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A HEAVY BURDEN: PROPER APPLICATION OF
COPYRIGHT'S MERGER AND *SCENES A FAIRE* DOCTRINES

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INTRODUCTION

One of the least clearly defined concepts in copyright law is the idea/expression dichotomy, which states that protection for works only extends to expression, not ideas.¹ It has been very difficult to distinguish between these two concepts.² Complicating matters, courts have disagreed in infringement actions over which party should bear the burden of proof regarding the idea/expression dichotomy in general.³ Courts have classified it as a question of whether it is a bar

¹ See *N.Y. Times Co. v. United States*, 403 U.S. 713, 726 n.* (1971) (“[T]he copyright laws, of course, protect only the form of expression and not the ideas expressed.”).

² See *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930) (“Upon any work, ... 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 [work] 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 [author] 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.*”) (emphasis added).

³ Compare *Kern River Gas Transmission Co. v. Coastal Corp.*, 899 F.2d 1458, 1460 (5th Cir. 1990) (holding that because the idea and expression in plaintiff’s maps merged, the maps were not copyrightable); *Mason v. Montgomery Data, Inc.*, 967 F.2d 135, 138 n.5 (5th Cir. 1992) (following *Kern River*); *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522, 538 (6th Cir. 2004) (holding that because copyrightability is an issue in both prongs of the analysis, both doctrines were applicable in the case of copyrightability); *Bateman v. Mnemonics, Inc.*, 79 F.3d 1532, 1544-46 n.28 (11th Cir. 1996) (holding that merger and *scenes a faire* could be used to deny copyrightability to portions of a work or even an entire work itself); *Whelan Assocs. v. Jaslow Dental Lab., Inc.*, 797 F.2d 1222, 1236 (3rd Cir. 1986) (discussing *scenes a faire* as a bar to copyrightability); *with Reed-Union Corp. v. Turtle Wax, Inc.*, 77 F.3d 909, 914 (7th Cir. 1996) (holding that the doctrine of *scenes a faire* is separate from the doctrine regarding the validity of a copyright, i.e., that it is invoked as a defense to infringement instead); *Taylor Corp. v. Four Seasons Greetings LLC*, 315 F.3d 1039, 1042-43 (8th Cir. 2003) (finding that the *scenes a faire* doctrine determined whether substantial similarity existed in the infringement determination); *Kregos v. Associated Press*, 937 F.2d 700, 705 (2d Cir. 1991) (holding that merger is applied as a defense to infringement, not a bar to

to copyrightability or a defense to infringement,⁴ but the real question is who bears the burden of proof. Should the plaintiff be required to show that his work consists of protectable expression, rather than unprotectable ideas, or should the defendant be required to show that what she took from the plaintiff was not protectable? Because of the difficulty in distinguishing between idea and expression, the party who ultimately bears the burden is in trouble.⁵ “Whoever has to prove the unprovable facts is likely to lose.”⁶

Since courts disagree about the burdens, judge-made law is still highly relevant and often decisive in moving the current understanding of the law forward.⁷ This problem stands at the heart of copyright law’s inconsistency. Judges across the country are often authorized to make their own individual decisions interpreting a federal statute,⁸ and these decisions are only binding on a particular region. Thus,

copyrightability); *CCC Info. Servs., Inc. v. Maclean Hunter Mkt. Reports, Inc.*, 44 F.3d 61, 72 n.26 (2d Cir. 1994) (following *Kregos*); *Matthew Bender & Co. v. West Publ’g Co.*, 158 F.3d 674, 688 n.12 (2d Cir. 1998) (following *Kregos*); *Ets-Hokin v. Skyy Spirits, Inc.*, 225 F.3d 1068, 1082 (9th Cir. 2000) (citing both *Reed-Union* and *Kregos* favorably regarding both merger and *scenes a faire* and following their approach); *but see also Lexmark*, 387 F.3d at 556-60 (Feikens, J., dissenting) (arguing that these doctrines ought to operate only as defenses to infringement); *Kregos*, 937 F.2d at 714-16 (Sweet, J., concurring in part and dissenting in part) (arguing that these doctrines should operate as bars to copyrightability).

⁴ See *supra* note 3.

⁵ David McGowan, *Copyright Nonconsequentialism*, 69 MO. L. REV. 1, 2 (2004) (“These examples represent a general truth. It is easy for each side to poke holes in the other side’s positions. It is hard for either side to make an affirmative, instrumental case for their views. For this reason, and because scholars favor consequentialist rhetoric, the debate often consists of competing narratives that use hunches and conjectures to link the result an author desires to the policy the author favors. Because the evidence in such arguments is so weak, the legal endgame is to place the burden of proof on the other side. Whoever has to prove the unprovable facts is likely to lose.”).

⁶ *Id.*

⁷ For example, in the context of the fair use doctrine, despite its legislative codification at 17 U.S.C. § 107 (2000), the legislative history still states:

The bill endorses the purpose and general scope of the judicial doctrine of fair use, but there is no disposition to freeze the doctrine in the statute, especially during a period of rapid technological change. Beyond a very broad statutory explanation of what fair use is and some of the criteria applicable to it, the courts must be free to adapt the doctrine to particular situations on a case-by-case basis. Section 107 is intended to restate the present judicial doctrine of fair use, not to change, narrow, or enlarge it in any way.

H.R. REP. NO. 94-1476, at 66 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5680.

⁸ See *id.*

despite the intended uniformity of copyright law that is supposed to accompany federal intellectual property legislation,⁹ there is still a great lack of consistency in application.¹⁰ Especially with regard to idea/expression, courts do not know how to properly apply two very important copyright doctrines, the merger doctrine and *scenes a faire*.¹¹ They cannot decide whether these doctrines operate as bars to copyrightability or defenses to infringement.¹² In fact, some have even argued that there is currently a circuit split.¹³ In reality, these judges aren't disagreeing; they are talking past one another. At the same time, the situation is still quite chaotic.

In order to sift through the madness of copyright law, judicial reliance on Professor Nimmer's comprehensive copyright treatise has risen to astounding levels.¹⁴ "The considerable number of citations to the Nimmer copyright treatise suggests it is widespread and commonplace for federal judges to depend on the treatise to articulate and support copyright law decisions."¹⁵ On the one hand, this reliance must certainly help bring some much needed uniformity to the realm of copyright law. On the other hand, because of Nimmer's influence, any error in approach will be compounded by an often blind acquiescence by the federal courts.¹⁶

The present discussion of the idea/expression dichotomy presents one such error. Professor Nimmer takes the stance that the burden of proof should lie with the defendant¹⁷ in proving that his

⁹ See *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 162 (1989) ("One of the fundamental purposes behind the Patent and Copyright Clauses of the Constitution was to promote national uniformity in the realm of intellectual property.").

¹⁰ See *supra* note 3.

¹¹ See *supra* note 3.

¹² See *supra* note 3.

¹³ *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522, 557 (6th Cir. 2004) (Feikens, J., concurring in part and dissenting in part) ("[There is] a Circuit split regarding the law of merger. Simply put, there is some disagreement about whether the merger doctrine acts as a bar to copyrightability, or simply as a defense to particular types of infringement.").

¹⁴ Ann Bartow, *The Hegemony of the Copyright Treatise*, 73 U. CIN. L. REV. 581, 589 (2004) ("Quantification of the number of times the Nimmer treatise has been cited by federal courts in published opinions via online legal databases is inexact at best, but conservatively exceeds 2000 citations, 17 by the Supreme Court alone.").

¹⁵ *Id.* at 591.

¹⁶ *Id.*

¹⁷ See 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.03[B][3], at 13-88 to 13-88.1 (Matthew Bender & Co. 2007) (1963) ("It is not always clear whether the merger doctrine is deemed a bar to copyright itself, rather than simply a defense to the charge of infringement [T]he better view construes it as the latter"); see also *id.* § 13.03[B][4], at 13-88.6 ("As was remarked above

taking was protected by the two major guardians of idea/expression, the merger doctrine and *scenes a faire*. Regarding merger, he states that “the better view” construes it as a defense to infringement, “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*,” thus requiring defendants to prove that their taking was justified.¹⁸ As to *scenes a faire*, he merely states that “this doctrine does not limit the subject matter of copyright; instead, it defines the contours of infringing conduct.”¹⁹

While Professor Nimmer may have been right about this application in 1976, subsequent statutes demand a reconsideration of his original stance. Since enactment of the Copyright Act of 1976, Congress has enacted dozens of statutes which expand the protection afforded to copyright owners.²⁰ However, as these same statutes

concerning merger, [the *scenes a faire*] doctrine does not limit the subject matter of copyright; instead, it defines the contours of infringing conduct.”).

¹⁸ *Id.* § 13.03[B][3], at 13-88.1.

¹⁹ *Id.* § 13.03[B][4], at 13-88.6.

²⁰ *See, e.g.*, Record Rental Amendment of 1984, 17 U.S.C. §§ 109, 115 (2000) (granting owners of copyrights in musical works the right to control rental despite the first sale doctrine); Semiconductor Chip Protection Act of 1984, 17 U.S.C. § 901 (2000) (creating protection for the layout of semiconductor chips); Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853 (codified as amended in scattered sections of 17 U.S.C. (2000)) (relaxing the notice, registration, and recordation requirements); Architectural Works Copyright Protection Act of 1990, 17 U.S.C. §§ 102, 106, 120, 301 (2000) (extending copyright protection to building designs); Copyright Renewal Act of 1992, 17 U.S.C. §§ 304, 408, 409, 708 (2000) (providing automatic renewal of the copyright term for works created before 1978 still in their first copyright term); Audio Home Recording Act of 1992, 17 U.S.C. §§ 101, 801, 803, 912 (2000); 19 U.S.C. § 1337 (2000) (imposing a royalty on digital audio tape recorders and tapes and requiring manufacturers to use a serial copy management system); Uruguay Round Agreements Act of 1994, 19 U.S.C. § 3901 (2000) (enacting protection for live, unrecorded performances of non-dramatic musical works); Digital Performance Right in Sound Recordings Act of 1995, Pub. L. No. 104-39, 109 Stat. 336 (codified as amended in scattered sections of 17 U.S.C. (2000)) (creating an exclusive right of public performance for sound recordings); No Electronic Theft Act of 1997, Pub. L. No. 105-147, 111 Stat. 2678 (codified as amended in scattered sections of 17 U.S.C., 18 U.S.C., 28 U.S.C. (2000)) (expanding criminal liability for copyright infringement); Sonny Bono Copyright Term Extension Act of 1998, 17 U.S.C. §§ 108, 203, 301-304 (2000) (extending the term of copyright protection to life of the author plus seventy years for most works); Digital Millennium Copyright Act of 1998, 17 U.S.C. §§ 1201-1332 (2000) (prohibiting circumvention of technological security measures, manufacture and distribution of circumvention devices, and removal or alteration of copyright management information, among other things); Digital Theft Deterrence and Copyright Damages Improvement Act of 1999, 17 U.S.C. § 504 (2000) (amending the statutory damages provisions); Work Made for Hire and Copyright Corrections Act of 2000, 17 U.S.C. §§ 101, 121, 705, 708 (2000) (removing sound recordings from the list of works eligible to be “works made for hire”); Family

demonstrate, it has not become any more difficult for owners to obtain protection in the first place.²¹ Under the quid pro quo bargain theory of copyright, this imbalance operates in direct contradiction to copyright's fundamental policies. Authors are given protection in exchange for their creative contributions.²² However, since 1976, authors have been given considerably more protection, yet have not noticeably increased their production, nor have they been asked to do so.²³ The courts' present disagreement ought to be resolved in favor of increased expectations for potential plaintiffs. In order to best serve the interests of copyright law, in light of the ever increasing statutory protection afforded copyright owners and the plain language of the copyright statute itself, courts should require plaintiffs to show that their work is protectable despite the merger doctrine and *scenes a faire*.

The basis for this position is set out in this Comment by first describing in Part I the fundamental policy objective of copyright law, the quid pro quo exchange, and how it has become unbalanced. Part II provides an overview of the idea/expression dichotomy and its constituent enforcers, the merger doctrine and *scenes a faire*, as well as a discussion of the difficulty courts have had in their application. Part III demonstrates why these doctrines should be applied as bars to copyrightability, requiring the plaintiff to shoulder the burden of proof, based on procedural, statutory, and constitutional policy concerns.

I. THE FUNDAMENTAL POLICY OF COPYRIGHT IS TO INCENTIVIZE AUTHORS THROUGH A QUID PRO QUO EXCHANGE, AND THIS EXCHANGE HAS BEEN DISRUPTED.

This section discusses copyright's quid pro quo exchange, which is based on the idea that authors contribute their creativity to society, and society rewards them with an exclusive right to control their work. Unfortunately, this exchange has been badly disrupted, as copyright protection has expanded to unprecedented levels, yet authors have not been asked to contribute anything more to society.

Entertainment and Copyright Act of 2005, Pub. L. No. 109-9, 119 Stat. 218 (codified as amended in scattered sections of 2 U.S.C., 15 U.S.C., 17 U.S.C., 36 U.S.C. (2006) (establishing pre-registration procedure for certain works and criminal penalties for unauthorized reproduction and distribution).

²¹ See *supra* note 20.

²² *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975) ("The ... effect of our copyright law is to secure a fair return for an 'author's' creative labor.").

²³ See *supra* note 20 (listing examples of statutes expanding protection without increasing requirements to obtain it in the first place).

A. *The Quid Pro Quo Exchange*

Congress derives its authority to promulgate copyright laws from the Intellectual Property Clause, which states that “[t]he Congress shall have Power ... [t]o promote the Progress of Science and the useful Arts by securing for limited times to Authors ... the exclusive Right to their respective Writings”²⁴ Thus, the Constitution directly authorizes Congress to enact intellectual property legislation. At the time of the Constitutional Convention, the word “science” was understood to mean “knowledge.”²⁵ Thus, the primary purpose of copyright law is to advance the public good by promoting the progress of knowledge.²⁶

There is a debate in copyright, however, about how this is best accomplished.²⁷ The first approach would provide very strong incentives for authors in the form of zealously enforced protective measures.²⁸ The second would give them much less protection, and put only the fruits of their labor that fit within the very letter of the law out of the immediate reach of the public.²⁹ In the first case, production by authors should theoretically increase based on stronger incentives, stimulating long-term growth of the public domain after copyrights expire.³⁰ The second approach more zealously protects information currently in the public domain, and only permits authors to protect those elements of their creation which fit narrowly within

²⁴ U.S. CONST. art. I, § 8, cl. 8.

²⁵ See *Eldred v. Ashcroft*, 537 U.S. 186, 243 (2003) (Breyer, J., dissenting) (in using the word “‘Science’ ... the Framers meant learning or knowledge.”).

²⁶ See *Am. Geophysical Union v. Texaco, Inc.*, 802 F. Supp. 1, 9 (S.D.N.Y. 1992) (“The theory espoused by this constitutional provision is that the advancement of public good, through growth of knowledge and learning, is to be obtained by securing the private commercial interests of authors.”).

²⁷ See *Kern River Gas Transmission Co. v. Coastal Corp.*, 899 F.2d 1458, 1463 (5th Cir. 1990) (“The Copyright Act reflects a tension created by Congress in balancing divergent public policies [P]rotection is extended to an expression of an idea fixed in a tangible form, but not to the idea itself regardless of the form in which it is fixed. In drawing this fundamental distinction, Congress balanced the competing concerns of providing incentive to authors to create and of fostering competition in such creativity.”).

²⁸ *Id.*

²⁹ See *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971) (“The guiding consideration in drawing the line is the preservation of the balance between competition and protection reflected in the patent and copyright laws. What is basically at stake is the extent of the copyright owner's monopoly—from how large an area of activity did Congress intend to allow the copyright owner to exclude others?”).

³⁰ *Id.*

the constitutional and statutory requirements.³¹ Thus, the debate revolves around whether to protect the current public domain at all costs, or to provide greater protection to authors, resulting in a more long-term growth strategy.³² In either case, the system encourages creativity by providing copyright protection, permitting authors to recoup their investment and reap the rewards.³³

This concept of protection in exchange for creativity is known as the bargain theory of copyright, and is “the dominant theoretical approach to copyright.”³⁴ In *Twentieth Century Music Corp. v. Aiken*, the Supreme Court discussed the bargain theory’s Constitutional basis, stating, “[t]he immediate effect of our copyright law is to secure a fair return for an ‘author’s’ creative labor. But the ultimate aim is, by this incentive, to stimulate artistic creativity for the general public good.”³⁵

Since our nation’s founding, our government has struggled to determine how an effective copyright system best operates. Over time, some clear ideas have emerged. For example, the Supreme Court interpreted the words “author” and “writings” to mean that a work must demonstrate a degree of “originality” in order to garner copyright protection.³⁶ The required amount of originality is quite low,³⁷ but nevertheless, it is a basic requirement. This is the quid pro quo exchange in copyright; it is the author’s contribution to society which justifies the government’s protection of his work.³⁸ As Professor Peter

³¹ *Id.*

³² *Id.*

³³ Peter K. Yu, *Fictional Persona Test: Copyright Preemption In Human Audiovisual Characters*, 20 CARDOZO L. REV. 355, 384 (1998) (“Copyright protection is ... needed to assure writers a fair return on their investments in creation.”).

³⁴ Margaret A. Wilkinson, *The Public Interest in Moral Rights Protection*, 2006 MICH. ST. L. REV. 193, 205 (2006).

³⁵ 422 U.S. 151, 156 (1975).

³⁶ See *In re Trade-Mark Cases*, 100 U.S. 82, 94 (1879) (“[U]nder the head of writings of authors, originality is required.. And while the word *writings* may be liberally construed, as it has been, to include original designs for engravings, prints, &etc., it is only such as are *original*, and are founded in the creative powers of the mind. The writings which are to be protected are *the fruits of intellectual labor*, embodied in the form of books, prints, engravings, and the like.”); see also *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 57-60 (1884) (“An author in that sense is ‘he to whom anything owes its origin; originator; maker ...’ [W]hen the supposed author sues for a violation of his copyright, the existence of those facts of *originality* ... on the part of the author should be proved.”) (emphasis added).

³⁷ See *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 358-59 (1991) (“[T]he originality requirement is not particularly stringent. ... Originality requires only that the author make [the work] independently (i.e., without copying ...), and that it display some minimal level of creativity.”).

³⁸ *Fox Film Corp. v. Doyal*, 286 U.S. 123, 127-28 (1932) (“The sole interest of the United States and the primary object in conferring the monopoly lie in the general

Yu stated, “[c]opyright protection is ... needed to assure writers a fair return on their investments in creation. Providing writers ... with monopolies over their creative works ... enables them to recapture their investments.”³⁹ Judge Richard Posner and Professor William Landes would agree, arguing that “[s]ome copyright protection is necessary to generate the incentives to incur the costs of creating easily copied works”⁴⁰

B. Copyright’s Quid Pro Quo Has Been Disrupted by Increased Protection

Despite the clear importance of the quid pro quo exchange, protection for copyright owners has expanded dramatically⁴¹ since the Copyright Act of 1976.⁴² In discussing copyright’s duration alone, Professor Lawrence Lessig notes, “[i]n the first hundred years of federal copyright’s life in America, Congress changed that term just once. In the next fifty years, Congress changed that term once again. But in the last thirty-nine years, Congress has extended the terms of copyrights eleven times.”⁴³

Congressional expansion of copyright protection is not just limited to duration, however. Consider the Digital Millennium Copyright Act, which essentially provides a new cause of action for copyright owners against those who circumvent their security technology.⁴⁴ Another example is the Uruguay Round Agreements Act, which extends copyright protection to live, unrecorded performances of nondramatic musical works.⁴⁵ Congress has passed literally dozens of other enactments which dramatically expand copyright protection.⁴⁶

While Congress has been expanding protection, copyright owners have been asked to do nothing more. In fact, in some cases,

benefits derived by the public from the labors of authors. A copyright, like a patent, is at once the equivalent given by the public for benefits bestowed by the genius and meditations and skill of individuals, and the incentive to further efforts for the same important objects.”) (internal quotations omitted).

³⁹ Yu, *supra* note 33, at 384-85.

⁴⁰ William M. Landes & Richard A. Posner, *An Economic Analysis of Copyright Law*, 18 J. LEGAL STUD. 325, 335 (1989).

⁴¹ See *supra* note 20.

⁴² 17 U.S.C. § 102(b) (2000).

⁴³ Lawrence Lessig, *Copyright’s First Amendment*, 48 UCLA L. REV. 1057, 1065 (2001).

⁴⁴ 17 U.S.C. §§ 1201-1332 (2000).

⁴⁵ 19 U.S.C. § 3901 (2000).

⁴⁶ See *supra* note 20.

statutory requirements for copyright protection have been relaxed.⁴⁷ Furthermore, the Supreme Court does not have very high expectations for copyright owners in the first place. In *Feist Publications, Inc. v. Rural Telephone Service Co.*,⁴⁸ the court stated that “[t]he originality requirement is not particularly stringent. . . . Originality requires only that the author make [the work] independently (i.e., without copying . . .), and that it display some minimal level of creativity.”⁴⁹ Well, the originality requirement is the *quid* that authors contribute in the quid pro quo exchange.⁵⁰ It is the constitutional requirement for copyright protection, and it is “not particularly stringent.”⁵¹ Basically, the quid pro quo balance has been greatly disrupted by an unbridled expansion of copyright protection, without any corresponding increased expectations for authorial contributions.

Thus, it is clear that an important policy objective of copyright law is that authors must give in order to receive. Make a contribution of originality and creativity to society as a whole, and the government will provide an exclusive right. Unfortunately, this policy has clearly been disrupted, and its balance needs to be restored. The fact is, courts must ensure that authors are only awarded for that which they actually contribute, and nothing more. The discussion below demonstrates how the idea/expression dichotomy helps courts ensure that authors do not receive any more protection than that which they have earned, quid pro quo.

II. THE IDEA/EXPRESSION DICHOTOMY: THEORY AND PRACTICE

In order to provide certainty in our nation’s intellectual property laws, and supply sufficient incentives to both authors and inventors, while at the same time avoiding the removal of material from the public domain, a clear delineation between the patent and copyright systems is a necessity. In service of this objective, the statute-based idea/expression dichotomy ensures that those works properly within the scope of copyright get protection, while everything else is relegated to either patent protection or the public domain. Unfortunately, courts have struggled to apply this distinction in practice.⁵²

⁴⁷ See, e.g., Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853 (codified as amended in scattered sections of 17 U.S.C. (2000)) (relaxing the notice, registration, and recordation requirements).

⁴⁸ 499 U.S. 340, 358 (1991).

⁴⁹ *Id.* at 358-59.

⁵⁰ See discussion *supra* Part I.A.

⁵¹ *Feist*, 499 U.S. at 358-59.

⁵² See *supra* note 3.

A. *What Is the Idea/Expression Dichotomy?*

Copyright protection is limited in that it pertains only to *expression*.⁵³ The Supreme Court interpreted the Intellectual Property Clause to require that protection for expression is distinguished from protection for *ideas*.⁵⁴ The primary purpose of this distinction is to specifically define what is protectable by copyright, what belongs in the public domain, and what is protected by patent law.⁵⁵ This creates certainty for those authors who wish to publish their works, so they can have a reasonable expectation of the protection the law will provide. It also provides the same benefit to potential patentees, by clearly delineating what a patent protects and what a copyright protects.⁵⁶ The result is that authors and inventors create, confident in the clearly defined scope of protection the law will provide them, and the public as a whole benefits from an increased dissemination of knowledge.⁵⁷

The legal term of art which refers to this distinction is the idea/expression dichotomy.⁵⁸ It was first clearly identified and discussed in the case of *Baker v. Selden*,⁵⁹ and Congress codified it at 17 U.S.C. § 102(b): “[i]n no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated,

⁵³ See *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 547 (1985) (“[N]o author may copyright facts or ideas. The copyright is limited to those aspects of the work—termed ‘expression’—that display the stamp of the author’s originality.”).

⁵⁴ See *Baker v. Selden*, 101 U.S. 99, 103 (1879) (“The copyright of a work on mathematical science cannot give to the author an exclusive right to the methods of operation which he propounds, or to the diagrams which he employs to explain them, so as to prevent an engineer from using them whenever occasion requires. The very object of publishing a book on science or the useful arts is to communicate to the world the useful knowledge which it contains. But this object would be frustrated if the knowledge could not be used without incurring the guilt of piracy of the book.”).

⁵⁵ See *id.* at 105 (“The description of the art in a book, though entitled to the benefit of copyright, lays no foundation for an exclusive claim to the art itself. The object of the one is explanation; the object of the other is use. The former may be secured by copyright. The latter can only be secured, if it can be secured at all, by letters-patent.”).

⁵⁶ *Id.*

⁵⁷ *Id.* at 103; see also discussion *supra* Part I.A.

⁵⁸ *Feist*, 499 U.S. at 350 (“[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. . . . This principle, known as the idea/expression . . . dichotomy, applies to all works of authorship.”).

⁵⁹ *Baker*, 101 U.S. at 103.

or embodied in such work.”⁶⁰ Thus, copyright law will never protect ideas, while original expression of ideas will always garner protection.⁶¹

Distinguishing between idea and expression in a work is very difficult. The most famous attempt to define this boundary was articulated by Judge Learned Hand:

Upon any work, ... 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 [work] 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 [author] 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.*⁶²

Despite the difficulties, there are two doctrines which assist in defining the boundary between idea and expression. The first of these is the merger doctrine. The second method is *scenes a faire*. These doctrines are critical in assisting courts to promote the fundamental policy objectives of copyright law.⁶³

1. The Merger Doctrine as the First Tool of Enforcing the Idea/Expression Dichotomy

When an idea is inseparable from its own expression, that idea is said to merge with the expression, and such expression, despite any originality, is denied copyright protection.⁶⁴ This concept is known as the merger doctrine, and is a valuable tool for courts in defining the

⁶⁰ 17 U.S.C. § 102(b) (2000).

⁶¹ *Id.*

⁶² *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930) (emphasis added).

⁶³ *See Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522, 535 (6th Cir. 2004) (“In ascertaining this ‘elusive boundary line’ between idea and expression, ... courts have looked to two other staples of copyright law—the doctrines of merger and scenes a faire.”); *see also Baker*, 101 U.S. at 103.

⁶⁴ *See Kern River Gas Transmission Co. v. Coastal Corp.*, 899 F.2d 1458, 1463 (5th Cir. 1990) (“The doctrine of ‘merger’ developed in an effort to deal with this difficulty in locating the precise boundary between idea and expression. The doctrine holds that when the expression of an idea is inseparable from the idea itself, the expression and idea merge.”).

boundary between protectable expression and unprotectable ideas.⁶⁵ The purpose of defining this boundary is to ensure that authors are only granted an exclusive right to their original expression.⁶⁶ However, if the expression and idea are inseparable, granting an exclusive right will result in the author obtaining a monopoly on the idea itself.⁶⁷ Rather than promote the progress of knowledge, such a result stymies the dissemination of knowledge. Giving authors an exclusive right to merged expression infringes upon the province of patent law, which provides inventors, not authors, with an exclusive right to exploit their ideas that are novel, useful, and nonobvious.⁶⁸

Patent law's protection of ideas does not stifle innovation or retard progress because such protection is much more difficult to obtain⁶⁹ and the duration of its protection is shorter.⁷⁰ Unlike a copyright, whose protection is available as long as a "modicum of originality" exists in a particular *expression*,⁷¹ patent law only protects inventions provided they pass tests of novelty, nonobviousness, and utility.⁷² These are significant hurdles, and ensure that ideas which the public already possesses are not thereafter taken away.⁷³ At the same time, these hurdles provide a powerful incentive for inventors to continue to innovate.⁷⁴

⁶⁵ *Id.*

⁶⁶ *See* *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971) ("When the 'idea' and its 'expression' are thus inseparable," copyright protection will not be extended, "since protecting the 'expression' in such circumstances would confer a monopoly of the 'idea' upon the copyright owner.").

⁶⁷ *Id.*

⁶⁸ *See id.* at 740 (The grant of an exclusive patent right "is carefully circumscribed by substantive and procedural protections. To be patentable the subject matter must be new and useful, and represent a nonobvious advance ... an advance that would not be obvious to a hypothetical person skilled in the art and charged with knowledge of all relevant developments publicly known to that point in time. A patent is granted only after an independent administrative inquiry and determination that these substantive standards have been met. This determination is subject to both administrative and court review."). *See also* *Mazer v. Stein*, 347 U.S. 201, 217-18 (1954) ("Unlike a patent, a copyright gives no exclusive right to the art disclosed; protection is given only to the expression of the idea—not the idea itself The copyright protects originality rather than novelty or invention.").

⁶⁹ *Kalpakian*, 446 F.2d at 740.

⁷⁰ *Compare* 17 U.S.C. § 302 (2000) (setting copyright duration for most types of works to life of the author plus seventy years) *with* 35 U.S.C. § 154 (2000) (providing for a patent term of twenty years from the date of filing of the patent application).

⁷¹ *See Feist*, 499 U.S. at 346 ("[O]riginality requires independent creation plus a modicum of creativity.").

⁷² *Kalpakian*, 446 F.2d at 740.

⁷³ *Id.*

⁷⁴ *Id.*

Copyright law, on the other hand, absent the idea/expression dichotomy, would provide an exclusive right to such ideas provided they possessed a mere “modicum of originality,” which is an extremely low standard.⁷⁵ This would open the floodgates to a monopolization of ideas, whose low but sufficient level of originality would sustain an exclusive right, and pull a great deal of information out of the public domain.⁷⁶ The result would directly counteract the primary policy of copyright law, by effectively foreclosing the public dissemination of a vast quantity of knowledge.⁷⁷

The merger doctrine counteracts this potential pitfall by erring on the side of caution when evaluating whether an expression is worthy of protection.⁷⁸ If the expression is inseparable from its idea, that is, if there are very few ways to express an idea, regardless of any originality present in that expression, copyright protection will not be available. Thus, potentially original expression is not protected in order to ensure that a monopoly on an idea is not granted.⁷⁹

2. Scenes a Faire as the Second Tool of Enforcing the Idea/Expression Dichotomy

Scenes a faire are defined as “incidents, characters or setting which are as a practical matter indispensable, or at least standard, in the treatment of a given topic,”⁸⁰ or “scenes which necessarily result from identical situations.”⁸¹ For example, broomsticks and bubbling cauldrons are not protectable expression in a story about witches. In

⁷⁵ *Feist*, 499 U.S. at 358-59.

⁷⁶ *See Kalpakian*, 446 F.2d at 741 (“Obviously a copyright must not be treated as equivalent to a patent lest long continuing private monopolies be conferred over areas of gainful activity without first satisfying the substantive and procedural prerequisites to the grant of such privileges.”).

⁷⁷ *Id.*

⁷⁸ *See Fin. Control Assocs., Inc. v. Equity Builders, Inc.*, 799 F. Supp. 1103, 1118 (D. Kan. 1992) (In cases of merger, “rigorously protecting the expression would confer a monopoly over the idea itself, in contravention of the statutory command. To prevent that consequence, courts have invoked the merger doctrine. In other words, given the dilemma either of protecting original expression even when that protection can be leveraged to grant an effective monopoly over the idea thus expressed, or of making the idea free to all with the concomitant result that the plaintiff loses effective copyright protection even over the precise original expression used, copyright law chooses the latter course.”) (quoting 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.03[B][3] (Matthew Bender & Co. 2007) (1963)).

⁷⁹ *Id.*

⁸⁰ *Atari, Inc. v. N. Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 616 (7th Cir. 1982) (quoting *Alexander v. Haley*, 460 F. Supp. 40, 45 (S.D.N.Y. 1978)).

⁸¹ *Reyher v. Children's Television Workshop*, 533 F.2d 87, 92 (2d Cir. 1976).

the area of computing, *scenes a faire* expands, denying protection to those elements that are dictated by external constraints, such as hardware requirements or operating system interface parameters.⁸² Thus, those expressions which are inherent in a specific theme, or dictated by external constraints, either do not meet the requisite level of originality because of their connection to that theme⁸³ or because they constitute ideas, and, therefore, must not receive protection under the idea/expression dichotomy.⁸⁴

Much like the merger doctrine, the notion of *scenes a faire* is available to assist courts in distinguishing between copyrightable and uncopyrightable material. Its purpose is to ensure that what belongs in the public domain stays there, and what deserves protection gets it.⁸⁵ Thus, *scenes a faire*, as an enforcer of the idea/expression dichotomy, is a concept invoked to promote the very same public policy that copyright law itself promotes, namely, the progress and public dissemination of knowledge.⁸⁶ Original expressions which are indispensable to a common theme will remain in the public domain to the benefit of all, and the author will not possess the exclusive right to ideas which are also necessary to that theme.

B. Because of Idea/Expression Dichotomy's Abstract Nature, the Party that Has the Burden of Proof Is Much More Likely to Lose, and Courts Have Struggled to Adjust

The discussion regarding the merger doctrine and *scenes a faire* may appear to suggest that courts should invoke these concepts in the initial determination of copyrightability for an individual seeking protection; however, that is not necessarily the case. Again, a work can achieve copyright protection by satisfying the subject matter

⁸² Gates Rubber Co. v. Bando Chem. Indus., Ltd., 9 F.3d 823, 838 (10th Cir. 1993) (“The *scenes a faire* doctrine . . . excludes from protection those elements of a program that have been dictated by external factors.”).

⁸³ See *id.* (“[W]here a particular expression is common to the treatment of a particular idea, process, or discovery, it is lacking in the originality that is the sine qua non for copyright protection.” (citing Feist Publications v. Rural Tel. Service, 499 U.S. 340, 348 (1991))).

⁸⁴ See Burnett v. Lambino, 204 F. Supp. 327, 331 (S.D.N.Y. 1962) (“Such stock characters and situations are inherent . . . as a background and are not copyrightable. The familiar test of copyrightability distinguishes between the ‘ideas’ used by the author and his ‘expression’ of them. Only the latter is said to be copyrightable.” (citing Holmes v. Hurst, 174 U.S. 82, 86 (1899))).

⁸⁵ *Id.*

⁸⁶ See Fin. Control Assocs. v. Equity Builders, Inc., 799 F. Supp. 1103, 1118 (D. Kan. 1992).

requirements of § 102(a) and demonstrating a “modicum of originality.”⁸⁷ The barrier to copyright protection is quite low.⁸⁸ Thus, an evaluation of merger or *scenes a faire* will not typically come up outside the scope of an infringement action.⁸⁹ This raises a fundamental question which this article attempts to answer, namely, who should bear the burden of proof when it comes to showing merger or *scenes a faire*?

As Judge Learned Hand pointed out regarding the point at which idea becomes expression, “[n]obody has ever been able to fix that boundary, and nobody ever can.”⁹⁰ In such a situation, where, “the evidence in such arguments is so weak, the legal endgame is to place the burden of proof on the other side. Whoever has to prove the unprovable facts is likely to lose.”⁹¹ When an abstract concept like idea/expression must be proven, the party who bears the burden will have a much more difficult time.⁹² Because of the extreme difficulty for either plaintiff or defendant to make such a showing, courts disagree about who should be assigned the burden.⁹³

In the last twenty years, the situation has deteriorated considerably, and all semblance of a consistent standard has vanished.⁹⁴ In the First, Third, Fifth, and Eleventh Circuits, courts have held that these doctrines are applicable as bars to copyrightability, and that the plaintiff must demonstrate that his work does not merge or constitute *scenes a faire*.⁹⁵ In the Second, Seventh, Eighth, and Ninth Circuits, courts have generally held that they are

⁸⁷ See *Feist*, 499 U.S. at 358-59 (“The constitutional requirement necessitates independent creation plus a modicum of creativity.”).

⁸⁸ See *id.* at 358 (“[T]he originality requirement is not particularly stringent. ... Originality requires only that the author make [the work] independently (i.e., without copying ...), and that it display some minimal level of creativity.”).

⁸⁹ See *Lexmark*, 387 F.3d at 538 (“[C]ourts 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[,]” not because that is necessarily the correct application.).

⁹⁰ *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930).

⁹¹ McGowan, *supra* note 5, at 1-2.

⁹² See *id.* (“It is easy for each side to poke holes in the other side’s positions. It is hard for either side to make an affirmative, instrumental case for their views. For this reason, and because scholars favor consequentialist rhetoric, the debate often consists of competing narratives that use hunches and conjectures to link the result an author desires to the policy the author favors. Because the evidence in such arguments is so weak, the legal endgame is to place the burden of proof on the other side. Whoever has to prove the unprovable facts is likely to lose.”).

⁹³ See *supra* note 3.

⁹⁴ See *supra* note 3.

⁹⁵ See *supra* note 3.

defenses to infringement, requiring a defendant to demonstrate that his taking *does* constitute merger or *scenes a faire*.⁹⁶ The problem with all of these cases, as the below discussion indicates, is that these courts are talking past one another, justifying their decisions based on inconsistent arguments which do not address one another. Bar/defense is not the argument, burden allocation is.

The dispute finds its foundation in the Supreme Court decision of *Baker v. Selden*.⁹⁷ In that case, the Supreme Court held that Selden's book of accounting practices, though copyrightable as a book, could not also be provided copyright protection for the ideas it described.⁹⁸ Thus, the defendant, Baker, was able to copy those ideas without incurring any liability.⁹⁹ In essence, Baker was able to claim as a defense to copyright infringement that he could not be held liable for what he had copied.¹⁰⁰ The Court held that Baker's taking constituted expression merged with ideas.¹⁰¹ The Court reasoned that because there were a limited number of ways to express an accounting system, taking from such a system was not actionable.¹⁰² However, the Supreme Court did not clearly articulate the application of idea/expression as such in any subsequent case, hence the "dispute."

In the 1967 case of *Morrissey v. Proctor & Gamble Co.*,¹⁰³ the First Circuit applied the merger doctrine, requiring the plaintiff to demonstrate that his work did not consist of merged expression or *scenes a faire*.¹⁰⁴ There, Morrissey had registered a copyright for rules he had promulgated regarding a sweepstakes contest.¹⁰⁵ The court held that because there were only a limited number of ways to express the sweepstakes rules themselves, their idea merged with their expression, and the rules themselves were *per se* uncopyrightable.¹⁰⁶ Morrissey was required to demonstrate that his work did not merge, and he failed to make that showing.¹⁰⁷ The court's rationale was that "to permit copyrighting would mean that a party or parties, by

⁹⁶ See *supra* note 3.

⁹⁷ 101 U.S. 99 (1879).

⁹⁸ *Id.* at 101-02.

⁹⁹ *Id.* at 102.

¹⁰⁰ *Id.* at 103.

¹⁰¹ *Id.* at 107.

¹⁰² *Id.* at 101-02.

¹⁰³ 379 F.2d 675 (1st Cir. 1967).

¹⁰⁴ *Id.* at 678.

¹⁰⁵ *Id.* at 676-77.

¹⁰⁶ See *id.* at 678 ("[T]he substance of the contest was not copyrightable . . .

Copyright attaches to form of expression, and defendant's own proof, introduced to deluge the court on the issue of access, itself established that there was more than one way of expressing even this simple substance.").

¹⁰⁷ *Id.*

copyrighting a mere handful of forms, could exhaust all possibilities of future use of the substance.”¹⁰⁸ The court reasoned that it was necessary for merger to act as a bar to copyrightability in order to prevent parties from obtaining protection for items that belong in the public domain.¹⁰⁹

In *Kern River Gas Transmission Co. v. Coastal Corp.*,¹¹⁰ the Fifth Circuit held that Kern River’s maps for natural gas pipeline routes were not copyrightable.¹¹¹ The court’s concern was that providing copyright protection to a map describing the location of a pipeline would provide a monopoly to Kern River on the idea of locating a pipeline in a chosen area, due to the fact that there were so few ways to express that same idea.¹¹² Essentially, the court felt that by copyrighting the map, Kern River would have been copyrighting the pipeline location itself.¹¹³ This mirrors the issues raised by the *Morrissey* court, i.e., that ideas should not be removed from the public domain by providing copyright protection to an uncopyrightable idea.¹¹⁴ It also mirrors the outcome of *Morrissey*, since Kern River was required to prove that its maps did not merge, and it failed to make that showing.¹¹⁵

The Sixth Circuit voiced its concerns in *Lexmark International, Inc. v. Static Control Components, Inc.*¹¹⁶ In that case, the court ruled that Lexmark’s toner loading program, because it consisted of only eight program commands, was not copyrightable because its elements constituted *scenes a faire*, i.e., elements dictated by external constraints.¹¹⁷ Because Lexmark could only write its program

¹⁰⁸ *Id.* at 678-79

¹⁰⁹ *Id.*

¹¹⁰ 899 F.2d 1458 (5th Cir. 1990).

¹¹¹ *See id.* at 1464 (“The idea of the proposed location of a prospective pipeline is not copyrightable. The 1:250,000 maps consisted of lines representing the proposed location of the pipeline drawn on maps sold to the general public. Such map markings are certainly the only effective way to convey the idea of the proposed location of a pipeline across 1,000 miles of terrain. To extend protection to the lines would be to grant Kern River a monopoly of the idea for locating a proposed pipeline in the chosen corridor, a foreclosure of competition that Congress could not have intended to sanction through copyright law”).

¹¹² *Id.*

¹¹³ *Id.*

¹¹⁴ *See Morrissey v. Procter & Gamble Co.*, 379 F.2d 675, 679 (1st Cir. 1967).

¹¹⁵ *Kern River*, 899 F.2d at 1464.

¹¹⁶ 387 F.3d 522 (6th Cir. 2004).

¹¹⁷ *Id.* at 535-36 (“[W]hen external factors constrain the choice of expressive vehicle, the doctrine of ‘scènes à faire’ – ‘scenes,’ in other words, ‘that must be done’ – precludes copyright protection. In the literary context, the doctrine means that certain phrases that are ‘standard, stock, ... or that necessarily follow from a common theme or setting’ may not obtain copyright protection. In the computer-

commands exactly the way that it had written them there were no creative decisions involved and thus, no copyrightable subject matter at issue.¹¹⁸ Lexmark was unable to carry its burden of proof, and could not show that its program's content deserved copyright protection under *scenes a faire* or merger.¹¹⁹ As with all other majority decisions finding that these doctrines should operate as bars to copyrightability, the primary concern is preventing copyright protection from extending to material which belongs in the public domain,¹²⁰ an argument which the opposition simply talks past, as the discussion below indicates.

This counter-argument is led primarily by the Second Circuit, which handed down the opinion in *Kregos v. Associated Press*.¹²¹ In that decision, the court held that the alleged infringer's conduct, consisting of copying statistics compiled by the plaintiff on various baseball pitchers, was excused by the merger doctrine, because the information copied had merged with its expression.¹²² The doctrine thus acted as a defense to infringement, and the court did not invalidate the plaintiff's copyright.¹²³ The court's rationale for applying merger as a defense to infringement, requiring the defendant to make the showing, was that such application provides "a more detailed and realistic basis for evaluating the claim that protection of expression would inevitably accord protection to an idea."¹²⁴ Needless to say, this is a somewhat cryptic and circular rationale, and later, the court "confess[es] to some unease because of the risk that protection of selections of data, or, as in this case, categories of data,

software context, the doctrine means that the elements of a program dictated by practical realities—*e.g.*, by hardware standards and mechanical specifications, software standards and compatibility requirements, computer manufacturer design standards, target industry practices, and standard computer programming practices—may not obtain protection. As 'an industry-wide goal,' programming '[e]fficiency' represents an external constraint that figures prominently in the copyrightability of computer programs.") (internal citations omitted).

¹¹⁸ *Id.* at 535.

¹¹⁹ *Id.*

¹²⁰ *See id.* ("In these instances, copyright protection does not exist because granting protection to the expressive component of the work necessarily would extend protection to the work's uncopyrightable ideas as well.")

¹²¹ 937 F.2d 700 (2d Cir. 1991).

¹²² *See id.* at 709 ("If Kregos prevails at trial on the factual issues of originality and creativity, he will be entitled to protection only against infringement of the protectable features of his form. Only the *selection* of statistics might be entitled to protection Even as to the *selection* of statistics, if Kregos establishes entitlement to protection, he will prevail only against other forms that can be said to copy his selection.")

¹²³ *Id.* at 710.

¹²⁴ *Id.* at 705.

have the potential for according protection to ideas.”¹²⁵ In the end, however, merger is a defense to infringement in the Second Circuit.¹²⁶ The defendant has the burden of showing that his taking is excused as merged expression or *scenes a faire*, and in *Kregos*, the defendant successfully met that burden.¹²⁷

In *Reed-Union Corp. v. Turtle Wax, Inc.*,¹²⁸ a car polish manufacturer copied another manufacturer’s commercial, which showed a beat-up car getting polished, and then enduring an entire year without another polishing.¹²⁹ The Seventh Circuit held that the original commercial was copyrightable, but because the copier took material from the original that constituted *scenes a faire*, the copying was excused.¹³⁰ Essentially, the court held that while the ideas behind *scenes a faire* were not copyrightable, the expressions themselves were, and that it was thus problematic to try to classify *scenes a faire* as *per se* uncopyrightable.¹³¹ However, the court did not directly address the counter-arguments regarding the danger of taking material out of the public domain.¹³² Though burden shifting ought to be the crux of the argument, this case exemplifies how courts talk past each other and fail to address the real issue.

The lengthiest discussion arguing that defendants should bear the persuasive burden, however, is in a concurring opinion. Judge Feikens, in his *Lexmark* opinion, argues that merger ought to apply as a defense to infringement rather than as a bar to copyrightability, thus placing the burden on the defendant.¹³³ He reasons that this is so because “it is necessary to know what the potential infringer is doing with the material in order to know if merger has occurred.”¹³⁴ In considering *scenes a faire*, Judge Feikens does not believe that courts should apply the doctrine uniformly as a defense to infringement.¹³⁵

¹²⁵ *Id.* at 707.

¹²⁶ *E.g.*, *CCC Info. Servs., Inc. v. Maclean Hunter Mkt. Reports, Inc.*, 44 F.3d 61, 72 n.26 (2d Cir. 1994) (following *Kregos*); *Matthew Bender & Co., Inc. v. West Publ’g Co.*, 158 F.3d 674, 692 (2d Cir. 1998) (following *Kregos*).

¹²⁷ *Kregos*, 937 F.2d at 709.

¹²⁸ 77 F.3d 909 (7th Cir. 1996).

¹²⁹ *Id.* at 910-11.

¹³⁰ *Id.* at 914.

¹³¹ *Id.*

¹³² *See id.* at 913.

¹³³ *See Lexmark*, 387 F.3d at 557 (Feikens, J., concurring in part and dissenting in part) (“I would find the merger doctrine can operate only as a defense to infringement, ... and as such has no bearing on the question of copyrightability.”).

¹³⁴ *Id.*

¹³⁵ *See id.* at 559 (“[T]he position that *Stromback* [took is] that the *scènes à faire* doctrine determines copyrightability. Clearly, this panel is bound to follow the decision in *Stromback*. However, I believe that *Stromback* can and should be

At least in the context of computer programming, however, Judge Feikens would argue that *scenes a faire* should be a defense “because it is necessary to understand the circumstances of the copying in order to know whether or not the *scenes a faire* doctrine applies.”¹³⁶ Thus, Judge Feikens argues that, in the limited context of computer programming, both *scenes a faire* and merger apply best as defenses to infringement because it is necessary to know what the potential infringer is doing in order to determine if the doctrines are even applicable.¹³⁷ Such a limited application also fails, yet again, to take into account the importance of burden shifting.

In light of the chaos that courts have created in their application of the merger doctrine and *scenes a faire*, the need for a consistent standard becomes remarkably clear. The difference may so affect the court’s analysis and the legal theories invoked that, as the subsequent discussion will indicate, it is ultimately outcome-determinative.¹³⁸ Thus, a uniform application of both *scenes a faire* and merger is necessary to inject some certainty into the system.¹³⁹

III. THE BURDEN OF PROOF BELONGS WITH THE PLAINTIFF

After considering the sorry state in which courts find themselves, the necessity of a consistent application becomes clear. The burden shifting which occurs is absolutely critical in determining how *scenes a faire* and the merger doctrine should be applied, as it is probably the single most significant consequence. As the following discussion will indicate, these doctrines must be applied as bars to copyrightability, placing the burden on the plaintiff. In the first place, the quid pro quo exchange copyright law is designed to promote has been seriously damaged by the increased statutory protection afforded copyright owners, without asking for anything in return. Requiring plaintiffs to demonstrate that their work is protectable can go a long way toward restoring this critical balance. In addition, the statutory

distinguished in the area of computer programming.” (discussing *Stromback v. New Line Cinema*, 384 F.3d 283, 296 (6th Cir. 2004))).

¹³⁶ *Lexmark*, 387 F.3d at 560.

¹³⁷ *Id.* at 556-57, 559-60.

¹³⁸ Matthew J. Leary, *Welding the Hood Shut: The Copyrightability Of Operational Outputs and the Software Aftermarket in Maintenance and Operations*, 85 B.U. L. REV. 1389, 1432 (2005) (“If the merger doctrine prevents copyrightability, the DMCA would not apply, but if it is only a defense to infringement, it will provide no defense whatsoever against the DMCA [T]he outcome of a case ... might turn on such a fine point”).

¹³⁹ See *Lexmark*, 387 F.3d at 557 (Feikens, J., concurring in part and dissenting in part) (“[I]t is essential to decide whether merger ... determines the initial question of copyrightability of the work, or operates only as a defense to infringement.”).

language is fully in support of such a conclusion. Thus, application of these doctrines as a bar to copyrightability, with the burden of proof on the plaintiff, is the most sensible result.

A. *Though the Courts Are in Disarray, Burden of Proof Is the Key Consideration, and It Belongs with the Plaintiff*

The disagreeing courts in the discussion above¹⁴⁰ did not properly consider the degree to which burden of proof is a topic of concern for both parties. However, such a distinction is incredibly important because it shifts the court's focus either to the plaintiff's or defendant's work.¹⁴¹ If the court applies *scenes a faire* or merger as a bar to copyrightability, an evaluation of the defendant's work is initially unnecessary.¹⁴² The court will find itself evaluating only the plaintiff's work.¹⁴³ This is potentially a major problem for the plaintiff, in that the court will evaluate the work with a far more scrutinous eye than the Register of Copyrights ever did.¹⁴⁴ On the other hand, if the defendant must prove merger or *scenes a faire*, his work, not the plaintiff's, will be subject to scrutiny and the defendant will have the burden of proving a difficult concept.¹⁴⁵

¹⁴⁰ See discussion *supra* Part II.B.

¹⁴¹ See Timothy S. Teter, *Merger And The Machines: An Analysis Of The Pro-Compatibility Trend In Computer Software Copyright Cases*, 45 STAN. L. REV. 1061, 1075 (1993) (“[W]hen courts consider merger to be a question of substantial similarity, they tend to focus on the *defendant's* work, and the options available to the copier On the other hand, if merger is considered a question of copyrightability, courts tend to focus on the *plaintiff's* work, and the alternatives open to the plaintiff at the time she created it.”).

¹⁴² *Id.*

¹⁴³ *Id.*

¹⁴⁴ See *Kregos*, 937 F.2d at 716 n.7 (Sweet, J., concurring in part and dissenting in part) (“[T]he Register of Copyrights is not expected to determine whether to deny registration because of merger, as the fact of registration offers no more than prima facie evidence of copyrightability. Just as a plaintiff with a registered copyright may nevertheless be denied protection if the work lacks creativity, the presumption of validity arising out of registration may be overcome by proof to the court that the expression merges with the idea.”) (internal citations omitted); see also *Weissman v. Freeman*, 868 F.2d 1313, 1320 (2d Cir. 1989) (discussing the fact that copyright registration provides a presumption of copyright validity that merely shifts the burden of proof to the defendant, but does not require a heightened burden to be met).

¹⁴⁵ See Teter, *supra* note 141, at 1075 (“[W]hen courts consider merger to be a question of substantial similarity, they tend to focus on the *defendant's* work, and the options available to the copier.”); McGowan, *supra* note 5, at 2 (“It is easy for each side to poke holes in the other side's positions. It is hard for either side to make an affirmative, instrumental case for their views. For this reason, and because scholars favor consequentialist rhetoric, the debate often consists of competing narratives that use hunches and conjectures to link the result an author desires to the policy the

Courts will undertake a far more careful examination than the Register of Copyrights to determine whether the work meets the minimum requirements of the Copyright Act.¹⁴⁶ The Register of Copyrights, when issuing a copyright, does not consider the question of merger,¹⁴⁷ and thus, a work which merges will still acquire a copyright. However, if such a work finds its copyrightability questioned in court, judges with full knowledge and a mandate to properly evaluate a work are going to consider these questions.¹⁴⁸ Registration of copyright carries with it a presumption of validity.¹⁴⁹ However, this presumption can be easily overcome with a minor showing by the defendant, since the Register does not consider questions of merger or *scenes a faire*.¹⁵⁰ Thus, the presumption in favor of validity which registration creates is easily overcome if the defendant presents *any* evidence of merger or *scenes a faire*.¹⁵¹ In essence, the presumption of validity created by registration does not extend to a work which merges or consists of *scenes a faire*.¹⁵² The plaintiff will still have the burden of proof regarding the idea/expression dichotomy enforced by these doctrines.¹⁵³

On the other hand, focusing attention on the plaintiff can potentially work to the plaintiff's benefit. Some have evaluated merger based on the degree of freedom a plaintiff has in his expression.¹⁵⁴ Essentially, the argument is that the greater the number

author favors. Because the evidence in such arguments is so weak, the legal endgame is to place the burden of proof on the other side. Whoever has to prove the unprovable facts is likely to lose.”).

¹⁴⁶ See *supra* note 144.

¹⁴⁷ See *supra* note 144.

¹⁴⁸ See *supra* note 144.

¹⁴⁹ See 17 U.S.C. § 410(c) (2000) (“In any judicial proceedings the certificate of a registration made before or within five years after first publication of the work shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate.”).

¹⁵⁰ See *Kregos*, 937 F.2d at 716 n.7 (Sweet, J., concurring in part and dissenting in part) (“[T]he Register of Copyrights is not expected to determine whether to deny registration because of merger, as the fact of registration offers no more than prima facie evidence of copyrightability. Just as a plaintiff with a registered copyright may nevertheless be denied protection if the work lacks creativity, the presumption of validity arising out of registration may be overcome by proof to the court that the expression merges with the idea.”).

¹⁵¹ *Id.*

¹⁵² *Id.*

¹⁵³ *Id.*

¹⁵⁴ See *Dymow v. Bolton*, 11 F.2d 690, 691 (2d Cir. 1926) (“[I]f the same idea can be expressed in a plurality of totally different manners,” there is no merger.); *Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d 1240, 1253 (3d Cir. 1983) (In providing copyright protection to a work, “if other methods of expressing that idea are not foreclosed as a practical matter, then there is no merger.”).

of potential expressions that exist for an idea, the less probable it is that such expression will merge.¹⁵⁵ In such a situation, where the plaintiff is usually the original innovator of a particular expression, it is more likely that she can argue that a number of potential expressions were available to her at the time of creation.¹⁵⁶ A finding of merger will be less likely, and the court will uphold the validity of the plaintiff's copyright.¹⁵⁷ Nevertheless, requiring the plaintiff to prove that his work does not merge or consist of *scenes a faire* is a much greater concern than any benefit such a burden might bring.¹⁵⁸

When merger is a defense to infringement, the reverse situation is true. The court will evaluate the defendant's work, and specifically the material which he has taken.¹⁵⁹ Thus, the defendant will have the burden of proving that the material which he took from the plaintiff *does* merge or consist of *scenes a faire*, such that he was practically entitled to take it.¹⁶⁰

At the same time, much like in the first case, the defendant does still derive a benefit from this approach. Because an issue of copyright infringement exists, the defendant's work is already similar enough that the plaintiff is upset about it. He is suing, after all. The fact that similarity exists may be evidence of limitations imposed by

¹⁵⁵ See *supra* note 154.

¹⁵⁶ See Teter, *supra* note 141, at 1075 (“[I]f merger is considered a question of copyrightability, courts tend to focus on the *plaintiff's* work, and the alternatives open to the plaintiff at the time she created it. Since the plaintiff will often be the original interface innovator, she may be able to argue that when she created her work, she could have chosen from among a myriad of alternative forms of expression. Courts that focus solely on the wide range of expression available to the plaintiff may therefore be inclined to hold that idea and expression have *not* merged.”).

¹⁵⁷ *Id.*

¹⁵⁸ See discussion *supra* Part II.B.

¹⁵⁹ See *Lexmark*, 387 F.3d at 557-58 (Feikens, J., concurring in part and dissenting in part) (“[I]t is necessary to know what the potential infringer is doing with the material in order to know if merger has occurred The rationale for the merger doctrine is that without it, certain ideas or methods of operation would be removed from the public realm because all ways of expressing them would be copyrighted Under this reasoning, an individual who copied a poem solely to use as a password would not have infringed the copyright, because in that scenario, the alleged infringer would have the defense that the poem has ‘merged’ with a method of operation (the password). By contrast, someone who copied the poem for expressive purposes (for instance, as part of a book of poetry) would not have this defense. For these reasons, I would hold that in cases where the merger is with a method of operation, the merger doctrine should be applied as a defense to infringement only, and not as informing the question of copyrightability of the work itself.”).

¹⁶⁰ *Id.*

industry standards.¹⁶¹ In this situation, the plaintiff will be unable to protect such functionally limited elements in an infringement action.¹⁶² Essentially, a finding that those elements of the plaintiff's work copied by the defendant merged due to industry standards will be more likely, and use of those elements could not have been precluded in the first place.¹⁶³ Thus, from a standpoint focusing on the court's attention, applying merger and *scenes a faire* as defenses to infringement would seem to favor the defendant. However, on final consideration, merely placing the burden of proof on the defendant to show merger or *scenes a faire* is such a great burden that it overcomes any potential benefit.¹⁶⁴

In light of the above considerations, Professor Nimmer argues that courts should apply the merger doctrine and *scenes a faire* as defenses to infringement, placing the burden of proof on the defendant.¹⁶⁵ In recalling the degree of reliance courts have placed on Nimmer's treatise,¹⁶⁶ this point of view is incredibly influential.¹⁶⁷ However, Professor Nimmer has been known to err in the past.¹⁶⁸ This is one such case, because Professor Nimmer has not specifically considered the importance of the burden of proof. Since so much protection has been extended to copyright owners in recent years,

¹⁶¹ See Teter, *supra* note 141, at 1075 (“[W]hen courts consider merger to be a question of substantial similarity, they tend to focus on the *defendant's* work, and the options available to the copier. A court focusing on the defendant is more likely to find merger, since the defendant may have had no practical alternative to conforming to industry standards.”).

¹⁶² *Id.*

¹⁶³ *Id.*

¹⁶⁴ See discussion *supra* Part II.B.

¹⁶⁵ See NIMMER & NIMMER, *supra* note 17.

¹⁶⁶ See discussion *supra* INTRODUCTION.

¹⁶⁷ Bartow, *supra* note 14, at 591 (“The considerable number of citations to the Nimmer copyright treatise suggests it is widespread and commonplace for federal judges to depend on the treatise to articulate and support copyright law decisions.”).

¹⁶⁸ Consider, for example, the judiciary's general rejection of Professor Nimmer's approach to classifying works of joint authorship:

The lack of support in all likelihood stems from one of several weaknesses in Professor Nimmer's approach. First, Professor Nimmer's test is not consistent with one of the Act's premises: ideas and concepts standing alone should not receive protection Second, contribution of an idea is an exceedingly ambiguous concept. Professor Nimmer provides little guidance to courts or parties regarding when a contribution rises to the level of joint authorship except to state that the contribution must be “more than a word or a line.”

Erickson v. Trinity Theatre, Inc., 13 F.3d 1061, 1070 (7th Cir. 1994) (citation omitted).

these copyright owners ought to be required to provide a little bit more in order to satisfy the constitutional quid pro quo.

Whichever party bears the burden of proving *scenes a faire* or merger will have the most difficulty in an infringement action.¹⁶⁹ Though there are some minor counterarguments discussed above, the effect of burden shifting is such an important consideration for either party that it puts such counterarguments to rest. The biggest effect of applying *scenes a faire* or the merger doctrine as bars to copyrightability or defenses to infringement is that it decides who bears the burden of proof as to these highly abstract concepts. “Whoever has to prove the unprovable facts is likely to lose.”¹⁷⁰ Based on the discussion below regarding the importance of reestablishing the quid pro quo in copyright law, this burden must lie with the plaintiff.

B. The Quid Pro Quo Exchange in Copyright Law Has Been Lost, and Requiring Plaintiffs to Shoulder the Burden of Proof in Cases of Merger and Scenes a Faire Will Reestablish It

As discussed in Part I, the fundamental copyright policy is a quid pro quo exchange, where “[c]reative work is to be encouraged and rewarded.”¹⁷¹ Authors contribute their originality and creativity to society as a whole, and society rewards them with an exclusive right to their work.¹⁷² Based on this theory, as the amount of protection given to authors increases, one might expect that authors should contribute more as well. This has not been the case. Though “copyright protection has expanded, [and] each expansion has been accompanied by rhetoric championing the needs of the deserving author, emphasizing the need to induce creative activity,”¹⁷³ authors have not been asked to do anything more to obtain such protection.¹⁷⁴

¹⁶⁹ See discussion *supra* Part II.B.

¹⁷⁰ McGowan, *supra* note 5, at 2.

¹⁷¹ Twentieth Century Music Corp. v. Aiken, 422 U.S. 151, 156 (1975).

¹⁷² Stewart E. Sterk, *Rhetoric and Reality in Copyright Law*, 94 MICH. L. REV. 1197, 1207 (1996) (“By giving copyright protection to works of authorship, we increase the cost of copyright, raise the return on creative authorship, and, at the margin, encourage more people to create.”).

¹⁷³ *Id.* at 1199.

¹⁷⁴ See Albert Sieber, *The Constitutionality of the DMCA Explored: Universal City Studios, Inc. v. Corley & United States v. Elcom Ltd.*, 18 BERKELEY TECH. L.J. 7, 37 (2003) (“Originally, copyright was conceived as a bargain between authors and the public. In exchange for limited exclusive rights that would provide enough economic incentive for authors to create and distribute their works, the public was free to enjoy, consume, learn from, and reuse the works in any way outside of

While Professor Nimmer's approach to the merger doctrine and *scenes a faire* might have been correct in 1976, at the time of the present Copyright Act's enactment, times have changed. Since 1976, Congress has dramatically expanded copyright protection for owners.¹⁷⁵ For example, consider the Digital Millennium Copyright Act, which essentially provides a new, unprecedented cause of action for copyright owners against those who circumvent their security technology.¹⁷⁶ Another example is the Uruguay Round Agreements Act, which extends copyright protection to live, unrecorded performances of nondramatic musical works, where no such protection existed in the past.¹⁷⁷ Finally, the duration of copyright protection has been increased with almost no restraint in the last three decades, despite the fact that it was only increased twice in the first two hundred years of copyright protection.¹⁷⁸ It is time for us to expect a little more from authors in exchange for what they have been given.

In order to get a little more out of this exchange, Professor David Lange has argued that "courts ought to indulge at least a presumption against new claims It is not too much ... to erect barriers not to be hurdled by plaintiffs relying on casual proof. Important questions ought to be asked of the plaintiff who seeks to establish a prima facie case."¹⁷⁹ An outstanding opportunity to effect this goal is to require the plaintiff to prove that his work passes muster under *scenes a faire* and merger.

The current system gives so much to the plaintiff, yet asks so little.¹⁸⁰ Because of the difficulty of proving merger and *scenes a faire*,¹⁸¹ forcing the defendant to prove that his taking falls under these unprotected categories simply makes things too easy for the plaintiff. This line of reasoning very much parallels the arguments which were

copyright owner's enumerated rights. The last thirty years, however, have seen the propertization of copyright, resulting in broader, longer, or stronger copyright protection and greater control over the use of copyrighted materials. We now talk of copyright as property that the owner is entitled to control—to sell to the public (or refuse to sell) on whatever terms the owner chooses." (internal quotations omitted); see also JESSICA LITMAN, DIGITAL COPYRIGHT 77-79, 81-86 (2001).

¹⁷⁵ See *supra* note 20.

¹⁷⁶ 17 U.S.C. §§ 1201-1332 (2000).

¹⁷⁷ 19 U.S.C. § 3901 (2000).

¹⁷⁸ Lessig, *supra* note 43, at 1065 ("In the first hundred years of federal copyright's life in America, Congress changed that term just once. In the next fifty years, Congress changed that term once again. But in the last thirty-nine years, Congress has extended the terms of copyrights eleven times.").

¹⁷⁹ David Lange, *Recognizing the Public Domain*, 44 LAW & CONTEMP. PROBS. 147, 175 (1981).

¹⁸⁰ See *supra* note 20.

¹⁸¹ See discussion *supra* Part II.B.

raised when the Sonny Bono Copyright Term Extension Act¹⁸² (“CTEA”) was enacted in 1998. That act, which is yet another example of increased protection for plaintiffs, increased copyright duration to life of the author plus seventy years for most works.¹⁸³ At the time of adoption, there were those who argued that it was wrong for copyright owners to receive something for nothing, i.e., longer copyright duration for the same work, without doing anything.¹⁸⁴ Professor Lessig, arguing against adoption of the act, stated that “the Copyright Clause must mean something when it says terms must be limited [T]he simplest way to ... promote[] progress is to require that the power only be used in exchange for progress. In exchange, that is, for producing something that has not already been produced.”¹⁸⁵

Unfortunately, the Supreme Court upheld the CTEA in *Eldred v. Ashcroft*, holding that “[p]etitioners’ dominant series of arguments, premised on the proposition that Congress may not extend an existing copyright absent new consideration from the author, are unavailing.”¹⁸⁶ While at first glance it might seem that the Supreme Court rejected the bargain theory of copyright and its quid pro quo requirement, the real basis for the Court’s decision was that a quid pro quo is still required, but that the extension did not violate this quid pro quo because post-amendment copyright terms are still limited.¹⁸⁷ The decision represents deference to the policy decisions of Congress, while at the same time finding that there really is no constitutional barrier to copyright term extensions, so long as those extensions themselves are limited in duration.¹⁸⁸

Though *Eldred* was a resounding defeat for those who wanted to check Congress’ unbridled expansion of copyright protection and restore the quid pro quo policy, this article’s approach to the merger doctrine and *scenes a faire* presents a legitimate alternative to reestablish the balance. Unlike the CTEA, Congress has not specifically mandated that these doctrines act as defenses to infringement, and in fact, as Part III.C demonstrates below, it is quite arguable that Congress *wants* plaintiffs to shoulder the burden of proof with regard to these doctrines. Thus, any trip to the Supreme Court is likely to turn out more favorably than it did in *Eldred*.

¹⁸² 17 U.S.C. §§ 108, 203, 301-304 (2000).

¹⁸³ *Id.*

¹⁸⁴ Lessig, *supra* note 43, at 1066 (“When the Bono Act was enacted, there were many with a strong view about its [un]constitutionality.”).

¹⁸⁵ *Id.* at 1066-67.

¹⁸⁶ 537 U.S. 186, 189 (2003).

¹⁸⁷ *Id.* at 187-88.

¹⁸⁸ *Id.*

C. *Strict Statutory Construction of § 102(b) Demonstrates that the Idea/Expression Dichotomy Is a Bar to Copyrightability, Requiring Plaintiffs to Carry the Burden of Proof*

The Copyright Statute states that “[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.”¹⁸⁹ This wording suggests that courts should bar a work from copyright protection if its expression merges with its idea, and thus the plaintiff should be required to demonstrate that his work deserves protection.¹⁹⁰

If the plain language of the statute says “*in no case* does copyright protection ... extend to any idea,”¹⁹¹ how is it even possible to argue that merger and *scenes a faire* are anything other than bars to copyrightability (or that the plaintiff bears the burden of proof)? Under the canons of statutory interpretation, when the language of the statute is unambiguous, the plain meaning governs.¹⁹² Of course, like any canon, this is not followed without exception.¹⁹³ Nevertheless, according to 17 U.S.C. § 106, the rights of copyright owners are granted “[s]ubject to sections 107 through 121.”¹⁹⁴ Here, the plain language of the statute seems to suggest that these are clear limitations, rather than exceptions, to the rights granted to copyright owners. In essence, the limitations illustrated in §§ 107 through 122 are removed from the scope of the owner’s rights, and she is granted the residual rights articulated in § 106.¹⁹⁵ Thus, the copyright owner

¹⁸⁹ 17 U.S.C. § 102(b) (2000).

¹⁹⁰ See *Kregos*, 937 F.2d at 715 (2d Cir. 1991) (Sweet, J., concurring in part and dissenting in part) (“[T]he proper approach requires the court first to decide whether the copyrighted work satisfies the primary requirement of creativity, then to determine whether there is merger *before* extending copyright protection[,] ... based on the wording of § 102(b) of the Copyright Act.”).

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

¹⁹² *United States v. Am. Trucking Ass’ns*, 310 U.S. 534, 543 (1940) (“There is ... no more persuasive evidence of the purpose of a statute than the words by which the legislature undertook to give expression to its wishes. ... In such cases we have followed the[] plain meaning.”).

¹⁹³ 17 U.S.C. §§ 107-122 (2000). These limitations include fair use, reproduction by libraries and archives, exemptions for certain performances and displays, secondary transmissions, ephemeral recordings, and limitations on the scope of exclusive rights in pictorial, graphic, sculptural, and architectural works, among others. *Id.*

¹⁹⁴ *Id.* § 106.

¹⁹⁵ Gale R. Peterson, *Overview of Intellectual Property*, 762 PRAC. L. INST./PAT. 11, 80 (2003) (“In essence Congress in § 106 granted copyright owners broad exclusive rights, and then narrowed those rights in §§ 107-122 to varying degrees.”).

should have no basis to sue a potential infringer based on any of these rights, as they are removed from the protectable scope of copyright.

The Supreme Court has adopted an approach that is diametrically opposed to this interpretation, despite the statute's plain language.¹⁹⁶ In *Campbell v. Acuff-Rose Music*,¹⁹⁷ the Court held that fair use under § 107 of the Copyright Act is an affirmative defense to infringement, and thus an exception to, rather than a limitation of, the rights granted under § 106.¹⁹⁸ While this interpretation has been criticized by the Eleventh Circuit,¹⁹⁹ it is clearly stated in a United States Supreme Court opinion.²⁰⁰ The implication is that items enumerated in §§ 107-122 are not bars to copyrightability, and thus copying of the excepted content mentioned in those sections can still serve as the basis for the filing of an infringement action.²⁰¹ The burden is placed on the defendant to demonstrate that his conduct falls into one of the statutory categories as an affirmative defense; a considerable burden, as has been shown.²⁰²

While the Court in *Campbell* appears to acknowledge the approach suggested by the court in *Bateman*,²⁰³ namely, fair use's value as a right rather than affirmative defense,²⁰⁴ its argument for a

¹⁹⁶ See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 590 (1994) (“[F]air use is an affirmative defense” (citing *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 561 (1985); H.R. REP. NO. 102-836, at 3, n.3 (1992), reprinted in 1992 U.S.C.C.A.N. 2553, 2554)).

¹⁹⁷ 510 U.S. 569 (1994).

¹⁹⁸ See *id.* at 590 (“[F]air use is an affirmative defense”).

¹⁹⁹ See *Bateman v. Mnemonics, Inc.*, 79 F.3d 1532, 1542 n.22 (11th Cir. 1996) (“Although the traditional approach is to view ‘fair use’ as an affirmative defense, . . . it is better viewed as a right granted by the Copyright Act of 1976. Originally, as a judicial doctrine without any statutory basis, fair use was an infringement that was excused—this is presumably why it was treated as a defense. As a statutory doctrine, however, fair use is not an infringement. Thus, since the passage of the 1976 Act, fair use should no longer be considered an infringement to be excused; instead, it is logical to view fair use as a right.”).

²⁰⁰ *Campbell*, 510 U.S. at 590 (“[F]air use is an affirmative defense”); but see also Glynn S. Lunney, Jr., *Fair Use and Market Failure: Sony Revisited*, 82 B.U. L. REV. 975, 989 (2002) (“[I]n *Campbell*, the Court declared that [s]ince fair use is an affirmative defense, the burden of proving fair use rests on the defendant seeking its protection. In allocating the burden in this manner, Justice Souter failed even to mention *Sony's* contrary resolution of the issue. While the Court is, of course, free to reverse itself on this issue (or to limit *Sony's* allocation of the burden of proof to cases involving non-commercial uses), one would hope that the Court, at the very least, would recognize and acknowledge that it is reversing itself.”) (internal quotations and citations omitted).

²⁰¹ See *supra* note 200.

²⁰² See discussion *supra* Part II.B.

²⁰³ See *Bateman*, 79 F.3d at 1542 n.22.

²⁰⁴ *Campbell*, 510 U.S. at 575-76.

contrary interpretation is compelling. Specifically, in a discussion of the history of the fair use doctrine, the Court notes that Congress, when adopting the statute, did not intend to modify the judicial doctrine of fair use, but merely intended to codify it in existing form.²⁰⁵ The Court discusses the fact that ever since Justice Story's 1841 formulation of the fair use doctrine in *Folsom v. Marsh*,²⁰⁶ it has been an affirmative defense to copyright infringement.²⁰⁷ Since Congress did not intend to change anything, the fact that the statutory language appears to directly contradict the court's interpretation is irrelevant.

The conclusion that merger and *scenes a faire* cannot be anything but bars to copyrightability is suddenly less clear, despite an unambiguous statute. If the plain language of the statute can contradict its legislative intent, what can this mean for § 102(b), the statutory provision of the idea/expression dichotomy? One cannot deny that there is some common ground between the §§ 107-122 statutory exceptions and the idea/expression dichotomy. For example, congressional intent demonstrates that § 102(b), just like §§ 107-122, is a mere codification of existing case law rather than an explicit change in course.²⁰⁸ As Judge Sweet, a proponent of strict statutory interpretation of § 102(b), states in his *Kregos* concurrence, allowing idea/expression to be a defense to infringement "owes little if anything to the strictures of § 102(b), and instead depends on the fundamental principle of copyright law that independent creation is never infringement."²⁰⁹ Perhaps Judge Sweet has harmed his argument. If § 102(b) is a mere codification of existing case law, and it is a fundamental principle of existing case law that the idea/expression dichotomy is a defense to infringement, it would appear that despite the statute's plain language, Congress intended a contradictory meaning and courts must enforce it. This is the common ground between § 107 fair use and § 102(b).

²⁰⁵ See *id.* (stating that in codifying the fair use doctrine Congress meant "'to restate the present judicial doctrine of fair use, not to change, narrow, or enlarge it in any way,' and intended that courts continue the common-law tradition of fair use adjudication") (internal quotations omitted).

²⁰⁶ 9 F. Cas. 342 (C.C.D. Mass. 1841) (No. 4901).

²⁰⁷ *Campbell*, 510 U.S. at 575-76.

²⁰⁸ See H.R. REP. NO. 94-1476, at 57 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5670 ("Section 102(b) in no way enlarges or contracts the scope of copyright protection under the present law. Its purpose is to restate, in the context of the new single Federal system of copyright, that the basic dichotomy between expression and idea remains unchanged."); *Id.* at 66 ("Section 107 is intended to restate the present judicial doctrine of fair use, not to change, narrow, or enlarge it in any way.").

²⁰⁹ *Kregos*, 937 F.2d at 714-16 (Sweet, J., concurring in part and dissenting in part).

There are some highly relevant differences, however, which set § 102(b) apart from §§ 107-122, and reestablish it as a bar to copyrightability, placing the burden on the plaintiff. First, while legislative history ultimately played an important role in the interpretation and application of §§ 107-122,²¹⁰ the Supreme Court has held that legislative history should only play a role in statutory interpretation when the language of the statute is ambiguous.²¹¹ While the language in § 106 seems clear in its implications, § 102(b) is considerably more direct and less susceptible to differing interpretations.²¹² Section 102(b) states, “in no case does copyright protection extend ... to any idea,” period.²¹³ Section 106 states, “subject to sections 107 through 121, the owner of copyright under this title has the exclusive rights” guaranteed by copyright.²¹⁴ Based on this wording, § 106 is at least *open* to differing interpretations, while § 102(b) is not.

An additional consideration is the wording of § 106. One must wonder why it is not worded like this: “subject to sections 102(b), and 107 through 122.” The answer would seem to be because § 102(b) and the idea/expression dichotomy serve a different purpose, namely, to stand as a bar to copyrightable subject matter, requiring plaintiffs to bear the burden. Even if one uses legislative history to interpret § 102(b) despite its lack of ambiguity, which would leave existing case law unaffected,²¹⁵ prior case law regarding the idea/expression dichotomy provides little assistance.²¹⁶ The fact is, the difference of opinion courts have over its application is older than the 1976 statute, and does not present a clear right or wrong answer.²¹⁷

²¹⁰ See *Campbell*, 510 U.S. at 575-76 (stating that in codifying the fair use doctrine Congress meant “to restate the present judicial doctrine of fair use, not to change, narrow, or enlarge it in any way,” and intended that courts continue the common-law tradition of fair use adjudication”) (internal quotations omitted).

²¹¹ See *United Air Lines, Inc. v. McMann*, 434 U.S. 192, 199 (1977) (“[L]egislative history ... is irrelevant to an unambiguous statute.”).

²¹² Compare 17 U.S.C. § 102(b) (2000) (“[I]n no case does copyright expression ... extend to any idea.”) (emphasis added) with 17 U.S.C. § 106 (2000) (“Subject to sections 107 through 122, the owner of copyright under this title has the exclusive rights” of reproduction, distribution, etc.).

²¹³ 17 U.S.C. § 102(b).

²¹⁴ *Id.* § 106.

²¹⁵ See *supra* note 208.

²¹⁶ See *supra* note 3.

²¹⁷ Compare *Baker v. Selden*, 101 U.S. 99, 102 (1879) (holding that works full of ideas, such as medical treatises, could still be copyrightable, but that in a suit for infringement, the defendant’s copying of those ideas would not be infringement), with *Morrissey v. Proctor & Gamble Co.*, 379 F.2d 675, 679 (1st Cir. 1967) (holding that instructions for a sweepstakes contest were uncopyrightable per se because their idea merged with the expression of that idea).

In light of the legislative history of § 102(b), the proper application of the idea/expression dichotomy is clear.²¹⁸ Based on a strict construction of the statute, the merger doctrine and *scenes a faire* should act as bars to copyrightability, and plaintiffs should bear the burden of proof. Such an adoption promotes the fundamental policy objective of the copyright system by preventing plaintiffs from suing defendants for taking something to which they are entitled, and ensures that what is currently in the public domain is free for all to use without fear of a lawsuit. In addition, following the plain language of the statute would inject some much needed certainty into the copyright regime.

CONCLUSION

The federal circuit courts think they have a dispute on their hands right now, over whether the merger doctrine and *scenes a faire* ought to act as bars to copyrightability or defenses to infringement. These courts are not arguing about the same thing. The real question is whether these doctrines place the burden of proof on the plaintiff or the defendant. Because these doctrines are extraordinarily difficult to prove, where this burden lies can affect the parties' rights to a considerable degree. "Whoever has to prove the unprovable facts is likely to lose."²¹⁹

Professor Nimmer says that the burden ought to lie with the defendant. Though the professor may have been right in 1976, the situation has so changed that there are now compelling reasons to assign this burden explicitly to the plaintiffs. First of all, the statute says in its plain language that we must.²²⁰ Second, the quid pro quo exchange intended to further the fundamental policies of copyright has been lost.²²¹ Plaintiffs have so much protection right now thanks to protective legislation, yet are asked to give so very little. Requiring plaintiffs to carry the burden in cases of merger or *scenes a faire* is a very promising means to restore balance to the system, and is well supported by copyright's bargain theory, "the dominant theoretical approach to copyright."²²² Finally, the grand old goal of certainty is quite applicable here, as a consistent application of these doctrines will only help settle expectations.

²¹⁸ See *supra* note 208.

²¹⁹ See *supra* note 208.

²²⁰ See *supra* Part III.C.

²²¹ See *supra* Part III.B.

²²² Wilkinson, *supra* note 34.