

**Pruning Paracopyright Protections: Why Courts
Should Apply the Merger and *Scènes à Faire*
Doctrines at the Copyrightability Stage of the
Copyright Infringement Analysis**

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I. Introduction	303
II. The Idea-Expression Dichotomy and the Merger and <i>Scènes à Faire</i> Doctrines	306
III. The Circuit Split.....	310
A. The Doctrines Applied as Bars to Copyrightability.....	311
B. The Doctrines Applied as Defenses to Infringement	317
IV. Analyzing the Split in Response to the DMCA and the Rise in False Positives.....	323
A. The Digital Millennium Copyright Act	324
1. Brief Historical Background of Copyright and the Birth of the “Paracopyright”.....	324
2. Utilizing the Copyrightability Approach as a Response to the DMCA.....	331
B. The Issue of False Positives	335
V. Conclusion	337

I. INTRODUCTION

The judiciary and Congress have long grappled with the proper interpretation of the Copyright Clause of the Constitution. They have also struggled to interpret and redraft copyright laws to keep up with a world where the mediums of creative expression are ever evolving.

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Riding on the crest of this perpetual conundrum is the management of the idea-expression divide that exists at the heart of every copyright protection analysis. Underpinning the idea-expression divide lay the doctrines of merger and *scènes à faire* (“the doctrines”): both simple in theory yet elusive in practice. The merger doctrine states that where an idea is inseparably connected to a particular expression, the idea and the expression are said to have “merged” with one another.¹ Such connection between idea and expression is not protected under copyright law, because it would contravene the notion of original expression protection by unfairly granting a monopoly to the author and banning all others from expressing the idea.² Similarly, the *scènes à faire* doctrine bars standard phrases that necessarily flow from a common setting or theme from copyright protection.³

As a testimony to the cumbersome nature of copyright analysis, a circuit split has perpetuated for decades regarding proper application of the two doctrines in the copyright infringement context. In a copyright infringement case, the plaintiff must prove two things: (1) the existence of a valid copyright and (2) that the defendant actually copied the work.⁴ When merger and *scènes à faire* are introduced, the courts have inconsistently applied the doctrines in their analyses. With regard to the merger doctrine, it has been held by the Second and Ninth Circuits, on the one hand, that the merger doctrine should only operate as a defense to copyright infringement.⁵ On the other hand, it has been held by the Fifth, Sixth, and Ninth Circuits that merger determines copyrightability.⁶ A similar rift exists regarding the application of the *scènes à faire* doctrine. The Seventh and Ninth Circuits have taken the stance that *scènes à faire* is separate from the doctrine regarding the validity of copyright⁷ while the Second and Sixth Circuits have applied *scènes à faire* to a determination of copyrightability.⁸

¹ 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.03[B][3][b] (Matthew Bender & Co. 2006).

² *Id.*

³ *Id.* § 13.03[B][4].

⁴ *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522, 534-36 (6th Cir. 2004).

⁵ *Ets-Hokin v. Skyy Spirits, Inc.*, 225 F.3d 1068, 1082 (9th Cir. 2000); *Kregos v. Associated Press*, 937 F.2d 700, 705 (2d Cir. 1991).

⁶ *Lexmark*, 387 F.3d at 535; *Mason v. Montgomery Data*, 967 F.2d 135, 138 (5th Cir. 1992); *see Brown Bag Software v. Symantec Corp.*, 960 F.2d 1465, 1475-76 (9th Cir. 1992).

⁷ *Ets-Hokin*, 225 F.3d at 1082; *Reed-Union Corp. v. Turtle Wax, Inc.*, 77 F.3d 909, 914 (7th Cir. 1996).

⁸ *Stromback v. New Line Cinema*, 384 F.3d 283 (6th Cir. 2004); *Hoehling v. Universal Studios, Inc.*, 618 F.2d 972 (2d Cir. 1980).

Although it has been asserted that no difference in outcome arises from either approach,⁹ the enactment of the groundbreaking Digital Millennium Copyright Act (“DMCA”) and recent case law demand a new look at the consequences of the two approaches. The DMCA grants additional legal protection to owners of copyrights who utilize technology as a means to safeguard their works in digital form¹⁰ by proscribing the anticircumvention of such protection measures.¹¹ Potential liability is triggered for even an attempt at accessing a copyrighted work that sits behind a technological protection measure, whether successful or not. This right to access, or “paracopyright,” as it is commonly known, has been the source of much controversy among legal theorists and practitioners as it has greatly expanded the rights bestowed upon a copyright owner.¹²

This comment attempts to provide a circumspect analysis of the merger and *scènes à faire* doctrines as well as their application to the modern digital world. It further attempts to show that, in light of the harsh liability under the DMCA that is triggered by the circumvention of technological protection measures, courts should be more reluctant to permit copyright in marginal cases. Pre-DMCA case law demonstrates that a majority of circuits follow this approach. Those circuits consider this approach to support the constitutional goal of fostering creative expression. A second rationale is that this approach supports the policy of § 102(b) to protect ideas from ownership so as to avoid unfair monopolies. Finally, this comment shows that failure to apply the doctrines as bars to copyrightability will yield false positives, the effect of which stands in direct contrast to the constitutional goal of fostering creative expression. In light of these arguments, the courts must employ greater prudence when they consider which approach to take. This comment does not assert that the doctrines should be removed from the affirmative defense prong of an infringement suit entirely, but rather that the doctrines should be applied first at the copyrightability stage, particularly in future DMCA cases.

⁹ See Scott Abrahamson, Comment, *Seen One, Seen Them All? Making Sense of the Copyright Merger Doctrine*, 45 UCLA L. REV. 1125, 1164 (1998). In either case, the Abrahamson comment notes that the practical outcome remains the same. It is respectfully noted that this law review article was published the same year that the DMCA was enacted. It would have been impossible for the author to consider the implications created by the DMCA.

¹⁰ JULIE E. COHEN ET AL., COPYRIGHT IN A GLOBAL INFORMATION ECONOMY 573, 578 (Erwin Chemerinsky et al. eds., Aspen Law & Bus. 2002).

¹¹ 17 U.S.C. § 1201 (2006).

¹² For example, see Copyfight, <http://copyfight.corante.com>, which lists copious articles written by legal practitioners and other highly respected thinkers on the consequences of the DMCA and other copyright issues.

II. THE IDEA-EXPRESSION DICHOTOMY AND THE MERGER AND *SCÈNES À FAIRE* DOCTRINES

To fully understand the arguments proposed in this comment, it is critical to first develop the idea-expression dichotomy and the related doctrines of merger and *scènes à faire*. This section provides that foundation by setting forth several core policies underlying copyright law. The section then discusses how the courts have struggled to evaluate ideas and expressions in an attempt to support these policies and, in doing so, have utilized the doctrines of merger and *scènes à faire* as a tool to aid them in their analyses.

The Constitution grants Congress the power “[t]o 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.”¹³ While the Framers of the Constitution left much unclear by this statement, it suggests a goal to enhance public welfare by promoting the creation and dissemination of knowledge.¹⁴ The copyright, which secures for a limited time an ownership right over a creative work, serves as an economic incentive in furtherance of this goal.¹⁵ In direct opposition to the constitutional goal of copyright law, the dissemination of knowledge would be compromised if an author were allowed to have a monopoly over an idea.¹⁶ It is a long-standing principle that copyright protection extends to the expression and not to the idea. This principle stems from the notion that “ideas are free to the world”¹⁷ and that the protection of an idea would create an unfair monopoly on the part of the owner of the copyrighted work. Congress codified this notion in § 102(b) of the 1976 Copyright Act, which states that “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.”¹⁸ This tenet of copyright law begets the very dilemma with which courts grapple in copyright

¹³ U.S. CONST. art. I, § 8, cl. 8.

¹⁴ CRAIG JOYCE, ET AL., COPYRIGHT LAW 19 (6th ed. 2003).

¹⁵ 17 U.S.C. § 302(a) (2006).

¹⁶ See, e.g., *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349-50 (1991) (“[C]opyright assures authors the right to their original expression, but encourages others to build freely upon the ideas and information conveyed by a work. It is the means by which copyright advances the progress of science and art.” (citation omitted)).

¹⁷ *Taylor v. Metro-Goldwyn-Mayer Studios*, 115 F. Supp. 156, 157 (S.D. Cal. 1953).

¹⁸ 17 U.S.C. § 102(b) (2006) (emphasis added).

infringement cases: how to properly separate the idea and the expression.¹⁹

Separating idea from expression has long troubled the courts. In 1930, Judge Learned Hand summarily explained the impossibility of a universally generalizable solution:

Upon any work, and especially upon a play, a great number of patterns of increasing generality will fit equally well, as more and more of the incident is left out. The last may perhaps be no more than the most general statement of what the play is about, and at times might consist only of its title; but there is a point in this series of abstractions where they are no longer protected, since otherwise the playwright could prevent the use of his “ideas,” to which, apart from their expression, his property is never extended. Nobody has ever been able to fix that boundary, and nobody ever can.²⁰

The well-known doctrines of merger and *scènes à faire* emerged from the difficulty in managing the idea-expression dichotomy.

The merger doctrine states that, where an idea is inseparably connected to a particular expression, the idea and the expression are said to have “merged” with one another.²¹ This unity of idea and expression arises when there is only one or very few ways of expressing the idea.²² Such connection between idea and expression would contravene the notion of original expression protection and unfairly grant a monopoly to the author banning others from expressing the idea.²³ For example, one can express a map with directions to a buried treasure in very few ways. To prevent unfair copyright protection in these cases, the courts have implemented the merger doctrine to protect free expression to all above granting an express monopoly over a single idea.²⁴

Although the merger doctrine was historically applied to cases involving literature, maps, compilations, and the like, the invention of the computer and the incorporation of computer software into copyrightable subject matter added a new dimension to merger applications. With

¹⁹ This issue also relates to unfair monopolies. *See Abrahamson, supra* note 9 at 1125 (“Too much copyright protection may bestow a windfall upon the party alleging infringement . . . and may exert a dampening effect on future efforts; yet too little protection, or none at all, may deprive the creator of the reward incentive which would in turn chill future creative efforts and perhaps result in market failure.”).

²⁰ *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930) (citation omitted).

²¹ 4 NIMMER & NIMMER, *supra* note 1, § 13.03[B][3][b].

²² *E.g.*, *Hart v. Dan Taxidermy Supply Co.*, 86 F.3d 320, 322 (2d Cir. 1996).

²³ 4 NIMMER & NIMMER, *supra* note 1, § 13.03[B][3][b].

²⁴ 4 NIMMER & NIMMER, *supra* note 1, § 13.03[B][3].

regard to computer software, the individual elements of the computer program may be considered to have merged with the idea.²⁵

Several important cases have developed this concept. In 1984, the court in *Apple Computer, Inc. v. Franklin Computer Corp.* examined the merger doctrine.²⁶ The court noted that if the computer program at issue can be written in other fashions and perform the same function then the program is a copyrightable expression of an idea.²⁷ The court stated that “this inquiry is no different than that made to determine whether the expression and idea have merged, which has been stated to occur where there are no or few other ways of expressing a particular idea.”²⁸ If the idea merges with the expression, a copyright is unavailable.²⁹ A more sophisticated application of the doctrine was explored in *Atari Games Corp. v. Nintendo of America Inc.*,³⁰ which held that “if the patentable process is embodied inextricably in the line-by-line instructions of the computer program . . . then the process merges with the expression and precludes copyright protection.”³¹ In *Brown Bag Software v. Symantec Corp.*, the Ninth Circuit used a “functional demands” approach and held that the portions of the computer program “essential to the idea of the computer program were ideas and unprotected.”³² In *Gates Rubber Co. v. Bando Chemical Industries, Ltd.*, another court defined merger as “expression that is inseparable from or merged with the ideas, processes,

²⁵ *Id.*; see *Atari Games Corp. v. Nintendo of Am., Inc.*, 975 F.2d 832, 839-40 (Fed. Cir. 1992); see also *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522, 542 (6th Cir. 2004) (“What is clear is that the bytes containing the ‘LXK’ reference are functional in the sense that they, like the rest of the Toner Loading Program, also serve as input to the checksum operation and as a result amount to a lock-out code that the merger and scènes à faire doctrines preclude from obtaining protection.”).

²⁶ 714 F.2d 1240 (3d Cir. 1983). In this case, Apple challenged a denial of a motion for preliminary injunction against Franklin Computer Corp. for copyright infringement of fourteen of Apple’s computer programs including its operating system (other claims not pertinent to this comment were also before the court). *Id.* at 1242. In the district court, Franklin disputed the claim under the defense that Apple’s programs were not copyrightable subject matter. *Id.* at 1244.

²⁷ *Id.* at 1252.

²⁸ *Id.* at 1253 (citing *Morrissey v. Procter & Gamble Co.*, 379 F.2d 675, 678-79 (1st Cir. 1967); *Freedman v. Grolier Enters., Inc.*, 179 U.S.P.Q. 476, 478 (S.D.N.Y. 1973) (“Copyright protection will not be given to a form of expression necessarily dictated by the underlying subject matter.”)).

²⁹ *Apple*, 714 F.2d at 1253.

³⁰ 975 F.2d 832, 839-40 (Fed. Cir. 1992).

³¹ *Id.*

³² 960 F.2d 1465, 1478 (9th Cir. 1992). In this case, Brown Bag Software sued Symantec for copyright infringement of Brown Bag’s computer program, which was protected under a registered copyright. *Id.* at 1468. The district court entered summary judgment in favor of Symantec and Brown Bag appealed. *Id.*

or discoveries underlying the expression.”³³ The court noted that, in applying merger and other limiting doctrines, the source code and object code will constitute copyright-protected material in most cases whereas the main purpose of a program never will.³⁴

The doctrine of *scènes à faire* also limits copyright protection. Literally, it translates to “‘scenes’ . . . ‘that must be done.’”³⁵ In the literary context, it bars phrases that are “‘standard, stock, . . . or that necessarily follow from a common theme or setting’” from copyright protection.³⁶ A classic example of a stock scene is the inclusion of a criminal foot chase in a police fiction or the use of a tough-speaking Italian mobster smoking a cigar in a Mafia movie.³⁷ In *Hoehling v. Universal Studios*, a case which considered the copyrightability of a book on the voyages of the famed Hindenburg ship, the Second Circuit declared that “[b]ecause it is virtually impossible to write about a particular historical era or fictional theme without employing certain ‘stock’ or standard literary devices . . . *scènes à faire* are not copyrightable as a matter of law.”³⁸ Although *scènes à faire* would appear at first glance to be limited to cases involving movies, plays, and other artistic media, it extends to the computer software context as well.

Scènes à faire is applied to the elements of a computer program that are dictated by the requirements of the system as a whole such as “‘hardware standards and mechanical specifications, software standards and compatibility requirements, computer manufacturer design standards, target industry practices and demands, and computer industry programming practices.’”³⁹ A major goal of computer software and systems, in general, is efficiency. From a utilitarian perspective, the more efficient a program is, the less memory it will require from a computer and, therefore, the more marketable it will be. A second major goal of computer software is interoperability. Interoperability is a computer program’s ability to function properly with other software or even hardware components. For instance, a computer’s operating system,

³³ 9 F.3d 823, 838 (10th Cir. 1993). In this case, Bando Chemical hired away numerous Gates employees to help create a computer program, similar to one created by Gates, that performed complex calculations for rubber belt manufacturing. *Id.* at 830-31. Gates sued Bando for copyright infringement and the lower court entered a decision against them. *Id.* at 830. Bando appealed the decision as well as other claims not pertinent to this comment. *Id.*

³⁴ *Id.* at 836.

³⁵ *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522, 535 (6th Cir. 2004).

³⁶ *Id.* (quoting *Gates Rubber*, 9 F.3d at 838).

³⁷ *See, e.g., Walker v. Time Life Films, Inc.*, 784 F.2d 44, 50 (2d Cir. 1986).

³⁸ 618 F.2d 972, 979 (2d Cir. 1980).

³⁹ *Gates Rubber*, 9 F.3d at 838 (citations omitted).

whether Microsoft XP or Mac OS, must be able to operate with the various software applications it calls upon, whether Microsoft-made or not, as well as the various hardware components that make up the computer system. The drive for greater efficiency and interoperability severely limits the options available to computer programmers in expressing the function of the software. These external constraints, thus, figure prominently into the copyrightability of computer programs⁴⁰ and frequently lead to a denial of copyright protection where it would otherwise seem warranted.

From the foundation laid out in this section, the reader can navigate through the cases discussed in the next section. Those cases span decades of judicial decision making and cover an array of tangible mediums from literature to computer technology. The following section will also illustrate the two strains of legal thinking regarding the proper application of the doctrines in the copyright infringement context.

III. THE CIRCUIT SPLIT

The merger and *scènes à faire* doctrines are difficult to apply, largely due to the fact that the doctrines do not instruct courts on how to identify which aspects of a copyrighted work are ineligible for copyright protection nor what the scope of protection should be.⁴¹ The cumbersome nature of the doctrines naturally results in varying copyright infringement analyses. In a copyright infringement case, the plaintiff must prove two things: (1) the existence of a valid copyright and (2) that the defendant actually copied the work.⁴² With regard to the merger doctrine, on the one hand, some circuits hold that the merger doctrine should only operate as a defense to copyright infringement.⁴³ Other circuits hold that merger determines copyrightability.⁴⁴ A similar rift exists regarding the application of the *scènes à faire* doctrine. Some circuits take the stance that *scènes à faire* is separate from the doctrine

⁴⁰ *Lexmark*, 387 F.3d at 536 (citing *Computer Assoc. Int'l v. Altai, Inc.*, 982 F.2d 693, 708 (2d Cir. 1992)).

⁴¹ *Id.*; JOYCE, *supra* note 14, at 166; *accord* *Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d 1240, 1253 (3d Cir. 1983).

⁴² *Lexmark*, 387 F.3d at 534-36.

⁴³ *Ets-Hokin v. Skyy Spirits, Inc.*, 225 F.3d 1068, 1082 (9th Cir. 2000); *Kregos v. Associated Press*, 937 F.2d 700, 705 (2d Cir. 1991).

⁴⁴ *Lexmark*, 387 F.3d 522; *Mason v. Montgomery Data, Inc.*, 967 F.2d 135 (5th Cir. 1992); *Brown Bag Software v. Symantec Corp.*, 960 F.2d 1465, 1478 (9th Cir. 1992).

regarding the validity of copyright⁴⁵ while others consider *scènes à faire* to be a determination of copyrightability.⁴⁶

The following sections explain the two competing approaches to the application of the merger and *scènes à faire* doctrines in the copyright infringement context. These sections also support the application of the doctrines as bars to copyrightability. This approach serves the goals of § 102(b) of the Copyright Act and promotes competition among businesses. The judicially created tests, which separate idea from expression in the computer software context, also support the application of the doctrines as bars to copyrightability. Ultimately, viewing the split in relation to the groundbreaking and controversial Digital Millennium Copyright Act solidifies support for the bar to copyrightability approach in Part IV.A.

A. The Doctrines Applied as Bars to Copyrightability

Circuits that apply the doctrines as bars to copyrightability commonly find that using the merger and *scènes à faire* doctrines in this manner falls in accord with § 102(b) of the Copyright Act, which mandates that “[i]n no case does copyright protection for an original work of authorship extend to any idea . . . [or] procedure . . . regardless of the form in which it is described, explained, illustrated, or embodied in such work.”⁴⁷ The merger doctrine states that, where an idea is inseparably connected to a particular expression, the idea and the expression are said to have “merged” with one another, such that the expression becomes the idea and, thus, not protectable under copyright law.⁴⁸ Similarly, *scènes à faire* are phrases that are “standard, stock, . . . or that necessarily follow from a common theme or setting;”⁴⁹ they are, therefore, barred from copyright protection under the same principle. The idea/expression dichotomy is an embodiment of the constitutional goal “[t]o promote the Progress of Science and useful Arts,”⁵⁰ which, as a policy matter, fosters creativity within the public by protecting it from unfair monopolies.

When merger is applied as a bar to copyrightability, it serves the constitutional goal of “promot[ing] the Progress of Science and the

⁴⁵ *Ets-Hokin*, 225 F.3d at 1082; *Reed-Union Corp. v. Turtle Wax, Inc.*, 77 F.3d 909, 914 (7th Cir. 1996).

⁴⁶ *Stromback v. New Line Cinema*, 384 F.3d 283 (6th Cir. 2004); *Hoehling v. Universal Studios, Inc.*, 618 F.2d 972 (2d Cir. 1980).

⁴⁷ 17 U.S.C. § 102(b) (2006).

⁴⁸ 4 NIMMER & NIMMER, *supra* note 1.

⁴⁹ *Gates Rubber Co. v. Bando Chem. Indus., Ltd.*, 9 F.3d 823, 838 (10th Cir. 1993).

⁵⁰ U.S. CONST. art. I, § 8, cl. 8.

useful Arts.”⁵¹ In *Veeck v. Southern Building Code Congress International, Inc.*,⁵² the court focused, in part, on this paradigm in its determination that merger should be applied at the copyright stage. Noting that the primary goal of the Constitution was not to reward the author for her labor but rather to promote art and science, the Fifth Circuit held that copyright not only secures an author’s right in her creative work, but encourages others to freely build on the ideas expounded in those works- a principle that “‘applies to all works of authorship.’”⁵³ Merger, therefore, secures that which is actually an idea for the public to utilize in creating other works. Quoting the Supreme Court, the Fifth Circuit noted that the § 102(b) “‘idea[-]expression dichotomy strikes a definitional balance between the First Amendment and the Copyright Act by permitting free communication of facts while still protecting an author’s expression.’”⁵⁴

In *Veeck*, the defendant argued that the idea-expression dichotomy was enacted as a policy matter to “‘balance[] the competing concerns of providing incentive to authors to create and foster[] competition in such creativity.’”⁵⁵ The defendant argued that merger would not bar copyrightability of its model building codes but rather would apply only if a subsequent author wishing to create a code would need to use the identical expression to convey the idea.⁵⁶ The court reasoned that “[t]his argument effectively converts the merger doctrine from a limit on copyrightability into a mere defense against infringement based on the identity of the author.”⁵⁷ The court held that § 102(b) fosters creativity not as a defense to infringement claims but rather by permitting the effluence of information in ideas and facts from their emergence.⁵⁸ This goal of fostering creativity supports the rejection of merger as a defense against particular types of infringement, because the defense approach misinterprets the balance under § 102(b).

⁵¹ *Id.*

⁵² 293 F.3d 791 (5th Cir. 2002). In this case, Veeck published model building codes created by the Southern Building Code Congress International (“SBCCI”) on his website. *Id.* SBCCI’s codes were not enacted into positive law. *Id.* At the time of the case, the codes did not necessarily fall outside of copyright protection. *Id.* Thus, SBCCI sued Veeck for copyright infringement to which Veeck asserted merger as a defense. *Id.*

⁵³ *Id.* at 800 (quoting *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991)).

⁵⁴ *Id.* at 801 (quoting *Harper & Row, Publishers, Inc. v. Nation Enter.*, 471 U.S. 539, 556 (1985)).

⁵⁵ *Id.* (quoting *Kern River Gas Transmission Co. v. Coastal Corp.*, 899 F.2d 1458, 1463 (5th Cir. 1990)).

⁵⁶ *Id.*

⁵⁷ *Id.* at 801-02.

⁵⁸ *Id.* at 802.

Due to their inherent functional nature, computer programs pose a bigger problem in the analysis of the idea-expression dichotomy and demonstrate a greater need for the application of the doctrines as bars to copyrightability. Although the source code and the object code of a computer program may warrant copyright protection, to the extent compatibility or efficiency requires that a specific code sequence be included with a component device to permit its operation, the doctrines generally keep the code from obtaining copyright protection.⁵⁹ As the Ninth Circuit noted in *Sega Enterprises Ltd. v. Accolade, Inc.*, “[w]hen specific instructions, even though previously copyrighted, are the only and essential means of accomplishing a given task, their later use by another will not amount to infringement.”⁶⁰

This holding is consistent with the First Circuit’s decision in *Lotus Development Corp. v. Borland International, Inc.*, which involved the copying of a computer menu command hierarchy.⁶¹ The court did not concern itself with an analysis of infringement, but stated that the initial inquiry should be whether the menu hierarchy could be copyrighted at all.⁶² Regarding the “long prompts” (the bottom line display) component of the menu, the court did not take a stance on whether it was copyrightable, but noted that a strong argument could be made that merger prevented the prompts from being copyrighted.⁶³ The court also discussed the menu command hierarchy as a method of operation. The First Circuit stated that the expressions of the menu are immaterial to a method of operation. While not explicitly discussing merger, the court stated that “[i]f specific words are essential to operating something, then they are part of a ‘method of operation’ and, as such, are unprotectable.”⁶⁴ This holding supports, in the computer context, the barring of methods from copyright protection under § 102(b).

Application of the doctrines as bars to copyrightability also benefits competition among businesses by eliminating monopoly power. In *Kern River Gas Transmission v. Coastal Corp.*, the Fifth Circuit considered a copyright infringement case involving a topographical map upon which

⁵⁹ *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522, 536 (6th Cir. 2004).

⁶⁰ 977 F.2d 1510, 1524 (9th Cir. 1992) (quoting National Commission on New Technological Uses of Copyrighted Works, Final Report 20 (1979)); *accord* *Atari Games Corp. v. Nintendo of Am., Inc.*, Nos. 88-4805 & 89-0027, 1993 U.S. Dist. LEXIS 6786, at *5 (N.D. Cal. May 18, 1993) (“Program code that is strictly necessary to achieve current compatibility presents a merger problem, almost by definition, and is thus excluded from the scope of any copyright.”).

⁶¹ 49 F.3d 807 (1st Cir. 1995).

⁶² *Id.* at 815.

⁶³ *Id.* at 816.

⁶⁴ *Id.*

the plaintiff, a gas transmission company, superimposed lines and mile markings for a natural gas pipeline development proposal.⁶⁵ A competing company utilized these maps with certain modifications in a proposal to build its own pipeline.⁶⁶ Plaintiff brought an action for copyright infringement against defendant for use of its copyrighted map.⁶⁷ The court stated that where merger has occurred, a party is not barred from copying the expression, because a grant of copyright protection in that instance would unfairly grant a monopoly upon the idea.⁶⁸ The court specifically agreed with the district court and stated that the proposed location of prospective pipelines is not copyrightable.⁶⁹ If it were copyrightable, Kern would monopolize the idea for the location of the pipeline, which would foreclose competition in opposition to the congressional intent behind copyright law.⁷⁰ The court specifically denied the defendant's urging not to look at merger in terms of copyrightability.⁷¹ Similarly, the Third Circuit in *Whelan Associates, Inc. v. Jaslow Dental Laboratory, Inc.*, addressed the issue of copyright infringement of a computer program structure.⁷² The court looked first at the copyrightability of the plaintiff's work before considering the infringement analysis.⁷³ The court also stated that *scènes à faire*, as a bar to copyrightability, is a "well-settled doctrine"; holding otherwise would unfairly grant a monopoly on ideas to the copyright owner.⁷⁴

Two judicially-created tests, known as the abstraction-filtration-comparison and the extrinsic-intrinsic test, separate idea from expression in the computer software context and support the application of the doctrines as bars to copyrightability. Before merger and *scènes à faire* are applied in computer software cases, some courts must undergo the abstraction-filtration-comparison. In *Computer Assoc. International v. Altai, Inc.*, the Second Circuit introduced the abstraction-filtration-comparison concept to analyze copyright infringements in ascertaining substantial similarity.⁷⁵ The abstraction test, originally expounded by

⁶⁵ 899 F.2d 1458, 1460 (5th Cir. 1990).

⁶⁶ *Id.*

⁶⁷ *Id.* at 1461.

⁶⁸ *Id.* at 1463 (citing *Baker v. Selden*, 101 U.S. 99, 103 (1880)).

⁶⁹ *Id.* at 1464-65.

⁷⁰ *Id.* at 1463-64.

⁷¹ *Id.* at 1464.

⁷² 797 F.2d 1222 (3d Cir. 1986).

⁷³ *Id.* at 1224.

⁷⁴ *Id.* at 1236.

⁷⁵ 982 F.2d 693, 706-07 (2d Cir. 1992) ("Altai"). In this case, Computer Associates marketed a job scheduling program ("ADAPTER") that was designed for IBM mainframes. *Id.* at 698. A particular component of the program acted as a translator between the program and the IBM operating system. *Id.* at 699. Altai marketed its own

Judge Learned Hand, requires the courts to first break down the program into its basic structural parts.⁷⁶ Courts must effectively reverse-engineer the program to identify all of its abstraction levels. First, the court will look at the purpose of the application; then zoom in to extract the functions of the higher-level modules that enable the purpose of the application to be reached; then zoom in further to obtain the lower-level modules that enable the higher-level modules to work; and, ultimately, all that remains are the individual lines of code.⁷⁷ The filtration phase requires the court to eliminate any abstraction level that is unprotected by copyright law. The court must determine if each level is an idea or dictated by efficiency constraints so as to be incidental to the idea; required by other external factors; or extracted out of the public domain.⁷⁸ The limiting doctrines of merger and *scènes à faire* are then applied to determine whether the remaining levels of abstraction are protectable by copyright.⁷⁹ Once all components have been sifted out through the filtration analysis utilizing merger and *scènes à faire*, then the substantial similarity inquiry entails determining whether any aspect of the plaintiff's program was copied by the defendant.⁸⁰

This test was applied by the Eleventh Circuit in *Bateman v. Mneumonics, Inc.*, which also considered the proper applications of the doctrines in a case concerning computer programs.⁸¹ The district court utilized the abstraction-filtration-comparison test to determine whether there was actionable similarity.⁸² On appeal, the court focused on the filtration step, which is used to separate out protectable expression from non-protectable expression.⁸³ The defendants argued that both merger and *scènes à faire* should be applied at this stage in literal copying (word-for-word copying) analysis, whereas the court instructions stated

job scheduler ("ZEKE" later adapted to "OSCAR"). *Id.* at 700. An employee of Altai recruited an employee of Computer Associates, who brought with him the code for ADAPTER. *Id.* He aided Altai in creating OSCAR. *Id.* at 700. Computer Associates sued Altai for copyright infringement of their ADAPTER program. *Id.* at 700.

⁷⁶ *Id.* at 706.

⁷⁷ *Id.* at 707.

⁷⁸ *Id.* at 707-10.

⁷⁹ *Id.* The court in *Gates Rubber Co. v. Bando Chemical Industries, Ltd.* labeled the filtration step as the "process-expression" dichotomy. 9 F.3d 823, 836 (10th Cir. 1993).

⁸⁰ *Altai*, 982 F.2d at 710.

⁸¹ 79 F.3d 1532 (11th Cir. 1996). In this case, Bateman sued Mneumonics on several counts of copyright infringement of copyrighted software applications and hardware components. *Id.* at 1536. Bateman claimed that he licensed the programs to defendant but later terminated the license. *Id.* at 1538. Mneumonic, Inc. then created software that was interoperable with Bateman's software. *Id.* at 1539. Bateman sued Mneumonics for copyright infringement. *Id.* at 1540.

⁸² *Id.* at 1544.

⁸³ *Id.*

that filtration only played a part in non-literal copying (paraphrasing or copying the essence of the work) analysis.⁸⁴ The court took no direct stance on this issue but focused on the failure of the district court to consider the challenges to copyrightability such as *scènes à faire* and merger.⁸⁵ Undoubtedly referring to the *scènes à faire* doctrine, the court noted that programs may be dictated by external factors including industry demands and efficiency considerations and, if found true, should be applied so as to refute copyright protection of the work.⁸⁶ With regard to the merger doctrine, the court explicitly stated that a work deemed copyrightable may not warrant copyright protection because this doctrine may render the work unoriginal.⁸⁷ Accordingly, *Bateman* instructs that the doctrines must come into play to determine the copyrightability issue.

In *Brown Bag Software v. Symantec*, the Ninth Circuit faced a copyright infringement suit regarding a computer program for outlining.⁸⁸ The district court utilized the extrinsic-intrinsic test to determine the substantial similarity of the two programs.⁸⁹ The extrinsic-intrinsic test normally requires the court to perform an “analytic dissection” which is an objective analysis of the expressive elements of the work (the extrinsic test) followed by an evaluation of the substantial similarity in the expressions from the viewpoint of the ordinary reasonable person (the intrinsic test).⁹⁰ The Ninth Circuit noted that the district court properly applied analytic dissection to five groups of features of the programs, not to identify infringement or compare similarities, but “for the purpose of defining the scope of plaintiff’s copyright.”⁹¹ The court agreed with this approach and stated that copyrightability applies to both the ownership element as well as the copying element of the claim.⁹² One aspect of copyright ownership “is the copyrightability of the subject matter.”⁹³

Circuits that apply the doctrines as bars to copyrightability base their approach primarily on § 102(b) policy grounds. As discussed, application of the doctrines in this manner serves additional goals, such

⁸⁴ *Id.*

⁸⁵ *Id.* at 1545.

⁸⁶ *Id.* at 1546 (noting that fair use acts as a defense only after a work meets the standard for copyright protection).

⁸⁷ *Id.* at 1547.

⁸⁸ 960 F.2d 1465 (9th Cir. 1992).

⁸⁹ *Id.* at 1475.

⁹⁰ *Id.*

⁹¹ *Id.* at 1475-76.

⁹² *Id.* at 1475.

⁹³ *Id.* at 1476.

as promoting competition.⁹⁴ The next section explains the application of the doctrines as a defense to infringement and demonstrates several shortcomings to this approach.

B. The Doctrines Applied as Defenses to Infringement

A second approach applies the doctrines solely to the defense prong of the infringement claim and removes the doctrines' application as bars to copyrightability. This section explains the reasoning of courts that follow this approach. In addition, this section discusses the view of a well-recognized authority on copyright law. Finally, this section introduces important considerations, which are not discussed by Nimmer or the courts.

In *Kregos v. Associated Press*, the Second Circuit considered whether a baseball pitching form was copyrightable.⁹⁵ The court noted

⁹⁴ It is also worth considering the copyright registration process. As previously discussed, the first prong of a copyright infringement claim is ownership of a valid copyright. *Feist Publ'ns v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991). To satisfy this prong, the plaintiff must prove that the work is original, which requires a showing of proper adherence to statutory formalities. *Id.* at 361. The statutory formalities, under 17 U.S.C. § 411, demand that the copyright has been preregistered or registered. 17 U.S.C. § 411(a) (2006) (“[N]o action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title.”). Unlike trademark registration or patent filing where the application process is rigorous and heavily screened by the Patent and Trademark Office, copyright registration is lax and registrations are issued with relatively low scrutiny by the Copyright Office. *Carol Barnhart, Inc. v. Econ. Cover Corp.*, 594 F. Supp. 364, 367 (E.D.N.Y. 1984). Therefore, the existence of a certificate of copyright registration is simply prima facie evidence of the validity of the copyright and the defendant may rebut that presumption. *Bibbero Sys., Inc. v. Colwell Sys., Inc.*, 893 F.2d 1104, 1106 (9th Cir. 1990); *see also* *Brown Bag Software v. Symantec*, 960 F.2d 1465, 1474 (9th Cir. 1992) (noting that the plaintiff's copyright registration created a presumption of validity that the defendant was entitled to rebut).

The merger and *scènes à faire* doctrines state that the expression of an idea may be unoriginal due to the limited means of expressing the underlying idea. No reason supports reserving the application of these doctrines to the substantial similarity side of the analysis when they may be determinative from the outset. Not applying the doctrines at this step would take away a defendant's ability to rebut the presumption of validity. This argument was offered in *Kregos*, in which Judge Sweet, in a dissenting opinion, contended that the proper approach for the merger analysis requires the courts to decide whether the copyrighted work meets the requirement of creativity and whether merger exists before allowing copyright protection. *Kregos v. Associated Press*, 937 F.2d 700, 715 (2d Cir. 1991) (Sweet, J., dissenting). Judge Sweet interpreted the language of § 102 of the Copyright Act to indicate that copyright protection simply cannot be attributed to a work, where the expression is inseparable from the underlying idea: “[i]n no case does copyright protection for an original work of authorship extend to any idea . . . regardless of the form in which it is described, explained, illustrated, or embodied in such work.” *Id.* (quoting 17 U.S.C. § 102(b) (2006)).

⁹⁵ 937 F.2d 700, 701 (2d Cir. 1991). The plaintiff distributed his pitching form to newspapers, which displayed information about the past performances of opposing

that assessing merger in the alleged infringement context rather than the copyrightability context provides “a more detailed and realistic basis” upon which a claim should be evaluated.⁹⁶ The court offered no further guidance than this statement of the circuit’s prior precedent under *Durham Industries, Inc. v. Tomy Corp.*⁹⁷ However, as Judge Sweet noted in his dissent, the majority relied on precedent that did not reach the question of merger at all.⁹⁸ Judge Sweet argued that a proper merger analysis requires the court to decide whether the copyrighted work meets the requirement of creativity and whether merger exists before allowing copyright protection.⁹⁹

Nevertheless, in *Hart v. Dan Chase Taxidermy Supply Co.*, the Second Circuit solidified its position that the merger doctrine serves as a defense to infringement.¹⁰⁰ On appeal, the Second Circuit examined whether the lower court applied the doctrine of merger prematurely as part of the copyrightability inquiry.¹⁰¹ The court determined that the lower court applied the doctrine prematurely on the grounds that descriptions of the defendant’s work were not available; therefore, no basis for evaluating the idea-expression divide existed.¹⁰² In general, the court reasoned that only when *all* contested forms of expression are

pitchers scheduled to start the baseball game each day. *Id.* at 702. The form contained several categories of data arranged in a particular format. *Id.* at 702-03. Some, but not all, of the categories of data had been utilized in other publications in the past. *Id.* The plaintiff successfully registered his pitching form with the Copyright Office. *Id.* at 702. The Associated Press began publishing a nearly identical form a year after the plaintiff’s first distribution. *Id.* The district court concluded, in part, that the limited space available in the newspaper for displaying pitching forms so limited the possible variations of the statistics that the idea of the form had merged with its expression and, thus, the plaintiff’s form did not warrant copyright protection. *Id.* at 703. On appeal, the court reversed and remanded the ruling of the district court. *Id.* at 711.

⁹⁶ *Id.* at 705 (citing *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 916 (2d Cir. 1980)).

⁹⁷ 630 F.2d 905, 916 (2d Cir. 1980). In *Durham*, the court found that the two expressions in question were dissimilar; therefore, merger was not at issue. *Id.* at 918.

⁹⁸ *Kregos*, 937 F.2d at 715. (Sweet, J., dissenting). Judge Sweet argued that a proper merger analysis requires the court to decide whether the copyrighted work meets the requirement of creativity and whether merger exists before allowing copyright protection. *Id.* Again, as most circuits applying the doctrine as a bar to copyrightability did, Judge Sweet interpreted § 102(b) as indicating that copyright protection cannot extend to a work that is inseparable from the underlying idea. *Id.* Judge Sweet also noted that the majority of cases have followed the copyright bar approach. *Id.*

⁹⁹ *Id.* at 715.

¹⁰⁰ 86 F.3d 320, 323 (2d Cir. 1996). In that case, the plaintiff and the defendant were creators of mannequins that serve as mounts for animal skins. *Id.* at 321. The defendant frequently used mannequins created by other manufacturers including those of the plaintiff. *Id.* The plaintiff, therefore, sued the defendant for copyright infringement for selling duplicates of the plaintiff’s model. *Id.*

¹⁰¹ *Id.*

¹⁰² *Id.* at 322.

presented can the court apply merger at the copyrightability stage.¹⁰³ Those cases are all but unlikely.¹⁰⁴ Therefore, the court reasoned that the better approach would be to evaluate the doctrine in the context of particular infringement in consideration of evidence relating to substantial similarity so as to have a “more detailed and realistic basis” for evaluation.¹⁰⁵ Certainly, where descriptions of a defendant’s work are not present, the idea-expression dichotomy is immeasurable. However, so too would be any substantial similarity analysis. Under such a rationale, neither prong of the copyright infringement test could be evaluated.

In *Reed-Union Corp. v. Turtle Wax, Inc.*, the Seventh Circuit stressed the importance of maintaining the difference between copyright invalidity and *scènes à faire*.¹⁰⁶ Comparing Shakespeare’s *Romeo and Juliet* against Bernstein’s *West Side Story* and Bellini’s *I Capuletti e i Montecchi*, the court explained that the core scenes of *Romeo and Juliet*, being in the public domain, could be incorporated into Bernstein’s own work; however, this act did not equate to placing *West Side Story* in the public domain.¹⁰⁷ Bernstein could, in fact, obtain a copyright for his own contributions to the work, which would disallow another from copying his work but not from using similar scenes.¹⁰⁸ Although it appears that this case completely separates *scènes à faire* from the issue of copyrightability, the court recognizes that, where a work is entirely composed of *scènes à faire*, albeit a rare instance, the work would not warrant copyright protection.¹⁰⁹ Therefore, *scènes à faire* can be determinative of copyrightability.

¹⁰³ *Id.*

¹⁰⁴ *Id.*

¹⁰⁵ *Id.* (quoting *Kregos v. Associated Press*, 937 F.2d 700, 705 (2d Cir. 1991)).

¹⁰⁶ 77 F.3d 909, 914 (7th Cir. 1996). In this case, the plaintiff manufactured the number-one selling car wax, NU FINISH, on the market until the defendant introduced a competing product, FINISH 2001, which ultimately surpassed plaintiff’s market share. *Id.* at 911. The plaintiff sued the defendant for copyright infringement claiming that the defendant’s “Revolutionary” and “Mission” commercials touting its product were knockoffs of a similar commercial by a third-party distributing company and that the main elements of the commercial—“laboratory test results, the revival of a weather-beaten car, the imperviousness of the polish to many car washes”—were *scènes à faire*, which did not fall under the scope of copyright protection. *Id.* The district court granted summary judgment in favor of the defendant on all claims. *Id.* The district court gave two reasons for allowing the defendant to use its two commercials: first, it simply used hackneyed ideas—“polishing up old cars, washing the polished cars, claiming the support of lab tests”—and that copyright law does not allow a claim of ownership on rudimentary ideas or common situations under the *scènes à faire* doctrine and, second, plaintiff’s own “Junkyard” commercial was not copyrightable. *Id.* at 913-14.

¹⁰⁷ *Id.* at 914.

¹⁰⁸ *Id.*

¹⁰⁹ *Id.*

Circuits maintaining that the doctrines have no place in determining copyrightability overlook the fact that the application of the doctrines on the infringement prong nonetheless considers the copyrightability of a work. In *Lexmark*, the majority criticized the district court by stating:

[i]n refusing to consider whether “external factors such as compatibility requirements, industry standards, and efficiency” circumscribed the number of forms that [the computer program at issue] could take, the district court believed that the idea-expression divide and accompanying principles of merger and [*scènes à faire*] play a role only in the “substantial similarity” analysis and do not apply when the first prong of the infringement test (copyrightability) is primarily at issue.¹¹⁰

The majority in *Lexmark* determined that “[b]oth prongs of the infringement test . . . consider ‘copyrightability,’ which, at its heart, turns on the principle that copyright protection extends to expression, not to ideas.”¹¹¹ On the substantial similarity prong, the doctrines do not measure similarity, but rather serve to distinguish the protectable elements of a work from the unprotectable elements.¹¹²

Professor Nimmer, a well-renowned authority on copyright law,¹¹³ recognizes the split regarding the doctrines.¹¹⁴ Nimmer states that “[i]t is not always clear whether the merger doctrine is deemed a bar to copyright protection itself, rather than simply as a defense to infringement via substantial similarity.”¹¹⁵ With regard to merger, Nimmer takes the stance that the better approach is to evaluate the idea-expression dichotomy in terms of a particular dispute rather than baring

¹¹⁰ *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522, 537-38 (6th Cir. 2004).

¹¹¹ *Id.* at 538.

¹¹² *Id.*

¹¹³ Professor Nimmer has authored multiple books and treatises spanning more than three decades and is widely considered by many to be a leading authority on copyright law. *E.g.*, 4 NIMMER & NIMMER, *supra* note 1. This fact is supported by the copious federal court opinions citing to his treatises as well as common recognition by practitioners. *See e.g.*, *Wrench LLC v. Taco Bell Corp.*, 256 F.3d 446, 457 (6th Cir. 2001); *see also* Ann Bartow, *The Hegemony of the Copyright Treatise*, 73 U. CIN. L. REV. 581, 589-92 (2004).

¹¹⁴ 4 NIMMER & NIMMER, *supra* note 1. Nimmer discusses the split within the section titled “Negating Substantial Similarity,” which notes the doctrines supporting a defendant’s challenge to a substantial similarity claim. *Id.* § 13.03[B] (“Having set forth above the tests for determining substantial similarity, the question remains how the defendant may challenge such a legal conclusion. Most obviously, the defendant may deny that such similarity exists. Alternatively, the defendant may concede that some matters are similar, but maintain that they concern unprotected elements, or are otherwise nonactionable.”).

¹¹⁵ *Id.* § 13.03[B][3].

certain expressions from copyright protection per se.¹¹⁶ Nimmer proposed that, under this paradigm, similarity of expression resulting from the fact that a common idea is capable only of expression in a stereotyped form will make findings of actionable similarity impossible.¹¹⁷ Nimmer clarified that this stance does not suggest “that, because original copyrighted features are, or may be described as, standard or commonplace, they may be freely copied.”¹¹⁸ Rather, Nimmer concluded that “permissible copying is limited to ‘that similarity which necessarily results from the replication of an idea.’”¹¹⁹

As the majority in *Lexmark* points out, Nimmer does not wholeheartedly disagree with utilizing merger as determinative of copyright.¹²⁰ The opinion states that

[a]s a matter of practice, Nimmer is correct that courts most commonly discuss the idea-expression dichotomy in considering whether an original work and a partial copy of that work are “substantially similar” (as part of prong two of the infringement test), since the copyrightability of a work as a whole (prong one) is less frequently contested.¹²¹

In fact, in his treatise, Nimmer states only that the *better view* is the treatment of the doctrine as a defense.¹²²

Nimmer has also been challenged by the courts. Judge Sweet, in his dissenting opinion in *Kregos v. Associated Press*, interpreted Nimmer as requiring a court to hold that, where merger exists, the two disputed works are not substantially similar even when they are identical.¹²³ Judge Sweet called this requirement “a not useful variety of doublespeak.”¹²⁴ Looking to other circuit and district court decisions, the dissent noted

¹¹⁶ *Id.* (“It is not always clear whether the merger doctrine is deemed a bar to copyright protection itself, rather than simply a defense to the charge of infringement via substantial similarity. . . . [T]he better view construes it as the latter, evaluating the inseparability of idea and expression in the context of a particular dispute, rather than attempting to disqualify certain expressions from protection per se.”).

¹¹⁷ *Id.*

¹¹⁸ *Id.* (quoting *Mattel, Inc. v. Goldberger Doll Mfg. Co.*, 365 F.3d 133, 136 n.3 (2d Cir. 2004)).

¹¹⁹ *Id.*

¹²⁰ *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522, 538 (6th Cir. 2004).

¹²¹ *Id.* at 538. It is noteworthy that Nimmer’s discussion of the doctrines and the circuit split falls within the section titled “Negating Substantial Similarity,” which discusses the resources available to a defendant in which they may challenge a substantial similarity claim. 4 NIMMER & NIMMER, *supra* note 1, § 13.03[B].

¹²² *Id.* § 13.03[B][3][b].

¹²³ *Kregos v. Associated Press*, 937 F.2d 700, 715 (2d Cir. 1991) (Sweet, J., dissenting).

¹²⁴ *Id.*

that, at the time, a majority of cases followed the method where merger becomes an issue when the copyrighted work and the alleged infringing work appear to be similar on the surface.¹²⁵ The dissent argued that the Nimmer approach leads to the “erroneous conclusion” that the doctrine is available only where the alleged infringer has independently created a work, which coincidentally happens to be similar to the work of the plaintiff. Judge Sweet reasoned that this approach would imply that merger is only utilized as a tool to explain the unintentional similarity.¹²⁶ Therefore, the dissent continued, a defendant who has actually copied a work is not allowed to rely on the merger doctrine to avoid liability.¹²⁷ The dissent concluded that this approach finds support not from the strictures of § 102(b), but from the fundamental principles of copyright law; an independent creation is never deemed infringement.¹²⁸

In the previously mentioned cases, the courts show indifference to transaction and litigation costs. Considering the small players that are involved in many copyright infringement actions, lack of concern for this aspect demonstrates an unfairness to defendants who should not be subjected to long legal battles. This point was suggested in *Hart*, when the court stated that “in essence, the merger inquiry asks whether all [works], no matter how artistic they might be, will necessarily be ‘substantially similar.’ And only if this is so, is there no unique

¹²⁵ *Id.* at 715-16 (citing *Kern River Gas Transmission Co. v. Coastal Corp.*, 899 F.2d 1458, 1463 (5th Cir. 1990); *Toro Co. v. R & R Products Co.*, 787 F.2d 1208, 1212 (8th Cir.1986); *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971); *Matthew Bender & Co. v. Kluwer Law Book Publishers, Inc.*, 672 F. Supp. 107, 109 (S.D.N.Y. 1987) (noting that work which does not “exceed[] the boundaries of ‘idea’ and enter[] the realm of ‘expression’” is not protectible); *Freedman v. Grolier Enters., Inc.*, 179 U.S.P.Q. 476, 478 (S.D.N.Y. 1973) (“When an idea is so restrictive that it necessarily requires a particular form of expression, that is, when the idea and its expression are functionally inseparable, to permit the copyrighting of the expression would be to grant the copyright owner a monopoly of the idea.”).

¹²⁶ *Id.* at 716.

¹²⁷ *Id.*

¹²⁸ *Id.* The dissent argued that, under the approach that utilizes merger as determinative of copyrightability, an alleged infringer who has directly copied a work is absolved if the idea of the plaintiff’s work has merged into the expression. *Id.* (citing *Herbert Rosenthal Jewelry*, 446 F.2d at 742) (“When the ‘idea’ and its ‘expression’ are thus inseparable, copying the ‘expression’ will not be barred, since protecting the ‘expression’ in such circumstances would confer a monopoly of the ‘idea.’”) (emphasis added) (citations omitted)). Judge Sweet reasoned that this approach more fully accords with the language and purpose of § 102(b); it focuses consideration on the definition of the idea of the work at the outset of an infringement inquiry. *Id.* Although the dissent agreed that assessing merger in the context of the alleged infringement would lead to a more realistic and detailed basis for evaluating a merger claim, Judge Sweet supported the application of the merger doctrine to the issue of copyrightability rather than the alleged infringement. *Id.*

expression to protect under the copyright laws.”¹²⁹ This suggestion implies, not only that merger should be applied as determinative of copyrightability, but also that the case could be disposed of on motion to dismiss grounds. This would be the most equitable approach for the court to take because it would allow the courts, when possible, to dismiss the case early on, fostering judicial economy and saving litigation costs. As will be discussed in Part IV.B, the threat of litigation alone has been abused by copyright owners, which has dampened the constitutional goal of the creative progress. Thus, courts should consider the doctrines from the outset.

Application of the doctrines as defenses to copyrightability do not consider the provisions set out in § 102(b). In addition, litigation and transaction costs are not considered under this approach. It is also important to note that the cases analyzed in this section are quite different from DMCA liability cases. As will be discussed in the next section, the DMCA creates a possibility of liability for the circumvention of a technological protection measure *regardless* of whether the actual use of the copyrighted work infringes and despite claims of fair use or other exceptions generally recognized under copyright law.¹³⁰ Considering the harsh liability of the DMCA, courts should be more reluctant to find copyrightability. To fully understand this critical issue, a brief outline of the DMCA and its impact on copyright law is necessary.

IV. ANALYZING THE SPLIT IN RESPONSE TO THE DMCA AND THE RISE IN FALSE POSITIVES

This section provides a history of the events leading to the enactment of the groundbreaking Digital Millennium Copyright Act (“DMCA”), which has caused significant controversy in the legal community due to the dramatic expansion of rights it has bestowed upon copyright owners, particularly, “the right to control access to copyrighted works.”¹³¹ The DMCA creates this right for owners, who utilize technology as a means of safeguarding their copyrighted works, by specifically proscribing the circumvention or the attempt of

¹²⁹ Hart v. Dan Chase Taxidermy Supply Co., 86 F.3d 320, 322 (2d Cir. 1996).

¹³⁰ LEE A. HOLLAAR, LEGAL PROTECTION OF DIGITAL INFORMATION 135, 209 (BNA Books 2002); see Chamberlain Group v. Skylink Techs., Inc., 381 F.3d 1178, 1195 (Fed. Cir. 2004) (“Defendants who use such devices may be subject to liability under § 1201(a)(1) whether they infringe or not.”). The DMCA explicitly carves out the exclusive list of safe harbor provisions that may be asserted as a defense to DMCA liability. 17 U.S.C. § 1201 (d)–(j) (2006).

¹³¹ Jane C. Ginsburg, *From Having Copies to Experiencing Works: The Development of an Access Right in U.S. Copyright Law*, 50 J. COPYRIGHT SOC’Y U.S.A. 113, 118 (2003).

circumvention of measures that are set in place to protect digital works.¹³² This section demonstrates that the central defense to DMCA liability is the absence of a copyrightable work. This section uses these considerations as the foundation for promoting application of the doctrines as bars to copyrightability to narrow the DMCA's reach in light of the harsh proscriptions of the statute.

A. The Digital Millennium Copyright Act

1. Brief Historical Background of Copyright and the Birth of the "Paracopyright"

In today's world, the rights afforded to a copyright owner have been dramatically expanded and have become more complex. United States copyright law originally stemmed from the proposition that the free copying of an author's "intangible products of the mind" would produce negative consequences.¹³³ The Constitution expressly gives Congress the power to protect original works of authorship "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."¹³⁴ However, the tone of copyright law has evolved through the centuries to, at first, provide greater protection to the author and for longer periods of time; later, to codify strict limitations on copyright protection such as fair use; and today, with the enactment of the DMCA, to create highly controversial "paracopyright" protections.

In 1790, Congress enacted the first federal copyright act, which attempted to clarify and expand upon those open issues by granting ownership protection for two fourteen-year terms for the exploitation of "maps, charts and books."¹³⁵ In 1909, Congress completely revisited and revamped federal copyright laws.¹³⁶ The Copyright Act of 1909 expanded the subject matter of copyrightable works to all of the author's

¹³² Digital Millennium Copyright Act, 17 U.S.C. § 1201 (2006); *see* United States v. Elcom Ltd., 203 F. Supp. 2d 1111, 1140 (N.D. Cal. 2002) ("Due to the ease with which digital works can be copied and distributed worldwide virtually instantaneously, copyright owners will hesitate to make their works readily available on the Internet without reasonable assurance that they will be protected against massive piracy.").

¹³³ Abrahamson, *supra* note 9.

¹³⁴ U.S. CONST. art. I, § 8, cl. 8.

¹³⁵ Act of May 31, 1790, ch. 15, § 1, 1 Stat. 124, *repealed by* Act of Mar. 4, 1909, ch. 320, § 23, 35 Stat. 2075, 1080-81; *Eldred v. Ashcroft*, 537 U.S. 186, 194 (2003); *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 56-57 (1884); *see* JOYCE, *supra* note 14, at 20.

¹³⁶ JOYCE, *supra* note 14, at 21 (noting that President Theodore Roosevelt called for "a complete revision of the copyright law to meet modern conditions" a full four years before the 1909 Act was finalized).

writings and allowed this ownership protection to last for two 28-year terms with the first term commencing at the time of publication.¹³⁷ Several legislative amendments were made to the 1909 Act to keep pace with evolving technologies.¹³⁸

Eventually, Congress enacted the Copyright Act of 1976 (“1976 Act” or “Copyright Act”), which dramatically altered the legal understanding of what subject matter qualifies for copyright protection and when it qualifies for copyright protection. The 1976 Act significantly expands the rights of copyright owners. The 1976 Act also widens the umbrella of copyrightable works to cover literary works; musical works; dramatic works; pantomimes and choreographic works; graphic, pictorial, and sculptural works; motion pictures and audiovisual works; architectural works; and sound recordings.¹³⁹ Equally important, the author no longer has to wait for the publication of his work to enjoy copyright protection; the 1976 Act allows for protection the moment a product of the mind becomes fixed in a tangible form.¹⁴⁰ The length of ownership protection was also greatly expanded to endure the length of the author’s life term plus fifty years.¹⁴¹ Of premier importance, the exclusive rights for the owner of the copyright are explicitly carved out. These rights include the right to reproduce and adapt the work, the right to perform the work, the right to publicly display the work, and the right to distribute the work.¹⁴²

Prior to the digital age, the right to distribute was relatively unthreatened as copyright infringement from an economic harm standpoint was largely dependent on the cost of carrying out a particular infringement.¹⁴³ In that era, a large number of infringing copies and an expansive distribution network was required to have a substantial effect

¹³⁷ Act of Mar. 4, 1909, ch. 320, §§ 23-24, 35 Stat. 1075, 1080-81, *repealed by* Act of October 19, 1976, ch. 3, § 302(a), 90 Stat. 2541, 2572-73; *Eldred*, 537 U.S. at 194; *see* JOYCE, *supra* note 14, at 21.

¹³⁸ *See* Act of Oct. 15, 1971, Pub. L. No. 92-140 § 1(b), 85 Stat. 391, 391 (adding sound recordings as copyrightable subject matter); Act of July 31, 1939, ch. 396, § 2, 53 Stat. 1142, 1142 (adding commercial labels and prints as copyrightable subject matter); Act of Aug. 24, 1912, ch. 356, 37 Stat. 488, 488 (adding motion pictures as copyrightable subject matter).

¹³⁹ 17 U.S.C. § 102(a) (2006). This section of the Act still remains unchanged.

¹⁴⁰ *Id.* It is important to note that a copyright infringement suit cannot be instituted unless the copyright has been preregistered or registered. 17 U.S.C. § 411(a) (2006).

¹⁴¹ Act of October 19, 1976, ch. 3, § 302(a), 90 Stat. 2541, 2572-73 (current version at 17 U.S.C. § 302(a) (2006)). The term of copyright has since been extended to the life of the author plus seventy years. Sony Bono Copyright Extension Act, Pub. L. No. 94-553, § 102(b), 112 Stat. 2827, 2827 (1998).

¹⁴² 17 U.S.C. § 106 (2006).

¹⁴³ HOLLAR, *supra* note 130, at 135.

on the market.¹⁴⁴ Therefore, the exclusive right to distribute the work was relatively unchallenged. In the digital era, however, unlimited copies can be made, with little to no variation in quality from the original, and distributed all over the world at the touch of a button; the copyright holder may suffer millions of dollars in damages while the cost to the infringer literally disappears.¹⁴⁵ Whereas before, “[a] few hand-made copies of a book would have little effect on the worldwide sale of a printed book,”¹⁴⁶ today “an individual consumer may become a worldwide distributor of copyrighted material after obtaining a single, promotional copy in digital format.”¹⁴⁷

In the early 1980s, with copyright law inadequately protecting the behemoth entertainment industries from the realities of the digital age, technological measures were adopted, such as the invention of Macrovision by the motion picture industry, to thwart unauthorized copying of videocassettes containing copyright protected motion pictures.¹⁴⁸ Satellite television joined the fray by encrypting its broadcasts to prevent unauthorized reception by viewers, who had not subscribed for its service.¹⁴⁹ Congress responded to and aided the satellite television industry by enacting the Satellite Home Viewer Act.¹⁵⁰ The computer software industry also came on board with its own copyright protection measures, which were fiercely opposed by the public.¹⁵¹ Eventually, Congress enacted the Audio Home Recording Act of 1992 in response to the digital audio tape (“DAT”) recording format, a technological feat at the time, which allowed unauthorized persons to make “perfect” copies of recorded music.¹⁵²

Despite the efforts of Congress and the industries’ technological protections, copyright owners continued to fear that these measures were insufficient without a legal impediment designed to punish devices or services that circumvented the technological protections.¹⁵³ This inescapable fact led the entertainment and computer industries to Congress’s doorstep again seeking modern-era protection of their

¹⁴⁴ *Id.*

¹⁴⁵ *Id.* (citing *United States v. LaMacchia*, 871 F. Supp. 535, 536 (D. Mass. 1994)).

¹⁴⁶ *Id.*

¹⁴⁷ *A & M Records, Inc. v. Napster*, 114 F. Supp. 2d 896, 909 n.12 (N.D. Cal. 2000).

¹⁴⁸ COHEN, *supra* note 10, at 575.

¹⁴⁹ *Id.*

¹⁵⁰ Pub. L. No. 100-667, 102 Stat. 3949 (1988) (codified as amended at 17 U.S.C. § 119 (2006)).

¹⁵¹ COHEN, *supra* note 10, at 576.

¹⁵² Pub. L. No. 102-563, 106 Stat. 4237 (1992) (codified as amended at 17 U.S.C. §§ 1001-1010 (2006)); COHEN, *supra* note 10, at 576.

¹⁵³ Ginsburg, *supra* note 131, at 113 (noting several anti-circumvention claims that suggest that these concerns are warranted).

intellectual property interests. As a response to industry outcry and, in an attempt to gauge the effects the Internet would have on copyright infringement, a task force appointed by the Clinton Administration in 1995 issued a “White Paper” analyzing whether existing intellectual property laws were sufficiently adapted to the new digital age.¹⁵⁴ The White Paper issued proposals that would affect, among other things, dealings with the circumvention of technological protection on digital devices.¹⁵⁵ Despite their valiant effort, the proposals set forth in the White Paper were ultimately rejected due to stiff resistance by Internet service providers as well as other outstanding problems that were left unaddressed.¹⁵⁶ Meanwhile, the implementation of further methods of innovative electronic copyright protection continued.¹⁵⁷ However, as the encryption methods increased, the availability of methods with which to bypass that protection also increased.¹⁵⁸ The continued inadequacy of copyright law spurred Congress to act yet again. Their response was the Digital Millennium Copyright Act (“DMCA”).

The DMCA grants additional legal protection to copyright owners who utilize technology as a means to safeguard their works.¹⁵⁹ The primary purpose of the statute reflects content owner demands by specifically proscribing the circumvention of measures that were set in place to protect digital works.¹⁶⁰ The statute targets both devices that are primarily designed to circumvent these protection measures and devices that have only a limited commercially significant purpose other than the circumvention of these protection measures.¹⁶¹ So determined was Congress in its protection goals that only in the midst of bitter controversy between the industries and the public did they carve out a few, discreet exceptions to the general rule of blanket anti-circumvention

¹⁵⁴ HOLLARR, *supra* note 130, at 202.

¹⁵⁵ *Id.*

¹⁵⁶ *Id.* at 154.

¹⁵⁷ Jeffrey A. Bloom et al., *Copy Protection for DVD Video*, 87 PROC. IEEE 1267, 1268 (1999) (noting the creation in 1996 of the Content Scrambling System (“CSS”), the Analog Protection System (“APS”) and the Copy Generation Management System (“CGMS”) by the Copy Protection Technical Working Group).

¹⁵⁸ See, e.g., *Universal City Studios, Inc. v. Reimerdes*, 111 F. Supp. 2d 294 (S.D.N.Y. 2000) (finding that the defendant had successfully created a decryption code (DeCSS) that bypassed CSS technology).

¹⁵⁹ COHEN, *supra* note 10, at 578.

¹⁶⁰ Digital Millennium Copyright Act, 17 U.S.C. § 1201 (2006); see *United States v. Elcom Ltd.*, 203 F. Supp. 2d 1111, 1140 (N.D. Cal. 2002) (“Due to the ease with which digital works can be copied and distributed worldwide virtually instantaneously, copyright owners will hesitate to make their works readily available on the Internet without reasonable assurance that they will be protected against massive piracy.” (quoting S. REP. NO. 105-190, at 8 (1998))).

¹⁶¹ 17 U.S.C. § 1201(a)(2)(A)-(b)(1)(B).

legislation: reverse engineering to achieve interoperability of software; the development of circumvention tools and circumvention for good faith encryption research; circumvention of access controls in the Internet context to enable filtering; circumvention of access controls to prevent the collection of personal on-line activity information; and the development of circumvention tools and circumvention for testing the security of computer systems.¹⁶²

These anti-circumvention proscriptions have created a new right under copyright law: “the right to control access to copyrighted works,”¹⁶³ or “paracopyright.”¹⁶⁴ This statute tipped the copyright power balance heavily in favor of the copyright owner and met with little enthusiasm in the legal world. Some legal theorists argued that the law should suppress technology by disallowing the creation and proliferation of anti-circumvention devices.¹⁶⁵ Others objected to the increase in power bestowed upon the copyright owners by the grant of this access right and the shift in the balance between the copyright owner and rights of the user that ensued.¹⁶⁶

The proscriptions of the DMCA are severe and they have drawn much criticism, particularly due to the gross misuse of copyright protection that the statute allows. Not only is the circumvention of technology protection measures considered illegal under the DMCA, but trafficking in circumventing technology is also proscribed, even to the extent that the public release of information regarding ways to

¹⁶² *Id.* § 1201(d)-(g).

¹⁶³ Ginsburg, *supra* note 131, at 118.

¹⁶⁴ The court in *United States v. Elcom* stated that as reflected in the legislative history of the DMCA, Congress recognized that while the purpose of the DMCA was to protect intellectual property rights, the means of doing so involved a dramatic shift from the regulation of the use of information to the regulation of the devices by which information is delivered. For this reason, the legislators viewed the legislation as “paracopyright” legislation that could be enacted under the Commerce Clause. Such a step by Congress to protect the market for digital content as an action under the Commerce Clause cannot be said to override Constitutional restraints of the Intellectual Property Clause, because Congress’ fundamental motivation was to protect rights granted under the Intellectual Property Clause in the digital world. Congress recognized that traditional intellectual property laws regulating the use of information border on unenforceable in the digital world; only regulation of the devices by which information is delivered will successfully save constitutionally guaranteed intellectual property rights.

203 F. Supp. 2d at 1140 (citations omitted).

¹⁶⁵ Ginsburg, *supra* note 131, at 118.

¹⁶⁶ *Id.* at 118-19.

circumvent protection mechanisms is considered trafficking.¹⁶⁷ The severity of the legislation also becomes apparent when one considers that attempting to circumvent a protected device, whether successful or not, triggers DMCA liability. Although it would be hard to dispute that access controls are not important in the digital age, there is much cause for concern in terms of the protection the DMCA affords the copyright owner. The provisions of § 1201(a), which protect technological access control of “a work protected under this title,” do not state “how much of the work” must be protected.¹⁶⁸ Accordingly, it is possible that the circumvention of a completely public work that is cloaked in a technological protection measure may trigger DMCA liability so long as the public work is infused with some copyrightable elements.¹⁶⁹ As Jane Ginsburg eloquently stated, as a practical consequence “[a] copyrightable figleaf that a producer affixes to an otherwise unprotectable work could, as a practical matter, obscure the public domain nakedness of the compiled information, and thereby insulate the [work] from the further access that is a prerequisite to otherwise lawful copying.”¹⁷⁰

Furthermore, protection under the DMCA potentially extends the life of a copyright far beyond the normal statutory period. For instance, consider the case of a movie in DVD format, which has been embedded with digital copy protection.¹⁷¹ The access protection will exist for the total life of the disc: potentially forever.¹⁷² Because the DMCA prohibits circumventing the copy protection to access the underlying work, it is possible that the work may be kept from the public domain indefinitely, thus, “making . . . entry into the public domain merely theoretical.”¹⁷³ Additionally, technological measures can never account for the intricacies of the law and, even if they could, no level of sophistication could enable them to adapt to the ever-changing law. As a consequence, the DMCA legalizes copyright misuse by creating unlimited term protection to works that are both protectable *and not* legitimately protectable under copyright.¹⁷⁴

¹⁶⁷ See, e.g., *Universal City Studios v. Reimerdes*, 111 F. Supp. 2d 294 (S.D.N.Y. 2000).

¹⁶⁸ 17 U.S.C. § 1201.

¹⁶⁹ Ginsburg, *supra* note 131, at 126.

¹⁷⁰ *Id.* at 127.

¹⁷¹ James Gibson, *The Once and Future Copyright*, 81 NOTRE DAME L. REV. 167, 233 (2005).

¹⁷² *Id.*

¹⁷³ *Id.*

¹⁷⁴ Carla Meninsky, Comment, *Locked Out: The New Hazards of Reverse Engineering*, 21 J. MARSHALL J. COMPUTER & INFO. L. 591, 627 (2003).

However, DMCA liability is not without its limitations. Modern interpretation of the statute dictates that the underlying work must contain some copyrightable subject matter. In *Chamberlain Group, Inc. v. Skylink Technologies, Inc.*,¹⁷⁵ Chamberlain, a manufacturer of a garage door opener (“GDO”) sued Skylink, a universal remote control manufacturer, in part, for violation of the DMCA.¹⁷⁶ A central issue in this case was whether the access to the applications was authorized, which would exonerate the defendant of DMCA liability. More pertinent to this comment, however, was the Federal Circuit’s interpretation of the DMCA in terms of its scope of liability. The court made several important points limiting the reach of the DMCA in anticircumvention suits. The court pronounced that some reasonable relationship must exist between the act of circumventing a technological access control and the copyrighted work.¹⁷⁷ The court also noted that holding otherwise would allow a defendant to effectively create aftermarket monopolies.¹⁷⁸ Furthermore, the court felt that § 1201(c)(1), which states that “nothing in this section shall affect rights, remedies, limitations, or defenses to copyright infringement, including fair use, under this title,” would flatly contradict itself by proscribing unauthorized access without regard to other provisions of the Copyright Act.¹⁷⁹ In consideration of these issues, the court held that the only meaningful interpretation of the DMCA was to require a nexus between the access and the protections otherwise

¹⁷⁵ 381 F.3d 1178 (Fed. Cir. 2004). Chamberlain’s GDO system utilized a copyrighted computer program called “rolling code” that acted as a security measure by changing the signal that the transmitter needs to send to the garage door. *Id.* at 1183. Chamberlain’s GDO incorporated a rolling code mechanism that created a window of bit strings. *Id.* at 1184. When a signal is sent from a transmitter that falls within the window it would allow the opener to activate the motor and open the garage door. *Id.* If the data sent from the transmitter fell outside of this window, the GDO would ignore it and the garage door will stay shut. *Id.* However, should the user send two signals within quick succession of one another and the two bit strings sent differ by three, the GDO would enter into a resynchronization module that would reset the window and allow the transmitter to operate the garage door. *Id.*

Skylink’s program did not incorporate the rolling program yet nonetheless was capable of controlling the GDO. *Id.* at 1185. Skylink’s transmitter simulated the rolling code and resynchronization methods by sending signals in rapid succession, two of which differ by three. *Id.* This caused the GDO to either immediately accept the incoming signal or to enter into the resynchronization mode and allow the transmitter to operate the garage door. *Id.* Chamberlain claimed that Skylink was liable under the DMCA on the grounds that the GDO contained copyright protected computer programs and that the rolling code acted as a technology measure that operated to control access to the programs. *Id.*

¹⁷⁶ *Id.* at 1182.

¹⁷⁷ *Id.* at 1200.

¹⁷⁸ *Id.* at 1201.

¹⁷⁹ *Id.* at 1200 (quoting 17 U.S.C. § 1201(c)(1) (2006)).

afforded to copyright owners under the Copyright Act.¹⁸⁰ Any other interpretation would grant “copyright owners carte blanche authority to preclude all use.”¹⁸¹ The court rested its decision on the fact that Chamberlain did not demonstrate a protected property right upon which Skylink infringed. Accordingly, should no copyright exist in the accessed work, no DMCA liability could ensue.

2. Utilizing the Copyrightability Approach as a Response to the DMCA

Under the DMCA, the work itself must be copyrightable in order to trigger DMCA liability. The single, unwavering escape from DMCA liability outside of the statutory safe harbor provisions is a finding that the underlying work does not warrant copyright protection. Thus, in consideration of the harsh effects of this controversial legislation, courts should apply the merger and *scènes à faire* doctrines as bars to copyrightability as opposed to defenses to infringement in DMCA cases. Under any other approach, the court would be forced to presume that DMCA liability has been triggered and undergo a liability analysis under that statute. This notion was considered in *Lexmark International, Inc. v. Static Control Components, Inc.*:¹⁸² the single case to date that involved DMCA concurrently with merger/*scènes à faire* issues.

In that case, Lexmark, a printer manufacturer, sued Static Control Components (“SCC”), a printer remanufacturer, for copyright infringement in an effort to enjoin SCC from selling microchips that allowed competing printer cartridges to operate with Lexmark’s printers.¹⁸³ Two programs at issue were the Toner Loading Program (“TLP”) and the Printer Engine Program (“PEP”); Lexmark owned copyrights for both the TLP and PEP programs and both programs could be read directly from the device on which they were stored.¹⁸⁴ The TLP was responsible for measuring amounts of toner remaining in the cartridges.¹⁸⁵ It was a very small program, less than 55 bytes depending on the printer model, consisting of only eight program commands which converted torque readings (using mathematical functions) to printer levels.¹⁸⁶ The PEP controlled the functions of each printer, such as paper feeding and movement, and was larger than the TLP yet still relatively

¹⁸⁰ *Id.* at 1202.

¹⁸¹ *Id.* at 1203.

¹⁸² 387 F.3d 522 (6th Cir. 2004).

¹⁸³ *Id.* at 528.

¹⁸⁴ *Id.*

¹⁸⁵ *Id.* at 529.

¹⁸⁶ *Id.* at 530.

small.¹⁸⁷ Lexmark sold the cartridges on a prebate and non-prebate basis.¹⁸⁸ The prebate cartridges were sold at an up-front discount under the agreement that the cartridge would be used only once and then would be returned to Lexmark.¹⁸⁹ To ensure adherence to this agreement, a publicly available encryption algorithm was employed to calculate a Message Authentication Code (“MAC”) which operated as a handshake between the printer and the printer cartridge.¹⁹⁰ The program compared the code calculated by the microchip against the code calculated by the printer; it terminated operation if the match was unsuccessful (only cartridges authorized by Lexmark would produce a match).¹⁹¹ After the authentication sequence was completed a second calculation was performed in which the PEP downloaded a copy of the TLP.¹⁹² A commonly used check-sum authentication sequence calculated the bytes of information in the code and compared it to a preset number which, if the numbers did not match, the Lexmark printer assumed the TLP was corrupted and would cease to operate.¹⁹³

SCC manufactured its “SMARTEK” microchips, which could break the Lexmark’s authentication sequence code.¹⁹⁴ The chip could be installed on any competing printer cartridge in order to trick a Lexmark printer into thinking it was communicating with an authorized Lexmark printer cartridge.¹⁹⁵ The chip contained an exact copy of the Lexmark TLP program.¹⁹⁶ Lexmark brought suit against SCC for copyright infringement of the TLP as well as for circumvention of the TLP and PEP in violation of the DMCA.¹⁹⁷ On the DMCA count, Lexmark contended that the SMARTEX chip circumvented the authentication sequence, which Lexmark claimed was a technological access control measure that protected the TLP.¹⁹⁸

The district court granted a preliminary injunction in favor of Lexmark.¹⁹⁹ The Sixth Circuit vacated the preliminary injunction and rejected the DMCA claims.²⁰⁰ According to the court, the two programs

¹⁸⁷ *Id.*

¹⁸⁸ *Id.*

¹⁸⁹ *Id.*

¹⁹⁰ *Id.*

¹⁹¹ *Id.*

¹⁹² *Id.* at 531.

¹⁹³ *Id.*

¹⁹⁴ *Id.* at 530.

¹⁹⁵ *Id.*

¹⁹⁶ *Id.* at 530-31.

¹⁹⁷ *Id.* at 531.

¹⁹⁸ *Id.* at 529.

¹⁹⁹ *Id.* at 532.

²⁰⁰ *Id.* at 551.

were not protected by any control mechanism, since they were readily available in the printer memory.²⁰¹ As such, the purchase of the printer automatically authorized access to the two programs and no DMCA violation could ensue.²⁰²

Although the majority opinion did not mention the circuit split, Judge Feikens, in his dissenting opinion, raised the issue concerning whether the merger and *scènes à faire* doctrines act as an outright bar to copyrightability or if they only act as a defense to certain types of infringement.²⁰³ Taking each in turn, the dissent introduced his concern as to the relevancy of either approach.²⁰⁴ First, Judge Feikens stated that, if the doctrine was applied at the copyright stage and the court found that merger occurred, the plaintiff would lose his opportunity to assert any claim for relief under the DMCA, which applies only to works that are protected under copyright law.²⁰⁵ On the other hand, the dissent noted that, if the doctrine was applied at the infringement stage, the court must consider a DMCA analysis despite having found that merger occurred.²⁰⁶ Accordingly, the dissent felt that it was essential to determine which approach to take before entering the DMCA analysis.²⁰⁷

As a general rule, in cases involving merger with a method of operation, Judge Feikens suggested that the doctrine apply at the infringement stage of the analysis and “ha[ve] no bearing on the question of copyrightability” of the work.²⁰⁸ Judge Feikens explained that the Copyright Act precludes copyright protection of methods of operation.²⁰⁹ However, the dissent noted that a text that is otherwise copyrightable “can be used as a method of operation of a computer” using the example of a poem used as a password or, in this case, a computer program used as a lock-out code.²¹⁰ Judge Feikens reasoned that it was important to know how the alleged infringer used the material in order to determine whether merger occurred.²¹¹

²⁰¹ *Id.* at 548-50.

²⁰² *Id.* at 550.

²⁰³ *Id.* at 556-57. (Feikens, J., concurring in part and dissenting in part).

²⁰⁴ *Id.* at 557.

²⁰⁵ *Id.*

²⁰⁶ *Id.*

²⁰⁷ *Id.*

²⁰⁸ *Id.* (noting that Nimmer finds this framework to be superior).

²⁰⁹ *Id.*

²¹⁰ *Id.*

²¹¹ *Id.* To clarify, Judge Feikens stated that the copyright protection of a work, which is used solely as a password, would prevent the public from utilizing a method of operation. *Id.* at 557-58. Accordingly, a person, who copied the work to use solely as a password, would not have committed copyright infringement, because he could utilize the merger defense: the work merged with the password or method of operation. *Id.* at 558. A person who copied the poem solely for expressive purposes would not have the

Judge Feikens's explanation of why the merger doctrine should be addressed in the infringement prong did not extend only to the merger of an expression with a method of operation; it applied to all cases.²¹² The dissent stressed that the use of the work should be viewed separately from the issue of copyrightability. However, the dissent's very thorough explanation failed to answer why merger could not be considered with the question of copyrightability. In fact, Judge Feikens notably pointed out that the application of the doctrine to copyrightability could be determinative in subjecting a defendant to DMCA liability. Additionally, with regard to *scènes à faire*, Judge Feikens stated that, where possible, *scènes à faire* should come into play in determining the question of copyrightability.²¹³ Moreover, the DMCA creates a possibility of liability for the circumvention of a technological protection measure *regardless* of whether the actual use of the copyrighted work infringes, and in spite of fair use or other exceptions generally recognized under copyright law.²¹⁴ The anticircumvention proscriptions are independent of the copyright claim. It must logically follow that application of the merger and *scènes à faire* doctrines as defenses are similarly unhelpful in escaping the harsh DMCA liability based on the simple fact that the statute has already been triggered. Therefore, limiting application of the doctrines solely to the infringement defense prong deprives the defendant of a valid safe harbor from DMCA liability, because she was unable to argue the existence of an invalid copyright under the bar to copyrightability approach. To ensure the loss of this defense, Congress did not pass a proposed amendment to revise the DMCA, which would

benefit of the defense. *Id.* With regard to the doctrine of *scènes à faire*, Judge Feikens noted the circuit split regarding whether the doctrine is "separate from the doctrine regarding the validity of a copyright" or if the doctrine "determined whether substantial similarity existed." *Id.* at 559. The dissent advocated a distinction in the area of computer programming, since that area goes beyond literary stock scenes to contain elements dictated by external constraints. *Id.* Again, the dissent maintained that some inquiry into the use of the element must take place. *Id.* However, Judge Feikens stated that, where possible, *scènes à faire* should come into play in determining the question of copyrightability as was held in *Stromback v. New Line Cinema*, an earlier Sixth Circuit ruling. *Id.*

²¹² *Id.* at 557 (Feikens, J., concurring in part and dissenting in part) ("Although I would exercise judicial economy and limit the holding to the case of merger with a method of operation . . . I would find the merger doctrine can operate only as a defense to infringement in that context, and as such has no bearing on the question of copyrightability.").

²¹³ *Id.* at 559.

²¹⁴ HOLLARR, *supra* note 130, at 208-209; *see* Chamberlain Group v. Skylink Techs., Inc., 381 F.3d 1178, 1195 (Fed. Cir. 2004) ("Defendants who use such devices may be subject to liability under § 1201(a)(1) whether they infringe or not"). The DMCA explicitly carves out the exclusive list of safe harbor provisions, which may be asserted as a defense to DMCA liability. 17 U.S.C. § 1201 (d)-(j) (2006).

impose liability only when the access-control circumvention led to actual copyright infringement.²¹⁵ This legislative action further emphasizes the notion that applying the doctrines in the context of copyright infringement defense is not helpful. Should the day come when this amendment is passed, reconsideration of this split in DMCA cases may be appropriate. That day is not today.

B. The Issue of False Positives

The rising cost of false positives also supports the application of the doctrines as bars to copyrightability. In the copyright context, a false positive occurs when copyright protection is improperly attributed to a work that does not warrant protection.²¹⁶ False positives directly affect error costs: the costs attributed to erroneous outcomes in intellectual property cases.²¹⁷ The error costs depend on the frequency of generating a false positive and the social cost created by the false positive.²¹⁸ An increase in either or both of these two factors leads to an increase in the error cost. The issue of false positives directly affects the balance between copyright ownership rights and creative expression: too much copyright protection may create a dampening effect on later creative efforts by bestowing a windfall upon the plaintiff in an infringement suit.²¹⁹

A legal rule may have the effect of increasing or decreasing the frequency of a false positive²²⁰ and an error can occur when the law is applied to the facts of a case incorrectly.²²¹ Disallowing application of merger at the copyrightability stage would lead to an increase in the frequency of false positives. Section 102(b) of the Copyright Act specifically forbids a grant of copyright protection to an idea.²²² The merger doctrine is rooted in this ideal by demanding that, where an idea is capable of expression in only few ways, the expression and the idea merge; thus, no copyright protection may be granted as dictated by § 102(b). Similarly, *scènes à faire* follows the same ideal by stating that stock scenes do not qualify as expression but are closer to the idea. Thus,

²¹⁵ See Digital Media Consumers' Rights Act of 2003, H.R. 107, 108th Cong. § 5 (2003).

²¹⁶ Conversely, a false negative occurs when a defendant is denied copyright protection where she should prevail. See, e.g., Abrahamson, *supra* note 9, at 1165.

²¹⁷ Robert G. Bone, *Enforcement Costs and Trademark Puzzles*, 90 VA. L. REV. 2099, 2123 (2004).

²¹⁸ *Id.* at 2124.

²¹⁹ Abrahamson, *supra* note 9, at 1129.

²²⁰ Bone, *supra* note 217, at 2124.

²²¹ *Id.* at 2125.

²²² 17 U.S.C. § 102(b) (2006).

keeping this doctrine outside of the question of copyrightability allows works, where the expression and the idea merge, to incorrectly obtain copyright protection, which increases the frequency of false positives and error costs.

Generally, a false positive in the copyright context creates a social cost by keeping a creative work out of the public domain. This cost is balanced by the goal of copyright law to create incentives for artists to contribute creative works to the world. During the term of copyright, the copyright owner may benefit from his bundle of rights by disallowing copies or derivative works absent payment of licensing fees or some other contractual arrangement. However, the constitutional intent is to grant this privilege for only a limited time. This balance shifts to unfairly benefit the copyright owner in DMCA-era paracopyright law. The false grant of a copyright places the work under DMCA jurisdiction when the work is guarded by a technological protection measure to prevent access. Once this measure has been taken, a work may indefinitely be kept out of the public domain, lest a person be willing to circumvent the protection measure and face DMCA liability. This potential reality stands in stark contrast to the “securing [copyright] for limited [t]ime[.]” constitutional language.²²³ While this shift may be favorable to the copyright owner who may reap the benefit of this monopoly, society suffers by incurring costs to access the work or to create derivatives thereof.

Falsely granting an unwarranted copyright allows the owner to get away with legal murder by reaping the benefits of the monopoly while unfairly creating the social costs of barring access to the work.²²⁴ The copyright owner is free to charge others with DMCA liability as well as copyright infringement, which results in unnecessary litigation costs for defendants as well as undue burdens for the courts. Administrative efficiency suffers due to a backlog of copyright infringement and DMCA cases on a court docket that should not be there in the first place. By not applying merger and *scènes à faire* at the copyrightability stage, there is even more danger in wrongfully protecting the “expression” by way of a false positive. Whereas a false positive grants protection where it should not be allowed, in this case, a false positive *would* improperly grant protection to the idea or the stock scene, because that safeguard is removed when the doctrines are not considered at the copyrightability stage. Therefore, the allowance of a false positive stands in stark contrast

²²³ U.S. CONST. art I, § 8, cl. 8.

²²⁴ For a more detailed analysis of the social costs created by copyright protection, see PAT AUFDERHEIDE & PETER JASZI, UNTOLD STORIES: CREATIVE CONSEQUENCES OF THE RIGHTS CLEARANCE CULTURE FOR DOCUMENTARY FILMMAKERS (Center for Social Media 2004).

with § 102(b) proscription of granting copyright protection to an idea. Where ideas become legally protected, the intent of promoting the progress of the useful arts is lost.

V. CONCLUSION

Applying the merger and *scènes à faire* doctrines as bars to copyrightability will support both the § 102(b) idea-expression dichotomy, which declares that ideas are not copyrightable subject matter due to the harmful monopoly effects it would otherwise create as well as the constitutional goal of fostering creative expression by rendering ideas free to the world. Since the enactment of the DMCA, the flaws of the statute have continued to reveal themselves. Paracopyright protection forms a dark cloud over copyright law with terrible repercussions to society despite the benefits to the copyright owners. By applying the merger and *scènes à faire* doctrines to the issue of copyrightability, defendants are deprived of a valid escape mechanism from harsh DMCA liability. Finally, the danger of false positives in the copyright context sends a harbinger for the courts to consider the doctrines as a bar to copyrightability rather than as a defense to particular types of infringement.