc. allegedly copied from Mason's maps to create a geographical indexing system, Mason sued Montgomery for copyright infringement. One of the issues was whether Mason should be denied copyright protection by reason of the merger doctrine.

The district court held Mason's maps are not copyrightable, stating "the problem with the Mason maps is . . . that [they] express the only pictorial presentation which could result from a correct interpretation of the legal description and other factual information relied upon by [Mason] in producing the maps."⁵⁸ After reviewing the merger doctrine, the circuit court reversed explaining:

The idea here was to bring together the available information on boundaries, landmarks, and ownership, and to choose locations and

⁵³ *Id.* at 102.

⁵⁴ *Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d 1240, 1250 (3d Cir. 1983).

⁵⁵ *Digital Communications*, 659 F.Supp. at 457.

⁵⁶ 17 U.S.C. § 102(a)(5) (1988).

⁵⁷ 967 F.2d 135 (5th Cir. 1992).

⁵⁸ *Mason v. Montgomery Data, Inc.*, 765 F.Supp. 353, 355 (S.D.Tex. 1991).

an effective pictorial expression of these locations. The idea and its final expression are separated by Mason's efforts and creativity that are entitled to protection from competitors.... Although Mason sought to depict the information accurately, the conflicts among the sources and the limitations inherent in the process of representing reality in pictorial map form required him to make choices that resulted in independent expression. Extending protection to that expression will not grant Mason a monopoly over the idea, because other mapmakers can express the same idea differently.⁵⁹

The circuit court in *Mason* distinguished *Mason* from a recent map case reaching an opposite result, *Kern River Gas Transmission Co. v. Coastal Corp.*⁶⁰ Kern River Gas Transmission Company identified the proposed route of a natural gas pipeline and submitted the maps to the Federal Energy Regulatory Commission in support of Kern River's application for authority to build a pipeline. When a competitor of Kern River copied portions of the maps and submitted a competing bid, Kern River sued for copyright infringement. The Court held the idea at issue here was a map showing "the proposed location of a prospective pipeline."⁶¹ In holding that the merger doctrine applied, the Court noted that "Kern River's principal planning engineer testified that he could think of no other way to portray the idea of the pipeline's proposed location." Thus the idea merged with Kern River's expression because there was only one effective way to express that idea.⁶²

In both *Mason* and *Kern River* the Court used the same process in applying the merger doctrine: (1) What is the idea? (2) Is there essentially only one way to express that idea? If so, the merger doctrine applies and there is no copyright protection for the author's expression (as in *Kern River*). Or is the idea capable of various modes of expression? If so, then the expression will be protected by copyright "because the fact that one author has copyrighted one expression of that idea will not prevent other authors from creating and copyrighting their own expressions of the same idea"⁶³ (as in *Mason*).

⁵⁹ 967 F.2d at 140.

⁶⁰ 899 F.2d 1458 (5th Cir.), cert. denied, 111 S.Ct. 374 (1990).

⁶¹ 899 F.2d at 1464.

⁶² *Id.*

⁶³ *Mason*, 967 F.2d at 139. See also *Concrete Machinery Co. v. Classic Lawn Ornaments*, 843 F.2d 600 (1st Cir. 1988) (The "idea" of molds to make concrete statues and ornamental articles, such as swans, donkeys, and deer used primarily for lawn decorations does not merge with the "expression" since there are limitless ways these creatures can be expressed in terms of posture and facial expression); *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738 (9th Cir. 1971) (The "idea" of a pin in the shape of a bee formed of gold encrusted with jewels and its "expression"

Another category of subject matter protected by the Copyright Act is literary works.⁶⁴ Works in this category include books, periodicals, manuscripts, phonorecords, film, tapes, disks, cards, and computer programs.⁶⁵ In *Costello, Erdlen v. Winslow, King, Richards*,⁶⁶ Winslow, a provider of outplacement counseling services to former employees of client companies, authored a 91-page literary work entitled "Job Hunting Guide." Winslow, a former Costello employee, also provides outplacement services. When Winslow prepared a document called the "Career Search Guide," Costello sued Winslow for copyright infringement, claiming "the Career Search Guide contains passages which are identical or almost identical to ones found in the Job Hunting Guide."⁶⁷

A closer examination of the competing guides show many similarities and some differences. The Job Hunting Guide contains twelve chapters; the Career Search Guide contains fourteen chapters. The chapters have similar, identical, or paraphrased headings (keeping records; preparing resumes), sentences (Take a long hard look at yourself.), phrases (inquisitive mind), words (selection; placement), action verbs, charts, evaluation forms, sample resumes, and sample interview questions (Are you direct and honest with people?).⁶⁸

After reviewing the merger doctrine, the Court dissected each chapter attempting to separate the unprotected ideas from the protected expression of the ideas, and then suggested that the merger doctrine may excuse some of the copying:

It should be noted that the similarity between the parties' job guides stems, in part, from the commonality of the idea of how to get a job. The idea, getting a job, logically begins with the loss of a job and ends with procuring new employment. . . . The similarity in the table of contents in the guides at issue reflects, in part, the limited number of ways to express the idea of how to get a job.⁶⁹

Recognizing that "similarity stemming solely from the commonality of the subject matter is not proof of unlawful copying," the Court denied Costello's motion for summary judgment so the trier of fact could determine whether the copying is sufficiently substantial to constitute infringement of copyright.⁷⁰

appear to be indistinguishable and inseparable; thus no copyright protection under the merger doctrine.)

⁶⁴ 17 U.S.C. § 102(a) (1988).

⁶⁵ 17 U.S.C. § 101 (1988).

⁶⁶ 797 F.Supp. 1054 (D.Mass. 1992).

⁶⁷ *Id.* at 1056.

⁶⁸ *Id.* at 1059.

⁶⁹ *Id.* at 1063-64.

⁷⁰ *Id.* at 1062, 1065.

The *Costello* case appears to establish a middle ground in merger cases. This is not a case where the idea can only be expressed in one way, thereby denying copyright protection. Nor is this a case where there are an unlimited number of ways of protecting the idea, thereby protecting each original expression of the idea. Instead this is a case where there are a limited number of ways to express the idea, whereby the court will permit some copying, but not substantial copying as a whole, to prevent the author of the expression from gaining a monopoly on the idea.

In *Matthew Bender & Co. v. Kluwer Law Book Publishers*,⁷¹ Matthew Bender published a treatise entitled *Damages in Tort Actions*. One segment contained a 635-page chapter, "Illustrative Awards and Settlements," which in chart form presents information relating to personal injury and wrongful death awards and settlements. The chapter contains thirty sub-chapters, each one naming a different body part. Each sub-chapter gives information including the amount of recovery, the name of the case, the event, the injury, and other relevant data. When Kluwer Law Book Publishers published a single volume 730-page work entitled *What's It Worth? A Guide to Current Personal Injury Awards and Settlements*, Bender sued Kluwer for copyright infringement. The evidence revealed that Kluwer presented in chart form information relating to personal injury and wrongful death awards and settlements in an identical or substantially similar way to that of Bender.⁷²

After reviewing the merger doctrine, the Court identified the idea in Bender's work: "to provide attorneys working on a medical malpractice case with a useful guide, in chart form, outlining the results achieved in prior similar cases."⁷³ Then, finding the merger doctrine applicable here, the Court held that Bender could not own a copyright on the charts:

[T]he number of ways to organize this information [in chart form] in a useful and accessible manner is limited. . . . Further, Bender cannot claim a legally protectable interest in the specific column headings utilized in its chart. Terms such as "amount" and "jurisdiction" are merely taken from the normal usage of the courts in describing key aspects of individual cases. The terms employed are the most logical and clear ways of expressing the idea to be conveyed. Indeed, these terms, or synonyms for them, are the only way of conveying the desired information.⁷⁴

⁷¹ 672 F.Supp. 107 (S.D.N.Y. 1987).

⁷² *Id.* at 108.

⁷³ *Id.* at 110.

⁷⁴ *Id.* at 110-111. Also detrimental to Bender was the lack of originality of the

There was a different result in *Educational Testing Services v. Katzman*.⁷⁵ Educational Testing Service (ETS) is a nonprofit educational organization that prepares and administers numerous standardized tests, including the Scholastic Aptitude Test (SAT) in multiple choice format given to high school students. John Katzman ran a review course and made copies of an SAT test. When ETS sued Katzman for copyright infringement, one defense was that the merger doctrine is applicable because the idea (to test students on their knowledge of square roots or dangling participles) can only be expressed in a limited number of ways.⁷⁶

The Court found no difficulty in concluding that the merger doctrine did not apply:

It is apparent on the face of the materials that ETS' questions do not represent the only means of expressing the ideas thereon. . . . Although ETS cannot appropriate concepts such as rules of punctuation, analogies, vocabulary or other fundamental elements of English composition, it can, using its own resources, devise questions designed to test these concepts and secure valid copyrights on these questions. Other persons, similarly resourceful, have ample latitude and opportunity to frame noninfringing questions testing the same subjects.⁷⁷

Perhaps the most difficult subject matter to analyze under the merger doctrine is a computer program. A computer program "is a set of statements or instructions to be used directly or indirectly in a computer in order to bring about a certain result."⁷⁸ It is classified as a work of authorship in the category of literary works, and in some situations may also be classified as an audiovisual work.⁷⁹

It would be hard to imagine a copyright infringement case involving computer programs that does not cite *Apple Computer, Inc. v. Franklin Computer Corp.*⁸⁰ Apple Computer manufactures and markets personal computers, related peripheral equipment, and computer programs. Franklin Computer manufactures and sells the ACE 100 personal computer, designed to be "Apple compatible." When Frank-

charts. *Id. Compare, Kregos v. Associated Press*, 937 F.2d 700 (2d Cir. 1991) (The general idea that statistics can be used to assess pitching performance does not merge with the expression of the idea - a baseball pitching form that displays nine items of information concerning the past performances of the opposing pitchers scheduled to start each day's baseball games.)

⁷⁵ 793 F.2d 533 (3rd Cir. 1986).

⁷⁶ *Id.* at 539, 540.

⁷⁷ *Id.* at 540.

⁷⁸ 17 U.S.C. § 101 (1988).

⁷⁹ 17 U.S.C. § 102 (1988).

⁸⁰ 714 F.2d 1240 (3rd Cir. 1983), *cert. dismissed*, 464 U.S. 1033 (1984).

lin copied fourteen of Apple's operating system programs, Apple sued Franklin for copyright infringement.⁸¹

Franklin claimed in defense that the programs contained no copyrightable subject matter.⁸² In addition, Franklin argued, "the use of identical signals was necessary in order to ensure 100% compatibility with application programs created to run on the Apple computer."⁸³

First the Court mercifully, for the benefit of the computer-illiterate reader, stated in simple, non-technical language how a computer operates. The Court defined and explained devices such as a CPU, ROM, EPROM, and diskette ("floppy disk"). It identified the differences between high level and low level languages, "source code" and "object code," and applications programs and operating systems programs.⁸⁴

Second, after reviewing in great detail the legislative history and case law on computer programs, the Court concluded that original computer programs are copyrightable. It makes no difference whether a computer program is expressed in object code or source code, whether or not it is embedded on a ROM (read only memory) device, or whether it functions as an operating system program or as an applications program.⁸⁵

Eventually there was discussion of the merger doctrine. The Court identified Apple's idea in its application programs as a "method which instructs the computer to perform its operating functions."⁸⁶ Supporting Apple, the Court noted that "Apple does not seek to copyright the method ... but only the instructions themselves."⁸⁷ Thus we "focus on whether the idea is capable of various modes of expression. If other programs can be written or created which perform the same function as an Apple's operating system program, then that program is an expression of the idea and hence copyrightable."⁸⁸ The case was remanded to the district court to resolve several issues, including whether there are other methods of expressing that idea.

Apple Computer v. Franklin Computer set a foundation and acted as a springboard for future copyright infringement cases involving computer programs.

In *Digital Communications v. Softklone Distributing*,⁸⁹ the plaintiff developed and marketed the Crosstalk asynchronous data commu-

⁸¹ 714 F.2d at 1242-44.

⁸² *Id.* at 1244.

⁸³ *Id.* at 1245.

⁸⁴ *Id.* at 1243.

⁸⁵ *Id.* at 1247-52.

⁸⁶ *Id.* at 1251.

⁸⁷ *Id.*

⁸⁸ *Id.* at 1253.

⁸⁹ 659 F.Supp. 449 (N.D.Ga. 1987).

nication system. The purpose of the Crosstalk system is to enable the user's computer to communicate with other computers. One of the elements of the system is the distinctively designed "status screen" display also called the "main menu," which contains an arrangement and grouping of parameter/command terms under various descriptive headings. The user selects and effectuates the desired command term by typing the two designated capitalized letters corresponding to the desired command. (For example, type "SP" for the S*peed* command.) The defendant developed a clone of the Crosstalk program and substantially copied the format of the Crosstalk status screen. When sued for copyright infringement, the defendant raised the merger doctrine as one of its defenses.⁹⁰

Citing several cases, including *Apple Computer v. Franklin Computer*,⁹¹ the Court reviewed the merger doctrine, especially as it relates to computers and applied one simple approach to separate the idea from the expression:

The inherent problem with applying the idea (and expression merged with idea) versus expression (copyrightable) distinction to any specific case is defining the underlying "idea" of the copyrighted work. . . . *[T]he purpose or function of a utilitarian work would be the work's idea.* Having once determined the "idea" of the copyrighted work, the court then is to determine whether there are various means of achieving the desired purpose. Where there are various means of achieving the desired purpose, then the particular means chosen is not necessary to the purpose: hence, there is expression [copyrightable], not idea [expression merged with idea]. [The] "accepted test" in [the] computer area is: if there is only one way to express the idea, "idea" and "expression" merge and there is no copyrightable material.⁹²

The Court proceeded to identify the "idea," as the process or manner by which the status screen operates, and the "expression" is the method by which the idea is communicated to the user.⁹³

The use of a screen to reflect the status of the program is an "idea"; the use of a command driven program is an "idea"; and the typing of two symbols to activate a specific command is an "idea." All of these elements relate to how the computer program receives commands or instructions from the user and how operationally the computer reflects the results of those commands.⁹⁴

⁹⁰ *Id.* at 452-54.

⁹¹ 714 F.2d 1240 (3rd Cir. 1983).

⁹² 659 F.Supp. at 458.

⁹³ *Id.*

⁹⁴ *Id.* at 459.

The Court identified the "expression" of the idea as those aspects of the status screen "unrelated to how the computer program operates, such as (1) the arrangement of the parameter/command terms, and (2) the highlighting and capitalizing of two specific letters. These have "no relation to how the screen functions, i.e., the user need not type in two highlighted, capitalized symbols to effectuate a command."⁹⁵

After the Court identified the "expression" of the idea, it had to decide whether such expression could be arranged in various ways:

The parameter/commands could have been arranged and delineated in an almost infinite number of horizontal and vertical patterns and groupings that would be substantially dissimilar to the arrangement and grouping utilized by the plaintiff. Likewise, the defendants could have used a wide variety of techniques to indicate which symbols the user should type to effectuate a command, eg., different symbols . . . highlighting, . . . capitalizing, . . . underlining, . . . or any combination thereof. . . . The modes of expression chosen by the plaintiff for its status screen are clearly not necessary to the idea of the status screen. Therefore, the plaintiff's mode of expression of the status screen does not merge with the idea of the status screen.⁹⁶

Digital Communications and other recent computer-related cases involving the merger doctrine illustrate that separating the idea from the expression is not an easy task.⁹⁷ Only when this is done may one

⁹⁵ *Id.*

⁹⁶ *Id.* at 460.

⁹⁷ See *Brooktree Corp. v. Advanced Micro Devices, Inc.*, 977 F.2d 1555 (Fed. Cir. 1992) (Semiconductor chips that embody a circuit design to act as a "color palette," producing the colors in color video displays having high speed and enhanced picture resolution. To what extent does the Semiconductor Chip Protection Act of 1984 [17 U.S.C. §§ 901-914] protect the design layouts of semi-conductor chips if the pattern is deemed inseparable from the utilitarian function of the chip?) 977 F.2d at 1562-63; *CMAX/Cleveland, Inc. v. UCR, Inc.*, 804 F.Supp. 337 (M.D.Ga. 1992) (A computer software system designed for use by companies engaged in the rent-to-own business. The system enables companies to input, store, process, and retrieve information incident to the "rent-to-own" furniture and appliance business, including inventory, rental agreement, and accounting information. To what extent are the file structures, transaction codes, and screens and reports subject to the limitations of the merger doctrine?) 804 F.Supp. at 351-56; *Apple Computer v. Microsoft Corp.*, 799 F.Supp. 1006 (N.D.Cal. 1992) (Audiovisual works for the graphical user interface of the Macintosh computer to help people prepare and analyze their work quickly and flexibly. To what extent do the following ideas for screen displays merge with the expression: "icons or symbols to represent programs or information; pull down menus or lists of commands or information; use of windows to display information and the ability to move, re-size, open or close those windows to retrieve, put away or modify information; and a display of text by a proportionally spaced font in all menu items, title bars, icon

proceed to determine whether there are various means of expression to achieve the desired purpose.

Another approach used by some courts to distinguish idea from expression is an abstraction-filtration-comparison test. A computer program contains many distinct ideas. Under such a test, the program is separated into manageable components (abstraction), after which the court filters the unprotectable components of the program from the protectable expression, and then compares the protectable expressive components of the program with the structure of the allegedly infringing program. This was done in *Atari Games Corp. v. Nintendo of America, Inc.*⁹⁸

Nintendo sells the Nintendo Entertainment System (NES), a home video game system consisting of a monitor, console, and controls. The user inserts a video game cartridge into the console in order to play a game. Nintendo designed a program (the 10NES) using microprocessors or chips to prevent the NES from accepting (thereby locking out) unauthorized game cartridges. Atari tried to break the code so that it could market Nintendo-compatible video games. When it was unable to do so, Atari fraudulently obtained a reproduction of the Nintendo 10NES program from the Copyright Office, copied it, and developed its own program (the Rabbit) to unlock the NES. Nintendo then sought an injunction enjoining Atari from using the Rabbit, claiming the Rabbit infringed Nintendo's copyright on the 10NES.⁹⁹

Using an abstraction-filtration-comparison approach, the Court proceeded to dissect the program into manageable components in order to separate the idea from the expression. The idea was identified as "the generation of a data stream to unlock a console." Concerning expression of the idea, Nintendo "produced expert testimony showing a multitude of different ways to generate a data stream which unlocks the NES console." Thus Nintendo's independently-created 10NES program, which exercised creativity in the selection and arrangement of its instruction lines, was original expression that did not merge with the idea.¹⁰⁰

These computer-related cases demonstrate the complexities involved in computer-related copyright infringement cases. The Copy-

names, and text directories for a consistent and distinctive appearance.") 799 F.Supp. at 1017, 1020-42; *Gates Rubber Co. v. Bando American, Inc.*, 798 F.Supp. 1499 (D.Colo. 1992) (In a computer software program designed to aid in the selection of replacement industrial belts, to what extent is the merger doctrine applicable to "fundamental tasks" or "install files"?) 798 F.Supp. at 1519.

⁹⁸ 975 F.2d 832 (Fed. Cir. 1992).

⁹⁹ *Id.* at 835-37.

¹⁰⁰ *Id.* at 840.

right Act, as it is presently written, contains no specific approach for distinguishing unprotectable idea from protectable expression. Therefore the courts have acted on a case-by-case basis. One approach for separating the idea from the expression has been identifying the idea as the purpose or function of a utilitarian work (as in *Digital Communications*). Another approach is the abstraction-filtration-comparison test (as in *Atari v. Nintendo*). Other courts suggest a modified approach "cognizant that computer technology is a dynamic field which can quickly outpace judicial decisionmaking."¹⁰¹ "Drawing the line between idea and expression is a tricky business. . . . Nobody has ever been able to fix that boundary and [perhaps] nobody ever can."¹⁰²

CONCLUSIONS AND RECOMMENDATIONS

The judicially-created merger doctrine is necessary to make copyright law work, to prevent an author from obtaining a monopoly on his idea, and to promote the progress of science and the useful arts. "We cannot recognize copyright as a game of chess in which the public can be checkmated."¹⁰³

A uniform approach is needed by the courts when analyzing to what extent the merger doctrine applies in a particular case. It is often difficult to clearly delineate when an imitator has gone beyond copying the "idea" and has borrowed its "expression," especially in computer-related cases. Although one purpose of copyright law is to create a balance between "the interests of authors . . . in the control and exploitation of their writings . . . on the one hand, and society's competing interests in the free flow of ideas [and] information on the other hand,"¹⁰⁴ the scales should tip in favor of society in a close case. "The immediate effect of our copyright law is to secure a fair return for an 'author's' creative labor. But the ultimate aim is, by this incentive, to stimulate artistic creativity for the general public good."¹⁰⁵

The merger doctrine presents a challenge to the true author. The more original the author is in expressing an idea, and the more creative the author is in formatting the selection, coordination, and arrangement of the idea, then the more likely the work as a whole will constitute an original work of authorship, and such author will survive an attack on his copyright by reason of the merger doctrine.

¹⁰¹ *Computer Associates Intern, Inc. v. Altai, Inc.*, 982 F.2d 693, 706 (2d Cir. 1992).

¹⁰² *Id.* at 704.

¹⁰³ *Morrissey v. Procter & Gamble Co.*, 379 F.2d 675, 679 (1st Cir. 1967).

¹⁰⁴ *Sony Corp. of Am. v. Universal City Studios*, 464 U.S. 417, 429-30 (1984).

¹⁰⁵ *Twentieth Century Music Corporation v. Aiken*, 422 U.S. 151, 156 (1975).

Meanwhile the courts should be permitted to experiment with different approaches to analyzing and applying the idea/expression merger doctrine until one approach emerges that is simple, practical, useful, and most in accord with the ultimate aim of our copyright law.