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## Protecting the Public Domain and the Right to Use Copyrighted Works: Four Decades of the Eleventh Circuit's Copyright Law Jurisprudence

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## Protecting the Public Domain and the Right to Use Copyrighted Works: Four Decades of the Eleventh Circuit's Copyright Law Jurisprudence

### Cover Page Footnote

Georgia Athletic Association Professor in Law, University of Georgia School of Law. BA 1972 with Highest Honors in History, Oberlin College; JD 1975 University of Chicago Law School.

**PROTECTING THE PUBLIC DOMAIN AND THE  
RIGHT TO USE COPYRIGHTED WORKS: FOUR  
DECADES OF THE ELEVENTH CIRCUIT'S  
COPYRIGHT LAW JURISPRUDENCE**

*David E. Shipley\**

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The United States Courts of Appeals for the Second and Ninth Circuits are the nation's premier appellate courts on copyright law.<sup>1</sup> Leading copyright casebooks include many decisions from these courts on topics like the originality standard, works of authorship, exclusive rights, fair use, and ownership.<sup>2</sup> For example, the materials on copyright infringement typically cover the Second Circuit's abstractions test from *Nichols v. Universal Pictures Corp.*<sup>3</sup> and its bifurcated approach to substantial similarity from *Arnstein v. Porter*.<sup>4</sup> This coverage is typically followed by a comparison with the extrinsic/intrinsic test the Ninth Circuit used in *Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corp.*<sup>5</sup>

The Second and Ninth Circuits are the primary sources of much of our nation's copyright jurisprudence because of Hollywood and Broadway. The states of California and New York are the principal places of business for much of the entertainment, broadcasting, publishing, media, and technology industries.<sup>6</sup> With a combined population of almost 60 million people, they are our first and fourth most populous states.<sup>7</sup> They have high concentrations of creative people in the arts, literature, music, and entertainment.<sup>8</sup> Californians and New Yorkers are longstanding influencers of social and cultural trends, and readily shape public opinion.<sup>9</sup>

This Article, however, is not about the impact of the Second and Ninth Circuits on copyright law. Rather, it discusses the importance of the copyright law decisions from the U.S. Court of Appeals for the Eleventh Circuit. This

<sup>1</sup> Andrew Deutsch, *Substantial Similarity in Copyright: It Matters Where You Sue*, DLA PIPER (Dec. 22, 2020), <https://www.dlapiper.com/en/germany/insights/publications/2020/12/ipt-news-q4-2020/substantial-similarity-in-copyright/> (“The Second and Ninth Circuit Courts of Appeals are inarguably the most important circuits for copyright law developments.”). Of course, the United States Supreme Court has the last word.

<sup>2</sup> See, e.g., JEANNE C. FROMER & CHRISTOPHER JON SPRIGMAN, *COPYRIGHT LAW* (1st ed. 2019); CRAIG JOYCE ET AL., *COPYRIGHT LAW* (10th ed. 2016).

<sup>3</sup> *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121-22 (2d Cir. 1930).

<sup>4</sup> *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946).

<sup>5</sup> *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977). Compare JOYCE ET AL., *supra* note 2, at 664-82, with FROMER & SPRIGMAN, *supra* note 2, at 221-58.

<sup>6</sup> See Andrew Deutsch, *supra* note 1 (stating that it “is not surprising [that they are the most important circuits] since the industries that generate the most copyright disputes are located in New York (publishing, media) and California (entertainment, software/gaming)”).

<sup>7</sup> California is the most populous state with almost 40 million people, and New York comes in fourth with nearly 20 million. *US States - Ranked by Population 2021*, WORLD POPULATION REVIEW, <https://worldpopulationreview.com/states> (last visited Nov. 5, 2021).

<sup>8</sup> See generally Zannie Giraud Voss, *The Top 40 Most Arts-Vibrant Communities in America (2019)*, SMU DATAARTS, <https://culturaldata.org/pages/arts-vibrancy-index-2019/> (last visited Jan. 21, 2021).

<sup>9</sup> *Top Ten Most Important U.S. States*, TOP TENS, <https://www.thetoptens.com/most-important-us-states/> (last visited Jan. 27, 2021).

circuit is important for many reasons, including South Beach, Peachtree Street, Muscle Shoals, barbeque, and college football. The combined populations of Alabama, Florida, and Georgia are over 36 million.<sup>10</sup> These states are racially, ethnically, and culturally diverse;<sup>11</sup> and, the music, film, entertainment, media, and technology industries in the region are booming.<sup>12</sup> The musical heritage of Georgia alone includes R.E.M., James Brown, Otis Redding, Little Richard, Ludacris, and the Robert Shaw Chorale.<sup>13</sup> Georgia has become “Hollywood East,” where *Deliverance*, *The Blind Side*, and *Black Panther* were filmed along with *The Walking Dead*, *Stranger Things*, and *Ozark*.<sup>14</sup> Cox Media Group, CNN, TNT, and Tyler Perry Studios are prominent media companies based in Atlanta.<sup>15</sup> The diverse creative culture in these states gives rise to copyright infringement litigation in their federal courts. The U.S. Court of Appeals for the Eleventh Circuit reviews the decisions rendered by the federal district courts in these states.<sup>16</sup>

The Eleventh Circuit turned 40 in 2021.<sup>17</sup> This court has rendered many influential copyright law decisions in the last four decades. This Article discusses this court’s decisions in several areas. First, this Article reviews the originality standard. Second, it explores the application of the U.S. Supreme Court’s *Feist*

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<sup>10</sup> *QuickFacts*, U.S. CENSUS BUREAU, <https://www.census.gov/quickfacts/fact/table/FL,GA,AL/PST045219> (last visited Jan. 21, 2021).

<sup>11</sup> Adam McCann, *Most & Least Diverse States in America*, WALLETHUB (Sept. 21, 2021), <https://wallethub.com/edu/most-least-diverse-states-in-america/38262>.

<sup>12</sup> See, e.g., *Georgia Ranked No. 1 in Film Production by Business Facilities Magazine*, GA. USA (July 20, 2020), <https://www.georgia.org/newsroom/press-releases/georgia-ranked-no-1-film-production-business-facilities-magazine>.

<sup>13</sup> *List of 163 Musicians – Georgia Music Hall of Fame Inductees*, GEORGIA MUSIC HALL OF FAME AND EDUCATION RESOURCES, <https://gamusichall.com/inductee-list/> (last visited Jan. 21, 2021).

<sup>14</sup> *Georgia Filmography*, EXPLORE GA., <https://www.exploregeorgia.org/filmography> (last visited Oct. 15, 2021).

<sup>15</sup> Olivia McClure, *24 Media Companies Making Atlanta the Epicenter of Entertainment*, BUILT IN, <https://builtin.com/atlanta/media-companies-in-atlanta> (last updated Sept. 30, 2021); *Contact*, TYLER PERRY STUDIOS, <https://tylerperrystudios.com/contact/> (last visited Oct. 15, 2021).

<sup>16</sup> Our nation’s federal courts have exclusive subject matter jurisdiction over copyright infringement claims. 18 U.S.C. § 1338(a). The three states in the Eleventh Circuit along with Mississippi, Louisiana, and Texas, were originally part of the Fifth Circuit, but they split off to form the Eleventh Circuit on October 1, 1981. Fifth Circuit Court of Appeals Reorganization Act of 1980, Pub. L. No. 96-452, 94 Stat. 1994. Fifth Circuit decisions from before the split are considered binding precedent in the Eleventh Circuit. *Bonner v. City of Prichard*, 661 F.2d 1206, 1207 (11th Cir. 1981) (en banc) (holding that all decisions of the “old Fifth” Circuit handed down prior to the close of business on September 30, 1981, are binding precedent in the Eleventh Circuit).

<sup>17</sup> See *Bonner*, 661 F.2d at 1207 (September 30, 1981 was the last day of business for the old Fifth Circuit so the ‘new’ Eleventh Circuit turned 40 on October 1, 2021).

decision to compilations, directories, computer software, architectural works, and other creative works like movies, photographs, and characters. Third, this Article analyzes copyright protection for unfixed works. Fourth, it examines the scope of the government edicts doctrine. Fifth, this Article discusses the fair use doctrine.

The Eleventh Circuit's many decisions evidence a consistently rigorous application of the originality standard, the principles announced in the Supreme Court's *Feist* decision, section 102(b) of the Copyright Act, *scènes à faire*, and the merger doctrine. Thanks to this rigorous analysis, the court carefully separates the copyrightable expression from the unprotected elements in works of authorship. The court's decisions also interpret and apply fair use generously in the contexts of tensions between copyright and the First Amendment, parody, and the use of protected works in education.

The Eleventh Circuit's copyright jurisprudence adheres consistently to the following fundamental principles. First, the circuit always applies the principle that everyone is free to use whatever is in the public domain.<sup>18</sup> Second, the circuit abides by the principle that copyright protection only extends to creative expression and not to ideas, facts, *scènes à faire*, and those elements of a work that are standard, routine, commonplace, or dictated by efficiency.<sup>19</sup> Third, the Eleventh Circuit stands by the principle that rewarding to the author is a secondary consideration because the primary beneficiary of copyright is the public.<sup>20</sup> Fourth, the circuit follows the principle that the use of a work and the use of a copyright are distinct in that one may use a work's unprotected elements without infringing copyright.<sup>21</sup> The Eleventh Circuit has thus protected the public domain and everyone's right to use the unprotected elements in a copyrighted work of authorship over the last 40 years.

## I. THE ORIGINALITY STANDARD

Shortly before the creation of the Eleventh Circuit in 1981, the old Fifth Circuit decided *Miller v. Universal City Studios, Inc.*<sup>22</sup> This ruling remains important

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<sup>18</sup> See *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 231 (1964); *Compro Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 237-238 (1964); David E. Shiple, *Congressional Authority over Intellectual Property Policy After Eldred v. Ashcroft: Deference, Empty Limitations, And Risks to the Public Domain*, 70 ALB. L. REV. 1255, 1256-57 (2007).

<sup>19</sup> See *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 363 (1991); *Bateman v. Mnemonics, Inc.*, 79 F.3d 1532, 1542 (11th Cir. 1996).

<sup>20</sup> See *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984) (stating that copyright law makes reward to the author a secondary consideration); *Feist*, 499 U.S. at 349 ("The primary objective of copyright is not to reward the labor of authors, but '[t]o promote the Progress of Science and useful Arts.'" (quoting U.S. CONST. art. I, § 8, cl. 8)).

<sup>21</sup> See *Bateman*, 79 F.3d at 1542 n.23 (citing L. Ray Patterson, *Understanding Fair Use*, 55 LAW & CONTEMP. PROBS. 249, 259, 264 (1992)).

<sup>22</sup> *Miller v. Universal City Studios, Inc.*, 650 F.2d 1365 (5th Cir. 1981).

precedent in the Eleventh Circuit,<sup>23</sup> and the U.S. Supreme Court cited *Miller* in its landmark *Feist* decision in 1991 for the proposition that the originality requirement is the very “premise of copyright law.”<sup>24</sup> The court of appeals also rejected the sweat of the brow rationale for extending copyright protection to an author’s research.<sup>25</sup> The court said that protection for directories, compilations, and other fact works is based on the originality of the compiler’s selection and arrangement of factual material, and not on the compiler’s industriousness in gathering the material.<sup>26</sup> The U.S. Supreme Court’s influential *Feist* decision reinforced the court of appeals’ explanations for not protecting research and rejecting sweat of the brow.<sup>27</sup>

Gene Miller, a reporter for the *Miami Herald*, wrote a book about a young woman abducted from an Atlanta motel and buried alive in a wood and fiberglass capsule for 83 hours while her abductors sought a ransom. The victim collaborated with Miller who spent more than 2500 hours investigating, researching, interviewing, and writing the book. It was titled *83 Hours Till Dawn* and published in 1971. A producer for Universal read a condensed version of the book in *Reader’s Digest* and thought it would make a good television movie. This producer gave a copy of the book to a screenwriter. Universal negotiated with Miller for movie rights, but the deal fell through. A screenwriter was then told to write the screenplay without using the book. The resulting movie, *The Longest Night*, was the Movie of the Week on ABC. Miller sued for copyright infringement, and a jury awarded him \$200,000.<sup>28</sup>

The major issue on appeal was whether the trial court erred by instructing the jury that research was copyrightable.<sup>29</sup> A critical sentence in the instruction stated: “Moreover, if an author, in writing a book concerning factual matters, engages in research on those matters, his research is copyrightable.”<sup>30</sup> The plaintiff testified about his extensive research. The plaintiff’s attorney’s opening and closing statements touched on the plaintiff’s research and said it was copyrightable. The trial court viewed “the labor and expense of the research involved in the obtaining of those uncopyrightable facts as distinct from those facts and more similar to the expression of the facts than to the facts

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<sup>23</sup> See *supra* text accompanying note 16.

<sup>24</sup> *Feist*, 499 U.S. at 347 (quoting *Miller*, 650 F.2d at 1368).

<sup>25</sup> *Miller*, 650 F.2d at 1372.

<sup>26</sup> *Id.* at 1369. This rationale for protection was repeated by the U.S. Supreme Court a decade later in *Feist*, 499 U.S. at 362-63.

<sup>27</sup> *Feist*, 499 U.S. at 359-60.

<sup>28</sup> *Miller*, 650 F.2d at 1367. For a complete version of the facts and the evidence presented at trial, see *Miller v. Universal City Studios, Inc.*, 460 F. Supp. 984 (S.D. Fla. 1978), *rev’d* 650 F.2d 1365 (5th Cir. 1981). See also David E. Shipley & Jeffrey S. Hay, *Protecting Research: Copyright, Common-Law Alternatives, and Federal Preemption*, 63 N.C. L. REV. 125, 146-48 (1984).

<sup>29</sup> *Miller*, 650 F.2d at 1367-68.

<sup>30</sup> *Id.* at 1372.

themselves.”<sup>31</sup> The ‘research is copyrightable’ theory was central to the outcome of the trial.<sup>32</sup>

The court of appeals stated that “[t]he issue is not whether granting copyright protection to an author’s research would be desirable or beneficial, but whether such protection is intended under the copyright law.”<sup>33</sup> It rejected protecting research because of the labor of the researcher/compiler. The court acknowledged the difficulty of distinguishing other decisions about compilations and directories that appeared to base protection on an industrious collection rationale, but stated, “copyright in a directory . . . is properly viewed as resting on the originality of the selection and arrangement of the factual material, rather than on the industriousness of the efforts to develop the information.”<sup>34</sup>

The court of appeals noted that the Second Circuit had twice rejected the argument that research was copyrightable.<sup>35</sup> The court also said that copyright’s distinction between protected expression and unprotectable facts balanced the public’s interest in encouraging creative activity with the need for unrestrained access to information. The court emphasized that this careful balance could not be maintained if research was copyrightable.<sup>36</sup> The court of appeals explained that

[t]here is no rational basis for distinguishing between facts and the research involved in obtaining facts. To hold that research is copyrightable is no more or no less than to hold that the facts discovered as a result of research are entitled to copyright protection. . . . [T]he law is clear that facts are not entitled to such protection. We conclude that the district court erred in instructing the jury that research is copyrightable.<sup>37</sup>

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<sup>31</sup> *Id.* at 1369 (quoting *Miller v. Universal City Studios, Inc.*, 460 F. Supp. 984, 987 (S.D. Fla. 1978), *rev’d* 650 F.2d 1365 (5th Cir. 1981)) (discussing the trial court’s order denying the plaintiff’s motion for a new trial). The trial court believed that authors like the plaintiff would not undertake the research required for a book like his account of the kidnapping only to have a movie company be able to appropriate the fruits of that research so easily.

<sup>32</sup> *Miller*, 650 F.2d at 1372.

<sup>33</sup> *Id.* at 1369.

<sup>34</sup> *Id.* See also *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 363-64 (1991) (using similar language a decade later to explain how to reconcile copyright protection for compilations with the principle that facts are not copyrightable).

<sup>35</sup> *Miller*, 650 F.2d at 1370-72 (first citing *Rosemont Enters., Inc. v. Random House, Inc.*, 366 F.2d 303 (2d Cir. 1966); and then citing *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972 (2d Cir. 1980)).

<sup>36</sup> *Id.* at 1371-72.

<sup>37</sup> *Id.* at 1372.

The U.S. Supreme Court cited the *Miller* decision in *Feist*<sup>38</sup> and rejected the industrious collection rationale for protecting compilations.<sup>39</sup> The high court followed the court of appeals in *Miller* in explaining that copyright protection depended on a compiler's creativity in selecting, coordinating, or arranging unprotectable facts and data.<sup>40</sup>

The Eleventh Circuit's 2020 decision in *Vallejo v. Narcos Productions LLC* shows the vitality of the *Miller* decision after almost 40 years. The court held that Netflix's popular series, *Narcos*, did not infringe two chapters from Virginia Vallejo's memoir.<sup>41</sup> The plaintiff's book recounted her close relationship with the drug trafficker Pablo Escobar.<sup>42</sup> She alleged that episode 103 of *Narcos* infringed material from her chapter titled "The Caress of a Revolver" and that episode 104 infringed material from her chapter titled "That Palace in Flames."<sup>43</sup> The defendants admitted copying and argued that the only similarities between the episodes and her chapters were unprotectable facts.<sup>44</sup> The trial judge agreed and granted summary judgment for the defendants because the scenes in *Narcos* did not copy any protectable expression.<sup>45</sup> The works were not substantially similar, so there was no infringement as a matter of law.<sup>46</sup>

The Eleventh Circuit's review was *de novo*, with the court having to decide whether there was substantial similarity between the scenes in *Narcos* and copyrightable elements in the two chapters from the plaintiff's memoir.<sup>47</sup> The court noted that it had affirmed summary judgment in infringement cases where it was clear that the moving party was entitled to judgment as a matter of law.<sup>48</sup>

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<sup>38</sup> *Feist*, 499 U.S. at 360 (quoting *Miller*, 650 F.2d at 1369-70).

<sup>39</sup> *Id.* at 360-61.

<sup>40</sup> *Id.* at 348.

<sup>41</sup> *Vallejo v. Narcos Prods. LLC*, 833 F. App'x 250 (11th Cir. 2020) (per curiam); Lee S. Brenner, *Eleventh Circuit Says Netflix Series Does Not Infringe Copyrighted Memoir*, VENABLE LLP (Jan. 11, 2021), <https://www.closeupsblog.com/2021/01/eleventh-circuit-says-netflix-series-does-not-infringe-copyrighted-memoir/#page=1>; Frank D'Angelo & Nathalie Russell, *Vallejo v. Narcos Productions LLC*, LOEB & LOEB LLP (Oct. 27, 2020), <https://www.loeb.com/en/insights/publications/2020/11/vallejo-v-narcos-productions-llc>.

<sup>42</sup> *Vallejo*, 833 F. App'x at 252 (referencing a memoir titled *Amando a Pablo, Odiando a Escobar* (*Loving Pablo, Hating Escobar*) that describes her affair with Escobar and the rise of the Colombian drug cartels).

<sup>43</sup> *Id.* at 254. "The Caress of a Revolver" describes an intimate encounter between the plaintiff and Escobar in which he used a gun to caress her. *Id.* at 252-53. Episode 103 had a similar sexual scene. *Id.* at 252. "That Palace in Flames" chapter involves a meeting between the plaintiff, Escobar, and a leader from M-19, a Colombian guerrilla group. *Id.* Episode 104 portrays a similar meeting. *Id.*

<sup>44</sup> *Vallejo v. Narcos Prods. LLC*, 415 F. Supp. 3d 1144, 1146, 1151 (S.D. Fla. 2019).

<sup>45</sup> *Id.* at 1154.

<sup>46</sup> *Id.* at 1152-54.

<sup>47</sup> *Vallejo v. Narcos Prods. LLC*, 833 F. App'x 250, 256-57 (11th Cir. 2020) (per curiam).

<sup>48</sup> *Id.* at 256.

Since the defendant admitted copying, the appellate court, like the trial court, had to determine if the appropriation of material from the memoir was actionable.<sup>49</sup>

The *Miller* decision was relevant to the court's analysis and its comparison of the respective scenes in the *Narcos* episodes and the chapters in the memoir. Ms. Vallejo acknowledged that "the facts reported in her memoir are true."<sup>50</sup> Since facts do not enjoy copyright protection, the plaintiff's copyright covered "the way that she set her 'characters, theme, plot, setting, and mood and pace.'"<sup>51</sup> The court affirmed because the challenged scenes in *Narcos* copied only unprotected facts, and were not substantially similar to the copyrightable aspects of the plaintiff's memoir.<sup>52</sup> The court's opinion includes thorough analyses and comparisons of the two chapters from the plaintiff's memoir and the two episodes from *Narcos*.<sup>53</sup>

Vallejo also argued unsuccessfully that the trial court erred by failing to distinguish between historical and non-historical facts in determining the scope of copyright protection for her memoir. The plaintiff contended that non-historical facts are personal and protectable by copyright.<sup>54</sup> According to the court, this distinction was not legally sound.<sup>55</sup> The court noted that the Supreme Court had stated in *Feist* that "facts—scientific, historical, biographical, and news of the day" do not receive copyright protection.<sup>56</sup> Like its decision against extending copyright protection to research in *Miller*, the Eleventh Circuit declined to distinguish between historical and non-historical facts for purposes of copyright protection.<sup>57</sup> The scope of copyright for fact works like historical accounts, biographies, news reports, and memoirs is very thin in the Eleventh Circuit due to *Miller v. Universal City Studios, Inc.* and *Vallejo v. Narcos Productions LLC* as reinforced by the Supreme Court's *Feist* decision.

## II. THE ELEVENTH CIRCUIT'S RIGOROUS APPLICATION OF *FEIST*

The Supreme Court focused on the copyrightability of a telephone company's standard white pages directory in *Feist*.<sup>58</sup> Justice O'Connor explained why the directory did not meet the constitutional and statutory requirements for protection. She defined an original work of authorship as one that is

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<sup>49</sup> *Id.* at 256-57.

<sup>50</sup> *Id.* at 257 (quoting *Miller v. Universal City Studios, Inc.*, 650 F.2d 1365 (5th Cir. 1981)).

<sup>51</sup> *Id.* at 258.

<sup>52</sup> *Id.* at 259-60.

<sup>53</sup> *Vallejo*, 833 F. App'x at 258-60.

<sup>54</sup> *Id.* at 260.

<sup>55</sup> *Id.* at 260-61.

<sup>56</sup> *Id.* (quoting *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 347-48 (1991)).

<sup>57</sup> *Id.* at 260-61. The court also declined to apply a modified substantial similarity test for comparing works in different media such as plaintiff's book and defendant's film.

<sup>58</sup> *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 356-59 (1991) (explaining that the plaintiff's directory had been copied by the publisher of an area-wide directory).

independently created, and that evidences at least a minimal level of creativity.<sup>59</sup> Most works can satisfy this standard because they will possess some creative spark.<sup>60</sup> The Court defined creativity in *Feist* by negative example, describing how an author's preparation of a compilation like a directory or a catalog might not satisfy the creativity requirement: selections and arrangements that are mechanical, routine, commonplace, typical, garden variety, obvious, inevitable, or dictated by law will often fail to pass muster.<sup>61</sup> The Court also rejected the industrious collection rationale for protecting compilations, directories, and other low authorship works.<sup>62</sup>

In view of the U.S. Supreme Court's approval and citation of *Miller v. Universal City Studios, Inc.* in *Feist*, it is not surprising that the Eleventh Circuit has been rigorous, and at times aggressive,<sup>63</sup> in its subsequent application of *Feist*'s principles to directories, computer software, architecture, and other works of creative authorship. The court has acknowledged that a typical yellow pages directory, or a software program for providing insurance premium quotes, or plans for a four-bedroom residence are entitled to copyright protection. At the same time, the court has consistently and carefully parsed these works to eliminate unprotectable elements like ideas, facts, and *scènes à faire*. Due to such parsing, the scope of copyright protection for these works is often very thin in the Eleventh Circuit. This rigorous dissection of works of authorship protects the public domain and everyone's right to use the unprotected elements in those works.

#### A. COMPILATIONS – DIRECTORIES, CATALOGS, AND OTHER LOW AUTHORSHIP WORKS

The Eleventh Circuit's very careful approach to identifying the copyrightable elements in a work of authorship took root in *BellSouth Advertising & Publishing Corp. v. Donnelley Information Publishing Inc.*<sup>64</sup> This litigation started in the late 1980s before the Supreme Court issued the *Feist* decision.<sup>65</sup> The parties stipulated that BellSouth's yellow pages directory, considered as a whole, qualified for copyright protection. The defendant had not copied the text or the graphics of BellSouth's ads; it had not used BellSouth's typeface; and, it had not photocopied or

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<sup>59</sup> *Id.* at 345 (stating that “a slight amount [of creativity] will suffice”).

<sup>60</sup> *Id.*

<sup>61</sup> See Howard B. Abrams, *Originality and Creativity in Copyright Law*, 55 LAW & CONTEMP. PROBS. 3, 16 (1992). See also David E. Shipley, *Thin But Not Anorexic: Copyright Protection for Compilations and Other Fact Works*, 15 J. INTELL. PROP. L. 91, 92-93 (2007).

<sup>62</sup> *Feist*, 499 U.S. at 359-61. The industrious collection rationale is also called the sweat of the brow rationale for protection. *Id.* at 352.

<sup>63</sup> JOYCE ET AL., *supra* note 2, at 247 n.7.

<sup>64</sup> *Bellsouth Advert. & Publ'g Corp. v. Donnelley Info. Publ'g, Inc.*, 999 F.2d 1436 (11th Cir. 1993).

<sup>65</sup> See generally Shipley, *Thin But Not Anorexic*, *supra* note 61, at 101-03.

reproduced the page-by-page arrangement or appearance of the directory.<sup>66</sup> Rather, defendant Donnelley stipulated that it obtained from each listing in BellSouth's directory the telephone number, name, address, kind of business, and unit of advertising for the subscriber. Donnelley's copying was established by its inclusion of erroneous listings taken from BellSouth's competing directory.<sup>67</sup> Donnelley took a free ride on BellSouth's industrious collection of a substantial amount of the information that went into the yellow pages. The fundamental issue was whether the defendant had copied protectable expression.<sup>68</sup>

According to the district court, which granted summary judgment, Donnelley infringed BellSouth.<sup>69</sup> The Eleventh Circuit initially affirmed,<sup>70</sup> saying that copyright protection "extends to the selection, coordination and arrangement which comprises an original format of the compilation work," and that "there must be a substantial appropriation of the original format of the compilation to constitute the copying of protected material."<sup>71</sup> The court determined that BellSouth had performed several acts of selection in creating its yellow pages by coordinating all the informational components into complete business listings, and then arranging these listings in an original format.<sup>72</sup> It stated that the lower court was correct in concluding that defendant had "expropriated the essence of [BellSouth's] compilation."<sup>73</sup>

The Supreme Court decided *Feist* shortly after this ruling, and then BellSouth's victory was subsequently vacated by a grant of a rehearing en banc.<sup>74</sup> Judge Stanley Birch, writing for the court, stated, "we are called upon to apply *Feist Publications* . . . which addressed copyright protection for a 'white pages' telephone directory, to resolve the infringement claims presented to us concerning a directory of a different color."<sup>75</sup>

The court concluded that BellSouth's decisions about what to include in the yellow pages, such as determining the directory's geographic scope, setting the closing date for changes, and its marketing techniques to generate the data, did

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<sup>66</sup> *Bellsouth*, 999 F.2d at 1438 & 1445.

<sup>67</sup> *Id.* at 1439.

<sup>68</sup> *Id.* at 1438.

<sup>69</sup> *Bellsouth Advert. & Publ'g Corp. v. Donnelley Info. Publ'g, Inc.*, 719 F. Supp. 1551 at 1563 & 1569 (S.D. Fla. 1988).

<sup>70</sup> *Bellsouth*, 999 F.2d at 952-53, *aff'g* 719 F. Supp. 1551 (S.D. Fla. 1988), *vacated and reh'g en banc granted by* 999 F.2d 1435 (11th Cir. 1993).

<sup>71</sup> *Id.* at 957.

<sup>72</sup> *Id.* at 957-58 (citing *Bellsouth*, 719 F. Supp. at 1557-58).

<sup>73</sup> *Id.* at 959.

<sup>74</sup> *Bellsouth*, 999 F.2d at 1436 (11th Cir. 1992).

<sup>75</sup> *Bellsouth*, 999 F.2d at 1438 (holding written by Judge Birch and joined by Judges Tjoflat, Fay, Edmondson, Black and Carnes, whereas Judge Hatchett dissented, and Judges Kravitch, Anderson, Cox and Dubina abstained from the decision).

not meet the required level of originality. Rather, they were techniques for the discovery of facts, not acts of authorship.<sup>76</sup>

Any useful collection of facts, however, will be structured by a number of decisions regarding the optimal manner in which to collect the pertinent data in the most efficient and accurate manner. If this were sufficient, then the protection of copyright would extend to census data, cited in *Feist* as the paradigmatic example of a work that lacks the requisite originality.<sup>77</sup>

The court next concluded that BellSouth's coordination and arrangement of the yellow pages was not copyrightable.<sup>78</sup> Although these pages required "somewhat more organization and arrangement than the white pages," this was not enough. BellSouth "did not deviate from the arrangement of the typical business directory, which employs an alphabetical list of headings to describe the various types of business and then alphabetizes the listings under the appropriate headings."<sup>79</sup>

Although it was conceivable that there could be other ways to arrange the yellow pages, the plaintiff's copyright in its arrangement failed due to the merger principle.<sup>80</sup> The merger of idea and expression prevents copyright protection for otherwise original expression if there are only a few ways to communicate the underlying idea.<sup>81</sup> According to the court, it was irrelevant that there could have been "some imaginable, although manifestly less useful, method of arranging business telephone listings" because the relevant issue was whether BellSouth's arrangement demonstrated originality.<sup>82</sup> Here again, the plaintiff failed to show originality because its arrangement was typical – widely used in the industry.<sup>83</sup> The contents of yellow pages vary from town to town, but the basic arrangement stays the same.

Similarly, the court decided that BellSouth's heading structure was not protectable because many headings were obvious such as Attorneys, Banks, and Brake Services.<sup>84</sup> For the same reason, protection could not extend to arrangements like dividing churches by denomination, attorneys by specialty, and doctors by practice areas. In addition, some headings were not just standard but

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<sup>76</sup> *Id.* at 1441.

<sup>77</sup> *Id.* (citing *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 347-48 (1991)).

<sup>78</sup> *Id.* at 1442.

<sup>79</sup> *Id.*

<sup>80</sup> *Id.*

<sup>81</sup> See *Morrissey v. Proctor & Gamble Co.*, 379 F.2d 675, 678-79 (1st Cir. 1967).

<sup>82</sup> *Bellsouth*, 999 F.2d at 1442-43.

<sup>83</sup> *Id.*

<sup>84</sup> *Id.* at 1444.

also recommendations from the National Yellow Pages Association.<sup>85</sup> Finally, subscribers could select the heading under which their information would appear from several options which meant that much of BellSouth's heading structure was not original.<sup>86</sup>

In short, the substantial similarity between BellSouth's and Donnelley's directories was due to the use of common facts, typical unprotected arrangements, and the alphabetization of listings under standard and unprotected classifications.<sup>87</sup> Donnelley "did not . . . appropriate *whatever original elements* might arguably inhere in the" BellSouth directory.<sup>88</sup> The Eleventh Circuit reversed the trial court's grant of summary judgment and entered judgment for Donnelley.<sup>89</sup> Copyright protection for BellSouth's directory as a whole extended only to prevent wholesale reproduction.<sup>90</sup>

Copyright protection did not extend to the facts (names, addresses, and phone numbers) in the white pages or to alphabetizing subscribers' names with their telephone numbers, according to the *Feist* decision. The Eleventh Circuit in *BellSouth* extended *Feist's* principles to a yellow pages directory which is a more complex work of authorship than the white pages. The court precluded copyright protection for BellSouth's approach to selecting the facts and data about the customers and businesses it listed, its typical arrangement of that information, its standard heading structure, and its alphabetization of the facts and data about those businesses and customers.<sup>91</sup>

The Eleventh Circuit applied *Feist* rigorously again in *Warren Publishing, Inc. v. Microdos Data Corp.*<sup>92</sup> The defendant's *Cable Access* software package allegedly infringed substantial sections of Warren's *Television & Cable Factbook*.<sup>93</sup> The appropriated sections comprised 1,340 pages of data on 8,413 cable systems.<sup>94</sup> The lower court granted summary judgment for Warren, ruling that its principal community system for presenting the information was copyrightable,<sup>95</sup> but the Eleventh Circuit vacated and remanded while expanding on what it said in *BellSouth* about satisfying the originality standard.<sup>96</sup>

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<sup>85</sup> *Id.*

<sup>86</sup> *Id.* at 1442.

<sup>87</sup> *BellSouth Advert. & Publ'g Corp. v. Donnelley Info. Publ'g, Inc.*, 999 F.2d 1436, 1442, 1444-45 (11th Cir. 1993).

<sup>88</sup> *Id.* at 1445 (emphasis added).

<sup>89</sup> *Id.* at 1446.

<sup>90</sup> *Id.* at 1438.

<sup>91</sup> In contrast, the Second Circuit upheld the copyright on a classified business directory for New York City's Chinese American community in *Key Publications, Inc. v. Chinatown Today Publishing Enterprises, Inc.*, 945 F.2d 509 (2d Cir. 1991).

<sup>92</sup> *Warren Publ'g, Inc. v. Microdos Data Corp.*, 115 F.3d 1509 (11th Cir. 1997).

<sup>93</sup> *Id.* at 1513.

<sup>94</sup> *Id.* at 1511.

<sup>95</sup> *Id.* at 1513-14.

<sup>96</sup> *Id.*

The defendant did not deny that the plaintiff's Factbook, considered as a whole, was entitled to copyright protection as a compilation. Instead, it challenged the lower court's finding that Warren's system for selecting the communities for listing data was sufficiently creative to be copyrightable.<sup>97</sup> The Factbook's information included the name, address, and telephone number of each cable system operator; the number of its subscribers; the channels it offered; the price of the service; and the type of equipment it used. The arrangement of the entries was listed state-by-state in alphabetical order, and the communities with cable service in each state were listed in alphabetical order.<sup>98</sup>

The information for each system, however, was not under the name of every community it served because many cities and towns were in multi-community systems. Repeating all the data under each community would have been duplicative and added to the publication's bulk. Instead, the plaintiff determined that one community would be the principal one served by a particular company, and all of the data about that company was listed under that community. There were cross-references to that principal community in the entries for the other cities and towns served by that cable operator.<sup>99</sup> The district court said this system for the selecting communities was original in the industry and a copyrightable part of the compilation's format. "[T]he selection of those communities was creative and protectable because Warren uses a unique system in selecting the communities that will be represented in the Factbook."<sup>100</sup>

The Eleventh Circuit held that this conclusion was in error because section 102(b) of the Copyright Act excludes protection for ideas, processes, procedures, and systems regardless of how they are expressed.<sup>101</sup> The court said that "[i]f Warren actually does employ a system to select the communities to be represented in the book, then section 102(b) . . . bars the protection of such a system."<sup>102</sup> It did not matter that defendant Microdos used that system.<sup>103</sup> Moreover, even if Warren's selection of communities was not based on a system, the company's decisions about which communities to include still would not be copyrightable because there was nothing to show that Warren exercised any judgment or creativity in determining which cable systems to include.<sup>104</sup> The court said that the plaintiff

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<sup>97</sup> *Id.* at 1516 n.18.

<sup>98</sup> *Id.* at 1512-13.

<sup>99</sup> *Id.* at 1516. The court used the Georgia section of the book as an example. Atlanta was designated the principal community for an operator and then other cities served by that operator in the region were cross referenced such as Alpharetta, Avondale Estates, Clarkston and so on. *Id.* at 1512 n.3.

<sup>100</sup> *Id.* at 1516 (quoting the district court ruling).

<sup>101</sup> *Id.* at 1517 (citing 17 U.S.C. § 102(b)).

<sup>102</sup> *Id.* at 1517.

<sup>103</sup> *Id.* at 1517 n.21.

<sup>104</sup> *Id.* at 1518.

*included the entire relevant universe known to it.* The only decision that it made was that it would not list separately information for each community that was part of a multi-community cable system; in other words, it decided to make the Factbook commercially useful. Therefore, it cannot prevail in its claim that it “selected” which communities to include in its Factbook.<sup>105</sup>

By including all communities, Warren did not satisfy the modicum of creativity required for a protectable selection of information. The court also said that the idea of organizing by the principal community could be expressed in only a few ways, so Warren’s organization of the cable system data merged with the underlying idea of cross-referencing.<sup>106</sup> The “people for whom [the directory is] produced are not interested in having information repeated under every community served by a multiple-community system.”<sup>107</sup> Finally, even if Warren’s selection of principal communities was creative and copyrightable, its claim for protection still failed because it did not make the actual selections. The record showed that the cable operators themselves determined, in the case of multi-community systems, the city or town under which the facts for their entire system would be listed.<sup>108</sup>

The Eleventh Circuit severely limited copyright protection for BellSouth’s yellow pages and Warren’s directory of cable systems, but it upheld an infringement verdict for a detailed multiple listings service for yachts in *BUC International Corp. v. International Yacht Council Ltd.*<sup>109</sup> The plaintiff’s service (BUCNET) was a centralized directory of yacht listings enabling yacht brokers to access a wealth of information about vessels.<sup>110</sup> BUCNET utilized a standard form and format that brokers used to submit information regarding the yachts.<sup>111</sup> The plaintiff selected and arranged the format’s section headings that appeared on a computer screen, and the headings included categories like accommodations and layout, overview, vessel walkthrough, galley/laundry, electronics and navigation, hull, construction, sails and rigging, and several other classifications.<sup>112</sup> The defendants set up a competing computerized listing service that replicated 4,400 listings from BUCNET.<sup>113</sup> The plaintiff’s claim concerned the defendants’ appropriation of their categories and headings—their template—

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<sup>105</sup> *Warren*, 115 F.3d at 1518 (emphasis added) (footnote omitted).

<sup>106</sup> *Id.* at 1518 n.27.

<sup>107</sup> *Id.* at 1518 n.27.

<sup>108</sup> *Id.* at 1519-20.

<sup>109</sup> *BUC Int’l Corp. v. Int’l Yacht Council Ltd.*, 489 F.3d 1129 (11th Cir. 2007).

<sup>110</sup> *Id.* at 1134.

<sup>111</sup> *Id.*

<sup>112</sup> *Id.* at 1134-35.

<sup>113</sup> *Id.* at 1137.

and not the use of the information entered by brokers on that template.<sup>114</sup> The trial court denied the defendants' motions for judgment as a matter of law, and the jury returned a verdict for BUCNET with an award of damages.<sup>115</sup>

The defendants' appeal echoed language from *BellSouth* and *Warren* regarding the originality of the plaintiff's listing service.<sup>116</sup> They asserted that the yacht brokers were the real authors of the selection and arrangement, that the merger doctrine precluded protection for the selection of the section headings, and that the overall selection and arrangement lacked creativity.<sup>117</sup> The Eleventh Circuit responded that in only two percent of the plaintiff's 4,667 listings had the brokers modified the plaintiff's format, so there was no merit to the defendants' contention that the brokers were the real authors of the compilation.<sup>118</sup> The defendants' merger argument failed because the court said there were many ways to select and organize information about yachts in a listing service.<sup>119</sup> Testimony about how the plaintiff selected and structured the categories also evidenced sufficient creativity to warrant the trial court's denial of the defendants' motion for judgment as a matter of law.<sup>120</sup>

The defendants also argued that the jury should have been instructed that works like directories needed to be 'virtually identical' in order to find infringement and that the trial court erred in its substantial similarity instruction.<sup>121</sup> The Eleventh Circuit found no error. It said that the substantial similarity standard applied to the alleged infringement of factual compilations.<sup>122</sup> The court recognized that "it is the original selection and arrangement of the collected data that bears legal significance for factual compilations"<sup>123</sup> and concluded that the plaintiff presented the jury with substantial claims for infringement of the selection, order, and arrangement of the compilation, in particular the categories and section headings.<sup>124</sup>

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<sup>114</sup> See Shipley, *Thin But Not Anorexic*, *supra* note 61, at 123 n.257.

<sup>115</sup> *BUC Int'l*, 489 F.3d at 1138. About 65 percent of defendants' listings were from the BUCNET listings.

<sup>116</sup> See *supra* text accompanying notes 75–108.

<sup>117</sup> *BUC Int'l*, 489 F.3d at 1142.

<sup>118</sup> *Id.*

<sup>119</sup> *Id.* at 1144 (stating the defendants defined the idea too narrowly, and the general idea about presenting information about boats to brokers could be expressed in a variety of ways. The defendants could use terms like hull, galley, sails, and rigging, but not in the same manner as the plaintiff). *Id.* at 1141–42.

<sup>120</sup> *Id.* at 1145.

<sup>121</sup> *Id.* The jury was told that it could find infringement if there were substantial similarities between the original elements of BUC's compilation and the corresponding elements of the defendants' compilation.

<sup>122</sup> *BUC Int'l*, 489 F.3d at 1149.

<sup>123</sup> *Id.* at 1148 (citing *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 348 (1991)).

<sup>124</sup> *Id.* at 1148–49 (stating that there was no error in the instruction).

The clear message from these decisions is that the Eleventh Circuit requires a strict application of *Feist's* principles to compilations like directories, catalogs, and other low authorship works. By carefully scrutinizing works to make sure that copyright does not extend to facts, ideas, and other unprotectable elements, the Eleventh Circuit, as in its *Miller v. Universal City Studios, Inc.* ruling as reinforced by *Feist*, is demanding proof of authorship in the compiler's selection, coordination, or arrangement of facts, ideas, and information. What is standard, routine, obvious, or customary does not pass muster, and the court is not reluctant to turn to § 102(b) and the merger doctrine to limit protection. Here again, the court is protecting the public domain and everyone's right to use those elements in a work of authorship that are not protected by copyright.

#### B. SOFTWARE INFRINGEMENT AND *FEIST*

The Eleventh Circuit's software infringement decisions exhibit the same rigorous analysis of copyrightability and the scope of protection as seen in the court's compilation and directory decisions. In *Bateman v. Mnemonics, Inc.*,<sup>125</sup> the court adopted the Second Circuit's influential "abstractions-filtration-comparison" test for the substantial similarity analysis from *Computer Associates International, Inc. v. Altai, Inc.*<sup>126</sup> This rigorous test, driven in large part by *Feist*,<sup>127</sup> is summarized by the Second Circuit as follows:

In ascertaining substantial similarity under this approach, a court would first break down the allegedly infringed program into its constituent structural parts. Then, by examining each of these parts for such things as incorporated ideas, expression that is necessarily incidental to those ideas, and elements that are taken from the public domain, a court would then be able to sift out all non-protectable material. Left with a kernel, or possible kernels, of creative expression after following this process of elimination, the court's last step would be to compare this material with the structure of an allegedly infringing program. The result of this comparison will determine whether the protectable elements of the programs

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<sup>125</sup> *Bateman v. Mnemonics, Inc.*, 79 F.3d 1532, 1532 (11th Cir. 1996).

<sup>126</sup> *Comput. Assocs. Int'l v. Altai, Inc.*, 982 F.2d 693 (2d Cir. 1992). The U.S. District Court for the Middle District of Georgia adopted the *Altai* test in *CMAX/Cleveland, Inc. v. UCR, Inc.*, 804 F. Supp. 337, 354 (M.D. Ga. 1992). The court found infringement in what was a "clear case of software cloning." Mark L. Gordon, *Copying to Compete: The Tension Between Copyright Protection and Antitrust Policy in Recent Non-Literal Computer Program Copyright Infringement Cases*, 15 J. COMPUT. & INFO. L. 171, 186-87 (1996).

<sup>127</sup> *Altai*, 982 F.2d at 711-12.

at issue are substantially similar so as to warrant a finding of infringement.<sup>128</sup>

The Second Circuit announced and applied this test in a case involving the defendant's non-literal copying of the plaintiff's program.<sup>129</sup> The Eleventh Circuit extended this test to literal or verbatim copying in *Bateman* when it held that a trial court's jury instruction, limiting the *Altai* test to non-literal elements, was misleading.<sup>130</sup> The court emphasized the importance of distinguishing between protectable expression and unprotectable methods of operation in a computer program, and the need to exclude those unprotectable methods and processes from the scope of copyright.<sup>131</sup> The plaintiff has to show that the defendant actually used protectable original elements from its work.<sup>132</sup> According to the Eleventh Circuit, the filtration analysis in the *Altai* test "should eliminate from comparison the unprotectable elements of ideas, processes, facts, public domain information, merger material, *scenes a faire* material, and other unprotectable elements . . . ."<sup>133</sup>

The challenged instruction, limiting the *Altai* test to non-literal copying, was seen as a manifest distortion and misstatement of the law because "the jury must have concluded that any instances of literal copying of Bateman's code . . . were by definition acts of copyright infringement."<sup>134</sup> The jury should have considered challenges to the originality of those portions of the plaintiff's code that were actually copied.<sup>135</sup> After all, copying unprotected elements from a work is not infringement.<sup>136</sup> "In other words, the fact-finder should be required, even in a literal copying case, to consider the defendant's challenges to the scope of plaintiff's copyright . . . ."<sup>137</sup>

The *Bateman* decision has been criticized because extending *Altai* "outside the non-literal arena further demonstrates the erosion of copyright protection available for computer software."<sup>138</sup> It is doubtful that this critique troubles the Eleventh Circuit. The court also stated that

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<sup>128</sup> *Id.* at 706.

<sup>129</sup> *Id.* at 721.

<sup>130</sup> *Bateman*, 79 F.3d at 1546.

<sup>131</sup> *Id.* at 1541 n.21.

<sup>132</sup> *Id.* at 1541.

<sup>133</sup> *Id.* at 1545 (quoting *Gates Rubber Co. v. Bando Chem. Indus., Ltd.*, 9 F.3d 823, 834 (10th Cir. 1993)).

<sup>134</sup> *Id.*

<sup>135</sup> *Id.*

<sup>136</sup> *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 351 (1991). *See also* L. Ray Patterson, *Understanding Fair Use*, 55 LAW & CONTEMP. PROBS. 249, 259, 264 (1992) (distinguishing between using the work and using the copyright).

<sup>137</sup> Gordon, *supra* note 126, at 185.

<sup>138</sup> Gordon, *supra* note 126, at 185.

[e]ven if the *Altai* test is limited to nonliteral copying, however, a parallel type of analysis must be undertaken in examining alleged instances of literal copying of computer code or screen displays. Whether one chooses to call the consideration of such generally recognized challenges to literal code copying as merger and efficiency “filtration” is of little consequence; what matters is that these well-established “defenses” are considered.<sup>139</sup>

In short, even if the plaintiff proves that there was verbatim copying of its code in the Eleventh Circuit, the defendant will not be liable if it can show that the code it copied is not copyrightable.

Another Eleventh Circuit software infringement decision from 1996 that applied the *Altai* test thoroughly is *MiTek Holdings, Inc. v. Arce Engineering Co.*<sup>140</sup> The trial court used *Altai*'s abstractions and filtration steps to determine that only five protectable elements remained in the plaintiff's program.<sup>141</sup> Even though four elements in the defendant's program were substantially similar, the court denied the plaintiff's motion for a preliminary injunction.<sup>142</sup> It determined that the copying of these elements was too insignificant in the context of the plaintiff's overall program to constitute infringement.<sup>143</sup> The Eleventh Circuit affirmed, agreeing that the defendant's copying of these protected elements was *de minimis* and not actionable.<sup>144</sup> The court stated that “[t]he burden is on the copyright owner to demonstrate the significance of the copied features, and, in this case, MiTek has failed to meet that burden.”<sup>145</sup> This statement underscores the court's demanding application of *Altai* and the principles announced in *Feist* to restrict the scope of copyright protection for software.<sup>146</sup>

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<sup>139</sup> *Bateman v. Mnemonics, Inc.*, 79 F.3d 1532, 1545 (11th Cir. 1996) (footnote omitted).

<sup>140</sup> *MiTek Holdings, Inc. v. Arce Eng'g Co.*, 89 F.3d 1548 (11th Cir. 1996).

<sup>141</sup> *Id.* at 1559.

<sup>142</sup> *Id.* at 1550, 1559.

<sup>143</sup> *MiTek Holdings, Inc. v. Arce Eng'g Co.*, 864 F. Supp. 1568, 1584 (S.D. Fla. 1994).

<sup>144</sup> *MiTek Holdings, Inc. v. Arce Eng'g Co.*, 89 F.3d 1548, 1560 (11th Cir. 1996).

<sup>145</sup> *Id.*

<sup>146</sup> *Gordon*, *supra* note 126, at 184-186. Notwithstanding the Eleventh Circuit's strict application of the *Altai* test and the principles from *Feist*, it is possible for the owner of copyright in a computer program to win an infringement claim in the Circuit. For example, the plaintiff can win if the alleged infringer is unable to meet its burden of demonstrating lack of originality or to show that the plaintiff's work is unworthy of copyright protection. *See, e.g.*, *Montgomery v. Noga*, 168 F.3d 1282, 1289-90 (11th Cir. 1999) (upholding jury verdict of copyright infringement against the defendant's arguments that the plaintiff's copyright was invalid); *Cable/Home Comm'n Corp. v. Network Prods., Inc.*, 902 F.2d 829, 851-54 (11th Cir. 1990) (holding that defendants' infringement of plaintiffs' encryption software that gave

The Eleventh Circuit discussed the *Bateman* and *MiTek* decisions in 2020 in *Compulife Software, Inc. v. Newman*, and clarified the allocation of the burden of proof in software infringement litigation.<sup>147</sup> Both parties provided insurance premium quotes electronically. Compulife alleged that the defendant obtained its copyrighted code by misrepresentation and that it had a hacker ‘scrape’ protectable data from its server.<sup>148</sup> The parties consented to a bench trial before a magistrate judge who determined that the copyright in Compulife’s HTML code was valid but that it had failed to prove its infringement claim.<sup>149</sup>

The Eleventh Circuit said that since the defendant’s copying of Compulife’s program was established, the question was whether the copied elements were “protected expression and of such importance to the copied work that the appropriation is actionable.”<sup>150</sup> This statement is consistent with the court’s earlier statement in *MiTek* regarding *de minimis* copying.<sup>151</sup> The court added that “[i]n most cases, a ‘substantial similarity’ between the allegedly offending program and the protectable, original elements of the copyrighted work establishes actionable copying.”<sup>152</sup> It said this analysis is both qualitative and quantitative, and is undertaken only after the unprotectable parts of the plaintiff’s work are set aside in the *Altai* test’s filtration step.<sup>153</sup> Here again, the court repeated principles it announced in *Bateman* and *MiTek*.<sup>154</sup> Copying unprotectable elements in a program is not actionable.

However, the court found several errors in how the magistrate judge applied the *Altai* test. That judge said the plaintiff had the burden to prove that the elements of the code copied by the defendant were protectable. This ruling was an error. The Eleventh Circuit stated

[a]lthough we haven’t previously done so, we now clarify that after an infringement plaintiff has demonstrated that he holds a valid copyright and that the defendant engaged in factual

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non-subscribers access to plaintiffs’ works was willful, direct, and contributory infringement and not a fair use).

<sup>147</sup> *Compulife Software Inc. v. Newman*, 959 F.3d 1288 (11th Cir. 2020).

<sup>148</sup> *Id.* Compulife also asserted a trade secret claim under Florida law. Valerie Sanders, *Defendant Must Prove That Copied Portion of Copyrighted Work Is Unprotectable*, EVERSHEDES SUTHERLAND (May 29, 2020), <https://www.11thcircuitbusinessblog.com/2020/05/defendant-must-prove-that-copied-portion-of-copyrighted-work-is-unprotectable/>.

<sup>149</sup> *Compulife*, 959 F.3d at 1288. The magistrate judge also held that Compulife failed to prove its trade secret claim.

<sup>150</sup> *Id.* at 1302.

<sup>151</sup> See *supra* text and notes accompanying notes 140–46.

<sup>152</sup> *Compulife*, 959 F.3d at 1302 (quoting *Bateman v. Mnemonics, Inc.*, 79 F.3d 1532, 1542 (11th Cir. 1996)).

<sup>153</sup> *Id.* at 1302-03.

<sup>154</sup> See *supra* text and notes accompanying notes 129–46 (discussing the *Bateman* and *MiTek* decisions from 1996).

copying, the *defendant* bears the burden of proving—as part of the filtration analysis—that the elements he copied from the copyrighted work are *unprotectable*.<sup>155</sup>

This clarifying statement is consistent with the *Bateman* decision, and the importance of considering the defendant’s arguments that the portions of the code it copied are unprotectable due to merger, *scenes a faire*, the application of section 102(b) of the Copyright Act, or other well-established defenses.<sup>156</sup> In other words, once the plaintiff has shown copying, the burden shifts to the defendant to demonstrate that the work it copied is unprotectable or otherwise unworthy of copyright protection.<sup>157</sup>

In addition, the court in *Compuserve* ruled that the magistrate judge erred by analyzing ‘substantiality’ by reference to the infringing work, rather than by reference to the copyrighted work. “The law is clear that both the quantity of the appropriation and the qualitative importance of the appropriated portion are properly judged by their significance to the copyrighted work, not their significance to the allegedly infringing work.”<sup>158</sup> This statement is consistent with the court’s earlier statement in *MiTek* that the plaintiff has the burden of showing that the protectable portions of code copied by a defendant had more than *de minimis* significance.<sup>159</sup>

In summary, the Eleventh Circuit, like most circuits, utilizes the ‘abstractions-filtration-comparison’ test announced by the Second Circuit in *Altai* to analyze software infringement claims.<sup>160</sup> The Eleventh Circuit extended this test to instances of literal copying as well as non-literal copying.<sup>161</sup> This application of the test means that even if the plaintiff shows verbatim copying of elements of its software, the defendant can try to show that those copied elements are not copyrightable.<sup>162</sup> In addition, the burden is on the plaintiff to show the significance of the copied elements. *De minimis* copying is not actionable.<sup>163</sup>

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<sup>155</sup> *Compulife*, 959 F.3d at 1305 (emphasis in original).

<sup>156</sup> See *supra* text and notes accompanying notes 129–39 (discussing how the court applied these limitations on the scope of copyright protection in *Bateman*).

<sup>157</sup> *Bateman*, 79 F.3d at 1541.

<sup>158</sup> *Compulife*, 959 F.3d at 1308. In addition, the court said that the magistrate judge failed to state sufficient findings and conclusions to permit meaningful review. *Id.* at 1308-09.

<sup>159</sup> See *supra* text and notes accompanying notes 140–46 (discussing the *MiTek* decision and the court’s requirement that the plaintiff/copyright owner show that the defendant had copied more than a *de minimis* amount of protected expression).

<sup>160</sup> *Bateman*, 79 F.3d at 1544; JOYCE ET AL., *supra* note 2, at 712 n.8 (stating that the Third Circuit still clings to *Whelan*).

<sup>161</sup> *Bateman*, 79 F.3d at 1545; JOYCE ET AL., *supra* note 2, at 713 n.10.

<sup>162</sup> *Bateman*, 79 F.3d at 1545.

<sup>163</sup> *MiTek Holdings, Inc. v. Arce Eng’g Co.*, 89 F.3d 1548, 1560 (11th Cir. 1996).

However, the alleged infringer bears the burden of showing that the elements it copied are not protectable or are otherwise unworthy of copyright protection.<sup>164</sup>

C. FEIST AND THE SCOPE OF COPYRIGHT PROTECTION FOR ARCHITECTURAL WORKS

Congress enacted the Architectural Works Copyright Protection Act (AWCPA) in 1990 which changed the copyright status of architecture in the United States.<sup>165</sup> This legislation established architectural works as a new category of protectable subject matter in section 102(a)(8) of the Copyright Act. It defined an architectural work as “the design of a building, as embodied in any tangible medium of expression, including a building, architectural plans, or drawings. *The work includes the overall form as well as the arrangement and composition of spaces and elements in the design, but does not include individual standard features.*”<sup>166</sup> The legislative history explains that the phrase “arrangement and composition of spaces and elements in the design” recognizes that creativity often includes an architect’s “selection, coordination, or arrangement of unprotectible elements into an original, protectable whole” and the incorporation of “new, protectable design elements into otherwise standard, unprotectable building features.”<sup>167</sup>

This language about architects selecting, coordinating, and arranging elements is similar to the Copyright Act’s definition of a compilation as “a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a

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<sup>164</sup> *CompuLife*, 959 F.3d at 1303. *See also* Google LLC v. Oracle Am., Inc., 141 S. Ct. 1183, 1197-200 (2021) (explaining that the Court assumed for argument’s sake that the Sun Java API fell within the definition of that which can be copyrighted, and then acknowledged, in discussing the importance of fair use, that the scope of protection for software and other functional works was thin); *SCOTUS Rules in Favor of Google in Landmark Copyright Case*, COOLEY LLP (Apr. 8, 2021), <https://www.cooley.com/news/insight/2021/2021-04-08-scotus-rules-in-favor-of-google-in-landmark-copyright-case>.

<sup>165</sup> Architectural Works Copyright Protection Act, Pub. L. No. 101-650, 104 Stat. 5089, 5133 (1990); David E. Shipley, *The Architectural Works Copyright Protection Act at Twenty: Has Full Protection Made a Difference?*, 18 J. Intell. Prop. Law 1, 3 (2010) (stating that The Copyright Act of 1909 did not include architectural works such as plans, blueprints, and models as copyrightable subject matter, and the 1976 Act did not mention architectural works either). *See generally* Marshall A. Leaffer, UNDERSTANDING COPYRIGHT LAW 134 (6th ed. 2014); David E. Shipley, *Copyright Protection for Architectural Works*, 37 S.C. L. Rev. 393, 395 (1986). Congress recognized that expanding protection for architecture would “stimulate excellence in design, thereby enriching our public environment in keeping with the constitutional goal.” H.R. REP. NO. 101-735, at 13 (1990).

<sup>166</sup> 17 U.S.C. § 101 (emphasis added).

<sup>167</sup> H.R. REP. NO. 101-735, at 18 (1990); *see also* 17 U.S.C. § 101 (interior design/architecture can be protected as well).

whole constitutes an original work of authorship.”<sup>168</sup> The Supreme Court in *Feist* described the scope of protection for compilations as thin,<sup>169</sup> and there have been many decisions applying the AWCPA showing that copyright protection for architectural works is often limited.<sup>170</sup> This lean copyright means that the architect/plaintiff ordinarily will have to prove close to verbatim copying of protected expression in order to win.<sup>171</sup> An architect’s thin copyright is due to several factors. These factors include the functionality of most buildings; the lack of protection for individual standard features as specified in the statute; application of the idea/expression dichotomy; the impact of the *scènes a faire* doctrine; and treating an architect’s arrangement and composition of design features like a compilation.<sup>172</sup> This rigorous application of the AWCPA resulting in thin protection for architectural works is especially clear in several Eleventh Circuit decisions.

*Intervest Construction, Inc. v. Canterbury Estate Homes, Inc.* involved litigation over floor plans for homes with four bedrooms.<sup>173</sup> The plaintiff’s architectural work was copyrightable, but the trial court said that given the dissimilarities with respect to the coordination of non-original, commonplace, and elementary components, no reasonable observer could conclude that the works were substantially similar.<sup>174</sup> The court of appeals upheld summary judgment for the defendant.<sup>175</sup> It said that the requisite creativity for copyrightable architecture was analogous to that required for a compilation; the architect’s selection, coordination, or arrangement of standard features may together constitute a protectable whole.<sup>176</sup> Although the plaintiff’s work satisfied this low threshold, the court said there was no infringement because the parties coordinated the unprotectable components differently.<sup>177</sup> It also noted that when the scope of copyright protection is thin, the substantial similarity inquiry is narrow.<sup>178</sup> In essence, the offending work had to be virtually identical to the plaintiff’s work

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<sup>168</sup> 17 U.S.C. § 101. *See also* 17 U.S.C. § 103(b) (explaining that a compilation’s copyright is limited to only the material contributed by the author, as opposed to the preexisting material used in the work).

<sup>169</sup> *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349 (1991).

<sup>170</sup> Shipley, *The Architectural Works Copyright Protection Act at Twenty: Has Full Protection Made a Difference?*, *supra* note 165, at 22-23, 60.

<sup>171</sup> *See, e.g.*, *Intervest Constr., Inc. v. Canterbury Est. Homes, Inc.*, 554 F.3d 914, 917-919 (11th Cir. 2008).

<sup>172</sup> Shipley, *The Architectural Works Copyright Protection Act at Twenty: Has Full Protection Made a Difference?*, *supra* note 165, at 7.

<sup>173</sup> *Intervest*, 554 F.3d at 921.

<sup>174</sup> *Id.* at 918-19.

<sup>175</sup> *Id.* at 921.

<sup>176</sup> *Id.* at 919.

<sup>177</sup> *Id.* at 921.

<sup>178</sup> *Id.* at 919, 921.

to infringe.<sup>179</sup> Moreover, the court expressed a preference for summary judgment in cases involving protected and unprotected elements because a judge understands the dichotomy between ideas and expression and appreciates that not all copying is infringement.<sup>180</sup>

*Oravec v. Sunny Isles Luxury Ventures* concerned plans for a high-rise condominium complex allegedly infringed by the Trump Palace and the Trump Royale.<sup>181</sup> The defendant contended the plaintiff's plans were too conceptual to be copyrighted because they had commonly-used features and lacked floor plans, site plan dimensions, and any other indicators of site support.<sup>182</sup>

The trial court disagreed, saying that there was not a constructability test, that the plaintiff's use of convex and concave segments was distinctive in relation to other aspects of the design, and that the arrangement and use of elevator towers were original and concrete.<sup>183</sup> Still, even though the plaintiff's plans were copyrightable, the court granted summary judgment for the defendants because no reasonable jury could find their buildings substantially similar to the plaintiff's.<sup>184</sup>

The Eleventh Circuit affirmed.<sup>185</sup> The plaintiff listed ten elements present in the respective designs of the parties' buildings:

- (1) alternating concave and convex sections;
- (2) three prominent elevator shafts that protrude above the roof of the building;
- (3) rounded building ends;
- (4) constant radius curves;
- (5) holes in the building;
- (6) a twin tower design;
- (7) see-through floor plans;
- (8) a circular plaza;
- (9) a central fountain;
- and (10) a rooftop pool and landscape elements.<sup>186</sup>

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<sup>179</sup> See also *Howard v. Sterchi*, 974 F.2d 1272, 1276 (11th Cir. 1992) (the parties' floor plans were visually similar, and the layouts were generally the same, but dissimilarities were significant such as roof lines, windows, and dimensions – the court noted that there were a limited number of ways to divide a rectangle and stated that modest dissimilarities are more significant than they may be in other types of works).

<sup>180</sup> *Intervest*, 554 F.3d at 920. See also *Home Design Servs., Inc. v. Turner Heritage Homes, Inc.*, 825 F.3d 1314, 1326 (11th Cir. 2016) (finding judgment as a matter of law for the defendant because the parties' four-three split style house plans were different in dimensions, wall placement, and presence, arrangement, and function of particular features).

<sup>181</sup> *Oravec v. Sunny Isles Luxury Ventures L.C.*, 469 F. Supp. 2d 1148, 1159 (S.D. Fla. 2006), *aff'd*, 527 F.3d 1218 (11th Cir. 2008).

<sup>182</sup> *Id.* at 1162.

<sup>183</sup> *Id.* at 1165-66.

<sup>184</sup> *Id.* at 1172.

<sup>185</sup> *Oravec v. Sunny Isles Luxury Ventures L.C.*, 527 F.3d 1218 (11th Cir. 2008) (footnote omitted).

<sup>186</sup> *Id.* at 1225-26.

The appellate court acknowledged that the defendants' buildings had alternating concave and convex sections and three partially exposed elevator towers extending above their rooflines.<sup>187</sup> However, it provided a list of dissimilarities that were evident from comparing the designs.<sup>188</sup>

For example, the dimensions and shapes of the floor plans were different. The designs of the elevator towers were also significantly different, with the towers on the Trump buildings being sloped to give the effect of smokestacks on a cruise ship while the plaintiff's towers were horizontal.<sup>189</sup> The plaintiff identified other elements of similarity but the court held that these elements were unprotected ideas or individual standard features that had been expressed differently by the defendants.<sup>190</sup>

The court also emphasized that it was necessary to be mindful of the principle codified in section 102(b) that copyright does not extend to ideas, but to expression.<sup>191</sup> The court also noted that the AWCPA excluded individual standard features from protection, such as commonly used doors, windows, and other staples.<sup>192</sup>

At the same time, the court said that creativity in architecture often involves the "selection, coordination, or arrangement of unprotect[ed] elements"<sup>193</sup> in a protectable whole, and that the statute itself defines an architectural work as "the arrangement and composition of spaces and elements in the design."<sup>194</sup> Nevertheless, protecting the use of concave and convex forms or the use of three elevator towers "would extend the protections of copyright law well beyond their proper scope."<sup>195</sup>

Affording protection to the plaintiff's selection of design elements "would effectively bar all other architects from incorporating those concepts into new

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<sup>187</sup> *Id.* at 1226.

<sup>188</sup> *Id.* at 1226-27.

<sup>189</sup> *Id.* at 1226-27.

<sup>190</sup> *Id.* at 1227.

<sup>191</sup> *Oravec v. Sunny Isles Luxury Ventures L.C.*, 527 F.3d 1218, 1224-25 (11th Cir. 2008) (citing 17 U.S.C. § 102(b), which provides that "[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 . . .").

<sup>192</sup> *Id.* at 1225 (referencing 17 U.S.C. § 101, which provides that "[a]n architectural work . . . does not include individual standard features"); see also H.R. REP. NO. 101-735 (1990), reprinted in 1990 U.S.C.C.A.N. 6935, 6949 (noting that "the definition [of architectural work] makes clear that protection does not extend to individual standard features, such as common windows, doors, and other staple building components").

<sup>193</sup> *Id.* (citing H.R. REP. NO. 101-735 (1990), reprinted in 1990 U.S.C.C.A.N. at 6949).

<sup>194</sup> *Oravec*, 527 F.3d 1225 (quoting the definition of "architectural work" in 17 U.S.C. § 101).

<sup>195</sup> *Id.* at 1227.

and original designs.”<sup>196</sup> This broad swath would diminish the number of ideas and concepts available for future works.<sup>197</sup>

Modest differences are significant when comparing architectural works in the Eleventh because there are often only a few ways to arrange standard architectural features. Having a commodious living space in the middle of a home is an idea, as is the concept of a four-three split plan. Ideas are not copyrightable, and modest differences are more significant with architectural works than with other works of authorship in the Eleventh Circuit.<sup>198</sup> It is challenging for architects to win infringement suits in this circuit because of its demanding application of the principles announced in *Feist* to separate protectable expression from unprotectable elements in an architectural work. This close scrutiny leads to very thin copyright protection for architectural works in the Eleventh Circuit.<sup>199</sup>

#### D. APPLYING *FEIST* PRINCIPLES TO OTHER WORKS OF AUTHORSHIP

The Eleventh Circuit’s careful parsing of works of authorship to separate copyrightable expression from unprotectable components is evident in *Beal v. Paramount Pictures Corp.*<sup>200</sup> This 1994 decision held that the movie “Coming to America” did not infringe the copyright in the novel *The Arab Heart*.<sup>201</sup> The court first summarized the respective works, and noted that another court held defendant Paramount liable to the author/humorist Art Buchwald for using his

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<sup>196</sup> *Id.* at 1228.

<sup>197</sup> *Id.* See also *Corwin v. Walt Disney Co.*, 468 F.3d 1329, 1343-45 (11th Cir. 2006) *vacated and superseded by*, 475 F.3d 1239 (11th Cir. 2007) (affirming summary judgment for defendant, Disney, because the alleged similarities between the plaintiff’s concepts and designs for a theme park and Disney’s EPCOT were unprotectable and not so striking as to establish copying and thus overcome Disney’s evidence of its independent creation of EPCOT).

<sup>198</sup> See, e.g., *Home Design Servs., Inc. v. Turner Heritage Homes, Inc.*, 825 F.3d 1314, 1320 (11th Cir. 2016); *Arthur Rutenberg Homes, Inc. v. Jewel Homes, LLC*, 655 F. App’x 807, 811-12 (11th Cir. 2016); *Interwest Constr., Inc. v. Canterbury Est. Homes, Inc.*, 554 F.3d 914, 921 (11th Cir. 2008).

<sup>199</sup> See *Medallion Homes Gulf Coast, Inc. v. Tivoli Homes of Sarasota, Inc.*, 656 F. App’x 450, 455 (11th Cir. 2016) (affirming summary judgment for alleged infringer because no reasonable finder of fact could find the works substantially similar); *Dream Custom Homes, Inc. v. Modern Day Constr., Inc.*, 476 F. App’x 190, 192 (11th Cir. 2012) (affirming summary judgment for the alleged infringer after the court separated what was protected from what was unprotectable in the respective works); *Miller’s Ale House, Inc. v. Boynton Carolina Ale House, LLC*, 702 F.3d 1312, 1326-27 (11th Cir. 2012) (noting that a chain restaurant’s features of a rectangular bar, booth seating, and high top tables were standard and unprotectable ideas). 200 20 F.3d 454 (11th Cir. 2012).

<sup>201</sup> *Id.* at 456, *aff’g* 806 F. Supp. 963 (N.D. Ga. 1992) (granting summary judgment for the defendants).

idea as the basis for the movie.<sup>202</sup> The appellate court said that the trial court had granted summary judgment on “two grounds: that any similarity between *The Arab Heart* and ‘Coming to America’ concerned only noncopyrightable elements of the book, and that no reasonable jury, properly instructed, would find the two works to be substantially similar.”<sup>203</sup>

“Paramount conced[ed] access for purposes of the summary judgment,” so the appellate court focused on substantial similarity of protected expression.<sup>204</sup> It agreed that the few broad similarities between the works “involve[d] ideas and other general themes that are not susceptible to copyright protection.”<sup>205</sup> Those themes were wealthy young princes coming to America to meet the women they would marry and strong rulers who wanted arranged marriages for their princes. The court said these themes were “in the realm of ideas” unprotected by copyright.<sup>206</sup>

The court next explained that respective works “diverge[d] sharply from those broad similarities.”<sup>207</sup> Nevertheless, it carefully analyzed the “plot, mood, characterization, pace, and setting” of the works and concluded that “no reasonable factfinder could conclude that ‘Coming to America’ is substantially similar to the copyrightable elements of *The Arab Heart*.”<sup>208</sup> “If the similarities in general ideas and *scènes à faire* serve to show anything at all, perhaps it is only that ‘in Hollywood, as in [life] generally, there is only rarely anything new under the sun.’”<sup>209</sup>

There was a similar parsing of a work’s copyrightable expression from its unprotectable components in litigation over the photograph of the Bird Girl statue that appeared on the book cover of the novel, *Midnight in the Garden of Good and Evil*.<sup>210</sup> The plaintiff, Jack Leigh, was commissioned by Random House to

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<sup>202</sup> *Id.* at 458 (discussing Paramount’s litigation with *Buchwald v. Paramount Pictures Corp.*, 13 U.S.P.Q.2d 1497 (Cal. Super. Ct. 1990). The court explained that while Paramount and the other defendants may have appropriated Buchwald’s idea, that would not preclude the copying of the plaintiff’s copyrightable expression from *The Arab Heart*).

<sup>203</sup> *Beal*, 20 F.3d at 458.

<sup>204</sup> *Id.* at 460.

<sup>205</sup> *Id.*

<sup>206</sup> *Id.*

<sup>207</sup> *Id.* at 460.

<sup>208</sup> *Id.* at 460-64. The district court had engaged in a similar thorough analysis of the respective works.

<sup>209</sup> *Id.* (citing *Berkic v. Crichton*, 761 F.2d 1289, 1294 (9th Cir. 1985) and *Ecclesiastes* 1:9); see also *Herzog v. Castle Rock Ent.*, 193 F.3d 1241 (11th Cir. 1999) (the plaintiff was unable to establish that the producers of the movie “Lone Star” had access to her screenplay “Concealed”, and the court also determined, after a thorough analysis, that the few similarities between the works involved noncopyrightable elements).

<sup>210</sup> *Leigh v. Warner Bros., Inc.*, 212 F.3d 1210, 1212 (11th Cir. 2000).

take the photo, but he retained ownership and registered his copyright.<sup>211</sup> Defendant Warner Brothers took photographs and film footage of a replica of the Bird Girl statue to promote its movie version of the novel. Three segments of film footage and six still images allegedly infringed Leigh's copyright.<sup>212</sup> The district court granted summary judgment for Warner Brothers, and Leigh appealed.<sup>213</sup>

The Eleventh Circuit stated:

Leigh's copyright does not cover the appearance of the statue itself or of the Bonaventure Cemetery, for Leigh has no rights in the statue or its setting. Nor does the copyright protect the association of the statue with the *Midnight* story. Leigh may have been the first to think of the statue as evocative of the novel's mood and as an appropriate symbol of the book's themes, but copyright law protects only original expression, not ideas.

Thus, the district court correctly identified the elements of artistic craft protected by Leigh's copyright as the selection of lighting, shading, timing, angle, and film.<sup>214</sup>

Leigh also argued that his copyright extended to the overall mood conveyed by his photograph, but the trial court said that the photo's eerie and spiritual mood was unprotectable *scenes à faire*.<sup>215</sup> The Eleventh Circuit followed this by explaining that "[a]nalyzing relatively amorphous characteristics of the picture as a whole" risks extending copyright to a work's unoriginal aspects.<sup>216</sup> Instead, the proper approach was to focus on the concrete elements of a photographer's craft because a photo's mood is the effect created by lighting, shading, timing, angle, and film, and not an independent aspect of the work.<sup>217</sup>

The appellate court ultimately concluded that the trial court was correct to hold that the film sequences featuring the Bird Girl statue were not substantially similar to Leigh's photograph. However, the similarities between the defendant's still photographic images and Leigh's photograph on the book's cover were significant enough to preclude summary judgment.<sup>218</sup> The court carefully compared of the defendant's works with the copyrightable aspects of Leigh's

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<sup>211</sup> *Id.* at 1213.

<sup>212</sup> *Id.*

<sup>213</sup> *Id.* at 1214.

<sup>214</sup> *Id.* at 1214-15 (citations omitted).

<sup>215</sup> *Id.* at 1215.

<sup>216</sup> *Leigh v. Warner Bros., Inc.*, 212 F.3d 1210, 1215 (11th Cir. 2000).

<sup>217</sup> *Id.*

<sup>218</sup> *Id.* at 1215-16.

photograph to reach these conclusions.<sup>219</sup> It emphasized that substantial similarity is a question of fact and that “summary judgment is only appropriate if no reasonable jury could differ in weighing the evidence.”<sup>220</sup>

The Eleventh Circuit exercised the same kind of thorough analysis in 2021 when it decided *Dubay v. King*.<sup>221</sup> The plaintiff alleged that the character Roland Deschain in Steven King’s *The Dark Tower* series infringed the copyright on the comic book character Restin Dane from the plaintiff’s series, *The Rook*.<sup>222</sup> The court described the plaintiff’s Dane as battling a variety of villains during his time-traveling adventures and as sharing

numerous attributes with other traditional heroes from comic books. He is handsome, masculine, courageous, and honorable. Dane is selfless and can always be counted on to “do the right thing.” Dane does not engage in much introspection; his character arc remains constant throughout *The Rook* series. In short, Dane is a traditional comic book hero.<sup>223</sup>

Stephen King regards *The Dark Tower* series as his ‘magnum opus.’ Throughout this series, Roland Deschain goes after a structure called the “Dark Tower” as well as the “Man in Black.” He is a sorcerer who serves the “Crimson King.”<sup>224</sup> The Eleventh Circuit described Deschain as a complex character.

He is courageous and skilled with a gun, yet he lacks the idealism and morality of the traditional hero. Deschain is a loner who does not value the lives of others and is, thus, willing to sacrifice those who get in his way. . . . Deschain’s character arc throughout *The Dark Tower* series is marked by his search for self-knowledge and redemption. . . . In short, Deschain is best described as an anti-hero.<sup>225</sup>

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<sup>219</sup> *Id.*

<sup>220</sup> *Id.* at 1216.

<sup>221</sup> See *Dubay v. King*, 844 F. App’x 257 (11th Cir. 2021), *cert. denied*, 142 S. Ct. 490 (2021) (the Eleventh Circuit’s ruling affirmed that King’s anti-hero, Roland Deschain, is not substantially similar to DuBay’s comic book character Restin Dane from *The Rook*); see generally Wook Hwang & Kyle Petersen, *DuBay v. King*, LOEB & LOEB LLP (Feb. 23, 2021), <https://www.loeb.com/en/insights/publications/2021/03/dubay-v-king>.

<sup>222</sup> *Dubay*, 844 F. App’x at 259.

<sup>223</sup> *Id.* at 259-60.

<sup>224</sup> *Id.* at 260 (adding that Marvel has published licensed graphic novels based on the series, and Sony produced a movie adaptation of the series).

<sup>225</sup> *Id.*

King moved for summary judgment after discovery. The district court, assuming that King had access to the plaintiff's works,<sup>226</sup> ruled for him and the other defendants. The court concluded that the characters were not substantially similar.<sup>227</sup>

DuBay asserted on appeal that a reasonable jury could find substantial similarity based on a list of eight similarities between his Dane character and King's Deschain.<sup>228</sup> The court's review was *de novo*. It said that because "a work may contain uncopyrightable elements," the task of the reviewing court was to determine "both whether the similarities between the works are substantial from the point of view of the lay observer and whether those similarities involve copyrightable material."<sup>229</sup> The court then narrowed the plaintiff's list of alleged similarities to a few copyrightable elements. It said that the characters' names did not merit protection, that many of the alleged similarities were *scènes à faire* too general to be protected,<sup>230</sup> and that the towers and tower imagery in the works served different functions for each character.<sup>231</sup> The court also said that "the characters interact[ed] with bird companions and imagery in different ways," and that their "interactions with young male companions [were] dramatically different."<sup>232</sup>

The court recognized the pitfalls of analyzing similarities in isolation but noted that taking a more holistic analysis of them, as urged by the plaintiff, hurt his case by showing the "distinctiveness of each character."<sup>233</sup> It concluded by stating that the characters were "surrounded by different stories and contexts, thereby rendering any similarities superficial."<sup>234</sup> The district court did not err by granting summary judgment in Stephen King's favor.<sup>235</sup>

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<sup>226</sup> *Id.* at 264, 265 n.8.

<sup>227</sup> *Id.* at 266.

<sup>228</sup> *Dubay*, 844 F. App'x at 263-64. DuBay also challenged the trial court's failure to exclude reports and plot and character summaries by King's experts.

<sup>229</sup> *Id.* at 264-65.

<sup>230</sup> *Id.* at 264-65. The alleged similarities that were *scènes à faire* included "their knightly heritage, travel to different times and parallel worlds, Western attire, fictionalized Alamo histories, and knife-wielding." *Id.* See also Wook Hwang & Kyle Petersen, *supra* note 218.

<sup>231</sup> *Id.* at 265.

<sup>232</sup> *Id.*

<sup>233</sup> *Id.* at 266.

<sup>234</sup> *Dubay*, 844 F. App'x at 266. The U.S. Supreme Court denied *Dubay's* petition for certiorari. 142 S. Ct. 490 (2021).

<sup>235</sup> *Id.* The U.S. Supreme Court denied *Dubay's* petition for certiorari. 142 S. Ct. 490 (2021). The Supreme Court's "refusal to hear *Dubay* reinforces the basic tenet of copyright law that general ideas or scenes a faire cannot be protected by copyright." See generally, Finnegan, Henderson, Farabow, Garrett & Dunner, *SCOTUS Shelves Request to Review 11<sup>th</sup> Circuit Dark Tower Decision, Ending Copyright Saga* (December 20, 2021), <https://www.lexology.com/library/detail.aspx?g.> See also Tolbert v. Discovery, Inc., 2021 WL

*Beal v. Paramount*, the *Interwest Construction* architectural plans ruling, *Vallejo v. Narcos Productions*, and the *Dubay* opinion about Stephen King's Roland Deschain character, were cited by the U.S. District Court for the Northern District of Georgia in 2021. This court granted a Rule 12(b)(6) motion dismissing a claim that Netflix's show *Outer Banks* infringed the novel *Pennywise: The Hunt for Blackbeard's Treasure*.<sup>236</sup> The judge made a careful comparison of the two works and focused on whether *Outer Banks* copied original elements of the novel.<sup>237</sup> It noted that courts within the Eleventh Circuit had examined substantial similarity "at the motion-to-dismiss stage, reasoning that to do so is appropriate because the analysis requires only an examination of the works in question."<sup>238</sup> It also stated that not all copying is infringement, that generalized themes are not protectable, and that *scènes à faire* were not protectable. "Once any generalized ideas and *scènes à faire* are disregarded, the infringement analysis asks whether the protected expression of ideas in the two works is substantially similar."<sup>239</sup>

Next, the court focused on the most significant of the alleged similarities between the works. The judge wrote that the plots of the novel and the film differed significantly, noted that the protagonists in the works shared few similarities, explained that copyright did not extend to setting the works on the shores of North Carolina, and concluded that the mood and pace of the works varied greatly.<sup>240</sup> Ultimately, the court determined that "no reasonable lay observer would recognize *Outer Banks* as being derivative of Wooten's novel" and dismissed the copyright infringement claim.<sup>241</sup>

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3793045 (N.D. Ala. 2021) (HGTV's *Good Bones* home renovation show did not infringe plaintiff's mother-daughter home renovation show following a thorough analysis of characters, plot, pace, setting and other features—in granting a summary judgment the court noted that the plaintiff failed to raise a genuine issue of material fact as to defendant's independent creation of *Good Bones*). Some cases do not require this kind of rigorous analysis of what is and what is not copyrightable. *See, e.g., Cable/Home Comm'n Corp. v. Network Prods., Inc.*, 902 F.2d 829 (11th Cir. 1990) (the defendant was held liable for importing and distributing pirated computer chips that enabled users to unscramble copyrighted programming intended for paying subscribers of cable systems).

<sup>236</sup> *Wooten v. Netflix, Inc.*, No. 1:20-cv-05166-TCB, 2021 U.S. Dist. LEXIS 203672 (N.D. Ga. May 25, 2021).

<sup>237</sup> *Id.* at 6.

<sup>238</sup> *Id.* at 7.

<sup>239</sup> *Id.* at 10-11 (citing *Vallejo v. Narcos Prods.*, 833 F. App'x at 257).

<sup>240</sup> *Id.* at 12-20.

<sup>241</sup> *Id.* at 23. *See also* *Jackson v. JPay, Inc.*, 851 F. App'x 171 (11th Cir. 2021) (affirming dismissal of copyright infringement claim because names are not copyrightable so the plaintiff could not sue based on the use of his name). *But see* *Nat'l Equestrian League v. White*, 2021 BL 198488, S.D. Fla., 20-21746-CIV-MORENO/GOODMAN, 5/26/21. In this litigation, a federal magistrate judge denied defendant's Rule 12(b)(6) motion and allowed plaintiffs' infringement claim to proceed stating that while "some elements may not be protected (like the broad idea of a horse jumping competition), this Court should not undertake the fact-focused process of determining the merits of Plaintiffs' copyright claims on a motion to

The Eleventh Circuit's careful parsing of works to separate copyrightable expression from unprotectable components is seen clearly in these several rulings: that the movie "Coming to America" did not infringe the copyright in the novel *The Arab Heart*; the court's opinion regarding the alleged infringement of the Bird Girl photograph from the book cover of the novel *Midnight in the Garden of Good and Evil*; and, its holding that Steven King's character Roland Deschain from *The Dark Tower* series did not infringe the comic book character, Restin Dane, from *The Rook*. The demanding application of principles of copyrightability and the scope of protection in these opinions and other Eleventh Circuit decisions is also evident in the opinion by the U.S. District Court for the Northern District of Georgia in *Wooten v. Netflix, Inc.* explaining why it was granting the defendant's Rule 12(b)(6) motion and dismissing the plaintiff's infringement claim. Whether the subject matter at issue is a directory, a compilation, a taxonomy, computer software, an architectural work, a movie, a photograph, a novel, or a character, the courts in the Eleventh Circuit take great care to separate the protectable from the unprotectable in a plaintiff's work to decide whether there is substantial similarity of protected expression.

### III. THE AVAILABILITY OF COPYRIGHT PROTECTION

In 1999 and 2018, the Eleventh Circuit decided influential cases dealing with whether particular categories of works of authorship are entitled to any kind of copyright protection whatsoever. The case of *United States v. Moghadam* focused on Congress' authority, under the Constitution's Copyright Clause, to extend copyright-like protection to unfixated works of authorship. The court said no, but it upheld the challenged legislation based on the Commerce Clause.<sup>242</sup> This ruling has influenced other federal courts.<sup>243</sup>

The second decision, *Code Revision Commission v. Public.Resource.Org*, focused on the government edicts doctrine. The Eleventh Circuit held that the annotations and commentary in the Official Code of Georgia Annotated were not copyrightable. It did this by expanding the venerable government edicts doctrine.<sup>244</sup> The United States Supreme Court affirmed 5-4, but the Court's

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dismiss." This report was affirmed and adopted by Judge Moreno. 2021 WL 2414153 (S.D. Fla. 6/14/2021).

<sup>242</sup> *United States v. Moghadam*, 175 F.3d 1269 (11th Cir. 1999); JOYCE ET AL., *supra* note 2, at 71-72 n.15.

<sup>243</sup> See *infra* text and notes accompanying notes 246-69.

<sup>244</sup> *Code Revision Comm'n v. Public.Resource.Org, Inc.*, 906 F.3d 1229 (11th Cir. 2018).

majority did not rely on the three-factor test used by the Eleventh Circuit, and the impact of this ruling is still playing out.<sup>245</sup>

#### A. ANTI-BOOTLEGGING LEGISLATION AND COPYRIGHT'S FIXATION REQUIREMENT

There was no federal protection for a performing artist's live performance prior to 1994. Imagine Linda Ronstadt performing live at a small club. She sings several copyrighted old standards, and one of her fans in the audience records the performance without permission. That fan—the bootlegger—could sell the recordings (audio and audio-visual) so long as they paid appropriate royalties to the copyright owners of the songs Ronstadt performed. The fan did not need to pay royalties to Ronstadt because her live performances of the songs were unfixed and thus not copyrightable. In addition, the fan did not infringe the copyright on Ronstadt's recordings of those songs because the fan did not copy those recordings. Instead, the fan recorded her live performances of the songs.<sup>246</sup>

The lack of federal protection for live performances changed in 1994 when Congress passed the Uruguay Round Agreements Act and implemented the General Agreement on Tariffs and Trade.<sup>247</sup> Section 512 of the Act is an anti-bootlegging statute that bars the unauthorized audio and audio-visual recording of live performances, the unauthorized reproduction of those recordings, and their trafficking.<sup>248</sup> This statute provides for penalties but does not have a duration notwithstanding the "Limited Times" restriction in the Copyright Clause.<sup>249</sup> For the first time in United States copyright law, legislation provided a remedy for the unauthorized copying of unfixed works; live performances that had not been fixed in a tangible medium of expression. The Act subjected violators to copyright-like liability.<sup>250</sup> There were doubts about the constitutionality of this legislation because it protected unfixed works notwithstanding the Constitution's 'writings' requirement.<sup>251</sup>

The Eleventh Circuit was the first appellate court to rule on the constitutionality of this statute in *United States v. Moghadam*,<sup>252</sup> and it upheld the

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<sup>245</sup> *Georgia v. Public.Resource.Org*, 140 S. Ct. 1498 (2020). See *infra* text and notes accompanying notes 297–12 (discussion of the U.S. Supreme Court's decision and the impact of that ruling).

<sup>246</sup> Shipley, *Congressional Authority Over Intellectual Property Policy*, *supra* note 18, at 1268.

<sup>247</sup> Leaffer, *supra* note 165, at 55-56.

<sup>248</sup> Uruguay Round Agreements Act, 103 Pub. L. No. 465, 108 Stat. 4809, 4974 (1994).

<sup>249</sup> See Leaffer, *supra* note 165, at 55-57 (thorough discussion of the anti-bootlegging statute and how it is at odds with the 'Limited Times' requirement in the Copyright Clause as well as the 'writings' requirement).

<sup>250</sup> Leaffer, *supra* note 165, at 57.

<sup>251</sup> *Id.* at 56-57; JOYCE ET AL., *supra* note 2, at 71-72.

<sup>252</sup> *United States v. Moghadam*, 175 F.3d 1269 (11th Cir. 1999).

legislation based on Congress' authority under the Commerce Clause.<sup>253</sup> The defendant admitted distributing bootleg CDs of live performances by several artists and moved to dismiss a criminal indictment because the statute did not fall within Congress' powers under the Copyright Clause.<sup>254</sup> The government argued in response that the statute was valid under the Commerce Clause. The trial court denied the defendant's motion, and the Eleventh Circuit affirmed Moghadam's conviction. The court said that the anti-bootlegging statute was a hybrid that resembled copyright in some ways but was distinct in others.<sup>255</sup> According to the court, the word 'writings' in the Copyright Clause seemed to require some kind of fixation.<sup>256</sup> However, it declined to decide whether that clause could be interpreted expansively to include protection for live performances that were capable of being reduced to tangible form.<sup>257</sup> The court assumed, without deciding, that the fixation requirement precluded Congress from turning to the Copyright Clause as the source of its power to enact the anti-bootlegging statute.<sup>258</sup> The court also noted that the statute did not have an explicit time limitation but said the defendant failed to preserve the argument that it violated the clause's "Limited Times" provision.<sup>259</sup>

The court turned to the Commerce Clause even though the Clause had not been cited by Congress in passing the anti-bootlegging legislation.<sup>260</sup> According to the Eleventh Circuit, the lack of a jurisdictional element was not fatal because the link between the prohibited conduct of making and distributing bootleg CDs and interstate and foreign commerce was clear.<sup>261</sup>

The court, however, said that "[t]he more difficult question . . . [was] whether Congress can use its Commerce Clause power to avoid the limitations that might prevent it from passing the same legislation under the Copyright Clause."<sup>262</sup> The court discussed cases indicating that the Commerce Clause could be "used . . . to accomplish something that the Copyright Clause might not allow,"<sup>263</sup> and it noted arguments from other cases that the clause's limitations "can be said to represent the Framers' judgment that Congress should be affirmatively

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<sup>253</sup> *Id.* at 1274-75.

<sup>254</sup> *Id.* at 1271.

<sup>255</sup> *Id.* at 1271-72. For example, it was not clear whether fair use or the work for hire doctrine applied to the statute.

<sup>256</sup> *Id.* at 1273-74.

<sup>257</sup> *Id.* at 1274.

<sup>258</sup> *Id.* at 1274.

<sup>259</sup> *Id.* at 1274 n.9, 1281 n.15.

<sup>260</sup> *Id.* at 1275 n.10.

<sup>261</sup> *Id.* at 1275-76.

<sup>262</sup> *Id.* at 1277.

<sup>263</sup> *Id.* at 1279.

prohibited from passing certain types of legislation, no matter under which provision.”<sup>264</sup>

Resolving this tension, we take as a given that there are some circumstances . . . in which the Commerce Clause cannot be used by Congress to eradicate a limitation placed upon Congress in another grant of power. For the reasons that follow, we hold that the instant case is not one such circumstance. We hold that the Copyright Clause does not envision that Congress is positively forbidden from extending copyright-like protection under other constitutional clauses, such as the Commerce Clause, to works of authorship that may not meet the fixation requirement inherent in the term “Writings.”<sup>265</sup>

The court also explained why extending copyright-like protection to live performances was not inconsistent with the fixation requirement.<sup>266</sup> In dicta, however, the court said that the apparently perpetual protection provided by the statute might be fundamentally inconsistent with the “Limited Times” restriction in the Copyright Clause.<sup>267</sup>

Even though the Eleventh Circuit expressed reservations about how Congress drafted the anti-bootlegging statute, other courts have followed its lead to uphold the statute by turning to the Commerce Clause.<sup>268</sup> The Eleventh Circuit reached this conclusion well before those other courts.<sup>269</sup>

#### B. EXPANSION OF THE GOVERNMENT EDICTS DOCTRINE

The Eleventh Circuit’s decision in *Code Revision Commission v. Public.Resource.Org, Inc.*<sup>270</sup> had a significant impact on questions of copyrightability and the scope of copyright protection. The court held in 2018 that all annotations, commentary, and notes in the Official Code of Georgia Annotated

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<sup>264</sup> *Id.* at 1279.

<sup>265</sup> *Id.* at 1280 (footnote omitted).

<sup>266</sup> *Id.* at 1281.

<sup>267</sup> *Id.* The court did not decide this issue because the criminal defendant had not raised it.

<sup>268</sup> *United States v. Martignon*, 492 F.3d 140 (2d Cir. 2007); *KISS Catalog v. Passport Int’l Prods.*, 350 F. Supp. 2d 823 (C.D. Cal. 2004), *on reconsideration*, 405 F. Supp. 2d 1169 (C.D. Cal. 2005) (upholding the anti-bootlegging statute as constitutional).

<sup>269</sup> See JOYCE ET AL., *supra* note 2, at 71 (discussing Eleventh Circuit’s *Moghadam* decision from 1999 and then the more recent Second Circuit decision in *Martignon* from 2007 in which that appellate court determined that the anti-bootlegging statute was not a copyright law and therefore could be upheld under the Commerce Clause, 492 F.3d at 151-53).

<sup>270</sup> *Code Revision Comm’n v. Public.Resource.Org, Inc.*, 906 F.3d 1229 (11th Cir. 2018).

(O.C.G.A.) were in the public domain and unprotectable.<sup>271</sup> The United States Supreme Court affirmed 5-4 in 2020, holding that the annotations in Georgia’s official code were not subject to protection under the Copyright Act.<sup>272</sup> The Supreme Court rejected the three-factor test applied by the Eleventh Circuit, but stated that

A careful examination of our government edicts doctrine precedents reveals a straightforward rule based on the identity of the author. Under the government edicts doctrine, judges—and, we now confirm, legislators—may not be considered the “authors” of the works they produce in the course of their official duties as judges and legislators. The rule applies regardless of whether a given material carries the force of law. . . . [C]opyright does not vest in works that are (1) created by judges and legislators (2) in the course of their judicial and legislative duties.<sup>273</sup>

The Georgia legislature’s involvement in creating the Official Code of Georgia Annotated started in 1977 when it concluded that the state’s laws needed to be re-codified. It established the Code Revision Commission to perform several tasks, including contracting with a publisher to revise the 1933 Code and subsequently enacted laws.<sup>274</sup> The Commission contracted with The Michie

<sup>271</sup> *Id.* at 1232. See generally David E. Shipley, Code Revision Commission v. Public.Resource.Org and the Fight over Copyright Protection for Annotations and Commentary, 54 GA. L. REV. 111 (2019) (taking the position that the Supreme Court should reverse the Eleventh Circuit and reinstate the U.S. District Court’s decision).

<sup>272</sup> Georgia v. Public.Resource.Org, Inc., 140 S. Ct. 1498 (2020); see also Darren Ford, *Supreme Court Offers Guidance Regarding Eligibility of State Legislative Records for Protection Under the Copyright Act*, GRAYDON HEAD & RITCHEY LLP (Apr. 28, 2020), <https://graydon.law/supreme-court-offers-guidance-regarding-eligibility-of-state-legislative-records-for-protection-under-the-copyright-act/>.

<sup>273</sup> Georgia v. Public.Resource.Org, 140 S. Ct. 1498, 1506, 1508 (2020).

<sup>274</sup> The legislature established a Code Revision Study Committee. It evaluated Georgia Code and concluded recodification was needed. It also recommended that there should be an official publication of the Code, controlled by the legislature. Georgia v. Harrison Co., 548 F. Supp. 110, 112. (N.D. Ga. 1982). See generally Elizabeth Holland, *Will You Have to Pay for the O.C.G.A.?: Copyrighting the Official Code of Georgia Annotated*, 26 J. INTELL. PROP. L. 99, 109-115 (2019)(discussing Georgia’s Code revision process). The Code Revision Commission’s powers are set forth in O.C.G.A. § 28-9-3. Those powers include:

(9) To prepare, or provide for the preparation of, and to include in the Code such annotations, historical notes, research references, notes on law review articles, cross-references, summaries of the opinions of the Attorney General of Georgia, editor’s notes, Code Revision Commission notes, comments, commentaries, rules and regulations, indexes, tables, and other material as the commission determines to be useful to users of the Code; . . . (10) To provide for the publication of annotated or

Company<sup>275</sup> to “codify, revise, index, print, bind, and deliver according to the directions of the Commission . . . a revised and recodified code of Georgia, which was to be designated as the ‘Official Code of Georgia Annotated.’”<sup>276</sup> It was a ‘work for hire’ under the Copyright Act,<sup>277</sup> with Georgia holding the copyright pursuant to the enabling legislation and the contract with Michie.<sup>278</sup> The new Code, as annotated, had the state’s imprimatur,<sup>279</sup> and the U.S. District Court for the Northern District of Georgia noted in 1982 that attorneys who cite unofficial versions of the Code did so at their peril because the Michie version was controlling.<sup>280</sup>

The Commission entered a new agreement in 2006 with Matthew Bender & Co., a division of Lexis/Nexis. This agreement also required the Official Code

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unannotated versions of the Code, or both; . . . (15) To negotiate and grant licenses or rights, on behalf of the state, to use such material upon such terms and conditions as the commission shall determine to be in the best interest of the state; . . . (emphasis added).

<sup>275</sup> The Commission heard presentations from five publishers. *Harrison Co.*, 548 F. at 112. The several versions of the Code published since 1933 had been under several titles including Georgia Code Annotated, Code of Georgia Annotated, and Georgia Code Unannotated. *Id.*

<sup>276</sup> *Id.*

<sup>277</sup> 17 U.S.C. § 101 (defining “work made for hire”); 17 U.S.C. § 201.

<sup>278</sup> *Harrison Co.*, 548 F. at 112. The Commission developed the numbering system and the rules of style used in the Code, and when the editorial process was completed, a manuscript was presented to the legislature and enacted at the 1981 extraordinary session. Annotations, indexes, and other notes and materials then were added to the manuscript to produce Georgia’s first official Code since 1933. Code Revision Comm’n v. Public.Resource.Org, Inc., 244 F. Supp. 3d 1350, 1353 (N.D. Ga. 2017).

<sup>279</sup> Lawyers serving in the Georgia General Assembly were strongly in favor of having an annotated code with “explanations to the statutory provisions which interpret judicial opinions, attorney general guidance documents, and law review and journal articles that relate to the statute.” Holland, *supra* note 274, at 111. They felt that annotations helped lawyers find how to apply the law, and essentially to practice law. Holland, *supra* note 274, at 111 (quoting the Commission’s counsel and lawyer in the House who served on the Commission). *See also* Adam Liptak, *Accused of ‘Terrorism’ for Putting Legal Materials Online*, N.Y. TIMES (May 13, 2019), <https://www.nytimes.com/2019/05/13/us/politics/georgia-official-code-copyright.html>; Kyle Jahner, *Firms, Lawyers, States Want High Court to Weigh in on Annotations*, BLOOMBERG LAW IP LAW NEWS (May 23, 2019, 4:46 AM), <https://news.bloomberglaw.com/ip-law/firms-lawyers-states-want-high-court-to-weigh-in-on-annotations> (additional commentary on the copyright litigation concerning the Official Code of Georgia Annotated).

<sup>280</sup> *Harrison Co.*, 548 F. at 117. In addition, the lawyer legislators did not want practitioners to have to buy two versions of the code—the official version and an unofficial annotated version. *See* Holland, *supra* note 274, at 111 (detailed discussion of how the O.C.G.A. was written and adopted). This intent is reflected in the legislation that empowered the Commission to contract with a publisher and to prepare “annotations, historical notes, research references, notes on law reviews articles, cross references, [and] summaries of the opinions of the Attorney General of Georgia” and other material the Commission determines to be useful to users of the Code. Holland, *supra* note 274, at 111. *See also* GA. CODE ANN. § 28-9-3(9) (2021).

of Georgia to include annotations, captions, editorial notes, chapter analyses, and other materials.<sup>281</sup>

Each O.C.G.A. volume and supplement therefore contains statutory text and non-statutory annotation text, including judicial decision summaries, editor's notes, research references, notes on law review articles, summaries of the Attorney General of Georgia, indexes, and title, chapter, article, part, and subpart captions, which are all prepared by Lexis/Nexis under the requirements of the Agreement.<sup>282</sup>

The agreement also required Lexis/Nexis to provide an appropriate copyright notice on the free public website and on the online Code made available as part of its for-profit service. Lexis/Nexis also notified users that reproduction of the Code, other than statutory text and numbering, was prohibited.<sup>283</sup> In essence, “[t]he Commission asserts a copyright in all portions of the OCGA except for the statutory text, which it recognizes cannot be copyrighted.”<sup>284</sup>

Public.Resource.Org (PRO) purchased a print edition of the O.C.G.A. and its supplements, scanned everything, and uploaded these scanned materials to its website, where they became accessible to the public free of charge. The Code Revision Commission demanded that PRO stop infringing the state's copyright. PRO responded that the state's copyright was invalid because the law cannot be copyrighted.<sup>285</sup> The Commission, acting on behalf of the General Assembly and the State of Georgia, sued PRO in 2015.<sup>286</sup> The U.S. District Court for the Northern District of Georgia ruled in favor of the Commission in 2017,<sup>287</sup> concluding that the annotations lacked the force of law and were not in the public

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<sup>281</sup> *Public.Resource.Org*, 244 F. Supp. 3d at 1553.

<sup>282</sup> *Id.* (citations omitted) (quoting from the Agreement between the Commission and Matthew Bender). Lexis/Nexis is also required to summarize all published opinions of the Georgia Supreme Court and Court of Appeals as well as all published opinions of the U.S. Supreme Court and other federal courts that arose in Georgia and construe Georgia's general statutes.

<sup>283</sup> *Id.* at 1354; *Code Revision Comm'n v. Public.Resource.Org, Inc.*, 906 F.3d 1229, 1234 (11th Cir. 2018).

<sup>284</sup> *Code Revision Comm'n v. Public.Resource.Org, Inc.*, 906 F.3d 1229, 1234 (11th Cir. 2018) (“The publication agreement also provides that “[a]ll contents of the Code . . . shall be copyrighted in the name of the State of Georgia . . . [and] [t]he copyrights shall cover all copyrightable parts of the Code.”).

<sup>285</sup> *Id.* at 1235.

<sup>286</sup> *Id.*

<sup>287</sup> *Code Revision Comm'n v. Public.Resource.Org, Inc.*, 244 F. Supp. 3d 1350, 1350 (N.D. Ga. 2017).

domain.<sup>288</sup> It held that state's copyright protected the annotations and research aids in the Official Code of Georgia.<sup>289</sup>

The Eleventh Circuit reversed and remanded after concluding that the People were the ultimate authors of the annotations, that the annotations were law-like, and that they were not copyrightable.<sup>290</sup> The court acknowledged that the enabling statutes provided that the annotations and commentaries were not law. "Despite the fact that they are part of the official Code, Georgia law says that the annotations themselves do not have the force of law in the way that the statutory portions of the Code do."<sup>291</sup> It also pointed out that another provision in the enabling legislation stated that "[t]he statutory portion of such codification *shall be merged with* annotations, captions, catchlines, history lines, editorial notes, cross-references, indices, title and chapter analyses, and other materials . . ."<sup>292</sup>

The Eleventh Circuit emphasized the "merged with annotations" language when it explained that the annotations were "the sovereign expression of the People by their legislature" and therefore in the public domain.<sup>293</sup> The court made this explanation notwithstanding the General Assembly's repeated statements that the annotations and commentaries were not part of the law.

The court did not state, however, that the annotations had the force of law. Instead, it said that they fell into "a zone of indeterminacy at the frontier between edicts that carry the force of law and those that do not."<sup>294</sup> They are part and parcel of the law and so enmeshed with Georgia's law as to be inextricable. They are law-like and uncopyrightable.<sup>295</sup> The court reached this conclusion by relying

<sup>288</sup> *Public.Resource.Org*, 906 F.3d at 1235 (discussing *Code Revision Commission v. Public.Resource.Org, Inc.*, 244 F. Supp. 3d 1350, 1353 (N.D. Ga. 2017)). The lower court also rejected the fair use defense asserted by the defendant. It was permanently enjoined from all unauthorized use of the O.C.G.A. and ordered to remove all versions of the O.C.G.A. from its website).

<sup>289</sup> *Public.Resource.Org*, 244 F. Supp. 3d at 1357.

<sup>290</sup> *Code Revision Comm'n v. Public.Resource.Org, Inc.*, 906 F.3d 1229, 1233, 1243 (11th Cir. 2018). The court had no occasion to address the parties' arguments concerning originality and fair use.

<sup>291</sup> *Id.* at 1233-34. The court also quoted section 1-1-7 of the O.C.G.A. that states "[a]ll historical citations, title and chapter analyses, and notes set out in this Code are given for the purpose of convenient reference and do not constitute part of the law." The court also acknowledged that laws passed during each session of the General assembly that reenact the Code state that the annotations "contained in the Official Code of Georgia Annotated are not enacted as statutes by the provisions of this Act." *Id.* at 1233-34 (quoting 2015 Ga. Laws 9, § 54).

<sup>292</sup> *Public.Resource.Org*, 906 F.3d at 1245 (emphasis added) (quoting Official Code of Georgia Annotated § 1-1-1 (Ga. L. 1982, p 3, §1)).

<sup>293</sup> *Id.* at 1232-33 (quoting Official Code of Georgia Annotated § 1-1-1 (Ga. L. 1982, p 3, §1)) (these annotations are part of the official Code because they "shall be merged" with the statutory portions).

<sup>294</sup> *Id.* at 1242.

<sup>295</sup> *Id.* at 1243.

on: (1) the identity of the public officials who created the work; (2) the authoritativeness of the work; and (3) the process by which the work is created.<sup>296</sup>

The United States Supreme Court affirmed 5-4, but the majority did not adopt the Eleventh Circuit's analysis.<sup>297</sup> Instead, it held that any work, including a state code's non-binding annotations and commentary, authored by or for the state's legislature in the course of its legislative duties, is ineligible for copyright protection.<sup>298</sup> The Supreme Court discussed the holdings of three 19<sup>th</sup> century decisions dealing with judicial opinions. It said that judges, because they have the authority to make and interpret the law, cannot be the 'author' of any work prepared in their judicial capacity.<sup>299</sup>

This long-standing rule, called the government edicts doctrine, denies copyright protection to judicial opinions and non-binding works such as headnotes.<sup>300</sup> The Court determined that the doctrine also applied to legislators acting in their legislative capacity, and bars copyright protection not only for legislation, but also for explanatory and procedural materials like the annotations and commentary.<sup>301</sup>

Turning to Georgia's code, the Supreme Court said that Code Commission was the author of the annotations even though they were prepared by a private company because the writing was done under a work-for-hire agreement with the Code Commission.<sup>302</sup> The majority recognized that the Commission was not the General Assembly but said it functioned as the legislature's arm in producing the annotations.<sup>303</sup> After all, the Commission was created by the legislature for the legislature, it consists largely of legislators, and its funding and staff were designated by the legislative branch.<sup>304</sup>

Moreover, the annotations were approved by the General Assembly before being merged with the O.C.G.A.'s statutory text.<sup>305</sup> In addition, this approval was done by legislators in the course of their legislative duties. The explanatory annotations were treated as analogous to the syllabi and headnotes prepared by

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<sup>296</sup> *Id.* at 1232, 1243-54. The U.S. Supreme Court granted certiorari on June 24, 2019.

<sup>297</sup> *Georgia v. Public.Resource.Org, Inc.*, 140 S. Ct. 1498 (2020).

<sup>298</sup> *Id.* at 1506; Dasha Chestukhin, *U.S. Supreme Court Finds No Copyright Protection for Works Prepared by Legislators Or Judges in the Course of Official Duties*, COWAN LIEBOWITZ & LATMAN (May 1, 2020), [https://www.ell.com/CopyrightDevelopmentsBlog/u-s-supreme-court-finds-nocopyright?utm\\_source=Mondaq&utm\\_medium=syndication&utm\\_campaign=LinkedIn-integration](https://www.ell.com/CopyrightDevelopmentsBlog/u-s-supreme-court-finds-nocopyright?utm_source=Mondaq&utm_medium=syndication&utm_campaign=LinkedIn-integration).

<sup>299</sup> *Public.Resource.Org*, 140 S. Ct. at 1506-07.

<sup>300</sup> *Id.* at 1506.

<sup>301</sup> *Id.*

<sup>302</sup> *Id.* at 1508.

<sup>303</sup> *Id.*

<sup>304</sup> *Id.*

<sup>305</sup> *Public.Resource.Org*, 140 S. Ct. at 1508.

judges.<sup>306</sup> They are deemed relevant by the legislature, published along with the statutory text, and seen as falling within the work performed by the legislators in their legislative capacity.<sup>307</sup> Accordingly, they were not copyrightable even though they lacked the force of law.<sup>308</sup>

Justice Thomas dissented. He said that the government edicts doctrine should not be extended to annotations since they lack the force of law.<sup>309</sup> Justice Ginsburg's dissenting opinion contended that the Code Revision Commission did not create the annotations as part of the legislature's lawmaking process. She reached this conclusion because the Commission generated the annotations after the General Assembly enacted the laws.<sup>310</sup>

The long-term impact of *Code Revision Commission v. Public.Resource.Org* is uncertain. The ruling puts annotated state codes in the public domain, and this may expand public access. There is, however, concern that the decision may ultimately reduce access. The annotations and commentary are prepared by private companies like Lexis/Nexis under contract with a state's legislative or judicial branch. Those private companies had the incentive of copyright law to produce works that would produce them a profit.

Since the annotations are no longer copyrightable, those private companies may decline to spend time and resources to prepare these works.<sup>311</sup> About a third of the states have arrangements with private companies to write annotated codes similar to Georgia's arrangement with Matthew Bender.<sup>312</sup> Still, the Eleventh Circuit first extended the rationale of the government edicts doctrine decisions

<sup>306</sup> *Id.* at 1509.

<sup>307</sup> *Id.*

<sup>308</sup> *Id.* See also Preston H. Heard & Emily Scheible Whittaker, *Georgia's Loss is the Public's Gain: Supreme Court Says States May Not Copyright Legal Codes*, WOMBLE BOND DICKINSON (Apr. 27, 2020), <https://www.womblebonddickinson.com/us/insights/alerts/georgias-loss-publics-gain-supreme-court-says-states-may-not-copyright-legal-codes> (commentary on the Supreme Court's decision and its impact).

<sup>309</sup> *Public.Resource.Org*, 140 S. Ct. at 1514-15 (Thomas, J., dissenting). Justice Alito joined this dissent in full, and Justice Breyer joined in part.

<sup>310</sup> *Id.* at 1522-23 (Ginsburg, J., dissenting). Justice Breyer joined this dissent. *Supreme Court Holds That Georgia Cannot Copyright the Annotations to Its Laws*, MAYER BROWN (Apr. 27, 2020), <https://www.appellate.net/resources/supreme-court-holds-that-georgia-cannot-copyright-the-annotations-to-its-laws/>.

<sup>311</sup> Dasha Chestukhin, *U.S. Supreme Court Finds No Copyright Protection for Works Prepared by Legislators Or Judges in the Course of Official Duties*, COWAN LIEBOWITZ & LATMAN (May 1, 2020), [https://www.cl.com/CopyrightDevelopmentsBlog/u-s-supreme-court-finds-nocopyright?utm\\_source=Mondaq&utm\\_medium=syndication&utm\\_campaign=LinkedIn-integration](https://www.cl.com/CopyrightDevelopmentsBlog/u-s-supreme-court-finds-nocopyright?utm_source=Mondaq&utm_medium=syndication&utm_campaign=LinkedIn-integration).

See also *Public.Resource.Org*, 140 S. Ct. at 1522 (Thomas, J., dissenting).

<sup>312</sup> *Statutory Editorial Process*, LEXISNEXIS, [http://www.lexisnexis.com/documents/pdf/20170303045425\\_large.pdf](http://www.lexisnexis.com/documents/pdf/20170303045425_large.pdf) (last visited Oct. 25, 2021).

from the late 19<sup>th</sup> Century to cover the annotations and commentary in Georgia's official code. Even though the U.S. Supreme Court did not accept the Eleventh Circuit's rationale for this outcome, it affirmed this critical decision on what is copyrightable and the scope of that copyright protection.

#### IV. FAIR USE IN THE ELEVENTH CIRCUIT

##### A. THE FIRST AMENDMENT AND FAIR USE

Determining fair use is one of the most troubling issues in copyright law.<sup>313</sup> This important affirmative defense balances the statute's incentives to create, against the public's interest in the dissemination of ideas.<sup>314</sup> Several Eleventh Circuit decisions issued before the U.S. Supreme Court's influential 1985 decision in *Harper & Row, Publishers, Inc. v. Nation Enterprises, Inc.* should be noted.<sup>315</sup> These opinions recognized that fair use is solicitous of free speech interests because it permits a defendant to reproduce some protected expression for a productive purpose. These productive purposes include criticism and news reporting, and the infringement suit can be resolved without turning to a First Amendment defense.

The Supreme Court in *Harper & Row* answered several questions about the interplay between copyright and free speech principles while refusing to create a public figure exception to copyright.<sup>316</sup> The Court made clear that a finding of fair use would conclude a matter without the trial court needing to rule on whether the alleged infringer's use was protected speech.<sup>317</sup> In reaching similar

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<sup>313</sup> *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 475 (1984) (Blackmun, J., dissenting). For illustrations by the Supreme Court of the troublesome nature of the doctrine, see the 5-4 decision in *Sony*, 464 U.S. 417 (1984), the 6-2 decision in *Google LLC v. Oracle America, Inc.*, 141 S. Ct. 1183 (2021) (holding that Google's copying of some of Oracle's APIs was a fair use), the 6-3 decision in *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539 (1985), the 4 – 4 split in *Williams & Wilkins Co. v. United States*, 487 F.2d 1345 (Ct. Cl. 1973), *aff'd by an equally divided Court*, 420 U.S. 376 (1975), and the 4 – 4 split in *Benny v. Loew's, Inc.*, 239 F.2d 532 (9th Cir. 1956), *aff'd by an equally divided Court sub nom. Columbia Broadcasting System, Inc. v. Loew's, Inc.*, 356 U.S. 43 (1958).

<sup>314</sup> See, e.g., Wendy J. Gordon, *Fair Use as Market Failure: A Structural and Economic Analysis of the Betamax Case and Its Predecessors*, 82 COLUM. L. REV. 1600, 1614 (1982) (“Fair use should be awarded to the defendant in a copyright infringement action when (1) market failure is present; (2) transfer of the use to defendant is socially desirable; and (3) an award of fair use would not cause substantial injury to the incentives of the plaintiff copyright owner.”).

<sup>315</sup> *Harper & Row*, 471 U.S. at 539.

<sup>316</sup> David E. Shipley, *Conflicts Between Copyright and the First Amendment After Harper & Row, Publishers v. Nation Enterprises*, 1986 BYU L. REV. 983, 984 (1986).

<sup>317</sup> *Harper & Row*, 471 U.S. at 556-60; Shipley, *supra* note 313, at 1006-07. See, e.g., *Triangle Publ'ns, Inc. v. Knight-Ridder Newspapers, Inc.*, 626 F.2d 1171 (5th Cir. 1980); *Pac. & S. Co.*

conclusions, the Eleventh Circuit did not say that copyright was the engine of free expression as the Supreme Court did in *Harper & Row*.<sup>318</sup> The court easily could have made such a statement.

Shortly before the split of the old Fifth Circuit in 1981, the Fifth Circuit Court of Appeals decided *Triangle Publications, Inc. v. Knight-Ridder Newspapers, Inc.*<sup>319</sup> This case concerned the Miami Herald's use of the plaintiff's copyrighted TV Guide cover for comparative advertising. The trial court held that the newspaper's copying of the cover infringed the display and reproduction rights and was not a fair use.<sup>320</sup> The court concluded, however, that the First Amendment mandated that the Herald's actions were protected commercial speech.<sup>321</sup> The court of appeals affirmed, but on fair use grounds instead of turning to the First Amendment.<sup>322</sup>

A couple of years later, in *Pacific & Southern Co. v. Duncan*, the Eleventh Circuit upheld an injunction blocking the defendant from copying the plaintiff's news broadcasts.<sup>323</sup> In this case, the court said the plaintiff's efforts to enforce its copyright did not conflict with the First Amendment.<sup>324</sup> The plaintiff's station in Atlanta showed four local news programs daily and sold tapes of its broadcasts to the public.<sup>325</sup> The defendant's TV News Clips service made unauthorized recordings of news reports and sold the tapes to persons and entities mentioned in the televised segments.

The plaintiff sued, and the defendant raised a First Amendment defense as well as fair use.<sup>326</sup> The lower court found for the plaintiff, holding that the defendant's reproduction of the news broadcasts was not fair use, and the Eleventh Circuit affirmed.<sup>327</sup> There was no need for the court to turn to the First

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v. *Duncan*, 744 F.2d 1490 (11th Cir. 1984); *Pillsbury Co. v. Milky Way Prods.*, 215 U.S.P.Q. (BNA) 124 (N.D. Ga. 1981)

<sup>318</sup> *Harper & Row*, 471 U.S. at 558. Incidentally, the Supreme Court's 2021 decision in *Google LLC v. Oracle America, Inc.*, 141 S. Ct. 1183 (2021) made clear that the issue of fair use is to be addressed as a matter of law, rather than a fact issue for the jury to decide. *Decoded: The Supreme Court Rules on Fair Use in Landmark Software Copyright Case*, VORYS SATER SEYMOUR & PEASE LLP CLIENT ALERTS (Apr. 6, 2021), <https://www.vorys.com/publications-2898.html>.

<sup>319</sup> *Triangle Publ'ns, Inc. v. Knight-Ridder Newspapers, Inc.*, 445 F. Supp. 875 (S.D. Fla. 1978), *aff'd on other grounds*, 626 F.2d 1171 (5th Cir. 1980).

<sup>320</sup> *Triangle Publications*, 626 F.2d at 1173.

<sup>321</sup> *Id.*

<sup>322</sup> *Id.* at 1172.

<sup>323</sup> *Pac. & S. Co. v. Duncan*, 744 F.2d 1490, 1493 (11th Cir. 1984).

<sup>324</sup> *Id.* at 1498. The court also held that enforcement of the plaintiff's copyright did not offend the Constitution's copyright clause. *Id.* at 1499.

<sup>325</sup> *Id.* at 1493.

<sup>326</sup> *Id.* at 1494.

<sup>327</sup> *Id.* at 1493.

Amendment because the defendant's use was neither productive nor creative.<sup>328</sup> Moreover, defendant's copying of the broadcasts was a commercial use that adversely affected the market for and value of the plaintiff's works.<sup>329</sup>

#### B. PARODY AND FAIR USE

The U.S. District Court for the Northern District of Georgia has decided several copyright infringement cases in which the defendants contended that they had parodied the plaintiffs' works, and that their parodies were fair use.<sup>330</sup> The court's fair use analysis in these cases foreshadowed the U.S. Supreme Court's fair use decision in *Campbell v. Acuff-Rose Music*.<sup>331</sup>

*Pillsbury Co. v. Milky Way Productions Inc.*,<sup>332</sup> involved infringement claims against pornographic adaptations of *Pillsbury's* characters 'Poppin Fresh' and 'Poppie Fresh' along with the company's jingles, "Nothin says lovin' like something from the oven" and "Pillsbury says it best."<sup>333</sup> The defendant admitted to using the copyrighted jingles and depicting the copyrighted characters having sex.<sup>334</sup> Notwithstanding the pornographic use of the plaintiff's works, the court found fair use.<sup>335</sup>

The court declined the defendant's request to characterize its use of the copyrighted characters and jingles as parody or satire.<sup>336</sup> Instead, it stated that:

[a]fter reviewing Milky Way's presentation, the court concludes that it is more in the nature of an editorial or social commentary than it is an attempt to capitalize financially on

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<sup>328</sup> *Id.* at 1496, 1498.

<sup>329</sup> *Pacific*, 744 F.2d at 1496. *See also* Radabaugh v. Clay Turner Realty Grp., LLC, No. CV 120-058, 2021 WL 2463576 (S.D. Ga. 2021) (summary judgment against defendant's unauthorized commercial use of plaintiff's creative photograph in its entirety on website and this weighed against a finding of fair use).

<sup>330</sup> *Metro-Goldwyn-Mayer, Inc. v. Showcase Atlanta Coop. Prods., Inc.* 479 F. Supp. 351 (N.D. Ga. 1979); *Pillsbury Co. v. Milky Way Prods., Inc.*, 215 U.S.P.Q. 124 (N.D. Ga. 1981).

<sup>331</sup> 510 U.S. 569 (1994).

<sup>332</sup> 215 U.S.P.Q. 124 (N.D. Ga. 1981). The District Court's reasoning in *Pillsbury*, finding fair use, was largely adopted by the Supreme Court over a decade later in *Campbell*. *See infra* text and notes accompanying notes 343–54 (discussion of the Supreme Court's decision in *Campbell v. Acuff-Rose Music*).

<sup>333</sup> 215 U.S.P.Q. at 126.

<sup>334</sup> *Id.* at 125-26.

<sup>335</sup> *Id.* at 131-32.

<sup>336</sup> *Id.* at 129-30. The court said Milky Way had not furnished it with any basis for making this determination and noted that the terms satire and parody did not have a fixed definition among literary critics.

the plaintiff's original work. Although the portrayal is offensive to the court, the court has no doubt that Milky Way intended to make an editorial comment on the values epitomized by these trade characters.<sup>337</sup>

Meanwhile, the plaintiff also argued that the court should consider the salacious content of the defendant's *Screw* magazine. The court responded:

[t]he plaintiff seems to believe that a pornographic adaptation of copyrighted works should be accorded less protection under the fair use doctrine than what might otherwise be granted a more continent presentation. The Copyright Act, however, does not expressly exclude pornographic materials from the parameters of the fair use defense, and the plaintiff offers no authority for this protection. The character of the unauthorized use is relevant, but, in the court's judgment, the fact that the use is pornographic in nature does not militate against a finding of fair use.<sup>338</sup>

The court distinguished its earlier decision in *Metro-Goldwyn-Mayer, Inc. v. Showcase Atlanta Cooperative Productions, Inc.*, in which it ruled against a fair use defense and found infringement.<sup>339</sup> This litigation was about a three-hour-long musical called *Scarlett Fever* based on Metro-Goldwyn-Mayer's classic movie, *Gone With the Wind*.<sup>340</sup> The trial court had held that the musical was neither a satire nor a parody and that even if it was a parody, the defendant had copied far more than the law allowed.<sup>341</sup> The musical was neither salacious nor obscene.<sup>342</sup>

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<sup>337</sup> *Id.* at 131 (footnote omitted).

<sup>338</sup> *Pillsbury*, 215 U.S.P.Q. at 131 (footnote omitted). The court later said that it did not condone the manner in which the defendant chose to assault the defendant corporation, but that value judgments had no place in the analysis. *Id.* at 132.

<sup>339</sup> *Metro-Goldwyn-Mayer, Inc. v. Showcase Atlanta Coop. Prods., Inc.*, 479 F. Supp. 351 (N.D. Ga. 1979).

<sup>340</sup> *Id.* at 354.

<sup>341</sup> *Id.* at 352. Summary judgment was eventually decided for Metro-Goldwyn-Mayer and against defendant's fair use defense. *Metro-Goldwyn-Mayer, Inc. v. Showcase Atlanta Coop. Prods., Inc.*, No. C79-1766A, 1981 U.S. Dist. LEXIS 15976, at \*10-11 (N.D. Ga. Aug. 26, 1981).

<sup>342</sup> David E. Shipley, *A Dangerous Undertaking Indeed: Juvenile Humor, Raunchy Jokes, Obscene Materials and Bad Taste in Copyright*, 98 KY. L. J. 517, 543 n. 177 (2010). See also *D.C. Comics, Inc. v. Unlimited Monkey Bus., Inc.*, 598 F. Supp. 110, 118-19 (N.D. Ga. 1984) (unauthorized imitation of plaintiffs' comic and cartoon characters in singing telegram business held to infringe, and the defendant's fair use defense failed in part they did not engage in any critical comment and instead sought to augment the value of their own property by creating detrimental associations with the plaintiff's property).

The United States Supreme Court addressed parody as fair use in 1994 in *Campbell v. Acuff-Rose Music, Inc.*<sup>343</sup> The case concerned an unauthorized rap version of a 1964 hit by Roy Orbison and William Dees titled ‘Oh, Pretty Woman.’ Luther Campbell and his group 2 Live Crew did their parody recording after Acuff-Rose Music, the copyright owner, denied their request for permission.<sup>344</sup> Campbell’s version copied the original work’s characteristic opening bass riff and “repeated it, but also produced otherwise distinctive sounds, interposing ‘scrapers’ noise, overlaying the music with solos in different keys, and altering the drum beat.”<sup>345</sup> He also copied the opening line from Orbison’s song but then added his own words that “quickly degenerate[d] into a play on words, substituting predictable lyrics with shocking ones.”<sup>346</sup>

The trial court concluded that Campbell’s song was a fair use parody,<sup>347</sup> but the Sixth Circuit reversed. The defendant’s commercial use was presumptively unfair, and the parody took too much protected expression from the plaintiff’s hit song.<sup>348</sup> The Supreme Court reversed following a thorough analysis and application of each factor codified in section 107 of the Copyright Act.<sup>349</sup> In doing so, the Court elevated the transformative use doctrine to special status in the fair use analysis,<sup>350</sup> and aligned itself with other “courts that have held that parody, like other comment or criticism, may claim fair use under § 107.”<sup>351</sup> It stated, “the heart of any parodist’s claim to quote from existing material, is the use of some elements of a prior author’s composition to create a new one that, at least in part, comments on that author’s work.”<sup>352</sup> The Court also said that “[p]arody needs to mimic an original to make its point, and so has some claim to

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<sup>343</sup> *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994).

<sup>344</sup> *Id.* at 572-73.

<sup>345</sup> *Id.* at 589 (footnote omitted).

<sup>346</sup> *Id.* at 573 (quoting *Acuff-Rose Music, Inc. v. Campbell*, 754 F. Supp. 1150, 1154-55 (M.D. Tenn. 1991)).

<sup>347</sup> *Id.* (quoting *Acuff-Rose Music, Inc. v. Campbell*, 754 F. Supp. 1150, 1154-55, 1157-58 (M.D. Tenn. 1991)).

<sup>348</sup> *Id.* at 573-74.

<sup>349</sup> *Campbell*, 510 U.S. at 572-94.

<sup>350</sup> JOYCE ET AL., *supra* note 2, at 857; David E. Shipley, *A Transformative Use Taxonomy: Making Sense of the Transformative Use Standard*, 63 WAYNE L. REV. 267, 274 (2018). Google’s use of Oracle’s APIs was held to be transformative by the Supreme Court in *Google LLC v. Oracle America, Inc.*, 141 S. Ct. 1183, 1204 (2021). The Court said that “Google’s use of the Sun Java API seeks to create new products. It seeks to expand the use and usefulness of Android-based smartphones. Its new product offers programmers a highly creative and innovative tool for a smartphone environment. To the extent that Google used parts of the Sun Java API to create a new platform that could be readily used by programmers, its use was consistent with that creative ‘progress’ that is the basic constitutional objective of copyright itself.” *Id.* at 1203.

<sup>351</sup> *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994).

<sup>352</sup> *Id.* at 580.

use the creation of its victim's . . . imagination, whereas satire can stand on its own two feet and requires justification for the very act of borrowing."<sup>353</sup> This statement does not mean, however, that satire cannot be a fair use.<sup>354</sup>

Not long after the Supreme Court decided *Campbell v. Acuff-Rose Music, Inc.*, the Eleventh Circuit discussed parody and the transformative use doctrine in *SunTrust Bank v. Houghton Mifflin Co.*<sup>355</sup> The defendant published Alice Randall's book *The Wind Done Gone* in 2001. Ms. Randall's novel was derived from Margaret Mitchell's 1936 novel, *Gone With the Wind* (GWTW), and it retold Mitchell's story from the perspective of a mixed-race, slave half-sister of Scarlett O'Hara. *The Wind Done Gone*, written without permission of the Mitchell estate, referred to GWTW in its forward and copied plot elements, major characters, traits, relationships, scenes, descriptions, and dialogues.<sup>356</sup> The estate would never permit a sequel of GWTW with miscegenation or homosexuality, and *The Wind Done Gone* had both.<sup>357</sup> SunTrust, on behalf of the author's heirs as trustee, sued for copyright infringement and won in the United States District Court for the Northern District of Georgia.<sup>358</sup>

The Eleventh Circuit reversed, holding that the defendant's novel was fair use.<sup>359</sup> It was a critique and parody of GWTW that had both verbatim and nonliteral copying of the 1936 novel's plot and characters.<sup>360</sup> It commented on the original work by appropriating characters and elements to conjure up the novel for readers, and used those elements to criticize the novel's depiction of slavery and race relations in the antebellum South.<sup>361</sup> The transformative nature of *The Wind Done Gone* outweighed the defendant's commercial purpose. The author added new expression and meaning to Mitchell's novel by changing it from a third-person epic to a first-person diary and memoir.<sup>362</sup> In addition, the second half of the defendant's novel was a new story featuring plot elements not found in the original.<sup>363</sup> The nature of the copyrighted work factor carried little weight since a parody is based invariably on a well-known expressive work. The court did not determine whether the amount of the copying from GWTW was

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<sup>353</sup> *Id.* at 580-81.

<sup>354</sup> Shipley, *A Dangerous Undertaking Indeed*, *supra* note 342, at 558.

<sup>355</sup> *SunTrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257 (11th Cir. 2001).

<sup>356</sup> *Id.* at 1259. *See also* JOYCE ET AL., *supra* note 2, at 842-43 n.13 (discussion of the extensive 'conjuring up' in *Wind Done Gone*).

<sup>357</sup> 268 F.3d at 1282.

<sup>358</sup> *Id.* at 1259.

<sup>359</sup> *Id.* at 1277.

<sup>360</sup> *Id.* at 1259.

<sup>361</sup> *Id.* at 1270.

<sup>362</sup> *Id.* at 1279.

<sup>363</sup> *Id.* at 1270.

excessive in relation to the defendant's purpose.<sup>364</sup> Finally, the court said the plaintiff's evidence did not show that the defendant's novel would have a deleterious effect on the market for GWTW by displacing sales.<sup>365</sup>

The U.S. District Court for the Northern District of Georgia held that *The Elf of the Shelf (Elf Off)*, a raunchy version of the popular children's Christmas book, *The Elf on the Shelf (Elf On)*, was a parody and fair use in *CCA and B, LLC v. F + W Media Inc.*<sup>366</sup> The books had similar covers and jackets, but the defendant's elf narrator used crude language, drank spiked eggnog, hit on Barbie while Ken was away, and watched pornography.<sup>367</sup> The district court relied on *Campbell* in finding that the defendant's book was a parody directed at the plaintiff's work,<sup>368</sup> and that it was a transformative use by depicting the elf in an unromantic setting that demystified the magic of plaintiff's *Elf On*.<sup>369</sup>

The court determined that the extent of the defendant's copying was appropriate in order to comment on *Elf On*,<sup>370</sup> and there was no evidence of market harm.<sup>371</sup> The court said it was improbable that sales of the defendant's book would replace sales of *Elf On*.<sup>372</sup> Citing the *Suntrust* decision, the court noted that the plaintiff "failed to meet its burden of proving . . . a substantial likelihood that Defendant's fair use defense will not succeed."<sup>373</sup>

A problem with post-*Campbell* parody case law is uncertainty about determining whether a defendant's challenged use is actually a parody that criticizes or comments on the plaintiff's original work of authorship. Does the defendant's entertaining pastiche or spoof truly comment on the plaintiff's popular work? Or, was the plaintiff's work easy to use as a vehicle for getting laughs or making a snarky comment about a general social issue?<sup>374</sup> This

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<sup>364</sup> *Id.* at 1274.

<sup>365</sup> *Id.* at 1275-76. *See also* *Katz v. Google Inc.*, 802 F.3d 1178 (11th Cir. 2015) (reproduction of an embarrassing copyrighted photo of the plaintiff in blog articles critical of the plaintiff's business practices was a transformative use and fair in that it criticized and satirized the plaintiff's character—the plaintiff had purchased the copyright to the photo from the photographer before suing the blogger). *See generally* Shipley, *A Transformative Use Taxonomy*, *supra* note 350, at 287 n. 126 (citations of decisions that illustrate the difficulty of determining whether a spoof or take-off is a parody); Shipley, *A Dangerous Undertaking Indeed*, *supra* note 342, at 571 n. 387 (citing *The Wind Done Gone* case and another decision for the proposition that the line between parody and satire is arbitrary).

<sup>366</sup> *CCA & B, LLC v. F + W Media Inc.*, 819 F. Supp. 2d 1310 (N.D. Ga. 2011).

<sup>367</sup> *Id.* at 1316-17.

<sup>368</sup> *Id.* at 1318-19.

<sup>369</sup> *Id.* at 1321-22.

<sup>370</sup> *Id.* at 1322-23.

<sup>371</sup> *CCA & B*, 819 F. Supp. 2d at 1323-24.

<sup>372</sup> *Id.* at 1323.

<sup>373</sup> *Id.* at 1324.

<sup>374</sup> Shipley, *A Transformative Use Taxonomy*, *supra* note 350, at 287.

uncertainty has not troubled courts in the Eleventh Circuit. The circuit's firm approach is evidenced by fair use rulings involving the pornographic uses of Pillsbury's characters, the controversial *Wind Done Gone* sequel to *Gone With the Wind*, and the raunchy version of *Elf on the Shelf*.<sup>375</sup> In each of these cases, the courts readily found that the defendants were commenting on the plaintiffs' well-known copyrighted works in concluding that the challenged uses were fair.

### C. FAIR USE AND THE REPRODUCTION OF WORKS FOR EDUCATIONAL PURPOSES

The preamble to the Copyright Act's fair use provision lists using a protected work for the purpose of 'teaching' as an example of a fair use.<sup>376</sup> The Supreme Court acknowledged in *Campbell v. Acuff-Rose Music* that an "obvious statutory exception to this focus on transformative uses is the straight reproduction of multiple copies for classroom distribution."<sup>377</sup> Moreover, the "multiple copies for classroom use" language in section 107<sup>378</sup> was tracked by the Supreme Court in *Campbell*. This language, however, is about photocopies.<sup>379</sup> Section 107 and its legislative history do not address using digital technology to reproduce protected works and making them available for educational purposes. The Eleventh Circuit grappled with digitization and fair use for twelve years in litigation concerning digital reserves at Georgia State University.

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<sup>375</sup> See *supra* notes 332 to 373 and accompanying text. Nothing in the Supreme Court's recent decision, *Google LLC v. Oracle America, Inc.*, 141 S. Ct. 1183 (2021), should alter the Eleventh Circuit's generous approach to fair use generally and the transformative use doctrine specifically. After all, the Court found fair use transformation in Google's copying of Oracle's programming code used in its JAVA APIs. *Id.* at 1209. What Google did with JAVA "was a fair use of that material as a matter of law" because it "reimplemented a user interface, taking only what was needed to allow users to put their accrued talents to work in a new and transformative program . . ." *Id.* Lawrence Veregin, *Planet of the APIs: U.S. Supreme Court Rules Google's Use of Java APIs in Android Is Fair Use*, SPOTLIGHT (Apr. 8, 2021), <https://www.airdberlis.com/insights/blogs/thephotlight/post/ts-item/planet-of-the-apis-u.s.-supreme-court-rules-google-s-use-of-java-apis-in-android-is-fair-use>.

<sup>376</sup> 17 U.S.C. § 107. The fact that a use is for an educational purpose does not, however, guarantee a finding of fair use. See, e.g., *Peter Letterese & Assocs. v. World Inst. of Scientology Enters.*, 533 F.3d 1287, 1317-18 (11th Cir. 2008) (ruling that defendants failed to prove their entitlement to summary judgment based on fair use for using plaintiff's instructional book, *Big League Sales Closing Techniques (BLS)*, for staff training material because the defendants' uses were not transformative and because there were genuine issues of material fact pertaining to the fourth fair use factor—the effect on the market—in that the defendant's course packets, derived from *BLS*, may have damaged the market for *BLS* as a substitute).

<sup>377</sup> *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 580 n.11 (1994).

<sup>378</sup> 17 U.S.C. § 107.

<sup>379</sup> See generally *JOYCE ET AL.*, *supra* note 2, at 875-77 (general discussion of photocopying and digital reproduction).

The Cambridge University Press and several other publishers sued Georgia State in 2008, but there was not a published opinion until 2012.<sup>380</sup> The plaintiffs claimed copyright infringement resulting from the university's electronic course reserve practices that made excerpts from academic books available online to students enrolled in particular courses.<sup>381</sup> According to the trial court, the first factor, "the purpose and character of the use," favored Georgia State.<sup>382</sup> It referenced the preamble to section 107 and noted that the copying was "for strictly nonprofit educational purposes" at a nonprofit educational institution.<sup>383</sup> There was no need for the lower court to discuss the transformative use standard given the Supreme Court's explicit reference to copying for educational purposes in *Campbell*.<sup>384</sup>

The second factor, "the nature of the copyrighted work," favored Georgia State because the reproduced works were informational.<sup>385</sup> Factor three, "the amount and substantiality of the portion used in relation to the copyrighted work as a whole," also worked in Georgia State's favor since the extent of the copying was limited by GSU's e-Reserves policy. This policy restricted, for example, the reproduced excerpts to ten percent of an article or one chapter from a book.<sup>386</sup> Only the fourth factor, the impact of the use on the "market for or value of the copyrighted work," favored the publishers because the defendant's use of the excerpts affected the market for licensing those excerpts.<sup>387</sup> Still, the trial court said that fair use applied whenever at least three of the four factors favored the defendant.<sup>388</sup> It determined that of the 48 alleged instances of infringement, all but five were fair use.<sup>389</sup>

The plaintiffs argued on appeal that the trial court's analysis was flawed and that it erred in finding fair use in those 43 instances.<sup>390</sup> The Eleventh Circuit reversed and remanded.<sup>391</sup> It found fault with the trial court's methodology of using bright-line rules and a formula.<sup>392</sup> It agreed that the first factor favored fair use, but it emphasized that fair use analysis must be on a flexible, case-by-case

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<sup>380</sup> *Cambridge Univ. Press v. Patton*, 769 F.3d 1232 (11th Cir. 2014), *rev'g and remanding* 863 F. Supp. 2d 1190 (N.D. Ga. 2012).

<sup>381</sup> *Id.* at 1237.

<sup>382</sup> *Id.* at 1249.

<sup>383</sup> *Id.*

<sup>384</sup> *Id.* at 1263 (citing *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 n.11 (1994)).

<sup>385</sup> *Id.* at 1249.

<sup>386</sup> *Id.* at 1251.

<sup>387</sup> *Id.* at 1250.

<sup>388</sup> *Id.* at 1251.

<sup>389</sup> *Id.* at 1252.

<sup>390</sup> *Id.* at 1253.

<sup>391</sup> *Id.* at 1232.

<sup>392</sup> *Id.* at 1259-60.

basis.<sup>393</sup> It also stated that Georgia State's use of the plaintiffs' works was not transformative, and that its uses "supersede[d] the object[s] of the original creations."<sup>394</sup> The court acknowledged that the uses were for education at a non-profit institution. However, it reminded the lower court that "the crux of the profit/nonprofit distinction is . . . whether the user stands to profit from exploitation of the copyrighted material without paying the customary price."<sup>395</sup>

The court ultimately concluded that the lower court did not err in saying that the first factor favored fair use and that this related to the fourth factor as well.<sup>396</sup> It explained that the district court's analysis properly took into account the availability of licenses.<sup>397</sup> The trial court erred, however, in concluding that the second fair use factor favored Georgia State because excerpts in the e-Reserves were informational and educational.<sup>398</sup> Instead, the district court should have concluded that this factor was neutral.<sup>399</sup> Similarly, the appeals court said it was an error to conclude automatically that ten percent of an article or one chapter from a book was a safe harbor in connection with the third factor.<sup>400</sup> Instead, the trial court should have analyzed each instance individually.<sup>401</sup>

On remand, the district court went with an approximate weight per factor formula, performed individualized inquiries for each of the works, and concluded that 44 of the 48 were fair use.<sup>402</sup> Once again, the Eleventh Circuit sent the case back to the trial court, saying that the district court had failed to break free of its arithmetic approach to fair use, and explained that the court should have been more holistic.<sup>403</sup>

The most recent chapter in this litigation was a 130-page order from the district court, issued in March 2020.<sup>404</sup> The district court, in attempting to heed the Eleventh Circuit's instructions from 2018, once again examined the 48 works still at issue and ultimately concluded that there were only 10 infringements.<sup>405</sup>

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<sup>393</sup> *Id.* at 1259, 1267.

<sup>394</sup> *Id.* at 1263.

<sup>395</sup> *Id.* at 1265.

<sup>396</sup> *Id.* at 1267.

<sup>397</sup> *Id.* at 1279.

<sup>398</sup> *Id.* at 1270.

<sup>399</sup> *Id.*

<sup>400</sup> *Id.* at 1271.

<sup>401</sup> *Id.* at 1272.

<sup>402</sup> *Id.* at 1290, 1293, 1297.

<sup>403</sup> *Cambridge*, 769 F.3d at 1300.

<sup>404</sup> *Cambridge Univ. Press v. Becker*, 446 F. Supp. 3d 1145 (N.D. Ga. 2020).

<sup>405</sup> *Id.* at 1271-72 (the summary lists the works that had been infringed); Final Order, *Cambridge Univ. Press v. Becker*, No. 1:08-cv-01245-ODE, n.2 (N.D. Ga. 2020), ECF No. 583.

The plaintiffs decided against filing a third appeal.<sup>406</sup> The trial court entered a final order on September 29, 2020.<sup>407</sup> This ruling was a final judgment with costs taxed against the plaintiffs. In the end, the publishers prevailed on only 10 of their original 99 claims; 89 of the challenged digitized excerpts were fair use.<sup>408</sup> Although the defendants were the prevailing parties, the district court declined to award attorney's fees.<sup>409</sup> The court ordered the defendants to maintain copyright policies "which are not inconsistent with the rulings" of the Eleventh Circuit.<sup>410</sup>

The Author's Alliance supported Georgia State's position that these limited uses of copyrighted material for non-profit educational purposes fell within fair use. They applauded the district court's third ruling that had found a majority of the challenged uses of unlicensed excerpts in the e-Reserves to be fair.<sup>411</sup> The Alliance contended that "academic authorial incentives to create scholarly book chapters would not be impaired by a fair use ruling."<sup>412</sup>

In contrast, the Association of American Publishers said that the trial court's 2020 ruling was at odds with the Eleventh Circuit's earlier rulings.<sup>413</sup> The Association added that "publishers are confident that the guidance from the court of appeals is clear and authoritative as to future actors . . . [and] is adequate to ensure that universities will maintain copyright policies and practices that are consistent with its rulings and well-established copyright jurisprudence."<sup>414</sup>

Georgia State was deemed the prevailing party by the U.S. District Court. Nevertheless, the Association of American Publishers and the Copyright Clearance Center said that the Eleventh Circuit "made clear that the kind of

<sup>406</sup> The Association of American Publishers and the Copyright Clearance Center, along with the Cambridge University Press, the Oxford University Press, and SAGE Publishing, issued a statement on November 12, 2020 explaining why they had declined to file another appeal, thus bringing this long running dispute to an end. Porter Anderson, *AAP and CCC End Georgia State 'E-Reserves' Copyright Litigation*, PUBLISHING PERSPECTIVES (Nov. 12, 2020) <https://publishingperspectives.com/2020/11/aap-and-copyright-clearance-center-end-georgia-state-e-reserves-litigation/>.

<sup>407</sup> Order, *Cambridge Univ. Press v. Becker*, No. 1:08-cv-01245-ODE (N.D. Ga. 2020), ECF No. 583.

<sup>408</sup> *Id.* at 13.

<sup>409</sup> *Id.*

<sup>410</sup> *Id.*

<sup>411</sup> Martin Adams, *District Court Finds Majority of Uses to Be Fair in Georgia State's E-Reserves Case*, AUTHORS ALLIANCE (Mar. 4, 2020), <https://www.authorsalliance.org/2020/03/04/district-court-finds-majority-of-uses-to-be-fair-in-georgia-state-e-reserves-case/>. The Authors Alliance had filed an amicus brief in 2017 in support of Georgia State in the second appeal to the Eleventh Circuit.

<sup>412</sup> *Id.*

<sup>413</sup> See Anderson, *supra* note 406 (this statement was made in the context of the plaintiffs' explanation for not appealing the 2020 ruling).

<sup>414</sup> *Id.*

‘nontransformative copying’ undertaken by Georgia State University poses a ‘severe threat of market harm’ to publishers, and that such harm should be given ‘more significant weight in [the] overall fair use analysis’ and ‘strongly disfavors’ fair use where publishers have offered digital licenses for the material.” These two entities added that that the “educational setting does not ameliorate the ‘threat of market substitution.’”<sup>415</sup>

The Georgia State e-Reserves litigation was a test case that ultimately “failed to deliver any kind of easily understood, broadly applicable formula for determining where the fair use line should be drawn.”<sup>416</sup> Another comment on the litigation stated,

when all is said and done, it is telling that the district court’s ultimate fair use conclusions vary little in each of its three bites of the apple. This suggests that the reason that this case has dragged on for so long has more to do with the district court’s transparency about its mode of analysis (about how the sausage was made) than with its ultimate conclusions on the merits.<sup>417</sup>

## V. CONCLUSION

The United States Court of Appeals for the Eleventh Circuit has rendered many important copyright law decisions in the last four decades. Its body of work has been influential on a variety of copyright issues and topics. The court’s discussion of the originality standard in *Miller v. Universal City Studios, Inc.*, along with its holding that copyright did not extend to research, was cited by the U.S. Supreme Court in its landmark *Feist* decision.<sup>418</sup> The Eleventh Circuit’s application of the principles announced in *Feist* to compilations, directories, computer software, architectural works, and other creative works like movies, photographs and characters has been especially rigorous.<sup>419</sup> The court has consistently scrutinized works of authorship in order to separate copyrightable expression from unprotectable elements. The court has done this by applying *Feist*’s principles about authorship along with section 102(b) of the Copyright

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<sup>415</sup> *Id.* (quoting the joint statement from the Presidents of the Association of American Publishers and the Copyright Clearance Center).

<sup>416</sup> Andrew Albanese, *Publishers Escape Fee Award as GSU E-Reserves Case Finally Ends*, PUBLISHERS WEEKLY (Oct. 2, 2020), <https://www.publishersweekly.com/pw/by-topic/digital/copyright/article/84514-publishers-escape-fee-award-as-gsu-e-reserves-case-finally-ends.html>.

<sup>417</sup> Brian Murphy, *Fantasies About a Formula for Fair Use*, FRANKFURT KURNIT KLEIN & SELZ PC (Mar. 11, 2020), <https://advertisinglaw.fkks.com/post/102g134/fantasies-about-a-formula-for-fair-use>.

<sup>418</sup> *See supra* text and notes accompanying notes 22–40.

<sup>419</sup> *See supra* notes 58–241 and accompanying text.

Act, the merger doctrine, and *scènes à faire*. The court's *Moghadam* decision upheld an anti-bootlegging statute under the Commerce Clause even though the statute extended copyright-like protection to unfixed works. Other courts have followed this decision.<sup>420</sup> The Eleventh Circuit extended the venerable government edicts doctrine to the annotations and commentary in the Official Code of Georgia Annotated. The U.S. Supreme Court affirmed in the *Code Revision Commission* decision, albeit on different grounds.<sup>421</sup> Finally, the circuit's fair use rulings show a generous interpretation and application of this important defense. The court has done this in the context of tensions between copyright and the First Amendment, parody, and the use of protected works for educational purposes.<sup>422</sup>

These many decisions show that Eleventh Circuit's copyright jurisprudence has consistently adhered to the fundamental principle that copyright protection extends only to creative expression. Ideas, facts, *scènes à faire*, and those elements of a work that are standard, routine, commonplace, or dictated by efficiency are not protected.<sup>423</sup> As a result, everyone is free to use whatever is in the public domain and whatever is unprotected by copyright in a work of authorship.<sup>424</sup> Accordingly, it is established in the Eleventh Circuit that the use of a work and the use of a copyright are distinct, in that one may use the unprotected elements of work without infringing copyright.<sup>425</sup> Reward to the author remains a secondary consideration in the Eleventh Circuit because the primary beneficiary of copyright is the public.<sup>426</sup>

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<sup>420</sup> See *supra* notes 242–69 and accompanying text.

<sup>421</sup> See *supra* notes 270–312 and accompanying text.

<sup>422</sup> See *supra* notes 313–417 and accompanying text.

<sup>423</sup> *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 363(1991); *Bateman v. Mnemonics, Inc.*, 79 F.3d 1532, 1542 (11th Cir. 1996).

<sup>424</sup> *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 231 (1964); *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 237 (1964); Shipley, *Congressional Authority Over Intellectual Property*, *supra* note 18, at 1256-57.

<sup>425</sup> *Bateman*, 79 F.3d at 1542 n.23 (11th Cir. 1996) (citing L. Ray Patterson, *Understanding Fair Use*, 55 LAW & CONTEMP. PROBS. 249, 259, 264 (1992)).

<sup>426</sup> *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984) (citing *Fox Film Corp. v. Doyal*, 286 U.S. 123 (1932)) (stating that the copyright law makes reward to the author a secondary consideration); *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 348 (1991) (“[t]he primary objective of copyright is not to reward the labor of authors, but [t]o promote the Progress of Science and useful Arts.” (quoting U.S. CONST. art. I, § 8, cl. 8)).